

# ARTICLE

## CASTING CALL AT FOREST LAWN: THE DIGITAL RESURRECTION OF DECEASED ENTERTAINERS - A 21ST CENTURY CHALLENGE FOR INTELLECTUAL PROPERTY LAW

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"Actors who died 50 years ago will be starring next to contemporary actors."— *Steve Williams, Industrial Light & Magic*<sup>1</sup>

"If it be not now, yet it will come—the readiness is all." — *Hamlet*<sup>2</sup>

## I. INTRODUCTION

Forest Lawn has been a mecca for Tinsel-town tourists and film fans for more than a half century now. It is the last resting place of many Hollywood luminaries: Bogart, Gable, Harlow, Tracy, Chaney—to name but a few. Befitting its eternal purpose, Forest Lawn is kept evergreen. So too, the memory of these deceased stars is kept evergreen by the endless re-runs of their films on broadcast television, cable, and videocassette, as well as by occasional theatrical tributes. But the images and sounds we witness are frozen in time: "Here's looking at you kid"; "Frankly my dear"; and Chaney's Quasimodo silently tolling the bells of Notre Dame. And while we may never tire of seeing Rick's poignant farewell to Ilsa or Rhett's indifference to Scarlett as he disappears into the mist, one might wish for Bogart to "pick up the pieces" in post-war Casablanca or for Gable and Leigh to be cast in *Scarlett* rather than the actor and actress who will ultimately bear the thankless burden of critical comparison. Until now such possibilities were mere wishful thinking. In fact, little more than a decade ago this writer opined that "Even the biblical magic of M.G.M. cannot recall the actor who has 'stepped beyond

1. Richard Corliss, *They Put the ILM in Film*, TIME, Apr. 13, 1992, at 68-69.

2. WILLIAM SHAKESPEARE, HAMLET, PRINCE OF DENMARK, Act 5, Scene 2.

the footlights."<sup>3</sup> But now it appears that emerging technology, such as that which brought to life the liquid-metal cyborg, T-1000, in *Terminator 2: Judgment Day*,<sup>4</sup> may be the key to the "resurrection" of long dead performers to, in the words of Steve Williams, "star next to contemporary actors."<sup>5</sup> Computer graphics that have brought magic to such films as *Terminator 2*, *Backdraft*,<sup>6</sup> and *The Abyss*<sup>7</sup> may yet give us Tracy, Bergman, Olivier, and the Barrymores acting with the stars of today (and ultimately the stars of all the tomorrows).

The public has already become accustomed to viewing films featuring actors, long dead, "acting" with now-living performers. Witness Carl Reiner's *Dead Men Don't Wear Plaid*,<sup>8</sup> Woody Allen's *Zelig*,<sup>9</sup> and Natalie Cole's "Unforgettable" Grammy-winning duet with her late father Nat "King" Cole.<sup>10</sup> Coca Cola scored an advertising coup with its "dead celebrity" ad featuring Elton John performing to an appreciative audience that included Humphrey Bogart, James Cagney, and Louis Armstrong.<sup>11</sup> The overwhelming success of the ad led to a sequel starring Paula Abdul with Cary Grant, Groucho Marx, and a younger version of the still very vital Gene Kelly. As clever as these various "quick and the dead" films are, they rely on the performance of the deceased actor

3. Joseph J. Beard, *The Sale, Rental, and Reproduction of Motion Picture Videocassettes: Piracy or Privilege?*, 15 NEW ENG. L. REV. 435, 455 (1980).

4. (Carolco 1991).

5. Corliss, *supra* note 1.

6. (Universal 1991).

7. (20th Century 1990).

8. (Universal 1982). This 1982 black and white film starring Steve Martin is a send-up of the film noir private eye classics of the 1940's. Clips of films starring Humphrey Bogart, Alan Ladd, Charles Laughton, and others were creatively spliced with scenes and dialog of Steve Martin and other live actors. Writing credits went to Carl Reiner, Steve Martin, and George Gipe. Gipe will be remembered as the author of "Nearer to the Dust," the pro-author/publisher monograph published by Williams & Wilkins at the time they were suing the U.S. Government for copying W & W's medical journals. *The Williams & Wilkins Co. v. United States*, 172 U.S.P.Q. 670 (Ct. Cl. 1972), *rev'd*, 487 F.2d 1345 (Ct. Cl. 1973), *aff'd by an equally divided court*, 420 U.S. 376 (1975).

9. (Orion Pictures 1983). This 1983 film, written and directed by Woody Allen and starring Allen and Mia Farrow, wove film clips of such long dead celebrities as Fanny Brice, Billy Rose, Tom Mix, and Charlie Chaplin into scenes in the film about Leonard Zelig (Allen), the human chameleon. The technical elements integrating Allen and the vintage film clips were undertaken by R. Greenberg Associates.

10. NATALIE COLE, *Unforgettable*, on UNFORGETTABLE (Elektra Entertainment. 1991).

11. The two ads are a result of the creative genius of Lintas: New York, the ad agency that has handled the Diet Coke account since its introduction in 1982, and the technical genius of R. Greenberg Associates. The first ad, "Night Club," relied on isolating images by rotoscoping film clips of Bogart in ALL THROUGH THE NIGHT, Armstrong in HIGH SOCIETY, and Cagney in PUBLIC ENEMY and THE ROARING TWENTIES. These images were then "computer stitched into the contemporary nightclub scene." Michael Quinn, *Ghosts in the Commercial*, TIME, Dec. 23, 1991, at 56.

exactly as originally filmed.<sup>12</sup> These works depend either on carefully juxtaposing clips of the deceased performers with film of the now-living performer(s), as in *Dead Men Don't Wear Plaid* and "Unforgettable," or on extracting the deceased actor's image from existing film and stitching the image into the new film, as in the Coke ads, a process known as rotoscoping. Just as the "block book" served as a crude precursor of the printing press, today's technology serves as a forerunner to a technology that promises virtual resurrection. Reanimation technology promises to put fresh dialogue into the mouth of the deceased performer and to bring new physical activity to the actor; the images of the late actor will no longer be frozen in time. But this new technology also promises something else—new challenges to intellectual property and entertainment law.

How soon will this Lazarusian technology be upon us? In the immortal words of Rick Blaine, "Maybe not today, maybe not tomorrow, but soon . . ." <sup>13</sup> In fact, this embryonic technology has already been graphically, and rather dramatically, demonstrated. In May 1987, the pioneering film *Rendez-vous à Montréal* premiered at the Canadian Engineering Centennial Convention.<sup>14</sup> The seven minute film starred Marilyn Monroe and Humphrey Bogart, in truth, a computer-generated synthetic Marilyn and Humphrey. To be sure, the images were not cinematographic replicas of the stars, but were an attempt to "portray these great stars emotionally—to reconstitute Marilyn's and Humphrey's personalities as most people know them."<sup>15</sup> The film was dramatic evidence of on-going attempts to create realistic, computer-generated, synthetic actors. Today, researchers in computer graphics are addressing such problems as facial modeling,<sup>16</sup> skin texture and hair modeling,<sup>17</sup>

12. Actually, there was a slight change to the Cagney image; he grew a bit taller so as not to be overshadowed by the live actress sitting next to him. *Id.*

13. CASABLANCA (Warner Brothers 1942).

14. (Nadia M. Thalmann & Daniel Thalmann 1987). For a description of the technology employed in creating Marilyn and Bogie see Nadia Magnenat-Thalmann & Daniel Thalmann, *The Direction of Synthetic Actors in the Film Rendez-vous à Montréal*, IEEE COMPUTER GRAPHICS & APPLICATIONS, Dec. 1987, at 9.

15. *Id.* at 10.

16. See André LeBlanc et al., *Sculpting with the "Ball and Mouse Metaphor"*, in 20 SIGGRAPH COURSE NOTES 30 (1991); Arghyro Paouri et al., *Creating Realistic Three-Dimensional Human Shape Characters for Computer-Generated Films* in COMPUTER ANIMATION '91 89 (Nadia M. Thalmann & Daniel Thalmann eds., 1991); Demetri Terzopoulos & Keith Waters, *Physically-based Facial Modelling, Analysis, and Animation*, 1 J. VISUALIZATION & COMPUTER ANIMATION 73 (1990), reprinted in 20 SIGGRAPH COURSE NOTES 67 (1991); Demetri Terzopoulos & Keith Waters, *Techniques for Realistic Facial Modeling and Animation*, in COMPUTER ANIMATION '91, *supra*, at 59. [hereinafter *Techniques for Realistic Facial Modeling*].

17. See André LeBlanc et al., *Rendering Hair Using Pixel Blending and Shadow Buffers*, 2 J. VISUALIZATION & COMPUTER ANIMATION 92 (1991), reprinted in 20 SIGGRAPH COURSE NOTES

emotion generation and synchronization with speech,<sup>18</sup> motion synthesis,<sup>19</sup> and voice synthesis.<sup>20</sup> While these research activities have been undertaken for a variety of reasons, not necessarily for the particular purpose of creating synthetic replicas of deceased actors, the results will be applied to reanimation. However, to achieve a quality of computer-generated synthetic image, voice, and emotional range that is indistinguishable from that of performances of the actor filmed during his lifetime is a goal perhaps not achievable in the near term. It may, in fact, be sometime early in the next century before the goal becomes a reality. But prognostication is a risky business, and I am reminded of the words of the late Professor J.C.R. Licklider of M.I.T.: "People tend to overestimate what can be done in one year and to underestimate what can be done in five or ten years."<sup>21</sup>

96 (1991); Monique Nahas et al., *Registered 3D - Texture Imaging*, in *COMPUTER ANIMATION '90 81* (Nadia M. Thalmann & Daniel Thalmann eds., 1990).

18. See Prem Kalra et al., *Simulation of Facial Muscle Actions Based on Rational Free Form Deformations*, in *11 COMPUTER GRAPHICS FORUM C-59* (1992); Prem Kalra et al., *SMILE: A Multilayered Facial Animation System*, in *MODELING IN COMPUTER GRAPHICS 189* (Tosiyasu L. Kunii ed., 1991) [hereinafter *SMILE*]; Nadia Magnenat-Thalmann & Daniel Thalmann, *Complex Models for Animating Synthetic Actors*, *IEEE COMPUTER GRAPHICS & APPLICATIONS*, Sept. 1991, at 32; Catherine Pelachaud et al., *Communication and Coarticulation in Facial Animation*, in *20 SIGGRAPH COURSE NOTES 236* (1991); Steven Pieper et al., *Interactive Graphics for Plastic Surgery: A Task-Level Analysis and Implementation* in *PROC. 1992 SYMP. ON INTERACTIVE 3D GRAPHICS 127* (1992); see also, Keith Waters, *A Muscle Model for Animating Three-Dimensional Facial Expression*, *COMPUTER GRAPHICS*, July 17, 1987, at 17.

19. See Laurent Bezault et al., *An Interactive Tool for the Design of Human Free-Walking Trajectories*, in *17 SIGGRAPH COURSE NOTES 181* (1992); Ronan Boulic et al., *A Global Human Walking Model with Real-Time Kinematic Personification*, *6 VISUAL COMPUTER 344* (1990); Gary Monheit & Norman I. Badler, *A Kinematic Model of the Human Spine and Torso*, in *IEEE COMPUTER GRAPHICS & APPLICATIONS*, Mar. 1991, at 29; Cary B. Phillips & Norman I. Badler, *Interactive Behaviors for Bipedal Articulated Figures*, *COMPUTER GRAPHICS*, July 1991, at 359; Olivier Renault et al., *A Vision-based Approach to Behavioural Animation*, *20 SIGGRAPH COURSE NOTES 287* (1991); David Zeltzer, *Human Figure Modeling for Virtual Environment Applications*, *IEEE INT'L WORKSHOP ON ROBOT AND HUM. COMM.*, (1992); David Zeltzer & Michael B. Johnson, *Motor Planning: An Architecture for Specifying and Controlling the Behavior of Virtual Actors*, *2 J. VISUALIZATION AND COMPUTER ANIMATION*, 74 (1991).

20. See JONATHAN ALLEN, ET AL., *FROM TEXT TO SPEECH: THE MITALK SYSTEM* (1987); J.N. HOLMES, *SPEECH SYNTHESIS AND RECOGNITION* (1987); R. LINGGARD, *ELECTRONIC SYNTHESIS OF SPEECH* (1985); NELSON MORGAN, *TALKING CHIPS* (1984); DOUGLAS O'SHAUGNESSY, *SPEECH COMMUNICATION: HUMAN AND MACHINE*, (1990); E.J. YANNAKOUDAKIS & P.J. HUTTON, *SPEECH SYNTHESIS AND RECOGNITION SYSTEMS* (1987); Yousif A. El-Iman & Karima Banat, *Text-to-Speech Conversion on a Personal Computer*, *IEEE MICRO*, Aug. 1990, at 62; Dennis H. Klatt & Laura C. Klatt, *Analysis, Synthesis, and Perception of Voice Quality Variations Among Female and Male Talkers*, *87 J. ACOUSTIC SOC'Y AM.* 820 (1990); Michael H. O'Malley, *Text-to-Speech Conversion Technology*, *COMPUTER*, Aug. 1990, at 17; Carl.R. Strathmeyer, *Voice in Computing: An Overview of Available Technologies*, *COMPUTER*, Aug. 1990, at 10; Roberta Wiener, *Computerized Speech: A Study of its Effect on Learning*, *18 TECHNOLOGICAL HORIZONS EDUC. J.* 100 (1991).

21. J.C.R. LICKLIDER, *LIBRARIES OF THE FUTURE* 17 (1965) (quoting an unspecified source).

Whatever the difficulty in predicting exactly when this technology will reach maturity, its inevitability can be predicted with confidence. There is another prediction that can be made with equal confidence: The legal system will have to respond to concerns—some proprietary and others of propriety—created by reanimation. In the past, the legal system has reacted to, rather than anticipated, innovation; witness the introduction of the motion picture,<sup>22</sup> television,<sup>23</sup> cable,<sup>24</sup> VCR,<sup>25</sup> and the pre-recorded videocassette.<sup>26</sup> Hamlet's observation about the certainty of death, "the readiness is all,"<sup>27</sup> is advice that might well be heeded with respect to reanimation. It is not too soon to begin a discussion of the legal issues raised by reanimation. While these issues may not be ripe for resolution, they are certainly ripe for reflection.

It is the purpose of this article to stimulate discussion of the legal issues involved in reanimation. The issues may be divided into those related to the *creation* of the synthetic replica of the deceased actor, and those related to its *exploitation*. With respect to *creation*, the focus will be on copyright. To create a realistic replica of the deceased actor, the reanimator will require reference works. Where these works enjoy copyright protection, issues arise as to whether, and to what extent, the reanimator may use these reference works without license. The discussion of copyright in Part II of this article will analyze the protectable versus unprotectable elements of reference works and

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22. When motion pictures appeared, so did law suits by play owners. See *Stodart v. Mutual Film Corp.*, 249 F. 507 (S.D.N.Y. 1917), *aff'd*, 249 F. 513 (2d Cir. 1918); *O'Neill v. General Film Co.*, 152 N.Y.S. 599 (N.Y. Sup. Ct. 1915), *modified*, 171 A.D. 854 (N.Y. App. Div. 1916).

23. When television began in earnest after World War II, old films, particularly Westerns, found new life, and actors sued for a piece of the pie. See *Republic Pictures Corp. v. Rogers* 213 F.2d 662 (9th Cir. 1954), *cert. denied*, 348 U.S. 858; *Autry v. Republic Prods.*, 213 F.2d 667 (9th Cir. 1954), *cert. denied*, 348 U.S. 858.

24. The introduction of cable produced a clash with broadcast T.V. See *Telepromptor Corp. v. Columbia Broadcasting Sys.*, 415 U.S. 394 (1974); *Fortnightly Corp. v. United Artists Television*, 392 U.S. 390 (1968).

25. When the public discovered that video cassette recorder/players could be used to tape off-air, the motion picture owners sued the VCR manufacturer. See *Sony Corp. of Am. v. Universal City Studios*, 464 U.S. 417 (1984).

26. When the pre-recorded motion picture videocassettes led to unlicensed mini-theaters, the motion picture industry reacted. See *Columbia Pictures Indus. v. Aveco, Inc.*, 800 F.2d 59 (3d Cir. 1986); *Columbia Pictures Indus. v. Redd Horne, Inc.*, 749 F.2d 154 (3d Cir. 1984). The owners of music copyrights were quick to react when pre-recorded videocassettes were released containing their songs on the soundtracks. See *Cohen v. Paramount Pictures Corp.*, 845 F.2d 851 (9th Cir. 1988); *Bourne v. Walt Disney*, No. 91-0344 LLS, 1992 U.S. Dist. LEXIS 11731 (S.D.N.Y. Aug. 6, 1992) (*Bourne II*); No. 91-0344 LLS, 1992 U.S. Dist. LEXIS 9853 (S.D.N.Y. July 1, 1992) (*Bourne I*), *rev'd*, 976 F.2d 99 (2d Cir. 1992).

27. SHAKESPEARE, *supra* note 2.

consider whether interim copying is an infringement. It will also consider the efficacy of a fair use defense.

The issue of *exploitation* of the synthetic replica may be subdivided into proprietary and "moral rights" questions. The exploitation of the synthetic replica raises questions as to who, if anyone, should have a proprietary interest in the replica. Part III addresses the issue of whether the reanimator should be afforded copyright protection for the computer-generated replica, either as a computer program or possibly as an audio-visual work. Part IV address another aspect of the proprietary question, whether reanimation should be subject to the post-mortem right of publicity. Because the post-mortem right of publicity is still in its infancy, the question does not, as will be shown, admit of an easy answer. Part V addresses the proprietary concerns of trademark owners and licensees, with respect to unlicensed exploitation of synthetic celebrities.

Beyond the purely economic concerns raised by reanimation are concerns about the effect reanimation will have on the memory of the late actor. Presumably, the public as well as the actor's family will be concerned about potential abuse of persona made possible by reanimation technology. If the quality of the synthetic replica is poor, or if the reanimated actor is cast in roles inconsistent with or even antithetical to his image, the public memory or reputation of the actor may be damaged. Part VI of this article examines the effectiveness with which current laws deal with the "moral rights" problem and will suggest changes to existing law to more effectively deal with the issue.

## II. CREATION OF THE SYNTHETIC REPLICA - THE COPYRIGHT ISSUE

### A. Scope of the Issue

To create cyborgs or, as Williams suggests, to create "actors who have never been born"<sup>28</sup> is wholly within the imagination of the animators, constrained only by available technology; computer animators are not fettered by any pre-conceived notions of the public as to what this computer-animated cyborg or actor must look or sound like. To create a wholly imaginary synthetic human likely will not require reference to copyrighted works. For that matter, a synthetic image of a currently living human probably will not raise copyright issues, at least where the person in question willingly serves as the model for his synthetic

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28. Corliss, *supra* note 1.

counterpart.<sup>29</sup> But the creation of a synthetic counterpart to a deceased actor is another matter. The reanimator who hopes to resurrect a Paul Muni or a Bette Davis is bound by the public's perception of how that actor looked and sounded, as well as other intangibles that distinguished that actor. The public memory is kept ever fresh by reruns of existing films and sound recordings. To be faithful to the memory of the deceased actor, the reanimator must replicate what the public perceives to be the persona of the actor. It is how the reanimator goes about accomplishing the goal of verisimilitude that raises the copyright issue.

To create the synthetic replica of a deceased actor, it will be necessary to reconstruct the actor's static characteristics such as height, weight, chest measurement, facial and hair features, and the actor's dynamic characteristics including mannerisms, gait, voice, and emotional range. One's physiognomy and other physical attributes are not copyrightable,<sup>30</sup> nor, for that matter, is one's voice.<sup>31</sup> Were the actor alive, the reanimator would be "free to copy the original," in the oft-repeated pronouncement of Justice Holmes in *Bleistein v. Donaldson Lithographing Co.*<sup>32</sup> But the actor is not alive to be "copied" and therein lies the problem. Although one could speculate that reanimation technology will be developed that in no way would implicate existing works featuring the deceased actor, such as a still photo, motion picture, or sound recording, it seems improbable that a reanimator could recreate a Paul Muni or Bette Davis without reference to existing works.

As will be discussed, torso and limb dimensions can be digitally replicated without using pre-existing visual works for more than general observation. However, to create a three-dimensional digital model of a deceased actor's head and facial features with current video-imaging technology will require reference to existing still photos and/or motion picture frames. Re-creation of the actor's voice will require reference to sound recordings or sound tracks of motion pictures.<sup>33</sup> Synthesizing the

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29. If a living actor were synthesized without his permission using data extracted from films, photographs and sound recordings, the actor would have a right of privacy/publicity claim in virtually every jurisdiction. See *RESTATEMENT (SECOND) OF TORTS* § 652C (1977).

30. "Courts treat the [human] model's appearance as unprotected subject matter." Paul Goldstein, II *COPYRIGHT PRINCIPLES, LAW & PRACTICE* 66 (1989). Note that an individual's appearance and voice are not totally without legal protection, for the rights of privacy and publicity and allied rights give the individual a degree of control over these elements of the persona. See *infra* part IV B.

31. "A voice is not copyrightable. The sounds are not 'fixed.'" *Midler v. Ford Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988), *cert. denied*, 112 S.Ct. 1513 (1992).

32. 188 U.S. 239, 249 (1903).

33. It is likely that impressionists may be employed in early re-animation films, but, at some point, computer synthesis should become a reality. Whether the late actor's voice is replicated by a human mimic or by a computer model of the actor's voice, reference to



actor's emotional range, including voice, will require reference to motion picture *performance*, not mere *display*. To the extent that the reanimator relies on photographs or motion pictures in the public domain,<sup>34</sup> or is either the owner of the copyright or a licensee authorized to make use of the work for reanimation purposes, copyright is not an issue. But where the reanimator chooses to rely on a presently copyrighted work to aid in the reconstruction of the deceased actor and does not, or is unable to, acquire a license from the copyright owner, the reanimator will have to demonstrate either that his reanimation in no way implicates any of the rights of a copyright owner or that his use is privileged under the "fair use" rubric. The best strategy of the reanimator would be to demonstrate that no right of the copyright owner has been invaded, thus avoiding a problematic fair use defense.

The owner of a copyright is granted the exclusive right of reproduction,<sup>35</sup> distribution,<sup>36</sup> public performance,<sup>37</sup> and display of the work,<sup>38</sup> as well as the right to create a derivative work incorporating in whole or in part the underlying copyrighted work.<sup>39</sup> If the reanimator does not exploit any of these rights in recreating the deceased actor, then no infringement can be successfully claimed. Each of these rights will be examined in the context of possible exploitation by the reanimator.

## B. Reproduction Rights

### 1. *STATIC VISUAL SYNTHESIS: THE PHYSIOGNOMY AND OTHER DIMENSIONAL CHARACTERISTICS*

Audiences use only two senses when receiving the information contained in a motion picture—sight and sound. Holographic images, smell, taste, and even tactile sensation may eventually become part of film entertainment, but that is left to discussion on another day. Though filmed only in two dimensions, the actor is three-dimensional. While the reanimator need only recreate the actor visually in two dimensions in any single frame of a motion picture, he will want to avoid the labor-intensive techniques of cel by cel animation and will opt to create a three-dimensional, programmable computer model of the actor. In order to

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sound recordings or film soundtrack recorded during the lifetime of the actor seems unavoidable.

34. Even if the film is in the public domain, post-mortem right of publicity issues lurk. See discussion *infra* part IV.

35. 17 U.S.C. § 106(1) (1988).

36. *Id.* § 106(3).

37. *Id.* § 106(4).

38. *Id.* § 106(5).

39. *Id.* § 106(2).

recreate a three-dimensional computer model of the actor, the reanimator will study pictures, either stills or frames from motion pictures, of different perspectives of the actor. For example, in creating a synthetic Elvis, the computer animators began "by buying two books about Elvis' life with several photographs."<sup>40</sup>

A number of current video-imaging techniques, all involving photographic reference material, may be used to recreate the physiognomy of the deceased actor. One technique, photogrammetry, compares common points in two photographs taken at different angles in order to calculate a three-dimensional coordinate of the point.<sup>41</sup> Another technique involves sculpting a bust of the late actor in a physical medium such as clay by referencing various photographs of the actor. The three-dimensional bust is then gridded and a computer input device optically scans the physical model to create a three-dimensional digital model in the computer.<sup>42</sup> The third method involves direct computer sculpting where the animator studies the photographs and "sculpts" the computer model using two computer input devices: a six-degree of freedom interactive input device for spatially orienting the digital "bust" and a two-degree of freedom input device to do the sculpting.<sup>43</sup> Each of these techniques will be analyzed in a copyright context.

Beginning with *Burrow-Giles Lithographic Co. v. Sarony*,<sup>44</sup> photographs of human subjects have been protected by copyright. Copying of a copyrighted photograph, whether by lithographic reproduction,<sup>45</sup> a similarly posed photograph,<sup>46</sup> a sketch,<sup>47</sup> or sculpture,<sup>48</sup> has been held to infringe the copyright. But copyright protection extends only to the copyrightable elements of the photograph. The human subject itself is not copyrightable.<sup>49</sup>

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40. Paouri et al., *supra* note 16, at 94.

41. For a discussion of photogrammetry, see *id.* See also ISAAC KERLOW & JUDSON ROSEBUSH, *COMPUTER GRAPHICS FOR DESIGNERS & ARTISTS* 152, 158, 162, 163 (1986).

42. See Paouri et al., *supra* note 16 at 90

43. See *id.* at 93; LeBlanc *supra* note 16.

44. 111 U.S. 53 (1884).

45. *Id.*

46. *Gross v. Seligman*, 212 F. 930, 931-32 (2d Cir. 1914).

47. *Time, Inc. v. Bernard Geis Assocs.*, 293 F. Supp. 130 (S.D.N.Y. 1968) (but for a fair use defense, sketches copied from frames of the Zapruder film of President Kennedy's assassination would have been an infringement.)

48. *Rogers v. Koons*, 960 F.2d 301, 307 (2d Cir. 1992), *cert. denied*, 113 S.Ct. 365.

49. In *Remco Indus., Inc. v. Goldberger Doll Mfg. Co.*, 141 U.S.P.Q. 898, 899 (E.D.N.Y. 1964), the court enjoined the defendant not only from copying the plaintiff's copyrighted dolls depicting the Beatles, but further enjoined copying the *original*, the actual features of the Beatles. Professor Nimmer criticized the injunction as it related to copying the *original*: "[Copying the original] might constitute an invasion of privacy or of a right of publicity of the Beatles themselves, but can hardly amount to an infringement of plaintiff's copyright."

So what, then, is it that is protectable? In Sarony's photograph of Oscar Wilde, it was "posing the said Oscar Wilde in front of the camera, selecting and arranging the costume, draperies, and other various accessories in said photograph arranging the subject so as to present graceful outlines, arranging and disposing the light and shade, [and] suggesting and evoking the desired expression."<sup>50</sup> In a photograph of a nude model,<sup>51</sup> it was "the pose, light and shade."<sup>52</sup> And Zapruder's historically significant film of President Kennedy's assassination was protectable because "Zapruder selected the kind of camera (movies not snapshot), the kind of film (color), the kind of lens (telephoto), the area in which the pictures were taken, the time they were to be taken, and (after testing several sites) the spot on which the camera would be operated."<sup>53</sup> As long as the animator does not appropriate any of the protectable elements of the photographs or motion picture frames, or if, at least, there is no substantial similarity with respect to *protected* elements of the reference works, there is no infringement.

As long as the reanimator uses photogrammetric techniques, he is not attempting to replicate the costuming, pose, lighting, shade, or other protectable elements; rather he is acting much as an anthropologist with a set of calipers, measuring the dimensions of the subject. By comparing identical points on the surface of the actor's face as portrayed in two photographs taken at different angles, the reanimator is able, with the aid of the computer, to establish a three-dimensional coordinate of the point. He can also establish three-dimensional coordinates of the other points which make up the surface of the subject's face and head. If nothing more than these reference points are used, then it would be stretching to suggest that a protectable element of the photographs had been appropriated since the pose as such was not copied nor would costume, light, shade, or other elements be appropriated. The most that could be said is that the respective *angles* of the reference photos were used in the calculation of the three-dimensional coordinates of a particular point on the surface of the actor's face.

If, however, the photographs *as a whole* are input through an optical scanning device to facilitate the three-dimensional modeling, then the issue of copying arises. In its Final Report, the National Commission on New Technological Uses of Copyrighted Works stated, "The 1976 Act,

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MELVILLE B. NIMMER & DAVID N. NIMMER, 2 NIMMER ON COPYRIGHT § 8.01[C] n. 34, at 8-18 (1992) (hereinafter "Nimmer"). Given Justice Holmes' now-hoary maxim that one is "free to copy the original," Nimmer's observation is clearly the correct exposition of the law.

50. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53,60 (1884).

51. *Gross v. Seligman*, 212 F. 930 (2d Cir. 1914).

52. *Id.* at 931.

53. *Time, Inc. v. Bernard Geis Assocs.*, 293 F. Supp. 130, 143 (S.D.N.Y. 1968).

without change, makes it clear that the placement of any copyrighted work into a computer is the preparation of a copy."<sup>54</sup> The enactment of the "Computer Software Act of 1980",<sup>55</sup> according to Professor Nimmer, made it "clear that computer input constitutes the making of a 'copy.'"<sup>56</sup>

The courts in three cases have held that inputting data into a computer is copying.<sup>57</sup> It might be argued, however, that not every *input* of data is necessarily a *copy*.<sup>58</sup> In *Rand McNally & Co. v. Fleet Management Systems*, *West Publishing v. Mead Data Central*, and *Bellsouth Advertising and Publishing Corp. v. Donnelly Information Publishing*, the data that was input was retained in memory on a long term and not merely transient basis; the data could be "perceived, reproduced or otherwise communicated"<sup>59</sup> by the defendant's computer software/hardware; and finally, the *data output* was substantially similar to the *data input*.<sup>60</sup> Before concluding that the input of data to a computer is the preparation of a copy, three questions need to be addressed. Was the data in computer memory

54. FINAL REPORT OF THE NATIONAL COMMISSION ON NEW TECHNOLOGICAL USES OF COPYRIGHTED WORKS 12 (JULY 31, 1978).

55. Pub. L. No. 96-517, 94 Stat. 3015, 3028 (December 12, 1980).

56. 2 NIMMER, *supra* note 49, § 8.08, at 8-105 & n.4.

57. *Bellsouth Advertising & Pub. Corp. v. Donnelly Inf. Publishing*, 933 F.2d 952, 958 (11th Cir. 1991), *opinion vacated*, 977 F.2d 1435 (11th Cir. 1992); *West Publishing Co. v. Mead Data Central*, 799 F.2d 1219, 1227 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070 (1987); *Rand McNally & Co. v. Fleet Management Systems*, 600 F. Supp. 933, 943 (N.D. Ill. 1984).

58. In the context of this discussion, I distinguish between the input of data as opposed to the input of the computer programs (software) that operate on data. Decisions dealing with software copying include *Tandy Corp. v. Personal Micro Computers*, 524 F. Supp. 171 (N.D. Cal. 1981); *Bly v. Banbury Books* 638 F. Supp. 983 (E.D. Pa. 1986).

59. 17 U.S.C. § 101 (1988) ("copies").

