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NOTE

MORAL RIGHT PROTECTIONS IN THE COLORIZATION OF BLACK AND WHITE MOTION PICTURES: A BLACK AND WHITE ISSUE*

Although Congress has always had to reckon with technological change, the new information and communications technologies available today are challenging the intellectual property system in ways that may only be resolvable with substantial changes in the system or with new mechanisms to allocate both rights and rewards.¹

United States Congress
Office of Technology Assessment

Here the difficult problem is rather that of defining the proper relationship between what is unquestionably an established and functioning system of law, on the one hand, and general standards of morality, on the other.²

Lon L. Fuller

I. INTRODUCTION

A. The Colorization Controversy

The complex problem of defining the proper relationship between law and morality underlies the current controversy surrounding the “colorization”³ of black and white motion pictures.⁴ Despite

* An earlier version of this Note was awarded first prize in the 1988 Nathan Burkan Memorial Competition at Hofstra University School of Law, sponsored by the American Society of Composers, Authors and Publishers, and has been entered in the national competition.

1. OFFICE OF TECHNOLOGY ASSESSMENT, INTELLECTUAL PROPERTY RIGHTS IN AN AGE OF ELECTRONICS AND INFORMATION, 99th Cong., 2d Sess. 3 (1986).
2. L. FULLER, THE MORALITY OF LAW 131 (rev. ed. 1969). "There are many different types of relation between law and morals and there is nothing which can be profitably singled out for study as the relation between them." H.L.A. HART, THE CONCEPT OF LAW 181 (1961) (emphasis in original).
3. The term "colorization" is a trademark of Colorization, Inc. PATENT AND TRADE-
the approximately $350,000 it can cost to colorize a full-length feature film, the companies producing color versions of black and white films ("colorists") and the owners of copyrights in black and white films ("copyright proprietors") view the sale of colorized films in the television syndication and home video markets as a potential gold mine that may stimulate interest in films of a different generation.

Mark Office, United States Dept' of Commerce, Official Gazette of the United States Patent and Trademark Office, Nov. 3, 1987, at TM153. Colorization, however, has become a generic term in the motion picture industry that denotes the process by which black and white films are enhanced with color, Glenex Industries, Inc., 1987 Annual Report 5 (1987), and is a term that is used extensively throughout this Note.

The two leading colorists are Colorization, Inc. and Color Systems Technology, Inc. Bennetts, 'Colorizing' Film Classics: A Boon or a Bane?, N.Y. Times, Aug. 5, 1986, at A1, col. 3. Glenex Industries owns a 50.5% interest in Colorization, Inc., while the remaining 49.5% is owned by Hal Roach Studios, Inc., which in turn is controlled by Glenex. Glenex Industries, Inc., 1987 Annual Report 5 (1987). Colorization, Inc. produces only 13 full-length feature films per year. Id. at 3. New facilities, however, are expected to increase this production to one film per week. Id. Popular motion pictures enhanced by Colorization, Inc. include Topper (MGM 1937) and It's a Wonderful Life (Liberty-RKO 1946), both of which grossed over $2 million in their first year of post-colorization distribution. See id. at 12.


Turner Entertainment Company, a subsidiary of Turner Broadcasting Systems, Inc., owns and preserves the largest film library in the world, with 6,700 feature films, shorts and cartoons. See Turner Entertainment Co., This is Turner Entertainment Co. (newsletter on file at Hofstra Law Review). Most of these film classics were produced by MGM, RKO and Warner Brothers during the heyday of the studio system. Turner Entertainment Co., Hollywood's Greatest Treasures (newsletter on file at Hofstra Law Review). Turner Entertainment Company's involvement in the colorization market exists pursuant to an agreement with Color Systems Technology, Inc. Turner Entertainment Company, The Revolution in Color (newsletter on file at Hofstra Law Review). The agreement provides for the initial colorization of 100 black and white classics, with an option for the subsequent colorization of an additional 200 feature films. Id. Turner Entertainment Company's colorization program has enhanced such classics as 42nd Street (Warner Brothers 1933), Captain Blood (Cosmopolitan-Warner Brothers 1935), The Maltese Falcon (Warner Brothers 1941) and Yankee Doodle Dandy (Warner Brothers 1942). Id.


6. Bennetts, supra note 3, at A1, col. 3; see infra notes 77, 191 (discussing the popular-
Opponents of colorization, however, charge that colorization degrades important works of art and have compared it "to putting lipstick on a Greek statue." 7

This Note focuses on the lack of moral right protections in the United States and the alternative theories that have been proposed as a means to protect the integrity of black and white films. It concludes that the alternative theories of copyright, 8 publicity, 9 and unfair competition 10 do not vindicate the integrity of original black and white films. Where appropriate, distinctions will be made between a colorist who colorizes a public domain film 11 and a copyright propri-
etor or licensee who colorizes his copyrighted work. This Note then briefly examines potential solutions to the colorization controversy, including contract remedies and pending Congressional legislation, and concludes that the original filmmakers and actors of a black and white film are without remedy under current law.

B. The Copyright Office Attempts to Resolve the Colorization Controversy

After conducting a Notice of Inquiry, on June 22, 1987, the Copyright Office of the Library of Congress attempted to partially resolve the colorization controversy. The Copyright Office ruled that colorized versions of black and white motion pictures are registrable for copyright protection as derivative works and should be accorded the exclusive rights and remedies of copyright law.

The Future: Exploiting Vintage Films in the Public Domain, L.A. Law., May 1987, at 34. Courts should view the public domain “not merely as an unexplored abstraction but as a field of individual rights fully as important as any of the new property rights.” Lange, Recognizing the Public Domain, 44 Law & Contemp. Probs. 147, 178 (1981). Thus, the recent uncontrolled growth of intellectual property law must be viewed in light of the increased recognition of individual rights in the public domain. Id. at 147.

12. See infra notes 209-37 and accompanying text.


15. Registration of a claim to copyright with the Register of Copyrights is not a prerequisite for copyright protection. 17 U.S.C. § 408(a) (1982). Registration, however, is a condition precedent to the commencement of a copyright infringement suit. Id. § 411. As an additional incentive for registration, the 1976 Act imposes registration as a precondition to the recovery of statutory damages or attorneys’ fees provided by §§ 504-505. See id. § 412.

16. Id. § 103. The 1976 Copyright Act defines a derivative work as “a work based upon one or more pre-existing works . . . . A work consisting of . . . modifications which, as a whole, represent an original work of authorship . . . .” Id. § 101. Professor Goldstein argues that judicial acceptance of derivative rights and derivative works has been inconsistent, resulting in part from the historical evolution of derivative rights and the lack of a general theory to guide the court in the resolution of cases involving such rights. Goldstein, Derivative Rights and Derivative Works in Copyright, 30 J. Copyright Soc’y U.S.A. 209, 210-11 (1983).


19. Copyright Office Ruling, supra note 4, at 23,445-46. In determining whether a particular colorized black and white film satisfies the appropriate standard for a derivative work, the Copyright Office will apply the following criteria:

(1) Numerous color selections must be made by human beings from an extensive color inventory.

(2) The range and extent of colors added to the black and white work must represent more than a trivial variation.

(3) The overall appearance of the motion picture must be modified; registration will not be made for the coloring of a few frames or the enhancement of color in a
The ruling, however, does not provide a definitive resolution of the colorization controversy. As the United States Register of Copyrights observed, this decision "may open a Pandora's box of troubles, but by restricting the Copyright Office's consideration to colorized black-and-white films, the damage to the purists can perhaps be limited."20

Perhaps the most glaring problem with the Copyright Office ruling is its failure to address moral right protections21 for the original black and white film. Opponents of colorization strongly argue that no one should have the right to alter an artist's work for any reason without the artist's consent.22 This argument fails, however, since the previously colored film.

(4) Removal of color from a motion picture or other work will not justify registration.
(5) The existing regulatory prohibition on copyright registration based on mere variations of color is confirmed.

Id. at 23,446. In order to assist the Copyright Office in its evaluation, the Notice of Proposed Rulemaking requires the deposit of the underlying black and white film along with the colorized version. Proposed Rulemaking for Copyright Registration for Colorized Versions of Black and White Motion Pictures, 52 Fed. Reg. 23,691, 23,692 (1987) (to be codified at 37 C.F.R. pt. 202) (proposed June 24, 1987). Such deposit requirements will simultaneously preserve the print of the black and white version as a collection of the Library of Congress. See id. If the Copyright Office determines that registration is warranted based upon a comparison of the two films,

the copyright will cover only the new material, that is, the numerous selections of color that are added to the original black and white film. The copyright status of the underlying work is unaffected. The black and white film version will remain in the public domain or enter the public domain as dictated by its own copyright term. When an underlying work is in the public domain, another party is free to use that work to make a different color version which may also be eligible for copyright protection.

Copyright Office Ruling, supra note 4, at 23,446.


21. The European concept of moral right protects the personal rights of the artist in his creative work, not merely his economic rights. See infra notes 26-37 and accompanying text (discussing the doctrine of moral right).

22. According to actor and director Woody Allen, the issue of morality is the central inquiry in the colorization controversy. Allen, The Colorization of Films Insults Artists and Society, N.Y. Times, June 28, 1987, at D25, col. 1. Although Allen is adamantly opposed to the colorization of black and white motion pictures, in his testimony before the Senate Subcommittee on Technology and the Law, he stated that he is not opposed to colorization per se. Senate Hearings on Colorization, supra note 6, at 24 (testimony of Woody Allen). Allen's personal belief is that the decision to colorize must always remain with the director. Id. Thus, if a work was originally created in black and white and the director is no longer alive, the film cannot be colorized. Id. Similarly, director Sydney Pollack does not argue the relative merits of black and white versus color, but rather would defer to the director's judgment. Id. at 17 (testimony of Sydney Pollack). Allen pointed out that a color film is neither better nor worse than a black and white film; rather, these are two distinct art forms. Id. at 25 (testimony of
doctrino of moral right is not expressly accepted in the United States. Nevertheless, similar protections in the United States have been afforded to artists under the laws of copyright, publicity and unfair competition, and at least one commentator has argued that these analogous protections constitute impediments to the colorization of black and white motion pictures.

