Proceedings Chapter

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Table of contents

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1. Introduction

Posthumous replications (or *post-mortem* copies) is an important issue. From the art market perspective, such copies aim to promote cultural heritage, and stimulate the market by assigning different values between the original, copies and fakes.[1] A good *example* is the Man Ray photograph *Ingres Violin*. A vintage print produced in 1924 signed by the artist is priceless, while one of thirty New Print copies produced right after Man Ray's death (1976) has been estimated at EUR 130'000, and one of 5,000 copies of the same print produced by Yellowkorner is sold for EUR 59.[2]

From a legal perspective, however, posthumous reproductions raise a number of complex issues, as the legal framework surrounding these reproductions necessarily cuts across *several fields of laws*, ranging from *copyright law* (copyright governs whether and under what conditions a work may be reproduced) to *inheritance and contract law* (the rights and obligations of the deceased artist are transferred to the deceased's estate). These issues are compounded by the fact that the *governing law* may vary depending on the geographical movement of the work and often varies from one jurisdiction to another.[3]

This contribution aims to examine these issues. After examining *copyright law,* in particular the relevant economic and moral rights involved in *post-mortem* copies (below 2) we analyse the relevant *contract law* (below 3) and *unfair competition law* rules that may prevent certain copies (below 4). Finally, we will *define the notions of original, copies and fakes* (below 5) and conclude with a *summary* and few reflections regarding copyright in successions.

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1 Original is understood here as the unique work made by the artist himself or under his supervision, copies as any reproduction of the original (whether genuine copies, i.e. made by the artist, or *post-mortem* copies made by third parties after his death) and fakes as works not created by the artist but by a third party and bearing the name of the artist. See infra 5.

2 See GIRARDIN/PIRKER, Controversies: A Legal and Ethical History of Photography, 72, reporting the case of the German collector Werner Bokelberg who bought in 1990 several Man Ray's photographs, which were supposedly dated between 1920–1930 but which were finally dated 1960 by experts.

3 This contribution will not examine in detail the question of governing law. It is nevertheless useful to recall the general principle of the laws of the country of protection (*Schutzland*, *lex protectionis*), according to which the applicable law is the law for which the protection is sought (see e.g. Swiss Private International Law LDIP, Art. 110 para 1). See JACQUES DE WERRA, Schweizerisches und internationales Recht, in: Mosimann/Renold/Raschèr (éds.), Kultur Kunst Recht, Basel 2009. 439 ss, 453.

2. Copyright law

Copyright law governs whether and under what conditions an artwork may be copied. Copyright holders (i.e. the author, co-authors of a work, or third parties to whom copyrights have been transferred via contract or succession) are granted an exclusive right on the work and may authorize or exclude third parties from using it.[4] Consequently, any *third party* willing to produce *post-mortem* copies will need to identify the relevant copyrights for the contemplated use (below 2.1 and 2.2) and the individual or entity owning such right (below 2.3). This is the case even if the third party owns the tangible artwork, as this ownership does not automatically include the ownership of the copyright. In other words, a third party may not reproduce an artwork just by virtue of the fact that he owns the tangible work.[5]

2.1 Economic rights

Copyrights are traditionally divided between economic and moral rights: economic rights enable the rightholder to *exploit his work commercially.*[6] They generally include exclusive rights over reproduction, public performance, public display, distribution, and the making of derivative works.[7]

a) Right of reproduction

The right of reproduction extends to, and protects the rightholder against any wrongful use, in particular against identical reproductions and derivative works (including copies produced in different formats). Consequently, this right may apply to *post-mortem* copies, as the rightholder may prohibit *any copy* of the work, *even in a modified form* (e.g. in other formats).[8]

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4 See Swiss Copyright Act (LDA), Art. 9 para 1 and Art. 10 para 1.

5 There is a clear distinction between ownership of the artwork and the copyright, as the assignment of ownership of a copy of a work does not include the right to exploit the copyright, even in the case of an original work (LDA 16 para 3).

6 DAVIES/GARNETT, Moral Rights, London 2010, 5.

7 Under Swiss law Art. 10 para 2 LDA provides a non-exhaustive list of economic copyrights. For a detailed presentation of all economic rights under Swiss law, see CHERPILLOD, Commentaire romand de propriété intellectuelle, in: de Werra/Gilliéron, Bâle 2013, LDA 10 N 1 ss.

8 See for instance Oberlandesgericht Hambourg, ZUM 1995, 430 (for Maillol's works produced in smaller formats). One might argue that, when a work is produced in another format that exceeds a certain size, there is no copy but a new original work. We are however of the view that there is always a copy / reproduction of the original work irrespective of the different format, see infra 5.

However, the right of reproduction does *not* protect the rightholder against *fakes* (i.e. works that are neither an identical copy nor a derivative work) and new works showing significant changes (i.e. works simply inspired or sufficiently different from the original to fall outside the scope of protection).[9]

b) Right of distribution

The right of distribution may also apply if a third party willing to produce *post-mortem* copies will *circulate the tangible copies* of a work that has *not been disclosed* (otherwise the exhaustion principle enables the transferee to further circulate the work) or wants to circulate the tangible copies of a work that has been circulated in a jurisdiction using the national exhaustion principle.

c) Right of communication

The right of communication may also apply, in particular to *contemporary works* that need to be *performed to be shown to the public,* such as multimedia works. The right of communication is to be understood broadly, in the sense that it encompasses both the direct communication to persons who are present at the time and place where the work is displayed (e.g. linear showing of a video in a showroom) and the indirect communication to persons who access a recording elsewhere (e.g. showing a video with an interactive service in the showroom that enables the visitor to choose the moment of the showing, or posting a video online).[10]

In other words, for tangible works, the right of reproduction is necessary (exclusively or along with the right of distribution). For digital contemporary works, the right of reproduction as well as the right of communication are necessary, i.e. the right of reproduction to duplicate the digital file, and the right of communication to show the work to the public.

