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Snipping Private Ryan: The Clean Flicks Fight to Sanitize Movies

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I. INTRODUCTION

Until the mass-market introduction of digital recording technology, consumers were unable to make near-perfect duplications or seamless alterations of video and audio recordings of artists. That was then; this is now. Today computers allow consumers to burn their own CDs and DVDs. They can create their own music compilations. Usenet groups post copies of newly released movies that members can download...sometimes, even before the movie's first theatrical release! Peer-to-peer file sharing services, like the now defunct Napster and its replacements (KaZaA, Grokster, and others), allow one consumer to browse the hard drives of thousands of other consumers in distant locations to find music, movies, and other types of electronic documents and download them to their own computers.

This consumer behavior is nothing new. When tape recorders were introduced, consumers recorded their vinyl albums for use in their car tape decks and Walkmans®. They made party tapes for their friends. When videotape recorders were introduced, consumers recorded TV shows and movies for their friends and for themselves. With premium cable and pay-per-view programs, commercials were eliminated, allowing for seamless videotaping of commercial-free programming. However, with digital technology, these recordings are virtually indistinguishable from the originals. Analog reproductions (audiotape, videotape, etc.) degrade with each generation. So, if a movie is taped and given to someone who makes a copy from the tape
and so on, the copy will eventually become unwatchable. With
digital reproduction, the degradation is almost imperceptible from
generation to generation, greatly postponing the unwatchable stage.

Digital technology scares the entertainment industry, and rightly
so. Not only are they losing control over the distribution of their
products, they are also losing control over the actual product. For
example, a backlash against the character Jar-Jar Binks in STAR
WARS® THE PHANTOM MENACE (Lucasfilm, 2001) resulted in an
underground version of the movie with Jar-Jar removed from the
film.¹ Bootleg copies of movies that have not even opened in theaters
yet are showing up on the sidewalks of New York, China, and
Russia.² The entertainment industry is grappling with how to reclaim
control over its products and protect its intellectual property against
future infringements.

It is against this backdrop that we consider the Clean Flicks case.
Should a third party be allowed to edit a movie to remove content the
third party finds objectionable? What if the third party is a co-
operative of consumers who have similar concerns about
objectionable content? What if the co-operative uses their library of
"sanitized" movies to attract new members? What if the members
want to own their own sanitized version of the movie? What if the
people who created the movie, the directors, writers,
cinematographers, and other artists are not the copyright owners? Do
they have any rights regarding the alteration and distribution of their
creations, and if so, what are those rights? These are just some of the
issues that the court will wrestle with in the Clean Flicks case.

Clean Flicks puts forth two alternative fair use defenses for its
actions: (1) the company's actions create no loss of revenue because
there is a one-to-one ratio between the originals and sanitized copies,

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¹ Peter Rojas, Let One Hundred Edits Bloom: The Blessed Version, VILLAGE VOICE, Oct. 9, 2002 (The "Phantom Edit" removed roughly 30 minutes of content the editor found objectionable, including scenes with Jake Lloyd (Anakin Skywalker) and Jar-Jar Binks. It is virtually impossible to find this version as all websites that previously posted it have either removed it or have been shut down.). For the official Lucasfilm point of view, see Andrew Rogers, Lucas Unhappy About 'Phantom Edit' Distribution, June 14, 2001, http://www.zap2it.com/movies/news/pstory/0,3382,7033,00.html.

² According to the Motion Picture Association of America (MPAA), China and Russia are two of the largest video piracy markets in the world. Pirated content is estimated to be 91% of the Chinese and 80% of the Russian home entertainment market. MPAA, Piracy Fact Sheets, at http://www.mpaa.org/PiracyFactSheets. See also Reuters, Man Admits Copying "The Hulk" Before Premier, June 25, 2003, available at http://www.forbes.com/markets/news/wire/2003/06/25/trt1011227.html (describing an ad agency employee who uploaded a working copy of The Hulk onto a Netherlands-hosted chat room).
or (2) they are a co-op film club that should be treated like a "lending library" because they lack a commercial motive. While both are novel arguments, the court should reject them as violative of the copyright law and not a valid exercise of the fair use doctrine.

The directors named in the suit have made a trademark infringement and trademark dilution counterclaim under the Lanham Act. They argue that by editing a director's movie without authorization, Clean Flicks is fraudulently implying a link between the director and the edited movie.