Woodo Allen). It is a director's professional choice of which medium to employ. Id. at 24. These choices are not mutually exclusive, however, as directors have successfully used both black and white and color in the same motion picture. Popular examples of this technique include Woody Allen's The Purple Rose of Cairo (Orion 1985) and Victor Fleming's The Wizard of Oz (MGM 1939). Allen believes that "no one should ever be able to tamper with any artist's work in any medium against the artist's will ...." Id. at 26 (testimony of Woody Allen). Similarly, Pollack believes "that it is morally unacceptable to alter the product of a person's creative life without that person's permission." Id. at 17 (testimony of Sydney Pollack).


25. See Greenstone, A Coat of Paint on the Past?: Impediments to Distribution of Colorized Black and White Motion Pictures, ENT. & SPORTS L., Fall 1986, at 1, 17-20. Although the threshold issue in the colorization controversy is whether colorized films actually qualify for copyright protection as derivative works, commentators overwhelmingly support the Copyright Office Ruling in favor of such protection. See, e.g., Duggan & Pennella, supra note 4, at 347-64; Note, A Film of a Different Color: Copyright and the Colorization of Black and White Films, 5 CARDOZO ARTS & ENT. L.J. 497, 500-23 (1986) (authored by Elise K. Bader). But see Greenstone, supra, at 13-16 (concluding that the colorization process does not involve a sufficient quantum of originality to warrant copyright protection for colorized films as derivative works). In addition, the Copyright Office Ruling carefully examined the colorization process and the appropriate judicial standard for a derivative work. See Copyright Office Ruling, supra note 4, at 23,443-46. The Ruling, however, is not a judicial decision and a court may very well reach a different conclusion. Molotsky, Colored Movies Ruled Eligible for Copyright, N.Y. Times, June 20, 1987, at A9, col. 6 (quoting Martin Garbus of Frankfurt, Garbus, Klein & Selz, P.C., counsel for Viking/Penguin Publishers). In contrast, other commentators believe that "[n]either the copyright law nor the copyright registration system should become a general determinant of artistic merit, creative propriety or cultural orthodoxy." Baumgarten & Hertzmark, Color-Converted Motion Pictures Are Registrable Derivative Works, Nat'l L.J., July 27, 1987, at 28, col. 1.
II. THE DOCTRINE OF MORAL RIGHT AND THE LACK OF EXPRESS PROTECTION IN THE UNITED STATES

Opponents of colorization point to the fact that in many countries artists' works are protected by the government.\textsuperscript{26} The government protection for artists in France is known as \textit{droit moral}, which is translated to mean "moral right."\textsuperscript{27} The underlying function of the doctrine of moral right is to protect the personal rights of artists in their creative works, not merely their economic rights.\textsuperscript{28} In 1957, France codified the moral right protections which its judiciary frequently extended to artists.\textsuperscript{29} The French doctrine consists of a quartet of rights, including the right of disclosure,\textsuperscript{30} right of withdrawal,\textsuperscript{31} right of paternity,\textsuperscript{32} and right of integrity.\textsuperscript{33} The moral
right most relevant to the colorization controversy is the right of integrity since it “protects the creator from any unauthorized modifications, alterations, or even additions to the work.”

Recognition of moral rights, however, is not limited to France. Adopting aspects of the French doctrine, article 6 of the International Union for the Protection of Literary and Artistic Works (Berne Convention) protects the personal rights of an artist in his creative work. Although seventy-six countries have ratified the Berne Convention, adherence by the United States is conspicuously absent.

33. Article 6 of the French statute is also the textual support for the right of integrity. See supra note 32. In contrast to the right of disclosure, however, the obligation to respect the integrity of an author's work does not commence until the work is completed and published. See Sarraute, supra note 24, at 480.

34. Shaffer, supra note 24, at 3; see generally Roeder, supra note 24, at 565-72 (discussing the moral right of integrity).

35. The International Union for the Protection of Literary and Artistic Works, originally signed in 1886 in Berne, Switzerland, was the first multilateral copyright treaty. See Berne Convention for the Protection of Literary and Artistic Property, Sept. 9, 1886, reprinted in 3 UNESCO & WIPO, COPYRIGHT LAWS AND TREATIES OF THE WORLD (1984) [hereinafter Berne Convention]. As a member of the Berne Convention, each signatory nation must extend its copyright protection to foreign copyright proprietors. Smith, Should the Motion Picture Industry Support or Oppose U.S. Adherence to the Berne Convention?, ENT. & SPORTS LAW., Fall 1987, at 1, 10. More importantly, the Berne Convention prescribes certain minimum rights that each signatory nation must extend to foreign copyright proprietors, regardless of that nation's copyright laws. Id. at 10. For national perspectives on the Berne Convention and the current problems facing the Convention, see Conference Celebrating the Centenary of the Berne Convention, 11 COLUM. J.L. & ARTS 1 (1986).

36. The 1928 Rome Revision to the Berne Convention adopted article 6bis to safeguard the moral right of integrity. Article 6bis was subsequently expanded at the 1971 Paris Revision and protects the right of integrity as follows:

(1) Independently of the author's economic rights, and even after the transfer of the said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation, or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation.

(2) The rights granted to the author in accordance with the preceding paragraph shall, after his death, be maintained, at least until the expiry of the economic rights, and shall be exercisable by the persons or institutions authorized by the legislation of the country where protection is claimed . . . .

Berne Convention, supra note 35, at art. 6bis (as revised in Paris on July 24, 1971).

France adheres to the view that the duration of moral rights is perpetual. Sarraute, supra note 24, at 483. But cf. Treece, supra note 24, at 505-06 (observing that the inalienability of French moral rights is often subject to judicial exception). The Berne Convention, however, advocates a durational limit equivalent to that of copyright, namely, the life of the author plus fifty years. See Kwall, supra note 24, at 15.

37. As of 1986, 76 countries have ratified the Berne Convention, which has undergone
The 1976 Copyright Act contains an extensive reform of our nation's copyright laws, but it does not seek to protect moral rights.\textsuperscript{38} In \textit{Twentieth Century Music Corp. v. Aiken},\textsuperscript{39} the Supreme Court interpreted the constitutional limitation upon the duration of copyrights\textsuperscript{40} to reflect the belief that "[t]he immediate effect of our copyright law is to secure a fair return for an 'author's' creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the public good."\textsuperscript{41} Consequently, "the 1976 Act continues this country's tradition of safeguarding only the \textit{pecuniary} rights of a copyright owner."\textsuperscript{42} The exclusive rights granted in section 106 of the Act unambiguously speak solely to the economic concerns of an owner, and do not afford any protection to the creator.\textsuperscript{43} Thus, the 1976 Act does not provide the governmental protection for artists advocated by proponents of moral rights.\textsuperscript{44}

Although the doctrine of moral right is not expressly recognized by the United States,\textsuperscript{45} a minority of states have enacted legislation specifically designed to protect the moral rights of artists. Under the "preservation approach" adopted by California,\textsuperscript{46} Louisiana,\textsuperscript{47} Maine,\textsuperscript{48} Massachusetts,\textsuperscript{49} and Pennsylvania,\textsuperscript{50} the primary emphasis

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\textsuperscript{38} See supra note 23 and accompanying text; see generally \textit{A Ten-Year Retrospective of the Copyright Act of 1976}, 34 \textit{J. COPYRIGHT SOC'Y U.S.A.} 1 (1986) (critiquing the successes and failures of the Act).

\textsuperscript{39} 422 U.S. 151 (1975).

\textsuperscript{40} The Constitution grants Congress the ability to promulgate laws "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8, cl. 8. \textit{See also supra} note 11 (discussing the public domain).

\textsuperscript{41} 422 U.S. at 156. Professor Goldstein, however, observes that "[t]he purpose of copyright is to attract private investment to the production of original expression." Goldstein, \textit{supra} note 16, at 216.

\textsuperscript{42} Kwall, \textit{supra} note 24, at 2 (emphasis in original).

\textsuperscript{43} \textit{See} 17 U.S.C. § 106 (1982), set forth \textit{infra} note 118.

\textsuperscript{44} \textit{See supra} note 22 and accompanying text.

\textsuperscript{45} \textit{See supra} note 23 and accompanying text.

\textsuperscript{46} \textit{CAL. CIV. CODE} §§ 987-989 (West Supp. 1987).

\textsuperscript{47} \textit{LA. REV. STAT. ANN.} tit. 51:2151-2156 (West 1987).

\textsuperscript{48} \textit{ME. REV. STAT. ANN.} tit. 27, § 303 (Supp. 1987). Prior to Maine's recent enactment of moral right legislation, that state adopted an interim contractual solution under which form contracts embodying a moral right clause would be made available by the Maine State Commission on the Arts and the Humanities upon request to any "interested Maine artist, governmental entity or other interested persons . . . ." 1983 Me. Acts 2643.

\textsuperscript{49} \textit{MASS. GEN. LAWS ANN.} ch. 231, § 85S (West Supp. 1987).

\textsuperscript{50} \textit{PA. STAT. ANN.} tit. 73, §§ 2101-2110 (Purdon Supp. 1987).
is to preserve the integrity of artistic creations. Alternatively, New York has adopted an “attribution approach,” which seeks to prevent alteration of a work that will adversely affect the artist’s reputation. At first glance, these statutes indicate a desire to protect authors’ rights. Upon closer examination, however, both approaches indicate America’s compromising attitude toward such protection.

The underlying function of the right of integrity, as embodied in the French doctrine of moral right, is the protection of the author’s personality and dignity. While reputation is an element of personality, the protection of personality exceeds the limited scope of reputation. Therefore, the New York statute is but a “pale reflection” of its French counterpart. In direct contrast to the shortcomings of the New York statute, the California, Massachusetts, and Pennsylvania statutes go beyond the protection of the author’s personality and preserve artistic creations as a protection of the public interest.

The intrinsic differences between state moral right legislation and the European doctrine of moral right precludes adequate protection for the integrity of original black and white films in the United States. The California and Pennsylvania statutes limit protection to “fine art” and specifically exclude work-for-hire arrangements from protection. Since films are generally “works made for hire,”

53. See id. at 1742 & n.68.
54. Id. at 1754. The right of integrity, as embodied in article 6bis of the Berne Convention, allows the author to object to any modification of his work which is prejudicial to his “honor or reputation.” See supra note 36 (setting forth article 6bis of the Berne Convention).
55. Damich, supra note 52, at 1754.
57. CAL. CIV. CODE § 987(a) (West Supp. 1987).
58. MASS. GEN. LAWS ANN. ch. 231, § 85S(a) (West Supp. 1987).
61. CAL. CIV. CODE § 987(b)(2), (7) (West Supp. 1987); PA. STAT. ANN. tit. 73, §
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California and Pennsylvania preservation approaches do not protect the integrity of black and white films. Moreover, most of the other preservation and attribution approaches specifically exclude sequential imagery such as motion pictures from protection. Therefore, state moral right legislation is unlikely to be an effective vehicle for the protection of original black and white films.