60. In *Rand McNally*, 600 F. Supp. at 943, mileage data taken from plaintiff's "Standard Highway Mileage Guide" were input by defendant into a computer data base, albeit in a rearranged format. The data input was "fixed" in that it was stored in digital form and sold in a computerized format. Although the data was rearranged, there was substantial similarity in gross between the input, the plaintiff's data, and the output, defendant's "Compu. Guide." Finally, the computer data in the "Compu. Guide" could be perceived with the aid of a machine.

In *West Publishing*, 799 F.2d 1219, 1227 (8th Cir. 1986), Mead Data Central (MDC) planned to include West's National Reporter system pagination in LEXIS, MDC's computer-assisted, on-line research service. This feature, called "star-pagination" would provide "jump-cites" to the West Reporter System. The data input would be permanently stored in LEXIS. The output data would be identical to the input data, *i.e.*, the pagination. And the data would be output on a video screen and/or printer.

In *Bellsouth*, 933 F.2d 952, 958 (11th Cir. 1991), the court found that the work was "fixed" because it was stored on magnetic tape. And, although the arrangement of the defendant's sales lead sheets was different from the plaintiff's phone directory, the court held that the lead sheets had nonetheless appropriated the coordination of informational components derived from the plaintiff's work and that the appropriation was substantial, *i.e.*, the output was substantially similar to the input. Finally, the infringing data stored in the computer could be read on a computer monitor screen and was ultimately output in hard copy.

"fixed"?<sup>61</sup> Was the output substantially similar to the input?<sup>62</sup> Finally, was the data, once input, perceivable with the aid of a machine or device?<sup>63</sup> The input of the entire picture necessarily implicates an *appropriation* of the copyrighted elements of the photographs as well as the unprotected elements. But, it does not follow that such an *appropriation* is a *copying*.

First, to constitute a copy, the copy must be "fixed." To be "fixed" the copy must be "sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated, for a period of more than *transitory duration*."<sup>64</sup> As Nimmer suggests,

the reproduction right is not infringed even if the defendant embodies the plaintiff's work in a material object, unless such embodiment is of more than transitory duration. In order to constitute an infringing copy or phonorecord, the embodiment of the plaintiff's work must be not only tangible (a 'material object'); it must also be of *some permanence*.<sup>65</sup>

The question is what time lapse must occur before a fixation is held to have *some permanence*, to be more than a *transitory time*.

In *Mura v. Columbia Broadcasting System*,<sup>66</sup> the court held that in the *live* broadcast of the *Captain Kangaroo* program, "The evanescent reproduction of a hand puppet on a television screen or on the projected kinescope recording of it is so different in nature from the copyrighted hand puppet that. . . it is not a copy."<sup>67</sup> In reaching its conclusion the court observed, "After 1/15,000 of a second plus the time for the phosphor decay, which is measured in milliseconds, the image disappears and nothing is left."<sup>68</sup> If the input of the photographs is but for a transient period, then the photographs would not be fixed and hence no copy of the protectable elements could be said to have been made although admittedly the non-infringing three-dimensional points would be fixed. However, if the computer analysis requires that the photographs be stored in memory for more than a transient period, then there is a fixation of the photographs, albeit in digital format, and the digital images stored in the computer are not merely substantially similar to, but identical to, the copyrighted photographs. Presumably, however, once the computer completes its three-dimensional analysis, the digital

61. 17 U.S.C. § 101 (1988) (emphasis added) ("fixed").

62. See *supra* note 60.

63. See *supra* note 60.

64. 17 U.S.C. § 101.

65. 2 NIMMER, *supra* note 49, § 8.02(B)(2) (emphasis added).

66. 245 F. Supp. 587, 590 (S.D.N.Y. 1965).

67. *Id.* at 590; see also H.R. REP. NO. 1476, 94th Cong., 2d Sess., at 62 (1976) ("the showing of images on a screen or tube would not be a violation of [reproduction rights]").

68. *Mura*, 245 F. Supp. at 589.

copies of the photographs will be erased from memory and all that will remain is the three-dimensional model of the actor's face and head. Does the fact that the ultimate permanent fixation does not contain protectable elements of the reference photographs and is not, therefore, itself an infringement of the reference photographs immunize the *interim* fixation of those very photographs? In *Walker v. University Books, Inc.*,<sup>69</sup> the court rejected an interim use defense: "[T]he fact that an allegedly infringing copy of a protected work may itself be only an inchoate representation of some final product to be marketed commercially does not in itself negate the possibility of infringement."<sup>70</sup> Similarly, in *Walt Disney Productions v. Filmation Associates*,<sup>71</sup> and *Sega Enterprises Ltd. v. Accolade, Inc.*,<sup>72</sup> the courts rejected a "transitory step" argument of the defendants. However, other case law suggests that as long as the *final product* is not substantially similar to the reference work, interim copying is irrelevant.

In *Walker v. Time-Life Films*,<sup>73</sup> the district court refused to consider the plaintiff's request to compare earlier scripts of defendant's screenplay to plaintiff's book to establish substantial similarity. The court stated that it would "consider[ ] the works as they were presented to the public."<sup>74</sup> On appeal, the Second Circuit stated: "[S]ince we conclude as a matter of law that, even assuming borrowing or copying, no substantial similarity exists between the protectable portions of the *final versions* of the works, any error in exclusion of the early drafts was harmless."<sup>75</sup> And in a Ninth Circuit case, *See v. Durang*,<sup>76</sup> the court stated: "The only discovery plaintiff suggests is the production of early drafts of defendant's play on the theory they might reflect copying from plaintiff's play that was disguised or deleted in later drafts. Copying deleted or so disguised as to be unrecognizable is not copying."<sup>77</sup> The decisions in *Time-Life Films* and *See* might be interpreted as standing for the proposition that interim

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69. 602 F.2d 859 (9th Cir. 1979). Plaintiff Helen Walker was the author of "I Ching Cards" which are designed to aid in the instruction of an ancient Chinese method of fortune telling.

70. *Id.* at 864.

71. 628 F. Supp. 871 (C.D. Cal. 1986).

72. 977 F.2d 1510 (9th Cir. 1992). However, the Ninth Circuit ultimately concluded that the interim copying was a fair use. See *infra* notes 133-154 and accompanying text.

73. 615 F. Supp. 430, 434-35 (S.D.N.Y. 1985), *aff'd*, 784 F.2d 44 (2d. Cir. 1986), cert. denied, 476 U.S. 1159. Plaintiff, Thomas Walker, was the author of "Fort Apache," a non-fictional account of his experiences as a policeman.

74. *Id.* at 434.

75. *Walker*, 784 F.2d at 52 (emphasis added).

76. 711 F.2d 141 (9th Cir. 1983). In *Sega*, the court acknowledged that certain types of interim copying might be lawful. 977 F.2d at 1526.

77. *Id.* at 142.

copying is not actionable if the final product is not itself substantially similar to the reference work.<sup>78</sup>

Assuming that the final product of the reanimator is not substantially similar to the reference work, with respect to the *protectable* elements, the question of whether the interim, computer-stored copy of a reference photograph is an infringement will depend on whether courts adopt the reasoning of *Sega* or the reasoning of *Time-Life Films*. It is likely that long before reanimation of deceased actors becomes a reality, courts will have addressed the "interim copy" issue with respect to the computer manipulation of still photos to create photographic "output" that to the lay observer is not substantially similar to the "input."<sup>79</sup> Presumably, the courts' analysis of whether a photographic output that is not substantially similar in the eyes of the average observer to the input is nonetheless an infringement will provide guidance to reanimators.

However, one aspect of the interim fixation issue may distinguish the reanimation issue from the mere computer manipulation of still photographs. Presumably, the reason still photos are being digitally manipulated is that the "manipulator" desires that the photographic output of the manipulation contain some elements of the original photograph; otherwise, why use it in the first instance? But in the

78. The thoughts of Justice Kaplan, written at the time he was the Royal Professor of Law at Harvard, illuminate the interim copying issue, even though his words were not directed to that particular issue:

So inured have we become to the extension of the monopoly to a large range of so-called derivative works, that we no longer sense the oddity of accepting such an enlargement of copyright while yet intoning the abacadabra of 'idea' and 'expression' . . . . It is not a breach of the copyright of a poem to try to capture its essence in glass sculpture, as artists in that medium recently sought to do. This would be about as free of legal consequences as Hemingway's allegation that he copied his writing style from Cézanne's paintings. Getting to more plausible cases, while a motion picture may be a mere replica of a copyrighted play, and thereby infringe, plays commonly are much altered, and novels even more so, as they are transmuted into motion pictures. It is often thought necessary to make drastic changes of dialogue, action, and other elements in order to keep the picture faithful to the original. But if it is a matter of nice artistic judgment how much change is needed to attain 'sameness' in the new medium, we can anticipate difficulties in deciding what is infringement. It is surely wrong to assume that what Hollywood is content to call a dramatization or screen treatment of a novel or play would necessarily be an infringing copy if not licensed. *The fundamental that 'use' is not the same thing as 'infringement,' that use short of infringement is to be encouraged,* is relevant to these transformation cases.

BENJAMIN KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 56-57 (1967) (emphasis added). The italicized phrase was quoted with approval in *Fortnightly Corp. v. United Artists Television*, 392 U.S. 390, 393 n.8 (1968).

79. The issue of computer manipulation of photographs has been a topic of discussion. See, e.g., Brad Bonnin, *Copyrights & Wrongs*, PUBLISH, Apr. 1990, at 77.

construction of a three-dimensional model of an actor, there is no desire to incorporate the reference photographs in the final product, only a need to acquire dimensional data.

Once the dimensional calculations are made, the digitally stored reference photograph can be wiped from memory. The mere fact that a copy is destroyed does not of itself expurgate an infringement.<sup>80</sup> But, to be a copy there must be a fixation from which the work can be perceived, reproduced or otherwise communicated, either directly or with the aid of a machine or device.<sup>81</sup>

Eventually, the reanimator will be able to develop a computer program that will accept a digital input from an optical scan of the reference photographs and automatically calculate the three-dimensional points from a comparison of the digital data, without the need for any interaction with the reanimator, and therefore without the need to visually display the reference photos. If the software is structured such that any output of the digitally-stored photographs is a proscribed command, and if the digitally stored photographs are automatically wiped from memory after the three-dimensional calculations are made, an argument might be made that the fixation is not, in a definitional sense, a "copy" because the fixation will not be perceivable when the software prohibits such a possibility,

In addition to digitally recreating the actor's physiognomy, it is also necessary to replicate in digital form the actor's torso and limbs. This can be done by making a body cast of a person whose dimensions are similar to that of the late actor, gridding the plaster casting, optically scanning the gridded casting and feeding the digitalized data into the computer<sup>82</sup>. Another method is to place a grid on the person's body directly, as was done in *Terminator 2*, and then to scan the person. Finally, taking a page from *Frankenstein*, digitally stored body parts can be borrowed from other synthetic actors and reshaped appropriately (this approach was used in creating a synthetic Elvis in which Marilyn's legs and arms and Bogie's hands and ears were used).<sup>83</sup> Although some reference to existing photographs or motion picture frames will be necessary, it does not appear that serious copyright issues arise.

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80. A work is "reproduced" if its embodiment in tangible form can be perceived for a period of more than transitory duration. H.R. Rep. No. 1476, *supra* note 67, at 62. So, unless the destruction were to take place before the transitory period elapsed, the infringement would be a *fait accompli*.

81. 17 U.S.C. § 101 (1988).

82. It is also possible to do a *face* cast of a person with features similar to the late actor, grid the casting, optically scan the gridded casting, and input the scan data into the computer. Once the data from the face mask is input, the data points can then be adjusted to more exactly replicate the features of the late actor.

83. Paouri et al., *supra* note 16, at 94-95.



As previously stated, the physiognomy and other physical attributes of an actor are not protected by copyright. If the reanimator's task was limited to the reproduction of a computer-stored, digital "sculpture" of the late actor, his reference to existing works would be only to obtain the physical dimensions of the actor such as height, length of forearm, size and shape of ears, and spacing and shape of eyes. The extraction of such non-copyrightable elements from copyrighted works may not constitute an infringement of the reproduction right, as discussed above. However, the reanimator seeks to do more than merely pose the actor like one of the whitened, human statues in the Wallace Circus in *Bleistein*. The reanimator seeks to resurrect the actor to *act*.

## 2. DYNAMIC VISUAL SYNTHESIS: EMOTION, VOICE-IMAGE SYNCHRONIZATION AND LOCOMOTION

Acting involves doing, or at least realistically simulating, the full range of human activity. The synthetic actor must appear to do what a living actor would be required to do in the same role, both visually and vocally. A great deal of research is being devoted to the dynamic aspects of the synthetic actor, from such purely physical activities as walking<sup>84</sup> and grasping objects,<sup>85</sup> to the more sophisticated aspects of acting such as emotion synthesis and voice-expression synchopy.<sup>86</sup>

Activities such as walking, running, grasping, and hitting can be synthesized today by employing techniques which require a human "stand-in" to perform the necessary activities. One technique utilizes a grid which is painted on the person and a digital-video camera to record the data for use in the computer-animation process. Another technique involves the use of a body suit with built-in sensors that detect the relative position of various body components such as spine, hand, and arm. The sensed data is then input into the computer. Eventually researchers will develop the ability to create realistic synthetic actors capable of motion without the use of a human stand-in. None of these activities particularly implicate copyright. Where copyright becomes a potential issue is in the "customizing" of the computer-stored image to reflect the idiosyncrasies of a particular deceased actor. To discern the peculiar gait of an actor, such as the "rolling" walk of a John Wayne, or particular mannerisms, such as the hand gesture of a Jack Benny, would require study of film of the actor. If the reanimator simply studies the film in order to "fine-tune" the computer model to more accurately reflect the peculiar dynamics of the deceased actor, it would require

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84. See Boulic et al., *supra* note 19.

85. See Jean-Paul Gourret et al., *Simulation of Object and Human Skin Deformations in a Grasping Task*, COMPUTER GRAPHICS, July 1989, at 21.

86. SMILE, *supra* note 18.

extraordinary lego-semantic gymnastics to suggest that something protectable in the motion picture was appropriated. An idiosyncrasy in and of itself is not copyrightable. Were the actor alive, he certainly could not be deprived of walking in a particular way or gesturing in a certain manner simply because he had once done so in a motion picture still protected by copyright. His idiosyncrasies are part of the tools of his trade, to be employed more than once, not unlike the author who reuses a main character in subsequent novels.<sup>87</sup> Thus, if all that is appropriated from a study of the reference motion pictures are the dynamics of an actor's idiosyncrasies, there is no infringement.

In Western drama, the most significant "acting" involves facial animation and verbalization. While emotional state may be signaled by gesture or body language, the face is the truest mirror of emotion. Also, facial expression and head movement may serve as a substitute for words: the nod of the head, the quizzical arch of eyebrow, the sneer of contempt. The muscles that animate the face are common to all humans: the occipito frontalis that raises the eyebrow, the zygomaticus major that raises the corner of the mouth, and the orbicularis that purses the mouth. These muscles are employed in reflecting emotions common to all humankind such as anger, disgust, fear, happiness, sadness, and surprise.<sup>88</sup> Research into emotion synthesis and the problems of lip-phoneme<sup>89</sup> synchronization, as well as other aspects of facial expression, is underway in a number of institutions.<sup>90</sup> Eventually, synthetic actors will be created that will be capable of realistic *generic* facial expression and emotional response. Because the muscles that animate the face are common to all humans and because emotions such as anger and surprise are common to all humankind, a generic model provides a general solution to facial animation. Paradoxically, however, an individual's uniqueness is particularly evident in that person's face. Thus the reanimator will need to create a synthetic actor capable not merely of *generic* emotional response but rather one that reflects a particular deceased actor's facial expression and emotional response. To capture the anger of a Lee J. Cobb, the haughty sneer of a Charles Laughton, the derring-do smile of an Errol Flynn, or the sultry look of a Marlene Dietrich requires more than a generic solution.

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87. See *Warner Bros. Pictures v. Columbia Broadcasting Sys.*, 216 F.2d 945 (9th Cir. 1954), *cert. denied*, 348 U.S. 971 (1955) ("Sam Spade").

88. See P. EKMAN & W. FRIESEN, *FACIAL ACTION CODING SYSTEMS* (1978).

89. See *SMILE*, *supra* note 18.

90. For example, M.I.T., University of Pennsylvania, University of Montreal, University of Toronto, University of Geneva, University of Paris, and the Swiss Federal Institute of Technology, to name but a few.

Emotion has been defined as "the evolution of the human face over time: it is a sequence of expressions with various durations and intensities."<sup>91</sup> Still photos will yield information on a particular expression, such as surprise or fear. But individual still photos do not reflect the fourth dimension, time. Motion pictures capture time by the linear distance a particular frame is from the initial frame. So, it is to motion pictures that the reanimator must refer to capture emotion and other facial animation. If—and this may be a big "if"—the reanimator is able to modify generic emotional synthesis and other aspects of facial animation to reflect the nuances of a particular reanimated actor by simply studying a performance of the film,<sup>92</sup> then the reproduction of these facial movements in the dynamic modeling does not copy the reference film, unless an actor's filmed facial movements are copyrightable elements per se, even though these dynamic characteristics are fixed in computer memory and even though they are capable of being perceived, reproduced, or otherwise communicated.

It is possible that future algorithms will be developed whereby a film can be optically scanned to "recognize" emotional and other facial animation which can be input to the computer to create the dynamic model of the late actor.<sup>93</sup> This approach raises potential copyright issues. The ability to portray emotions is part of an actor's stock in trade. Clearly, the actor who displays anger in one film cannot be precluded by copyright law from displaying that same anger in another film—copyright law is not so all encompassing.<sup>94</sup> That said, the *expression* in the film is comprised, in part, of the emotional responses of the actors. Thus, the issue becomes whether an actor's emotional response in a particular film is separable from the expression of the film or whether it is

91. *SMILE*, *supra* note 18.

92. Performance rights and re-animation are discussed in Performance Rights, part II E.

93. See, e.g., *Techniques for Realistic Facial Modeling*, *supra* note 16.

94. One might liken the actor to an artist. As was said in *Franklin Mint Corp. v. National Wildlife Art Exchange*,

[There is a] tendency of some painters to return to certain basic themes time and time again. Winslow Homer's schoolboys, Monet's facade of Rouen Cathedral, and Bingham's flatboat characters were cited. Franklin Mint relied upon these examples of 'variations on a theme' as appropriate examples of the freedom which must be extended to artists to utilize basic subject matter more than once. National vigorously objects to the use of such a concept as being contrary to the theory of copyright. We do not find the phrase objectionable, however, because a 'variation' probably is not a copy and if a 'theme' is equated with an 'idea,' it may not be monopolized. We conceive of 'variation on a theme,' therefore, as another way of saying that an 'idea' may not be copyrighted and only its 'expression' may be protected.

575 F.2d 62, 66 (3d Cir. 1978), *cert. denied*, 439 U.S. 880:

inextricably linked with that expression. The question seems almost metaphysical. But, if this Gordian copyright knot can be cut by technology and means can be developed whereby the physical manifestations of emotion, the movement of an eyebrow or the motion of the lips and eyes, can be extracted from the film as it is optically scanned without appropriating, at the same time, the *expression* of the film, then no infringement will have occurred. However, it should be noted that if the emotion synthesis techniques should require computer input of a sequence of motion picture frames in order to create the dynamic model of the actor, copyright clearly would be an issue. The copyright analysis of the digital input to synthesize the static characteristics of the actor is equally applicable to the digital input to synthesize facial animation.

### 3. VOICE SYNTHESIS

Despite extensive research in voice synthesis and various current voice synthesis applications, faithful voice synthesis of a particular individual is a remote goal. Early reanimation films likely will use an impressionist to supply the voice for the video image of the deceased actor. Eventually technology that can be used to identify a particular voice should be able to replicate that voice. Whether the voice is provided by an impressionist or by a computer model of the late actor's voice, reference to sound recordings and motion picture sound tracks containing the late actor's voice will be necessary. First, the human voice as such is not copyrightable.<sup>95</sup> Therefore, replicating a human voice in and of itself would not implicate copyright. However, the sound recordings and motion picture sound tracks containing the voice of the actor may well be protected by copyright. The sounds contained in a sound recording are protected only against exact duplication; they are not protected against mere imitation.<sup>96</sup> On the other hand, motion picture sound tracks are protected not only against exact duplication but imitation and simulation as well.<sup>97</sup> Thus, an impressionist's imitation or a computer simulation would in no way violate the copyright in a sound recording whereas there is such a *possibility* with respect to a film sound track. However, I would suggest that the apparent distinction between the scope of protection of a sound recording contained in a phonorecord

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95. See *Midler v. Ford Motor Company*, 849 F.2d 460, 462 (9th Cir. 1988), *cert. denied*, 112 S.Ct. 1513 (1992).

96. 17 U.S.C. § 114(b) (1988). "Mere imitation of a recorded performance would not constitute a copyright infringement even where one performer deliberately sets out to simulate another's performance as exactly as possible." H.R. Rep. No. 1476, *supra* note 67, at 106.

97. "[A] copyrighted work would be infringed by reproducing it in whole or in any substantial part, and by duplicating it exactly or by imitation or simulation." H.R. Rep. No. 1476, *supra* note 67, at 61.

and the scope of protection of a sound track is more illusory than real where reanimation is involved. The typical phonorecord and copy of a motion picture sound track both contain: the sounds themselves and the expression, musical or verbal, that these sounds represent. The phonorecord that contains a sound recording also contains the work, literary or musical, that the sound recording communicates to the auditory senses. The copy of a film sound track also contains sounds and the literary or musical work communicated by these sounds. The impressionist who listens to a phonorecord or the copy of the soundtrack of a film is performing the work(s) involved but does not reproduce it (them) simply by listening. Clearly, imitating the *sounds* heard in the sound recording is not an infringement of the sound recording copyright but that does not answer the question of whether the imitation is an infringement of the copyright in the underlying work contained in a phonorecord: I would suggest that in determining whether an impressionist is infringing depends less on whether he listened to a sound recording or listened to a sound track than on whether he took protectable expression from the literary or musical work contained in the phonorecord or film. Copyright Office regulations state that “[w]ords and short phrases such as names, titles and slogans” are not subject to copyright.<sup>98</sup> On occasion, phrases have been given protection,<sup>99</sup> but it “is inconceivable that anyone could copyright a single word or a commonly used short phrase . . . .”<sup>100</sup> The impressionist’s desire is to replicate the way the deceased actor pronounced phonemes and the words constructed from them. But a phoneme is not an original expression, nor is a word, nor for that matter are most short phrases *original*, unless they contain a high degree of creativity.<sup>101</sup> Assuming the reanimator is

98. 37 C.F.R. § 202.1(a) (1991).

99. See *Universal City Studios v. Kamar Indus.*, 217 U.S.P.Q. 1162 (S.D. Tex. 1982); *Dawn Assocs. v. Links*, 203 U.S.P.Q. 831 (N.D. Ill. 1978); *American Greetings Corp. v. Kleinfab Corp.*, 400 F. Supp. 228 (S.D.N.Y. 1975).

100. *Signo Trading Int’l Ltd. v. Gordon*, 535 F. Supp. 362, 365 (N.D. Cal. 1981); see also *Warner Bros. v. American Broadcasting Co.*, 720 F.2d 231 (2d Cir. 1983); *Alberto-Culver Co. v. Andrea Dumon, Inc.*, 466 F.2d 705 (7th Cir. 1972); *Stratchborneo v. Arc Music Corp.*, 357 F.Supp. 1393 (S.D.N.Y. 1973). But, where the word or phrase is an imaginary invented word, protection *may* possibly be granted. See *Life Music Inc. v. Wonderland Music Co.*, 241 F. Supp. 653 (S.D.N.Y. 1965) (“SUPERCALIFRAGILISTICXPALIDOJUS” versus “SUPERCALIFRAGILISTICXPALIDOCIOUS”). In *Life Music*, the court refused to issue a preliminary injunction because the word was known and used by members of the public for many years prior to the date when the plaintiff published their song. The court did state, “[o]f course, even if defendant copied only ‘the word,’ they conceivably might still be liable for infringement.” *Id.* at 656. See also, *Heim v. Universal Pictures Co.*, 154 F.2d 480, 487 n.8 (2d Cir. 1946) (“There may be wrongful copying, though small quantitatively; so if someone were to copy the words . . . ‘Twas brillig and the slithy toves.’”).

creating new speeches, perhaps with words never spoken by the actor during his lifetime,<sup>102</sup> the reanimator will not have copied the expression of the work contained in the phonorecord or film but at most individual words or common phrases. There is, however, one troubling aspect of the foregoing analysis that is raised by the digital sampling issue and that is: Is there a direct correlation between the quantum of sound appropriated and the quantum of expression appropriated?

Digital sampling has been a topic well ventilated, not only in scholarly works,<sup>103</sup> but in the press as well.<sup>104</sup> The sounds in a sound recording are protected against unlicensed reproduction by the Copyright Act. There is no question that at some level of copying, the appropriation would be held to be substantially similar to the original. The question that remains to be answered is what quantum falls just short of being substantial. In the only case to be fully litigated, *Grand Upright Music Ltd. v. Warner Brothers Records*.<sup>105</sup> (the "BIZ MARKIE" case), the court enjoined the appropriation of three words—"Alone again (naturally)"—and the accompanying notes. Were three words and the music accompanying the words to be the threshold of substantial similarity, the test for substantial similarity with respect to sound recordings would not be significantly more stringent than the test for infringement with respect to other types of works. But, there are those who believe that using even one isolated sound may be an infringement of the sound recording reproduction right.<sup>106</sup> In theory there should be no distinction between the quantum of sound that would be an infringement if appropriated from a motion picture sound track and one appropriated from a sound recording,

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101. "Unless it is 'especially unique or qualitatively important, there is no basis for inferring copying' of a 'small common phrase.'" 3 NIMMER, *supra* note 49, § 13.03[a], at 13-53 n. 115, citing Stratchborneo, 357 F. Supp. 1393.

102. SMILE, *supra* note 18.

103. See, e.g., Gregory Albright, *Digital Sound Sampling and The Copyright Act of 1976: Are Isolated Sounds Protected?*, 38 COPYRIGHT L. SYMP. (ASCAP) 47 (1992); Aaron Keyt, Comment, *An Improved Framework for Music Plagiarism Litigation*, 76 CAL. L. REV. 421 (1988); Bruce McGiverin, Note, *Digital Sound Sampling, Copyright and Publicity: Protecting Against the Electronic Appropriation of Sounds*, 87 COLUM. L. REV. 1723 (1987); Thomas C. Moglovkin, Note, *Original Digital: No More Free Samples*, 64 S. CAL. L. REV. 135 (1990); Note, *A New Spin On Music Sampling: A Case For Fair Pay*, 105 HARV. L. REV. 726 (1992).

104. E.g., David Goldberg & Robert Bernstein, *Music Copyrights and the New Technologies*, N.Y.L.J., Jan. 15, 1988, at 1; Judith Greenberg Finell, *A Musicologist Discusses Disguised Infringement*, N.Y.L.J., May 29, 1992, at 5; Michael Miller, *High-Tech Alteration of Sights and Sounds Divides the Arts World*, WALL ST. J., Sept. 1, 1987, at 1; Stan Soocher, *License to Sample*, NAT'L L. J., Feb. 13, 1989, at 1; Robert Sugarman & Joseph Salvo, *Sampling Litigation In the Limelight*, N.Y.L.J., Mar. 16, 1992, at 1; Robert Sugarman & Joseph Salvo, *Sampling Gives Law a New Mix; Whose Rights?*, NAT'L L. J., Nov. 11, 1991, at 21; Kevin Zimmerman, *Old Is New Again in World of Sampling*, VARIETY, Aug. 1, 1990, at 69.

105. 780 F. Supp. 182 (S.D. N.Y. 1991).

106. See, e.g., Albright, *supra* note 103.

although, the focus of digital sampling claims has been on music sound recordings. And in theory, it should not matter that the sound, rather than being a musical one, such as a trumpet note, a drum beat, or a high C by Pavarotti,<sup>107</sup> is one phoneme in a series of phonemes comprising a word spoken by an actor. If the above logic is adopted, not only could one not take Rhatt's "Frankly, my dear" from the soundtrack of *Gone With The Wind*,<sup>108</sup> but one could not take "Frankly" or even the first phoneme "f" of "Frankly". If this is to be the interpretation of sound protection, then one potential method of voice synthesis would probably die aborning. Although it may well not be an effective method of voice synthesis, one procedure might be to build a catalogue of phonemes for a particular actor using existing sound recordings and soundtracks. This system may be impractical because phonemes depend in part on the character of the phoneme preceding and following a given phoneme. But if such a system were to be pursued, digital sampling law may prove a barrier to unlicensed phoneme reproduction. Putting aside the phoneme copying issue, does the single-sound theory create a problem where there is no direct copying but merely imitation or simulation? Of course, with respect to a sound recording, imitation or simulation of the sounds is not an infringement; as previously discussed, the only infringement that could conceivably occur in relation to a sound recording would be with respect to the underlying musical or literary work that is fixed in the phonorecord simultaneously with the sound recording and which the sound recording makes audible. However, imitation or simulation can be an infringement of the sound track of a motion picture. Assuming, for the moment, that a phoneme which is *duplicated* from a sound recording or a sound track is an infringement of the reproduction right, should it follow that the *imitation* or *simulation* of a phoneme or even a word from a film soundtrack should also be an infringement? I believe the answer is no.

The rationale for protecting an isolated sound against reproduction is that it is unique to the artist and perhaps even unique to one particular performance of the artist, be it a trumpet note of a Miles Davis or the high C of a Pavarotti. To the extent the trumpet note or high C can be imitated or synthetically created, as opposed to reproduced, it is not unique. Protection against imitation, and even synthesis, is better left to the right of publicity, if it is to be protected at all. The sound recording provision was aimed principally at outright piracy; it filled a gap in the law where, theretofore, relying solely on a compulsory mechanical license for the song, pirates were free to reproduce the sounds contained in a music

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107. "Most would agree that Pavarotti's performance of even a single note embodies a sufficient modicum of creativity." *Id.* at 66.

108. (MGM 1939).

phonorecord. It is arguably a distortion of the intent of the copyright law, which requires some *de minimis* threshold of originality, and of the rationale for the enactment of the sound recording provision itself to say that *copyright* law should hold that the appropriation of a single sound is an infringement.<sup>109</sup> But to go further and to hold that *copyright* law should prohibit the imitation or electronic synthesis of a sound, where that sound is connected with, and makes audible, but a part of one word, would be to render meaningless the concept of *originality*. It would elevate the importance of the sense of hearing to a state far more grandiose than the sense of sight: no single word, not even a short common phrase is copyrightable simply because it is in *printed* form. Even if courts protect single sounds against duplication, they will not, or at least should not, protect single sounds against imitation or synthesis.

### C. Derivative Work Rights

In order to generate a "three-dimensional" model of a deceased actor, I have assumed, for purposes of copyright analysis, that it would be necessary to refer to copyrighted two-dimensional pictures — still photographs or, more likely, individual frames from one or more motion pictures. One might conclude that the ultimate computer-stored, three-dimensional model is *derived* from the various two-dimensional still photo and motion picture frames. But, that conclusion does not necessarily result in the three-dimensional model being a *derivative work* in the copyright sense of that term. Section 101 of the Copyright Act defines a "derivative work" as "a work *based upon* one or more *preexisting works* . . ."<sup>110</sup> Nimmer has suggested that "the term derivative work in a technical sense does not refer to all works which borrow in any degree from pre-existing works. A work is not derivative unless it has *substantially copied* from a prior work."<sup>111</sup> He goes on to state, "If that which is borrowed consists merely of ideas and not the expression of ideas, then although the work may have in part been derived from prior works, it is not a derivative work."<sup>112</sup> What this suggests is that if what is appropriated from a copyrighted work is an uncopyrightable element, then there is no *substantial copying* in a copyright sense. The physical features of a deceased actor are akin to ideas in that neither are copyrightable. Thus, the reanimator will argue that in creating the three-

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109. "[I]nfringement takes place whenever all or any *substantial portion of the actual sounds* that go to make up a copyrighted sound recording are reproduced in phonorecords by repressing, transcribing, recapturing off the air, or any other method . . ." H.R. Rep. No. 1476, *supra* note 67, at 106 (emphasis added).

