Moral rights, legal wrongs

Risks, conflict and Constitutional considerations introducing moral rights protection to US

Joe Beck leads a team from Kilpatrick Stockton in assessing moral rights protection in US state and federal legislation – and potential conflicts arising under US law

Many lawyers may assume that moral rights protection in the United States stems from the Lanham Act, or is limited to a small class of paintings, drawings, sculptures, and still photographs under Section 106A of the Copyright Act. Some states, and Puerto Rico, however, have adopted moral rights legislation.[i]

These statutes provide authors substantial rights and pose significant risks for those who use, copy, display, or criticise creative works. Recently, a federal district court in Puerto Rico, with little explanation or analysis, awarded more than $6 million to the author of a musical work in compensation for a moral rights violation arising out of the defendant's modification of the lyrics to a song.[ii] Practitioners should be aware of the risks associated with these moral rights laws. Those drafting or relying on moral rights legislation should consider whether broad moral rights laws can co-exist with United States Constitutional and statutory law.

Among other things, the *Berne Convention for the Protection of Literary and Artistic Works* is a moral rights treaty. Article 6bis requires signatory countries to recognise certain reputation rights, or "moral rights" of authors, in addition to and separate from any copyright protection accorded to a particular work:

> *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.*[iii]

In preparing the implementing legislation required for United States' compliance with Article 6*bis*, Congress concluded that many works of authorship were already protected from "distortion or mutilation" under section 43 of the Lanham Act, as interpreted in cases such as *Gilliam v American Broadcasting Cos.*,[iv] and that only limited moral rights legislation was necessary. Congress, therefore, enacted the Visual Artists Rights Act (VARA),[v] which prohibits the destruction, mutilation, and distortion of certain works of visual art. Given its limited focus, however, many moral rights advocates remain unsatisfied with VARA.

To date, the debate over the United States compliance with the Berne Convention has centered around two questions: (1) whether US moral rights protection is sufficient; and if not, (2) what can be done by the states or the federal government to provide adequate moral rights protection. Fewer commentators, however, have asked the whether state moral rights statutes are consistent with the current US statutory scheme of copyright protection. Fewer still have considered the First Amendment and other Constitutional issues that may arise in connection with moral rights legislation.

In summary

- Some US states have adopted moral rights legislation that goes beyond that offered by the Lanham Act and Section 106A of the Copyright Act. The authors argue that practitioners need to be aware of the risks posed by these state laws, exemplified by *Monroig* in Puerto Rico
- Legislators contemplating or drafting moral rights legislation are encouraged to consider whether broad moral rights laws can co-exist with US Constitutional and statutory law
- A number of hypothetical scenarios are presented to illustrate potential conflicts between existing moral rights protection in state laws, and the Copyright Act. The authors also argue that flaws will be found in moral rights legislation considered in light of First Amendment guarantees

The preemption analysis

As recognised in the Berne Convention's text, moral rights are — at least in theory — distinct from the author's copyright rights. Moral rights protect the author's "honor and reputation" while copyrights typically relate to the author's ability to control economic exploitation of a work.

Moral rights include the right of attribution (the right to claim or disclaim authorship), the right of integrity (the right to object to any distortion, mutilation, or other derogatory modification a work), and, at least in some countries, the *droite de suite* (the right to claim a royalty from the resale of an original work).

The most obvious potential obstacle to enacting and enforcing state moral rights legislation is the express statutory preemption in Section 301 of the Copyright Act of rights equivalent to rights granted in Sections 106 and 106A; any attempt by the states to duplicate the rights granted to an author by the Copyright Act would be expressly preempted.

In addition to Section 301, the comprehensive federal regulation of copyright suggests an additional potential limitation of the states' ability to enact and enforce moral rights legislation. Within the Copyright Act,

a number of provisions divest the author of the exclusive right to control the copyrighted work and invest the public with an affirmative right to make use of, and even modify, the work. Examples include the statutory compulsory license of musical works,[vi] fair use,[vii] and the first sale doctrine.[viii]

It is not difficult to imagine a situation in which the author's right of integrity or attribution would come into direct conflict with the statutory right conferred upon the public by these provisions. In such a situation, Supremacy Clause jurisprudence counsels that the state regulation would be preempted.