III. THE LAW OF COPYRIGHT AS A PROTECTOR OF THE INTEGRITY OF ORIGINAL BLACK AND WHITE FILMS

When a copyright proprietor assigns or licenses his black and white film, the laws of copyright may prohibit colorization. The central inquiry is whether colorization of a black and white film is analogous to substantial editing which causes alteration and mutilation.

2107(3) (Purdon Supp. 1987). Under the California statute, "fine art" is narrowly defined as "an original painting, sculpture, or drawing, or an original work of art in glass, of recognized quality, but shall not include work prepared under contract for commercial use by its purchaser." Cal. Civ. Code § 987(b)(2) (West Supp. 1987). The commercial use exception embodies "fine art created under a work-for-hire arrangement for use in . . . print and electronic media." Id. § 987(b)(7).

62. The 1976 Copyright Act defines a "work made for hire" as "a work prepared by an employee within the scope of his or her employment" such as "a work specially ordered or commissioned for use . . . as a part of a motion picture . . ." 17 U.S.C. § 101 (1982).

In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of this title, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright.


64. A more detailed analysis of state moral right legislation is outside the scope of this Note. State moral right legislation is used as a point of departure to illustrate the lack of statutory moral right protection available in the United States. For a more comprehensive comparison of the effects and underlying rationales of the California and New York moral right statutes, see Damich, supra note 52; Engdahl, supra note 60; Note, supra note 60. It is important to note, however, that the threshold question of preemption under § 301 of the 1976 Copyright Act may further impede the effectiveness of a state moral right cause of action. Commentators disagree on the preemptive effect of federal copyright law on a state moral right cause of action. Compare Engdahl, supra note 60, at 236-39 (arguing that the two-prong test of section 301 does not preempt an action under the California or New York moral right statutes) with Fracione, The California Art Preservation Act and Federal Preemption by the 1976 Copyright Act — Equivalence and Actual Conflict, 18 Cal. W.L. Rev. 189, 214-17 (1982) (arguing that the actual conflict between the California moral right statute and federal copyright law justifies preemption of a state moral right claim). See infra notes 116-30 and accompanying text (discussing the two-prong preemption test under § 301 of the 1976 Copyright Act).
In Gilliam v. American Broadcasting Cos., the Second Circuit held that substantial unauthorized editing by a licensee of a copyrighted work constitutes copyright infringement. Gilliam involved a sublicensee of the British Broadcasting Corporation (BBC) which deleted twenty-four minutes of a ninety-minute Monty Python special in order to insert commercials and omit what it felt was offensive material. The court's holding in favor of a copyright infringement was largely premised on the fact that the contract between Monty Python's scriptwriters and BBC did not specifically grant BBC the right to edit the programs once they had been recorded. The court concluded that since a grantor may not convey rights greater than it owns, BBC did not have the power to convey editing rights to its licensee or sublicensee.

Based upon Gilliam, at least one commentator has argued that colorization by the licensee of a black and white film currently protected by copyright constitutes a copyright infringement. In support of this argument, the commentator observes that in both the colorization scenario and in Gilliam, the original works were changed to make them more attractive to consumers. Therefore, he concludes that the alteration of a work from black and white to color

65. 538 F.2d 14 (2d Cir. 1976).
66. Id. at 21, 23.
67. Id. at 18. Gilliam involved a British group of comedians known as Monty Python's Flying Circus which wrote and performed scripts for television broadcast by BBC. An agreement between BBC and Monty Python's scriptwriters severely limited BBC's ability to make "script alterations," as the scriptwriters maintained optimum control over the editing process. Id. at 17. The agreement did, however, permit BBC to license the transmission of unaltered recordings of the group's performances overseas. Id. The scriptwriters expressly retained all other rights in the scripts. Id.
68. See id. at 21.
69. Id. Critical to the court's conclusion was its finding that the Monty Python scriptwriters had retained a common law copyright in their original unpublished scripts upon which BBC based its recorded television program. Id. at 19 n.3.
70. See Greenstone, supra note 25, at 19.
71. Id.
impairs the integrity of the work in the same manner as the extensive editing in Gilliam, which the court held to constitute a copyright infringement.72

Such an argument is likely to fail in its attempt to extend Gilliam to the colorization scenario. In Gilliam, the court's copyright infringement holding was premised upon a determination that the substantial editing would misrepresent the quality of Monty Python's work to the viewing public.73 The edited version omitted the climax of various Monty Python skits and “at other times deleted essential elements in the schematic development of a story line.”74 The court characterized the edited version as “represent[ing] to the public as a product of appellants what was actually a mere caricature of their talents.”75 As a result, the court found that such misrepresentations would drive away potential Monty Python followers and thus impair the value of Monty Python works.76 In the colorization scenario, however, the statistics clearly indicate that the colorized films have done remarkably well in the home video market.77 Thus, the pecuniary injury upon which Gilliam focused may well be absent in the colorization of black and white films.

Gilliam is also problematic because it does not specify the quantum of editing by the licensee that is necessary to constitute a copyright infringement. The court relied upon the fact that the editing in question was “substantial.”78 Specifically, the licensee in Gilliam deleted twenty-seven percent of the original program and contravened contractual provisions that grant control over the editing process to

72. Id. “The addition of color is reediting, thereby altering and mutilating the motion picture.” Id. (footnote omitted).
73. Gilliam, 538 F.2d at 19.
74. Id. at 25.
75. Id.
76. Id. at 19.
77. For instance, sales of the colorized version of It's a Wonderful Life (Liberty-RKO 1946) exceed sales of its black and white counterpart more than sixfold. Cook, Actors and Directors: Color Them Mad as Hell, Nat'l L.J., July 27, 1987, at 11, col. 3; see infra note 191 (providing additional statistics on the popularity of colorized films).

In a recent audience survey conducted by Hal Roach Studios on the popularity of colorized films, 85% of those polled indicated that they would only watch a film if it was in color. See Bennetts, supra note 3, at C14, col. 3. In a survey of 1200 movie critics, however, the Pantone Color Institute concluded that 80% of the critics were opposed to colorization. See Darnton, Debate Goes on After Colorization, N.Y. Times, Apr. 17, 1987, at C8, col. 3. It therefore appears that movie critics oppose the alteration of black and white films while audiences desire the aesthetics of colorization. Thus, at the very least, there is no conclusive evidence that colorization will undermine the popularity of the original black and white film.
78. Gilliam, 538 F.2d at 19.
The court emphasized that its copyright infringement discussion "refer[red] only to such facts as have been developed upon the hearing for a preliminary injunction." In the colorization context, however, no essential elements in the schematic development of the plot are deleted from the black and white film. Aside from the addition of color, the colorized version is identical to the black and white version. Thus, the colorized version is not a "mere caricature of [the actor's or director's] talents," as the court found in Gilliam.

Historically, the palette available for motion pictures was limited to black and white. When a film is intentionally made within the limitations of a black and white medium, the director must use special lighting exhibiting higher contrast between light and shadow. The fact that a director purposely creates a film in black and white when color is a viable alternative does not, however, create a stronger case for protection under Gilliam. Although colorization "technically" alters the underlying film by adversely affecting the lighting contrast and portrayal of imagery, such effects are not likely to constitute "substantial" editing as contemplated by Gilliam. It is doubtful that a change in lighting contrast and the portrayal of certain imagery will delete a portion of the film necessary for an understanding of the plot. Actress Ginger Rogers argues that the colorization of 42nd Street cheapened a once thrilling musical, and equates it with Saturday morning cartoons. This does not, however, necessarily display a "mere caricature" of Rogers' talents in the same manner as the omission of almost thirty percent of the underlying black and white film. There is no deletion of material from Rogers' role that may adversely display her talents, since the addition of

79. See id.
80. Id.
81. Id. at 25.
82. Id.
83. See Senate Hearings on Colorization, supra note 6, at 4 (testimony of Elliot Silverstein, film director).
85. Fairly recent examples of popular films purposely created in black and white include Woody Allen's Manhattan (United Artists 1979) and David Lynch's The Elephant Man (Paramount 1980) and Eraserhead (1977). See supra note 22 (discussing the use of black and white and color in the same motion picture).
86. See supra notes 65-82 and accompanying text.
87. Senate Hearings on Colorization, supra note 6, at 39 (testimony of Ginger Rogers, actress).
color is "merely incidental to the plot." Thus, absent "substantial" editing, the "technical" alteration of colorization is not likely to impair the earning ability of the underlying actors and directors so as to justify a finding of copyright infringement.

Therefore, when a copyright proprietor assigns or licenses his or her black and white film, subsequent colorization by the assignee or licensee is not likely to fall within the parameters of Gilliam or the law of copyright. Such a conclusion, however, does not imply that Gilliam provides no protection for the moral rights of artists. In the absence of a contractual provision to the contrary, it is likely that Gilliam prohibits a licensee from substantially editing a copyrighted work.

IV. THE LAW OF PUBLICITY AS A PROTECTOR OF THE INTEGRITY OF ORIGINAL BLACK AND WHITE FILMS

When advertising a colorized film to the public, it is likely that a colorist will use the name and likeness of the underlying actors and directors, since this mode of advertising is more likely to entice the public into purchasing the colorized home video. One commentator argues that the original producer acquires the right to use the name and likeness of the original actors and directors through contract, but the colorist of a public domain motion picture does not have the benefit of such a contract. Therefore, the commentator concludes that the right of publicity is an effective impediment to the sale and distribution of colorized films when the colorist uses the names and/or likenesses of the underlying actors and directors, at least in the absence of a contractual provision granting such use.