110. 17 U.S.C. § 101 (1988) (emphasis added) ("derivative work")

111. 1 NIMMER, *supra* note 49, § 3.01, at 3-3.

112. *Id.* (footnotes omitted).



dimensional computer model he has not copied a protectable element of the copyright owner's work. If the reanimator has not violated the reproduction right in creating the three-dimensional model, as discussed above, then perforce, he will not have violated the adaptation right. Furthermore, even if interim copying were found, there would still not be an infringement of the derivative work right if the protectable elements of the interim copying were not incorporated into the final computer model of the actor. However, if a court were to conclude that, in producing the three-dimensional computer model of the deceased actor, the reanimator infringed the copyright in the works of others, it would be no defense that the reanimator had created a three-dimensional work, albeit in digital format, and that the copyrighted works were two-dimensional.<sup>113</sup>

#### D. Distribution Rights

Little need be said with respect to the distribution rights provided by the Copyright Act.<sup>114</sup> The reanimated actor is being created to act in films that will be sold or rented. But, if the reanimated actor is not substantially similar to *protectable* elements of the photographs, motion pictures and sound recordings used as reference works, then no distribution rights in the reference photographs, motion pictures and sound recordings would have been infringed by the distribution of the reanimator's film. It should be noted that, even if interim copying has been found, as discussed in "Reproduction Rights," above, it would still not be an infringement of the distribution right as long as the protectable elements of the interim copying were not incorporated into the final computer model of the actor.

#### E. Performance Rights

Regardless of the specific details of how the digital resurrection of deceased performers will be accomplished, it is likely that the reanimator will make reference to existing motion pictures and sound recordings featuring the actor in question. However, in his reference to a copyrighted motion picture or sound recording, the reanimator must not violate § 106(4) of the Copyright Act, the public performance right. Absent a license, the reanimator must avoid publicly performing the reference motion picture or sound recording. To "perform" a motion picture is "to show its images in any sequence or to make the sounds

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113. See *Fleischer Studios v. Ralph A. Freundlich, Inc.*, 73 F.2d 276, 278 (2d Cir. 1934), *cert. denied*, 294 U.S. 717 (1935); *King Features Syndicate v. Fleischer*, 299 F. 533, 538 (2d Cir. 1924).

114. 17 U.S.C. § 106(3) (1988).

accompanying it audible."<sup>115</sup> Thus if the reanimator does not show the images in some sequence, he has not *performed* the motion picture although he may be said to have *displayed* a particular frame, an issue discussed below. Even if the reanimator performs a motion picture or a sound recording, he will not be in violation of § 106(4) if the performance is not *public* but, rather, *private*. To perform a motion picture or sound recording "publicly" is "to perform . . . at a place open to the public or at any place where a substantial number of persons outside of a normal circle of a family and its social acquaintances is gathered."<sup>116</sup> Presumably the performance would be on the business premises of the reanimator and only employees involved in the reanimation would be present at the performance. Obviously, proprietary concerns would dictate that the premises of the reanimator would be a place not open to the public. More troublesome is the second leg of the public performance test: "any place where a substantial number of persons outside of a normal circle of friends is gathered."<sup>117</sup> In its interpretation of "substantial number," the House Committee on the Judiciary stated that "Routine meetings of businesses . . . would be excluded because they do not represent the gathering of a 'substantial number of persons.'"<sup>118</sup> Thus, *performance* on the business premises of the reanimator, witnessed only by employees of the reanimator, would not be public, and thus would not violate § 106(4) of the Copyright Act. It may well be that in order to analyze a motion picture or sound recording for purposes of constructing the three-dimensional computer model of the deceased actor, it will be necessary to input the motion picture or sound recording in digital format into a computer. Would the input into the computer be itself a performance, public or otherwise? Nimmer believes that "the mere act of input into a computer or other retrieval system would not appear to be a performance."<sup>119</sup> Even if Nimmer is wrong, and computer input is held a performance, as long as the input is not *public*, there is still no violation of § 106(4). Of course, the question of whether the input is a copy must be addressed.<sup>120</sup> In any event, it does not appear that the reanimator need concern himself with respect to the public performance issue.

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115. *Id.* § 101 ("perform"). For example, a re-animator might "perform" a motion picture by projecting a segment of it, frame-by-frame, onto a gridded screen to measure incremental upper and lower lip displacement of a Marilyn Monroe smile in order to create parameters for the MM software.

116. *Id.* § 101.

117. *Id.*

118. H.R. Rep. No. 1476, *supra* note 67, at 64.

119. 2 NIMMER, *supra* note 49, § 8.14[b], at 8-168.

120. See *supra* part II B (Reproduction Rights).

The above discussion has focused on the performance of a motion picture or sound recording during the reanimation process itself. Once the computer model of the deceased actor has been constructed, the actor will be utilized in one or more motion pictures that are intended for public performance. The mere fact the "same" actor appears in a post-mortem film as appeared in a film produced with that actor when alive would not in and of itself lead to a conclusion of substantial similarity. First of all, the actor is not a copyrightable element. To hold that he were would lead to the obviously absurd conclusion that once an actor appeared in one film, the actor could appear in no subsequent film without license from the copyright owner of the first film.<sup>121</sup> The test of substantial similarity would have to be based on criteria other than the identity of the actor.

## F. Display Rights

Section 106 of the Copyright Act grants to the copyright owner the right of public display.<sup>122</sup> The right is severely circumscribed by the fact that the lawful owner of a particular copy has the privilege to publicly display his copy.<sup>123</sup> To "display" a work is to "show a copy of it, either directly or by means of a film, slide, television image, or any other device or process."<sup>124</sup> With respect to motion pictures one must distinguish between a showing that amounts to a *display* and a showing that amounts to a *performance*. A use of a motion picture by a reanimator that constitutes a "performance" is discussed in "Performance Rights" above. The discussion in this section will be limited to the "display" of still photographs and motion pictures. If the reanimator is the owner of a particular copy of a still photo or a motion picture, he has a right to publicly display the work (though with respect to the motion picture he has no right to publicly perform it, *i.e.*, to show the frames in some sequence). And of course, absent a contractual restriction, the reanimator has a right to privately display the work, even if he was a mere lessee of an authorized copy. Assuming that the reanimator owns the particular copy of the photograph or motion picture, he need not concern himself as to whether his display, though limited to company personnel, is public or

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121. For example, in *Gross v. Seligman*, the court did not hold that the photographer could not use the same model that he had previously used, only that he could not use the identical pose. "Of course when the first picture has been produced and copyrighted every other artist is entirely free to form his own conception of the Grace of Youth . . . and to avail of the *same* young woman's services . . ." 212 F. 930, 931 (2d Cir. 1914) (emphasis added).

122. 17 U.S.C. § 106(5).

123. *Id.* § 109(c).

124. *Id.* § 101 ("display").

not (a concern that must be addressed if a motion picture is performed). Thus, in analyzing a photograph or a frame from a motion picture, the reanimator violates no right of the owner of the copyright in the photograph or the motion picture when the reanimator displays the work. Of course, if the reanimator inputs the display into a computer for analysis, the "Reproduction Rights" discussed above, are in issue.

### G. Fair Use

If the computer model of the deceased actor does not itself contain any elements copied from the reference works that are substantially similar to protected elements of the various reference photographs, motion pictures or sound recordings, then mere exploitation by the reanimator of the computer model will not infringe any of the rights of the owners of copyright in the reference works. However, if in creating the final computer model, the reanimator inputs reference works into the computer in order to extract the static and dynamic characteristics of the late actor, the interim copying issue arises. In "Reproduction Rights," I addressed the various factors to be considered in determining whether an input into a computer is a copy, and I also discussed the two divergent judicial views on whether interim copying is or is not an infringement. If a court finds that the input is a copy, and if that court rejects the "interim copy" reasoning of *Time-Life Films*<sup>125</sup> in favor of that of *Sega*,<sup>126</sup> the reanimator will be liable for copyright infringement unless he successfully raises a fair use defense. While fair use determinations are not limited to the four factors enumerated in Section 107 of the Copyright Act, "[n]evertheless, the Section 107 factors do offer some guidelines in the determination of fair use . . ."<sup>127</sup>

The fair use analysis is germane to two stages of reanimation. The first stage involves the research and development that precedes commercial exploitation; the second stage is the actual commercial exploitation of reanimation.

Two of the fair use factors will remain unchanged as reanimation moves from the research stage to commercial exploitation. With respect

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125. See *supra* notes 73-79 and accompanying text.

126. See *supra* notes 72-79 and accompanying text.

127. 3 NIMMER, *supra* note 49, § 13.05[A], at 13-102.43. The four factors specifically addressed in 17 U.S.C. §107 are:

(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work.

to "the nature of the copyrighted work,"<sup>128</sup> the reference works — photographs, motion pictures, and sound recordings — are themselves likely created for commercial exploitation and typically not for non-profit purposes. With respect to "the amount and substantiality of the portion used in relation to the copyrighted work as a whole,"<sup>129</sup> the amount appropriated may vary from an entire work, such as a single still photograph, to relatively small segments, such as several frames from a two-hour film; but the amount appropriated with respect to any given reference work is not likely to vary substantially between the R & D stage and full commercial exploitation. It is in "the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes"<sup>130</sup> and "the effect of the use upon the potential market for or value of the copyrighted work"<sup>131</sup> that a sharp distinction can be drawn between the R & D stage and the commercial exploitation stage.

During the R & D stage, the reanimator will take the position that the use of the copyrighted reference work is for "research," and at least as conducted in universities, non-profit. The position taken by the reanimator will be reminiscent of the arguments put forth during the 1960s with respect to experiments in the computer storage and retrieval of large scale databases.<sup>132</sup> The reanimator will also argue that at the R & D stage, reanimation would have no immediate or near-term effect upon the market for the copyrighted reference works. During the R & D stage of reanimation, I believe that researchers, or at least university researchers, will be able to rely on factors 1 and 4 of fair use to establish that the interim copying is not an infringement.

There is no question that reanimation will be exploited commercially, either by the reanimator producing his own films or by leasing the synthetic actor to other film producers (not unlike the loan-outs during the halcyon days of the Hollywood studio system). At the stage of commercial exploitation, the reanimator can no longer claim non-profit purposes under factor 1, and in fact, is faced with the pronouncement of the U.S. Supreme Court that "every commercial use of copyrighted material is presumptively an unfair exploitation of the

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128. 17 U.S.C. § 107(2).

129. *Id.* § 107(3).

130. *Id.* § 107(1).

131. *Id.* § 107(4).

132. See Joseph J. Beard, *Cybera: The Age of Information*, 19 COPYRIGHT L. SYMP. (ASCAP) 117, 135-136 (1971); Julius Marke, *Copyright Revisited*, 42 WILSON LIB. BULL. 35, 39 (1967). At the time the author wrote this article, he was technical assistant to the Director of Project INTREX (Information Transfer Experiments) at M.I.T. Project INTREX was one of the first experiments in the storage and retrieval of large scale databases.

monopoly privilege that belongs to the owner of the copyright."<sup>133</sup> However, as observed by the Ninth Circuit in *Sega v. Accolade*,<sup>134</sup> "the presumption of unfairness that arises in such cases can be rebutted by the characteristics of a particular commercial use."<sup>135</sup> In *Sega*, the Ninth Circuit noted that in that case "the use at issue was an intermediate one only and thus any commercial 'exploitation' was *indirect* or derivative."<sup>136</sup> The same could be said of the reanimator's interim copying; it was done to extract unprotected data only, arguably an *indirect* use.

In *Sega*, the court also emphasized that *Accolade* had no other alternatives available.<sup>137</sup> With respect to reference films, the same may be true for the reanimator. For the late actor who made but few films, (*e.g.*, James Dean), or for an entity that owns the copyright to a large catalog of films, (*e.g.*, Ted Turner, who owns the MGM library), the ability to preclude the use of such indispensable reference films would confer an unwarranted monopoly. This monopoly would allow the copyright holder to control not only traditional exploitation of the films, as provided in Title 17, but to control reanimation — which is contemplated by neither Congress nor, more importantly, the Constitution. Furthermore, the copyright owner might choose not to reanimate the actor on the theory that he can gain more revenue from the few films made by the late actor, films which may well be "cult classics," as long as no reanimation takes place, than he might gain from the combined revenue of the reanimation films and the old, but now no longer exclusive, films. Thus, as to reference films, and perhaps even as to photographs and sound recordings, the unavailability of a license should be a factor. Finally, in *Sega*, the Ninth Circuit emphasized public benefit considerations:

Public benefit need not be direct or tangible, but may arise because the challenged use serves a public interest . . . . In the case before us, *Accolade's* identification of the functional requirements for Genesis compatibility has led to an increase in the number of independently designed video game programs offered for use with the Genesis console. It is precisely this growth in creative expression, based on the dissemination of other creative works and the unprotected ideas contained in those works, that the Copyright Act was intended to promote . . . . The fact that Genesis-compatible video games are not scholarly works, but works offered for sale on the market, does not alter our judgment in this regard.<sup>138</sup>

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133. *Sony Corp. v. Universal City Studios*, 464 U.S. 417, 451 (1984).

134. 977 F.2d 1510 (9th Cir. 1992).

135. *Id.* at 1522.

136. *Id.* (emphasis added).

137. *Id.* at 1531-1532.

138. *Id.* at 1523.

The public benefit considerations which weighed in favor of Accolade as to factor 1 seem equally applicable to the reanimation. Thus, while it might be a close call, I would suggest that factor 1 would be found in favor of the commercial reanimator.

Factor 2, as applied to the reference works as a whole, is not likely to favor the reanimator, since unlike for the computer program in *Sega*,<sup>139</sup> there is little difficulty in finding a distinction between the idea and the expression in the typical reference photograph, film or sound recording. Thus, it is unlikely that factor 2 will be of any assistance to the reanimator's claim of fair use. But there remains to be considered factor 3, "the amount and substantiality of the portion used in relation to the copyrighted work as a whole,"<sup>140</sup> and factor 4, "the effect of the use upon the potential market for or value of the copyrighted work."<sup>141</sup> The analysis of "the amount and substantiality of the portion used in relation to the copyrighted work as a whole" has primarily focused on the *quantity* of the portion of the work appropriated and/or the *quality* of the portion of the work appropriated.<sup>142</sup> If the reanimator can establish that he did not input the entire reference work, a position perhaps more readily taken with a motion picture than a photograph, he could conceivably demonstrate that he has not appropriated so much by way of quantity or quality that factor 3 should be weighed against him rather than in his favor.<sup>143</sup> However that may be, I believe there should be a third measure of the appropriation — a *temporal* measure.

In *Knickerbocker Toy Co. v. Azrak-Hamway Intern.*,<sup>144</sup> defendant employed a "blister card,"<sup>145</sup> using an illustration of the plaintiff's toy car "Wrist Racer," as a sample to position its art work. The use of the blister

139. "The second statutory factor, the nature of the copyrighted work, reflects the fact that not all copyrighted works are entitled to the same level of protection . . . . Works of fiction receive greater protection than works that have strong factual elements, such as historical or biographical works. . . . Because of the hybrid nature of computer programs, there is no settled standard for identifying what is protected expression and what is unprotected idea in a case involving the alleged infringement of a copyright in computer software."

*Id.* at 1524.

140. 17 U.S.C. § 107(3).

141. *Id.* § 107(4)

142. For a discussion of the amount and substantiality of the portion appropriated see 3 NIMMER, *supra* note 49, § 13.05 [A][3], at 13-102.59.

143. It may well be that, because many photographs of an actor are available, the amount of data copied from any particular photograph, or film for that matter, would either be *de minimis* or at least an amount of such little magnitude and quality that Fair Use factor (3) would clearly favor the re-animator.

144. 668 F.2d 699 (2d Cir. 1982).

145. *Id.* at 701 n. 1 ("A 'blister' card is a cardboard display card on which is printed promotional copy and illustrations of the product. The card is treated to accept a plastic 'blister' in which the product itself is contained for sale at retail.").

card was limited: "a totally different illustration would be used for the production run of the card."<sup>146</sup> The court concurred with the finding of the trial judge that "[the blister card] was only an office copy which was never used."<sup>147</sup> The court held that this interim use fell "squarely within the maxim of *de minimis non curat lex*."<sup>148</sup> In *Knickerbocker*, there was a fixation in a material object, and there was an interim use, but the interim copy was not used in the final product, not unlike the procedure followed by the reanimator. It may be that less use was made of the photograph of the toy car in positioning the art work in *Knickerbocker* than might be made of a reference work in the creation of a three-dimensional computer model of a deceased actor. But, if *Knickerbocker* suggests that "[a] commercial use may be of such limited duration . . . as to justify holding for the defendant under the principle of *de minimis non curat lex*,"<sup>149</sup> perhaps that notion can be extrapolated to "times" that just exceed *de minimis*.

Let me suggest a time continuum that is marked at one end by that use which just exceeds being transient and that is marked at the other end by a copy that is permanent. The *Knickerbocker* case suggests that where the duration of use is so short and the ultimate product does not contain protectable elements of the work "copied," it is not even an issue of fair use; it is an issue with which the court does not even want to concern itself. I would suggest there is *some* duration of fixation which exceeds *de minimis* that would be a "fair use" as measured by time, so long as the copied elements did not appear in the final product. In developing reanimation technology, researchers who find it necessary to make an interim copy would be well-advised to keep the storage in computer memory to the absolute minimum necessary to accomplish data extraction from the reference works (and of course, to limit the quantity or quality copied, if feasible). Finally, as the Ninth Circuit observed in *Sega*, "The fact that an entire work was copied does not, however, preclude a finding a [sic] fair use . . . In fact, where the ultimate (as opposed to direct) use is as limited as it was here, the factor is of very little weight."<sup>150</sup> In reanimation, the ultimate use of the reference work is not merely limited, it is free of any protectable elements of the reference

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146. *Id.* at 702. Most art directors make extensive use of what is called in the Agencies "swipe art." This consists usually of photos and illustrations ripped out of books and magazines and which are cut up (or not) to compose ideas. These dummy ads are used internally to discuss and develop concepts, and to illustrate the idea graphically. Naturally, when the time comes to actually make the shot, the talent, props and location are original.

147. *Id.* at 702.

148. *Id.* at 703.

149. 3 NIMMER, *supra* note 49, § 13.05[A], at 13-102.49 n. 25.3.

150. 977 F.2d at 1526.



works. If the temporal measure of copying is adopted the use might pass muster under factor 3 or, if not, the factor may be given little weight for the reason suggested in *Sega*.

Finally, one must consider whether factor 4 favors the copyright owner or the reanimator. Is there a *potential* for economic harm to the owner of the reference works? With respect to photographs, the fact that a synthetic Charles Laughton appears in a film would not appear to diminish the market for photographs of the genuine article, *i.e.*, Charles Laughton himself. Nor is it likely that the market for sound recordings made by the late actor<sup>151</sup> will in any way be diminished by the fact the synthetic Charles Laughton speaks in a post-mortem film. If there is to be any *significant* adverse effect to reference works, one would think it would be the competition between films starring the synthetic actor and films starring the flesh-and-blood actor during his lifetime. But, if the synthetic actor is in no way substantially similar to the protectable elements of the reference motion picture, then, even if "he" were to contain protectable elements from other films or from photographs or sound recordings, that would be irrelevant to the litigation at hand. To say otherwise would be to conclude that there is a "collective" copyright for works that are not in a "collective work."<sup>152</sup> Therefore, the issue is: does the exploitation of a work that does not contain protectable elements of a reference work but which was created by use of the reference work create a factor 4 problem?

With respect to factor 4 of fair use, Nimmer has opined:

It is only the impact of the use of defendant's work on material which is protected by plaintiff's copyright which need be considered under the factor. Thus, a court need not take into account the adverse impact on the potential market for plaintiff's work by reason of defendant having copied from plaintiff's non-copyrightable factual material.<sup>153</sup>

The synthetic star may prove to be competition for films starring the late actor himself. But, presuming that all that was appropriated from the

151. Laughton, in fact, made several sound recordings including a reading, *Mr. Pickwick's Christmas* (Decca Records 1944).

152. 17 U.S.C. § 101 (1988) ("collective work"). But see *In re Hart*, 83 N.Y.S. 2d 635, 639 (N.Y. Surr. Ct. 1948), where the court suggested that a song writer had *calvacade* rights: "while the assignee of . . . a copyright has interests in the individual composition assigned which must be respected there still remains in the original composer a residual right to forbid or to control the *combined* use of his compositions." *Id.* (emphasis added). Nimmer, in characterizing *Hart* as a "rather startling decision," commented: "This decision, which appears to lack both judicial ancestry and offspring, may have been a somewhat distorted attempt to apply the recognized principle that a grant of small performing rights does not divest the grantor of grand (or dramatic) performing rights in a given musical work." 3 NIMMER, *supra* note 49, § 10.10 [D], 10-90.

153. 3 NIMMER, *supra* note 49, § 13.05 [A], at 13-102.60 n. 34.

reference work was the static and dynamic characteristics of the late actor, which are unprotected as facts, then, assuming Nimmer's position is correct — and I believe that it is — it would appear that no adverse market consequences can be traced to the exploitation of the synthetic actor. Such adverse market consequences, as are present, would be irrelevant to the factor 4 analysis. In *Sega*, the Ninth Circuit, while observing that copying that effectively usurped the market for the copyrighted work by supplanting that work was not a fair use, went on to state, "the same consequences do not . . . attach to a use which simply enables the copier to enter the market for works of the same type as the copied work."<sup>154</sup> This language seems particularly appropriate with respect to the reanimator. Factor 4 is, I believe, clearly in the reanimator's favor.

While perhaps a close call, factor 1 might be found to favor the reanimator. Factor 2 will not favor the reanimator. Depending in part upon the quantity or quality of the portion of the reference work copied and in part on whether a court would agree to entertain a "temporal" criteria in evaluating factor 3, this factor might be found to favor the user. Factor 4 is clearly in the user's favor. The user might also point out that his use is "productive,"<sup>155</sup> rather than "non-productive,"<sup>156</sup> as the "distinction between 'productive' and 'non-productive' uses may be helpful in calibrating the balance"<sup>157</sup> between the interests of the owner and the user. Thus, one might draw the conclusion that even if interim copying would otherwise be an infringement, the reanimator may well be successful in raising a fair use defense.

While the reanimator may be successful in establishing a fair use, he will obviously be better off if he is able to avoid interim copying or, if copying is unavoidable, to limit the duration of the fixation to a time period that a court might find *de minimis*, as in *Knickerbocker*.

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154. 977 F.2d at 1523.

155. A "productive" use is one in which "the copier himself is engaged in creating a work of authorship whereby he adds his own original contribution to that which is copied." 3 NIMMER, *supra* note 49, § 13.05[A], at 13-102.45.

156. See *Russell v. Price*, 612 F.2d 1123, 1127-28 (9th Cir. 1979), *cert. denied*, 466 U.S. 952 (1980) ("[W]hatever place sympathy for the position of creators of derivative works might properly have under the 1909 Copyright Act, the defendants here can take advantage of none, having contributed nothing to the production of the film 'Pygmalion.'").

157. *Sony Corp. v. Universal City Studios*, 464 U.S. 417, 455 n. 40 (1984).

### III. COPYRIGHT/TRADE SECRET PROTECTION FOR THE REANIMATED ACTOR

#### A. Introduction

It is obvious that the creation of a realistic, dynamic replica of a deceased actor will require the expenditure of a great deal of time and money. Will anyone undertake the effort, if some type of protection against unlicensed copying is not available? In Part IV of this article, I discuss the possibility that reanimation is, or at least should be, subject to a post-mortem right of publicity. If reanimation is subject to a post-mortem right of publicity, and if the reanimator is given an *exclusive* license to create and exploit a computer-generated replica of the late actor, that will provide protection against unlicensed exploitation of the reanimation by third parties. But, if the term of the post-mortem right of publicity is of relatively short duration, then the protection of the reanimated actor based on that exclusive license will be equally brief. And one must consider the possibility that the owner of the post-mortem right of publicity might grant only a *non-exclusive* license to the reanimator, whatever the term of the post-mortem right of publicity might be. There is also the possibility that a particular jurisdiction might not have a post-mortem right of publicity, or that even if it did, the right might not encompass reanimation. Finally, one must consider the fact that many elements of the software are likely to be independent of the particular actor being reanimated and to have generic applicability, and therefore would not be subject to a post-mortem right of publicity at all. Thus, one may well conclude that the reanimator requires proprietary protection beyond that which might arise under an exclusive post-mortem right of publicity license. It is likely that the reanimator will look to copyright law and possibly trade secret law for protection of the reanimated actor.

#### B. Copyright Protection

##### 1. ELIGIBILITY

Federal copyright extends to *original* works of authorship.<sup>158</sup> But "*original*, as the term is used in copyright, means only that the work was independently created by the author and that it possesses at least some *minimal* degree of creativity [and that] requisite level of creativity is extremely low."<sup>159</sup> When one considers the various activities an actor

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158. 17 U.S.C. § 102 (1988).

159. *Feist Publications v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282, 1287 (1991).

might be called upon to undertake in a film, it becomes quickly apparent that the computer software that must replicate what the actor did in life will be quite sophisticated. The program must be able to animate the actor to walk, run, sit, point, shake hands, cross his legs, and so on. The synthetic actor must be able to speak in a voice that mimics that of the late actor; the actor's lips must be synchronized to the phonemes that comprise the words being spoken; eye movement must be coordinated with the words spoken. The actor must be capable of the full range of facial expression that reflects fear, surprise, happiness, and so on. With the test in *Feist Publications v. Rural Telephone Service Co.*<sup>160</sup> as a yardstick, it seems beyond peradventure that the reanimation software, including the database of the actor's static/dynamic characteristics, will be copyrightable, as will be the audio-visual output of the software — the reanimated actor. However, while the reanimation software and audio-visual output are sure to be copyrightable, the ultimate question is what will be the *scope* of that protection, *i.e.*, how "thin" will the protection be?

## 2. SCOPE OF PROTECTION

I shall begin this part of the discussion by echoing the caveat of the Second Circuit in *Computer Associates International v. Altai, Inc.*:<sup>161</sup> "We are cognizant that computer technology is a dynamic field which can outpace judicial decision making."<sup>162</sup> Computer technology can easily outpace law review articles as well. A discussion of the scope of protection is problematic because the technology of creating synthetic humans is in an embryonic stage of development, and because the federal courts have not adopted a common analytical approach to the scope of software protection.

A review of human modeling, animation and rendering literature<sup>163</sup> reveals that a variety of techniques are being evaluated with respect to the creation and animation of synthetic human actors. The creators of "Rendez-vous à Montréal" have proposed classifying animation techniques according to a hierarchy of motion control methods ("MCMs"): (1) geometric, (2) physical and (3) behavioral.<sup>164</sup> Geometric techniques were the earliest approach to animation control using successive joint angles to define motion. More sophisticated is the dynamic approach relying on such parameters as mass, moment of inertia and stiffness. The intent of behavioral motion control is to take into

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160. *Id.*

161. 982 F.2d 693 (2d Cir. 1992).

162. *Id.* at 706.

163. See *supra* notes 12-16 and accompanying text.

164. ANIMATION OF SYNTHETIC ACTORS AND 3D INTERACTION 28 (Nadia Magnenat-Thalmann & Daniel Thalmann eds., 1991).

account the fact that “[m]echanics-based motions are too regular, because they do not take into account the personality of the [actor].”<sup>165</sup> Of particular importance in creating a realistic replica of a deceased actor is facial modeling; various facial animation methods are currently under study, including paramitized models, muscle models for facial expressions, and abstract muscle action procedures.<sup>166</sup> Also under study are such matters as “object grasping,” hair rendering and clothing modeling.<sup>167</sup> What is unclear at this juncture is whether one particular approach will ultimately be adopted as the optimum technique for creating a realistic, synthetic human, or whether alternative techniques will compete on more or less equal terms. Presumably, alternate technical approaches to the creation and animation of synthetic actors would lead to somewhat different software structures. One might expect that, with respect to any one particular technical solution to animation, competing software implementing that approach would have certain characteristics in common and that other technical approaches would result in competing software with other general characteristics.<sup>168</sup> To some degree, one might anticipate that, because the end goal is the creation of a realistic replica of a human, the software structures will have some common characteristics at higher levels of abstraction,<sup>169</sup> regardless of the particular technical approach taken to achieve the goal. The above generalizations must then be examined in light of existing judicial approaches to the issue of scope of protection.

It is axiomatic that copyright does not protect an idea but only the expression of that idea. The axiom is easy to state. It is the application of the axiom that is problematic, particularly to computer software.

At the highest level of abstraction, one might state that the idea, or purpose, of reanimation software is to produce a realistic, dynamic,

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165. *Id.* at 18.

166. *See supra* note 16 and accompanying text.

167. *See supra* note 17 and accompanying text.

168. Interview with Dr. Nadia Magnenat-Thalmann, Director, MIRALab Group, University of Geneva, and Dr. Daniel Thalmann, Director Computer Graphics Lab, Swiss Federal Institute of Technology, Lausanne, in Philadelphia, Pa. (March 13, 1993).

169. This Article uses the term ‘level of abstraction’ as defined in *Computer Associates. v. Altai, Inc.*:

As applied to computer programs, the abstractions test will comprise the first step in the examination for substantial similarity. Initially, in a manner that resembles reverse engineering on a theoretical plane, a court should dissect the allegedly copied program’s structure and isolate each level of abstraction contained within it. This process begins with the code and ends with an articulation of the program’s ultimate function. Along the way, it is necessary essentially to retrace and map each of the designer’s steps—in the opposite order in which they were taken during the program’s creation.

982 F.2d 693, 707 (2d Cir. 1992).

audio-visual model of a particular actor. In *Whelan Associates v. Jaslow Dental Laboratory*<sup>170</sup> the Third Circuit concluded:

[T]he line between idea and expression may be drawn with reference to the end sought to be achieved by the work in question. In other words, *the purpose or function of a utilitarian work would be the work's idea, and everything that is not necessary to that purpose or function would be part of the expression of the idea . . . .* Where there are various means of achieving the desired purpose, then the particular means chosen is not necessary to the purpose; hence, there is expression, not idea . . . .<sup>171</sup>

The court in its analysis focused on the structure, sequence, and organization<sup>172</sup>(SSO) in determining whether there was an infringement. In the context of reanimation, one might speculate that whatever technological approach one might take to reanimation, the idea is common to all techniques. But, as between techniques, the SSO might well be different. However, within a given technological approach, one might anticipate that the SSOs would be similar at least at the higher levels of abstraction. The Second Circuit has interpreted *Whelan* as assuming that a computer program has only one idea and that everything else in the program must therefore be protectable expression.<sup>173</sup> However, in fairness to the Third Circuit, the *Whelan* opinion, in dicta, acknowledged the possibility that an *idea* may not only encompass the purpose but also a particular way of accomplishing that purpose:

We do not mean to imply that the idea or purpose behind *every* utilitarian or functional work will be precisely what it accomplishes, and that structure and organization will therefore always be part of the expression of such works. The idea or purpose behind a utilitarian work may be to accomplish a certain function *in a certain way . . .* and the structure or function of a program might be essential to that task.<sup>174</sup>

Thus, even in the Third Circuit, a particular technique for accomplishing the ultimate purpose of the software might be considered part of the idea; if so, to the extent the SSO reflects the technique, it would be considered part of the idea also. However, even if the Third Circuit were to hold, when squarely faced with the issue, that a particular methodology for accomplishing animation is part of the idea, the scope of copyright protection would still be very significant, since under that Circuit's doctrine, everything else would be expression.

