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ARTICLE

SCREEN CREDIT IN THE ENTERTAINMENT INDUSTRY

Robert Davenport †

Screen credit is probably the single most important factor for artists in the entertainment business. This factor determines who is “hot” and who is not; it is the basis for determining whether artists are offered subsequent assignments and their increase in compensation for those assignments.

[B]ig 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 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 [is] . . . of critical importance¹

The focus here is the right of paternity for artists, which naturally includes within it the right of an artist to be accorded proper screen credit. The Berne Convention² (“Berne”), a century old treaty, guarantees the right of paternity to all artists and provides a definition of paternity which guarantees a broad right to claim authorship or credit:

[I]ndependently 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 would be prejudicial to his honor or reputation.³

An additional provision of the Berne Convention “encompasses the author’s rights to have the work published anonymously or pseudony-

† A.B. Middlebury College, J.D. St. John’s Law School, M.B.A. Harvard Business School

1. *Smith v. Montoro*, 648 F.2d 602, 607 (9th Cir. 1981).

2. The Convention for the Protection of Literary and Artistic Works, signed at Berne, Switzerland on September 8, 1886, [hereinafter “Berne Convention”].

3. Berne Convention, *supra* note 2, at Article 6bis.

mously, to prevent it from being attributed to another and to prevent his name from being applied to the work of another person.⁴

Historically, the American position on artist credit has been in direct opposition to that adopted by the majority of countries who signed the Berne Convention.⁵ The fundamental "moral right" of paternity was a major stumbling block to American ratification of the treaty, primarily because "American copyright law . . . does not recognize moral rights or provide for their violation, since the law seeks to vindicate the economic, rather than personal, rights of authors."⁶ The Convention's goal, on the other hand, was to provide this personal moral right to artists.

The entrenched American view of moral rights is clearly seen in the case of *Vargas v. Esquire, Inc.*⁷ ("*Vargas*"). The artist, Vargas, attempted to exercise his moral rights after signing an agreement with a publisher to reprint his art for a calendar.⁸ The contract explicitly stated that Vargas' work could be reproduced without his name.⁹ Vargas argued that reprinting his art without attributing credit to him constituted a misrepresentation and was unfair competition.¹⁰ The *Vargas* court stated:

[t]he conception of 'moral rights' of authors so fully recognized and developed in the civil law countries has not yet received acceptance in the law of the United States. No such right is referred to by legislation, court decision or writers. What plaintiff in reality seeks is a change in the law of this country to conform to certain other countries. We need not stop to inquire whether such a change, if desirable, is a matter for the legislative or judicial branch of the government, in any event,

4. World Intellectual Property Organization ("WIPO"), Guide to the Berne Convention for the Protection of Literary and Artistic Works 41, n.5 (Paris Act 1971) (noted in Final Report of the Ad Hoc Working Group on U.S. Adherence to the Berne Convention—Moral Rights, 10 COLUM. J.L. & ARTS 513, 550 (1986)).

5. Berne Convention, *supra* note 2.

6. Gilliam v. American Broadcasting Co., 538 F.2d 14, 24 (2d Cir. 1976).

7. 164 F.2d 522, 526 (9th Cir. 1947). See also *Chesler v. Avon Book Div.*, 76 Misc. 2d 1048, 352 N.Y.S.2d 552, 557 (Sup. Ct. 1973) (An author was unsuccessful in preventing a publisher from condensing his hardcover book for a paperback edition). "The authorities she cites do not establish that [the doctrine of moral right] . . . is recognized in New York." *Id.* at 1051, 352 N.Y.S.2d 552, 555. Of course, even Berne does not prevent a subsequent owner of an artistic work from totally destroying it, thus removing the creation to which credit would attach. *Crimi v. Rutgers Presbyterian Church*, 194 Misc. 570, 573, 89 N.Y.S.2d 813, 818 (1949) (An artist was unsuccessful in preventing a church from destroying the wall on which he had painted a fresco).

8. *Vargas*, 164 F.2d at 524.

9. *Id.*

10. *Id.*

we are not disposed to make any new law in this respect.¹¹

Though the United States has recently become a signatory to the Convention,¹² Congress has declined to implement into federal law those provisions of Berne which guarantee the broad right of paternity.¹³ Because Congress merely implemented Berne but did not statutorily enact it, it is clear that Congress did not intend to automatically increase or decrease the moral rights available to artists under current case law.¹⁴ Though the full impact of the Berne Convention has not been felt in the United States,¹⁵ congressional ratification of the treaty has opened the doors for the courts to further expand the right of credit in the United States. Courts are now recognizing the rights of artists to be associated with their work. It is the argument of this author that artists' rights have evolved from a "caveat emptor" approach,¹⁶ where the contract ruled and the right of credit was easily bargained away,¹⁷ to a growing realiza-

11. *Id.* at 526.

12. CONG. REC. S14622 (daily ed. Oct. 5, 1988) (Berne Convention Implementation Act of 1988).

13. *Id.* "The Convention for the Protection of Literary and Artistic Works, signed at Berne, Switzerland on September 8, 1886, and all acts, protocols, and revisions thereto are not self-executing under the Constitution and laws of the United States." *Id.* at § 2(1). "The obligations of the United States under the Berne Convention may be performed only pursuant to appropriate domestic law." *Id.* at § 2(2).

14. *Supra* note 12, at § 3. Construction of the Berne Convention:

(a) Relationship with Domestic Law. The provisions of the Berne Convention —

(1) shall be given effect under Title 17, as amended by this Act, and any other relevant provision of Federal or State law, including the common law; and

(2) shall not be enforceable in any action brought pursuant to the provisions of the Berne Convention itself.

(b) Certain Rights Not Affected. — The provisions of the Berne Convention, the adherence of the United States hereto, and satisfaction of United States obligations thereunder, do not expand or reduce any right of an author of a work, whether claimed under Federal, State, or the common law —

(1) to claim authorship of the work; or

(2) to object to any distortion, mutilation, or other modification of, or other derogatory action in relation to, the work, that would prejudice the author's honor or reputation.

Id.

15. *Supra* note 12.

No right or interest in a work eligible for protection under this title may be claimed by virtue of, or in reliance upon, the provisions of the Berne Convention, or the adherence of the United States thereto. Any rights in a work eligible for protection under this title that derive from this title, other Federal or State statutes, or the common law, shall not be expanded or reduced by virtue of, or in reliance upon, the provisions of the Berne Convention, or the adherence of the United States thereto.

Id.

16. In this case, let the artist beware that his "bundle of rights" has not been reduced to one stick. *Giving the Devil Its Due: Actors' and Performers' Right to Receive Attribution for Cinematic Roles*, 4 CARDOZO ARTS & ENT. J., 299, 309 (1985).

17. *Harris v. Twentieth Century Fox Film Corp.*, 43 F. Supp. 119 (S.D.N.Y. 1942). "It seems to me that the plaintiff transferred all rights in her work to the defendant by express

tion that an artist's right of paternity, and hence right to screen credit, is an inalienable right. Congressional adoption of Berne and the evolution of judge-made law has resulted in a right to screen credit that approximates the paternity right defined in Berne. However, instead of being a neatly defined term as found in Berne, the judicially-created right to credit in the United States is a patchwork of rights from which an entitlement can be fashioned.¹⁸ During the congressional debate concerning whether the United States should become a signatory to the Convention, it was stated: "there are substantial grounds for concluding that the totality of the U.S. law provides protection for the right of paternity"¹⁹ Thus, even without statutory enactment of Berne, there are legal theories on which paternity rights can be based.²⁰

contract and she cannot complain at this time that defendant did not mention her . . . in the screen credits" *Id.* at 121.

Perhaps the most egregious early case was that of *Vargas v. Esquire, Inc.*, 164 F.2d 522 (7th Cir. 1947), which demonstrates the lengths the courts will go to strip authorship completely from one who has not guarded himself with a phalanx of attorneys. Vargas had created a series of famous renditions for *Esquire Magazine* which were originally titled the "Vargas Girl." Later, the publisher reprinted the drawings without Vargas' name. The court stated that *Esquire* could remove Vargas' name from his artwork and substitute a name of their own, because it had purchased the complete right to the pictures.

Plaintiff argues that the use of 'Esquire Girl' as a title for the pictures was a representation that the author was someone other than the plaintiff. We do not agree with this contention. . . . [A]s already shown, it was provided in the contract that both the pictures and name 'shall forever belong exclusively to Esquire'. . . . [T]his was the basis both upon which plaintiff was paid and upon which Esquire acquired their possession and ownership.

Id. at 527.

18. *Jaeger v. American Int'l Pictures, Inc.*, 330 F. Supp. 274 (S.D.N.Y. 1971).

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 name 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 . . . [i]n the charge that defendant represents to the public that what the plaintiff had nothing to do with is the plaintiff's product. . . . 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. at 278.

19. 133 CONG. REC. S7370 (daily ed. May 29, 1987) (statement of Sen. Leahy).

20. *Geisel v. Poynter Products, Inc.*, 295 F. Supp. 331 (S.D.N.Y. 1968).

The doctrine of moral right recognized by the civil law of many European and Latin American countries . . . even after the transfer of the copyright in his work . . . (Berne Convention, article 6*bis*) . . . is not part of the law in the United States, except in so far as parts of that doctrine exist in our law as specific rights — such as copyright, libel, privacy and unfair competition.

Id. at 340, n.5.

I. A COMPILATION OF LEGAL THEORIES FOR PATERNITY RIGHTS

A. *The Copyright Act*

The 1976 Copyright Act protects a written work for the life of the author plus fifty years.²¹ One policy behind this time period is to make it easier for third parties to compute the period of protection.²² At least one commentator has suggested that this provides a legal theory on which to base an author's right to credit.²³

When an author writes and sells a screenplay,²⁴ the copyright to the screenplay terminates fifty years after the author's death, at which point any member of the public has the right to produce a film based upon it. Failure to identify the author in the credits frustrates attempts by third parties to determine the date of the unknown author's demise, and thus the date of the screenplay's expiration of copyright.

It can thus be argued that an express provision in a contract permitting the producer to omit the author's name is unenforceable because it violates the policy underlying the 1976 Copyright Act. Although this approach has not yet been formally adopted in any case law, it appears to be firmly rooted in the intent of the statute.

B. *The Lanham Act*

Since the dark days of *Vargas v. Esquire, Inc.*,²⁵ courts have increasingly accepted the concept of the moral right to screen credit.²⁶ The Lanham Act,²⁷ the federal unfair competition law, is perhaps the most

21. 17 U.S.C. § 302(a) (1982).

22. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 135, *reprinted in* 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5751.

23. Final Report of the Ad Hoc Working Group on U.S. Adherence to the Berne Convention - "Moral Rights." 10 COLUM. J.L. & ARTS 513, 522 n.19 (1986).

24. This theory would not help a writer who has written a screenplay as a work made for hire, rather than to have written it and then to have sold it as his or her own work. As a work made for hire, the writer's employer, usually the producer, is considered the author for purposes of copyright protection. 17 U.S.C. § 201(b) (1986) states: "in the case of a work made for hire, the employer . . . for whom the work was prepared is considered the author . . . unless the parties have expressly agreed otherwise in a written instrument signed by them."

25. 164 F.2d 522 (7th Cir. 1947).