[9] For a discussion on inspired work (including works from the appropriation art), see DE WERRA (supra 3), 448.

[10] Many legislatures make a distinction between direct and indirect communications. Swiss law for instance protects direct communications under the right of diffusion (LDA 10 let. d) and indirect communications under the right to make available (LDA 10 let. c). See also Art. 8 and 11 WCT.

2.2 Moral rights

Moral rights, as distinguished from the economic rights, aim to *protect the expression of the author's personality* and his continuing relationship to his work. They are actually a collection of separate rights of which three are particularly relevant for *post-mortem* copies: the right of paternity, the right of integrity, the right of paternity and the right of disclosure.[11]

a) Right of integrity

The right of integrity is the right to require respect of the integrity of a work. It includes the right to authorize or prohibit modification of the work by third parties by way of additions or deletions.[12] The *scope of the right* varies from one jurisdiction to another, the central issue being whether the right applies to any reproduction (including copies with minor changes) or only to replications with significant changes.

Under Swiss law, the right of integrity is interpreted by scholars and jurisprudence as applicable to *any modification,* whether substantial or not,[13] direct or indirect,[14] prejudicial or not.[15] However, the right of integrity should *not* apply to the record of the work using a *different technology* or to the transfer of the work to a *different medium.*[16] The latter is only true in our view when the medium is irrelevant or ancillary (e.g. common books), while moral rights shall apply if the medium is relevant for the substance of work in particular in fine art (e.g. photographs printed only on a specific medium,

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11 Art. 6bis Bern Convention. See DAVIES/GARNETT (supra 6), 5 ss, analyzing other moral rights, in particular the right of disclosure, of retraction and of access.

12 DAVIES/GARNETT (supra 6), 7, gives the author a degree of control over adaptations of his work, even when the third party has been granted the right of reproduction. For instance, if a film based on a novel fails to stick to the plot and characters of the novel.

13 BARRELET/EGLOFF, Le nouveau droit d'auteur, 2nd ed., Bern 2000, art. 11 N5. See Trib. app. TI, sic! 2002, 509 c. 8 (modification of the text font of a poster).

14 DE WERRA, Droit à l'intégrité de l'œuvre: étude du droit d'auteur suisse dans une perspective de droit comparé, Berne 1997, 68 ss.

15 PHILIPPIN, Commentaire romand de propriété intellectuelle, in: de Werra/Gilliéron, Bâle 2013, LDA 11 N 6; DE WERRA (supra 3), 456: direct modification affects the substance of the work itself, such as the destruction of a work or asset-stripping of a work. Indirect modification relates to the use of work in inappropriate contexts, such as advertisment purposes (e.g. work of Niki de Saint-Phalle used in an advertisment campaign; WALRAVENS, La protection de l'œuvre d'art et le droit moral de l'artiste, RIDA 2003 (197), 3 ss, 51) or the exhibition of a work considered inappropriate by the author or addition of an inappropriate frame to a painting suggesting that the frame was part of the initial work (e.g. Unikatrahmen relating to additional frames of framed painting suggesting to the public that the additional frames were part of the artistic intent of the author, BGH (I ZE 304/99), BGHZ 150, 32 ss.

16 Only the right of reproduction would apply in this context (LDA 10 para 1 lit. a). See PHILIPPIN (supra 15), LDA 11 N 7; BARRELET/EGLOFF (supra 13), LDA 11 N 6a ; HILTY, Urheberrecht, Bern 2010, N 198 (for compression of music files).

or musical works only produced on vinyl records). In addition, when the right of reproduction is granted in a specific context and for a specific purpose, there might be an *implied consent* to modify the work (e.g. color photograph used for a publication in a daily newspaper may be transferred to black and white photograph).[17] The situation seems more complicated when it comes to the replication of *different formats* and when copyrights have been transferred and allocated to different heirs. The rightholders of moral rights may certainly claim that the different formats are protected by the right of integrity and, even if the rightholders of the economic rights have validly authorized the replications, they may argue that such transfer of economic rights does not include the right of modification. Consequently, it is advisable to obtain the consent of both groups of rightholders (moral and economic right).

In some jurisdictions, the right applies *only to changes prejudicial* to the honour or reputation of the author.[18] In other jurisdictions, such as under US law, this right is even *nonexistent* and has never developed in US jurisprudence.[19]

In other jurisdictions, the scope is stronger and more protective in that the author may object to *any change* irrespective of its nature and extent to any derivative works (e.g. replication with minor changes). Under *French law,* Courts tend to apply moral rights to any changes and derivative works. For instance, in *Asphalt Jungle,* the Supreme Court recognized that Huston's heirs could object to the *colorization* of the movie based on their moral rights despite a previous valid transfer of copyrights under US law. It must be noted that the disputed movie was considered to be *jeopardizing* the well-known atmosphere of Huston and not only as a simple derivative work.[20] In

[17] PHILIPPIN (supra 15), LDA 11 N 16, however recalling the principle of finality (LDA 16 para 2), i.e. that the transfer of an economic right does not include the transfer of other rights (such as the right of modification).

[18] DAVIES/GARNETT (supra 6), 7, in accordance with the Bern Convention (CB 6bis para 5), indicating that the courts in civil law countries generally apply a subjective test: does the author honestly believe that the action of the adapter would be prejudicial to the honour or reputation of the author? The courts in common law countries usually apply an objective test: would a reasonable, right-thinking member of the public think that the alteration is prejudicial to the honour and reputation of the author?

[19] URICE, Artists' archives as cultural heritage, 2016, referring to various decisions, n. 9: Crimi v. Rutgers Presbyterian Church, 89 N.Y.S.2d 813 (Sup. Ct. 1949) (rejecting an artist's claim that destruction of his mural violated his property and moral rights, finding that the moral rights of artists are "*not supported by the decisions of our courts*"); Gilliam v. ABC, 538 F.2d 14, 23–25 (2d Cir. 1976) (granting preliminary injunction under the Lanham Act to plaintiff Monty Python comedy group who claimed "mutilation" after ABC edited their works, but noting that the U.S. Copyright Act does not recognize moral rights, as the Act "*seeks to vindicate the economic, rather than the personal, rights of authors*").