This comment will discuss these defenses and counterclaims and attempts to predict the outcome of this controversy. Although the directors have filed various motions to join other plaintiffs (Movie Mask and ClearPlay for example), this comment will focus on the Clean Flicks copyright claim, the directors' trademark counterclaim, and a possible motive underlying the way in which Clean Flicks brought this suit.

II. BACKGROUND

A. Facts & Issues

In 1999, a man in Utah performed what was, at the time, a very small act. He edited some nude scenes that a neighbor didn't want her children to see, out of the film TITANIC (Paramount Pictures and Twentieth Century Fox, 1997). Nearly three years and countless neighbors later, Ray Line's small act has spawned a cottage industry that has Hollywood in an uproar. His company, Clean Flicks, is one of a handful of companies that edit or allow viewers to edit objectionable scenes from videos and DVDs. Subsequent to filing its

3. Proposed Amended Counterclaim, Huntsman v. Soderbergh, Civil Action No. 02-M-1622 (MJW), ¶ 89, available at http://www.dga.org [hereinafter Proposed Amended Counterclaim]. The Counterclaimants also make an unfair competition claim, alleging Clean Flicks violated California Business and Professions Code § 17200 and common law, but these claims will not be discussed here.

4. In the fall of 2002, Clean Flicks changed its name to CleanFilms.

5. Clean Flicks edits content and makes the films available to its customers/members. Clean Cut Cinemas, Family Safe Media (TV Guardian), EditMyMovies, Family Flix, Video II, and Play It Clean Video are similar in that they physically edit the original movie and distribute copies of the edited version. Trilogy Studios (MovieMask), Family Shield (MovieShield), and ClearPlay are software applications or hardware that do not edit the original movie. They "mask" or delete scenes or parts of scenes while the movie is playing, without making a permanent change to the DVD or videotape, by muting the audio, skipping past nudity and violence, or putting digital clothing on naked actors. See Proposed Amended Counterclaim, supra note 3, ¶¶ 39–61.
claim, Clean Flicks stopped selling videos and DVDs, and limited its transactions to rental only, requiring membership in its video rental club.

In August 2002, Clean Flicks filed a suit in Federal District Court in Colorado seeking a declaratory ruling stipulating its third party editing was protected free speech and therefore was fair use under the Copyright Act. The suit was filed against sixteen directors of major motion pictures including, among others, Steven Spielberg and Robert Altman (collectively "the Directors"). While some directors lacked standing since they were not the copyright owners of the films in question, others did. Therefore, the case could not be dismissed at the outset.

A flurry of motions and a counterclaim followed the initial Clean Flicks complaint. The Directors, recognizing that many of them lacked standing since they were not the copyright holders of the films in question, filed a motion to join, as co-defendants, the studios that actually held the copyrights. They also filed a motion to join as counterdefendants, companies that edit content out of films and companies that provide hardware and software so that viewers may edit objectionable content while viewing a movie on video or DVD. The Directors then filed a counterclaim alleging that the actions of plaintiffs/counterdefendants violated the Lanham Act by

6. Complaint and Jury Demand, Huntsman v. Soderbergh, Civil Action No. 02-M-1662 (MJW), ¶ 1 [hereinafter Complaint and Jury Demand].
7. Id. ¶ 14 ("Plaintiffs ... believe that their actions ... are free speech and/or fair use and are protected by the First Amendment to the U.S. Constitution."). Only the fair use defense within the context of the Copyright Act is discussed herein.
8. Id. ¶ 1 ("... arising out of a dispute and controversy between Plaintiffs and Defendants relating to the Copyright Act...").
9. The initial complaint named as defendants Steven Soderbergh, Robert Altman, Michael Apted, Taylor Hackford, Curtis Hanson, Norman Jewison, John Landis, Michael Mann, Phillip Noyce, Brad Silberling, Betty Thomas, Irwin Winkler, Martin Scorsese, Steven Spielberg, Robert Redford, and Sydney Pollack. See Complaint and Jury Demand, supra note 6.
10. Some of the Directors created their movies under work-for-hire contracts and therefore did not hold the copyright in the finished film. In such cases, the movie studio or production company holds the copyright. Clean Flicks did not name any studios as defendants in its complaint. Subsequent to the commencement of this case, the following motion picture studios were joined as defendants: Metro-Goldwyn-Mayer Studios, Inc., Time Warner Entertainment Company, L.P., Sony Pictures Entertainment Inc., Disney Enterprises, Inc., DreamWorks L.L.C., Universal City Studios, LLLP, Twentieth Century Fox Film Corporation, and Paramount Pictures Corporation.
12. Proposed Amended Counterclaim, supra note 3, ¶ 65-161 (alleging Countercomplainants' violations of 15 U.S.C. §§ 1125(a) and (c)).
misrepresenting the edited films as being the creations of their respective directors. The Directors’ Guild of America (DGA) filed a motion to intervene. As the exclusive collective bargaining representative for motion picture directors, the DGA has a vested interest in the outcome of this case. The DGA joined the Directors in their various motions to join additional plaintiffs/counterdefendants and co-defendants.