The Puerto Rico Act

The inadequacy of a preemption analysis that focuses only upon express preemption under Section 301 was recently illustrated in a case handled by the authors that arose under Puerto Rico's comparatively broad moral rights statute.

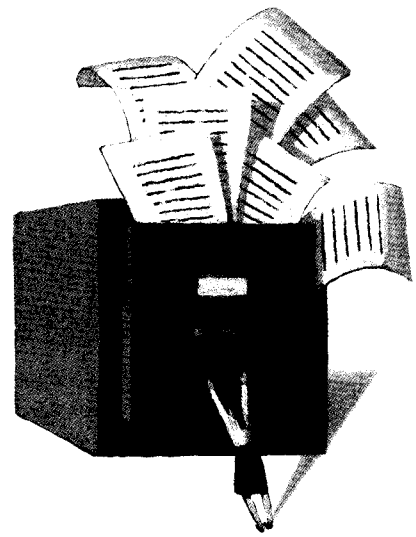
The Puerto Rico Intellectual Property Act (PRIPA) provides: *"The author or beneficiary of a literary, scientific, artistic and/or musical work has the right to benefit from it, and the exclusive prerogatives to attribute to him/herself or retract its authorship, dispose of his/her work, authorize its publication and protect its integrity, in accordance with the special laws in effect on the matter."*[ix]

Relying on the PRIPA, the plaintiffs, Puerto Rican songwriters represented by plaintiff's counsel from *Monroig*, threatened the authors' client, a major record company, with litigation arising out of a dispute over relatively minor modifications, in licensed sound recordings, of the lyrics to two songs written by the plaintiffs.

Although the record company had complied with the Copyright Act's compulsory license provisions, the plaintiffs argued that the modification of the lyrics resulted in a "mutilation" of the songs and established a violation of the authors' moral rights as defined by the PRIPA. As the dispute escalated, our client instituted a declaratory judgment action in district court in Miami, seeking a declaration that the PRIPA was unenforceable for several reasons.[x]

First, we took the position that, even if not expressly preempted by Section 301, the PRIPA grants to authors descendible moral rights protections that are inconsistent with Copyright Act limitations on the ability of authors to control the copying and modification of their works. These limitations, we argued, represent a careful Congressional balancing of the incentives to create new works against society's need to copy and distribute, a balance that broad moral rights laws can easily disrupt.

For example, the compulsory license provision of §115 of the Copyright Act provides that following the initial distribution of phonorecords to the public, any person complying with the notice and royalty payment provisions of Section 115 has the statutory "privilege of making a musical arrangement of the work to the extent necessary to conform it to the style or manner of interpretation of the performance involved" as long as the arrangement does "not change the basic melody or fundamental character of the work."[xi]



Hypotheticals

The potential conflict between the Copyright Act's compulsory licensing provisions and the PRIPA can be seen in the following hypothetical situation:[xii] A San Juan-based grunge band, popular in the early 1990s, learns that a new age record label has begun selling CDs containing a harp and pan flute led recording of the band's hit song. The band sues the publisher for violations of the Puerto Rico moral rights law, claiming that the new age version of their song lacks the angst conveyed in the original recording. The label claims that the recording is authorised by the compulsory licensing provisions of the Copyright Act and that the band is only entitled to statutory royalties.

The band would have an initially appealing claim under the PRIPA which grants authors the right to protect the integrity and to prevent the mutilation of their works. The band would claim that the artistic essence of the song was lost as soon as it was recorded with harps and a pan flute instead of two guitars, a bass, and drums, and, therefore, that the work had been "mutilated".

The record label, on the other hand, would assert that the Copyright Act grants it the privilege to do exactly what it had done, namely, to distribute an arrangement that conformed to the style and manner of interpretation of the performance involved; and that it did not change either the melody or words of the original musical work. As this example shows, a conflict exists between the band's moral rights claim and the label's privilege under the Copyright Act. Recognition of the moral rights claim in this hypothetical could disturb the Congressional balancing of rights under the Copyright Act.