26. In the past, the studios had 'morals' clauses in their artist contracts, which could be used to deny screen credit to those who engaged in immoral behavior, which was expanded during the McCarthy era to include allegations of communism. For an excellent review of the "morals clause" see Berman & Rosenthal, *Screen Credit and the Law*, 9 UCLA L. REV. 156, 169-77, (1962). This subject is not dealt with in my law journal article because all guild agreements now prohibit the inclusion of such clauses, and all entertainment lawyers ensure that their clients do not have such clauses in their contracts, so that as a practical matter the whole issue has, hopefully, become moot.

27. Lanham Act, § 43(a); 15 U.S.C. § 1125 (a) (1982): "Any person who shall affix . . . a

effective sword utilized in support of an artist's right to screen credit.²⁸ "One well known treatise . . . suggested that any author may claim a violation of Section 43(a) of the Lanham Act if his work is published without his name."²⁹

The Act effectively contains two causes of action. One cause arises when credit to which the artist is entitled is deleted ("implied reverse passing off"),³⁰ and the other cause arises when work belonging to one artist is attributed to another ("express reverse passing off").³¹ An example of the coexistence of both causes of action is seen in *Smith v. Montoro*.³² There, "defendants not only removed appellant's name from all credits and advertising, they also substituted a name of their own choosing."³³

A typical trademark infringement case under Section 43(a) of the Lanham Act requires that there be a trademark, which is registered, along with a showing of market competition.³⁴ These legal requisites are not required in credit cases. In a credit case, the plaintiff need not prove that a trademark exists,³⁵ that it is registered,³⁶ or that there is market

false designation of origin . . . and shall cause such goods to enter into commerce . . . shall be liable in a civil action . . . by any person who believes he . . . is likely to be damaged by the use of . . . such false . . . representation."

28. *But see Gilliam v. American Broadcasting Co.*, 538 F.2d 14, 26 (2d Cir. 1976). In a concurring opinion, Judge Gurfein rejects the concept of relief for screen credit under the Lanham Act, but no case has ever followed his lead. *Id.* at 26.

29. *Dodd v. Fort Smith Special School Dist.*, 666 F. Supp. 1278, 1284-85 (W.D. Ark. 1987). The commentator being referred to is M. NIMMER, 2 NIMMER ON COPYRIGHT § 8.21 (e) (1987).

Removing credit "amounts to express reverse passing off. . . . [S]uch conduct . . . is wrongful, because it involves an attempt to misappropriate or profit from another's talents and workmanship. Moreover . . . the originator of the misidentified product is involuntarily deprived of its name and of the goodwill that otherwise would stem from public knowledge of the true source of the satisfactory product. . . . [An action for removing credit states] a valid claim for relief under 43(a) of the Lanham Act.

Smith, 648 F.2d at 607.

30. *Supra* note 29.

31. In a third cause of action the artist is forced to seek removal of his credit from the work, either because he had no connection with the work, or because it misrepresents his efforts. The Lanham Act supports this action, since the improper attribution of credit is still a fraud on the public.

32. 648 F.2d 602 (9th Cir. 1981).

33. *Id.* The concept applies not only to performers, but equally to all artists, including producers, directors and authors. *Id.* at 607. *See also Dodd*, 666 F. Supp. at 1278. A teacher and her students wrote a book, which was subsequently given to another writer who made some revisions and then published the book as sole author. No mention was made on the title page of the teacher or her students. *Id.* at 1284.

34. *Dodd*, 666 F. Supp. at 1284.

35. *Id. Accord, Cher v. Forum Int'l, Ltd.*, 213 U.S.P.Q. 96, 102 (C.D. Cal. 1982), *rev'd in part*, 692 F.2d 634 (9th Cir. 1982).

competition. Additionally, the plaintiff is not required to prove consumer confusion typically required under the Lanham Act,³⁷ because screen credit cases are considered *sui generis*. In screen credit cases, the confusion is not caused by a comparison of two competing products labelled with the same name and both in the public domain, but rather is the result of the omission or misidentification of the name of the artist responsible for its creation.³⁸ Absent any express contract language,³⁹ authors have the right to use their own name on their creations.⁴⁰ Authors can bargain away this right of paternity,⁴¹ but this right is expressly reserved unless explicitly conveyed.⁴² It is no defense to a violation under the Lanham Act to state that some of the joint authors to a project were given the appropriate credit.⁴³ "An incomplete designation of the source of the good or service is no less misleading because it is partially correct."⁴⁴

Two benefits result from using the Lanham Act theory. First, federal court jurisdiction is available without a showing of diversity between the parties. Second, once entitlement to protection is established under the Lanham Act, remedies exist both for specific performance of credit

36. *National Lampoon v. American Broadcasting Co.*, 376 F. Supp. 733, 747 (S.D.N.Y. 1974), *aff'd per curiam*, 497 F.2d 1343 (2d Cir. 1974). *Cher* 213 U.S.P.Q. 96.

37. *PPX Enter. v. Audio Fidelity Enter.*, 818 F.2d 266, 272 (2d Cir. 1987).

If the statement actually is false, relief can be granted on the court's own findings without reference to the reaction of the buyer or consumer of the product This is the same conclusion implicitly reached in several cases involving counterfeit Louis Vuitton products, in which plaintiffs appear to have established entitlement to damages absent an evidentiary showing of actual consumer confusion or deception.

Id.

38. *Dodd*, 666 F. Supp. at 1285.

39. *Harms, Inc. v. Tops Music Enter.*, 160 F. Supp. 77 (S.D. Cal. 1958). "Courts will protect against: (a) the omission of the author's name, unless, by contract, the right is given to the publisher to do so" *Id.*

40. *Chesler v. Avon Books Div.*, 76 Misc. 2d 1048, 352 N.Y.S.2d 552 (Sup. Ct. 1973). "The purchaser cannot . . . put it out under another name than the author's, nor can he omit altogether the name of the author, unless his contract with the latter permits him to do so." *Id.* at 1052, 352 N.Y.S.2d at 556.

41. *Harlequin Enter. v. Warner Books, Inc.*, 639 F. Supp. 1081 (S.D.N.Y. 1986) (An author's previous publisher sought to enjoin him from using his own name on new books).

42. *Id.* at 1090. "Since [the contract] permits [the author] to write other books, and does not restrict him from designating himself as author, he is well within his rights in accepting a byline" *Id.*

43. *Lamothe v. Atlantic Recording Corp.*, 847 F.2d 1403, 1408 (9th Cir. 1988) (Two composers re-released their songs and omitted the names of two of their collaborators from acknowledgment or credit).

44. *Id.* at 1408. *See also Kingsmen v. K-Tel Int'l*, 557 F. Supp. 178 (S.D.N.Y. 1983) (Court enjoined the original lead singer of the Kingsmen from releasing his own recording of "Louie, Louie" as by the Kingsmen, when the rest of the group did not join in the recording).

by injunction and for damages for past loss of credit for which injunctive relief is no longer available.

1. Lanham Act Jurisdiction

Until recently, the question of jurisdiction in Lanham Act cases was not an issue, since trademark actions lie properly in federal court,⁴⁵ and pendent jurisdiction bootstraps related causes of action into district court. Once properly in federal court, if "jurisdiction was premised on the Lanham Act, . . . [plaintiff has] proved a cause of action for breach of contract which the court [can] . . . adjudicate on the basis of pendent jurisdiction."⁴⁶ This situation was temporarily upset when a federal court denied jurisdiction because a contract was involved in a Lanham Act case.⁴⁷ The court reasoned that once classified as a contract action, federal jurisdiction was undercut.⁴⁸

When subsequent cases weaved a tortured web to uphold jurisdiction,⁴⁹ a district court finally formulated a concise rule for jurisdiction under the Lanham Act.⁵⁰ The court rejected the concept that jurisdiction is defeated simply by the presence of an issue of contract law.⁵¹ The

45. 28 U.S.C. § 1338(a). "The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to . . . trademarks. Such jurisdiction shall [not] be exclusive of the courts of the states in [trademarks]." *Id.*

46. *Nuchtern v. Vanderbes*, Case 82 Civ. 6182 (S.D.N.Y. 1982) noted in 4 ENT. L. REP. 23 at 2-3 (Aug. 1983).

47. *Bear Creek Prod. v. Saleh*, 643 F. Supp. 489, 494 (S.D.N.Y. 1986).

48. *Id.* But see *Smith v. Montoro*, 648 F.2d 602 (9th Cir. 1981). In a brief footnote, the court in *Bear Creek* offhandedly dismissed *Smith*, the leading case upholding pendent jurisdiction over breach of contract claims without considering whether the content of those claims undercut § 1338 jurisdiction. *Id.* at 494 n.23. The *Bear Creek* court stated:

[p]laintiffs have chosen to rely on the contract in seeking relief. They have set forth no reason upon which it can fairly be argued that the contract will not be dispositive of the parties rights and obligations, and they have cited no § 43(a) cases in which jurisdiction was upheld under 28 U.S.C. § 1338 despite a related claim for breach of contract. Plaintiffs' cases either involved contracts containing no provision regarding credit for the allegedly mislabeled product . . . or did not consider whether the contract at issue might preclude consideration of the Lanham Act and thus defeat jurisdiction under 28 U.S.C. § 1338. . . . Plaintiffs have thus failed to show that their claim "arises under" the trademark laws within the meaning of § 1338.

Id. at 494 (footnote omitted).

49. *CBS Catalogue Partnership v. CBS/FOX Co.*, 668 F. Supp. 282 (S.D.N.Y. 1987). On a motion to dismiss, the district court upheld jurisdiction over a copyright infringement claim despite assertions that the action was really one for breach of contract. It rejected two contentions for dismissal, the first being that "there is no copyright jurisdiction if contract allegations defeat the copyright claim on the face of the complaint," and the second being that a "case does not arise under the federal copyright laws because 'the only issues to be resolved are wholly contractual in nature.'" *Id.* at 283, 284 (quoting *Berger v. Simon & Schuster*, 631 F. Supp. 915 (S.D.N.Y. 1986)).

50. *Foxrun Workshop, Ltd. v. Klone Mfg.*, 686 F. Supp. 86, 89 (S.D.N.Y. 1988).

51. *Id.* at 89-90.

court logically observed that state law questions, including ownership, will invariably arise at the beginning of a case, but this should not lead the court to deny jurisdiction without considering the trademark law issue.⁵² The court rejected the concept advanced by defendant that “the court should look behind the complaint to assess whether the action turns primarily on claims of breach of contract.”⁵³ Interestingly, the court approved the strategy of bringing a parallel action in the state court to enforce breach of contract claims.⁵⁴ One important benefit of the Lanham Act is that it grants federal question jurisdiction totally apart from federal diversity jurisdiction and allows the use of pendent jurisdiction.⁵⁵

C. Remedies

1. Specific Performance

The federal courts have long recognized⁵⁶ that specific performance

52. *Id.*

53. *Id.* at 90-91.

Taking the allegations of the complaint as pleaded, I find that plaintiff ‘has directed his pleading against the offending use . . .’ Workshop has pleaded that the defendants have infringed his trademarks and has not asserted a claim for breach of contract. Although this court may be required to make a preliminary determination that the rights to the trademarks have reverted to plaintiff under the licence agreement, the necessity for that determination does not defeat federal jurisdiction.

Id. (citation omitted).

54. *Id.* at 89.