[20] Turner Entertainment Co. v. Huston, CA Versailles, civ. ch., December 19, 1994, translated in Ent. L. Rep., Mar. 1995, at 3, N 9: "*the aesthetic conception which earned John HUSTON his*

Rodin counterfeits, the Supreme Court held that the copies of a Rodin sculpture (which is in the public domain since 1982) were infringing moral rights because they were based on *overmolding techniques,* which do not allow the reproduction of the exact features of the initial work, and were made with different pedestals. Another important element was that the copies did not mention "*reproduction*", which was considered as misleading.[21] The *Camille Claudel* case was more balanced. The Supreme Court held that the niece of Camille Claudel (owner of the related right of reproduction) did not infringe the moral rights (owned by other heirs) when she made copies in bronze of the sculpture "La Vague". First, because the manufacturing of a bronze molding by Claudel in 1987 (useless for onyx) indicated that Claudel intended to produce further bronze copies. Secondly, because the copies were based directly on Claudel's molding and thus bored the print of the artist and respected the artist's integrity.[22] Such copies shall however include the word "*reproduction*", and not "*original*", as the overmolding technique used for copies cannot reproduce an identical copy. Consequently, in France for instance, Courts tend to admit that heirs can object to any copies based on their moral rights which do not maintain the exact features of the original (e.g. for sculptures based on overmolding techniques) and/or which do not indicate that the copy is a "*reproduction*". By contrast, they may not object to copies that respect the exact features of the original (e.g. photographs based on the original negative or digital works based on an unaffected digital file).

Based on the above, given the possible objections of the heirs and the possible application of more protective right of integrity, it is advisable either to *obtain the consent* of rightholder along with the economic rights regardless of a valid contractual waiver, or *to ensure* that the applicable moral rights is *not over-protective* and will not prevent from copies.

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great fame is based on the interplay of black and white […] In 1950, while color film technique was already widespread and another option was available, the film entitled "ASPHALT JUNGLE" was shot in black and white, following a deliberate aesthetic choice, according to a process which its authors considered best suited to the character of the work. 10. Therefore, the film's colorization without authorization and control by the authors or their heirs amounted to violation of the creative activity of its maker".

21 Cour de cassation, 25 octobre 2016, N° de pourvoi: 15-8462. Regarding the principles of international law, it is interesting to note that the French Court accepted jurisdiction and the application of French law despite the fact that there were few connecting factors with France: the claimant (musée Rodin) claimed moral rights protection because an American art trader, who bought plaster moldings in France produced on the basis of the original Rodin, produced around 2'000 copies in Italy and exhibited them in Switzerland. The Supreme Court held that the committed actions in Italy and Switzerland formed an indivisible whole of the alleged infringements in France and created jurisdiction.

22 Cour de Cassation, 4 mai 2012, 11-10763.

b) Right of paternity

The right of paternity is the right of an author to claim authorship of a work and to be associated and identified with his own work.[23] The scope of the right varies from one jurisdiction to another.

Under Swiss law, the author may prohibit third parties from placing his real name or the name of a third party on the artist's work (so-called plagiarism).[24] However, he may not prohibit the market (in particular experts) from authentifying his work as an original work.[25] Consequently, heirs may not rely on this right to object to *unauthorized post-mortem copies,* as there is no false attribution of the name: the copies bear the correct name of the artist and the authorship is respected. It is of course up to the market to determine whether it is an authentic or a *post-mortem* copy, but not to the heirs. In other jurisdictions, such as France, the right seems to include a right to object to unauthorized copies, in particular for works in the public domain. This protection is however granted only if the signature on a work leads to a risk of confusion between the original and the copy.[26]

The question is more difficult when it comes to *fakes,* i.e. works not created by the artist but by a third party and bearing the name of the artist. Under Swiss law, a claim against wrongful attribution or fakes may not be based on the moral right of paternity, but on the personality right, in particular the protection of the name, as there is no use of copyright (there is no replication or adaptation of the artist's work).[27] The disadvantage of this concept is that the protection of personality rights expires with the death of the artist and may not be claimed *post-mortem*. Some *jurisdictions,* such as the UK, consider this right as *within the scope of copyright* and provide the artist with a right to object to a false attribution.[28] In other jurisdictions, such

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23 DE WERRA (supra 3), 457; DAVIES/GARNETT (supra 6), 6.

24 Art. 9 para 1 and 2 LDA: the right includes "*right to recognition of his authorship*" and the "*right to decide "under what author's designation his own work is published*". See DE WERRA (supra 3), 457.

25 DE WERRA (supra 3), 457, quoting SCHACK, Kunst und Recht: bildende Kunst Architektur Design und Fotografie im deutschen und internationalen Recht, 2e édition (Tübingen: Mohr Siebeck, 2009), N 252, 101.

26 French Supreme Court, Recueil Dalloz II, Informations Rapides, 1997, 200. DE WERRA (supra 3), criticizing this approach due to the fact that moral right of paternity shall be protected as such irrespective of any risk of confusion.

27 DE WERRA, Droit d'auteur et successions, sic! 2000, 685, 695. This issue is controversial in Germany as well, in particular after a decision of Bundesgerichtshof (BGHZ 107, 384) regarding fake watercolours attributed to E. Nolde (the protection, based on personality right not on moral right, has been deemed insufficient). On this questin see NORDEMANN, Kunstwerkfälschung und kein Rechtsschutz?, GRUR 1996, 737.