The right of publicity currently exists as an extension of the commercial appropriation branch of the common law cause of action
for invasion of privacy.\textsuperscript{94} Courts frequently equate the right of publicity with the right of an individual to control the commercial value of his or her name or likeness, thereby preventing the unauthorized appropriation of this value by others for their commercial gain.\textsuperscript{95} The right, therefore, is most often asserted by actors or celebrities who have exploited their persona\textsuperscript{96} for personal gain.\textsuperscript{97} In such cases, the celebrity seeks to recover compensation for the unauthorized commercial use of his persona rather than to prevent injury to feelings by enjoining the commercial use.\textsuperscript{98} Thus, the publicity action is based upon the defendant's unauthorized exploitation of the celebrity's commercially valuable persona.\textsuperscript{99} As the Supreme Court has

\textsuperscript{94} Simon, \textit{Right of Publicity Reified: Fame as Business Asset}, 30 N.Y.L. SCH. L. REV. 699, 701 (1985). In fact, one commentator has dubbed the right of publicity "privacy's stepchild." \textit{See Comment, Transfer of the Right of Publicity: Dracula's Progeny and Privacy's Stepchild}, 22 UCLA L. REV. 1103 (1975) (authored by David R. Ginsburg). In one of the seminal works on the right of privacy, Dean Prosser delineated four distinct torts comprising the law of privacy: (1) the appropriation of an individual's name or likeness for another person's benefit; (2) the intrusion upon an individual's seclusion or solitude; (3) the public disclosure of embarrassing private facts; and (4) publicity which places an individual in a false light in the public eye. Prosser, \textit{Privacy}, 48 CALIF. L. REV. 383, 389 (1960). Prosser distinguishes the commercial appropriation branch of privacy by observing that "[t]he interest protected is not so much a mental as a proprietary one, in the exclusive use of the plaintiff's name and likeness as an aspect of his identity." \textit{Id.} at 406.


\textsuperscript{96} The term "persona" is used throughout this Note to stand for those general attributes protected by the right of publicity, including an individual's name, likeness, and other identifying characteristics.


\textsuperscript{98} Note, \textit{Rights of Privacy and Publicity in Advertising}, 1985 ANN. SURV. AM. L. 585, 588 (authored by Sarah Corley). In a publicity action "[t]he gravamen of the harm is that the defendant has not compensated the plaintiff for using the plaintiff's name and likeness." Kwall, \textit{supra} note 97, at 197. An action based upon invasion of privacy, on the other hand, traditionally prevents injury to feelings resulting from the unauthorized exploitation of the individual's name or likeness for commercial gain. \textit{Id.} at 195, 197. For a discussion of the inadequacies of the privacy doctrine in protecting the right of publicity, see Nimmer, \textit{supra} note 97, at 204-10.

\textsuperscript{99} \textit{See} Lerman v. Flynt Distrib. Co., 745 F.2d 123, 134 (2d Cir. 1984), \textit{cert. denied},
noted, the impetus for protecting the right of publicity is the goal of “preventing unjust enrichment by the theft of good will. No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay.”

Nevertheless, variations in state publicity law and the preemptive effect of federal copyright law preclude the right of publicity from being a viable impediment to the sale and distribution of colorized black and white motion pictures.

A. Variations in State Publicity Law

Thus far, a minority of jurisdictions have codified the right of publicity. Other jurisdictions recognize this doctrine as part of their common law. Moreover, both judicial and legislative treatment of the right of publicity have been extremely inconsistent. Forum choice issues result in part from the lack of statutory standing requirements and from far-reaching long-arm statutes; typically, state publicity statutes contain no requirement that the commercially exploited plaintiff be a resident of the forum state, that the use take place within the state, or even that the defendant be located within the state. The problem is exacerbated by seemingly limitless long-arm statutes that bring defendants into state courts simply because


101. See infra notes 103-15 and accompanying text.

102. See infra notes 116-43 and accompanying text.


106. Id. at 1180-81. The California, Florida, Kentucky, Oklahoma, Utah and Virginia statutes indicate a lack of any standing requirements. Id.
they sold a few products or advertised in the forum state. Therefore, it is likely that a plaintiff will be able to shop for the most favorable state publicity law scheme, thereby precluding a potential defendant from predicting whether liability will attach to his conduct.

The issue of descendibility provides a fertile ground for the illustration of the material variations in state publicity law. During the past fifteen years, a host of actors and entertainers have been the subject of lawsuits revolving around whether the right of publicity survives their deaths and may be exercised by their heirs and grantees. Currently, there is a split of authority, in some cases even within a single jurisdiction, over whether an individual's right of publicity should be survivable and thus descend to one's heirs. In sharp contrast, however, the overwhelming majority of academic commentaries that have wrestled with the issue of descendibility favor a freely descendible right of publicity.

108. Id. at 1180-81.
The issue of descendibility can be taken a step further to illustrate the forum choice issues inherent in state publicity law. Even among those courts and commentators that favor a descendible right of publicity, there is enormous disagreement concerning the duration of this protection. In the absence of some type of durational limit, distant heirs of famous ancestors could initiate a considerable amount of frivolous litigation.111 Despite the potential for abuse, however, most state legislatures have been reluctant to enact legislation aimed at resolving the descendibility issue.112 Among those states that have enacted legislation, there is no semblance of consistency. California and Kentucky provide the strongest safeguards for a celebrity's heirs, providing a fifty-year limit on the descendibility of the right of publicity.113 Tennessee, on the other hand, provides only a ten-year survivability provision.114

111. See Note, Lugosi v. Universal Pictures: Descent of the Right of Publicity, 29 Hastings L.J. 751, 772-73 (1978) (authored by Jon B. Eisenberg). For example, the great-grandchildren of composer Robert Schumann brought suit nearly one hundred years after his death. Id. at 772 (citing Schumann v. Loews Inc., 135 N.Y.S.2d 361 (Sup. Ct. 1954)).


Since the underlying policy of both the right of publicity and copyright law is "to provide an incentive for enterprise and creativity by allowing individuals to benefit from their personal efforts," Felcher & Rubin, The Descendibility of the Right of Publicity: Is There Commercial Life After Death?, 89 Yale L.J. 1125, 1129 (1980), many commentators support the fifty-year survivability provision because it is analogous to the duration of copyright protection. See, e.g., id.; Marks, An Assessment of the Copyright Model in Right of Publicity Cases, 32 Copyright L. Symp. (ASCAP) 1, 35 (1986); Note, supra note 111, at 773; Note, The Right of Publicity: "You Can't Take it With You", supra note 110, at 1022-23; Note, supra note 105, at 1204; Comment, supra note 94, at 1126-28. But see Halpern, The Right of Publicity: Commercial Exploitation of the Associative Value of Personality, 39 Vand. L. Rev. 1199, 1206 (1986) (favoring a freely descendible right of publicity); Hoffman, supra note 110, at 43 (favoring a descendible right of publicity uninhibited by any durational limit). Other commentators, however, believe that the courts should refrain from adhering to the "unreasonable" durational limit specified by copyright law. See, e.g., Ausness, The Right of Publicity: "Haystack in a Hurricane", 55 Temp. L.Q. 977, 1011-12 (1982); Kwall, supra note 97, at 252;
The preceding discussion illustrates some of the uncertainties and material variations in state publicity law. The material variations and uncertainties in state law, compounded by issues of forum choice,\textsuperscript{115} would seem to preclude it from being an effective impediment in every jurisdiction to the sale and distribution of colorized motion pictures. Therefore, the right of publicity is at best an inconsistent remedy for actors and directors of a colorized black and white film when the colorist advertises his film in such a manner as to use the persona of the underlying actors and directors.

B. \textit{The Preemptive Effect of Federal Copyright Law on State Publicity Actions}

Although variations in state publicity law preclude it from being an absolute source of relief for actors and directors, it is nonetheless theoretically possible that an actor or director could find a variation of publicity law conducive to his or her needs. Given this potential for a bona fide publicity claim, it is necessary to examine the preemptive effect of federal copyright law on state publicity actions.

1. Statutory Preemption Under Section 301 of the Copyright Act.—Section 301 of the Copyright Act of 1976 governs the compatibility of federal copyright law and state publicity law.\textsuperscript{116} This

\textsuperscript{115}See supra notes 105-08 and accompanying text. Consequently, “the law of publicity continues to resemble a ‘haystack in a hurricane.’” Ausness, supra note 114, at 1024 (quoting \textit{Comment, Copyright Preemption and Character Values: The Paladin Case as an Extension of Sears and Compco}, 66 \textit{Mich. L. Rev.} 1018, 1020 (1968)).

\textsuperscript{116}Section 301 of the Copyright Act provides:

(a) On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.

(b) Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to —

(1) subject matter that does not come within the subject matter of copyright as specified by sections 102 and 103, including works of authorship not fixed in any tangible medium of expression; or
provision sets forth a two-prong test for determining whether pre-
emption will be a viable defense. First, the state right must be
claimed in "works of authorship that are fixed in a tangible medium
of expression and come within the subject matter of copyright as
specified by sections 102 and 103 . . . ."117 Second, the state right
must be "equivalent to any of the exclusive rights within the general
scope of copyright as specified by section 106 . . . ."118

(2) any cause of action arising from undertakings commenced
before January 1, 1978; or
(3) activities violating legal or equitable rights that are not
equivalent to any of the exclusive rights within the general scope
of copyright as specified by section 106.

(d) Nothing in this title annuls or limits any rights or remedies under any other
Federal statute.

117. 17 U.S.C. § 301(a) (1982); see also 17 U.S.C. § 301(b)(1) (1982) (preserving the
ability of the states to regulate non-copyrightable subject matter). Section 102 of the Copy-
right Act of 1976, governing the subject matter of copyright, provides:

(a) Copyright protection subsists, in accordance with this title, in original
works of authorship fixed in any tangible medium of expression, now known or later
developed, from which they can be perceived, reproduced, or otherwise communi-
cated, either directly or with the aid of a machine or device. Works of authorship
include the following categories:

(1) literary works;
(2) musical works, including any accompanying words;
(3) dramatic works, including any accompanying music;
(4) pantomimes and choreographic works;
(5) pictorial, graphic, and sculptural works;
(6) motion pictures and other audiovisual works; and
(7) sound recordings.

(b) In no case does copyright protection for an original work of authorship
extend to any idea, procedure, process, system, method of operation, concept, princi-
ple, or discovery, regardless of the form in which it is described, explained, illustrat-
ed, or embodied in such work.

Section 103(a) provides that "[t]he subject matter of copyright as specified by section 102
includes compilations and derivative works, but protection for a work employing preexisting
material in which copyright subsists does not extend to any part of the work in which such
material has been used unlawfully." Id. § 103(a).