[T]his case comes within the terms of federal subject matter jurisdiction under § 1338. The theory of the complaint is not the enforcement of contract rights to reversion and royalty payments. Rather, the complaint alleges claims under the Lanham Act. Although [plaintiff] . . . has apparently instituted parallel state adjudication seeking damages from the breach of the licensing agreements, it has directed this pleading against the offending use. The relief the complaint seeks includes a declaration that . . . the defendants have infringed the trademarks, an injunction against future infringement, and treble damages, remedies expressly granted by the Lanham Act.

Id.

55. *Smith*, 648 F.2d at 608. “In addition to the claim under 43(a), appellant’s complaint alleged claims under state law for breach of contract, ‘false light publicity,’ and commercial appropriation of a person’s likeness under Cal. Civ. Code § 3344. Since we are reversing dismissal of appellant’s Lanham Act claim, the dismissal for lack of jurisdiction of appellant’s state law claims is also reversed. ‘One important benefit of 43(a) is that it grants federal question jurisdiction totally apart from federal diversity jurisdiction’. . . Thus, once in federal court under 43(a), a plaintiff can allege related claims of unfair competition under common law and any available state statutory provisions.” *Id.* (quoting 2 J. MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 25.1 (1973)).

56. *Universal Pictures v. Aumont*, No. 7193-O’C (S.D. Cal. 1947), quoted in *Berman & Rosenthal, Screen Credit and the Law*, 9 UCLA L. REV. 156, 179 n.84 (1962).

[T]his is a proper case for granting a Temporary Restraining Order in that credit and billing to an actress in the motion picture industry is of extreme and vital importance and that advertising and paid publicity material issued, released, publicized or published, wherein an actress does not receive the credit to which she is entitled by

is the choice remedy for loss of credit under the Lanham Act.

[T]he failure to give . . . [screen] credit would constitute irreparable injury. Not only would money damages be difficult to establish, but at best they would hardly compensate for the real injury done. A[n] [artist's] . . . reputation, which would be greatly enhanced by public credit for authorship of an outstanding picture, is his stock in trade and it is clear that irreparable injury would follow the failure to give him screen credit if in fact he is entitled to it.⁵⁷

Since "damages are difficult to prove and the harm to the plaintiff's reputation . . . is irreparable, injunctive relief is appropriate."⁵⁸ Unfortunately, some courts have not understood the dynamics of the entertainment business, declaring that a damage remedy was sufficient, since "screen credits have little or no significance and any resulting harm by failure to include [the] name in the credits will be minimal."⁵⁹

A more sensible approach was taken by the court in *National Lampoon v. American Broadcasting Companies, Inc.*⁶⁰ ("*National Lampoon*"). In *National Lampoon*, the publisher of the satirical magazine "National Lampoon" brought suit to enjoin ABC from using the word "Lampoon" in its title for a pilot television program of humor and entertainment.⁶¹ The court enjoined ABC from using "Lampoon,"⁶² stat-

reason of her status in the industry and agreements therefore can and will as a proximate result thereof cause said motion picture actress to suffer great and irreparable damage and harm to her reputation and standing both personally and as a motion picture actress in the eyes of the motion picture industry and the public generally

Id. at 179 n.84.

57. *Poe v. Michael Todd Co.*, 151 F. Supp. 801, 803 (S.D.N.Y. 1957).

58. *Granz v. Harris*, 198 F.2d 585, 588 (2d Cir. 1952). *See also Uhlaender v. Henricksen*, 316 F. Supp. 1277, 1283 (D. Minn. 1970). In *Uhlaender* the court found damages inadequate stating:

[i]t seems clear to the court that a celebrity's property interest in his name and likeness is unique, and therefore there is no serious question as to the propriety of injunctive relief. Defendants have violated plaintiff's rights by the unauthorized appropriation of their names and statistics for commercial use. The remedy at law, considering particularly the difficulty in determining and measuring damages, past or future, is inadequate.

316 F. Supp. at 1283.

59. *Luster Enter. v. Jacobs*, 78 F. Supp. 73, 75 (S.D.N.Y. 1967). "If a screen credit is improperly denied her by the defendants she has an action in damages. One of the forgotten functions of the damage remedy is to apprise members of the community of the rights which the court has adjudicated in the plaintiffs' favor. If the plaintiffs prevail in this action the attendant publicity and the subsequent damage award will make . . . [plaintiff] whole within her professional community." *Id.* at 75.

60. *National Lampoon v. American Broadcasting Co.*, 376 F. Supp. 733 (S.D.N.Y. 1974).

61. *Id.* at 736.

62. *Id.* at 750.

ing that "money damages are inadequate. The law recognizes that the consequences of trademark infringement, or passing off and unfair competition generally, are by their nature not fully compensable by money damages."⁶³ Having established the right to enjoin a property before production, the court then extended the equitable remedy to those situations where plaintiff sought to prevent release of the television program after completion.⁶⁴

2. Preliminary Injunction

The issuance of a preliminary injunction is regarded by the courts as an extraordinary remedy which should not be granted unless the movant demonstrates:

- (1) a threat of irreparable harm, (2) that the state of balance between the harm likely to be suffered by the movant and the injury the injunction will inflict on other parties favors the movant, (3) a probability that the movant will succeed on the merits and (4) that the public interest favors the granting of the injunction.⁶⁵

In credit cases, irreparable harm is presumed and therefore exists as a matter of law.⁶⁶ The presumption arises because proof of a likelihood of confusion satisfies the requirement of irreparable harm,⁶⁷ and a likelihood of confusion is inferred.⁶⁸ The presumption is created by combining several rules of law. One rule of law states that if the plaintiff

63. *Id.* The court was under no illusions as to the nature of National Lampoon when it remarked

[e]ven if we assume defendants' program will be funnier, or better, or more acceptable in regard to its conformity with general public standards of taste, than a television series which plaintiff [National Lampoon] produced, nonetheless irreparable injury is present. . . . Trash though it may be, plaintiff's magazine does have a consistent 'product quality' as do its other products

Id. at 749-50.

64. *Nuchtern v. Vanderbes*, Case 82 Civ. 6182 (S.D.N.Y. 1982), noted in 4 Ent. L. Rep. 24, at 2-3 (May 1983). The producer tried to list himself as co-director of the film. "The court found that Nuchtern had not agreed to Vanderbes' proposal to a shared or different credit on the film[,] and that there was substantial evidence to establish Nuchtern's contribution as the sole director of . . . [the film]. [H]aving shown irreparable harm and loss to his reputation if he failed to receive director credit, was awarded a preliminary injunction." *Id.* at 3.

65. *Dodd*, 666 F. Supp. at 1285.

66. *Id.*

67. *Id.*

68. *Id.*

The confusion here is not caused by a comparison of two products both in the public domain. Here the 'confusion' is the result of the alleged false representation of . . . [the credited author] as the preparer and editor of the work in question. Undoubtedly, the public would have no reason to doubt or question the statement in the book that . . . [the credited author] was responsible for these activities. [The credited au-

ultimately succeeds on the merits, but was unable to obtain an injunction, he would have suffered irreparable harm.⁶⁹ Another rule of law holds that "if plaintiff carries its burden of establishing a likelihood of confusion, it will have satisfied both the element of possible irreparable harm and the element of probable success on the merits."⁷⁰ Since the court can infer confusion,⁷¹ irreparable harm exists as a matter of law if the plaintiff can establish his or her right to the credit.

An injunction to enforce screen credit is an equitable remedy which the plaintiff can jeopardize, either by waiting too long after the commencement of the lawsuit before seeking his or her injunction,⁷² or by knowingly allowing the picture to be released without previously seeking an injunction.⁷³ However, if the plaintiff fails to ask for an injunction early in the action, he or she can still preserve his or her later right to equitable relief by giving the defendant notice.⁷⁴

thor) would be receiving credit or at least part of the credit rightfully belonging to others.

Id.

69. *Camp Beverly Hills, Inc. v. Camp Central Park, Inc.*, 217 U.S.P.Q. 783 (S.D.N.Y. 1982), *aff'd*, 697 F.2d 288 (2d Cir. 1982).

[I]n Lanham Act cases, '[t]here is no question that irreparable harm would result from a failure to enjoin if the plaintiff ultimately succeeds on the merits.' This conclusion stems from the nature of the rights protected by the Lanham Act, and the recognition that consequences of trademark infringement and unfair competition 'are by their nature not fully compensable by money damages.'

Id. at 785 n.12 (quoting *Cuisinarts Inc. v. Robot-Coupe Int'l Corp.*, 509 F. Supp. 1036, 1044-45 (S.D.N.Y. 1981)).

70. *Camp Beverly Hills*, 217 U.S.P.Q. at 785 (emphasis omitted).

71. *See supra* note 68.

72. *Jaeger v. American Int'l Pictures, Inc.* 330 F. Supp. 274, 281 (S.D.N.Y. 1971).

[T]he plaintiff has not been notably prompt in the assertion of his rights. While he saw the allegedly distorted film in December and brought his action then, he waited until February to move for injunctive relief . . . the court must . . . weigh the developing equities that have continued to grow on the side of the defendant. . . . [T]he court is compelled to conclude that the potential injury against which the plaintiff seeks protection is far outweighed by the clear and substantial hurt defendants would suffer from the issuance now of a preliminary injunction.

Id.

73. *Poe v. Michael Todd Co.*, 151 F. Supp. 801, 802 (S.D.N.Y. 1957). "The plaintiff . . . writer . . . [sought] a preliminary injunction to enjoin the exhibition of a motion picture entitled *Around the World in Eighty Days* . . . unless the defendants give him screenplay writing credit." *Id.* Plaintiff was denied relief on the grounds he knew about the screen credit problem, yet delayed filing his motion for an injunction until three months after the picture was released, and was left only with his action for damages. *Id.*

74. *National Lampoon*, 376 F. Supp. at 750. When "all [the] time and money invested by defendants occurred with notice of plaintiff's rights, after plaintiff's demand letter . . .," the court ordered the injunction. *Id.*

3. Damages

Under the Lanham Act, if the court cannot award specific performance, a plaintiff can obtain damages for both past and future denial of credit.⁷⁵ The cases in this area were initially based on an incorrect judicial presumption that the loss of credit had no pecuniary value. Today there is acknowledgment that screen credit alone has monetary value.⁷⁶

4. Entertainment Guild Remedies

Various artists guilds ("Guilds"), representing writers,⁷⁷ directors,⁷⁸ and actors⁷⁹ have negotiated with major studios, networks and other signatories to their union agreements to insure that Guild members have a right to receive screen credit for all projects in which Guild members have been involved. This right emerged from collective bargaining sessions, and as a result all the Guilds have similar provisions in their basic Guild agreements providing for screen credit.⁸⁰ In addition to establishing an artist's general right to credit, the union agreements also specify the exact wording required for the credit, and in the case of multiple parties entitled to the same credit, the order and type of credit applicable to each artist. The Directors Guild of America ("DGA") has gone to the extreme of insuring that no other guild in the industry can have a credit sounding similar to "Director."⁸¹ A provision in the DGA's basic agreement prohibits members of any other union from being awarded any

75. *Paramount Prod., Inc. v. Smith*, 91 F.2d 863, 866-67 (9th Cir. 1937), *cert. denied*, 302 U.S. 749 (1937).

76. *Id.*

77. *Id.* Writers Guild of America ("WGA"), Theatrical and Television, Basic Agreement of 1988, effective Aug. 8, 1988. "Credit shall be given on the screen for the screenplay authorship of feature length photoplays" (Features Schedule A), and "Credit shall be given on the screen for the authorship of stories and teleplays." (Television Schedule A). *Id.*

78. Directors Guild of America, Inc. ("DGA"), Basic Agreement of 1987, § 8-201:

The Director of the film shall be accorded credit on all positive prints and all videodiscs/videocassettes of the film. . . . No other credit shall appear on the card which accords credit to the Director of the film. Such credit shall be on the last title card appearing prior to principal photography.