28 See Sec. 84 UK Copyright Designs and Patents Act 1988: "(1) A person has the right in the circumstances mentioned in this section (a) not to have a literary, dramatic, musical or artistic

as France, the name of the artist is protected by the copyright legislation and courts tend to protect the artistic identity of the author based on this moral right, even in relation to public domain works.[29] One benefit of this concept is to provide protection during the duration of moral rights and to enable the heirs to claim such protection. One disadvantage is that this protection is conceptually outside the scope of copyright and aims at protecting the name of the artist, not his work. In the *US,* the right of attribution, which has only a *limited statutory recognition,*[30] expires upon his death[31] and has never developed judicially.[32] Consequently, the right of attribution may not be claimed by heirs as a moral right as such but potentially through the protection against misrepresentation of the artist's identity under the Lanham Act.[33] A *solution* to overcome this lack of protection is either to *extend* the term of protection of the artist's *personality rights* or to recognize a *generous protection of the heirs' personality rights* to protect the memory of the artist.[34]

Irrespective of its scope, this right is of critical importance in art, whether or not it extends to fakes, as it enables the parties to question the authenticity of a work. Art dealers try to obtain certificates of authenticity from the heirs to avoid future claims of inauthenticity.[35] In the event of litigation, the defendant's experts can of course contest the claim of inauthen-

work falsely attributed to him as author, and (b) not to have a film falsely attributed to him as director".

29 See French Intellectual Property Code Art. 121-1. LEQUETTE-DE KERVENOAËL, 572 ss. Courts have admitted that moral rights may prohibit the commercialization of copies of an original painting bearing the artist's signature despite the expiration of economic rights (TGI Paris, RIDA 1996 (167), 282). See the Utrillo case: Jean Fabris, the rightholder of the right of attribution (after Utrillo's death on 5 November 1955) claimed that paintings published in the catalog of works by Galerie Robert Schmit and as identified as Utrillos, were improperly attributed. He instituted a proceeding to refer the question of authenticity to experts. He obtained the seizure pending the result of a criminal proceeding for fraud and counterfeiting, and the Galerie brought a preemptive civil action for a declaration that Fabris lacked standing because he did not hold the right of attribution of Utrillo's works (Cour d'app. Paris, Ire ch., sec. A, 17 Dec. 1986. Sem. jur. 1987. II. 20899).

30 For an extensive literature on the preemption issue, see URICE (supra 19), n. 8: U.S. federal law provides only limited moral rights to visual artists under the Visual Artists' Rights Act of 1990, 17 U.S.C. § 106A (1990), although various states had previously adopted versions of the moral right, including the right of attribution. However, as a general rule, VARA preempts state statutes.

31 17 U.S.C. § 106A(d)(1).

32 URICE (supra 19), n. 9, quoting for instance Vargas v. Esquire, Inc., 164 F.2d 522 (7th Cir. 1947) (rejecting plaintiff artist's attempt to use foreign civil law concepts of moral rights in an action to recover for unaccredited use of artist's work in Esquire magazine).

33 15 U.S.C. § 1125(a). See URICE (supra 19), n. 11, indicating that there is an exception for specific "works of visual arts", for which there is a right of attribution. 17 U.S.C. § 106A (1990)

34 De Werra (supra 27), 695.

35 MERRYMANN, The Moral Right of Maurice Utrillo, 43 Am. J. Comp. L. 445 1995, 220, qualifying the power of the heirs as a *de facto* authority; de Werra (supra 3), 453, qualifying this power as a *legal authority* arising from copyright (the heirs being able to exercise the right of paternity).

ticity, but the practical momentum is with the plaintiff, who holds the right of attribution. The difficulty is that the certificate must be obtained from all heirs (prior to the division) or from the correct rightholder (after the division).[36] Another difficulty is that this right must be exercised freely and that certain heirs may be tempted to protect their own financial interests by refusing to authenticate the work (and to issue a certificate of authenticity).[37] Such freedom to exercise the right is, however, limited by competition law or by the abusive exercise of rights.[38]

In light of the above, with respect to *post-mortem* copies, heirs are not likely to claim the right of paternity, and therefore consent in this respect will not likely be needed. With respect to *fakes,* the claim is based either on the right of paternity in some jurisdictions such as the UK or France, or on the personality right or unfair competition law in other jurisdictions such as Switzerland and the US.

c) Right of disclosure

The right of disclosure is the right to decide whether, when, in what form and on what terms a work will be made available to the public for the first time.[39]

For *post-mortem* copies, the question may arise in relation to unfinished and undisclosed works, even in cases when heirs have granted the required economic rights to a third party who intends to replicate. If heirs of economic rights are also in possession of moral rights, the third party may assume that there is an implied consent to the disclosure. However, if economic and moral rights are divided between different groups of rightholders, the third party will not be able to deduct an implied consent from the rightholders of moral rights and must ask them for permission to disclose unfinished works.

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[36] DE WERRA (SUPRA 3), 457, recalling that copyrights are sometimes allocated to various persons, e.g. economic rights are granted to the heirs and the moral rights to a third party. Infra 2.3.

[37] See for instance Findlay v. Duthuit, 86 AD 2d 789, 446 NYS 2d 951 (1982), in which Duthuit was not only holder of moral rights but also owner and vendor of various works of Matisse, which created a conflict of interests with other holders and vendors of Matisse's works.

[38] On abuse of dominant position under Swiss law, see RINGE, Le pouvoir de l'expert face au droit de la concurrence, in: Gabus/Renold/de Werra (éds), L'expertise et l'authentification des œuvres d'art, volume 19 des Etudes en droit de l'art, Zurich 2007, 135 ss. On civil liability for abuse of right under French law, see Cass. 2e civ., 10 nov. 2005, pourvoi n°04-13618, in which the holder of the moral rights who refused to authentify a work has not been considered as liable because he did not act in bad faith.

[39] DAVIES/GARNETT (supra 6), 6.