118. 17 U.S.C. § 301(a) (1982); see also 17 U.S.C. § 301(b)(3) (1982) (preserving the
ability of the states to create rights not equivalent to the exclusive rights of copyright). Section
106 of the Copyright Act of 1976, governing the exclusive rights in copyrighted works, provides:

Subject to sections 107 through 118, the owner of copyright under this title has the
exclusive rights to do and to authorize any of the following:

(1) to reproduce the copyrighted work in copies or phonorecords;
(2) to prepare derivative works based upon the copyrighted work;
(3) to distribute copies or phonorecords of the copyrighted work to the public
by sale or other transfer of ownership, or by rental, lease, or lending;
Both elements of section 301 must be satisfied in order to pre-empt state law. The first prong of the preemption test essentially focuses on the nature of the work protected by the state law. General, if the state right protects copyrightable subject matter, pre-emption will result under the first prong of section 301 unless the work of authorship is not fixed in a tangible medium of expression. Pursuant to the Copyright Act of 1976, a work is “fixed” in a tangible medium of expression” when it is “sufficiently permanent or stable to permit it to be ... communicated for a period of more than transitory duration.” Thus, the first prong of section 301 allows the states to regulate non-copyrightable subject matter. Alternatively, the second prong of the preemption test focuses on the nature of the rights protected by the state law. Preemption will result if the state law protects rights equivalent to those rights granted under copyright law. In general, this will occur if the state right is infringed by the mere act of reproduction.

Despite the professed Congressional objective of using “the clearest and most unequivocal language possible, so as to foreclose any conceivable misinterpretation ... and to avoid the development of any vague borderline areas between State and Federal protection,” application of the two-prong preemption test under section

(4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly; and

(5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly.


119. 1 M. Nimmer & D. Nimmer, supra note 23, § 1.01[B], at 1-9.

120. See supra note 117 (discussing the subject matter capable of being copyrighted).


122. Id. § 101.

123. See id. § 301(a), (b)(3); see also supra note 118 (discussing the the copyright holder's exclusive rights in his or her copyrighted work).

124. Shipley, Publicity Never Dies; It Just Fades Away: The Right of Publicity and Federal Preemption, 66 CORNELL L. REV. 673, 704 (1981). As Professor Nimmer observed: [i]f under state law the act of reproduction ... will in itself infringe the state created right, then such right is preempted. But if other elements are required, in addition to or instead of, the acts of reproduction ... in order to constitute a state created cause of action, then the right does not lie “within the general scope of copyright,” and there is no preemption.

1 M. Nimmer & D. Nimmer, supra note 23, § 1.01[B][1], at 1-12 (emphasis in original) (footnotes omitted).

301 is not a simple task. Moreover, courts have not provided any concrete resolution to the preemptive effect of federal copyright law on state publicity actions. Academic commentaries have likewise disagreed as to the compatibility of the right of publicity and copyright law. Although statutory preemption is exceedingly unclear under section 301, the supremacy clause dictates that copyright will prevail whenever there is an actual conflict between state law.
and the protections conferred by federal copyright law.\textsuperscript{130}

2. The Clash Between Federal Copyright Law and State Publicity Law in the Colorization Controversy.— Although many of the black and white motion picture classics currently being colorized had previously fallen into the public domain,\textsuperscript{131} colorization has also been performed by the copyright proprietor of the black and white film. For example, colorists such as Hal Roach Studios and Turner Entertainment Company own copyrights in many of the black and white classics produced during the heyday of the studio system.\textsuperscript{132}

Pursuant to section 106(2) of the Copyright Act of 1976, a copyright proprietor has the exclusive right “to prepare derivative works based upon the copyrighted work.”\textsuperscript{133} Since the Copyright Office unambiguously ruled that certain colorized versions of black and white motion pictures are registrable as derivative works,\textsuperscript{134} preventing a copyright holder from colorizing his black and white film violates the copyright proprietor’s exclusive rights in his copyrighted work. The right of publicity necessarily clashes with the copyright proprietor’s ability to exploit the exclusive rights in his copyrighted work. Thus, if the actors or directors of an underlying black and white film bring suit for unauthorized commercial exploitation of their persona resulting from the copyright proprietor’s subsequent colorization and advertisement of the film, the claim is likely to be preempted by section 301 of the Copyright Act. Therefore, when the colorist is a subsequent copyright proprietor, enhancement of black and white classics is not likely to be the basis of a publicity action by the underlying actors and directors.

Similarly, when colorists colorize a public domain motion picture and subsequently advertise their film, they are not liable to the underlying actors or directors for the unauthorized commercial exploitation of their persona. The Supreme Court in \textit{Twentieth Century Music Corp. v. Aiken}\textsuperscript{135} observed that the primary objective in

\textsuperscript{130} See Ausness, \textit{supra} note 114, at 1023; Francione, \textit{supra} note 64, at 215-16; Kwall, \textit{supra} note 24, at 86 & n.367; Shipley, \textit{supra} note 124, at 724-25; Note, \textit{supra} note 105, at 1187-89.

\textsuperscript{131} For example, Frank Capra’s classic \textit{It’s a Wonderful Life} (Liberty-RKO 1946) is in the public domain because the copyright proprietor failed to renew his or her copyright for a second 28-year period pursuant to the Copyright Act of 1909 when the first 28-year period expired. Molotsky, \textit{supra} note 25, at A9, col. 5.

\textsuperscript{132} See \textit{supra} note 3 (discussing the colorization activities of Hal Roach Studios and Turner Entertainment Company).

\textsuperscript{133} 17 U.S.C. § 106(2) (1982), set forth \textit{supra} note 118.

\textsuperscript{134} Copyright Office Ruling, \textit{supra} note 4, at 23,445-46.

\textsuperscript{135} 422 U.S. 151 (1975).
conferring a limited statutory monopoly to the author stems from the "'general benefits derived by the public from the labors of authors.'" Once the author's limited copyright has expired, the public gains access to the product of the author's genius. Thus, when the copyright on a film expires and falls into the public domain, the public has free access to the film and may use scenes from the film to advertise its products or for any other purpose. Therefore, the right of publicity necessarily clashes with the purpose of federal copyright law, and a publicity action against a public domain colorist is likely to be preempted by section 301 of the Copyright Act.

Although some commentators believe that colorists open themselves up to liability when they advertise their colorized film, liability may not attach. The right of publicity necessarily clashes with the copyright holder's exclusive right to prepare derivative works based upon his copyrighted work, thereby preempting a publicity action against a copyright holder for the colorization of his copyrighted film. Similarly, the overall purpose of federal copyright law clashes with the right of publicity, thereby preempting a publicity action against the colorizing producer of a public domain film. Consequently, the right of publicity will not be a foundation for liability when a colorist sells and distributes its colorized work.

136. *Id.* at 156 (quoting Fox Film Corp. v. Doyal, 286 U.S. 123, 127 (1932)); *see also* 1 M. Nimmer & D. Nimmer, supra note 23, § 1.03[A], at 1-32 (observing that the justification for granting authors a limited monopoly of copyright is based upon "the dual premises that the public benefits from the creative activities of authors, and that the copyright monopoly is a necessary condition to the full realization of such creative activities." (footnote omitted)).


138. *See* cases cited supra note 137.

139. *But see* Moskin, supra note 128, at 190-97 (arguing that state publicity law does not sufficiently conflict with federal copyright law so as to justify preemption).

140. *See supra* notes 91-93 and accompanying text.

141. *See supra* notes 131-34 and accompanying text.

142. *See supra* notes 135-39 and accompanying text.

143. In fact, many commentators favor a federal publicity statute as a means of eliminating non-uniformity in state publicity law. *See, e.g.*, Ausness, supra note 114, at 1025; Simon, supra note 94, at 723; *Note*, supra note 105, at 1191-207.
V. THE LAW OF UNFAIR COMPETITION AS A PROTECTOR OF THE INTEGRITY OF ORIGINAL BLACK AND WHITE FILMS

A. Section 43(a) of the Lanham Act as a Federal Equivalent to the Common Law Cause of Action for Unfair Competition

The equitable doctrine of unfair competition was originally developed as a judicial mechanism to protect the goodwill of an enterprise and to prevent competitors from appropriating the goods of another.144 Although it would be troublesome to generalize about the reach of this common law tort,145 the focus of unfair competition is the principle of "passing off" or "palming off" — selling one's goods or services under the name of a more popular competitor.146 Inherent in the "passing off" theory are two basic elements: deception of the public147 and a competitive relationship between two parties.148

Section 43(a) of the Lanham Trademark Act (Lanham Act)149 serves as a federal equivalent to the common law cause of action for

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145. Judge Learned Hand observed more than 60 years ago that "there is no part of the law which is more plastic than unfair competition, and what was not reckoned an actionable wrong 25 years ago may have become such today." Ely-Norris Safe Co. v. Mosler Safe Co., 7 F.2d 603, 604 (2d Cir. 1925), rev'd, 273 U.S. 132 (1927).
146. See 1 R. Callmann, supra note 144, § 2.02, at 5-6. The passing off theory is "the typical and most common case of unfair competition." Id. at 6 (quoting Neva-Wet Corp. v. Never Wet Processing Corp., 277 N.Y. 163, 168, 13 N.E.2d 755, 758 (1938). In the landmark case of International News Serv. v. Associated Press, 248 U.S. 215 (1918), however, the Supreme Court explicitly stated that equitable relief under the doctrine of unfair competition was not restricted to the narrow concept of passing off. Id. at 241-42. The traditional passing off theory requires that the defendant sell its own goods as those of the plaintiff. See 1 R. Callmann, supra note 144, § 2.02, at 6. The Court, however, expanded this common law doctrine to include the concept of "misappropriation." Under this theory of unfair competition, the defendant misappropriates rather than misrepresents the plaintiff's goods, and then sells them as his own. 248 U.S. at 242. Generally, "passing off" involves injury to the public, while misappropriation seeks to remedy the pecuniary loss suffered by the plaintiff. Ausness, supra note 114, at 983.
147. 1 R. Callmann, supra note 144, § 2.02, at 6. A private cause of action will only arise, however, if the deception induces the public to buy the goods as those of the plaintiff. American Washboard Co. v. Saginaw Mfg. Co., 103 F. 281, 285 (6th Cir. 1900). The rationale for maintaining such an action is based solely upon the protection of the plaintiff's property rights. Id.
148. Borden Ice Cream Co. v. Borden's Condensed Milk Co., 201 F. 510, 514 (7th Cir. 1912). "The phrase 'unfair competition' presupposes competition of some sort. In the absence of competition the doctrine cannot be invoked." Id. For a comprehensive discussion of the competitive relationship and a weakening of the competition element, see 1 R. Callmann, supra note 144, § 2.10-.17, at 47-68.
unfair competition, and is designed to protect any person from false or misleading representations of goods or services which affects interstate commerce. Specifically, section 43(a) prohibits representations concerning false descriptions or false representations of origin. In applying section 43(a), the determinative issue is "whether there is any likelihood that an appreciable number of ordinarily prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question." As in the case of trademarks, however, this element does not require that the consumer believe that the owner of the mark actually manufactured the product. Rather, "[t]he public's belief that the mark's owner sponsored or otherwise approved the use of the trademark satisfies the confusion requirement."