170. 797 F.2d 1222 (3d Cir. 1986), *cert. denied*, 479 U.S. 1031 (1987).

171. *Id.* at 1236.

172. *Id.* at 1224.

173. *Computer Assocs. Int'l v. Altai, Inc.*, 982 F.2d 693, 705 (2d Cir. 1992).

174. 797 F.2d at 1238 (emphasis in original).

At the other extreme is the approach the Second Circuit took in *Computer Associates International v. Altai, Inc.*<sup>175</sup> In *Computer Associates*, the court engaged in a three-step process: abstraction, filtration, and comparison. In *Computer Associates*, the court analyzed the software at various levels of abstraction beginning with the object code and ending with an articulation of the program's ultimate function. Once the various levels of abstraction have been determined, the protectable expression is "filtered" from the unprotected. The unprotected portion at a particular level of expression might be deemed so because it is the idea, or is dictated by considerations of efficiency so as to be necessarily incidental to that idea, required by factors external to the program itself (analogized to "scènes à faire") or is in the public domain.<sup>176</sup> Since efficiency would be the goal of any programmer, to treat efficiency as equivalent to an idea under the merger doctrine is clearly a disincentive to a creative programmer though a boon to a competitor (and perhaps, the most dramatic evidence that the Second Circuit approach is too restrictive). Also included as an external factor are the demands of the industry being served. It is likely that reanimated actors will be "directed" from some type of console. Since it is unlikely that the console will be customized to a particular reanimation supplier, the supplier will have to ensure compatibility of his software, including command menus, with the console. In addition, there must also be compatibility with the film producer's software for integrating the reanimated actor into a digitized version of the live action filming. To the extent a reanimator's software is structured to meet these compatibility demands, the software is not protectable expression, at least not in the Second Circuit. One consideration labeled under "External Factors," "widely accepted programming practices within the computer industry,"<sup>177</sup> seems somewhat redundant to the last factor, "elements taken from the public domain,"<sup>178</sup> which includes programming that "if not standard . . . [is] then commonplace in the industry."<sup>179</sup> Following this rigorous — if not

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175. 982 F.2d 693.

176. *Id.* at 707.

177. *Id.* at 710.

178. *Id.*

179. *Id.* (quoting *Brown Bag Software v. Symantec Corp.*, 960 F.2d 1465, 1473 (9th Cir. 1991), *cert. denied*, 113 S. Ct. 198 (1992)). Changing practices in software engineering may significantly affect the similarity of outcomes from all circuits, and make the decisions more predictable. Specifically, "object-oriented" software engineering uses prepackaged data structures, bundled with the code needed to manipulate them ("objects"), and encourages the construction of programs from these building blocks. By representing abstract concepts with appropriate objects, programmers will be able to control how the abstractions test is applied to their code. However, as libraries of objects become more available, the amount of program material filtered may increase too. For an introduction to these concepts, see BRAD J. COX, OBJECT-ORIENTED PROGRAMMING (1987). For a look at

draconian — filtration, the court engaged in a comparison of the defendant's work to the protected "golden nugget" components of the plaintiff's work. As *Whelan* has been criticized for being overly protective of the first-comer, *Computer Associates* has been criticized as not providing adequate protection to a creator.<sup>180</sup>

The Ninth Circuit, home of the extrinsic/intrinsic approach first enunciated in *Sid & Marty Krofft Television Productions v. McDonalds Corp.*,<sup>181</sup> has reformulated the *extrinsic* test "to perpetuate 'analytic dissection' as a tool for comparing not only ideas but also expression."<sup>182</sup> The Ninth Circuit also now apparently applies analytic dissection at the *intrinsic* stage: "Analytic dissection is relevant not only to the copying element of a copyright infringement claim, but also to the claim's ownership element . . . . Thus, where two works are found to be similar without regard to the scope of the copyright in the plaintiff's work . . . the source of the similarity must be identified and a determination made as to whether this source is covered by plaintiff's copyright."<sup>183</sup> While the Second Circuit *first* filters protected from unprotected and *then* compares similarities, it appears that the Ninth Circuit would *first* compare and *then* filter.<sup>184</sup> Whether the Second Circuit or Ninth Circuit approach is less protective of the plaintiff is not clear.<sup>185</sup> Perhaps one can take the Third

future trends, see BRUCE SHRIVER & PETER WEGNER, RESEARCH DIRECTIONS IN OBJECT-ORIENTED PROGRAMMING (1987).

180. *Gates Rubber Co. v. Bando American*, 798 F.Supp. 1499, 1513 (D. Colo. 1992). The Second Circuit, in *Computer Associates*, acknowledged the narrow scope of protection its analysis provides: "If the test we have outlined results in narrowing the scope of protection, as we expect it will, that result flows from applying, in accordance with Congressional intent, long-standing principles of copyright law to computer programs." 982 F.2d at 712.

181. 562 F.2d 1157 (9th Cir. 1977).

182. *Brown Bag Software v. Symantec Corp.*, 960 F.2d 1465, 1475 (9th Cir. 1991), *cert. denied*, 113 S. Ct. 198 (1992).

183. *Id.* at 1476.

184. The court stated:

The Defendants urged this Court to undertake the "sifting" process *before* the substantial similarity test is performed. The Court rejects such an approach on the grounds that it has the real potential to eviscerate the application of the prevailing substantial similarity test as defined by *Whelan* and its progeny, and in return offers little in the way of establishing any more workable alternative.

Any sifting or dissecting of protectable from unprotectable elements before the two-step test is applied (or other considerations associated with this test) would be wholly inconsistent with case law authorities. (emphasis in original).

*Gates Rubber*, 798 F. Supp. 1499, 1516-17.

185. Where there is a substantial degree of similarity of expression between the two works in question and where the plaintiff's work is rich in expressive content, infringement is likely to be found under either the Second or Ninth Circuit analytical approach. Where the degree of similarity between the two works is low and the plaintiff's



and Second Circuits as representing the polar positions with the other circuits falling somewhere along the continuum of scope of protection. While the First Circuit has not provided guidance as specific as that of the Second, Third, and Ninth Circuits, the district court opinion in *Lotus Development Corp. v. Borland International*<sup>186</sup> is an insightful decision, in its discussion of the idea/expression dichotomy in the context of deciding where in the hierarchy of the program structure the infrastructure ceases to be idea and becomes expression.<sup>187</sup> While the *Borland* court concluded

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work contains "threadbare" expression, infringement is not likely to be found under either the Second or Ninth Circuit approach. However, where comparability is low but plaintiff's expressive content is high or where comparability is high but plaintiff's expression is slight, it is unclear whether the Ninth Circuit approach might produce a result different from that of the Second Circuit.

186. 799 F.Supp. 203 (D. Mass. 1992).

187. The court stated:

FIRST, in making the determination of "copyrightability," the decisionmaker must focus upon alternatives that counsel may suggest, or the court may conceive, along the scale from the most generalized conception to the most particularized, and choose some formulation, some conception of the "idea," "system," "process," "procedure," or "method" -- for the purpose of distinguishing between the idea, system, process, procedure, or method and its expression.

One may describe a number of conceptions of the 1-2-3 user interface. A non-exclusive list, commencing with the most abstract and moving toward the particular, includes:

- (1) Lotus 1-2-3 is an electronic spreadsheet.
- (2) It is a menu-driven electronic spreadsheet.
- (3) Its user interface involves a system of menus, each menu consisting of less than a dozen commands, arranged hierarchically, forming a tree in which the main menu is the root/trunk of the tree and submenus branch off from higher menus, each submenu being linked to a higher menu by operation of a command.
- (4) Its user interface involves a system of menus, each menu consisting of less than a dozen commands, arranged hierarchically, forming a tree in which the main menu is the root/trunk of the tree and submenus branch off from higher menus, each submenu being linked to a higher menu by operation of a command, so that all the specific spreadsheet operations available in Lotus 1-2-3 are accessible through the paths of the menu command hierarchy.
- (5) Finally, one may conceive of the interface as that precise set of menu commands selected by Lotus, arranged hierarchically precisely as they appear in 1-2-3. Under this conception, the interface comprises the menu of commands "Worksheet," "Range," "Copy," "Move," "File," "Print," "Graph," "Data," "System," and "Quit," linked by operation of the command "Worksheet" to the menu of commands "Global," "Insert," "Delete," "Column," "Erase," "Titles," "Windows," "Status," and "Page," etc. (The completion of this proposed statement of the

that the rulings made were substantively compatible with, though different in methodology from, the Second Circuit decision in *Computer Associates*, the analytical approach taken in *Borland* is somewhere on the aforementioned continuum; less protective than the Third Circuit in *Whelan* but somewhat more protective than the Second Circuit in *Computer Associates*.

Hopefully, the circuits will reach some uniformity or the Supreme Court or Congress will impose guidelines to insure homogeneity among the circuits before those who create synthetic actors reach the stage of commercial exploitation. While it may be some time before the circuits do come to some common understanding of how to determine scope of protection, there are aspects of reanimation programming that will clearly warrant protection, and strong protection at that. While much of the software will be devoted to paradigmatic solutions to such problems as walking, speaking, smiling or grasping, some activities of the reanimator will be very subjective, varying to the same degree as where two portrait artists might interpret the same human model differently. No two animators in modifying the parameters that are implicated in a smile, or a frown, are likely to do so in an identical manner. Because realism is, to a degree, in the eye of the beholder, two animators each independently

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"idea," listing all of the more than 400 commands for which "etc." stands, would require several dozen more lines of text.)

Borland argues that the appropriate conception of the "idea" of the 1-2-3 interface is the fifth option. If that were the case, of course, there would be no elements of expression in the menu commands and menu command hierarchy and therefore no copyrightable aspects in them.

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To select, at the opposite extreme, the very abstract statement of the idea of 1-2-3 as "an electronic spreadsheet" would be to draw an inappropriately abstract boundary between idea and expression. Thus, I concur in a fundamental principle of the *Computer Associates* opinion and reject the contrary proposition in *Whelan*.

Arguably, my Opinion in the *Paperback* decision, where no sharper focus was essential to the outcome, is consistent with accepting a conception of the idea that falls between the second and third formulations above. See *Paperback*, 740 F.Supp. at 67 (electronic spreadsheet having "menu structure"). In any event, I now explicitly recognize that for decision of the issues now before me the selection of functional operations that the spreadsheet performs must be considered part of the idea of the program. Copyrightability depends on expression distinct from the selection of the set of spreadsheet operations that can be performed.

I conclude that an appropriate conception of the "idea" or "system" of the 1-2-3 interface is the fourth of the five alternative conceptions stated above.

*Id.* at 216-17.

creating a synthetic Marilyn Monroe are likely to have somewhat different perceptions of what a "realistic" replica is.<sup>188</sup> It is this subjectivity that is likely to be given broad protection, whether one espouses the position currently held by the Third Circuit or the Second Circuit.

As discussed in "Trade Secret Protection," below, commercial exploitation, at least initially, will be limited to licensing use in film productions. Thus, the audio-visual output of the reanimation will be available to potential reanimation competition only to the extent the reanimated actor appears in a film. Assuming such films are generally available on pre-recorded videocassettes, a competitor might analyze segments of the film in which the reanimated actor appears in order to acquire such personalized parameters as lip displacement of the synthetic actor during a smile. While I have suggested in Part II of this article that the features and emotional range of the late actor himself are facts, and therefore, not subject to copyright protection, I would also suggest that the characteristics of the reanimated actor are not themselves facts but rather the subjective decision of the reanimator as to what is "realistic," in short, not facts but expression, much as the work of a sculptor or painter is expression. If my conclusion is correct, then any copying of the features, emotions, etc., of the synthetic actor by a competitor would be a copyright infringement unless protected by a fair use defense.

### 3. FAIR USE

From the perspective of the unlicensed user, the concept of fair use is a boon. From the creator's perspective, it is a diminution of the scope of the protection of his work. Thus, in evaluating the scope of protection, the reanimator must not only consider how much of the infrastructure of his reanimation program is unprotectable either because it is the idea rather than the expression, or because the merger doctrine is applicable or because it is equivalent to a *scènes à faire* or is in the public domain, he must also consider the negative impact of the fair use defense on the scope of protection.

If a court, regardless of the analytical scheme it employs, finds a competitor's unlicensed use of a reanimator's software and/or audio-visual output to be a substantially similar copy, the competitor will be liable for copyright infringement unless shielded by a fair use defense. In Part II of this article, I discussed the fair use defense as it related to a reanimator's unlicensed use of copyrighted reference works containing

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188. In the conversation with the Thalmanns, *supra* note 168, Dr. Nadia Magnenat-Thalman remarked that two research associates from different national backgrounds had different perceptions about realistic hair rendering.

the image and/or voice of the late actor. In concluding that the reanimator might be successful in raising a fair use defense, I suggested that factor 1<sup>189</sup> of the fair use defense might be found to favor the reanimator as might factor 3.<sup>190</sup> I also suggested that factor 4<sup>191</sup> would clearly favor the reanimator. While in Part II I concluded that the reanimator might be successful in raising a fair use defense, I do not believe that the competitor who utilizes the reanimator's work will have success with a fair use defense, because factors 1 and 4, which might have favored the reanimator, as discussed above, will not favor the reanimator's competitor.

The competitor's use of the reanimator's work clearly will be for commercial purposes and "every commercial use of copyrighted material is presumptively an unfair exploitation. . . ."<sup>192</sup> While that presumption might be rebutted by evidence that the "commercial 'exploitation' was *indirect* or derivative,"<sup>193</sup> as I argued might be true of the reanimator's copying, the copying by the reanimator's competitor might be said to be *direct*. Thus, factor 1 would likely be found not to favor the competitor. And even if factor 3 might prove to be no more or less favorable to the competitor than to the reanimator, factor 4, which I argued clearly favored the reanimator, would not, I would argue with equal force, favor the competitor who copies the reanimator. What distinguishes the application of factor 4 is that the reanimator will not compete as directly with the creators of reference works as would the copyist who would compete head-to-head with the reanimator using the reanimator's own material. Finally, whereas the original reanimator use might be considered a "productive" one,<sup>194</sup> the competitor's exploitation of the reanimator's work would be "non-productive."<sup>195</sup> Thus, I conclude that the competition will not be persuasive in arguing a fair use defense.

### C. Trade Secret Protection

Although the Second Circuit in *Computer Associates v. Altai Inc.*<sup>196</sup> found no copyright infringement by the defendant, it ordered the

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189. 17 U.S.C. § 107(1) (1988) ("the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes").

190. *Id.* § 107(3) ("the amount and substantiality of the portion used in relation to the copyrighted work as a whole").

191. *Id.* § 107(4) ("the effect of the use upon the potential market for or value of the copyrighted work").

192. *Sony Corp. v. Universal City Studios*, 464 U.S. 417, 451 (1914).

193. *Sega v. Accolade*, 977 F.2d 1510, 1522 (9th Cir. 1992).

194. *See supra* note 155.

195. *See supra* note 156.

196. 982 F.2d 693 (2d Cir. 1992).

district court to consider the plaintiff's trade secret claims. According to one litigator, "Most, if not all intellectual property cases today contain a trade secret allegation."<sup>197</sup> Trade secret claims are not merely of *tactical* value, they are of *strategic* value. The Second Circuit in *Computer Associates*, underscored the significance of a trade secret claim:

Precisely because trade secret doctrine protects the discovery of ideas, processes, and systems which are explicitly precluded from coverage under copyright law, courts and commentators alike consider it a necessary and integral part of the intellectual property protection extended to computer programs.<sup>198</sup>

It is likely that the commercial exploitation of reanimation will evolve much like the film industry itself. The film industry, for most of its existence, did not sell its product but merely licensed exhibition of its product. It is only since the advent of the V.C.R. that the film industry has sold its product on a large scale, in the form of pre-recorded videocassettes. It is likely that, in the early years of commercial exploitation of reanimation software, reanimators will license the software for exploitation by producers of films.<sup>199</sup> While the end product of the software -- the audio visual image of the reanimated actor -- may be sold as part of the film in which he appears, the software itself will not be publicly distributed. The licensing contracts can be drafted with trade secret provisions. Such trade secret provisions should provide a degree of protection against unlicensed copying of even uncopyrightable elements of the software. It must be admitted that to the extent the audio-visual output of the software, *i.e.*, the synthetic actor, as incorporated in a particular film, reveals the software structure, trade secret protection is lost. While it is pure speculation at this point, I would suggest that it is not highly probable that much of what might be secret, but uncopyrightable,<sup>200</sup> in the software would be divulged by the publicly distributed film.

Eventually, commercial reanimation exploitation may be expanded from the mere licensing to a relative handful of motion picture producers to the sale of reanimation software to the mass market, much as videocassettes and game cartridges are sold today. "Arm-chair" producers, equipped with cam-corder, personal computer and

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197. Victoria Slind, *More Trade Secret Wars.*, NAT'L L.J., Mar. 22, 1993, at 1, 34.

198. 982 F.2d at 717.

199. While, it is not yet clear as to how re-animation software might be exploited, it is possible that there may be a bifurcation of the product into a database unique to a particular re-animated actor, licensed by one entity, and animation software suitable for use with any animation database, licensed by another entity.

200. In the discussion of copyright protection, I have suggested that dimensional data that might be extracted from a viewing of a motion picture featuring the re-animated actor would be protected expression.

reanimation software, will be able to create their own films in which they co-star with Humphrey or Marilyn. When reanimation software is available at the retail level, it is likely trade secret protection will be of slim comfort, leaving only copyright, and possibly post-mortem right of publicity, as a means of protecting reanimation software.

#### IV. POST-MORTEM RIGHT OF PUBLICITY

##### A. Introduction

The use of a deceased actor in a post-mortem film raises questions with respect to possible post-mortem — or, it is as more commonly called, descendible — rights of publicity. The history of the right of publicity, and its sibling the right of privacy, has been well documented, beginning with the Warren and Brandeis article in the 1890 *Harvard Law Review*,<sup>201</sup> and will not be repeated here. While virtually all states have some type of right of privacy laws,<sup>202</sup> and while there is a wealth of commentary on the rights of privacy and publicity, the right of publicity is still in search of a separate identity. Is the right a personal right, terminating at death as some jurisdictions have held,<sup>203</sup> or is it a property right, fully assignable and devisable at death, as some other jurisdictions have concluded?<sup>204</sup> To the laws of which jurisdiction will a particular forum look when determining the existence and terms of a post-mortem right of publicity — its own or that of some other jurisdiction? And finally, do such post-mortem rights as do exist apply at all to the post-mortem exploitation of deceased actors in motion pictures? By the time the digital resurrection of deceased actors becomes a *marketable* reality, the right of publicity, and more particularly for our purposes, the post-mortem right of publicity, will in all probability, be more fully developed. However that may be, it is still instructive to consider the current state of the post-mortem right. But, regardless of the outcome of the analysis of the existing state of the post-mortem right of publicity, the question that must ultimately be asked is: “*Should* the reanimation of a deceased actor in a motion picture

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201. Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890).

202. Only Minnesota appears not to recognize a cause of action for invasion of privacy. *Stubbs v. North Memorial Medical Ctr.*, 448 N.W.2d 78 (Minn. Ct. App. 1990).

203. *E.g.*, *Maritote v. Desilu Productions*, 345 F.2d 418 (7th Cir. 1965), *cert. denied* 382 U.S. 883 (Illinois); *Reeves v. United Artists*, 572 F. Supp. 1231 (N.D. Ohio 1983), *aff'd*, 765 F.2d 79 (1985).

204. *E.g.*, *Martin Luther King, Jr., Center for Social Change v. American Heritage Prods.*, 296 S.E.2d 697 (1982) (Georgia); *Elvis Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981).

be subject to the post-mortem right of publicity?" The answer to that question is deferred for the moment.

While most of the states have some type of privacy/publicity laws, statutory or common law, only a relative few states, so far, have specifically addressed the post-mortem right of publicity. Nine states have passed post-mortem right of publicity statutes: California,<sup>205</sup> Florida,<sup>206</sup> Kentucky,<sup>207</sup> Nebraska,<sup>208</sup> Nevada,<sup>209</sup> Oklahoma,<sup>210</sup> Tennessee,<sup>211</sup> Texas<sup>212</sup> and Virginia.<sup>213</sup> The law of four states has been expressly interpreted, either in state or federal court, to include a common law post-mortem right of publicity: Arizona (if exploited during lifetime),<sup>214</sup> Georgia (whether exploited during lifetime or not),<sup>215</sup> New Jersey (if

205. CAL. CIV. CODE § 990 (West 1992). Earlier, in *Lugosi v. Universal Pictures*, 603 P.2d 425 (Cal. 1979), the California court buried the post-mortem right of publicity; however, with the enactment of § 990 by the California legislature, the post-mortem right of publicity, like Lugosi's legendary Dracula, rose from the grave.

206. FLA. STAT. ANN. § 540.08 (West 1988).

207. KY. REV. STAT. ANN. § 391.170 (Michie 1984).

208. NEB. REV. STAT. §§ 20-202, 20-208 (1983).

209. NEV. REV. STAT. § 598.980-988 (1989).

210. OKLA. STAT. ANN. tit. XII, § 1448 (West 1985).

211. Personal Rights Protection Act of 1984, TENN. CODE ANN. § 47-25-1101 to 1105 (1984). Tennessee was schizophrenic, deciding in favor of a descendible right of publicity in *Commerce Union Bank v. Coors*, 7 Media L. Rep. (BNA) 2204 (Tenn. Ct. App. 1981), *aff'd on other grounds*, No. 83-327-II (Tenn. Ct. App. June 20, 1987), and against it in *Lancaster v. Factors*, 9 Media L. Rep. (BNA) 1109 (Tenn. Ch. App. 1982), as did the Court of Appeals for the Sixth Circuit in *Memphis Development Foundation v. Factors Etc., Inc.*, 616 F.2d 956 (6th Cir.), *cert. denied*, 449 U.S. 953 (1980). Finally, the Tennessee legislature stepped in and resolved matters in favor of a post-mortem right of publicity. Not to be outdone by the Tennessee legislature, a Tennessee Court of Appeals held, in *Elvis Presley International Memorial Foundation v. Crowell*, 733 S.W.2d 89 (Tenn. Ct. App. 1987), that, contrary to the opinion of the Sixth Circuit, the right of publicity is descendible under the common law of Tennessee. The Tennessee court rejected the philosophy of the Sixth Circuit in favor of the reasoning of Georgia in *Martin Luther King, Jr.* Based on the decision of the Tennessee court in *Crowell*, the Sixth Circuit, in *Elvis Presley Enterprises v. Elvisly Yours, Inc.* 817 F.2d 104 (6th Cir. 1987) reversed the position it had taken in *Memphis Development*. The Tennessee court did not address the duration issue of the post-mortem right of publicity. The Tennessee post-mortem right of publicity statute would appear to permit perpetual protection of the post-mortem right.

212. TEX. PROP. CODE ANN. § 26.001 - .012 (West 1987).

213. VA. CODE ANN. § 8.01 - .40 (Michie 1984).

214. In Arizona, a federal district court appeared to conclude that, if there were a descendible right of publicity at all in that state, the person would have to have exploited his right of publicity in his name and personality "by assigning the right to use them to another" during his lifetime. *Sinkler v. Goldsmith*, 623 F. Supp. 727, 734 (D. Ariz. 1985).

215. *The Martin Luther King, Jr., Ctr. for Social Change v. American Heritage Prods.*, 296 S.E.2d 697 (Ga. 1982). The Georgia Supreme Court had no problem in finding that there was a common law right of publicity in that state and that it was descendible, a not surprising result given Georgia's early interest in protecting citizens with respect to privacy/publicity issues. See *Pavesich v. New England Life Ins. Co.*, 50 S.E. 68 (Ga. 1905).

exploited during lifetime),<sup>216</sup> and Utah (if exploited during lifetime).<sup>217</sup> Similarly, the law of four states includes the right of publicity as a property right from which one *might* infer, at least tentatively, that the right is descendible: Michigan,<sup>218</sup> Missouri,<sup>219</sup> Oregon<sup>220</sup> and Wisconsin.<sup>221</sup>

216. In *Estate of Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981), the federal district court concluded that New Jersey common law provided a *descendible* right of publicity. However, in *Gleason v. Hustler*, 7 MEDIA L. REP. (BNA) 2183 (D. N.J. 1981), the district court narrowed its interpretation of the New Jersey post-mortem right of publicity by conditioning it on "the decedent's own overt exploitation of his name or likeness, usually through an *inter vivos* transfer of his rights." *Id.* at 2185 (citations omitted). New Jersey courts had dealt early on with a person's rights in his name and features, in a case involving Thomas Edison. In *Edison v. Edison Polyform Mfg. Co.*, 67 A. 392 (N.J. Eq. 1907), the court stated "If a man's name be his own property . . . it is difficult to understand why the peculiar cast of one's features is not also one's property, and why its pecuniary value, if it has one, does not belong to its owner rather than to the person seeking to make an unauthorized use of it." *Id.* at 394.

217. In Utah, the federal district court in *Nature's Way Products v. Nature-Pharma, Inc.*, 736 F.Supp. 245 (D. Utah 1990), concluded that Utah would recognize a descendible common law right of publicity, where the right was exploited during the person's lifetime.

218. In *Carson v. Here's Johnny Portable Toilets*, 698 F.2d 831 (6th Cir. 1983), the Sixth Circuit found that Michigan had a common law right of publicity but in so doing quoted its own language in *Memphis Development*: "The famous have an exclusive legal right *during life* to control and profit from the commercial use of their name and personality." *Id.* at 835 (emphasis added) (quoting *Memphis Dev. Found. v. Factors Etc., Inc.*, 616 F.2d 956, 957 (6th Cir.), *cert. denied*, 449 U.S. 953 (1980)). While the *Carson* court did not have a post-mortem issue before it, the cited language leaves a question as to the status of post-mortem rights in Michigan. However, it should be noted that, at least with respect to Tennessee, the Sixth Circuit has abandoned its *Memphis Development* position. See *Elvis Presley Enters. v. Elvisly Yours, Inc.*, 817 F.2d 104 (6th Cir. 1987); see also 936 F.2d 889.

219. In *Cepeda v. Swift & Co.*, 415 F.2d 1205 (8th Cir. 1969), the Eighth Circuit, citing Missouri case law, stated that "plaintiff has a valuable *property right* in his name, photograph and image and that he may sell these *property rights*." *Id.* at 1206 (emphasis added) (citations omitted). Thus, Missouri may recognize a descendible right of publicity.

220. In *Rogers v. Grimaldi*, the Second Circuit, engaging "in the uncertain task of predicting what the New York courts would predict the Oregon courts would rule as to the contours of a right of publicity under Oregon law," 875 F.2d 994, 1002 (2d Cir. 1989), appeared to decide that Oregon has a right of publicity. *Id.* at 1004-05 (recognizing Oregon would limit right of publicity to "wholly unrelated" or "disguised commercial advertisement" uses of celebrity's name in a movie title and therefore denying relief). However, the opinion does not suggest whether the right is descendible in Oregon; in fact, the court suggested that in the absence of Oregon precedent, New York might presume a similarity with New York law and, New York had already decided *Stephano v. News Group Publications*, 474 N.E.2d 580 (N.Y. 1984), a decision which appeared to foreclose a descendible right of publicity in New York. See *infra* note 223 and accompanying text.

221. In *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129 (Wis. 1979), the Supreme Court of Wisconsin clearly established a common law right of publicity in Wisconsin that is a property right and not merely a personal right. Subsequent to *Hirsch*, Wisconsin enacted a Right of Privacy statute restricted to *living* persons similar to New York's Civil Rights Law §§ 50 and 51. While acknowledging that Elroy "Crazy Legs" Hirsch would have been protected under that statute *in futuro*, the court nonetheless found that the common law right of publicity already existed independently of the Right of Privacy Statute. Thus, *Hirsch* provides for a separate common law property right. Presumably Wisconsin would find the right to be descendible.



The law of four states appears to specifically preclude, as a matter of statute or common law, a post-mortem right of publicity: Illinois,<sup>222</sup> New York,<sup>223</sup> Ohio<sup>224</sup> and Pennsylvania.<sup>225</sup>

222. In *Maritote v. Desilu Productions*, 345 F.2d 418 (7th Cir.), *cert. denied*, 382 U.S. 883 (1965) (involving the T.V. dramatization of Al Capone's criminal activities), the Seventh Circuit concluded that there was no descendible right of publicity in Illinois.

223. New York *appeared* to be the leading state in the development of a common law fully-assignable (and presumably devisable) right of publicity separate from, and in addition to, the protection provided by New York Civil Rights Law sections 50 and 51. The decisions, beginning with the progenitor of the right of publicity, *Haelan Laboratories v. Topps Chewing Gum*, 202 F.2d 866 (2d Cir.1953), *cert. denied*, 346 U.S. 816, were mostly federal cases that, in the absence of New York authority, had to define New York's position on a common law right of publicity. See *Groucho Marx Prods. v. Day and Night Co.*, 523 F. Supp. 485 (S.D.N.Y. 1981), *rev'd on other grounds*, 689 F.2d 317 (2d Cir. 1982) (the Second Circuit ruled that California law, not New York law, applied); *Factors, Etc., Inc. v. Pro-Arts, Inc.*, 579 F.2d 215 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979); *Hicks v. Casablanca Records*; 464 F. Supp. 426 (S.D.N.Y. 1978); *Price v. Hal Roach Studios*, 400 F. Supp. 836 (S.D.N.Y. 1975) (deciding that the right of publicity was descendible).

In *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 396 N.Y.S.2d 661 (N.Y. App. Div. 1977), a New York court found a right in Guy Lombardo's persona, distinguishable from the New York Civil Rights Law. Thus, most lawyers and commentators initially concluded that New York recognized a descendible common law right of publicity separate and apart from the Civil Rights Law. But the New York Court of Appeals dropped a bombshell in *Stephano v. News Group Publications*, 474 N.E.2d 580 (N.Y. 1984) "Since the 'right of publicity' is encompassed under the Civil Rights Law as an aspect of the right of privacy, which, as noted, is exclusively statutory in this State, the plaintiff cannot claim an independent common-law right of publicity." *Id.* at 584. In a footnote, the court observed, "In view of the fact that the plaintiff is asserting his own right of publicity we need not consider whether the statute would also control assignment, transfer or descent of publicity rights . . ." *Id.* at 584 n.2. (emphasis added)(citations omitted). Because the New York Civil Rights Law only prohibits the use of "the name, portrait or picture of any living person," it would appear that there is no descendible right of publicity in New York. N.Y. CIV. RIGHTS LAW § 50 (McKinney 1976) (emphasis added). In *Pirone v. MacMillan* the Second Circuit denied the heirs of Babe Ruth relief under sections 50 and 51 because "The right of privacy protection . . . is clearly limited to 'any living person.'" 894 F.2d 579, 585 (2d Cir. 1990). The court, in a footnote, commented that "The cryptic footnote 2 in the *Stephano* opinion . . . creates some grounds for uncertainty as to whether New York's statutory remedy preempts an heir's common law right of publicity claim, but we believe recognition of such a right will have to await either clarification from the Court of Appeals or action by the New York legislature, which has thus far declined to amend the statute to make a right of publicity descendible." *Id.* at 586 n.6. The New York legislature is currently considering Assembly Bill 681 and Senate Bill 285 which provide for a post-mortem right of publicity with a term of 50 years after death.