2.3 Individuals or entity owning the copyrights after death of the artist

The third party willing to produce *post-mortem* copies shall also identify the individual or entity to be contacted. Indeed, after death of the author, the copyrights may be allocated to different holders, which could be described, a real *fragmentation* of rights.

Copyrights survive the death of the author with a minimum term of protection of 50 years.[40] After the death of the author, all copyrights still owned by the artist fall to his or her heirs.[41] Heirs enjoy absolute discretion in exercising their inherited copyrights and may, for instance, prohibit the production of new copies, whether identical or modified (e.g. in smaller format). Consequently, a third party willing to produce *post-mortem* copies will need to obtain permission from the artist's heirs.

That permission might be difficult to obtain for several reasons. Prior to the division of rights, heirs form a succession community and each decision over the rights shall be taken unanimously.[42] After the division of rights, the rights may be either merged and granted to one single heir or divided among various heirs, individual and entities. Prior to the division, the third party willing to produce *post-mortem* copies will have to contract with all heirs (otherwise the contract is void) and, after the division, will have to identify the correct rightholder depending on the contemplated use. To avoid these difficulties and to *control his legacy,* the artist may *set out inheritance rules,* subject to the forced heirship (*réserve légale*) of certain jurisdictions.[43] The artist may for instance impose specific charges that govern how heirs may exercise the copyrights,[44] allocate copyrights to a trusted third-party, such as a foundation or one heir,[45] or designate a testamentary executor.[46]

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[40] Under Swiss law, protection expires 70 years after the death of the author (and 50 years for computer programs), Art. 29 para 2 LDA. As an exception, some countries, such as France, provide that moral rights are perpetual and may be claimed indefinitely after the death of the author by heirs or personal representatives. For French law, see art. L.121-1 CPI providing that the moral right is «*perpétuel, inaliénable et imprescriptible*». For other perpetual moral rights, see DAVIES/GARNETT (supra 6), 955: Table of National Laws on Moral Rights.

[41] BARRELET/EGLOFF (supra 15), LDA 16 N 12; DE WERRA (supra 27), 686.

[42] Art. 602 para 2 Swiss Civil Code (CC); the specific rules of co-authorship (Art. 7 LDA) being not applicable to the community of heirs. See ATF 121 III 118, 121, JdT 1995 I 274.

[43] See URICE (supra 19), explaining that, under civil law, heirs have a legally protected right to inherit (forced heirship; réserve légale:), while under common law an individual may for instance limit testamentary transfers to a single person and completely disinherit other heirs (freedom of testamentary disposition is absolute). Under Swiss law, heirs are entitled to a legally defined minimum share of the total inheritance (art. 471 ss CC) and the legal reserve shall not be affected by specific inheritance rules (e.g. allocate economic copyrights, or certain moral rights granting the right to prevent from many uses, to third parties, such as a foundation).

[44] For instance prohibiting heirs to disclose unachieved works, determining how copyrights will be exploited after his death, or defining the authorized uses or even prohibiting partial or full use of

Copyrights may also have been transferred to third parties prior to the death of the artist.[47] The third party willing to produce *post-mortem* copies will need to identify such third parties and ask them permission.

However, while *economic rights* are assignable in whole or in part (e.g. under Swiss law, global transfer of these rights against a lump-sum payment is valid)[48], *moral rights* are more difficult to transfer. Unlimited contractual waivers are held valid in certain jurisdictions, such as *UK and US copyright law,* but other jurisdictions limit such waivers. Under *Swiss and German law,* moral rights may be subject to contractual waivers provided that they are not excessive.[49] For instance, an artist *may agree in advance to specific known and determinable modifications* by third parties, but not to any modification. Under *French law,* blanket waivers to moral rights are deemed null and void, even if the contractual waiver is deemed valid under other applicable laws.[50] For instance, French courts tend to apply French copyright law as a matter of public policy (ordre public) or as the applicable law (*lex protectionis*) according to which moral rights could not validly be waived (at least to the broad extent which is allowed under UK copyright law),[51] even if there is a valid contractual waiver under UK law. From this perspective, it is possible for waivers to moral rights which would be valid under the law of one country to be struck down by the application of the protective rules of another country.

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copyrights. For concrete cases, see Arthur Schnitzler set out rules to prohibit his heirs from staging his play Der Reigen and Herman Hess set out rules to prohibit his spouse from making any movie adaptation. Both cases cited by DE WERRA (supra 27), 691.

45 For instance preserving and promoting the artistic heritage of the deceased artist, managing all or specific copyrights, such as moral rights in general or via instructions on unfinished works, fighting against fakes and false attribution (which is difficult for the reasons explained below, supra 1.2.b). For concrete cases, see Roy Lichtenstein Foundation which shall preserve and promote the artistic heritage of the artist, quoted by DE WERRA (supra 27), 694. This author also recommends the creation of a foundation during the lifetime of the artist to avoid litigation between heirs (e.g. the registration of the trademark "Anne Frank" has given rise to conflict between the Dutch Foundation founded by Anna's father and the Basel Foundation).

46 For instance for the same purposes as with foundations, supra 47. See BECKET who gave precise instructions to his friend and publisher on how to stage "Waiting for Godot"; DE WERRA (SUPRA 27), 694 ss.

47 See DE WERRA (SUPRA 27), 688. Due to the freedom of contract, agreements on copyrights may take various forms (e.g. copyrights may be transferred with licence or assignment, or along with donation, purchase, employment agreement or contract for work).

48 DE WERRA (supra 3), 462.

49 Assignment of moral rights is debated by some scholars, see DE WERRA, in: Müller/Oertli (éds), N 16 ss ad art. 16 LDA.

50 As was confirmed in a recent decision of the French Cour de Cassation, which stated that the unwaivability of the right of integrity is a principle of public policy (ordre public), which recalls the equally strong protective position that was adopted in the famous Asphalt case about colorization applying moral rights irrespective a of any contractual waivers (JdW, Handbook, 275).