Since its enactment in 1946, the reach of section 43(a) has been partially circumscribed simply as a result of its appearance as part of a trademark statute. Courts currently recognize, however, that


Any person who shall . . . use in connection with any goods or services . . . a false designation of origin, or any false description or representation . . . and shall cause such goods or services to enter into commerce . . . shall be liable to a civil action . . . by any person who believes that he is or is likely to be damaged by the use of any such false description or representation.

152. 15 U.S.C. § 1125(a) (1982). Section 43(a) "is broadly worded and proscribes not only 'a false designation of origin' but also the use of 'any false description or representation, including words or other symbols tending falsely to describe or represent . . . goods or services' in commerce." Boston Professional Hockey Ass'n v. Dallas Cap & Emblem Mfg., 510 F.2d 1004, 1010 (5th Cir.) (quoting 15 U.S.C. § 1125(a) (1970)), cert. denied, 423 U.S. 868 (1975).
154. See Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, 604 F.2d 200, 204-05 (2d Cir. 1979) (citations omitted).
155. Id. at 205. The likelihood of confusion requirement embodies various types of confusion, including "confusion of source; confusion of affiliation; confusion of connection; or confusion of sponsorship." 2 J. McCarthy, TRADEMARKS AND UNFAIR COMPETITION § 24:3(B), at 166 (2d ed. 1984); see also 3A R. Callmann, supra note 144, § 20.01-.07, at 3-31 (rev. 4th ed. 1983) (discussing the various types of consumer confusion).
the Lanham Act may be invoked as federal protection against acts of unfair competition, even where no registered trademark is involved. Thus, a violation of section 43(a) exists if the representation creates a mere likelihood of public deception or confusion, even though the representation may in fact be technically true.

B. Section 43(a) of the Lanham Act in the Colorization Controversy

Recently, an opponent of colorization stated that "[t]he director whose rights are violated has a powerful tool in the Lanham Act. Use of the Lanham Act is a back door assertion of moral rights." Although preemption under the 1976 Copyright Act is not a concern, the statement is somewhat tenuous in light of some recent applications of section 43(a).

In the landmark case of Gilliam v. American Broadcasting Cos., the Second Circuit explicitly considered the Lanham Act in the context of the moral right of integrity. The court stated, in an alternative holding, that the editing by ABC constituted an actionable distortion under section 43(a) of the Lanham Act. Alluding to the European doctrine of moral right, the court observed that a viable cause of action exists under the Lanham Act when the defendant presents to the public a distorted version of the plaintiff's work. Upon viewing the edited version, the court found "that the..."
truncated version at times omitted the climax of the skits to which [Monty Python's] rare brand of humor was leading and at other times deleted essential elements in the schematic development of a story line.” As a result, the edited version broadcast by ABC represented to the public as a product of Monty Python “what was actually a mere caricature of their talents.” Based on such distortion, the court concluded that ABC’s broadcast of the edited Monty Python program as a creation of Monty Python should be enjoined, at least preliminarily, under section 43(a) of the Lanham Act.

Judge Gurfein’s concurrence took issue with the majority’s finding that the licensee’s editing was also actionable under section 43(a). He found that there was no need to apply the Lanham Act as a protector of moral rights since Monty Python’s works were sufficiently protected by contract and copyright law. Nevertheless, Judge Gurfein went on to suggest that a disclaimer to the effect that Monty Python did not approve of the editing would have satisfied the Lanham Act’s policy against misrepresentation of the description or origin of a product. A number of courts and commentators support Judge Gurfein’s position that the Lanham Act is not a viable source of relief when a disclaimer alleviates the consumer confusion resulting from the misrepresentation. Thus, the court’s broad interpretation of section 43(a) may not be as powerful a vindicator of the moral right of integrity as it first appears.

In the subsequent case of Follett v. New American Library,
the court relied on section 43(a) to protect an author from misrepresentation by a publisher.\textsuperscript{174} At the outset, the court observed that Follett's reputation as a writer known for his intricate plots and complex characters was inconsistent with the "comparatively flat, historical narrative tone" of the edited work in question.\textsuperscript{175} Relying upon Gilliam, the court noted that the Lanham Act is designed to "vindicate 'the author's personal right to prevent the presentation of his work to the public in a distorted form,'"\textsuperscript{176} as well as to "protect the public and the artist from misrepresentations of the artist's contribution to a finished work."\textsuperscript{177} After a close examination of the facts, the court held that the attribution of principal authorship to Follett was likely to mislead the public.\textsuperscript{178} Interestingly, the court did not advance any economic argument to justify its holding, in contrast to the court in Gilliam which concluded that the injury to Monty Python's reputation would significantly impair the value of Monty Python's future works.\textsuperscript{179} Rather, the court premised its holding on the fact that it simply would be misleading to depict Follett as the principal author, and that such a representation was "literally false."\textsuperscript{180}

Gilliam and Follett illustrate the difficulties in using the Lanham Act as a "back door assertion of moral rights" in the colorization scenario. To obtain relief under section 43(a), the original filmmaker must prove that the colorized version is likely to cause consumer confusion by falsely attributing the color version to the efforts of the original filmmaker.\textsuperscript{181} Moreover, such injunctive relief is warranted only if it prevents further irreparable injury to the origi-

\textit{Cinq Milliards au Bout de l'Engout}. Id. at 306. No American publishing house was interested in publishing Follett's refashioned French work, including defendant New American. Id. at 307. After Follett's subsequent books achieved best seller status, Arbor House acquired the United States publishing rights to Follett's earlier refashioned French work. Id. at 307-08. Arbor House, however, was determined to change the attribution of authorship and make Follett the principal author. Id. at 308. Only Follett's name would appear on the spine of the jacket, and not that of the original French authors. Id. The court found for Follett and enjoined Arbor House from using its proposed form of author attribution. Id. at 313.

\textsuperscript{174} Id. at 311-13.

\textsuperscript{175} Id. at 309.

\textsuperscript{176} Id. at 313 (quoting Gilliam, 538 F.2d at 24).

\textsuperscript{177} Follett, 497 F. Supp. at 313.

\textsuperscript{178} Id. at 312-13.

\textsuperscript{179} Krigsman, supra note 156, at 269. As a result, Follett is more closely aligned with the personal, non-commercial interests of the doctrine of moral right than Gilliam. See Krigsman, supra note 156, at 269-70.

\textsuperscript{180} Follett, 497 F. Supp. at 312.

\textsuperscript{181} See supra notes 144-59 (discussing the elements of a § 43(a) action).
nal filmmaker’s reputation.\(^\text{182}\)

The first hurdle that an original filmmaker must overcome is to prove that the colorized version is being attributed to his efforts, thereby causing consumer confusion. The easiest way to meet this burden is to show that the colorist uses an advertisement that somehow labels the colorized version a product of the original filmmaker.\(^\text{183}\) As direct competitors in the colorization market, colorists such as Hal Roach Studios and Turner Entertainment Company are unlikely to advertise their colorized films as the product of the original filmmaker.\(^\text{184}\) Rather, each company perceives a financial incentive in advertising its product under its name so that the public will become aware of the company’s quality and remain loyal to that company’s production of colorized films.\(^\text{185}\) In fact, colorists have not tried to mask the monetary purpose in the colorization market.\(^\text{186}\) Therefore, there is no danger of false representation resulting in consumer confusion as in Gilliam and Follett.

The second hurdle that an original filmmaker must overcome is to prove that the alleged false representation of the colorized film is likely to injure his reputation.\(^\text{187}\) In our society where labels and status often dictate consumer acceptance, the artist’s reputation may determine the price his or her work will command.\(^\text{188}\) Therefore, if

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183. \textit{See Note, supra note 25, at 539.} One of the few commentators to consider the relationship between colorization and the Lanham Act observed that if the colorized version of \textit{It’s a Wonderful Life} (Liberty-RKO 1946) is advertised as “The New Color Film by Frank Capra,” Mr. Capra may obtain relief under § 43(a) if he is injured by the false representation of origin. \textit{Id.} Thus, the original filmmaker can prohibit the colorist from attributing its colorized version to his or her efforts. \textit{Id.}

184. \textit{Id.} at 539 n.321; \textit{see supra note 3} (discussing the colorization activities of Hal Roach Studios and Turner Entertainment Company).

185. \textit{See Note, supra note 25, at 539 n.321; cf. infra note 217} and accompanying text (arguing that the implied covenant of good faith between two contracting parties may require a colorist to advertise its product as a colorized version of a black and white original). One industry executive argues that a company that owns colorization rights “has an obligation to its investors to maximize the potential of the library . . . .” \textit{Senate Hearings on Colorization, supra note 6}, at 60 (testimony of Buddy Young, president, Color Systems Technology, Inc.).

186. According to the president of Colorization, Inc., “The reason we’re doing [colorization] is monetary. People don’t like black and white. They do like color, and when we color it, they buy it.” Bennetts, \textit{supra} note 3, at A11, col. 5.