224. In *Reeves v. United Artists*, 572 F. Supp. 1231 (N.D. Ohio, 1983), *aff'd*, 765 F.2d 79 (6th Cir. 1985), the federal district court held that the right of publicity is not descendible in Ohio. The court reached its conclusion based on the Ohio Supreme Court's language in *Zacchini v. Scripps-Howard Broadcasting Co.*, 351 N.E.2d 454 (Ohio 1976), *rev'd on other grounds*, 433 U.S. 562 (1977), which the court in *Reeves* interpreted as rejecting the notion of the right of publicity as a property right. *Reeves*, 572 F.Supp. at 1235.

225. In *Sharman v. C. Schmidt & Sons*, 216 F. Supp. 401 (E.D. Pa. 1963), the federal district court held that Pennsylvania recognized a right of publicity, but said that the right of publicity is "a fledgling branch of the tort of invasion of privacy," which may suggest

The remaining states have neither had the issue before the court nor adopted statutes specifically dealing with post-mortem rights of publicity. With only a relative handful of states having addressed the post-mortem right of publicity issue, it is somewhat difficult to predict the eventual shape this legal theory will take. Furthermore, the problem of divining the evolution of this right is compounded by the fact that the states that have adopted such laws have not done so uniformly. The aspects of persona that are protected, the duration of protection, and the type of unlicensed uses of the celebrity persona that are prohibited vary, in some instances quite considerably. That said, it would nonetheless facilitate a consideration of the future contours of the post-mortem right of publicity to review its current state. The following analysis is divided into: (1) the types of rights protected, such as name, likeness, and voice; (2) duration of the rights; and (3) types of unlicensed uses that are proscribed.

## B. Types of Rights Protected

### 1. VOICE

California,<sup>226</sup> Nevada,<sup>227</sup> Oklahoma,<sup>228</sup> and Texas<sup>229</sup> protect the name, signature, photograph, likeness and voice of the deceased celebrity. Florida,<sup>230</sup> Nebraska,<sup>231</sup> Tennessee,<sup>232</sup> and Virginia<sup>233</sup> protect the name, photograph, and likeness, but *omit* reference to signature (which might be subsumed in "name") and voice. Kentucky<sup>234</sup> protects the name and likeness but *omits* reference to signature (which might be subsumed in "name"), photograph (which might be subsumed in "likeness"), and voice. Presumably, in those states omitting voice from the scope of protection there is no *statutory* protection in that regard. With respect to statutory rights of privacy/publicity, courts have strictly construed the applicable statutes with respect to "voice." The First Circuit, in *Lahr v. Adell Chemical Co.*,<sup>235</sup> rejected the invitation to interpret the New York Civil Rights Laws, sections 50 and 51, "name, portrait or picture," as

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that the right of publicity is a personal right rather than a property right and therefore not descendible. *Id.* at 407.

226. CAL. CIV. CODE § 990 (West 1992).

227. NEV. REV. STAT. § 598.984(1) (1989).

228. OKLA. STAT. ANN. tit. XII § 1448 (West 1985).

229. TEX. PROP. CODE ANN. § 26.002 (West 1987).

230. FLA. STAT. ANN. § 540.08(c) (West 1988).

231. NEB. REV. STAT. § 20-208 (1983).

232. TENN. CODE ANN. § 47-25-1105(a) (1984).

233. VA. CODE ANN. § 8.01-40 (Michie 1984).

234. KY. REV. STAT. ANN. § 391-170 (Michie 1984).

235. 300 F.2d 256 (1st Cir. 1962).

equating a vocal imitation to "name."<sup>236</sup> The district court for the Southern District of New York likewise declined the invitation in *Tin Pan Apple v. Miller Brewing Co.*<sup>237</sup> The Ninth Circuit, in *Midler v. Ford Motor Company*,<sup>238</sup> another sound-alike case, stated that California Civil Code § 3344, the right of publicity statute, was of no aid to Midler. "The term 'likeness' refers to a visual image not a vocal imitation."<sup>239</sup> However, it is not unreasonable to expect that states newly adopting a post-mortem right of publicity will include *voice* as well as the other attributes of persona. And it would also not be unreasonable to expect that Florida, Kentucky, Tennessee and Virginia will amend their respective statutes to include *voice*. However, even assuming that all jurisdictions include *voice*, would that provision apply to the reanimated "voice" of the deceased actor? Assuming that the reanimation will not use "sound bites" of the actor's voice recorded prior to the death of the actor, but will either use an impressionist or will analyze existing recordings to re-create a computer model of the late actor's voice, the end result will not be the actor's actual voice but either that of a human mimic or a computer-driven, electronically-generated imitation of the voice — in short, a sound-alike.

Although there has been relatively little sound-alike litigation, the few decisions that have been reported provide some useful insights. In *Lahr v. Adell Chemical Co.*,<sup>240</sup> Bert Lahr, the "cowardly lion," was held to have sufficiently alleged a cause of action in unfair competition with respect to a "Lestoil" commercial featuring a cartoon duck with a voice provided by an actor who specialized in imitating the vocal sounds of Lahr. The court noted that Lahr had alleged that he had gained fame "because of his 'style of vocal comic delivery which, by reason of its distinctive and original combination of pitch, inflection, accent and comic sounds,' has caused him to become 'widely known and readily recognized . . . as a unique and extraordinary comic character.'"<sup>241</sup> The court observed that while it "might hesitate to say that an ordinary singer whose voice, deliberately or otherwise, sounded sufficiently like another to cause confusion was not free to do so . . . [Lahr had alleged]. . . a peculiar style and type of performance, unique in a far broader sense."<sup>242</sup>

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236. *Id.* at 258.

237. 737 F. Supp. 826, 836-37 (S.D.N.Y. 1990) (noting that "the Civil Rights Law 'is to be strictly construed'" (citing *Lombardo v. Doyle, Dane & Bernbach*, 396 N.Y.S.2d 661 (N.Y. App. Div. 1977)).

238. 849 F.2d 460 (9th Cir. 1988).

239. *Id.* at 463. However as discussed *infra* note 243 and accompanying text, Midler was more successful with a common law property theory.

240. 300 F.2d 256 (1st Cir. 1962).

241. *Id.* at 257 (quoting the complaint).

242. *Id.* at 259.

In *Midler v. Ford Motor Company*,<sup>243</sup> Bette Midler was held to have a cause of action for misappropriation of her common law property right in her singing voice. In *Midler* the court emphasized the uniqueness of Midler's voice:

We need not go so far as to hold that every imitation of a voice . . . is actionable. We hold only that when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs . . . .<sup>244</sup>

Uniqueness of voice and style was also relevant in *Waits v. Frito-Lay, Inc.*,<sup>245</sup> a sound-alike case involving an advertisement for Frito-Lay's new Salsa Rio Dorito Corn Chips. In *Tin Pan Apple v. Miller Brewing Co., Inc.*,<sup>246</sup> a case involving a Miller Beer commercial featuring comedian Joe Piscopo, the plaintiffs alleged unfair competition, among other claims. The court, while deciding that sound-alikes were not governed by New York Civil Rights Law, sections 50 and 51, went on to state, "It does not follow that resemblances in sound between the Fat Boys' performances and the commercial are not probative of any issues in the case. Similarity of sound in combination with similarity of appearance may militate in favor of plaintiffs' other claims . . . ." <sup>247</sup> This decision provided less support for the rappers' claim to uniqueness than found in *Lahr, Midler, and Waits*.

Two other cases deserve mention. In *Sinatra v. Goodyear Tire & Rubber Co.*,<sup>248</sup> Nancy Sinatra brought an unfair competition action based on the use of "a singer whose voice and style was deliberately intended to imitate the voice and style of the plaintiff . . . ." <sup>249</sup> It would appear the court was not as sure as Sinatra that her voice and style were unique: "One wonders whether her voice, and theatrical style, would have been identifiable if another song had been presented, and not 'her song' . . . ." <sup>250</sup> The court expanded on its evaluation of uniqueness: "[T]here was no readily identifiable accent (Maurice Chevalier), range, quality, (Lahr or Andy Devine), or pitch which would distinguish it to the

243. 849 F.2d 460 (9th Cir. 1988).

244. *Id.* at 463.

245. 978 F.2d 1093, 1102 (9th Cir. 1992), *cert. denied*, 113 S. Ct. 1047 (1993). In addition to his claim under California law, Waits was successful in his Lanham Act § 43(a) claim which was based on an unauthorized imitation of his distinctive voice in the advertisement.

246. 737 F.Supp. 826 (S.D.N.Y. 1990).

247. *Id.* at 838.

248. 435 F.2d 711 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971).

249. *Id.* at 712.

250. *Id.* at 716.

ordinary listener . . . ."<sup>251</sup> Contrasting *Midler* and *Sinatra*, one might conclude that uniqueness is a *sine qua non* of protection in sound-alike cases, at least in the Ninth Circuit.

More troublesome is *Booth v. Colgate-Palmolive Company*.<sup>252</sup> Actress Shirley Booth complained that a laundry detergent advertisement featuring a cartoon character named "Hazel" (Booth had starred in the situation comedy "Hazel" on television) used an imitation of her voice. Booth alleged property rights in her timing, inflection, tone and general performing style. The court did not address the uniqueness or lack thereof of Booth's voice, but decided against her unfair competition claim based on the *Sears* and *Compco* pre-emption theory,<sup>253</sup> and on the fact that neither had Booth exploited her voice in connection with any product or service nor had her voice served a trademark function.<sup>254</sup>

Presuming that a court would interpret "voice" to mean only actual words spoken or sung by the actor during the actor's lifetime, a court would likely analogize the synthesized voice of the late actor to the "sound-alike" situation and therefore treat the sound-alike cases as at least instructive, if not precedential. The paucity of decisions makes it difficult to predict with certainty how courts will deal with the issue. But a tentative conclusion might be drawn from the language of *Lahr*, *Midler* and *Sinatra*: For a voice to be protected against imitation, whether by a human or by a synthesizer, it must be *distinctive* and not *ordinary*. Of course putting flesh on that skeleton may prove to be an awesome task. But, perhaps, a rough cut may be made by looking at actors who have historically been the subject of imitation<sup>255</sup> (realizing that in part the imitation has involved mannerisms and not merely voice in many of the celebrity imitations): Gable, Bogart, Cagney, Wayne, Stewart, Hepburn, Streisand, Bette Davis, Mae West. In contrast, many other well respected actors have not been particularly the subject of impersonation: Muni, Tracy, William Powell, Lombard, Harlow. Obviously, whether a voice is sufficiently distinctive to warrant protection is a question not easily answered, *ad hoc*, and after the fact.

Assuming that a synthesized voice is that of an actor whose voice meets the "distinctiveness" threshold for granting protection against misappropriation, there remains the question of whether the exploitation

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251. *Id.* at n.12.

252. 362 F. Supp. 343 (S.D.N.Y. 1973).

253. See *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964); *Compco Corp. v. Day-Brite Lighting*, 376 U.S. 234 (1964).

254. *Booth*, 362 F.Supp. at 349.

255. Voice-overs on commercials may also be instructive in attempting to establish criteria by which to measure distinctiveness, since the speaker is identified only by voice.

of the synthesized voice in a motion picture would be a misappropriation. That issue is addressed below in Part D.

## 2. LIKENESS

All of the states that have post-mortem statutes include "likeness" in the list of protected attributes. While arguably not a photograph of the deceased actor, the computer-generated image is, beyond peradventure, a "likeness." Look-alike cases lend support to this conclusion. Both *Onassis v. Christian Dior-New York*<sup>256</sup> and *Tin Pan Apple v. Miller Brewing Co.*<sup>257</sup> hold that look-alikes are within the ambit of the New York Civil Rights Law sections 50 and 51 proscription against the unlicensed use of "portrait or picture." And in *Ali v. Playgirl, Inc.*,<sup>258</sup> a composite photo-drawing of the former world's heavyweight boxing champion which "represented something short of actuality—somewhere between representational art and a cartoon" was held to be a proscribed picture.<sup>259</sup> And the 1913 case *Binns v. Vitagraph Co. of America*,<sup>260</sup> a case that today might have been decided differently because of First Amendment considerations, is nonetheless instructive on the issue of likeness. In *Binns*, an actor was made up to look like the plaintiff, a hero in a ship disaster. The court stated:

A picture within the meaning of the statute. . . [the New York Civil Rights Law §§ 50 & 51]. . . is not, necessarily a photograph of the living person, but includes any representation of such person . . . . The defendant is in no position to say that the picture does not represent the plaintiff in that it was an actual picture of a person made up to look like and impersonate the plaintiff . . . .<sup>261</sup>

In *Motschenbacher v. R. J. Reynolds Tobacco Co.*,<sup>262</sup> a race car driver was held to be identifiable despite the fact his features were not visible in a photo. He was held to be identifiable because he was sitting in a race car unique to him.<sup>263</sup> It seems highly unlikely that a court would not find

256. 472 N.Y.S.2d 254, 259 (N.Y. Sup. Ct. 1984), *aff'd* 488 N.Y.S.2d 943 (N.Y. App. Div. 1985).

257. 737 F. Supp. 826, 836 (S.D.N.Y. 1990); *accord* *Allen v. National Video*, 610 F. Supp. 612 (S.D.N.Y. 1985).

258. 447 F. Supp. 723, 726 (S.D.N.Y. 1978).

259. *Onassis*, 472 N.Y.S.2d at 259.

260. 103 N.E. 1108 (N.Y. 1913).

261. *Id.* at 1110.

262. 498 F.2d 821, 827 (9th Cir. 1974).

263. In *White v. Samsung Electronics America*, 971 F.2d 1395, (9th Cir. 1992), *cert. denied* 113 S. Ct. 2443 (1993), game-show hostess Vanna White claimed that a robot dressed in a wig, gown, and jewelry posed next to a Wheel of Fortune game show set was a use of her "likeness" in violation of California Civil Code section 3344. The Ninth Circuit disagreed, but held that White had a common law publicity right in her "identity." *Id.* at 1399. See also *Carson v. Here's Johnny Portable Toilets*, 698 F.2d 831, 835 (6th Cir. 1983) (*Carson* held to have publicity rights in the introduction "Here's Johnny").

a computer-generated image to be a "likeness" of the deceased actor. However, there remains the question of whether the unlicensed use of that image is proscribed by the post-mortem right of publicity; that issue is addressed below at Part D.

### C. Duration of Protection

Those states that have provided statutory post-mortem publicity rights have also provided, with the possible exception of Nebraska and Tennessee, that the right terminates at the expiration of a fixed period after the death of the celebrity. In Virginia, the post-mortem right of publicity terminates at the end of 20 years after the death of the celebrity. In Florida, the right terminates at the end of 40 years after the death of the celebrity. In California,<sup>264</sup> Nevada,<sup>265</sup> and Texas,<sup>266</sup> the right terminates at the end of 50 years after the death of the celebrity. In Oklahoma, the right endures until the end of 100 years after the death of the celebrity.<sup>267</sup> The Tennessee post-mortem statute, waggishly called the "Elvis Statute," provides protection for 10 years after the death of the celebrity and thereafter, without limit, provided only that the right is continuously exercised;<sup>268</sup> presumably the right could be kept viable in perpetuity (or at least until the public finally asks "Elvis who?"). The Nebraska right of privacy statute provides that the right of action for an invasion of privacy shall not survive the death of the individual with the single exception of an action arising out of an exploitation of the person's name or likeness for advertising or commercial purposes.<sup>269</sup> However, while Nebraska created a post-mortem right of publicity, it did not expressly state whether the right was of a finite duration.

Some states that have not enacted post-mortem statutes have nonetheless found that a descendible right of publicity existed at common law. Furthermore, some states that have enacted post-mortem statutes have also recognized the possibility that there were also common law rights of publicity and the descendibility of such rights. The problem is when, if ever, do common law post-mortem rights of publicity expire.

In response to a question certified by the Eleventh Circuit Court of Appeals, the Supreme Court of Georgia held that there was a common law right of publicity, distinct from the right of privacy, and that the right

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264. CAL. CIV. CODE § 990(g) (West 1992).

265. NEV. REV. STAT. § 598.984(1) (1989).

266. TEX. PROP. CODE ANN. § 26.012(d) (West 1987).

267. OKLA. STAT. ANN. tit. XII § 1448(g) (West 1985).

268. TENN. CODE ANN. § 47-25-1104 (1984). For a discussion of the perpetual protection issue, see J. Graham Matherne, *Descendibility of Publicity Rights in Tennessee*, 53 TENN. L. REV. 753, 774-77 (1986).

269. NEB. REV. STAT. § 20-208 (1983).

of publicity was inheritable and devisable.<sup>270</sup> However, the court did not reach the question, admittedly not asked by the Eleventh Circuit, whether the post-mortem right of publicity endured only for a finite time or perpetually, or to whom it descended. In applying New Jersey law to a Presley imitation, the federal district court for the district of New Jersey concluded that New Jersey recognized a common law right of publicity and that such right was descendible.<sup>271</sup> Like the *King* case in Georgia, the court in this "King" case did not address the issue of whether there were any time limits on this right, at least not directly.<sup>272</sup> The problem is further compounded by states that have not addressed the issue, either by case law or statute, of a post-mortem right of publicity.

In the absence of such guidance, a forum state *may* choose to assume that the law of the domiciliary state<sup>273</sup> is like that of the forum state and one must also consider that Nevada's statute applies regardless of the last domicile of the celebrity.<sup>274</sup> Finally, a state may focus on the fact the infringement complained of happened within its borders without ever addressing the domicile issue.<sup>275</sup> *Schumann v. Loew's, Inc.*<sup>276</sup> illustrates the type of multi-jurisdiction infringement that could face a reanimator. In *Schumann*, the great grandchildren of the composer, Robert Schumann, alleged that the motion picture *Song of Love* violated their rights and the rights of the deceased composer "under the laws of every country in the world."<sup>277</sup> Happily for the defendant in *Schumann*, the court was able to find grounds to dismiss the various actions. But the case is a sharp reminder of the difficulties facing a reanimator if he must deal with a post-mortem right of publicity. As other commentators have suggested, a

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270. *Martin Luther King, Jr., Ctr. for Social Change v. American Heritage Prods.*, 296 S.E.2d 697 (Ga. 1982).

271. *Estate of Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981).

272. In a footnote the court stated "Since we are not directly faced with the issue of whether there should be a durational limit on the right of publicity after it is inherited, we will not decide this question. However, the court suggests that a length of time should be set by the New Jersey State legislature. The Federal Copyright Act, 17 U.S.C. § 302, 305 provides guidelines which may be informative in this situation." *Id.* at 1355 n. 10.

273. *See Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). "We believe that New York courts would, as a matter of substantive interpretation, presume that the unsettled common law of another state would resemble New York's but that they would examine the law of the other jurisdiction and that of other states, as well as their own, in making an ultimate determination as to the likely future content of the other jurisdiction's law." *Id.* at 1003 (citations omitted).

274. NEV. REV. STAT. § 598.982 (1989). Nevada's Right of Publicity Statute provides that it applies to a "deceased person's name, voice, signature, photograph or likeness regardless of the person's domicile." *Id.* (emphasis added).

275. *See Estate of Presley v. Russen*, 513 F.Supp. 1339.

276. 135 N.Y.S.2d 361 (N.Y. Sup. Ct. 1954).

277. *Id.* at 364-65.



national law would go a long way toward reducing the complexity of the post-mortem right of publicity.<sup>278</sup>

#### D. Proscribed Post-Mortem Exploitation

Assuming for the moment that the computer-animated image of the late actor is a "likeness" and that the synthesized voice (or human imitation) is considered the voice of the late actor and further assuming that post-mortem right of publicity has not terminated, there remains the question of whether the unlicensed exploitation of a deceased actor in a post-mortem film is proscribed by *existing* post-mortem statutes and common law.

When California State Senator William Campbell first proposed a law governing post-mortem rights of publicity, the American Civil Liberties Union and other interested parties voiced concern about the chilling effect the bill might have on First Amendment rights.<sup>279</sup> In response to those concerns the post-mortem right of publicity, as finally enacted, provides:

(n) This section shall not apply to the use of a deceased personality's name, voice, signature, photograph, or likeness, in any of the following instances:

(1) A play, book, magazine, newspaper, musical composition, *film*, radio or television program other than an advertisement . . .<sup>280</sup>

Oklahoma has adopted language virtually identical to that of California.<sup>281</sup> Texas excludes from the purview of its post-mortem right of publicity statute the use of a deceased individual's name, voice, signature, photograph, or likeness in "a play, book, *film*, radio program, or television program."<sup>282</sup> Nevada provides an exception in its post-mortem right of publicity statute if use of the decedent's name, voice, signature, photograph or likeness "is an attempt to portray, imitate, simulate or impersonate a person in a play, book, magazine article, newspaper article, musical composition, *film*, or a radio, television or other audio or visual program, except where the use is directly connected with commercial

278. See J. Stephen Bingham, Comment, *A Descendible Right of Publicity: Has the Time Finally Come for a National Standard?*, 17 PEPP. L. REV. 933 (1990); Eugene Saloman, Jr., Note, *The Right of Publicity Run Riot: The Case for a Federal Statute*, 60 S. CAL. L. REV. 1179 (1987).

279. See Stephen F. Rohde, *Dracula: Still Undead*, CAL. LAW., Apr. 1985, at 51, 54.

280. CAL. CIV. CODE § 990(n) (West 1992) (emphasis added). If one adopts the policy that re-animation should be governed by post-mortem rights of publicity, then states with statutes similar to California must amend the exclusion of film from the post-mortem statute so as to exclude from the exclusion "re-animation" or, as Sam Goldwyn once so colorfully put it: "Include me out."

281. OKLA. STAT. ANN. tit. XII § 1448 (N) (West 1985).

282. TEX. PROP. CODE ANN. § 26.012(a)(1) (West 1987) (emphasis added).

sponsorship."<sup>283</sup> It is obvious that what the drafters of these exclusions had in mind was to prevent the post-mortem right of publicity from inhibiting stories about the celebrity himself, or stories in which the celebrity played some role in real life. It is very doubtful that anyone involved in the drafting of the exclusion to the various state statutes had contemplated the use of a deceased, albeit reanimated, actor to play a role in a post-mortem film, even the role of playing himself. Nonetheless, as currently drafted, the post-mortem statutes of California, Nevada, Oklahoma and Texas would appear to expressly permit the unlicensed use of a reanimated actor. Florida, Kentucky, Nebraska, Tennessee and Virginia do not have exclusions for media exploitation. Putting aside the media exclusions in California, Nevada, Oklahoma and Texas statutes, do the post-mortem statutes of those states otherwise apply to reanimation? Do the statutes of Florida, Kentucky, Nebraska, Tennessee and Virginia apply to reanimation? And finally, do common law post-mortem publicity rights, as currently exist, apply to reanimation?

The California post-mortem statute applies to use "in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of products, merchandise, goods or services."<sup>284</sup> Florida prohibits unlicensed use "for purposes of trade or for any commercial or advertising purpose."<sup>285</sup> Kentucky provides that no unlicensed use will be made "for commercial profit."<sup>286</sup> Nebraska prohibits unlicensed use "for advertising or commercial purposes."<sup>287</sup> Nevada's post-mortem statute governs "any commercial use."<sup>288</sup> Oklahoma uses language identical to that of California.<sup>289</sup> Tennessee's post-mortem statute covers use "as an item of commerce for purposes of advertising products, merchandise, goods, or services, or for purposes of fund raising, solicitation of donations, purchases of products, merchandise, goods or services."<sup>290</sup> Texas states that there is a post-mortem property right in a person's "name, voice, signature, photograph, or likeness after the death of the individual,"<sup>291</sup> and then lists those uses that may be made of the property without permission,<sup>292</sup> presumably every other use would require a license. Virginia prohibits the unlicensed

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283. NEV. REV. STAT. § 598.984 (2)(d) (1989) (emphasis added).

284. CAL. CIV. CODE § 990(a) (West 1992).

285. FLA. STAT. ANN. § 540.08 (West 1988).

286. KY. REV. STAT. ANN. § 391.170 (Michie 1984).

287. NEB. REV. STAT. § 20-202 (1983).

288. NEV. REV. STAT. § 598.982 (1989).

289. OKLA. STAT. ANN. tit. XII § 1448 (West 1985).

290. TENN. CODE ANN. § 47-25-1105 (1984).

291. TEX. PROP. CODE ANN. § 26.002 (West 1987).

292. *Id.* § 26.012.

use of a person's name, portrait or picture "for advertising purposes or for purposes of trade."<sup>293</sup> The language of the statutes covers a spectrum from the very specific enumeration of California to the open-ended "for commercial profit" of Kentucky. It seems reasonably clear that unlicensed post-mortem advertising would be prohibited by all of the statutes.

Although advertising cases have dealt, to date, exclusively with living celebrities, the cases are instructive of the courts' philosophy with respect to advertising. One has only to look at *Carson*,<sup>294</sup> *Coors*,<sup>295</sup> *Lahr*,<sup>296</sup> *Midler*,<sup>297</sup> *Motschenbacher*,<sup>298</sup> *Onassis*,<sup>299</sup> and *Waits*<sup>300</sup> to see that courts are very unsympathetic to the unlicensed advertiser. However, with respect to *trade* as opposed to *advertising*, the picture is not so clear. For purposes of licensing film for theatrical or television exhibition, the film itself might not be considered goods, but the sale of film in pre-recorded video-cassette format would clearly be considered a sale of goods.<sup>301</sup> But for that matter, copies of newspapers and magazines and books are likewise *goods*. And newspapers, magazines and books implicate First Amendment rights. So, the mere fact that a motion picture may be goods is not necessarily dispositive of the issue of whether a motion picture falls within the prohibitions of the various statutes and the various common law post-mortem rights of publicity. Case law to date may be instructive in determining the applicability of post-mortem statutes and common law to reanimation.

"Purposes of trade" may well be like obscenity: difficult to define, but recognized when seen.<sup>302</sup> Posters, even posters bearing legends, have been held to be for trade purposes.<sup>303</sup> Not surprisingly, shaving gel has

293. VA. CODE ANN. § 8.01-40 (1984).

294. *Carson v. Here's Johnny Portable Toilets*, 698 F.2d 831 (6th Cir. 1983).

295. *Commerce Union Bank v. Coors*, 7 Media L. Rep. (BNA) 2204 (Tenn. Ch. App. 1981), *aff'd on other grounds*, No. 83-327-II (Tenn. Ct. App. June 20, 1987).

296. *Lahr v. Adell Chemical Co.*, 300 F.2d 256 (1st Cir. 1962).

297. *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988).

298. *Motschenbacher v. R. J. Reynolds Tobacco Co.* 498 F.2d 821 (9th Cir. 1974).

299. *Onassis v. Christian Dior-New York*, 472 N.Y.S.2d 254 (N.Y. Sup. Ct. 1984) *aff'd*, 488 N.Y.S.2d 943 (N.Y. App. Div. 1985).

300. *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992), *cert denied*, 113 S. Ct. 1047 (1993)..

301. In *United States v. Drebin*, 557 F.2d 1316, 1332 (9th Cir. 1977), *cert. denied*, 436 U.S. 904 (1978), the court held that copies of motion pictures are goods or merchandise for purposes of 18 U.S.C. § 2314.

302. *Beverly v. Choices Women's Med. Ctr.*, 532 N.Y.S.2d 400, 404 (N.Y. App. Div. 1988) ("The phrase 'for purposes of trade' is not susceptible to a ready definition.")

303. *Brinkley v. Casablancas*, 438 N.Y.S.2d 1004, 1008 (N.Y. App. Div. 1981); *see Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979). The court in *Factors* held that a poster featuring a picture of Elvis Presley bearing the legend "IN MEMORY" was "not privileged as celebrating a newsworthy event." *Id.* at 222; *cf.*

been held to be for trade purposes,<sup>304</sup> as have bubble gum cards,<sup>305</sup> baseball regalia<sup>306</sup> and plastic busts.<sup>307</sup> But, where the exploitation complained of has been in the media, courts have been more reluctant to grant relief, lest free speech be chilled. Books<sup>308</sup> and magazine articles<sup>309</sup> about celebrities (even magazines of dubious communication value<sup>310</sup>) have been insulated against right of publicity claims, because of First Amendment considerations. Motion pictures<sup>311</sup> and plays<sup>312</sup> about individuals in the public eye have also been shielded by the First Amendment.

However, where the media use is perceived to be of questionable communicative content, courts have found, or at least raised the issue of, the use being merely an advertisement or for purpose of trade.<sup>313</sup> In *Midler*, the court acknowledged that "[t]he First Amendment protects much of what the media do in the reproduction of likenesses or sounds."<sup>314</sup> The court went on to state that "[t]he purpose of the media's use of a person's identity is central. If the purpose is 'informative or cultural' the use is immune; 'if it serves no such function but merely exploits the individual portrayed, immunity will not be granted.'"<sup>315</sup> In *Grant v. Esquire, Inc.*,<sup>316</sup> the court suggested that if Esquire used Grant's picture "merely to attract attention" that use would be for purposes of

Paulsen v. Personality Posters, 299 N.Y.S.2d 501 (N.Y. Sup. Ct. 1968) (poster of comedian Pat Paulsen, a mock presidential candidate, held newsworthy).

304. *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129 (Wis. 1979).

305. *Haelen Laboratories v. Topps Chewing Gum*, 202 F.2d 866, 868 (2d Cir.), cert. denied, 346 U.S. 816 (1953).

306. *Cepeda v. Swift and Co.*, 415 F.2d 1205, 1207 (8th Cir. 1969).

307. *Martin Luther King, Jr., Ctr. for Social Change v. American Heritage Prods.*, 296 S.E.2d 697, 708 (Ga. 1982).

308. *Frosch v. Grosset & Dunlap, Inc.*, 427 N.Y.S.2d 828, 829 (N.Y. App. Div. 1980);

*Rosemont Enters. v. Random House*, 294 N.Y.S.2d 122, 128-29 (N.Y. Sup. Ct. 1968), aff'd, 301 N.Y.S.2d 948 (N.Y. App. Div. 1969).

309. *Ann-Margret v. High Soc. Magazine*, 498 F. Supp. 401, 406 (S.D.N.Y. 1980); *Stephano v. News Group Publications*, 474 N.E.2d 580, 584-86 (N.Y. 1984).

310. *Ann-Margret*, 498 F. Supp. 401. The court, while upholding the First Amendment protection of "High Society Celebrity Skin," was moved to observe that "it is questionable whether any 'readers' of this magazine ever read it." *Id.* at 405 n.8.

311. See *Hicks v. Casablanca Records*, 464 F. Supp. 426, 433 (S.D.N.Y. 1978); *Donahue v. Warner Bros. Pictures Distrib. Corp.*, 272 P.2d 177 (Utah 1954).

312. See, e.g., *Joplin Enters. v. Allen*, No. C91-1035C (W.D. Wash. 1991).

313. See *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 727 (S.D.N.Y. 1978); *Grant v. Esquire*, 367 F. Supp. 876, 880, 881 (S.D.N.Y. 1973); *Eastwood v. Superior Court*, 198 Cal. Rptr. 342 (Cal. Ct. App. 1983).