51 DE WERRA, The moral right of integrity, in: Research handbook on the future of EU copyright, Cheltenham, UK (E. Elgar) 2009, 267 ss, 276.

Consequently, the third party willing to produce *post-mortem* copies may need to ask permission of the individual or entity to which the economic copyrights have been transferred and, notwithstanding such transfer of rights, potentially the consent of the heirs who have retained the moral rights.

3. Contract law

Contract law is also relevant for *post-mortem* copies. The third party willing to reproduce copies shall take into account guaranteees towards other third parties with respect to its own produced copies (below a) as well as any possible contractual engagement taken by the deceased artist to limit further copies (below b).

3.1 Guarantee of the third party with respect to its copies

Obviously any third party replicating and selling copies to a buyer undertakes certain warranties. In particular, he is liable to the buyer for any breach of warranty of quality[52] and, if the copies ultimately appear to be fakes or unauthorized copies, he will be subject to a possible claim for breach of warranty by the buyer.[53]

3.2 Guarantee of the artist to limit further copies

A more delicate question is whether heirs own all copyrights for replications, or whether, on the contrary, they are limited by the contractual understandings of the deceased artist during his lifetime.

Rights and obligations of the deceased artist fall into the succession.[54] Heirs will succeed the author as contractual parties, including in contracts regarding the exploitation of copyrights entered into between the artist and contractual third parties.[55]

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[52] Under Swiss law, CO 197 ss (see in particular CO 197 para 1 "*the seller is liable to the buyer for any breach of warranty of quality and for any defects that would materially or legally negate or substantially reduce the value of the object or its fitness for the designated purpose*").

[53] Under Swiss law, CO 205 ss (see in particular CO 205 para 1 "*In claims for breach of warranty of quality and fitness, the buyer may sue either to rescind the contract of sale for breach of warranty or to have the sale price reduced by way of compensation for the decrease in the object's value*").

[54] Subject to strictly personal rights and obligations (*intuitu personae*), such as contracts for the creation of works (commission contracts), DE WERRA (supra 27), 688, n. 48–50.

[55] For German law, see. SCHRICKER, (éd.), Urheberrecht Kommentar, 2nd ed., Munich 1999, UrhG 28 N 7. For Swiss law, DE WERRA (supra 27), 688. For an analysis of the applicable law to the

Heirs may consequently inherit the contractual engagements of the artist, such as limitations on production of specific copies (e.g. different formats of the same photograph). These limitations on production do not seem to be clearly regulated. The *art market* has established as common practice *specific limitations* on the production of the photograph, with respect to the *number* of prints (e.g. the first print of an edition of 5 would be market as 1/5 and the last print 5/5), the *date* of the print (e.g. date of print 2017 against any given year), the *size* of print (e.g. format 40x60 against any given format) and the *material* (aluminium or paper print against any given support). Besides few specific regulations and tax laws to exempt artworks from VAT, there are no *international standards* for limitations on production. This leads to uncertainty, as artist and dealers are not necessarily always accurate in their Certificates of Authenticity and/or may consider that limits on the number of prints (e.g. limited edition of 5 numbered prints) allow the free production of further prints with other size, date and material.

Notwithstanding art market practice, when an artist and dealer agree on the above limitations, *these limitations shall be legally qualified.* Distinctions must be made between the warranty of quality and fitness along with the sale and independent guarantee. With the *warranty of quality* (CO 197), the seller promises certain qualities inherent to the object. If there is a discrepancy between the promise of quality and the delivered item, the buyer has a *claim for breach of warranty* (CO 205). The above limitations may be considered as a promise of quality subject to warranty of quality. However, further prints are often produced after the initial production and/or the sale of the promised print, while the promise of quality relates to the property of the good at the time of the risk transfer (except to future quality when the seller undertakes to ensure the quality, such as installation undertakings).[56] In addition, this claim expires two years after delivery of the object to the buyer (unless the seller has assumed liability under warranty for a longer period and subject to the specific longer time-limit for cultural property of one year after the buyer discovered the defect, but in any event 30 years after the contract was concluded). If the claim is admitted, the buyer may either rescind the contract for breach of warranty or have the sale price reduced to account for the decrease in the object's value (CO 205 para. 1).

With the *independent guarantee* (CO 111), the seller promises contractually, through an independent contractual engagement which goes beyond the legal regime, an economic result. If there is a discrepancy, the buyer has a *claim for breach of contract* (CO 97). The above limitations may be consid-

contract, see MOSIMANN/MÜLLER-CHEN, Kauf eines Originals der bildenden Kunst, insbesondere einer Fotografie, in: Büchler/Müller-Chen, Bern 2011, 1313.

[56] ATF 96 II 115 c. 2b; CR CO-197 N 20.

ered as an independent guarantee not to reproduce further prints, i.e. a waiver to make use of the right of reproduction. Such waiver is subject to the above limitations (excessive engagement, which might be valid, as it relates to a unique work, not to the general creative freedom of the artist). If the claim is admitted, the buyer may, after having set an appropriate time limit for subsequent performance, compel performance in addition to suing for damages in connection with the delay or he may instead forego subsequent performance and either claim damages for non-performance or withdraw from the contract altogether, provided he makes an immediate declaration to this effect (CO 109).