187. \textit{See supra note 182.}

188. \textit{Krigsman, supra note 156, at 272.} An artist, like a businessman, wishes to be well-paid for his products sold in the marketplace. \textit{Id.} The value of the artist’s work, however, is dependent upon his reputation, which fluctuates in accordance with the artist’s popularity and the quality of his work. \textit{Id.} Therefore, it is possible that the commercial value of an artist’s
the artist can show that his reputation is likely to be endangered, economic damages can virtually be presumed.\textsuperscript{189} It is arguable, however, that the original filmmaker's reputation is not likely to be damaged by virtue of colorization. First, the statistics overwhelmingly indicate that the public loves colorization.\textsuperscript{190} Thus, colorized films achieve a certain degree of popularity with the viewing public, and presumably, the original filmmaker's reputation should grow accordingly; at the very least, his or her reputation is not likely to be damaged. Second, colorization may revive public interest in some films, particularly those that enjoyed limited success in black and white.\textsuperscript{191} Third, if in fact colorization is injurious to the original filmmaker's reputation, one would assume that filmmakers would hesitate to contract for the colorization of their films. In at least one instance, however, just the opposite has occurred.\textsuperscript{192} Therefore, it appears that colorization does not necessarily impair the original filmmaker's reputation. In fact, even opponents of colorization would be hard-pressed to argue that colorization in and of itself is injurious to the original filmmaker's reputation.

When the colorization is performed by a subsequent copyright proprietor of the black and white film, the original filmmaker must overcome additional hurdles before obtaining relief under section work is directly proportional to his reputation. \textit{Id.}

189. \textit{Id.}

190. \textit{See supra} note 77.

191. When \textit{It's a Wonderful Life} (Liberty-RKO 1946) was first released, it was a financial failure that was trashed by the critics. \textit{Senate Hearings on Colorization, supra} note 6, at 83 (statement of Rob Word, senior vice president for Creative Affairs, Hal Roach Studios, Inc.). Colorization, however, enables subsequent audiences to enjoy films they may not otherwise have such an opportunity to view. According to one industry executive, consumers have bought over 70,000 home video tapes of the color version of \textit{It's a Wonderful Life} compared to only 11,000 in black and white. Cook, \textit{supra} note 77, at 11, col. 3. Similarly, \textit{Captain Blood} (Cosmopolitan-Warner Brothers 1935) and \textit{Sea Hawk} (Warner Brothers 1940), two Errol Flynn classics, grossed only $200,000 each as black and white films, but grossed over $800,000 each in less than one year as color films. Cook, \textit{supra} note 77, at 11; Telephone interview with Alison L. Hill, director of public relations, Turner Broadcasting Systems, Inc. (June 16, 1988). Ironically, during the conception of the colorization process, skeptics questioned whether the mere addition of color would be sufficient to revive interest in outdated motion pictures. Cleply, \textit{Movie Classics Transformed to Color Films}, Wall St. J., Sept. 11, 1984, at 37, col. 3.

192. Otto Preminger Films has contracted with Hal Roach Studios to colorize four black and white films for worldwide television and home video distribution. Bennett, \textit{supra} note 3, at C14, col. 3. It should be pointed out, however, that the director of the films was no longer living and the decision to colorize for the television market was made by Otto Preminger Film executives. \textit{Id.} According to one such executive, these films were originally created in black and white for viewing in a large theater. \textit{Id.} "But television has become another market, and therefore I think has to be approached in a different way. We felt that the colorization of these four films would enhance their viewing on a small screen." \textit{Id.}
43(a) of the Lanham Act. Geisel v. Poynter Products\textsuperscript{193} illustrates the relevance of copyright ownership in a section 43(a) Lanham Act action.\textsuperscript{194} Geisel, whose pseudonym is “Dr. Suess”, assigned the copyrights in certain drawings to Liberty Magazine for publication therein.\textsuperscript{195} As an assignee, Liberty subsequently licensed the merchandising rights of the cartoons to Poynter, a toy manufacturer.\textsuperscript{196} Poynter then manufactured dolls based upon the Liberty Magazine drawings and labeled their dolls as being “From the Wonderful World of Dr. Suess . . .”\textsuperscript{197} Dr. Seuss, however, had only assigned certain drawings to Liberty and retained all other copyrights in his works.\textsuperscript{198} As a result, pursuant to section 43(a) of the Lanham Act, the court enjoined Poynter from broadly labeling its dolls in such a manner since it created a false impression that Dr. Seuss manufactured the dolls.\textsuperscript{199} The court, however, permitted Poynter to narrowly label the source of its dolls as “based on” those cartoons by Dr. Seuss that were originally transferred to Liberty.\textsuperscript{200} As a copyright proprietor of the cartoons in question, Liberty had the right to transform their copyrighted works into a different medium.\textsuperscript{201} Alternatively, Liberty could license that right, and permit Poynter to prepare dolls based upon the two-dimensional copyrighted cartoons.\textsuperscript{202} Based upon the court’s delineation of the relationship between section 43(a) and copyright ownership, courts are unlikely to permit a section 43(a) action that simultaneously detracts from the rights of a copyright proprietor.\textsuperscript{203}

Since the colorized version of a black and white film qualifies for copyright protection as a derivative work,\textsuperscript{204} preventing a copy-

\textsuperscript{193} 295 F. Supp. 331 (S.D.N.Y. 1968).
\textsuperscript{194} See Krigsman, supra note 156, at 264.
\textsuperscript{195} 295 F. Supp. at 335, 337.
\textsuperscript{196} Id. at 347.
\textsuperscript{197} Id. at 348-49.
\textsuperscript{198} See id. at 335.
\textsuperscript{199} Id. at 352-53.
\textsuperscript{200} Id. at 349, 353. In setting forth the permissible uses of a trade name, the court observed that “[t]he Lanham Act does not prohibit a commercial rival's truthfully denominating his goods a copy of a design in the public domain, though he uses the name of the designer to do so.” Id. at 351 (quoting Societe Comptoir De L'Industrie Cotonniere Etablissements Boussac v. Alexander's Dep't Stores, 299 F.2d 33, 36 (2d Cir. 1962)).
\textsuperscript{201} Id. at 351.
\textsuperscript{202} Id. at 350.
\textsuperscript{203} See Krigsman, supra note 156, at 265.
\textsuperscript{204} See Copyright Office Ruling, supra note 4; supra note 19 (listing the criteria used by the Copyright Office to determine whether a colorized black and white film qualifies as a derivative work); see also supra note 16 (defining derivative works).
right proprietor of a black and white film from colorizing his copyrighted work detracts from the value of his copyright. Such protection, however, extends only to the copyright proprietor, which includes an assignee but not a licensee of the right to use the work. Although the Lanham Act conveys rights to authors, it is difficult to ascertain who is the actual author of a black and white film which is now caught in the middle of the colorization controversy. Since these films were made in the heyday of the studio system, they are likely to be considered the product of the studio, not an individual director. Regardless of whether the author of a black and white classic is a director or the studio, injunctive relief under the Lanham Act cannot detract from the rights of a copyright proprietor.

Consequently, directors do not have a powerful tool in the Lanham Act. To escape liability, colorists who colorize a public domain film simply will not attribute the color version to the original director's efforts. Thus, there would be no false representation resulting in consumer confusion as in Gilliam and Follett. Directors of an original black and white film would also have a difficult time showing that colorization has damaged their reputation. Lastly, when colorization is performed by a subsequent copyright proprietor, there is the additional problem of a section 43(a) action detracting from the copyright proprietor's exclusive rights in his copyrighted work.

VI. OTHER POTENTIAL PROTECTORS OF THE INTEGRITY OF ORIGINAL BLACK AND WHITE FILMS

A. Contractual Provisions Against Colorization

Perhaps the most obvious method of protecting the integrity of a black and white film is for the original filmmaker to negotiate a contract with the producers prohibiting any alteration of the film without the consent of the director and screenwriter. In fact, filmmakers have already started to negotiate such contracts in order to prevent

205. See supra notes 133-34 and accompanying text.
206. See Geisel, 295 F. Supp. at 337. To be an assignee, one must be assigned all rights in the copyrighted work. Id.
207. See Senate Hearings on Colorization, supra note 6, at 60 (testimony of Buddy Young, president, Color Systems Technology, Inc.). The studios hired all those associated with the production of the film, including the actors and directors, and were responsible for marketing the film. Id.
208. See supra notes 193-203 and accompanying text (delineating the relationship between § 43(a) and copyright ownership).
COLORIZATION

In a recent round of collective bargaining negotiations between the Directors Guild of America (DGA) and the Alliance of Motion Picture and Television Producers, the Guild sought control of colorization and other post-production material alterations as part of their creative rights demand. As a result of these negotiations, the DGA won the right to be consultants when films are colorized. Although this does not seem like much of a concession from the producers association, it does allow those directors who choose to colorize their films the opportunity to supervise the process.

Contractual provisions entitling directors to control colorization and other post-production material changes is a step in the right direction, but it begs the question in terms of providing a resolution to the current colorization controversy. Most of the black and white films currently in question were made in the heyday of the studio system. Films were created and contracts were executed long before anyone contemplated the colorization process. Thus, state courts construing contracts under the canons of state law are left to determine whether the contractual right to prepare derivative works based upon the black and white film includes the right to colorize the

209. See Cook, supra note 77, at 10, col. 3.
210. The Directors Guild of America is a labor organization whose 8500 members are involved in various aspects of directing. Senate Hearings on Colorization, supra note 6, at 5 (statement of Elliot Silverstein, film director).
211. Cf. Note, supra note 25, at 534 (suggesting that the copyright proprietor should contractually reserve the rights to (1) oversee the colorization process; (2) give final approval to the finished product; (3) approve distribution; and (4) order destruction of the new version if it is deemed unsatisfactory). Such a contractual reservation of rights by the original filmmaker or subsequent copyright proprietor would give them sufficient control over their work so as to prevent colorization of their black and white film or to ensure that the film is colorized appropriately.
212. Baumgarten & Hertzmark, supra note 25, at 29 n.14. "Creative rights" are essentially a list of recorded acknowledgments in the DGA's basic minimum contract with the producers association ensuring that directors have certain rights connected with the filmmaking process. Senate Hearings on Colorization, supra note 6, at 6 (statement of Elliot Silverstein, film director). These rights include, but are not limited to, the director's right to be fully consulted on every artistic decision after the director's employment begins, the right to make a director's cut, and the right not to be discharged after completion of photography for any reason other than gross willful misconduct. Id. According to the DGA, the purpose of including these creative rights in its basic minimum contracts with the producers association is "so that we can not [sic] be deprived of the precious post-production rights we have negotiated." Id. at 6-7.
213. Cook, supra note 77, at 11, col. 3.
214. See id.
215. See supra note 207.
According to Professor Goldstein, state courts could plausibly hold that an obligation respecting authenticity and requiring the colorists to label their products as a colorized version of a black and white original is embodied within the implied covenant of good faith that exists between two contracting parties. Given the Copyright Office's ruling, a contract executed after June 22, 1987, granting the general right to prepare derivative works based upon the underlying black and white film does include the right to colorize.