314. *Midler v. Ford Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988), cert. denied, 112 S.Ct. 1513 (1992).

315. *Id.* (quoting Peter L. Felcher & Edward L. Rubin, *Privacy, Publicity and the Portrayal of Real People by the Media*, 88 YALE L.J. 1577, 1596 (1979)).

316. 367 F. Supp. 876.

trade.<sup>317</sup> In *Ali v. Playgirl, Inc.*,<sup>318</sup> the court held that a likeness of Ali "falling somewhere between representational art and cartoon"<sup>319</sup> was included in the magazine solely for purposes of trade because there was "no such informational or newsworthy dimension"<sup>320</sup> to defendant's use. In *Eastwood v. Superior Court*,<sup>321</sup> the court held that the deliberate fictionalization of Eastwood's personality would constitute commercial exploitation.<sup>322</sup> The mere fact that a publisher or producer expected to make a profit from exploiting a story about a celebrity is not of itself enough to invoke a right of publicity claim.<sup>323</sup> But *Grant, Ali* and *Eastwood* suggest that unless there is some protectable First Amendment expression such exploitation would be a violation of the right of publicity. How does all of this apply to reanimation?

The decisions in which courts have denied recovery for invasion of privacy or publicity rights because of overriding First Amendment concerns have involved books, articles or performances, live and on film, *about* the celebrity. Newspapers and biographers are free to write *about* a celebrity. Publishers are free, with some exceptions, to use photographs of the celebrity to illustrate a book or article *about* the celebrity. Film and stage producers are free to mount performances *about* the celebrity and to employ an actor that resembles the celebrity. But it takes no citation to declare that no writer could require a *living* celebrity to grant an interview or to pose for a picture. Nor could a producer require the celebrity to appear in a film or play about the celebrity simply because such appearance would enhance the realism of the production. The First Amendment does not supersede the Thirteenth Amendment.<sup>324</sup> Celebrities have appeared in films as themselves on any number of occasions: Gene Krupa and Harry James in *The Benny Goodman Story*,<sup>325</sup>

317. *Id.* at 881.

318. 447 F. Supp. 723 (S.D.N.Y. 1978).

319. *Id.* at 727.

320. *Id.*

321. 149 Cal. App. 3d. 409 (1983).

322. *Id.* at 426.

323. *Ann-Margret v. High Soc. Magazine*, 498 F. Supp. 401, 406 (S.D.N.Y. 1980) ("[S]imple use in a magazine that is published and sold for profit does not constitute a use for advertising or trade sufficient to make out an actionable claim.") (citing *Oma v. Hillman Periodicals*, 118 N.Y.S.2d 720, 724 (N.Y. App. Div. 1953)); *accord Stephano v. News Group Publications*, 474 N.E.2d 580, 586 (N. Y. 1984).

324. "Neither slavery nor involuntary servitude, except as a punishment for crime whereof the party shall have been duly convicted, shall exist within the United States, or any place subject to their jurisdiction." U.S. Const. amend. XIII § 1.

325. (Universal 1955).

Frances Langford in *The Glenn Miller Story*,<sup>326</sup> and Monty Wooley in *Night and Day*,<sup>327</sup> the film biography of Cole Porter.

Perhaps the most dramatic example of celebrity self-portrayal is the film *To Hell and Back*.<sup>328</sup> Audie Murphy was the most decorated serviceman of WW II. For his extraordinary heroism he was given the nation's highest decoration, the Congressional Medal of Honor. Following the war, Murphy pursued an acting career, mostly starring in westerns. But in 1955 he portrayed himself in the autobiographical film, *To Hell and Back*. While anyone might have been free to write about or produce a film based on Murphy's World War II exploits, no one could have required Murphy to star in the film. Even if he contracted to play himself, as he in fact did, had he decided not to honor the contract no court would have issued an injunction requiring him to perform.<sup>329</sup> At most, a negative injunction prohibiting him from performing for others would have been issued.<sup>330</sup> Should the exploitation of a deceased actor be treated differently from the exploitation of an actor in life? Well, first of all, there is no Constitutional impediment to involuntary servitude with respect to a reanimated actor.<sup>331</sup> So, any proscription against unlicensed exploitation of a resurrected actor would have to be based on other considerations.

Employing the language of *Midler*, if the reanimation is "informative or cultural," then the use should be exempt from the post-mortem right of publicity. But if the use is merely "exploitive," or merely to attract attention, a different conclusion should be drawn. For instance, the unlicensed sale of T-shirts, posters, plaster busts and other products of little or no First Amendment value<sup>332</sup> is proscribed by many states. It is

326. (Universal 1953).

327. (Warner Bros. 1946).

328. (Universal 1955).

329. *Lumley v. Wagner*, 1 De G. M. & G. 604, 619 (Ch. 1852) ("It is true, I have not the means of compelling [Johanna Wagner] to sing . . .").

330. [B]ut she has no cause of complaint, if I compel her to abstain from the commission of an act which she has bound herself not to do . . ." *Id.* Of more recent vintage are *MCA Records v. Newton-John*, 90 Cal. App. 3d 18 (1979), and *King Records v. Brown*, 252 N.Y.S.2d 988, 992 (N.Y. App. Div. 1964).

331. See *Guyton v. Phillips*, 606 F.2d 248, 250 (9th Cir. 1979), *cert. denied*, 445 U.S. 916 (1980) ("[T]he definition of a 'person' for purposes of protection of constitutional rights is limited only to a living human being.").

332. In her concurring opinion in *Guglielmi v. Spelling-Goldberg Productions*, 603 P.2d 454, 457 (Cal. 1979) (en banc), Chief Justice Bird said, "[F]ilm is a 'significant medium for the communication of ideas.' Whether exhibited in theaters or on television, a film is a medium which is protected by the constitutional guarantees of free expression . . . . A film is presumptively protected . . . and will forfeit that protection only if it falls within 'narrowly limited classes.'" Chief Justice Bird went on to state "*Lugosi* involved the use of Bela Lugosi's likeness in connection with the sale of such *commercial products* 'as plastic toys, pencil sharpeners, soap products, target games, candy dispensers and beverage

easy to articulate such a litmus test, but what criteria or standards will be used to distinguish between the permitted and the proscribed? At one extreme might be situations where it is clear that the late star is being used only for exploitive purposes, purposes that had minimal communicative content, for example a brief cameo as a corpse on a slab. At the other end of the spectrum would be the reanimated actor appearing in his own, unfictionalized life story.

More difficult to assess are situations in which the reanimated actor is clearly serving a story-telling role. Perhaps the distinction drawn by Judge Mosk in his concurring opinion in *Lugosi v. Universal Pictures*,<sup>333</sup> between actors simply playing a role, such as Gregory Peck as General MacArthur, George C. Scott as General Patton or Charlton Heston as Moses, and actors performing as themselves, or as characters of their own device, such as Groucho Marx, Red Skelton, Abbott and Costello, or Laurel and Hardy, would be useful in deciding this issue. In *Chaplin v. Amador*,<sup>334</sup> Charlie Chaplin successfully enjoined the actor Charles Amador from appearing, under the name "Charlie Aplin," in the universally-recognized garb of the "Little Tramp" — the ill-fitting vest, tight fitting coat, and too-large pants and shoes. In *Price v. Worldvision Enterprises*,<sup>335</sup> the defendant was enjoined from producing and distributing a television series entitled "Stan 'n' Ollie" in which actors Chuck McCann and Jim McGeorge, respectively would portray Oliver Hardy and Stanley Laurel. In *Estate of Presley v. Russen*,<sup>336</sup> the court, while denying an injunction until the plaintiff made "a showing of immediate, irreparable harm to the commercial value of the right of publicity . . ."<sup>337</sup> found that:

THE BIG EL SHOW. . . serves primarily to commercially exploit the likeness of Elvis Presley without contributing anything of substantial value to society. . . . [E]ntertainment that is merely a copy or imitation, even if skillfully and accurately carried out, does not really

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stirring rods'. . . . These objects, unlike motion pictures, are not vehicles through which ideas and opinions are regularly disseminated." *Id.* at 463 (emphasis added) (footnote omitted) (citing *Lugosi v. Universal Pictures*, 603 P.2d 425 (Cal. 1979)).

333. 603 P.2d 425, 432-33 (Cal. 1979) (Mosk, J., concurring). While Judge Mosk's analysis focused on the rights an actor might have in his characterization, the distinction he drew between roles in which the actor's own identity disappears as he adopts the persona of the character (e.g., MacArthur, Patton, Moses) and those roles in which his identity either as himself or as his self-created character (Groucho, Red, Abbot & Costello) is useful in the analysis of whether a right of publicity should attach to a role in which the actor's identity is "masked" by the role and those in which he essentially plays himself.

334. 269 P. 544 (Cal. Dist. Ct. App. 1928).

335. 455 F. Supp. 252 (S.D.N.Y. 1978), *aff'd*, 603 F.2d 214 (2d Cir. 1979).

336. 513 F. Supp. 1339 (D.N.J. 1981).

337. *Id.* at 1379.

have its own creative component and does not have a significant value as pure entertainment.<sup>338</sup>

The federal district court for the Southern District of New York, in *Groucho Marx Productions, Inc. v. Day & Night Co.*,<sup>339</sup> held that "the Marx Brothers fame arose as a direct result of their efforts to develop instantly recognizable and popular stage characters, *having no relation to their real personalities.*"<sup>340</sup> The court went on to state, "the Marx Brothers exploited their rights of publicity in their *self-created characters* and therefore those rights are properly asserted here."<sup>341</sup> Thus, one might draw a distinction, for post-mortem publicity purposes, between the exploitation of a reanimated actor playing a role in which he assumes the personality of a real person or fictional character, on the one hand, and the situation in which the reanimated actor is used in the role of the self-created character exploited by the actor during his lifetime. Where the actor's goal is to persuade the audience that he is Moses or MacArthur or Lincoln, the persona of the actor himself is masked. In fact, his face may be altered, by a prosthetic device (e.g., Pacino in "The Godfather"), or by makeup such that he looks nothing like himself; one only has to recall the "Man of a Thousand Faces," Lon Chaney. Voices may be altered by, for example, an accent. In short, the goal of the actor is to make you forget that he is the actor named in the screen credits and to believe he is the person he is portraying. This would seem to be the antithesis of the notion of a right of "publicity." On the other hand, where the actor is simply playing "himself," or a character of his own creation, that is a different story. To paraphrase Gertrude Stein, "a Groucho is a Groucho is a Groucho." Thus, one might make a case for the proposition that the exploitation of a synthetic actor is not subject to the post-mortem right of publicity except where it is a "Groucho Marx" type of situation.

Predicting what courts would do if faced with reanimation *today* is fraught with uncertainty. Only a relatively few states have addressed the issue of a post-mortem right of publicity; none have specifically addressed reanimation. The states that have adopted a post-mortem right of publicity, legislatively or judicially, have not been uniform in the scope, duration and types of prohibited exploitation. And except, perhaps, to the extent *Price*,<sup>342</sup> *Russen*<sup>343</sup> and *Day & Night Co.*,<sup>344</sup> provide

338. *Id.* at 1359.

339. 523 F. Supp. 485 (S.D.N.Y. 1981), *rev'd on other grounds*, 689 F.2d 317 (2d Cir. 1982) (applying New York rather than California law).

340. *Id.* at 491 (emphasis added).

341. *Id.* at 492 (emphasis added).

342. *Price v. Worldvision Enters.*, 455 F. Supp. 252 (S.D.N.Y. 1978), *aff'd*, 603 F.2d 214 (2d Cir. 1979).

343. *Estate of Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981).

344. *Groucho Marx Prods., Inc. v. Day & Night Co.*, 689 F.2d 317 (2d Cir. 1982).



some insight into post-mortem imitation, there is no precedent to guide us at the moment. If one concludes that reanimation *should* be subject to a post-mortem right of publicity, then clearly, either there should be a federal post-mortem right of publicity, or the states must adopt a uniform post-mortem statute that is uniform in scope, duration and proscribed unlicensed exploitation. To do less would be to drastically impede this new technology. Of course, the threshold question is: should reanimation be subject at all to a post-mortem right of publicity, be it state or federal. The next section addresses that question.

### E. Policy Considerations

Because reanimation technology is still in the embryonic stage, there is time to consider whether or not reanimation should be subject to a post-mortem right of publicity.

With respect to the public, the goal to be satisfied is the desire of that public to see technically high quality synthetic replicas of deceased performers in new motion pictures, presumably also starring living actors. I would define high quality by how faithful the replica is to the late actor, not only physically, but also in acting ability. The public will also desire that the reanimation of an actor occur during their own lifetime; this desire may be particularly true for the older members of the viewing public for whom nostalgia plays an increasingly important role (one has only to refer to the success of "oldie but goodie" record -- or today, C.D. -- sales for validation of that observation). Thus, long delays in the reanimation of deceased performers would not be in the public interest. It is likely that the public would desire that the roles assigned to the reanimated actor be consistent with the general image of the actor while alive. While innovative roles might be acceptable, it is doubtful that the public at large would desire to see the reanimated actor in roles totally incompatible with the late actor's image, even if some segments of society might desire this (*e.g.*, pornography). The public, obviously, is interested in paying as little as possible to see reanimation, without a sacrifice in the quality of the reanimation. If reanimation is not subject to a post-mortem right of publicity, the cost of creating the computer replica is reduced by the licensing fee saved. Presuming that the savings are passed onto the public, the public interest is served.

But a reduction in the cost of reanimation is not the most important consideration favoring an exclusion of reanimation from the ambit of the post-mortem right of publicity. One argument against including reanimation among the rights protected by a post-mortem right of publicity is that the owner of those rights might refuse to license the rights altogether or demand such unrealistic fees that no producer would be willing to buy. While it is true that the post-mortem right of publicity

will eventually terminate, throwing reanimation rights into the public domain, the public could be denied the right of enjoying a reanimation for 50 or 100 years, or perhaps even longer. This means that at least two generations of moviegoers could be deprived of seeing a reanimation, and these would likely be the generations who had an awareness of the actor while alive and who, therefore, might be the most keenly interested. The problem is further compounded if, in order to create the three-dimensional model, copyright permissions might be required. One might find a situation in which the copyright owner is willing, but the post-mortem rights owner is not, or vice-versa. This could lead to the type of undesirable result, from a public point of view, that occurred in *Chamberlain v. Feldman*.<sup>345</sup> There, the defendant owned the original, unpublished manuscript (holographic and signed) of a Mark Twain work, *A Murder, A Mystery and A Marriage*, but the defendant was held to not own the copyright. The owners of the copyright were successful in barring publication of the work, thus denying the public the enjoyment of a "new" Mark Twain work.

The quality of the reanimation is important to the public. If reanimation is not subject to the post-mortem right of publicity, what effect might that have on the quality of the computer-generated replica? If reanimation is not protected by the right of publicity, will any reanimator undertake the expense of creating a three-dimensional model of a deceased actor, knowing that anyone else with the technology can do the same thing, and depending on how one views the copyrightability of the reanimated model, perhaps more cheaply. If reanimation is subject to the post-mortem right of publicity, a reanimator might be able to negotiate an exclusive license. That said, perhaps putting reanimation in the public domain, while depriving the heirs of economic benefits, will foster a healthy competition to produce the *best* in reanimation quality.

Arguments can be made that reanimation should be included within the rights protected by a post-mortem right of publicity. One argument is that the financial benefits of the actor's labors in life should, in death, go to his heirs. While the opinion in *Lugosi* may not have been a paradigm of clarity, the reasoning of Chief Justice Bird, in her dissent, as to who should enjoy the fruits of post-mortem rights is quite cogent:

[G]ranting protection after death provides an increased incentive for the investment of resources in one's profession, which may augment the value of one's right of publicity. If the right is descendible, the individual is able to transfer the benefits of his labor to his immediate successors and is assured that control over the exercise of the right can be vested in a suitable beneficiary. "There is no reason why, upon a celebrity's death, advertisers should receive a windfall

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345. 89 N.E.2d 863 (N.Y. 1949).

in the form of freedom to use with impunity the name or likeness of the deceased celebrity who may have worked his or her entire life to attain celebrity status. The financial benefits of that labor should go to the celebrity's heirs . . . ."<sup>346</sup>

There is a second reason for extending post-mortem protection to reanimation. If post-mortem rights as to reanimation are in the public domain, not only are the heirs deprived of economic benefit, the actor *in his lifetime* will be deprived of income he might otherwise receive from an *inter vivos* transfer of post-mortem rights. This may be the most telling argument in favor of including reanimation in the post-mortem right of publicity. One must also consider that if reanimation is not included in the post-mortem right of publicity, the actor is deprived of the ability to contractually limit the types of roles in which his synthetic replica will appear.

There is one final consideration. What of the actor who does not want any commercial exploitation of his post-mortem celebrity status; should his wish be honored? If reanimation is subject to a post-mortem right of publicity, the actor could leave his post-mortem rights to a beneficiary, on the condition that the beneficiary would not exploit the rights. It should be noted that a bequest to an individual may not be truly effective, in that if the beneficiary were to ignore the condition of the bequest, the bequest could be terminated — which would result in the post-mortem rights going to statutory heirs who might themselves exploit the rights! Faced with the possibility of that prospect, the actor might leave the post-mortem rights to a testamentary trust with instructions that the rights were not to be exploited. In any event, a performer would be able to deny a reanimation to the public for the term of post-mortem protection, which might be for as much as 100 years. While the public would be deprived of the enjoyment of reanimation for the term of protection granted by the law of the domicile, such deprivation of public enjoyment is equally true with respect to the unpublished works of a deceased author who leaves his copyright to a testamentary trust with terms that the copyrights are not to be exploited.

I will leave it to the reader to judge whether the benefits of including reanimation in post-mortem rights of publicity — economic benefits to the actor or his heirs, incentives to create the three-dimensional model based on exclusive licenses, and the possibility of imposing contractual aesthetic considerations — outweigh the consequences — possible denial of reanimation for the term of post-mortem protection, and the loss of competition that might lead to a higher quality reanimation. If one concludes that reanimation should be subject to a

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346. *Lugosi v. Universal Pictures*, 603 P.2d 425, 446 (Cal. 1979) (Bird, J., *dissenting*) (citations omitted).

post-mortem right of publicity, one must then consider the ramifications of that conclusion.

#### F. Ramifications of Post-Mortem Protection

If reanimated actors are subject to post-mortem rights of publicity, what are the ramifications? If reanimation is within the bundle of rights encompassed by the post-mortem right of publicity, actors and producers will ultimately realize that the post-mortem right is, to begin with, an asset of the actor while alive, and a property that can be transferred *inter vivos*. A review of existing post-mortem statutes demonstrate this truth.<sup>347</sup> But for actors now dead, or those who die in the future without having transferred reanimation rights, the transfer of such rights will be done by the beneficiaries of the actor's will or the statutory heirs. Whether the transfer of reanimation rights is *inter vivos* or post-mortem, the contract is likely to include the types of roles in which the reanimated actor will appear, the duration of the transfer, and of course, the compensation.

One would suppose that the person who would be most concerned that the reanimation reflect credit on the actor would be the actor himself. If the transfer of reanimation rights is *inter vivos*, and presuming the actor has sufficient "box office" appeal, the actor could specify the types of roles and the billing that the synthetic actor would have, could enumerate the kinds of roles specifically proscribed, and could even specify the acceptable MPAA ratings (*e.g.*, NC 17, PG 13,). However, if the *inter vivos* transfer is done early in the actor's career, a time when presumably he is in a relatively disadvantageous bargaining position, the producer may dictate the terms of the transfer, including no limitations on the types of post-mortem exploitation of the reanimated actor. Even if an actor might otherwise have significant stature in the film community, he might be in a disadvantaged position, for example, because of serious medical problems known to the industry at large (*e.g.*, for a John Wayne or a Susan Hayward). If the transfer of reanimation rights is post-mortem, one would hope that the beneficiaries of the actor's post-mortem publicity rights would seek to extract the same restrictions on roles that the actor would. But there is no guarantee that they will — perhaps because of a lack of bargaining power, or, worse yet, because of a focus on the dollar, the post-mortem transfer of publicity rights might have little or no

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347. See CAL. CIV. CODE § 990(c) (West 1993); FLA. STAT. ANN. § 540.08(1)(c) (West 1988); KY. REV. STAT. ANN. § 391.170(1) (Michie 1984); NEB. REV. STAT. § 20-208 (1943); NEV. REV. STAT. § 598.984(2) (1991); OKLA. STAT. ANN. tit. 21 § 839.1 (1983); TENN. CODE ANN. § 47-25-1103 (1984); TEX. PROP. CODE ANN. § 26.002 (West 1987); VA. CODE ANN. § 8.01-40 (Michie 1977).

restrictions on exploitation. If the actor is not able to obtain favorable terms in an *inter vivos* transfer of post-mortem rights, or if the actor does not make an *inter vivos* transfer, what laws will protect his memory and who will champion his cause? If this nation ultimately overcomes its apparent abhorrence of a codified moral rights law beyond the parsimonious recognition in the Copyright Act<sup>348</sup> and the scattered state provisions,<sup>349</sup> perhaps, as discussed in Part VI of this article, a federal moral rights act could be enacted — one that would protect not only the creators of works but the interpreters of works as well. Absent federal or state protection of performer's post-mortem moral rights, the Screen Actors Guild would be the next best hope. Once reanimation becomes an economic reality and not merely an exotic experiment, the Screen Actors' Guild could insist on terms on moral rights-type protection with respect to reanimation in agreements with producers.

Assuming that reanimation rights are the subject of the post-mortem right of publicity, what are they worth? Obviously, the more marketable an actor is during life, the more valuable reanimation rights would be. But the term of protection of such rights must also be considered. In California, a personal service contract can be for no more than seven years,<sup>350</sup> and no one can force an actor under contract to play a particular role; at most, an actor can be suspended or terminated. But reanimation is not a "personal service," because the synthetic actor is not a *person*, he is a *property*; the producer will likely want the property for its full term, *e.g.*, in California, 50 years.<sup>351</sup> However, once protection of post-mortem rights terminates, anyone would be free, at least as far as the right of publicity is concerned, to exploit their own reanimated version of the late actor. Therefore, in valuing such rights, the term of protection must be taken into account. Though the issue is not totally free from doubt,<sup>352</sup> it is likely that the term of protection will be determined according to the law of the jurisdiction in which the actor was domiciled on the date of death.<sup>353</sup> That term might be, under existing laws, as short as 10 years<sup>354</sup>

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348. 17 U.S.C. § 106A (Supp. II 1991).

349. See CAL. CIV. CODE § 987 (West 1979); CONN. GEN. STAT. § 42-116s-116t (1988); LA. REV. STAT. ANN. §51:2151-2155 (West 1986); ME. REV. STAT. ANN. tit. 27, § 303 (1985); MASS. GEN. L. ch. 110, § 231-85S (1985); NEV. REV. STAT. § 598.970-76 (1989); N.J. REV. STAT. § 2A:24A (1986); N.M. STAT. ANN. § 13-4B-1-4B-2 (Michie 1987); N.Y. ARTS & CULT. AFF. LAW § 14.03 (McKinney 1983); PA. STAT. ANN. tit. 73, § 2101-05 (1992); R.I. GEN. LAWS § 5-62-4-5-62-6 (1987).

350. CAL. LAB. CODE § 2855 (West 1989).

351. CAL. CIV. CODE § 990 (4)(g) (West 1988).

352. See *supra* notes 273-275 and accompanying text.

353. See, *e.g.*, *Factors v. Pro Arts*, 652 F.2d 278 (2d Cir. 1981), *cert. denied*, 456 U.S. 927 (1982); see also Stanley Rothenberg et al., *Choice of Law in Sound-Alike Cases*, 14 ENT. L. REP. 3 (1993).

354. TENN. CODE ANN. § 47-25-1104(a) (1984).

or as long as forever.<sup>355</sup> Where the transfer of post-mortem rights is *inter vivos*, the actor will have some state as domicile (although one might well have to consider an actor even though a U.S. citizen domiciled outside of the United States). But there is no guarantee that the actor will be domiciled in that state at death. Presumably, in an *inter vivos* transfer of post-mortem rights, the then-living actor would want a *quid quo pro* while alive, *i.e.*, cash. However, even if the reanimation contract stipulated that the actor would remain domiciled in a designated state, there is no guarantee that in fact, he would be so domiciled at death. The producer faces the risk that the actor might be domiciled at the time of his death in a jurisdiction with a relatively short term of protection. Faced with the uncertainty of the duration of post-mortem protection, the producer would likely demand that part of the payment for the *inter vivos* transfer of post-mortem rights be withheld until death, and that any payments due would be reduced if the post-mortem term of protection of the domicile at death were less than the term contemplated in the contract. However, even this type of "escrow" arrangement would not guarantee protection for a producer who gave "up front" partial payment, if the actor died domiciled in a jurisdiction that did not recognize a post-mortem right of publicity at all, unless that jurisdiction were willing to recognize the post-mortem right of publicity statute of the jurisdiction governing the *inter vivos* contract.

Part V of this article discusses the impact reanimation may have on those with trademark or other proprietary interests in the persona of the actor. Prudence dictates that any contract transferring reanimation rights take into account the interests of such third parties.

## V. TRADEMARK AND RELATED RIGHTS

### A. Introduction

Copyright and post-mortem rights of publicity are not the only rights of which the reanimator must be aware. Many celebrities lend their name to goods or services, perfumes, jewelry, "official" games, toys, even restaurant chains. The value of the celebrity trade or service mark, registered or common-law, is inextricably linked to the image and reputation of the celebrity. If that image is tarnished in some fashion, the assignees or licensees of that trademark might have cause to complain. Celebrities may lend their name and image, not by way of trade or service mark, but by way of product or service endorsements. Even in death, celebrity endorsements may continue to be valuable: witness the Coca

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355. See *id.* § 47-25-1104(b).

Cola television ads featuring Bogart, Cagney, Armstrong, Groucho and Grant. As with celebrity trademarks, the effectiveness of celebrity endorsements might be undercut by activities inconsistent with the popular image of the celebrity. The reanimator must also be mindful of the interests of those who own the copyright in films starring the actor in life. In creating the synthetic, computer replica of a deceased star, the reanimator must be concerned about the quality of his efforts, *i.e.*, how faithful his synthetic replica is to the public's memory of the actor. He must equally consider the types of roles, including "billing" that he gives the reanimated actor. Should the quality of the synthetic actor be poor, or should the roles in which the reanimator places the synthetic replica be inconsistent with, or tarnish, the image of the late actor, the result may be injury to trademark or other proprietary interests in the celebrity's persona.

## B. Trademark

Assuming that a celebrity's name or likeness has a "secondary" meaning, that name or likeness can be registered federally for use as a trademark with respect to the sale of goods, or as a service mark with respect to the sale of services.<sup>356</sup> It may also operate as a common law mark,<sup>357</sup> or perhaps as a state-only registered mark.<sup>358</sup> Will the fact that a reanimator has resurrected a deceased actor, whose image or name happens to be a trade or service mark, violate that mark? With respect to listing the deceased actor's name in the credits, the name is used in its "primary sense," *i.e.*, in identifying the person, and not in its secondary sense, as a source of the product (*i.e.*, the film) which presumably will be the producer.<sup>359</sup> "While the secondary use may be protected, the use of these words in their primary descriptive sense may not be."<sup>360</sup> With

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356. *E.g.*, *Five Platters, Inc. v. Purdie*, 419 F. Supp. 372 (D. Md. 1976); *In re Carson*, 197 U.S.P.Q. 554 (Trademark Trial & App. Bd. 1977).

357. *E.g.*, *Carson v. Here's Johnny Portable Toilets*, 698 F.2d 831 (6th Cir. 1983); *Allen v. National Video*, 610 F. Supp. 612 (S.D.N.Y. 1985); *Estate of Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981).

358. While state registration of a mark associated with an entertainer is possible, it is more likely the mark will be used interstate, at least if the entertainer is more than a local celebrity.

359. In *Pirone v. MacMillan*, 894 F.2d 579, 584 (2d Cir. 1990), the court stated, "The picture of [Babe] Ruth no more indicates origin than does the back cover's picture of Jackie Robinson. . . . [T]he photographs . . . indicate the contents of the calendar, not its source. The source of the publication is clearly indicated by the numerous, prominent references to MacMillan." *Id.*

360. *Id.* With respect to the right of publicity, Chief Justice Bird in her concurring opinion in *Guglielmi v. Spelling-Goldberg Productions*, 603 P.2d 454, 457 n. 6 (Cal. 1979), believed that the use of Valentino's name to advertise the made-for-television film "Legend of Valentino: A Romantic Fiction" did not constitute an infringement of

respect to the photographic images of the film, the fact that one pose may serve as a trademark does not preclude others from using differently posed photographs of the person serving as a trademark symbol.<sup>361</sup> In *Pirone v. MacMillan*<sup>362</sup> the court observed:

Unlike a stylized flying horse or similar picture marks, an individual's likeness is not a consistently represented fixed image—different photographs of the same person may be markedly dissimilar. Thus a photograph of a human being, unlike a portrait of a fanciful cartoon character, is not inherently “distinctive” in the trademark sense of tending to indicate origin. [citations omitted] Under some circumstances, a photograph of a person may be a valid trademark—if, for example, a particular photograph was consistently used on specific goods. Pirone, however, asserts rights in every photograph of Ruth.<sup>363</sup>

This sweeping contention resembles that rejected in *Estate of Presley v. Russen*.<sup>364</sup> The estate of the entertainer Elvis Presley argued that his “image and likeness” was a valid mark. The District of New Jersey rejected the claim as too broad.<sup>365</sup>

Valentino's right of publicity. “While Valentino's name was allegedly used to advertise this particular film, this is not a case in which a celebrity's name is used to promote or endorse a collateral commercial product or is otherwise associated with a product or service in an advertisement.” *Id.* (citations omitted). Chief Justice Bird went on to state that the use of Valentino's name and likeness in advertisements for the film was:

merely an adjunct to the exhibition of the film. It was not alleged that the advertisements promoted anything but the film. Having established that any interest in financial gain in producing the film did not affect the constitutional stature of respondents' undertaking, it is of no moment that the advertisement may have increased the profitability of the film. It would be illogical to allow respondents to exhibit the film but effectively preclude any advance discussion or promotion of their lawful enterprise. Since the use of Valentino's name and likeness in the film was not an actionable infringement of Valentino's right of publicity, the use of his identity in advertisements for the film is similarly not actionable.

*Id.* at 462. In *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1363, n. 31 (D.N.J. 1981), the court noted that “an Elvis Presley performance, itself, cannot be a service mark. As it has been noted, . . . a service mark must not be the service itself, but rather a designation of its source.” *Id.*

361. See *Estate of Presley*, 513 F.Supp. at 1339.

362. 894 F.2d 579 (2d Cir. 1990).

363. *Id.* at 583.

364. 513 F. Supp. 1339 (D.N.J. 1981)

365. *Id.* at 583. In *Estate of Presley*, the court stated:

The plaintiff asserts that the likeness and image of Elvis Presley serves as a service mark; however, the available evidence does not support such a broad position. Rather, the record only supports a conclusion that a picture or illustration of Elvis Presley dressed in one of his characteristic jumpsuits and holding a microphone in a singing pose is likely to be found to function as a service mark.