Id.

79. For example, the Screen Actors Guild mandates that every member of its union who appears in a film will receive at least one credit in the main titles. 1977 Screen Actors Guild ("SAG") Television Agreement 51, § 54; Screen Credit and Billing (a) (1); and 1977 SAG Theatrical Agreement 31, § 25. Screen Credits, provide that "a cast of characters on at least one card shall be placed at the end of each television motion picture [theatrical feature] naming the actor and the role portrayed."

80. *See generally*, Berman & Rosenthal, *Screen Credit and The Law*, 9 UCLA L. REV. 156 (1962).

81. DGA Basic Agreement of 1984, § 8-103(a).

credit which even remotely sounds like that of a "Director."⁸²

The Guilds not only insure their members receive the proper screen credit in the first instance, but they also insure that screen credit, once awarded, will never be removed from the print.⁸³ Even if the production is later assigned to a distribution company, licensed into television syndication, released on cable, or sold outright to the public on video cassette, the Guilds have incorporated safeguards into their agreements which mandate the attachment of the credit to the released copy, and which contractually binds the new owner to retain the credit in all subsequent uses of the title.⁸⁴

D. Federal Preemption

With the adoption of the Berne Treaty, Congress had the option to pass legislation specifically granting paternity rights to authors, and thus preempt state law. However, since the federal legislature failed to act in this area, the states are free to pass their own legislation guaranteeing the paternity rights of artists in their works.⁸⁵ The framers of the Berne-implementing legislation made it clear that "[t]he scope of Federal preemption under this section is not affected by the adherence of the United States to the Berne Convention."⁸⁶

82. *Id.*

The Employer will not hereafter . . . enter into any agreement with any [other] guild . . . where it agrees to accord members thereof credit on screen . . . which includes the word "Director" or "Direction," or any derivation thereof. . . . The Directors Guild has used this provision to prevent the term "Casting Director" from being credited to any person on any film or television show under their jurisdiction, although this provision was instituted too late to prevent the creation of the credit for "Director of Photography."

Id.

83. WGA Theatrical and Television, Basic Agreement of 1988, effective Aug. 8, 1988. (Theatrical Schedule A at 252), and the almost identical provision in 1977 SAG Television Agreement 51, § 54, Screen Credit and Billing (b) (1): "In its distribution and licensing agreements with exhibitors, distributors, broadcasters, etc., Producer will include a provision prohibiting the licensee from eliminating or changing the billing as it appears on the positive prints of the motion picture."

84. DGA Basic Agreement of 1987 § 8-307, Assumption of Obligations: "Employer shall specifically contract with its distributors and the television networks that they shall not cut, edit, move or omit the credit of the Director as placed by the Employer on the positive prints."

Id.

85. *Morseburg v. Balyon*, 621 F.2d 972, 978 (9th Cir. 1980), *cert. denied*, 449 U.S. 983 (1980). "The crucial inquiry is not whether state law reaches matters also subject to federal regulation, but whether the two laws function harmoniously rather than discordantly." *Id.* at 978. Since federal copyright law does not encompass the issue of moral rights, it does not seem to preempt state moral rights legislation.

86. Section 301 is amended by adding at the end thereof the following: (e): Berne Convention Implementation Act of 1988. Preemption with Respect to Other Laws Not Affected. CONG. REC. S14622 (daily ed. Oct. 5, 1988).

California and New York have enacted modern statutes that establish a paternity right for works of fine art.⁸⁷ However, the legislatures have not expanded the rights granted in those statutes to the screen trade.⁸⁸ For example, California specifically grants to the artist, in those cases where the state purchases a work of art, the "right to claim authorship of the work of art"⁸⁹ "or, for just and valid reason, to disclaim authorship of his . . . work of fine art."⁹⁰ To protect those rights, the California statute authorizes injunctive relief, actual and punitive damages and attorneys and expert witness fees.⁹¹ New York has adopted identical statutes.⁹² While these statutes do not grant rights for screen credit presently, the mere existence of the statutes holds out hope of future guarantees of statutory protection for the right to paternity at the state level. Nevertheless, there is protection for artists under a wide variety of other state laws.

II. A COMPILATION OF AVAILABLE LEGAL THEORIES FOR PATERNITY RIGHTS: RIGHT TO CREDIT UNDER STATE LAW

A. *Unfair Competition*

1. California

California's recognition of the concept of a misleading credit as unfair competition predates modern enactments.⁹³ As early as the days of Charlie Chaplin's silent films, the courts recognized that

[p]laintiff has the right to be protected against unfair competition in business. . . . The foregoing principles of law do not apply alone to the protection of parties having trademarks and trade names. They reach way beyond that and apply to all cases where fraud is practiced by one in securing the trade of a rival dealer and these ways are as many and as various as the

87. See *Community For Creative Non-Violence v. Reid*, 846 F.2d 1485, 1498 (D.C. Cir. 1988). "Independent of Reid's ownership of the copyright, CCNV might be obliged to credit Reid as an author of the sculpture." *Id.* at 1498.

88. Brown, *Adherence to the Berne Copyright Convention: The Moral Rights Issue*, J. COPYRIGHT SOC. OF THE USA, 196, 196-209, April 1988.

89. CAL. CIV. CODE § 987(d) (West 1982 & Supp. 1983).

90. *Id.*

91. *Id.* at § 987(e).

92. N.Y. ARTS & CULT. AFF. LAW, § 14.03 (McKinney Supp. 1988). "[T]he artist shall retain at all times the right to claim authorship, or, for just and valid reason, to disclaim authorship of his . . . work of fine art." *Id.*

93. *Chaplin v. Amador*, 93 Cal. App. 358, 276 P. 544 (1928).

ingenuity of the dishonest schemer can invent.⁹⁴

Once denial of credit is established, the California plaintiff can use the unfair competition statute, which mirrors the federal Lanham Act,⁹⁵ and which specifically provides for injunction.⁹⁶ The federal courts first recognized that the state statute, California Business and Professions Code Section 17203,⁹⁷ was directly parallel to the federal statute and invoked it in California federal cases.⁹⁸ One drawback to section 17203 is that the plaintiff's remedy is limited to injunctive relief, unless grounded in a claim other than unfair competition.⁹⁹ However, a parallel section permits the award of monetary damages.¹⁰⁰ Because "pecuniary com-

94. *Id.* The court was

perpetually enjoining and restraining [defendants] . . . from using the name 'Charles Aplin' or 'Charlie Aplin,' or any other name similar to that of plaintiff [Charlie Chaplin] in connection with . . . any motion picture, in imitation of the motion pictures of plaintiff, which will be likely to deceive the public into believing that plaintiff is acting the role therein hereafter referred to

Id. at 359, 276 P. at 545.

95. CAL. BUS. & PROF. CODE § 17200 (West 1987 & Supp. 1989). Unfair Competition: [U]nfair competition shall mean and include unlawful, unfair, or fraudulent business practice and unfair, deceptive, untrue or misleading advertising" *Id.*

96. CAL. BUS. & PROF. CODE § 17203 (West 1987 & Supp. 1989).

Any person performing or proposing to perform an act of unfair competition within this state may be enjoined in any court of competent jurisdiction. The court may make such orders or judgments . . . as may be necessary to prevent the use or employment by any person of any practice which constitutes unfair competition . . . or as may be necessary to restore to any person in interest any money or property, real or personal, which may have been acquired by means of such unfair competition.

Id.

97. CAL. BUS. & PROF. CODE § 17203 (West 1987 & Supp. 1989).

98. *Meta-Film Assoc. v. MCA, Inc.*, 586 F. Supp. 1346 (C.D. Cal. 1984).

In light of the expansive construction given statutory unfair competition by the California courts, the court has concluded that the defendants' alleged failure to provide plaintiff with a screen credit for having written portions of *Animal House* states a claim under Business and Professions Code § 17203. In reaching this conclusion, the court is guided by this Circuit's decision in *Smith v. Montoro*, 648 F.2d 602 (9th Cir. 1981), a case construing § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

Id. at 1362.

In *Smith*, the Ninth Circuit relied heavily upon the common law of unfair competition to assist in its construction of the Lanham Act. . . . As in *Smith*, the plaintiff alleges that the defendants deprived it of a valuable screen credit and that their action involves an attempt to misappropriate another's talents and workmanship. The court believes that such a practice, which the Ninth Circuit found "unfair," is also "wrongful" and therefore is proscribed by § 17203.

Id. at 1363.

99. *Supra* note 97.

100. *Meta-Film Assoc. v. MCA, Inc.*, 586 F. Supp. 1346, 1363 (C.D. Cal. 1984).

[In] certain circumstances, courts may award monetary relief in statutory unfair competition actions; under Business and Professions Code § 17535, the section parallel to § 17203, "the trial court has authority to order restitution as a form of ancillary relief in . . . an injunctive action [The court may do so if it] determines that such a remedy is necessary to deter future violations of the unfair trade practice statute or to foreclose the defendant's retention of any ill-gotten gains."

compensation for [plaintiff's] future harm is not a fully adequate remedy,"¹⁰¹ plaintiff may receive specific enforcement of screen credit under theories other than unfair competition.¹⁰²

California case law has authorized injunctive relief for the loss of screen credit because the legal remedies available to the injured party for harm resulting from future exhibition of a film without proper attribution of screen credit are inadequate as a matter of law.¹⁰³ Three separate and distinct legal theories support an injunction for screen credit in California: (1) that an accurate assessment of damages would be far too difficult and require much speculation; (2) that any future exhibitions might be deemed to be a continuous breach of contract and thereby create the danger of a multiplicity of lawsuits; (3) the failure to give credit constitutes irreparable injury, for which damages could not adequately compensate.¹⁰⁴

Id.

101. *Tamarind Lithography Workshop, Inc. v. Sanders*, 143 Cal. App. 3d 571, 577, 193 Cal. Rptr. 409, 412 (1983).

102. *Id.* at 575. 193 Cal. Rptr. at 411.

The availability of the remedy of specific performance is premised upon well established requisites. These requisites include: a showing by plaintiff of (1) the inadequacy of his legal remedy; (2) an underlying contract that is both reasonable and supported by adequate consideration; (3) the existence of a mutuality of remedies; (4) contractual terms which are sufficiently definite to enable the court to know what it is to enforce; and (5) a substantial similarity of the requested performance to that promised in the contract.

Id.

103. CAL. CIV. PROC. CODE § 526 (West 1979 & Supp. 1989) states in pertinent part:

An injunction may be granted in the following cases:

1. When it appears by the complaint that the plaintiff is entitled to the relief demanded, and such relief, or any part thereof, consists in restraining the commission or continuance of the act complained of, either for a limited period or perpetually;
2. When it appears by the complaint or affidavits that the commission or continuance of some act during the litigation would produce waste, or great or irreparable injury, to a party to the action;
3. When it appears, during the litigation, that a party to the action is doing, or threatens, or is about to do, or is procuring or suffering to be done, some act in violation of the rights of another party to the action respecting the subject of the action, and tending to render the judgment ineffectual;
4. When pecuniary compensation would not afford adequate relief;
5. Where it would be extremely difficult to ascertain the amount of compensation which would afford adequate relief;
6. Where the restraint is necessary to prevent a multiplicity of judicial proceedings;
7. Where the obligation arises from a trust.