Clean Flicks’ request for a declaratory ruling and the Directors’ counterclaims raise two key issues:

1. Can Clean Flicks convince the court to hold that it did not violate any of at least three possible separate infringements of copyright (reproduction, derivative works, and distribution) by defending its editing practice with a fair use argument: that its one-to-one ratio of originals to sanitized copies creates no loss of revenue, and that, because it runs a film rental club, it should be treated like a non-commercial lending library?

2. Does Clean Flicks’ promotion of its edited version of movies using the director’s name, the studio’s name, the original packaging, and other information associated with the original, unedited version of the movie create a viable counterclaim for the Directors that Clean Flicks violated the Lanham Act?

What began as Clean Flicks’ plan to preempt a lawsuit against the company for copyright infringement has evolved into an opportunity for the both sides to set legal precedent under the Copyright Act and the Lanham Act. But in the end, it may become nothing more than a creative tactic by Clean Flicks and its competitors to acquire a license to edit and distribute commercial movies.

13. Id. ¶ 5. ("Among the DGA’s members are more than 1,000 directors of feature films.").


15. As expected, the motion picture studios are defending their copyrights against infringement. It is interesting to note that counterclaim defendants (Triology Studios, Inc., Family Shield Technologies, LLC, and ClearPlay, Inc.) filed a motion for summary judgment to which the studios have replied alleging the defendants’ are "preparing and exploiting infringing derivative works." See Motion Picture Studio Defendant’s Response Brief in Opposition to ClearPlay, Inc.’s, Trilogy Studios, Inc.’s, and Family Shield Technologies, LLC’s Motion for Summary Judgment, Huntsman v. Soderbergh, Civil Action No. 02-M-1622.
B. The Litigants

1. The Plaintiffs

Clean Flicks, a Utah-based business, edits videotapes, and to a lesser extent DVDs, to remove content that some viewers find offensive – sex, gratuitous violence, profanity, etc.\(^\text{16}\) It is one of a number of companies that provide similar services. It rents altered videos and DVDs to customers via its physical store locations and via the Internet. Clean Flicks currently has 39 franchise locations in 11 states\(^\text{17}\) and according to its website is planning to expand its retail locations into all 50 states.

![Movie Mask digitally dresses Titanic's nude Kate Winslet.](image)

2. The Defendants

The Directors named in the suit are some of the most respected and powerful movie directors in the world. Their collective lists of works include such award-winning movies such as TRAFFIC (USA Films, 2000, directed by Steven Soderbergh), SAVING PRIVATE RYAN (Dream Works and Paramount Pictures, 1998, directed by Steven Spielberg), GLADIATOR (Dream Works and Universal Studios, 2000, directed by Ridley Scott), GOODFELLAS (Warner Bros., 1991, directed by Martin Scorsese), CLEAR AND PRESENT DANGER

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16. Complaint and Jury Demand, supra note 6, ¶4–5 (The complaint was filed by a Clean Flicks franchise located in Colorado and Robert Huntsman, who describes himself as “an inventor...of a method for allowing viewers to view content edited movies.”). Movie Mask, another company like Clean Flicks, altered a scene in TITANIC, in which Kate Winslet appears nude, by clothing her in a digital corset.  
(Paramount Pictures, 1998, directed by Phillip Noyce), GOSFORD PARK (Universal Studios, 2002, directed by Robert Altman), TOOTSIE (Columbia TriStar Pictures, 1993, directed by Sydney Pollack), INDECENT PROPOSAL (Paramount Pictures, 1993, directed by Robert Redford), and many, many more. For many of the films they have created, the Directors are work-for-hire employees of the studios and production companies that own the rights to the films they create. In these instances, therefore, the Directors lack standing as defendants in a dispute involving copyright law. Although the studios own the movies, however, the Directors are fiercely protective of the artistic integrity of their work, negotiating for control over final cut\(^\text{18}\) and other control elements into their employment contracts.