513 F. Supp. 1339, at 1363-64. *But cf.* *Prudhomme v. Procter & Gamble*, 800 F. Supp. 390 (E.D. La. 1992) (denial of motion to dismiss claim of Plaintiff, a well-known chef, that



Thus, the fact that the name, and perhaps even a likeness of the late actor is registered as a federal trade or service mark, or as a common law or state-registered mark, will not prevent the reanimator from listing the deceased actor's name in the credits—at least where it is clearly indicated that it is the synthetic version of the actor—or from producing a photo-play using visual images of the synthetic version of the actor. Presumably, it would not be an infringement if a frame of the motion picture captured an image identical to that of the trademark image, since the former is not being used in a secondary sense, but in a primary sense. But care must be taken, as discussed in Section C below, to avoid any confusion as to the identity of the actor, as when the portrayal is not by the late actor himself, but rather by a synthetic look-alike.

### C. Lanham Act §43(A) & State Unfair Competition

Section 43(a) of the Lanham Act has "been held to apply to situations that would not qualify formally as trademark infringement, but that involve unfair competitive practices resulting in actual or potential deception."<sup>366</sup> With respect to confusion over celebrity endorsements "'mark' means the celebrity's persona."<sup>367</sup> There have been a number of decisions involving *ersatz* celebrity endorsements (not all for § 43(a) violations), including *Motschenbacher v. R. J. Reynolds Tobacco Co.*,<sup>368</sup> *Carson v. Here's Johnny Portable Toilets*,<sup>369</sup> *Onassis v. Christian-Dior-New York, Inc.*,<sup>370</sup> *Allen v. National Video, Inc.*,<sup>371</sup> *Tin Pan Apple, Inc. v. Miller Brewing Co., Inc.*,<sup>372</sup> and *White v. Samsung Electronics America, Inc.*<sup>373</sup> The elements of persona have ranged from the obvious look-alike cases<sup>374</sup> to decisions involving the extensions of the persona — such as unique markings on a famous racing car associated with a celebrity driver,<sup>375</sup> familiar introduction of a nighttime talk-show host ("Here's Johnny"),<sup>376</sup> or the blond tresses, long gown, large jewels and familiar game board

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his likeness had acquired a secondary meaning and therefore may be a protectable image under traditional trademark law).

366. *Allen v. National Video*, 610 F. Supp. 612, 625 (S.D.N.Y. 1985).

367. *White v. Samsung Electronics America*, 971 F.2d 1395, 1400 (9th Cir. 1992).

368. 498 F.2d 821 (9th Cir. 1974).

369. 698 F.2d 831 (6th Cir. 1983).

370. 472 N.Y.S.2d 254 (N.Y. Sup. Ct. 1984) *aff'd*, 488 N.Y.S.2d 943 (N.Y. App. Div. 1985).

371. 610 F. Supp. 612 (S.D.N.Y. 1985).

372. 737 F. Supp. 826 (S.D.N.Y. 1990).

373. 971 F.2d 1395 (9th Cir. 1992).

374. *See, e.g., Tin Pan Apple*, 737 F. Supp. 826; *Allen*, 610 F. Supp. 612; *Onassis*, 472 N.Y.S. 2d 254.

375. *See Motschenbacher*, 498 F.2d 821.

376. *See Carson*, 698 F. 2d 831.

associated with a game show hostess.<sup>377</sup> While almost all of the litigation involving celebrities has concerned advertisements or trade purposes (*Motschenbacher, Carson, Onassis, Allen, Tin Pan Apple, and White*<sup>378</sup>), there have been a handful of cases dealing with the exploitation of the celebrity in a performance by look-alikes—*Price v. Worldvision Enterprises, Inc.*,<sup>379</sup> *Estate of Presley v. Russen*,<sup>380</sup> *Apple Corps, Ltd. v. Leber*.<sup>381</sup>

Section 43(a) of the Lanham Act is "designed to afford broad protection against various forms of unfair competition and false advertising."<sup>382</sup> Since "as a general rule, the same facts which would support an action for. . . common law unfair competition. . . would support an action for unfair competitive practices under §43(a),"<sup>383</sup> section 43(a) and state unfair competition are discussed together.

Does section 43(a) even apply to film credits and film advertising? The district court in *Smith v. Montoro*<sup>384</sup> held that misidentification in film credits and film advertisements were "not the economic equivalent of palming off or misuse of trademarks or trade names."<sup>385</sup> The district court also questioned the actor-plaintiff Smith's standing to sue "since the plaintiff [was] not in any sort of competition with the defendants."<sup>386</sup> On appeal, the Ninth Circuit disagreed with the district court on both its conclusions. With respect to the applicability of § 43(a) to actor credits and film advertising, the Ninth Circuit stated:

In the film industry, a particular actor's performance, which may have received an award or other critical acclaim, may be the primary attraction for movie-goers. Some actors are said to have such drawing power at the box office that the appearance of their names on the theater marquee can almost guarantee financial success. Such big box office names are built, in part, through being prominently featured in popular films and by receiving appropriate recognition in film credits and advertising. Since actors' fees for pictures, and indeed, their ability to get any work at all, is often based on the drawing power their name may be expected to have at the box office, being accurately credited for films in which they have played would

377. See *White*, 971 F. 2d 1395.

378. *White*, 971 F. 2d 1395; *Carson*, 698 F.2d 831; *Motschenbacher*, 498 F.2d 821; *Tin Pan Apple*, 737 F. Supp. 826; *Allen*, 610 F. Supp. 612; *Onassis*, 472 N.Y.S. 2d 254.

379. 455 F. Supp. 252 (S.D.N.Y. 1978) (discussing *Laurel & Hardy*), *aff'd*, 603 F.2d 214 (2d Cir. 1979).

380. 513 F. Supp. 1339 (D.N.J. 1981) (discussing *Elvis Presley*).

381. 229 U.S.P.Q. 1015 (Cal. Super. 1986) (not officially published) (discussing "Beatlemania").

382. *John Wright, Inc. v. Casper Corp.*, 419 F. Supp. 292, 324-25 (E.D. Pa. 1976), *aff'd in part, rev'd in part sub nom. Donsco, Inc. v. Casper Corp.*, 587 F.2d 602 (3d Cir. 1978).

383. *Estate of Presley*, 513 F. Supp. at 1376.

384. 648 F.2d 602 (9th Cir. 1981).

385. *Id.* at 603 (quoting the district court).

386. *Id.*

seem to be of critical importance in enabling actors to sell their "services," i.e., their performances. We therefore find that appellant has stated a valid claim for relief under section 43(a) of the Lanham Act.<sup>387</sup>

As to standing, the Ninth Circuit held:

[I]t is clear that appellant, as one in the business of providing his talents for use in the creation of an entertainment product, is uniquely situated to complain of injury resulting from a film distributor's misidentification of appellant's contribution to the product. According to one commentator, the "dispositive question" as to a party's standing to maintain an action under section 43(a) is whether the party "has a reasonable interest to be protected against false advertising." [citations omitted] The vital interest of actors in receiving accurate credit for their work has already been described. Accordingly, we hold that appellant has standing to sue in federal court based on defendants' alleged violation of section 43(a).<sup>388</sup>

If the reanimator were to engage in express or implied "passing off," who would have standing to claim a Lanham Act violation? First, although a direct competitor would have standing to sue, "the plaintiff under section 43(a) need not be in actual competition with the alleged wrongdoer."<sup>389</sup> As stated in *L'Aiglon Apparel Co. v. Lana Lobell, Inc.*,<sup>390</sup> "Congress has defined a statutory civil wrong of false representations of goods in commerce and has given a broad class of suitors injured or likely to be injured by such wrong the right to relief in the federal courts."<sup>391</sup> Owners of films starring the late actor would clearly be in competition with the films starring the reanimated actor. Those with trademark rights in the late actor's name or likeness, for purposes other than films starring the actor, might not be in direct competition with the reanimator's films, but would appear to have an economic interest that might be harmed by express or implied passing off — particularly where the reanimator's film casts the "actor" in a role inconsistent with the late actor's screen image (e.g., John Wayne as a "wimp," Bette Davis as a "dimwit"). If the post-mortem right of publicity does not include reanimation, then the owners of the post-mortem right of publicity may have standing to sue for passing off as well.

387. *Id.* In *Dallas Cowboy Cheerleaders v. Pussycat Cinema*, 467 F. Supp. 366, 375 (S.D.N.Y.) *aff'd*, 604 F.2d 200 (2d Cir. 1979), the district court stated that "[i]t would appear obvious that Section 43(a) of the Lanham Act applies to a motion picture. A misuse of trademarks or service marks, and deception or confusion of the kind prohibited by the statute, may occur in connection with the title of a movie, its advertising or in the content of the movie itself."

388. *Smith*, 648 F.2d at 608.

389. *Id.* at 607.

390. 214 F.2d 649 (3d Cir. 1954).

391. *Id.* at 651.

*Smith* dealt with "express reverse palming off"; the film distributor had removed the actor's name from both the film credits and advertising material, and substituted the name of another actor, "Bob Spencer." In reanimation the issue will not be *express reverse passing off* but rather with *express passing off*. If the film credits simply were to list the synthetic actor as "Clark Gable," that would be a clear case of express palming off, *i.e.*, passing off the synthetic "Clark Gable" as the actual Clark Gable. To avoid express passing off, the reanimator will have to make clear in the credits that the actor appearing in the film is not Clark Gable but is a synthetic Clark Gable. With respect to advertising, the reanimator absolutely should not use photographs of the actual actor, *e.g.*, Clark Gable, since this would be an implied passing off.<sup>392</sup> But even where photos or likenesses of the synthetic actor are used, or where the actor's name is used in advertising, the reanimator should make it abundantly clear that the actor in the film is synthetic, and that others who would have standing to complain have "nothing to do with the project - whether that is accomplished through a bold and unequivocal disclaimer, the staging of the photograph, or the accompanying advertising copy."<sup>393</sup>

In addition to federal law, the reanimator must also consider state unfair competition law. As stated by McCarthy, "Liability [for unfair competition] can result from the buyer's likely confusion between two products or services based upon the total impact of all aspects of the parties' selling efforts."<sup>394</sup> In *Chaplin v. Amador*<sup>395</sup> the court enjoined Charles Amador from imitating Chaplin's character of his own devise, the "Little Tramp." In upholding the injunction against Amador's appearance as "Charlie Aplin," the court stated that "The right of action in such a case arises from the *fraudulent purpose and conduct of appellant and injury caused to the plaintiff thereby, and the deception to the public.*"<sup>396</sup>

In *Chaplin*, the defendant attempted to compete with Chaplin, deceptively — according to the court — by adopting identical garb and a very similar name. Because Chaplin was alive, the public might reasonably, albeit mistakenly, have believed that Charles Amador as "Charlie Aplin" was, in fact, Charles Chaplin in his well-known portrayal. Two things should be noted. First, Amador used a character created by the plaintiff, not merely an imitation of the unadorned

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392. "'Implied passing off' occurs when a firm uses a picture or sample of its competitor's product, impliedly misrepresenting that its product is the competitor's product." J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 25.01, at 25-11 (1992).

393. *Allen v. National Video*, 610 F. Supp. 612, 630-31 (S.D.N.Y. 1985).

394. MCCARTHY, *supra* note 392, § 2.02, at 2-14.

395. 269 P. 544 (Cal. Dist. Ct. App. 1928).

396. *Id.* at 546.

plaintiff. Second, the plaintiff was alive at the time. As was suggested in "Post-mortem Right of Publicity" above, one might distinguish between an actor in a self-created character, *e.g.*, the "Little Tramp," and the actor who simply plays an assigned role. The Restatement of Torts § 711 provides that one who "markets goods with an unprivileged imitation of the physical appearance of another's goods is liable to the other for relief . . ." <sup>397</sup> Section 741 of the Restatement states that it is an unprivileged imitation if, in addition to other criteria, "the copied or imitated feature is nonfunctional, or, if it is functional, [the imitator] does not take reasonable steps to inform prospective purchasers that the goods which he markets are not those of another." <sup>398</sup> Where the actor adopts a particular garb or particular idiosyncrasies in creating the character — the mustache and leer of Groucho, fidgeting of an Ollie, or the garb of the "Little Tramp" — that might be analogized to non-functional features, the imitation would not be privileged. But where the actor simply takes on an assigned role, then his physiognomy, etc. might be analogized to functional features. In that case, the reanimator need only take steps sufficient to inform prospective purchasers that the goods (the synthetic actor) which he markets are not those of the other (the films showing the late actor). It should be reiterated that, unlike in *Chaplin*, in reanimation, the actor is dead and the competition is between films of the actor created in his lifetime and films showing his synthetic counterpart. In *Estate of Presley v. Russen*, <sup>399</sup> the court stated:

[E]ven assuming the similarity in shows should be considered, we are convinced that the doctrine of unfair competition was not designed to attach strict liability to a good faith and non-confusing imitation of an entertainment service, such as a concert by a famous performer like Presley, particularly where the original performer is no longer living. <sup>400</sup>

The court went on to state that while the plaintiff had made a sufficient showing of the deceptive impact of the defendant's advertising and promotional materials, the plaintiff had "not made such a showing with respect to the nature or composition of the defendant's show, itself." <sup>401</sup>

One might conclude that the use of the synthetic actor itself is not unfair competition, and that a claim of unfair competition may be avoided merely by indicating, by an appropriate disclaimer, that the actor is synthetic and is not authorized, licensed or sponsored by any third

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397. RESTATEMENT (FIRST) OF TORTS § 711 (1938).

398. *Id.* § 741.

399. 513 F. Supp. 1339 (D.N.J. 1981).

400. *Id.* at 1375 (emphasis added).

401. *Id.*

parties — including the owners of films in which the actor appeared in his lifetime.

#### D. Dilution

In creating the three-dimensional image of the deceased actor and in deciding the type of character and role the synthetic look-alike will play, the reanimator must be mindful of state anti-dilution statutes. In that regard, the reanimator must be equally mindful that anti-dilution statutes typically provide that the statute applies "notwithstanding the absence of competition between the parties or the absence of confusion as to the source of goods or services."<sup>402</sup>

A significant number of states have anti-dilution statutes including the very important entertainment states of California,<sup>403</sup> New York,<sup>404</sup> and Tennessee.<sup>405</sup> The dilution doctrine remains solely a state doctrine, having been omitted from the Trademark Law Revision Act of 1988. The reanimator may well ask what acts constitute "dilution"? One court has defined dilution as a use which causes a "gradual diminution in the mark's distinctiveness, effectiveness and hence value. This kind of infringement corrodes the senior user's interest in the trademark by blurring its product identification or by damaging positive associations that have attached to it."<sup>406</sup> One form of dilution is "tarnishment," a use by the defendant of plaintiff's mark "in an unwholesome or degrading context,"<sup>407</sup> or "out-of-keeping with plaintiff's high quality image."<sup>408</sup>

402. This language which appears in most anti-dilution statutes is adopted from the Model State Trademark Act § 12.

403. CAL. BUS. & PROF. CODE § 14330 (West 1987).

404. N.Y. GEN. BUS. LAW § 368-D (1993).

405. TENN. CODE ANN. § 47-25-512 (1992). In addition 20 other states have adopted antidilution statutes based upon the Model State Trademark Act § 12. ALA. CODE § 8-12-17 (1992); ARK. CODE ANN § 4-71-113 (1991); CONN. GEN. STAT. ANN. § 35-11(C) (1987); DEL. CODE ANN. TIT. 6, § 3313 (Supp. 1992); FLA. STAT. § 495.151 (1988); GA. CODE ANN.. § 10-1-451 (1993); ID. CODE § 48-512 (1977); ILL. ANN. STAT. CH. 140 PARA. 22 (Smith-Hurd 1986); IOWA CODE ANN. § 548.11 (1987); LA. REV. STAT. ANN. § 51:223.1 (West 1984); ME. REV. STAT. ANN. TIT. 10, § 1530 (1980); MASS. GEN. LAWS ANN. CH. 110B, § 12 (West 1990); MO. ANN. § 417.061 (1990); MONT. CODE ANN. § 30-13-334 (1991); NEB. REV. STAT. § 87-122 (1987); N.H. REV. STAT. ANN. § 350-A:12 (1992); N.M. STAT. ANN. § 57-3-10 (Michie 1993); OR. REV. STAT. 647.107 (1987); PA. STAT. ANN. TIT. 54, § 1124 (1993); R. I. GEN. LAWS § 6-2-12 (1992); TEX. BUS. & COM. CODE ANN. § 16.29 (1992). The state of Washington provides injunctive relief to the owner of a famous mark if use by another causes dilution of the distinctive quality of the mark. WASH. REV. CODE ANN. § 19.77.160 (West 1993). Ohio appears to recognize an action for trademark dilution under its common law. See *Ameritech, Inc. v. American Information Technologies Corp.*, 811 F.2d 960, 965 (6th Cir. 1987), *Worthington Foods v. Kellogg Co.*, 732 F. Supp. 1417 (S.D. Ohio 1990).

406. *Ameritech, Inc. v. American Info. Technologies*, 811 F.2d 960, 965 (6th Cir. 1987).

407. 2 MCCARTHY, *supra* note 392, § 24.16, at 24-131.

408. *Id.* at 24-134.

Linking a trademark to illegal drugs<sup>409</sup> or risqué<sup>410</sup> or pornographic<sup>411</sup> activities has been held to be a dilution of rights, as have uses that dilute the prestige of the mark because of the nature of the other product.<sup>412</sup>

Dilution arguments based on a "quality and prestige" argument<sup>413</sup> might be raised against a reanimator because the quality of the synthetic actor is poor. More likely, the issue will arise because of the role in which the reanimated actor is cast, particularly where the role is inconsistent or perhaps even antithetical to the image generally portrayed by the actor. The sensitivity to image is illustrated by this excerpt from a 1948 Roy Rogers/Republic Productions contract:

(a) He (Roy Rogers) shall not use or authorize or willingly permit the use of his name, likeness, or voice in connection with alcoholic beverages, tobacco, laxatives, deodorants, or articles of feminine use, or any other product with which, at the time of such use, authorization, or permission, it reasonably might be considered to be detrimental or prejudicial to associate artist or inconsistent with or harmful to his position as a motion picture star, particularly with reference to his youthful fan audience.

(b) In connection with publications (including so-called "comic" magazines), phonograph records, transcriptions and the like, artist shall, from and after the date of his contract, insert or cause to be inserted in all contracts and agreements appertaining thereto, a clause substantially as follows: "the artist shall not be depicted, described, shown or mentioned, in any form whatsoever, in the character of a villain, thief, or other despicable or derogatory character, or as consuming, dispensing, or handling alcoholic beverages, tobacco of any kind or form, laxatives, deodorants, articles of feminine use, or any other product with which it reasonably might be considered to be detrimental or prejudicial to associate artist, or as engaging in any mental or physical dissipation, or in any manner which will appeal to the sensual emotions of the reader, but all material shall star artist, and depict, describe, show or

409. *Coca Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183 (E.D.N.Y. 1972) (the "Enjoy Cocaine" case).

410. *American Express Co. v. Vibra Approved Lab. Corp.*, 10 U.S.P.Q. 2d 2006 (S.D.N.Y. 1989) (condom in fake AMEX card with phrase "Never Leave Home Without It"). *But see* *L.L. Bean, Inc. v. Drake Publishers*, 811 F.2d 26, (1st Cir. 1987), *cert. denied* 483 U.S. 1013.

411. *Dallas Cowboy Cheerleaders v. Pussycat Cinema, Ltd.*, 467 F. Supp. 366 (S.D.N.Y.), *aff'd*, 604 F.2d 200 (2d Cir. 1979)); *Pillsbury Co. v. Milky Way Productions*, 215 U.S.P.Q. 124 (N.D. Ga. 1981) ("Poppin Fresh" and "Poppie Fresh"); *Edgar Rice Burroughs, Inc. v. Manns Theaters*, 195 U.S.P.Q. 159 (C. D. Cal. 1976) ("Tarzan" in X-rated film).

412. *Steinway & Sons v. Demars & Friends*, 210 U.S.P.Q. 954 (C.D. Cal. 1981) (*STEINWAY* Pianos v. *STEIN-WAY* clip-on beer can handles); *General Electric Co. v. Alumpa Coal Co.*; 205 U.S.P.Q. 1036 (D. Mass. 1979) (infringing product "Genital Electric" underwear).

413. *See supra* note 408 and accompanying text.

mention artist or any character described by the name of Roy Rogers or Rogers, in a decent and virtuous manner, and as champion of right and the enemy of wrong. . . ."414

If the reanimator casts the synthetic actor in a character and role that is out of keeping with the image portrayed by the actor in lifetime, particularly if the role is one with unsympathetic or repugnant characteristics, the owner of a trademark in the late performer's name or image, or even the owner of post-mortem rights of publicity might argue that such miscasting of the synthetic actor tarnishes the image of the mark or the persona of the late actor. The reanimator might argue that any restrictions placed on the type of role the reanimated actor plays would be a violation of the First Amendment rights of the reanimator. Defendants have been successful in defeating trademark infringement or dilution claims based on First Amendment considerations.<sup>415</sup> However, not every unlicensed use of a trademark is protected. First Amendment defenses may fail "where adequate alternative avenues of communication exist"<sup>416</sup> or where "a barely discernible message" is conveyed.<sup>417</sup> Pornographic films similar to *Debbie Does Dallas*<sup>418</sup> clearly would not merit serious consideration of a First Amendment defense. But, in the spectrum between films that employ the reanimated actor in roles consistent with the image of the late actor and pornographic motion pictures with "barely discernible messages," some weight must be given to First Amendment considerations. One might hazard a guess that the more "negative" the role played by the reanimated actor, coupled with a diminished communicative content, the less likely it would be that a First Amendment defense would be effective.

414. Reprinted in DONALD E. BIEDERMAN ET AL., LAW AND BUSINESS OF THE ENTERTAINMENT INDUSTRIES 244 (2d ed. Praeger 1992).

415. *Toho Co. v. Sears, Roebuck & Co.*, 645 F.2d 788 (9th Cir. 1981) ("Godzilla" v. "Bagzilla"); *New Kids on the Block v. News Am. Pub.* 745 F. Supp. 1540 (C.D. Cal. 1990) *aff'd* 971 F.2d 302 (9th Cir. 1992) (telephone survey); *Lucasfilm, Ltd. v. High Frontier*, 622 F. Supp. 931 (D. Col. 1985) ("STAR WARS"). McCarthy has stated "In terms of traditional free speech policy, use of a mark in a purely communicative, non-trademark setting should be permitted . . ." 3 MCCARTHY, *supra* note 392, § 31.37, at 31-207.

416. *Lloyd Corp. v. Tanner*, 407 U.S. 551, 567 (1972). See also *Mutual of Omaha Ins. Co. v. Novak*, 648 F. Supp. 905, 911 (D. Neb. 1986) ("There are numerous ways in which [defendant] may express his aversion to nuclear war without infringing upon a trademark in the process."), *aff'd*, 836 F.2d 397 (8th Cir. 1987), *cert. denied*, 488 U.S. 933 (1988).

417. *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979); see also *Pillsbury Co. v. Milky Way Productions*, 215 U.S.P.Q. 124 (N.D. Ga. 1981); *Gucci Shops v. R.H. Macy & Co.*, 446 F. Supp. 838 (S.D.N.Y. 1977); *Edgar Rice Burroughs, Inc. v. Manns Theaters*, 195 U.S.P.Q. 159 (C.D. Ca. 1976); *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183 (E.D.N.Y. 1972).

418. (*Pussycat Cinema* 1978). This film was the subject of the controversy in *Dallas Cowboy Cheerleaders*, 604 F.2d 200.



## E. Contractual Restrictions

If the entertainer has created trademark or service mark rights and those rights are sold or franchisees are licensed to use the trademark, the assignee or licensee would obviously be concerned that nothing the actor does in his lifetime would adversely affect those rights. In Roy Rogers' contract with Republic, Rogers agreed that any rights to be granted to others would be exploited "in a decent and virtuous manner." Today, Roy Rogers restaurants are a familiar landmark. Just as Republic Pictures was concerned about Roy's image, the owners of the Roy Rogers trademark and franchises are equally interested in Roy's continuing to project a wholesome, family image. Presumably, when reanimation becomes a reality, trademark assignees and licensees will want the actor to agree to language in the assignment or franchise license that any other contract entered into by the celebrity or by the actor's legatees and heirs will not be inconsistent with the image of the actor at the time the assignment of trademark or franchise agreement was entered into.

## V. MORAL RIGHTS

### A. Introduction

"Cast Your Fate to the Wind," recorded some thirty years ago by Vince Guaraldi,<sup>419</sup> might well serve as the anthem of the reanimated actor, for the fate of the actor's reputation may well be in the hands of those with little interest in preserving the dignity of his memory. Were this a nation steeped in the traditions of the Continental *droit moral*, an actor might be comforted by the knowledge that there would be safeguards against the desecration of his memory by those with little conscience. But moral rights do not fit comfortably in our property-oriented society. A half-century ago, an article in the *Harvard Law Review* opined that "[i]nsofar as judicial recognition has been accorded the moral right, the expressed grounds on which common-law protection has been based have been those of libel, unfair competition, copyright and the right of privacy, with some groping towards an inarticulate, *sui generis* tort theory."<sup>420</sup> The "groping" towards a *sui generis* tort continues. Today, moral rights doctrine in the United States is a collage of narrowly-drawn federal and state statutes, libel, Lanham Act, breach of contract actions — and whatever else occurs to a court seeking to provide relief. A review of

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419. Music by Guaraldi, lyrics by Carol Rowe, copyright 1961. Guaraldi, a jazz musician, was perhaps more popularly known for his musical contribution to the "Charlie Brown" T.V. specials.

420. Martin Raeder, *The Doctrine of Moral Right: A Study in the Law of Artists, Authors and Creators*, 53 HARV. L. REV. 554, 575 (1940).

the current state of moral rights will provide some insight as to the general inadequacy of the law in protecting the reanimated actor against unconscionable exploitation.

## B. Moral Right Statutes

Even with the decision to join the Berne convention, the American embrace of moral rights has been tepid at best. Title 17 abjures any notion that adherence to Berne expanded moral rights protection beyond its current status in the United States.<sup>421</sup>

While the moral rights provisions of the Berne Convention have not been adopted in gross in the United States, they provide a framework within which to consider the applicability of the doctrine of moral rights to reanimation. Article 6 *bis* of the Berne Convention provides:

Independently of the author's economic rights, and even after the transfer of 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 shall be prejudicial to his honor or reputation.<sup>422</sup>

This provision protects attribution rights and integrity with respect to *works* of the author in order to protect the honor and reputation of the *author*. The right has been said to be a personal right rather than a property right. While the protection relates to *works* as they reflect on the *author*, it does not appear to deal with more direct attacks on the honor and integrity of the author. In attempting to apply the moral rights doctrine to exploitation of the reanimated actor, one would hope that moral rights protection could be extended to deal with the quality of the reanimation itself, *i.e.*, the dynamic three-dimensional computer model, the role assigned to the reanimated actor as well as the overall quality of the film.

Two arguments might be made for the application of moral rights to these issues. First, if the rationale of moral rights is to protect the honor and reputation of the actor, would not a distorted image of the actor, or a miscasting, or a poor quality of film, be a more direct attack on that honor and integrity than a distortion, mutilation or other modification of a *work* of that actor — and therefore be even more deserving of moral rights protection? Second, one might consider that in participating in the creation of a film an actor could be said to be a contributor to (if not in a

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421. The Berne Convention Implementation Act (BCIA) states that adherence to Berne and passage of BCIA "do not expand or reduce any right of an author" with respect to attribution and integrity. BCIA § 3(b). Pub. L. No. 100-568, 102 Stat. 2853 (1988).

422. Berne Convention (Paris text), art. 6 *bis* (1).

narrow legal sense an "author" of) the work, *i.e.*, the film.<sup>423</sup> Since the late actor is not himself the cause of the poor quality of image, the miscasting or the poor overall quality of the film, the spokesman for the late actor might argue that his work (the contribution of the late actor's synthetic counterpart) has been distorted by the producers of the film. The second argument goes to the direct application of the moral rights provisions, whereas the first argument would justify the application of the doctrine by analogy, if not directly. If either or both of these arguments is persuasive, then Article 6 *bis* would provide a vehicle for protecting the late actor against shoddy or inappropriate exploitation of his computer-generated "clone." How would this interpretation of Berne affect U.S. "moral rights," such as they may be?

When the United States made a tentative step towards codifying moral rights, the scope of protection was narrow. Section 106A extends moral rights protection to a "work of visual art." A work of visual art is defined as "a painting, drawing, print or sculpture,"<sup>424</sup> and includes "still photographs."<sup>425</sup> Motion pictures are specifically excluded from the definition of "visual art."<sup>426</sup> Furthermore, for works created on or after June 1, 1991, the effective date of the Visual Artists Rights Act of 1990,<sup>427</sup> moral rights protection only endures for the life of the author.<sup>428</sup> Thus, those seeking relief against inappropriate post-mortem exploitation by the reanimator will receive no succor from the moral rights provision of Title 17, at least as presently enacted.

423. The contributions of performers to the economic success of a production was recognized in *Frank Music Corp. v. Metro-Goldwyn-Mayer, Inc.*, 886 F.2d 1545 (9th Cir. 1989), *cert. denied*, 494 U.S. 1017 (1990). The Ninth Circuit, while disagreeing with the district court's ultimate apportionment of profits in the case, agreed that a portion of the profit of the infringing derivative work should be allocated to "the creative talent of the producer, and director, the talent of the performers, composers, choreographers, costume designers and others who participated in creating [the derivative work]" *Id.* at 1549 (emphasis added). France provides moral rights protection to actors in "videograms" under "Neighboring Rights." See *infra* note 468 and accompanying text.

424. 17 U.S.C. § 101(1) "Work of Visual Art" (1988). The definition is restricted to a single copy or no more than 200 copies signed (sculptures need not be "signed" but must bear, if not "signed", and "identifying mark") and consecutively numbered. *Id.*

425. *Id.* The definition is restricted to a single copy or no more than 200 copies signed and consecutively numbered.

426. *Id.* § 101 (A)(i) (1988).

427. Pub. L. No. 101-650, 104 Stat. 5128.

428. 17 U.S.C. § 106(A)(d) (Supp. II 1991). However, for works created before June 1, 1991, in which title to the work had not been transferred by the author as of June 1, 1991, the rights provided by § 106(A) shall last for as long as § 106 rights endure (*e.g.*, life plus 50, 75 years, etc., as appropriate). See 2 NIMMER, *supra* note 49, § 8.21[B], 8-826 to 8-289.