Id.

104. Although not specifically stated by the court in *Tamarind*, injunctive relief was presumably authorized by CAL. CIV. PROC. CODE (CCPC) § 526(2), (5), (6). CCPC § 526(5) provides that an injunction may be granted "[w]here it would be extremely difficult to ascertain the amount of compensation which would afford adequate relief . . ." CCPC § 526(6) provides that an injunction may be granted "[w]here the restraint is necessary to prevent a multiplicity of judicial proceedings . . ." CCPC § 526(2) provides that an injunction may be

2. New York

New York's unfair competition law also provides a basis for injunctive relief. However, early cases displayed a lack of understanding of the entertainment business. For example, in *Loren v. Samuel Bronston Productions, Inc.*¹⁰⁵ ("Loren") the court failed to perceive the importance of screen billing.¹⁰⁶ In *Loren*, actress Sophia Loren moved for injunctive relief to halt the showing of the movie *El Cid* (Allied Artists 1961) because she did not receive the billing to which she was entitled by a written agreement.¹⁰⁷ Loren was to receive "second (2nd) star billing above the title, 100% the size and type of the title, on the same line, same size, same prominence as that used for [co-star] Charlton Heston, who received first (1st) star billing."¹⁰⁸ The court denied the actress' request for an injunction observing that "[t]here is also a genuine question whether, even if the plaintiff's claims under the billing clause of the . . . agreement are upheld, Miss Loren is really in danger of suffering the loss of prestige and other damage attributed to its nonobservance."¹⁰⁹

While New York courts had hinted at the potential for injunctive relief,¹¹⁰ it was the federal courts, applying New York law, which first

granted "[w]hen it appears by the complaint or affidavits that the commission or continuance of some act during the litigation would produce waste, or great or irreparable injury, to a party to the action"

105. 32 Misc. 2d 602, 224 N.Y.S.2d 959 (Sup. Ct. 1962).

106. *Id.* at 603, 224 N.Y.S.2d at 960.

The egocentricity which appears to be indigenous to "show business" is here manifested by the passionate insistence of a well known motion picture actress to have her name emblazoned on Broadway not only in the same type of the same size, but also on the same line, as that of her male lead. Such vanity — "the frail estate of human things", a "splendid but destructive egotism," as it has variously been called — doubtless is due in measurable part to the adulation which the public showers on the denizens of the entertainment world in a profusion wholly disproportionate to the intrinsic contribution which they make to the scheme of things when seen in correct perspective. For that matter often in disproportion to any true talent, latent or apparent!

Id.

107. *Id.* at 604, 224 N.Y.S.2d at 961.

108. *Id.*

109. *Id.*

110. *Preminger v. Columbia Pictures Corp.*, 49 Misc. 2d 363, 372, 267 N.Y.S.2d 594, 603 *aff'd*, 25 A.D.2d 830, 269 N.Y.S.2d 913, *aff'd*, 18 N.Y.2d 659, 219 N.E.2d 431, 273 N.Y.S.2d 80 (1966). Otto Preminger objected to television cuts for *Anatomy of a Murder*.

The criterion for the determination of what the defendants were likely to do with respect to interrupting and cutting the subject film, in the absence of a specific contractual arrangement, was not what plaintiffs might disapprove of or dislike but, rather, what was the normal custom and practice in the industry.

Id. at 371, 267 N.Y.S.2d at 603. "Should such 'mutilation' occur in the future, plaintiffs may make application to this court for injunctive or other relief against such violation as they may be advised." *Id.* at 372, 267 N.Y.S.2d at 603.

established that a cause of action existed under the state unfair competition law.¹¹¹ The New York state courts followed suit.¹¹²

3. Damages

Judicial ignorance of the inherent value of screen billing lay at the root of early cases in California. In these cases, plaintiffs unsuccessfully attempted to convince courts that credit, even for a commercial flop, had value within the entertainment community.¹¹³ *Smithers v. Metro-Goldwyn-Mayer Studios*¹¹⁴ (“*Smithers*”), introduced the concept that damages were recoverable for denial of screen credit despite the fact that the credit had been denied on a production which was a financial failure.¹¹⁵ *Smithers* was hired as an actor on a television series which had poor ratings.¹¹⁶ In order to overhaul the show, the producer decided to change the storyline and the billing of the actors.¹¹⁷ Though his contract specified that *Smithers* was to be billed as the third lead in the series, he

111. *National Lampoon*, 376 F. Supp. at 747.

Plaintiff also establishes a right to relief under New York law. To prevail under the common law of unfair competition and General Business Law § 368-d, plaintiff need not prove more than notice to defendants, which was timely given, and that there will be dilution of the mark which will have a detrimental effect, particularly in an area of normal expansion. . . . In addition, the plaintiff need not prove secondary meaning.

Id. at 747.

112. *Shaw v. Time-Life Records*, 38 N.Y.2d 201, 341 N.E.2d 817 (1975).

The defendant's promotional materials offered consumers an opportunity to purchase “Artie Shaw versions” of Swing Era classics. It is impossible to say, as a matter of law, that reasonably discriminating consumers would discern that these “versions” were not authentic Shaw performances, but were instead attempted re-creations by modern day musicians. We believe that the plaintiff has made a sufficient factual showing to entitle him to present his case to the jury. A triable issue of fact exists as to whether reasonably discriminating members of the public would be confused or misled by defendant's advertising.

Id. at 206-07, 341 N.E.2d at 800-21.

113. *See, e.g., Zorich v. Petroff*, 152 Cal. App. 2d 806, 811, 313 P.2d 118, 122 (1957).

With respect to the claim of *Zorich* [plaintiff] that he was entitled to screen credit, the court impliedly found that he was entitled to credit, but if he has not received it and does not receive it, he has suffered and will suffer no damage. It is sufficient to say on this point that there was no evidence from which the court could have placed a value upon the screen credit to be given plaintiff as an associate producer (Civ. Code, § 3301.) It is undisputed that no profits have been realized from the picture and there was apparently a \$36,000 deficit. Upon the evidence that was before the court as to the lack of success of the picture, receipt of screen “credit” by plaintiff could reasonably have been regarded as a detriment to him.

Id.

114. 189 Cal. Rptr. 20 (App. 1983).

115. *Id.* at 4.

116. *Id.* at 22.

117. *Id.* at 22-23.

was only given credit as the fourth lead.¹¹⁸

In support of his claim, Smithers produced several experts to demonstrate the direct correlation between credits and future earnings.¹¹⁹ For example, an agent from the William Morris Agency testified that credit "is as important as compensation, [that credits] and money go hand in hand [and that] a lot of times you forego money [for credits]."¹²⁰ The court finally put to rest the defense argument that "damages arising from such breach were speculative and incapable of ascertainment."¹²¹ In rejecting that contention, the court stated

[o]ne who wilfully breaches the contract bears the risk as to the uncertainty or the difficulty of computing the amount of damages. . . . A number of witnesses established the relationship between billing and the actor's future negotiation for compensation. The jury could reasonably conclude from the evidence that Smithers suffered an economic loss by reason of MGM's failure to live up to its agreement. Although witnesses were unable to estimate with precision how much Smithers had lost or how much he would earn in future years, the jury was provided a reasonable basis upon which to calculate damages.¹²²

The court found that such a reduction of credit would have serious long term effects on Smithers' career.¹²³ *Smithers* firmly establishes the concept that credit alone has monetary value and removes the onus from plaintiffs to establish with absolute precision the value of that credit.¹²⁴

118. *Id.*

119. *Smithers*, 189 Cal. Rptr. at 23. The judge stated, "the threat was extraneous to the contract, not only intending to bludgeon Smithers into foregoing his contractual rights but also threatening action directly affecting the practice of his art and damaging to his future earning power." *Id.* at 23.

120. Plaintiff's Memorandum of Points and Authorities in Opposition to Defendants Motion for New Trial at 12-13. The jury awarded Smithers \$3.5 million, which included \$500,000 for breach of contract, \$1 million compensatory damages, and \$2 million in punitive damages. The trial court reduced the jury's punitive award to \$1 million, leaving a total recovery of \$2.5 million. Order Denying Motion for Judgment Notwithstanding the Verdict and Order Denying Motion for New Trial on Condition Plaintiff Accepts Certain Reduction of Damages (Aug. 21, 1981).

121. *Smithers*, 189 Cal. Rptr. at 24.

122. *Id.* (citation omitted).

123. *Id.* at 23.

124. *Id.* at 23-24. New York has also recognized the damage remedy for loss of credit, at least in those cases where "each plaintiff willingly agreed that they would sing the records in question and that they were not to receive any money for their services [T]heir services were rendered to . . . [defendants] in the hope on their part that the professional and commercial exploitation of the records might rebound to their credit in their profession" Long v. Decca Records, 76 N.Y.S.2d 133, 135 (Sup. Ct. 1947).

III. REMOVAL OF CREDIT

The battles are not always over receiving credit. For a variety of reasons, artists wish to remove their name from a project.¹²⁵ A number of legal theories support the artist in removing the credit,¹²⁶ including invasion of privacy, libel, guild provisions, misrepresentation and the lack of association of the artist with the enterprise.

A. Invasion of Privacy

1. California

In California, the misappropriation of a person's name or likeness for commercial advantage is an invasion of privacy.¹²⁷ This misappropriation permits recovery based on a violation of California Civil Code Section 3344.¹²⁸ At the minimum, the misappropriation will result in

125. Despite the furor over the colorization of black and white films, no artist has yet attempted to mandate removal of his or her credit from the color version, based on the fact that the remodeled films were not their work. The author suggests that this approach, utilizing one of theories discussed in this article, might be more effective than the hysteria which presently surrounds this issue. See *The Colorization of Black and White Films: An Example of the Lack of Substantive Protection for Art in the United States*, 63 NOTRE DAME L. REV. 309 (Summer 1988).

126. Presumably, the laws of unfair competition, both federal and state, would apply equally in cases for removal of credit as they would in denial of credit, since the basic concept is the same: any misrepresentation of the true origin of the film, whether it pertains to denying a valid credit or removing a bogus credit, serves to protect the public from a false designation of the origin of the goods.

This concept of removing a credit to avoid defrauding the public was recognized quite early, in *Paramount Prod. v. Smith*, 91 F.2d 863 (9th Cir. 1937), cert. denied, 302 U.S. 749 (1937). The dissenting judge recognized "[t]hus it is believed other motion picture producers will seek to avail themselves of the services of the person given screen credit . . . [t]o a person not reasonably entitled thereto would be a fraud upon the public . . ." *Id.* at 867 (dissenting opinion).

127. For a privacy case predating the statute, see *Kerby v. Hal Roach Studios*, 53 Cal. App. 2d 207. A woman's name was put on a very risqué publicity letter sent out by the studio. It was the name of the character in the film. Because she was the only one by that name in the Los Angeles telephone directory, she was able to recover the damage to her reputation that such false credit caused. *Id.* at 209-10.