The DGA ("the Guild") is a professional guild representing the directors named in the complaint and many more directors working in the United States, irrespective of whether the director is a citizen or resident of the United States. The Guild represents more than 12,000 directors, most of whom are not as well known as those named in the complaint\(^\text{19}\).

The studios that have been joined as co-defendants are the major movie studios. However, the issues raised in this complaint also will affect all studios and production companies including small independent shops like View Askew\(^\text{20}\). Directors are hired by movie studios and production companies to direct their pictures. In some cases, the studios have long-term development deals with directors, particularly A-list directors like Spielberg and others named in this action.

III. ANALYSIS

A. Clean Flicks' Fair Use Affirmative Defense

By filing its complaint against the Directors, Clean Flicks has forced a decision that the Studios were unlikely to have made proactively\(^\text{21}\)—whether Clean Flicks will be licensed to edit or

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18. "Final cut" is a term used to designate the finished film that is released into theaters. More recently it also includes video and DVD releases.

19. Press Release, DGA, DGA Denounces Lawsuit Filed Against 16 Directors by Two Entities Engaged in Unauthorized Editing of Films (Aug. 29, 2002). The membership number conflicts with Countercomplaint.

20. View Askew is a New Jersey-based production company led by independent director Kevin Smith and can be found at http://www.viewaskew.com/main.html.

distribute films owned by the studios. Clean Flicks makes a fair use affirmative defense argument that others have made and the courts have rejected on numerous occasions: the purpose of their use is non-commercial, and their use results in insignificant market harm to the copyrighted work. Clean Flicks, however, takes a novel approach in making its case. In determining whether a fair use defense against copyright infringement is valid, courts consider four factors:

1. Purpose and character of the use – whether it is commercial in nature or for a non-profit or educational purpose;
2. the nature of the copyrighted work itself;
3. the amount and substantiality of the part of the work used relative to the entire copyrighted work; and
4. the effect of the infringing use on the potential market or market value of the copyrighted work.

1. Purpose and Nature of the Use.

The Copyright Act exempts from liability certain unauthorized uses made for purposes of criticism, comment, news reporting, teaching, scholarship and research, qualifying them instead as non-infringing fair uses. But this list is not meant to be exhaustive—"[w]hen technological change has rendered its literal terms ambiguous, the Copyright Act must be construed in light of [its] basic purpose." In 1984, the Supreme Court in its Sony Betamax decision upheld the notion that non-commercial use of copyrighted material weighs heavily in favor of the alleged infringer, whereas commercial

meeting between Trilogy and the Motion Picture Association of America President (MPAA) Jack Valenti. MPAA said it is studying the issue."); Mark Eddington, Director's Cut? Try Censor's Cut, THE SALT LAKE TRIBUNE, Apr. 14, 2002 ("So far, Hollywood studios seem to be following [Professor Doris] Long's [John Marshall Law School in Chicago] script, maintaining a studied silence - at least publicly - on an issue some privately wish would fade to black. The Motion Picture Association of America is staying mum. Paramount Pictures sounded off in 1998 about [another company's] 'Titanic' tinkering, but has said little about subsequent efforts."); Rich Vosepka, Utah Companies Edit R-rated Videos for Family Audiences, THE DETROIT NEWS, Aug. 18, 2001 ("After some initially hostile muttering, the film industry has been silent.").