B. Congressional Protection of the Integrity of Original Black and White Films

In an attempt to provide relief to the filmmakers and screenwriters of black and white motion pictures, Representative Richard A. Gephardt recently introduced The Film Integrity Act of 1987. The Act seeks to prohibit colorization of motion pictures in the absence of consent from the “principal director and principal screenwriter” even if they no longer hold copyrights in the

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216. Senate Hearings on Colorization, supra note 6, at 99 (statement of Paul Goldstein, Professor of Law, Stanford University).

217. Id. One practitioner has suggested that creators may exploit their employment contracts to prevent colorization. Cook, supra note 77, at 10, col. 3. Since colorization rights were not yet contemplated when the contracts were executed, such rights could not have been knowingly contracted away. Id.; see Note, supra note 25, at 532-34 (discussing the use of contract law to protect the integrity of black and white motion pictures); see also Kwall, supra note 24, at 21 & n.77 (discussing protection available for creators against excessive mutilation of their work when the contract does not address modification rights).

218. Copyright Office Ruling, supra note 4.

219. This section discusses the Film Integrity Act of 1987 and the Berne Convention Implementation Act of 1988 as Congressional attempts to provide direct relief from colorization. The Visual Artists Rights Act of 1987, S. 1619, 100th Cong., 1st Sess. (1987), is not discussed since it specifically excludes works made for hire. See id. § 8. It should be noted, however, that the bill seeks to incorporate the moral right of integrity into § 106 of the Copyright Act of 1976. See id. § 3(c). Based on this moral right protection, at least one commentator favors broadening the bill's “fine art” standard to include a work made for hire such as a motion picture, thereby prohibiting unauthorized subsequent colorization of an original black and white film. See Note, Artists' Moral Rights and Film Colorization: Federal Legislative Efforts to Provide Visual Artists with Moral Rights and Resale Royalties, 38 Syracuse L. Rev. 965, 987-88 (1987) (authored by Steven Gibaldi).

220. Representative Gephardt is a Democrat from Missouri and a former candidate for the 1988 Democratic Presidential nomination.

221. H.R. 2400, 100th Cong., 1st Sess. (1987). When asked about his sponsorship of this legislation, Gephardt quipped, "[t]he reason I'm against colorization is because in black and white I have eyebrows." N.Y. Times, June 30, 1987, at A28, col. 1. On a different occasion, however, Gephardt remarked, "I've been interested in artists' issues for a long time . . . . Color is my platform." Cook, supra note 77, at 11, col. 2.

222. See H.R. 2400, 100th Cong., 1st Sess. §§ 2(a), 3 (1987). If a colorist fails to obtain the consent of the director and screenwriter, the colorized work is not copyrightable. Id. §
work. As of this date, the bill is pending in the Subcommittee on Courts, Civil Liberties and the Administration of Justice of the House Judiciary Committee, where no action is scheduled. One subcommittee official, however, has noted that “the language is very unclear.”

The Berne Convention Implementation Act of 1988, proposed by Representative Robert W. Kastenmeier, is an alternative attempt at Congressional resolution of the colorization controversy. The Act seeks to amend the 1976 Copyright Act in order to facilitate United States adherence to the Berne Convention. This is a much more drastic solution to the colorization controversy than Representative Gephardt’s proposal. Although an examination of the compatibility of United States copyright law and the Berne Convention is beyond the scope of this Note, there are certain controversial incompatibilities, such as notice and registration formalities, that must be resolved as a precondition to United States adherence to the Berne Convention. Furthermore, the Ad Hoc Working Group on United States Adherence to the Berne Convention has demon-

2(d)(1).

223. Id. § 3.

224. Telephone interview with Virginia Sloan, assistant at the House Subcommittee on Courts, Civil Liberties and the Administration of Justice of the House Committee on the Judiciary (June 29, 1988). A “lively debate” did take place, however, during a hearing before the Subcommittee on June 21, 1988. Id.

225. Fighting Color In Old Movies, N.Y. Times, November 29, 1987, at A72, col. 4. For example, the Act would prohibit unauthorized colorization “in the case of a motion picture.” H.R. 2400, 100th Cong., 1st Sess. § 2(a) (1987). Since the Act does not specify “black and white motion pictures,” it prohibits all unauthorized colorization, including the use of color to restore early Technicolor classics that have faded over the years. See supra note 6 (discussing the various uses of colorization). Commentators have also criticized the Act because it gives directors exclusive control over their films. See, e.g., Cook, supra note 77, at 11, col. 2 (Professor Goldstein questioning the ability of directors to give away rights they may not exclusively possess); see also Osterlund, Ruckus Over Coloring Old Movies Reaches Halls of Congress, Christian Sci. Monitor, May 14, 1987, at 5, col. 4 (Roger Mayer, president of Turner Entertainment Company, arguing that denial of the right to colorize is equivalent to censorship).


227. Representative Kastenmeier is a Democrat from Wisconsin.

228. See H.R. 4262, 100th Cong., 2d Sess. § 3(3) (1988).


230. Id. at 105-07. For an objective discussion of the arguments in favor and against United States adherence to the Berne Convention, see Smith, supra note 35, at 11-17.

231. Shortly after the United States' withdrawal from the United Nations Educational, Scientific, and Cultural Organization in 1985, the United States Department of State formed the Ad Hoc Working Group to analyze and report on the degree of compatibility between
strated that controversial changes in domestic law will be needed prior to such adherence by the United States. Although the bill passed the House on May 10, 1988, given the traditional failure of moral rights legislation in Congress, one might expect that the bill will not be enacted into law. Optimists, however, may continue to take heart in the fact that the Copyright Act of 1976 removed many of the obstacles that previously stood in the way of adherence. Given the basic compatibility between American copyright law and the Berne Convention, intensive lobbying efforts will likely play a significant role in determining the future of the Berne Convention Implementation Act.

VII. CONCLUSION

Technology often raises difficult questions concerning the proper
role of intellectual property law.238 This does not, however, justify the suppression of technology. Despite the strong criticism from most of the film industry, the technological advance of colorization does serve a useful societal function. Statistics indicate that colorization can revive interest in black and white films of the past.239 In addition, colorization can restore some of the early Technicolor films that have become difficult to view due to their faded condition.240

Nevertheless, there is the popular argument that colorization violates the doctrine of moral right. Opponents of colorization argue that no one should have the ability to alter an artist’s work without the artist’s explicit consent.241 Despite the intrinsic appeal of this argument, the United States does not expressly recognize the doctrine of moral right.242 Moreover, the similar protections afforded by the laws of copyright,243 publicity244 and unfair competition246 do not protect the integrity of the underlying black and white film. Thus, colorists may continue to colorize public domain films, and subsequent copyright proprietors may continue to colorize their copyrighted black and white films.

Of course, the most apparent and immediate method of protecting the integrity of black and white films is for the director to negotiate a contract with the producer prohibiting any alteration of the film without the consent of the director and screenwriter. In fact, the DGA has sought to control colorization and other post-production material alterations as part of its creative rights demand on the producers association.246 Although such contractual provisions will protect the integrity of future black and white films, they are ineffective in protecting the integrity of black and white films currently in existence, most of which were created long before anyone contemplated the colorization process.247

The eventual vindicator of the integrity of black and white films

238. See generally Office of Technology Assessment, supra note 1 (discussing the stress that technology places on the intellectual property system as a whole and on each of its parts).

239. See supra notes 77, 191.

240. See Senate Hearings on Colorization, supra note 6, at 62 (statement of Buddy Young, president, Color Systems Technology, Inc.).

241. See supra note 22 and accompanying text.

242. See supra note 23.

243. See supra notes 65-90 and accompanying text.

244. See supra notes 91-143 and accompanying text.

245. See supra notes 144-208 and accompanying text.

246. See supra notes 209-14 and accompanying text.

247. See supra note 207.
must be Congress. The Film Integrity Act of 1987 would give directors and screenwriters the right to control colorization of their original films, regardless of who holds the copyright, but insiders suggest that the bill is likely to die in committee. More significantly, the Berne Implementation Act of 1988 seeks United States adherence to the Berne Convention. Although there are major obstacles precluding immediate adherence to the Convention, it is in the best interest of the United States to become a member nation. United States Trade Representative Clayton Yeutter has suggested that adherence to the Berne Convention would curb the international piracy of United States copyrighted work by member nations of the Berne Convention.

Perhaps Woody Allen summed it up best when he observed that “[t]he colorizers may think they have a legal loophole, but the morality of what they are doing is atrocious.” Although societal progress is predicated on our ability to build upon the accomplishments of our predecessors, no art, including film art, is created in a social vacuum. Our artists have been formed and informed by our culture which, in most cases, gave them birth, and in all cases gave them an opportunity for the kind of free expression that led finally to the production of their work—work unique and special to their nation, born of a par-

248. See supra notes 220-25 and accompanying text.
249. See supra notes 226-28.
250. See supra notes 229-30 and accompanying text.
251. See DuBoff, Winter, Flacks & Keplinger, Out of UNESCO and into Berne: Has United States Participation in the Berne Convention for International Copyright Protection Become Essential?, 4 CARDOZO ARTS & ENT. L.J. 203, 215 (1985). One commentator suggests that the motion picture industry will benefit in its economic struggle for international copyright protection if the United States were to become a member nation. See Smith, supra note 35, at 11, 17-18. Other commentators argue that the need for national uniformity and the avoidance of forum choice mandates federal protection for moral rights. See, e.g., Kwall, supra note 24, at 91; Note, supra note 172, at 589.
252. This Week in Congress, Cong. Index (CCH) No. 55, at 2 (Feb. 19, 1988) (statement of United States Trade Representative Clayton Yeutter); see also DuBoff, Winter, Flacks & Keplinger, supra note 251, at 215 (viewing United States compliance with the Berne Convention as a necessary condition for the protection of United States copyrighted material from international piracy).
253. Senate Hearings on Colorization, supra note 6, at 26 (testimony of Woody Allen, actor and film director).
ticular time and a particular place, solving particular aesthetic and technical problems with the particular tools available to them at that time.255

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255. Senate Hearings on Colorization, supra note 6, at 4 (testimony of Elliot Silverstein, film director).