Several states have enacted moral rights statutes.<sup>429</sup> These statutes provide moral rights protection to an artist with respect to the artist's creation — painting, sculpture, etc. — but not protection to the artist's persona. Whether a state would be willing to extend protection by analogy to the persona of an actor as embodied in a reanimation is uncertain, but the possibility should be explored. The Massachusetts<sup>430</sup> and New Mexico<sup>431</sup> statutes would, arguably, extend moral rights protection to reanimation. Both statutes specifically include film in the types of works protected, and both extend protection to 50 years after the death of the author (by analogy, the actor, in our case).<sup>432</sup> In Massachusetts, the Attorney General may act on behalf of the deceased author. A number of states specifically exclude film from coverage: Louisiana,<sup>433</sup> Nevada,<sup>434</sup> New Jersey,<sup>435</sup> New York,<sup>436</sup> and Rhode Island.<sup>437</sup> One might argue that it is not the desecration of the film that is in issue, but rather the desecration of the actor. As the extension of protection that is sought is not of the work of the author (actor), but of the author (actor) himself, the exclusion of film makes that application of the statutes, by analogy, more difficult. California extends protection to "fine art" (defined as original painting, sculpture or drawing or work of art in glass) for the life of the author and fifty years after his death; post-mortem, the rights may be exercised by his "heir, beneficiary, devisee, or personal representative."<sup>438</sup> Connecticut extends protection to drawings, paintings, etc. for the life of the author and fifty years after death; heirs, etc., may exercise the post-mortem rights.<sup>439</sup> Maine extends protection to works of "fine art" and makes no mention of post-mortem protection.<sup>440</sup>

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429. To some degree, these state statutes have been pre-empted by the Visual Artists Rights Act of 1990. 17 U.S.C. §301 (f)(1),(2), (1988 & Supp.II 1993) (scope of pre-emption). It should be particularly noted that subsection (f)(2)(C) provides that the pre-emption does not annul or limit any rights or remedies under the common law or under statutes of any state with respect to "activities violating legal or equitable rights *which extend beyond the life of the author.*" *Id.* (emphasis added). Consequently, the pre-emption provisions of section 301 will not present an obstacle to the application of state law to *post-mortem* exploitations of an actor through re-animation.

430. MASS. GEN. LAWS Ch. 110 § 231-85(S) (1993); see Vance Koven, *Observations on the Massachusetts Art Preservation Act*, 71 MASS. L. REV. 101 (1986).

431. N.M. STAT. ANN. § 13-4B-2 (Michie 1987).

432. See *supra* note 428 and accompanying text for the federal approach to post-mortem protection.

433. LA. REV. STAT. ANN. 51:2152(7) (West 1986).

434. NEV. REV. STAT. § 598.970(3) (1989).

435. N.J. STAT. § 2A:24A-3e (1993).

436. N.Y. ARTS & CULT. AFF. LAW § 14.03 (McKinney 1983).

437. R.I. GEN. LAW § 5-62-2(e) (1987).

438. CAL. CIV. CODE § 987(g)(1) (West 1979).

439. CONN. GEN. STAT. § 42-116(s)-(t) (1988).

440. ME. REV. STAT. ANN. tit. 27, § 303 (West 1985).

Pennsylvania protects original works of art in any medium (which arguably would include film) but makes no provision for descendibility protection.<sup>441</sup> Whether the statutes of California, Connecticut, Maine or Pennsylvania would extend protection, by analogy, to the reanimated actor is questionable. Of all the states with moral rights statutes, Massachusetts appears to be the most hospitable to possible post-mortem protection of actors against inappropriate exploitation. But, for the moment, neither federal nor state moral rights statutes appear to be an effective source of protection.

While the moral rights statutes, such as they are, do not appear to offer much, if any, protection to creators in other than the visual arts, protection has been obtained under a variety of rubrics including libel, false attribution, privacy and contract violation. While courts have been reluctant to base relief on a *sui generis* moral rights tort, preferring merely to mention the notion of moral rights while going on to grant or deny relief on grounds more comfortable to common-law nations,<sup>442</sup> it is clear that courts have been willing, on occasion, to grant relief based on moral

441. PA. STAT. ANN. tit. 73, § 2102 (1986).

442. The reluctance of courts to rest a decision on moral rights when other grounds are available is illustrated by the language in *Granz v. Harris*, 198 F.2d 585 (2d Cir. 1952):

"Moral right" seems to indicate to some persons something not legal, something meta-legal. (b) The "moral right" doctrine, as applied in some countries, includes very extensive rights which courts in some American jurisdictions are not yet prepared to acknowledge; as a result, the phrase "moral right" seems to have frightened some of those courts to such an extent that they have unduly narrowed artists' rights. (c) Finally, it is not always an unmitigated boon to devise and employ such a common name. As we have said elsewhere: "A new name, a novel label expressive of a new generalization, can have immense consequences. Emerson said, 'Generalization is always a new influx of the divinity into the mind. Hence the thrill that attends it.' Confronted with disturbing variety, we often feel a tension from which a generalization, an abstraction, relieves us. It serves as a de-problemizer, aiding us to pass from an unstable, problematical, situation to a more stable one. It satisfies a craving, meets what Emerson called 'the insatiable demand of harmony in man,' a demand which translates itself into the so-called 'law' of 'the least effort.' But the solution of a problem through the invention of a new generalization is no final solution: The new generalization breeds new problems. Stressing a newly perceived likeness between many particular happenings which had theretofore seemed unlike, it may blind us to continuing unlikenesses. Hypnotized by a label which emphasizes identities, we may be led to ignore differences \* \* \* For, with its stress on uniformity, an abstraction or generalization tends to become totalitarian in its attitude toward uniqueness."

Without rejecting the doctrine of "moral right," I think that, in the light of the foregoing, we should not rest decision on that doctrine where, as here, it is not necessary to do so.

*Id.* at 590-91 (citations omitted).

rights considerations, even if they have been chary of labeling the cause as one sounding in moral rights.<sup>443</sup> A review of cases involving false attribution or distortion will give some insight into the effectiveness of this patchwork of theories to substitute for a moral rights law.

### C. Moral Rights "Stand-In"

#### 1. LIBEL

In *Brown v. Paramount Publix Corp.*,<sup>444</sup> the court, in referring to the "talking motion picture," observed that "[i]n the hands of a wrongdoer these devices have untold possibilities toward producing an effective libel."<sup>445</sup> The court probably had in mind the libel arising out of the story told, rather than a libel growing out of a misattribution to, for instance, a producer or director. This latter libel pertains not to the story itself, but to the quality of the story telling, *i.e.*, the quality of the motion picture. But the court's observation as to calumniators would seem equally applicable to the quality issue. In fact, libel actions have been successful with respect to misattribution of inferior quality films and other types of works.<sup>446</sup> But injunctive relief traditionally has not been available to the plaintiff in libel actions,<sup>447</sup> and this leaves the plaintiff without an effective prophylaxis.

443. In *Jaeger v. American International Pictures*, 330 F. Supp. 274, 278, (S.D.N.Y. 1971), the court explicitly acknowledged the moral rights substitute approach of American courts:

Whether or not there is any square counterpart in American law of the "moral right" of artists assertedly recognized on the European Continent, there is enough in plaintiff's allegations to suggest that he may yet be able to prove a charge of unfair competition or otherwise tortious misbehavior in the distribution to the public of a film that bears his bane but at the same time severely garbles, distorts or mutilates his work, it is at least arguable that there is a claim under the Lanham Act. . . . Perhaps a similar species of wrong is defined and reachable under the law of New York and other jurisdictions where the film is being shown.

*Id.*; (citations omitted) *see also* *Gilliam v. American Broadcasting Co.* 538 F.2d 14 (2d Cir. 1976); *Edison v. VIVA International, Ltd.*, 421 N.Y.S.2d 203 (N.Y. App. Div. 1979); *Society of Survivors of the Riga Ghetto, Inc.*, 535 N.Y.S.2d 670 (N.Y. Sup. Ct. 1988); *Seroff v. Simon & Schuster, Inc.*, 162 N.Y.S.2d 770 (N.Y. Sup. Ct. 1957), *aff'd*, 210 N.Y.S.2d 479 (N.Y. App. Div. 1960). *But cf.* *Classic Film Museum, Inc. v. Warner Bros., Inc.*, 453 F. Supp. 852 (D. Me. 1978), *aff'd*, 597 F.2d 13 (1st Cir. 1979).

444. 270 N.Y.S. 544 (N.Y. App. Div. 1934).

445. *Id.* at 547.

446. *Carroll v. Paramount Pictures*, 3 F.R.D. 95 (S.D.N.Y. 1942) (film); *Clevenger v. Baker Voorhis & Co.*, 168 N.E.2d 643 (N.Y. 1960) (book). *Ben-Oliel v. Press Pub. Co.*, 167 N.E. 432 (N.Y. 1929) (newspaper article). Less successful in a libel action was the plaintiff in *Seroff v. Simon & Schuster, Inc.*, 162 N.Y.S.2d 770 (N.Y. Sup. Ct. 1957), *aff'd*, 210 N.Y.S.2d 479 (N.Y. App. Div. 1960) (translated book).

447. *Girl Scouts of the United States of America v. Personality Posters Mfg. Co.*, 304 F.Supp. 1228 (S.D.N.Y. 1969); *Hoxsey Cancer Clinic v. Folsom*, 155 F.Supp. 376 (D. D. C.

While monetary damages for libel provide some balm for injury to reputation, they are a poor substitute for avoiding the harm in the first instance, as a true moral rights law might do.

Furthermore, libel laws are an inadequate substitute for another reason. Few states have enacted 'libel of the dead' criminal statutes.<sup>448</sup> Fewer still have enacted civil statutes, and those that have seem reluctant to enforce them.<sup>449</sup> The statutes typically proscribe acts that "blacken" or "vilify" the memory of the deceased. The most likely occasion for violation of a libel of the dead statute will be when the reanimator exploits the synthetic actor in a role that, if undertaken by the late actor in life, would have subjected him to criminal prosecution. In effect, placing the synthetic replica in such a situation is akin to suggesting that the actor in life would have played such a role, which in turn is tantamount to accusing him of a crime.<sup>450</sup> If the reanimated actor is playing a real person, living or dead, such a possibility must be considered. If the characterization of the real person, as portrayed by the reanimated actor, is itself libelous, and particularly if the portrayal would be in violation of a criminal libel statute, then placing the reanimated actor in such a position might itself be considered a libel of the deceased actor. The most likely occasion for such a criminal prosecution would be when the film is

1957); *Kuhn v. Warner Bros. Pictures*, 29 F.Supp. 800 (S.D.N.Y. 1939); *Prucha v. Weiss*, 197 A.2d 253 (Md. 1964), *cert. denied*, 377 U.S. 992. *But see West Willow Realty Corp. v. Taylor*, 198 N.Y.S.2d 196 (N.Y. Sup. Ct. 1960); *Wolf v. Gold*, 193 N.Y.S.2d 36 (N.Y. App. Div. 1959).

448. At present, ten states have libel of the dead statutes that make it a crime to defame a deceased person. COL. REV. STAT. ANN. § 18-13-105 (West 1990); GA. CODE ANN. § 16-11-40 (1991); IDAHO CODE § 18-4801 (1991); LA. REV. STAT. ANN. § 14:47 (West 1986); NEV. REV. STAT. § 200.510 (1989); WASH. REV. CODE ANN. § 9.58.010 (1988); KAN. STAT. ANN. § 21-4004 (1988); N.D. CENT. CODE § 12.1-15-01 (1985); OKLA. STAT. ANN. tit. 21, § 771 (West 1983); UTAH CODE ANN. § 76-9-501 (1986). It is a misdemeanor in six states. GA. CODE ANN. § 16-11-40 (1990), KAN. STAT. ANN. § 21-4004 (1988), NEV. REV. STAT. § 200.510 (1989), N.D. CENT. CODE § 12.1-15-01 (1985); UTAH CODE ANN. § 9.58.010 (1986) and WASH. REV. CODE ANN. § 9.58010 (West 1988). In threestates, one may be fined or imprisoned, or both. ID. CODE § 18-4802 (1991), LA. REV. STAT. ANN. § 14:47 (1986); OKLA. STAT. ANN. tit. 21, § 773 (1983). In Colorado, criminal libel is a class 6 felony. COLO. REV. STAT. ANN. § 18-13-105 (1990).

449. Presently Oklahoma, Texas, and Utah have civil statutes defining libel as to include that which tends to blacken the memory of one who is dead. OKLA. STAT. ANN. tit. 12, § 1441 (1980); TEX. CIV. PRAC. & REM. CODE ANN. § 73.001 (1986); UTAH CODE ANN. § 45-2-2 (1986). However, despite the plain language of these statutes, courts in Oklahoma and Texas have so far refused to recognize a right in favor of the relatives of the deceased actor. *in Drake v. Park Newspapers of N.E. Oklahoma, Inc.*, 683 P.2d 1347 (Okla. 1984); *Renfro Drug Co. v. Lawson*, 160 S.W. 2d 246 (Commission of App. of Tex. 1942).

450. *Restatement (Second) of Torts* section 569 comment d (1977) states, in part, that "[T]he imputation of certain crimes is sufficient to support an action for slander without proof of special harm. To constitute slander actionable per se under the rule there stated, the crime imputed must be of a kind that involves moral turpitude or that is punishable in the first instance by confinement."

obscene.<sup>451</sup> If the quality of the reanimation is itself poor, it is improbable that poor quality, *per se*, would constitute a libel of the dead, under either criminal or civil law.<sup>452</sup>

If the film itself, apart from the quality of the reanimation, is not in keeping with the type of film the actor performed in during life, there is a possibility that such use of the reanimated actor in an inferior quality film would itself be a libel. Attribution of inferior quality work products to a *living* individual has been held to be a libel.<sup>453</sup> Whether the same standard used for determining that a false attribution of an inferior work to a *living* person is a libel should also be applied to the false attribution of an inferior work to a *deceased* person is a question not free of difficulty. One could envision situations in which the distortion is not so outrageous as to constitute a "blackening" or a "vilification" of an actor's memory, but which nonetheless would deserve redress had there been a *droit moral* provision.

### 3. LANHAM ACT & STATE UNFAIR COMPETITION LAWS

Where the moral rights issue has arisen in a business context, Lanham Act Section 43(a)<sup>454</sup> and state unfair competition laws have provided relief.<sup>455</sup> Unlike libel laws, they have made injunctive relief available to redress such wrongs as the false attribution of inferior works

451. A number of jurisdictions make it a criminal offense to appear in an obscene film. IND. CODE ANN. § 35-49-3-2 (1983); N.C. GEN. STAT. § 14-190.5 (1985); OKLA. STAT. tit. 21 § 1040.8 (1983); S.C. CODE ANN. § 16-15-305 (1987); VA. CODE ANN. § 18.2-382 (1988).

452. Cf. *Gardella v. Log Cabin Prod. Co.*, 89 F.2d 891, 896 (2d Cir. 1937). The court said:

If there was a deceptive imitation which amounted to an impersonation, an inferior performance would constitute an attack upon appellee's professional reputation. To have said of her, whether in writing or orally, that her abilities had suffered, or that she was an incompetent singer, or that she was no longer the able and talented entertainer the public knew her to have been, would constitute a clear injury to her reputation. To say it by self-revelation is the same thing and, if anything, is more effective.

*Id.*

453. *Carroll v. Paramount Pictures*, 3 F.R.D. 95 (S.D.N.Y. 1942). Legendary producer Earl Carroll brought an action for libel with respect to a motion picture "A Night at Earl Carroll's" which film contained the false legend that it had been produced by Carroll. The opinion in *Carroll* recited Carroll's complaint that the film "was of poor quality and vastly inferior to the plays and motion pictures with which the plaintiff has been associated as producer in the past and reflects adversely on his name, standing and reputation." *Id.* at 96, *see also* *Clevenger v. Baker Voorhis & Co.*, 168 N.E.2d 643 (N.Y. 1960) (claim of libel for false attribution of revision to author of original work where revision claimed to contain numerous errors).

454. *Gilliam v. American Broadcasting Companies*, 538 F.2d 14 (2d Cir. 1976); *Follett v. New American Library*, 497 F. Supp. 304 (S.D.N.Y. 1980). *See* *Jaeger v. American International Pictures*, 330 F. Supp. 274 (S.D.N.Y. 1971).

455. *Jaeger*, 330 F. Supp. 274; *Granz v. Harris*, 198 F.2d 585 (2d Cir. 1952); *Prouty v. National Broadcasting Co.*, 26 F. Supp. 265 (D. Mass. 1939).



to the plaintiff. While the Lanham Act and state unfair competition laws may be invoked to prevent a violation of the deceased actor's moral rights, typically the plaintiff must have a protectable economic interest. Only if there is such a plaintiff, and then, only if that plaintiff deems "the game worth the candle" will an action under these statutes be brought. Those with the greatest interest in the actor's memory — his family — may have no standing under the Lanham Act or state unfair competition laws. In addition, even if a commercial plaintiff with standing were to bring a Lanham Act, state unfair competition or state anti-dilution action, the success of the plaintiff might depend in part on the strength of the mark — in this case the strength of the actor's persona.<sup>456</sup> Thus, the moral rights protection of a reanimated actor might depend upon the amount of his celebrity. One would hope that moral rights might be more egalitarian.

### 3. PRIVACY

Right of privacy statutes have on occasion been invoked to redress what more properly might be categorized as a moral rights violation, particularly where there has been false attribution of authorship to a mutilated work.<sup>457</sup> But typically, the injured party has been a *living* person. To the extent right of privacy statutes do not extend protection to the deceased, they are, of course, of no benefit to reanimation. Given the paucity of decisions in which a right of privacy has substituted for a moral rights law, the right of privacy remedy appears an anemic guardian of moral rights.

### 4. CONTRACT RIGHTS

Courts have also looked to contract provisions, either express or implied, to protect against false attribution, and to provide injunctive relief when appropriate.<sup>458</sup> But the absence of author-protective contract clauses has, at least to some degree, left authors without remedy for what

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456. *E.g.*, *Allen v. Nat'l Video, Inc.*, 610 F.Supp. 612, 627 (S.D.N.Y. 1985); *Estate of Presley v. Russen*, 513 F.Supp. 1339, 1366 (D.N.J. 1981).

457. *Manger v. Kree Inst. of Electrolysis, Inc.*, 233 F.2d 5 (2d Cir. 1956); *Jaeger*, 330 F.Supp. 274.

458. *Society of Survivors of the Riga Ghetto, Inc. v. Huttenbach*, 535 N.Y.S.2d 670 (N.Y. Sup. Ct. 1988); *Edison v. VIVA International, Ltd.*, 421 N.Y.S.2d 203 (N.Y. App. Div. 1979).

Plaintiff Edison's moral right to protection has been subsumed in his contractual right to seek redress for the alleged mutilation of his article. Hence, even if the second cause is viewed as expressing a request for relief based on the plaintiff's 'moral right,' it must be dismissed for its failure to allege a breach of duty distinct and apart from a breach of contract.

*Id.* at 206; *see also Gilliam*, 538 F.2d 14.

they perceived to be moral rights violations.<sup>459</sup> However, the failure to provide contract protection against alteration is not necessarily fatal to all moral rights-like claims. A comparison of two decisions with opposite results is instructive on this issue. In *Preminger v. Columbia Pictures*,<sup>460</sup> the court denied relief to Otto Preminger with respect to the editing by television stations of the film *Anatomy of a Murder* to accommodate commercials. In contrast to *Preminger*, the court in *Gilliam v. American Broadcasting Companies*<sup>461</sup> granted relief against editing of the "Monty Python" series to accommodate commercials and to remove certain scatological material. At a superficial level, one might distinguish *Gilliam* from *Preminger* on the basis that the creators of Monty Python programs took the precaution to include language in their contract to preclude alteration of the Python programs once they were recorded, whereas Otto Preminger had no such language in his producer/director contract with respect to *Anatomy of a Murder*. But a closer look suggests a more substantial reason for distinguishing the two cases with respect to moral rights considerations. In *Gilliam*, ABC had cut approximately 24 minutes from each 90-minute segment (comprised of three 30-minute programs). Thus, close to 27% of the original program content was excised by ABC. By way of contrast, the editing of *Anatomy of a Murder*, which had an original running time of 161 minutes, to accommodate commercials was considered "minor cuts" and not a "mutilation."

In *Gilliam*, the court recognized that some latitude must be given with respect to minor editing changes: "Courts have recognized that licensees are entitled to some small degree of latitude in arranging the licensed work for presentation to the public in a manner consistent with the licensee's style or standards."<sup>462</sup> But the *Gilliam* court went on to say, "That privilege, however, does not extend to the degree of editing that occurred here especially in light of the contractual provisions that limited the right to edit Monty Python material."<sup>463</sup> And in *Preminger*, the court invited the producer/director to make application for injunctive relief if cuts were made that were not minor, but so major as to constitute a "mutilation," citing as examples cutting the film to 100 minutes or 53

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459. Jaeger, 330 F. Supp. 274; *Preminger v. Columbia Pictures Corp.*, 219 N.E.2d 431 (N.Y. 1966), *aff'd*, 269 N.Y.S.2d 913 (N.Y. App. Div. 1966); *Seroff v. Simon & Schuster*, 162 N.Y.S.2d 770 (N.Y. Sup. Ct. 1957), *aff'd*, 210 N.Y.S.2d 479 (N.Y. App. Div. 1960).

460. 219 N.E.2d 431 (N.Y. 1966).

461. 538 F.2d 14.

462. *Id.* at 23 (citing *Preminger*, 219 N.E.2d 431, as well as *Statchborneo v. Arc. Music Corp.*, 357 F. Supp. 1393, 1405 (S.D.N.Y. 1973)); *see also*, *Packard v. Fox Film Corp.*, 202 N.Y.S. 164 (N.Y. App. Div. 1923).

463. *Gilliam*, 538 F.2d at 23 (emphasis added).

minutes total running time.<sup>464</sup> Thus, we might conclude that even in the absence of specific moral rights protection in a contract, a court will grant relief when the alteration is so serious as to constitute a "mutilation."

However, short of "mutilation," other "distortions" of the actor's memory, as far as contract law is concerned, would be left to the parties to resolve. The courts' language appears to place the burden on the talent to define, contractually, what is proscribed, rather than to place on the exploiter of that talent the burden of bargaining for what is permitted. As interpreted by courts faced with a moral rights issue, contract law seems to favor property rights over moral rights, a not surprising result given our common law heritage. In short, contract law is, at best, a "crap shoot" as far as moral rights are concerned. On the other hand, a moral rights law would be less unpredictable in protecting an actor's reputation. A moral rights approach would shift the burden to the talent exploiter, reserving to the talent the right to prohibit all *unmentioned* alterations.

#### D. International Implications

Perhaps the moral rights of the creative community could be left to the tender mercies of the legal crazy quilt that now exists, if the efforts of the creative community were distributed only domestically. But domestically-created intellectual property is exploited not only in America; it is a major, and very successful, export of the United States. This country cannot afford to be unmindful of the fact that there are nations to which we export intellectual property that place a high value on moral rights. France is such a country. In 1991, the *Cour de Cassation* in France held that John Huston's children and Ben Maddow, who had collaborated with Huston on the screenplay of the *Asphalt Jungle*, had standing to complain of the television exhibition of the colorized version of the film.<sup>465</sup> The decision of the High Court of France to ignore United States copyright law with respect to "authorship" in works made for hire, and instead, to apply French law under the doctrine of "loi de police," will force American producers to consider the ramifications of the Continental *droit morale*. In that regard, it should be noted that France accords protection to performers under "Neighbouring Rights." In

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464. *Preminger v. Columbia Pictures Corp.*, 267 N.Y.S.2d 594, 603 (N.Y. Sup. Ct. 1966); *aff'd*, 269 N.Y.S.2d 913 (N.Y. App. Div. 1966), *aff'd*, 219 N.E.2d 431 (N.Y. 1966). An invitation similar to that in *Preminger* was extended to Gene Autry by a court that found no mutilation in minor T.V. editing. "As to the question of the appellee's emasculating the pictures, we have attempted to leave that question open, to be properly presented when and if the occasion arises . . . ." *Autry v. Republic Prod.*, 213 F.2d 667, 670 (9th Cir.), *cert. denied*, 348 U.S. 858 (1954).

465. For a discussion of the decision in *Huston*, see Jane Ginsburg & Pierre Sirinelli, *Authors and Exploitations in International Private Law: The French Supreme Court and the Huston Film Colorization Controversy*, 15 COLUM.-VLA J.L. & ARTS 135 (1991).

Article 17, a "performer shall have the right to respect for his name, his authorship and his interpretation. This inalienable and imprescriptible right shall attach to his person. It may be transmitted to his heirs in order to protect the interpretation and the memory of the deceased."<sup>466</sup> Whether France would extend the protection granted performers to the reanimated actor is, of course, unknown at this time. While France may be the leading proponent of moral rights, it is not alone in exalting those rights. The transnational nature of intellectual property is one more reason for overhauling our approach to moral rights.

The piecemeal approach of the United States to moral rights, while perhaps not a pastiche, is a poor substitute for the integrated approach an adoption of *droit morale*, in full panoply, would yield. Moral rights have implications far beyond reanimation considerations. But reanimation provides a microcosm of the creative universe. It is, perhaps, not too great a leap of faith or logic to suggest that a moral rights law that addresses the issues raised by reanimation might be appropriate to a broad spectrum of creative activities.

### E. Recommendations

The law, in its current state, will only imperfectly protect the integrity of the reanimated actor. Libel laws protecting the dead are too few, and in any event, probably ineffective, except where the role is in a film that would violate criminal law. Trademark and similar laws protect only limited economic interests; they do not protect the public's interest. What is needed is a *sui generis* moral rights law. Assuming that a moral rights law is appropriate, a number of questions arise: Should the law be state or federal? If federal, should it be part of the Copyright Act? Who should have standing to bring an action? Should the action be civil, criminal or both? Should the protection be of limited duration or unlimited duration? Should the law be broadly worded or should it be specific?

I would suggest that a moral rights law should be adopted at the federal level rather than the state level. Transaction costs would be less if there were a uniform law. While a uniform state law might provide a solution, experience demonstrates that the uniform adoption of proposed uniform laws is a goal not easily achieved; witness the forty-year history of the Uniform Commercial Code. A federal law would ensure the kind of uniformity that is desirable in what is clearly, with respect to film, both an interstate business and an international business. The Commerce

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466. Law on Authors' Rights and on The Rights of Performers, Producers of Phonograms and Videograms and Audiovisual Communications Enterprises, Title II, Neighboring Rights, Article 17.

Clause of the Constitution provides a sufficient legal basis for adoption of a national moral rights law, should Congress decide that moral rights should not be integrated into the Copyright Act, as Congress did so decide with respect to visual artists' moral rights. Since the adoption of a comprehensive, national moral rights law would be a departure from our long-standing position on the issue, and given the pragmatics of politics, divorcing moral rights from copyright may be politically unrealistic. However, as previously stated, moral rights, which could be constitutionally supported under the Copyright and Patent Clause of the Constitution, could also be justified by the Commerce Clause, if a decision were made to decouple moral rights from copyright.

State statutes could provide standing to the Attorney General acting in *parens patriae*, to the next of kin, or to the actor's estate. If a national moral rights act is adopted, it should carefully spell out the extent to which it pre-empts state laws, civil and criminal, including "libel of the dead" statutes. Of particular concern would be the relation of the federal moral rights to the Lanham Act Section 43(a) and state unfair competition and anti-dilution statutes. If trademark owners and those with similar economic interests were given standing to sue under the moral rights law, pre-emption of the federal statutes and state law would be appropriate. However, it may be preferable to leave trademark and other economic-interest plaintiffs to the Lanham Act and state law, since their interests are solely to prevent economic harm and only incidentally to preserve the integrity of the memory of the late actor. However, one could make the argument that distinguishing between economic and personal interests could lead to inconsistent treatment of what is, at base, a moral rights violation. On balance, I believe that retaining the status quo with respect to trademark and related issues is the preferred course.

If the federal moral rights law provides civil relief only and avoids criminalizing breach of its provisions, there are a number of advantages. By not including criminal provisions, the language of the statute, arguably, can be less specific than it would have to be if criminal sanctions were involved. Omitting criminal provisions will help to reduce the caseload of the federal judiciary; states are perhaps in a better position to decide what conduct is deserving of criminal sanctions in light of their particular circumstances. And finally, it will not be necessary to address pre-emption as to state criminal laws, such as "libel of the dead" statutes.

With respect to duration of moral rights protection, one might adopt the French position of perpetual protection. However, if this position were to be seriously entertained, Constitutional issues would have to be addressed. First, moral rights could not be incorporated in the Copyright

Act, since the Constitution<sup>467</sup> directs Congress to grant protection for a limited time only. On the other hand, basing Congressional authority to legislate moral rights on the Commerce Clause removes the time impediment posed by the Copyright/Patent clause. However, one must ask whether perpetual, as opposed to a limited-duration, protection is advisable. In her dissent in *Lugosi v. Universal*,<sup>468</sup> Chief Justice Bird suggested, with respect to a post-mortem right of publicity, a term of life plus 50 years. A similar suggestion was made by the court in *Estate of Presley v. Russen*.<sup>469</sup> Moral rights could be similarly limited.

I would suggest that a time limit be placed on moral rights. I do so for several reasons. As time passes, descendants multiply; which of the great-great-great grandchildren are to have standing? If there are no heirs, must some government official forever be guardian of an actor's integrity? As society evolves, what yardstick is to be used to measure the inappropriateness of a role, that existing when the actor died, or those of the current generation? On a practical level, would Congress pass a moral rights statute that would give perpetual protection? A moral rights statute grants a type of personal monopoly - a perpetual monopoly would likely not be politically acceptable. If life plus 50 years would be too short, perhaps life plus 75 or 100 years would be sufficient.

Finally, one must decide the specificity of the statute's wording. Detailed language serves to give specific guidance to the reanimator and others involved with moral rights issues. But detailed guidelines deprive courts of flexibility in dispensing justice and detailed guidelines are an invitation to the devious. Broad language provides flexibility, a quality that lends itself to an ever-evolving society.

## VI. CONCLUSION

In centuries past, authors and artists enjoyed a kind of immortality denied to performers. So long as their prose, poetry, music, paintings and sculptures endured, the memory of long dead authors and artists persisted in the physical embodiment of their creative genius; works created centuries ago are enjoyed today by the latest inhabitants of this planet. Performers were not so fortunate; performance was gossamer, vanishing upon completion. All that remained were, at best, fragments — a sketch of the performer, a description of the performance, a playbill, nothing more. The twentieth century changed all that; the motion picture and the sound recording lend permanence to the talent of the performer. The voices of Caruso, Madame Schumann-Heinke and McCormack have

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467. U.S. const. Art. 1, § 8, cl. 8.

468. 603 P.2d 425, 447 (Cal. 1979).

469. 513 F. Supp. 1339, 1355 n. 10 (D.N.J. 1981).

not been stilled by death. The performances of the Barrymores, Olivier, Tracy, Garbo and Swanson, captured on film, remind succeeding generations of their skill as actors. The twenty-first century may bestow yet an additional measure of immortality to performers via reanimation.

The prospects of reanimation are exciting and boundless. Acting dynasties may find the living performing with their ancestors; Drew Barrymore may find herself teamed with her grandfather John and her great-aunt and uncle, Ethel and Lionel. Dream casts assembled across generations would enrich the silver screen. Society might be able to rectify, in some small way, social ills of the past. Actors from minority groups who had been given only stereotypical roles during their lifetime or who were cast in films with limited, ethnic distribution could be cast in serious roles with general appeal. Actors denied the opportunity to explore subjects taboo during their lifetimes would have the opportunity through reanimation to address the once-forbidden topics. But, unless the legal issues implicated by reanimation are addressed in a thoughtful, comprehensive and cohesive way, reanimation may find itself strangled at birth.

Reanimation technology is still in the embryonic stage of development. In fact, it is likely that reanimation will not reach the silver screen until early in the twenty-first century. There is time to explore the legal issues raised by this fascinating innovation in entertainment. This article has discussed a number of issues raised by reanimation; others may occur to the reader. There is time to debate the best ways of responding to the legal issues raised. Too often in the past, the legal profession has lagged behind the scientific community. Playing legal catch-up might impede rather than foster innovation. I do not suggest that laws be drafted before we fully understand the ramifications of the technology. But it is not premature for the legal profession to join the scientific community in discussing the entwined legal and technical issues of reanimation. The readiness is all.