128. CAL. CIV. CODE § 3344(a) (West Supp. 1989):

Any person who knowingly uses another's name, voice, signature, photograph, or likeness, 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, . . . without such person's prior consent, or in the case of a minor, the prior consent of his parent or legal guardian, shall be liable for any damages sustained by the person or persons injured as a result thereof. In addition, in any action brought under this section, the person who violated the section shall be liable to the injured party or parties in an amount equal to the greater of seven hundred fifty dollars (\$750) or the actual damages suffered by him or her as a result of the unauthorized use, and any profits from the unauthorized use that are attributable to the use and are not taken into account in computing the actual damages. In establishing such prof-

statutory damages.¹²⁹ California also considers it actionable to violate a person's right of publicity,¹³⁰ or to appropriate one's likeness with a celebrity look-alike.¹³¹ Such a violation can result in both compensatory and punitive damages.¹³²

Although recognizing the right of privacy, California courts were reluctant to extend this protection past death.¹³³ In *Lugosi v. Universal Pictures*,¹³⁴ the court denied protection to Bela Lugosi's persona of "Dracula" after his death.¹³⁵ In response to this decision, the California legislature responded with an additional statute, California Civil Code Section 990.¹³⁶ Section 990 mirrored the language of section 3344, and extended the privacy theory of credit to deceased persons.¹³⁷ Borrowing from federal copyright law, the legislature adopted a time period of death plus fifty years for the protection of these rights.¹³⁸

its, the injured party or parties are required to present proof only of the gross revenue attributable to such use, and the person who violated this section is required to prove his or her deductible expenses. Punitive damages may also be awarded to the injured party or parties. The prevailing party in any action under this section shall also be entitled to attorney fees and costs.

Id.

129. *Ericson v. Playgirl, Inc.*, 73 Cal. App. 3d 850, 859, 140 Cal. Rptr. 921, 927 (1977). At the very least, plaintiff is

entitled to recover nominal damages for breach of contract. We evaluate plaintiff's right to nominal damages by analogy to Civil Code section 3344, which provides minimum statutory damages of \$300 [now \$750] for knowing commercial use of a person's name or likeness without his consent. The statute's obvious purpose is to specify an amount for nominal damages in situations where actual damages are impossible to assess.

Id.

130. *Cher*, 692 F.2d at 634.

131. *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988). "We hold only that when a distinctive voice of a professional singer [Bette Midler] is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a tort in California." *Id.* at 463.

132. *Clark v. Celeb Publishing, Inc.*, 530 F. Supp. 979, 982 (S.D.N.Y. 1981). Punitive damages predicated on CAL. CIV. CODE § 3294, if guilty of "oppression, fraud, or malice, express or implied. . . ." *Id.* at 984.

133. *Lugosi v. Universal Pictures*, 25 Cal. 3d 813, 160 Cal. Rptr. 323 (1979) (Bela Lugosi's heirs); *James v. Screen Gems, Inc.*, 174 Cal. App. 2d 650, 344 P.2d 799 (1959) (Widow of Jesse James, Jr.).

134. 25 Cal. 3d 813, 160 Cal. Rptr. 323 (1979).

135. *Id.* at 824, 160 Cal. Rptr. at 329.

136. CAL. CIV. CODE § 990 (West 1982 & Supp. 1989). See also S. Rodhe, *Dracula, Still Undead*, 5 CAL. LAW. 51 (1985).

137. CAL. CIV. CODE § 990(b) (West 1982 & Supp. 1989). "The rights recognized under this section are property rights, freely transferable, in whole or in part, by contract or by means of trust or testamentary document . . ." *Id.*

138. CAL. CIV. CODE § 990(f) (3) (West 1982 & Supp. 1989).

2. New York

A similar right to removal of credit¹³⁹ for unauthorized commercial exploitation of a person's name or likeness exists in New York under Civil Rights Law Section 51.¹⁴⁰ Even before the adoption of section 51, the New York courts had recognized the right to remove credit for invasion of privacy in those cases in which a person's name is placed on a work with which he or she had no connection.¹⁴¹ Once the statute was enacted, it was used to remove credit from works in which the artist did not play an active role in its creation.¹⁴²

This right of privacy exists distinct from any contractual relationship between the parties,¹⁴³ and is also separate from the common law right of publicity.¹⁴⁴ In New York, the statutory right of privacy does

139. *Durgom v. Columbia Broadcasting System*, 214 N.Y.S.2d 752, 754 (1961). "One who chooses to portray another, by name or photograph, for trade purposes, runs the risk that the latter may sue for an injunction and/or damages." *Id.*

140. *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 726 (S.D.N.Y. 1978). Playgirl used a drawing which looked like Muhammad Ali. The court found this a violation of CIV. RIGHTS § 51 and awarded Muhammad Ali an injunction prohibiting further distribution of the magazine. *Id.*

Section 51 of the New York Civil Rights Law provides in pertinent part: Any person whose name, portrait or picture is used within this state for . . . the purposes of trade without the written consent [of that person] may maintain an equitable action . . . against the person, firm or corporation so using his name, portrait or picture, to prevent and restrain the use thereof; and may also sue and recover damages for any injury sustained by reason of such use

Id. See also, *Jaeger*, 330 F. Supp. at 278; *Onassis v. Christian Dior-New York, Inc.*, 122 Misc. 2d 603, 472 N.Y.S.2d 254 (N.Y. Sup. Ct. 1984) (use of Jackie Onassis' look-alike in advertisement actionable as privacy violation).

141. *Eliot v. Jones*, 120 N.Y.S. 989, 990 (Sup. Ct. 1910). Dr. Eliot, the former president of Harvard, consented to the use of his name on a series of books. A rival publisher, without his consent, pirated Dr. Eliot's name for use on his book series. *Id.*

142. An author has a right under the New York Civil Rights Law to ensure that any attribution to him accurately reflects his contribution to a manuscript. *Gieseeking v. Urania Records, Inc.*, 17 Misc. 2d 1034, 1035, 155 N.Y.S.2d 171 (Sup. Ct. 1956).

"A performer has a property right in his performance that it shall not be used for a purpose not intended, and particularly in a manner which does not fairly represent his services." By analogy, it may well be that Follett is entitled to an accurate description of his role in preparing [the book]. Any rights which he may hold in this regard are co-extensive with his right under the Lanham Act

Follett v. Arbor House Publishing Co., 497 F. Supp. 304, 310-11 (S.D.N.Y. 1980).

143. *Yameta Co. v. Capitol Records, Inc.*, 279 F. Supp. 582, 585 (S.D.N.Y. 1968), *rev'd on other grounds*, 393 F.2d 91 (2d Cir. 1968). "The claims based upon Civil Rights Law § 51 and the Lanham Act present a greater problem. Hendrix himself is entitled to assert a claim for relief under those acts, irrespective of the contractual dispute between PPX and Yameta." *Id.* See also *Brinkley v. Casablancas*, 80 A.D.2d 428, 440-41, 438 N.Y.S.2d 1004, 1012-13 (1st Dept. 1981). "The wrong consists of only two elements: the commercial use of a person's name or photograph and the failure to procure the person's written consent for such use." *Id.*

144. "No social purpose is served by having the defendant get for free some aspect of the plaintiff that would have market value and for which he would normally pay." *Zacchini v.*

not extend past death.¹⁴⁵ However, the right of publicity does survive the death of the artist,¹⁴⁶ because it is a purely commercial right.¹⁴⁷ The right of publicity exists post mortem, however, only if it is based on a commercially valuable image and not on a tarnished image which could not be perceived to have value.¹⁴⁸ While damages are recoverable for the violation of the right to publicity, the preferred remedy is an injunction.¹⁴⁹ However, "an author has no right under the Civil Rights law to

Scripps-Howard Broadcasting Co., 433 U.S. 562, 576 (1977). *See also*, *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836 (S.D.N.Y. 1975) where the court stated:

[w]e think that, in addition to and independent of that right of privacy (which in New York derives from statute), a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made 'in gross,' i.e., without an accompanying transfer of a business or of anything else.

400 F. Supp. at 843. For a further discussion, *see Lombardo v. Doyle, Dane & Bernbach, Inc.*, 58 A.D.2d 620, 396 N.Y.S.2d 661 (1977), where the court explained that:

In New York there is a distinction between the statutory right which protects living persons from commercial exploitation of their names and pictures without their written consents, as embodied in sections 50 and 51 of the New York Civil Rights Law, and the common-law property right in one's public personality.

Lomardo, 58 A.D.2d 624, 396 N.Y.S.2d at 664 (1977), and *see also*, *Stephano v. News Group Publications, Inc.*, 64 N.Y.2d 174, 474 N.E.2d 580 (1984); *Southeast Bank, N.A. v. Lawrence*, 104 A.D.2d 213, 483 N.Y.S.2d 218 (1984).

145. The right of privacy does not survive death, especially in Al Capone's case, because "[t]he evil that men do lives after them." *Maritote v. Desilu Productions*, 345 F.2d 418, at 420 (7th Cir. 1965) (quoting Shakespeare).

146. "In arguing for termination of the right, defendants appear to confuse the two essentially different concepts, that is, the traditional right of privacy which clearly terminates upon death of the person asserting such a right and the right of publicity which we think does not terminate on death." *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836, 844 (S.D.N.Y. 1975). In a similar case, a company released an unauthorized Elvis Presley poster. ["There is no reason why the valuable right of publicity — *clearly exercised by and financially benefiting Elvis Presley in life* — should not descend at death like any other intangible property right."] *Factors, Etc., Inc. v. Creative Card Co.*, 444 F. Supp. 279, 284 (S.D.N.Y. 1977), *aff'd*, 579 F.2d 215 (2d Cir. 1978), *cert. denied*, 440 U.S. 908 (1979). "Similarly, while a cause of action under the Civil Rights Law is not assignable during one's lifetime and terminates at death, the right of publicity, i.e., the property right in one's name, photograph and image is under no such inhibition." *Lombardo*, 58 A.D.2d at 624, 396 N.Y.S.2d at 664.

147. *Price*, 400 F. Supp. at 844.

When determining the scope of the right of publicity, however, one must take into account the purely commercial nature of the protected right. Courts and commentators have done just that in recognizing the right of publicity as assignable. There appears to be no logical reason to terminate this right upon the death of the person protected.

Id. at 844.

148. *Factors, Etc.*, 444 F. Supp. at 279, 285. Obviously, any 'right of publicity' died with Al Capone and could not thereafter be invaded. Furthermore, there could be no valid, surviving claim based on a right of publicity as this Court construes it. Whatever else Al Capone was doing in life, he was not trying to create an image with widespread commercial appeal.

Id.

149. *Durgom v. Columbia Broadcasting System, Inc.*, 29 Misc. 2d 394, 214 N.Y.S.2d 752

restrict the use of his name to indicate his authorship of a work as to which he possesses no copyright."¹⁵⁰ "The lack of copyright protection has long been held to permit others to use the names of authors in copying, publishing or compiling their works."¹⁵¹ In addition, the artist should be aware that once he has conveyed his artistic work, he forfeits any right under the privacy law to prohibit the use of his likeness in connection with it.¹⁵²

B. Libel

The attribution of credit which is not desired by the recipient can be removed by resort to a cause of action grounded in defamation.¹⁵³ It has successfully given rise to damages for libel in California.¹⁵⁴ In New York, a libel theory has been successfully employed for both general and

(1961). "To deny the injunction sought would permit a clear violation of the Civil Rights Law and deprive plaintiff of one of the statutory remedies, thus limiting him to the less satisfactory remedy of a damage suit." *Id.* at 396, 214 N.Y.S.2d at 754. See also, *Brinkley v. Casablancas*, 80 A.D.2d 428, 438 N.Y.S.2d 1004 (1981).