The *scope of these limitations* shall be determined on the basis of general rules of contract law, i.e. the basis of the real intention of the involved parties (subjective interpretation) and, if that cannot be determined, on the basis of what the parties would have agreed to in good faith and based on the specific circumstances of the agreement (objective interpretation). Based on the independent guarantee, the limitations shall be also determined on the basis of the specific rules of interpretation of copyright: when the objective interpretation remains uncertain, the scope of transfer of copyrights is interpreted according to the *Zweckübertragungstheorie* which stipulates *"The assignment of a right subsisting in the copyright does not include the assignment of other partial rights, unless such was agreed"* (LDA 16 2).[57]

When the artist undertakes (directly on the work or through a certificate of authenticity) to limit its prints with respect to any *number, date, size* and material (*"tout tirage, toute date, tout format et tout support confondus"*), which is rather out of the ordinary, he will be contractually bound not to produce any other prints of the same work. When these undertakings are not specified (e.g. reference is made to a number of prints, date, size and material with no further precision), drawing the line between authorized and unauthorized new copies (e.g. after a year in another format and material) may be difficult. This shall be assessed on a case-by-case basis based on the above principles of interpretation and, if necessary, based on the relevant art market / industry practice. It seems fair to allow the artist to reproduce further new copies at least after a year and/or in another material, provided that these differences are clearly indicated in the new copies (e.g. affixed in the prints or in the certificate of authenticity). It also seems fair to allow the production of copies in another format, provided that the new format is sufficiently distinct from the initial format (e.g. 13x13 against 40x60 against 76x115). A slightly altered format (e.g. 40x60 against 45x68) should therefore not be authorized.

[57] Swiss Supreme Court, 23 April 2013, 4A_643/2012, c. 3.1 and references. For few critics on this theory, see BENHAMOU/TRAN, Circulation des biens numériques, sic! 2016 571, n. 65.

4. Unfair competition law

Beyond copyright and contract laws, unfair competition law may also be considered as an additional limitation to *post-mortem* copies, in particular to public domain works (i.e. works for which the protection has expired).[58] Under Swiss law, Art. 3 lit. b LCD in particular sanctions who *"provides inaccurate or fallacious information about himself, his goods, works […] or, through that information, provides a third party an advantage over his competitors"*. It could apply to *two (2) particular scenarios:*

– when a *third party claims authorship on a work created by the deceased artist.*[59] However, unfair competition should not systematically apply in the event of plagiarism of public domain works, as copyright would always be bypassed through the application of unfair competition.[60] Unfair competition would only on a case-by-case basis under specific circumstances presenting unfair behavior.

– *when a third party attributes his work to a deceased artist,* by placing the name of the deceased artist on works made by him. Art. 3 lit. d LCD could typically apply in this situation, as the name and the style would be used and imitated by a third party without copying a specific work (in which case copyright protection could apply).[61] Again, unfair competition should not apply systematically (not to override the lack of copyright protection) but only on a case-by-case basis under specific circumstances presenting unfair behavior. For instance, in the event that someone imitates the style of Picasso for an advertising campaign and leads consumers to believe that the imitations are attributable to Picasso.[62] It

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58 I.e. 70 years after the death of the author (art. 29 para 1 LDA).

59 BARRELET/EGLOFF (supra 15), LDA 9 N 14; TROLLER, Immaterialgüterrecht, 3rd ed., Basel 1985, 691.

60 Under the Swiss law, unfair competition shall not bypass the lack of copyright protection, each law has its own scope of protection (this is known as the so-called *Umwegtheorie*). For details on the link between intellectual property and unfair competition laws, see BENHAMOU/ DE WERRA, Propriété intellectuelle et concurrence déloyale. Analyse du droit suisse et perspectives de droit allemand. In: Puttemans/Gendreau/de Werra (Ed.). *Propriété intellectuelle et concurrence déloyale: les liaisons dangereuses? Bruxelles*. Bruxelles 2017, 185 ss. In US, Courts tend to adopt the same approach, see Dastar Corp. v. Twentieth Century Fox Film Corp. et al., 540 U.S. 806 (2003): Supreme Court refused to apply unfair competition law for a work of the public domain (art 43(a) Lanham Act which sanctions "*false designation of origin, false or misleading description of fact, or false or misleading representation of act, which […] is likely to cause confusion […] as to the origin of [its] goods*"), observing a right of attribution (of paternity) after the expiration of the protection would conflict with the principles of copyright ("*[…] giving the Lanham Act special application to such products would cause it to conflict with copyright law, which is precisely directed to that subject, and which grants the public the right to copy without attribution once a copyright has expired*"). See DE WERRA (supra 3), 440.

61 DE WERRA (supra 3), 484 ss.

62 TGI Paris, Gazette du Palais 2nd Semester 1998 - sommaires et notes, 689 commenté et analysé par TREPPOZ, 71: Une telle utilisation en effet a été condamnée en France (en application de

could also be the case of one who copies paintings in the public domain and removes the name of a famous deceased artist and leads the public to believe that the imitations are attributable to Picasso.[63]

The foregoing shows the limits of unfair competition law, in the sense that it only applies under specific circumstances. For instance, under Swiss and German law, unfair competition does not serve to compensate for a lack of copyright protection (e.g. for works outside the scope of copyright protection for lack of originality or expired protection) (*Umwegtheorie*). It only applies according to its own conditions and goals, which requires an assessment on a case-by-case basis. In addition, it shall only apply if the behaviour is able to objectively influence the market.[64] In case law, for example, unfair competition has been rejected when a private collector sold a used car (a collector Ferrari) at an auction, as this behavior does not objectively influence the market.[65] This is the case even if the private collector made use of the services of a company that specializes in collector cars, organized the auction and mentioned the car in its catalogue.[66] Following this case law, unfair competition would not apply to the sale of works falsely attributed to an author by private collectors, as there would allegedly be no impact on the market.[67] Notwithstanding this case law, and the restrictive Swiss and German law approach, unfair competition usually requires careful examination in each case as to whether the act in question could objectively influence the market and thereby distort competition.

droit de la responsabilité civile), le Tribunal retenant en l'espèce qu'est répréhensible le fait d'avoir "volontairement cherché à utiliser à des fins purement mercantiles et publicitaires, la renommée de Pablo Picasso pour faire croire au public que l'une de ses œuvres originales participait à la promotion de produits de peinture en bâtiment".