An equally compelling argument for comprehensive moral rights preemption can be illustrated by the following hypothetical: An art history professor gives a lecture on different brush techniques used by 20th century American artists. To illustrate his point, the professor creates a slideshow of details from various paintings in which the details have been magnified to demonstrate the superlative, or abysmal, uses of the various techniques. The daughter of a deceased Puerto Rican artist whose work had been used to illustrate poor brush technique sues the professor, claiming that the enlarged detail constitutes a "mutilation" of her father's painting in violation of his right of artistic integrity.

Like the first hypothetical, this one also presents a case for a moral rights violation under the PRIPA, or a similarly broad US state statute. Under Section 107 of the Copyright Act, however, this scenario arguably presents a classic example of fair use. The codified fair use doctrine recognises an affirmative right of the public to make certain uses of a copyrighted work without liability. If a state law permits an author to recover damages from an individual entitled to assert the fair use defense for a moral rights violation, the state law would conflict with an express limitation upon the author's rights under the Copyright Act and deprive the public of a valuable right.

These hypothetical situations demonstrate that moral rights laws can create rights that may be inconsistent with the Copyright Act. The usual method for determining whether state laws are preempted by the Copyright Act involves consideration only of express preemption, found in Section 301 of the Copyright Act. The evaluation of express preemption under Section 301 is governed by the judicially-created "extra element test."

Generally speaking, the extra element test provides that if a state law claimed to be preempted by the Copyright Act requires an extra element, beyond mere copying, preparation of derivative works, performance, distribution, or display, then the state cause of action is qualitatively different from, and not preempted by, the Copyright Act. A plaintiff could therefore argue that the moral rights cause of action under the PRIPA involves an extra element—harm to the author's personal reputation—that is not required to find a violation of the Copyright Act.

Simultaneously with the enactment of

VARA, Congress expanded Section 301 express preemption to include *"all legal or equitable rights that are equivalent to any of the rights conferred by section 106A"*;[xiii] however, even with respect to visual artwork, the statutory exemptions to express preemption substantially narrow its potential scope. Thus, the following state moral rights laws are not preempted: (1) laws creating legal or equitable rights which are not equivalent to any of the rights conferred in 106A "with respect to works of visual art,"[xiv] and (2) laws granting legal or equitable rights which extend beyond the life of the author.[xv]

Setting aside the complicated questions regarding what rights may be "equivalent" to the rights conferred by Section 106A in "works of visual art" (the definition of which is tightly circumscribed),[xvi] the exemption of legal and equitable rights that extend beyond the life of the author creates an express preemption loophole arguably large enough to accommodate the cause of action arising under the PRIPA in the second hypothetical discussed above.

For the foregoing reasons, moral rights laws such as the PRIPA may be found not to be preempted by the Copyright Act under a strict application of the extra element test. As noted above, however, such an analysis arguably fails to account for those situations where the moral rights law and the Copyright Act are incompatible.

Constitutional concerns

Apart from the possibility for conflict between state moral rights laws and the Copyright Act, some moral rights laws may contain Constitutional defects. The PRIPA, for example, grants the author of a work the right to protect its integrity. In the case handled by the authors, we argued that the PRIPA authorised content regulation of expressive works such as music and books in violation of the First Amendment. Moreover, we argued that the PRIPA was unconstitutionally vague, leaving authors such as our client, the declaratory plaintiff, with no guidance as to the kinds of uses that could be made of works licensed by the copyright owner, a situation that inevitably would chill speech.

The PRIPA also grants the author of a work the *"exclusive prerogatives to attribute to him/herself or retract its authorship"* from the work.

Consider how such a provision might apply in the following scenario: a successful district attorney in Puerto Rico announces his intent to seek his party's nomination to run for higher office. During investigations concerning the candidate's background, a newspaper discovers a draft article submitted for publication in a law review thirty years earlier when the candidate was a law student. The newspaper correctly reports that the district attorney's article urged that in order to reduce the threat from OPEC, the United States government should authorise the immediate exploration and drilling for oil in US national parks. The next day, the district attorney calls a press conference and renounces the opinions expressed in the article as outdated and no longer his opinion.

The district attorney's 30-year-old article continues to be highlighted by the media for several weeks until he withdraws his intent to seek the nomination. The district attorney later files suit against several media companies, including the newspaper that originally discovered the article, on the ground that the companies violated his moral right to retract his authorship from the work.