The admitted failure of defendant *Galaxy* to obtain plaintiff's written consent prior to the unauthorized sale of the poster is, in the circumstances represented herein, dispositive on the issue of liability under the Civil Rights Law. Plaintiff is therefore entitled to summary judgement on the first cause of action, which seeks a permanent injunction, and to partial summary judgement on liability on the second cause of action, which seeks compensatory and exemplary damages.

Id. at 441-42, 438 N.Y.S.2d at 1013.

150. *Follett*, 497 F. Supp. at 310.

151. *Shostakovich v. Twentieth Century-Fox Film Corp.*, 196 Misc. 67, 71, 80 N.Y.S.2d 575, 577 (1948) (Russian composer's music was in public domain, and they were denied relief under § 51 to have their credit removed from the titles), *aff'd*, 275 A.D. 692, 87 N.Y.S.2d 430 (1949).

152. *Yameta v. Capital Records, Inc.*, 279 F. Supp. 582, 585 (S.D.N.Y. 1968) (Jimi Hendrix could not restrain the use of his likeness under a privacy theory, although he did prevail under the Lanham Act), *rev'd on other grounds*, 393 F.2d 91 (2d Cir. 1968).

[S]ection 51 also creates a limited exception permitting the use of the name or picture of an author, composer, or artist in conjunction with artistic productions which have been "sold or disposed of with such name, portrait or picture used in connection therewith". We conclude that the exception applies in this case and that the defendant was entitled to summary judgement on the plaintiff's Civil Rights law causes of action.

Shaw v. Time-Life Records, 38 N.Y.2d 201, 205, 341 N.E.2d 817, 819, 379 N.Y.S.2d 390, 394 (1975).

153. *Caroll v. Paramount Pictures, Inc.*, 3 F.R.D. 95 (S.D.N.Y. 1942).

I am of the opinion that these allegations, which are deemed admitted on this motion, sufficiently plead a claim or cause of action predicated on libel. The asserted false imputation to plaintiff, a well-known producer, of the production of an inferior work [that he actually did not produce] that injures his position as a producer in the professional and theatre world, is libelous per se.

Id. at 96.

154. *Kerby v. Hal Roach Studios*, 53 Cal. App. 2d 207, 127 P.2d 577 (1942). The name of a fictional character in a film was put in a provocative letter asking men to come and see her, at an address which was actually the location of a movie theatre. The name used was also that of

punitive damages as well as injunctive relief.¹⁵⁵

C. Entertainment Guild Provisions

Through their collective bargaining agreements, the Guilds have instituted specific procedures whereby an artist may remove his or her credit from a production.¹⁵⁶

1. Writers

Writers of theatrical screenplays "have the right to have credit given to him/her on the screen, advertising or otherwise, in a reasonable pseudonymous name,"¹⁵⁷ but the only ground for refusing credit is servile pay for their writing.¹⁵⁸ The television agreement has a similar provision.¹⁵⁹

2. Directors

Film and television directors have the right to remove their credit by requesting a pseudonym, if the request is approved by the production company, or by a guild arbitration committee.¹⁶⁰ If the director takes his or her name off the picture "as a condition for using a pseudonym, the Director must refrain from publicly criticizing the film."¹⁶¹

3. Actors

Unlike writers and directors, removal of credit, or the use of a pseudonym, is not a viable remedy for actors, since an actor's likeness is dis-

a real woman, the only one by that name in Los Angeles. She successfully sued under a libel theory. *Id.*

155. *Clevenger v. Baker Voorhis & Co.*, 8 N.Y.2d 187, 203 N.Y.S.2d 812 (1960) (Editor of law books was successful under a libel theory in having his name removed from subsequent editions of which he was not the author, and also received punitive damages); *Ben-Oliel v. Press Publishing Co.*, 251 N.Y. 250, 167 N.E. 432 (1929) (Libel theory supported removal of byline from an article which author did not write. It was an inaccurate historical article, and damaged her professional reputation).

156. *See infra* notes 159-75 and accompanying text.

157. WGA Theatrical and Television, Basic Agreement of 1988, effective Aug. 8, 1988. Theatrical Schedule A, 252.

158. *Id.* A low-paid writer is defined as one receiving less than \$125,000 for a feature length screenplay. *Id.* Presumably, a writer receiving less than that amount for a script does not want that fact advertised in the industry, and his agent does not want to have to explain such a miniscule quote in a subsequent negotiation.

159. WGA Theatrical and Television, Basic Agreement of 1988, effective Aug. 8, 1988. Television Schedule A, Television Credits, 272. Television writers define low pay as less than three times applicable minimum. *Id.*

160. DGA, Basic Agreement of 1987 § 8-211.

161. *Id.*

played on the screen.¹⁶² As a result, the actor's only remedy is a drastic one: to enjoin the release of a motion picture entirely. In balancing the possible harm to the actor against the potentially catastrophic repercussions for the production company if the injunction prevented the release of the movie, it is difficult, though not impossible, for an actor to obtain this particular remedy. The British comedy group Monty Python was able to obtain such relief.¹⁶³ The troupe was horrified by the American Broadcasting Company's ("ABC") editing of their show. The group realized that the public would not be seeing a true representation of their wit if the edited version was broadcast, and that anything less than the full, original show would be a fraud on the public. Monty Python invoked the protection of the Lanham Act to enjoin the telecast.¹⁶⁴ The court rejected ABC's contention that a warning label or disclaimer¹⁶⁵ at the top of the show would preserve the comedians' reputation, and granted the injunction.¹⁶⁶

D. *Misattribution of Credit*

The artist has a right to remove his credit if he had absolutely nothing to do with the enterprise with which he is credited. This is the classic Lanham Act case, since it is obviously a fraud upon the public not only to deny a credit to a person who worked upon a production, but the reverse is true, to pass off to

162. It is probably for this reason that the Screen Actors Guild basic agreement has no provision for the removal of credit.

163. *Gilliam v. American Broadcasting Cos.*, 538 F.2d 14, 26 (2d Cir. 1976).

164. *Id.* at 25 n.13. See also *Granz v. Harris*, 198 F.2d 585, 588 (2d Cir. 1952) (plaintiff recording artist successfully had his credit removed from his recordings which were altered by removing eight minutes of music).

165. An alternative to the total removal of credit is the less drastic remedy of placement of a disclaimer on the property, particularly when the credit attributed to the artist is truthful but the artist feels it could be misinterpreted.

[T]he court declined to enjoin the selling of an album bearing a current likeness of plaintiff Charlie Rich, but containing songs just as they had been recorded by Rich ten to fifteen years before his current success. The court, however, ordered that a decal be affixed to each album to clarify its contents, thus alleviating any harm that might be caused by defendant's violation of § 43(a) of the Lanham Act.

Benson v. Paul Winley Record Sales Corp., 452 F. Supp. 516, 518 (S.D.N.Y. 1978) (quoting *CBS, Inc. v. Gusto Records*, 403 F. Supp. 447 (M.D. Tenn. 1974)). "Defendant is directed to affix to the cover of each offending album a label (2) by (3) inches in dimension bearing the inscription '[t]hese Songs Were Recorded Over Ten Years Ago' in bold letters." *CBS, Inc. v. Springboard Int'l Records, Inc.*, 429 F. Supp. 563, 569 (S.D.N.Y. 1976). See also *Rich v. RCA Corp.*, 390 F. Supp. 530 (S.D.N.Y. 1975). The court could also take appropriate action in connection with the distribution of further paperbacks and advertising to indicate to the public and prospective purchasers of the paperback version that changes had been made. *Chesler v. Avon Book Div.*, 76 Misc. 2d 1048, 352 N.Y.S.2d 552, 557 (1973).

166. *Gilliam*, 538 F.2d at 26.

the public as the product of an artist that with which he had no connection.¹⁶⁷

This rule is especially applicable in those cases where companies attempt to take commercial advantage of the good will which attaches to a performer's personality by hiring a celebrity look-alike.¹⁶⁸

Similarly, where an author has written the property which supplies the underlying rights to the story, a production company cannot change the title to which the author has agreed to be associated.¹⁶⁹ Conversely, it is equally damaging when a producer seeks to capitalize on a title already used by another,¹⁷⁰ because

a vast field of words and phrases is open to a producer who wishes to seek a title to distinguish his play or photoplay from that of another. Consequently, whatever doubts there may be on that score should be resolved in favor of the producer who has already spent time, money and effort to give the title of his production a secondary meaning and against the newcomer who, even unintentionally, uses or simulates the title in such a manner as to confuse or mislead the public.¹⁷¹

167. *Follett*, 497 F. Supp. at 311. See also *Shaw v. Time-Life Records*, 38 N.Y.2d 201, 341 N.E.2d 817, 379 N.Y.S.2d 390 (1975) (orchestra leader could obtain relief from misattribution on common-law passing-off grounds); *Zim v. Western Pub. Co.*, 573 F.2d 1318 (5th Cir. 1978); *Ali v. Playgirl, Inc.*, 447 F. Supp. 723 (S.D.N.Y. 1978); *Durgom v. Columbia Broadcasting System*, 29 Misc. 2d 394, 214 N.Y.S.2d 752 (Sup. Ct. 1961) (plaintiffs obtained injunctions against the use of their names in contexts unrelated to their own activities).

168. See *Allen v. National Video*, 610 F. Supp. 612 (S.D.N.Y. 1985). Woody Allen was awarded equitable relief under the Lanham Act to prevent the use of a celebrity look-alike who portrayed his distinctive "schmiel" trademark. But the court rejected New York Civil Rights Law § 51 as a legal basis because it was not actually Allen. *Id.*

169. *Packard v. Fox Film Corp.*, 207 A.D. 311, 202 N.Y.S. 164 (1923).

By its contract with the plaintiff the defendant acquired the right to make a motion picture based upon the plaintiff's story under the title of "The Iron Rider," and in connection therewith to advertise the same by the use of the plaintiff's name. The unauthorized use of plaintiff's name in connection with a story of a different title was a distinct damage to the plaintiff.

Id. at 314, 202 N.Y.S. at 167.

170. Similarly, the guilds prohibit their members from using the same name. When you join a guild, if someone already has your name, you must choose another. This led one hopeful young actor named Jimmy Stewart, upon arriving in Hollywood, to change his name to Stewart Granger.

171. *Johnston v. Twentieth Century-Fox Film Corp.*, 82 Cal. App. 2d 796, 187 P.2d 474 (1947). The court felt

the title "Queen of the Flat Tops" is an arbitrary, fictitious, fanciful, artificial, distinctive and nondescriptive combination of words The title, . . . being nondescriptive, was a product of the mind. Under [California] Civil Code sections 655 and 980 respondents were the owners of the title and as such owners had the right to its exclusive use for all purposes. (Civ. Code §§ 654, 679).

Id. at 809, 187 P.2d at 480. Similarly, "[t]he court [found] it impossible to believe that the selection of the title "Lampoon," out of a universe of possible titles, was fortuitous, in view of

Neither can former members of rock groups use the group's name if it would mislead the public.¹⁷² "Public confusion as to the source of the program is inevitable. Plaintiff, therefore, has standing to sue and has established [his] right to relief under 15 U.S.C. Section 1125(a)."¹⁷³

E. Misrepresentation

Less clear is the situation where the artist did contribute to a work, but only to a minor degree. The extent of the credit given to the artist creates the impression that the artist was an integral contributor to the finished production and now the artist wants to reduce or remove the credit.¹⁷⁴ While primarily a problem of proof, once the artist has established that his credit is misleading, courts have reduced the credit.¹⁷⁵ A line of cases chronicle the right of artists who have progressed in their careers to enjoin the release of old productions in which they played minor roles, which are re-released with advertising which purports to feature them as a major force in the production.¹⁷⁶ This theory also supports removal of credit when the work itself is altered without the concurrence of the artist.¹⁷⁷

the negotiations between ABC and National Lampoon." *National Lampoon*, 376 F. Supp. at 744.