63 DE WERRA (supra 3), 484.

64 TF, sic! 2002, 694: unfair competition law (LCD) sanctions only "actes déployant des effets sur le marché, objectivement propres à avantager ou désavantager une entreprise dans sa lutte pour acquérir de la clientèle, ou à accroître ou diminuer ses parts de marché".

65 In this dispute, the claimant tried to prohibit the sell of a Ferrari car based on unfair competition, by using the argument that the car supposedly contained a wrong identification number corresponding to a model destroyed by fire a in 1960. This identification number was also used by the claimant on another car. Decision quoted by DE WERRA (surpa 3), 484, indicating that this decision has been held on public law appeal with a limited power of examination and shall be consequently not overestimated.

66 TF, sic! 2002, 696.

67 DE WERRA (supra 3).

5. Notion of original, copies and fakes

There is no single agreed upon definition for original copies. From the art market perspective, there are no international standards[68] and in the practice sometimes refers to "original copies" or "authentic copies" (*"tirages originaux ou authentiques"*) for copies made by the artist or under his supervision and to "posthumous replications" or "post-mortem copies" ("*reproductions ou tirages posthumes*") for copies made after the death of the author.

From a legal perspective, there is no single definition. Under specific tax regulations, such as Swiss and French tax laws, which provide tax exemptions for certain works of art, original copies are defined as reproductions made by the artist or under his supervision, limited to 8 reproductions for bronzes, 30 prints for photographs and 250 copies for lithography.[69] Under the resale right (*droit de suite*), original works of art are defined as those made by the artist himself or under his authority in limited numbers.[70] French courts even recognize original *post-mortem* works of art and define them as copies made after death of the artist but respecting the exact features of the original work.[71]

Under copyright law, an original work is a work created by the artist which expresses a certain degree of originality (individuality under Swiss law) and contains the *"mark of the author"*.[72] This relates in our view to a unique work as the object of protection, which excludes multiple *original* copies. Every further copy relates to the reproduction of the work, whether in the same or in different formats.

For the sake of consistency between these different definitions and to avoid misuse or misunderstanding in the art market, we recommend to use the following definition: *Original* means the unique work made by the artist himself or under his supervision, *copies* mean any reproduction of the original (whether authentic copies, i.e. made by the artist during his lifetime, or posthumous copies made by third parties after his death and whether in the same or different formats) and *fakes* mean works made by a third party but bearning the name of the artist).

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68 FEHR/HUFSCHMID, Is a picture worth a thousand… prints? The challenges of limited edition prints in photography, Art & Museum, Summer issue 2017, 10.

69 CGI Annexe III ; LTVA 53 c.

70 Art. 2 Directive 2001/84/EC of 27 September 2001 on the resale right for the benefit of the author of an original work of art.

71 See infra 2.2.a, in particular the Camille Claudel's case, n. 22. For an analysis of this case, and regarding the distinction between "original" work of art under copyright law on one hand and under resale right and the art market on the other hand, see Aude Mercier, L'originalité des tirages posthumes, Légipresse n° 318, Juillet/Août 2014, 428.

72 ATF 130 III 172, JdT 2004 I 289.

6. Conclusion

Any third party willing to produce *post-mortem* copies will need to identify the relevant copyrights for the contemplated use and the individual or entity owning such right. Various copyrights must be taken into account, in particular the economic rights of reproduction and the moral rights of integrity and paternity. Various rightholders may also be considered, as the copyrights may be allocated between several entities (heirs, trusted-party or contracting parties). As a result, all of them must be contacted and must agree to the replication in order to avoid legal consequences.

Post-mortem copies may be prohibited by copyright (if the economic rights have not been granted), by contract law (if the artist agreed to limit further copies in the initial sale) and/or by unfair competition (if they are depicted as an original instead of a reproduction). *Fakes* may be prohibited either by the copyright (for jurisdictions that recognize a right of non-paternity) or by unfair competition.

The challenges examined in this contribution (in particular the fragmentation of rights between rightholders, the different concepts applicable in each jurisdiction and the possible abusive exercise of rights by heirs) seem to raise insoluble legal problems and uncertainty. As a practical consequence, these challenges could potentially affect the promotion of cultural heritage, in particular the circulation of the artistic legacy. These challenges could even affect the art market itself and the marketability of original and authentic works: *post-mortem* copies and even fakes might indeed create scarcity of authentic works and increase their value. It is also questionable whether heirs (or sometimes third parties with a lesser connection to the deceased artist) are in the right position to determine the faith of the artistic legacy, in particular when it comes to moral rights of integrity (e.g. to accept or prohibit modified copies), the right of disclosure for unfinished works or the right of paternity for contesting the authenticity of works.

For these reasons, one may provocatively wonder why copyrights shall survive instead of expiring with the death of the artist, at least the moral rights, such as in the US.[73] Heirs would benefit from the economic rights and hence from the efforts made by the deceased artist, but would not be in a position to restrict abusively the circulation of the artistic legacy. And when there is a need to protect the deceased artist against misrepresentation of his life and work or the public against vandalism by misattributions and coun-

[73] These challenges have led to repeating studies and harmonization efforts on moral rights, see for instance the Research handbook on the future of EU copyright, Cheltenham, UK (E. Elgar) 2009, where various authors seem to plead for an harmonization of moral rights, including Jacques de Werra, 281 ss; the Study on the Moral Rights of Attribution and Integrity led by the USPTO https://www.copyright.gov/policy/moralrights/ (last consultation 08.10.2017).

terfeits, heirs could rely on their own personality rights (the closer the relationship to the deceased artist, the more generous the protection is likely to be). Finally, it could be also interesting to recognize a broad right of action to associations which aim at defending the artistic legacy of the artist, or more generally cultural heritage.[74]

[74] See MERRYMAN (supra 35), 453, suggesting for US Law to enact a rule similar to § 989 California Civil Code which creates a right of action in "*a public or private non-profit entity or association, in existence at least three years […] a major purpose of which is to…display or otherwise present works of art to the public or to promote the interests of the arts or artists*."