This hypothetical illuminates the difficulties of importing moral rights wholesale into a legal system in which they have not historically been recognised. Moral rights laws may create rights that have the potential to infringe upon longstanding First Amendment protections. A state or federally created right to retract authorship should not provide a means for public figures to stifle truthful speech. Indeed, the very reason authors may choose to retract their authorship will often coincide with a newsworthy event of public interest. Further, in protecting an author's integrity, moral rights laws may prohibit other socially important conduct, including criticism of a work and the public display of a work in a location deemed unsuitable by the author.

In addition to overbreadth,[xvii] moral rights laws may also be subject to a vagueness challenge. A law that depends on a subjective determination of what the author finds offensive arguably fails to provide adequate notice of what acts are prohibited.[xviii] Vagueness in a law that regulates speech is particularly troublesome because of the possibility that non-infringing or unpopular speech will be suppressed.

Conclusion

Even though VARA has a relatively limited application to a select group of works of the visual arts, individuals and entities that use, copy, display, and criticise other types of creative works may face significant exposure under PRIPA or similar state moral rights laws.

Because a preemption analysis relying primarily and often exclusively on Section 301 may be inadequate to determine whether efforts to provide authors with moral rights protections are consistent with the Copyright Act, a more nuanced analysis that takes into account conflict and implied preemption considerations should be used. In addition, flaws in moral rights legislation may be found when those laws are considered in light of First Amendment guarantees.

A comprehensive conflict and First Amendment analysis may effectively limit the application of state moral rights laws. ⊕

Notes

i See, e.g., Cal. Civ. Code §987-89; N.Y. Arts & Cultural Affairs Law §14.01-.08; Mass. Gen. Laws ch. 231, §85S; N.J. Stat. Ann. §2A:24A-1 to –8; Conn. Gen. Stat. §42-116s & -116t; N.M. Stat. Ann. §13-4B-3; Me. Rev. Stat. Ann. Tit. 27, §303; R.I. Gen. Laws §5-62-2 to –12. Although several states have enacted moral rights protection, the Puerto Rico Intellectual Property Act may be the broadest of the moral rights laws because it is not limited to protecting works of visual art but also protects literary and scientific works.

ii Monroig v. RMM Records & Video Corp., 196 F.R.D. 214 (D.P.R. 2000).

iii Berne Convention for the Protection of Literary and Artistic Works, art. 6bis(1).

iv 538 F.2d 14 (2d Cir. 1976).

v 17 U.S.C. § 106A

vi 17 U.S.C. § 117.

vii 17 U.S.C. § 107.

viii 17 U.S.C. § 109.

ix Puerto Rico Intellectual Property Act, 31 L.P.R.A. § 1401.

x Soon after the declaratory judgment action was filed, the case settled on terms favorable to the record company.

xi 17 U.S.C. § 115(a)(2).

xii This hypothetical is inspired by the above case in which the authors participated as counsel for the record company.

xiii 17 U.S.C. § 301(f).

xiv 17 U.S.C. § 301(f)(2)(B).

xv 17 U.S.C. § 301(f)(2)(C).

xvi 17 U.S.C. § 101.

xvii See, e.g., Gooding v. Wilson, 405 U.S. 518, 522 (1972) (explaining that a "statute must be carefully drawn or be authoritatively construed to punish only unprotected speech and not be susceptible to application to protected expression").

xviii See, e.g., Grayned v. City of Rockford, 408 U.S. 104, 108-09 (1972) ("A vague law impermissibly delegates basic policy matters to policemen, judges and juries for resolution on an ad hoc and subjective basis, with the attendant dangers of arbitrary and discriminatory application."); Connally v. General Const. Co., 269 U.S. 385, 391 (explaining that a law is unconstitutionally vague if people of "common intelligence must necessarily guess at its meaning and differ as to its application") (internal quotations omitted).

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Joe Beck (left) is a partner in Kilpatrick Stockton's Intellectual Property Practice Group, based in the firm's Atlanta office. He has served as a Trustee of The Copyright Society of the USA, is the Founder of the Copyright Society of the Southeast. **Alex Fonoroff** (centre) and **Robin Wharton** (right) are associates in Kilpatrick Stockton's Intellectual Property Practice Group.