172. Use of name "Herman's Hermits" by group after Peter Noone had left was actionable under Lanham Act, since the public believed Noone to be "Herman." *Noone v. Banner Talent Assoc.*, 398 F. Supp. 260 (S.D.N.Y. 1975).

173. *National Lampoon*, 376 F. Supp. at 747.

174. See *infra* note 178.

175. See *infra* note 178.

176. Defendant placed plaintiff's name prominently on a record jacket in which he was only a background player. The court granted an injunction under the Lanham Act, finding that "[d]efendant's misrepresentations can cause irreparable injury to [plaintiff's] professional and personal reputation." *Benson v. Paul Winley Record Sales Corp.*, 452 F. Supp. 516, 518 (S.D.N.Y. 1978). In another case, the Second Circuit awarded damages where defendant "marketed eight albums purporting to contain feature performances by Jimi Hendrix, but which either did not contain Hendrix performances at all or contained performances in which Hendrix was merely a background performer or undifferentiated session player." *PPX Enter. v. Audio Fidelity Enter.*, 818 F.2d 266, 268 (2d Cir. 1987). In a third case Ken Follett edited a book before becoming famous as an author. (Among his credits are "Key to Rebecca," which was later made into a movie with Cliff Robertson and Robert Culp). Defendant sought to publish the edited book with plaintiff given credit as principal author. The court prohibited the publication unless plaintiff's credit was reduced. *Follett v. New American Library, Inc.*, 497 F. Supp. 304, 313 (S.D.N.Y. 1980). In an earlier case, Jimi Hendrix was only background guitarist, but his picture was featured on the record album cover as if he were the featured artist. Hendrix was granted an injunction under Lanham Act. *Yameta Co. v. Capital Records, Inc.*, 279 F. Supp. 582, 587 *rev'd on other grounds*, 393 F.2d 91 (2d Cir. 1968).

177. *Granz*, 198 F.2d 585 (2d Cir. 1952). When eight minutes of music were removed from a record without permission of plaintiff, he sued to remove his credit. The court stated, "If . . . the [defendant] did so describe it [as a recording made by plaintiff], he would commit the tort of unfair competition This contractual duty carries by implication, without the necessity

"The Lanham Act . . . is designed not only to vindicate 'the author's personal right to prevent the presentation of his work to the public in a distorted form'. . . but also to protect the public and the artist from misrepresentation of the artist's contribution to a finished work."¹⁷⁸ Even if such a custom is a common industry practice, it cannot justify such misrepresentation.¹⁷⁹ In the case of actors, editing can so alter the performance that it destroys the artistic integrity, a point successfully made by Monty Python.¹⁸⁰

Nevertheless, artists must be careful not to contract away their ability to deny involvement with a program at a later date. This is especially true when the contract *requires* the producer to give the artist credit¹⁸¹ for a project on which he or she does not have any contractual right to control changes,¹⁸² and with which the artist may disapprove. Because injunction is an equitable remedy, the plaintiff must insure that his own conduct does not counter his argument that the credit given him or her is a misrepresentation of his contribution.¹⁸³ For example, where a writer

of an express prohibition, the duty not to sell records which make the required legend a false representation." *Id.* at 588.

178. *Follett*, 497 F. Supp. at 313. (quoting *Gilliam v. American Broadcasting Cos.*, 538 F.2d 14 (2d Cir. 1976)).

179. *Follett*, 497 F. Supp. at 313 ("Even if an attribution of authorship were consistent with industry practices, it would nevertheless be illegal under the Lanham Act if it misrepresented the contribution of the person designated as author.").

180. *Gilliam*, 538 F.2d at 19. In issuing a preliminary injunction to prevent broadcast of their show, the court recognized that

[i]f ABC adversely misrepresented the quality of Monty Python's work, it is likely that many members of the audience, many of whom, by defendants admission, were previously unfamiliar with appellants, would not become loyal followers of Monty Python productions. The subsequent injury to appellants' theatrical reputation would imperil their ability to attract the large audience necessary to the success of their venture. Such an injury to professional reputation cannot be measured in monetary terms or recompensed by other relief.

Id.

181. *Landon v. 20th Century-Fox Film Corp.*, 384 F. Supp. 450 (S.D.N.Y. 1974). Plaintiff entered into agreement for film version of "Anna and the King of Siam" in 1944. In 1972, when Fox did a TV series, she brought suit alleging "defamation, invasion of her right of privacy, misappropriation of literary property and wrongful attribution to Landon of credit for the series, which she claims to have 'mutilated' her literary property." *Id.* at 452. The court found

the claim is insufficient as a matter of law Although plaintiff would have a valid claim against defendants if they had falsely attributed the authorship of the series to her . . . her claim must fail, where, as here, she contracted to . . . require Fox to give her appropriate credit "for her contribution to the literary material upon which such motion pictures shall have been based."

Id. at 459.

182. *Id.* at 460. "These provisions clearly grant Fox the right to alter the literary property substantially and to attribute to plaintiff credit appropriate to her contribution." *Id.*

183. *See Market v. Scovill Mfg.*, 471 F. Supp. 1244, 1255 (W.D.N.Y. 1979).

created a character in a series of books, and then permitted the publisher to hire other writers to turn out additional books featuring that character and the author's name, the court denied the writer credit removal.¹⁸⁴

The court stated:

[plaintiff] who has previously acquiesced to the current description, continues to benefit at the rate of \$200,000 a year from the sale of Harlequin books. While he may not have been guilty of an 'unconscionable act,' he has been responsible for the repeated usage of his name over the years. Under the circumstances, he does not have the clean hands required of someone seeking such equitable relief.¹⁸⁵

IV. ENTERTAINMENT GUILD AGREEMENTS

In many cases, an artist, if employed by a signatory to the Guild agreements, can get a faster and less expensive determination of his credit rights by an arbitration proceeding conducted by his Guild than he or she would by pleading his case in state or federal court.¹⁸⁶ Confusion as to the appropriate credit for writers can be great. While there is only one screenplay, numerous writers can make contributions to the finished script. The Writers Guild of America's ("WGA") arbitration procedure determines which author's input actually appears in the final screenplay, and then mandates the credit to appear on the final film print.¹⁸⁷ The

184. *Harlequin Enter. v. Warner Books, Inc.*, 639 F. Supp. 1081 (S.D.N.Y. 1986). Plaintiff had created a character, "Mack Bolan" in a series of books. Harlequin then hired hack writers to turn out additional books which used the plaintiff's name. Plaintiff sought to prevent defendant from continuing to list him as author on the books. In denying removal of credit, the court stated plaintiff,

who has previously acquiesced to the current description, continues to benefit at the rate of \$200,000 a year from the sale of Harlequin books. While he may not have been guilty of an 'unconscionable act,' . . . he has been responsible for the repeated usage of his name over the years. Under the circumstances, he does not have the clean hands required of someone seeking such equitable relief.

Id. at 1081 (citation omitted).

185. *Harlequin*, 639 F. Supp. at 1091 (citation omitted).

186. See *supra* notes 159-75 and accompanying text for a discussion of the related remedy of removal of credit and those instances in which guild rules allow the effective removal of the credit by attributing the service provided on the production to a pseudonym.

187. WGA, Theatrical and Television, Basic Agreement of 1988, effective Aug. 8, 1988. (Television Schedule A, 285). The WGA agreement provides that

[w]here the Company has failed to provide credit on the screen in accordance with final credit determination it shall correct each print before such print is re-telecast and place a full-page advertisement in either Daily Variety or the Hollywood Reporter specifically crediting the writer. Such remedies shall be in addition to any claim the individual writer may have for damages by reason of such failure to provide credit.

Id. at 285.

WGA specifically recognizes that guild arbitration is not an exclusive remedy, since their members can resort to the courts to either obtain additional relief¹⁸⁸ or invalidate the arbitration.¹⁸⁹ Similarly, the Screen Actors Guild agreement provides that "[d]isputes as to screen credit shall be arbitrable."¹⁹⁰ Two concurrent remedies are provided in the agreement, liquidated damages for past breach¹⁹¹ and specific performance to prevent future breach.¹⁹²

The Directors' Guild of America takes a "laissez faire" approach to the enforcement of credit rights, embodying no specific reference to remedies in the guild agreement. In fact, the guild has gone in the opposite direction and appears to preclude any action by their members to enforce their right to credit by injunction.¹⁹³ This guild provision has never been tested in court, but might be found in violation of public policy. Unfair competition under the Lanham Act or parallel state statutes could arguably be employed regardless of guild agreements.

V. CONCLUSION

The law of screen credit has made rapid advances in the last several decades. Initially, the courts took a position rooted in ignorance of the economics of the entertainment business, holding that screen credit had no intrinsic value and that the denial of such credit did not give rise to

188. WGA, Theatrical and Television, Basic Agreement of 1988, effective Aug. 8, 1988. Article 12: Court Proceedings.

Nothing in this Basic Agreement shall limit the rights of the Guild or any writer to assert any and all appropriate legal and equitable rights and remedies to which the Guild or such writer is entitled in courts of competent jurisdiction with regard to an alleged breach of Article 8 and Schedule A of this Basic Agreement with respect to writing credit

Id.

189. WGA, Theatrical and Television, Basic Agreement of 1988, effective Aug. 8, 1988. "Nothing in this Basic Agreement shall preclude any court of competent jurisdiction from confirming, setting aside or modifying any grievance or arbitration award hereunder in any proceeding brought for such purpose in accordance with applicable law." *Id.*

190. 1977 SAG Television Agreement 51, § 54, Screen Credit and Billing (b) (3), and 1977 SAG Theatrical Agreement 31, § 25, Screen Credits (C) (3).

191. 1977 SAG Television Agreement 51, § 54, Screen Credit and Billing (b) (5), and 1977 SAG Theatrical Agreement 31, § 25, Screen Credits (C) (5). Liquidated damages are awarded "if a breach occurs and the facts are not in dispute, or if breach is found by an arbitrator."

192. 1977 SAG Television Agreement 51, § 54, Screen Credit and Billing (b) (7), and 1977 SAG Theatrical Agreement 31, § 25, Screen Credits (C) (7). Specific performance consists of "[c]orrection of prints with respect to the first broadcast or first rerun [which] may be awarded by the arbitrator" *Id.*

193. DGA, Basic Agreement of 1984, § 8-101. "In no event shall an Employer be obligated to delay the preparation or issuance of advertising matter or the release of any motion picture pending proceedings for the determination of credits." *Id.*

damages nor mandate an injunction to prevent its continued denial.¹⁹⁴ From that starting point, the courts became increasingly sophisticated about the realities of the marketplace, and thus increased the remedies available to the aggrieved artist. In recognizing that the credit itself has monetary value, and that the denial of screen credit is an appropriate basis for enjoining exhibition of the property, the courts have developed a policy which arms the artist with significant protections. Studios, networks, and production companies should think twice before violating artists' right to screen credit.

194. See *supra* notes 7-11 and accompanying text.