23. Id. ("[T]he fair use of a copyrighted work, . .for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.").
24. Atari Games Corp. v. Nintendo of Am. Inc., 975 F.2d 832, 843 (Fed. Cir. 1992) (citing Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975)).
use is presumptively unfair. Ten years later, however, the Court clarified the scope of the presumptive unfairness of commercial use in *Campbell v. Acuff-Rose Music, Inc.*, holding that "no 'presumption' or inference of market harm that might find support in *Sony* is applicable to a case involving something beyond mere duplication for commercial purposes." Revenue need not be generated directly from the sale or barter of the copyrighted materials in order for the use to be deemed commercial. Playboy Enterprises, Inc. (PEI) sued the provider of an online bulletin board service because his subscribers were downloading PEI's copyrighted images from the bulletin board without PEI's permission. Although the bulletin board service provider only charged his subscribers for the general subscription to the bulletin board service and not the images themselves, the court held that this use qualified as being commercial in nature. Furthermore, the court held that a use is commercial in nature "even if the customers supplied with such material themselves use it for personal use."

Clean Flicks argues that the revenue it derives is not from the sale or rental of the content-edited videos, but that it is from the editing service itself. The characterization of what Clean Flicks does is much easier to discern in a transaction where the owner of a video brings their copy to Clean Flicks to have certain content removed so the owner can view the edited version in their own home. In this scenario, Clean Flicks is deriving revenue from providing the editing service and someone other than Clean Flicks owns the video being edited. According to Clean Flicks' president, John Dixon, his customers are "well within [their] rights . . . to pay extra for someone

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25. Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 451 (1984) ("[A]lthough every commercial use of copyrighted material is presumptively an unfair exploitation of the monopoly privilege that belongs to the owner of the copyright, noncommercial uses are a different matter. A challenge to a noncommercial use... requires proof either that the particular use is harmful, or... it would adversely affect the potential market for the copyrighted work."); see also Bridge Pub'ns, Inc. v. Vien, 827 F. Supp. 629, 635 (S.D. Cal. 1993) (citing Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 449-51 (1984)).


28. Id. at 1558 ("Defendant Frena's use was clearly commercial. BBS [bulletin board service] was provided to those paying twenty-five dollars ($25) per month or to those who purchased products from Defendant Frena.").

29. Id.
to edit the videos for them." Doris Long, professor of copyright and Internet law at John Marshall Law School in Chicago disagrees: "What they are doing is a violation of copyright law because they are editing movies without the permission of copyright owners and making money off of the transactions." 

The argument defending the video rental service, on the other hand, is a bit more complicated. Clean Flicks characterizes its video rental program as a "cooperative rental club," where members "collectively purchase original, unedited DVD movies" and have them edited, and it further asserts "as collective owners . . . the Co-op has the right . . . to edit out content that is objectionable to its members." Professor Susan Poulter of the University of Utah Law School believes that the practice of editing videos, whether done by Clean Flicks on behalf of individual customers or on behalf of its co-op members, may be creating a derivative product and therefore still a violation of copyright law. Whether this is the case will depend on just how much of a movie's content is deemed "objectionable" and is edited out of the original version. According to Pamela Samuelson, a professor of law at University of California at Berkeley's Boalt Hall, "it's pretty unlikely . . . that a judge would say [omitting just ten seconds of bad language] runs afoul of the derivative work right." 

Clean Flicks is relying on the non-exhaustive nature of the list of fair use exemptions. It hopes to set legal precedent with the inclusion of its one-to-one ratio argument on that list. Legal scholars agree that the Clean Flicks model creates a grey area that opens up the discussion. Harvard Law School professor, Peter Weiler, notes the "qualitative difference between someone making a whole host of free copies from the original, and someone making changes in a whole host of originals they've bought." Even noted film director Ron Howard seems to agree with Profess Weiler, saying, "If somebody wants to take a Picasso print, cut some parts up, color some things in and hang it in their room as their take on Picasso, that's the sort of

30. Rojas, supra note 1.
32. See the Clean Flicks/Clean Films website, at http://www.cleanfilms.com/faq/phtml.
36. Rojas, supra note 1.
personalization I don't mind. But I wouldn't want somebody to take that to an art show and say that's Picasso.” If the court sees this issue the way Mr. Howard sees it, Clean Flicks has a chance, albeit a slim one, to prevail on the nature and purpose of the use. This is likely to require, however, a determination by the court that Clean Flicks' membership model is the same as private or personal use. Furthermore, such a determination by the court still would not address the issue of whether a Clean Flicks version of a film could be promoted with the same title, artists' names, and studio name as the original film. However, despite the creativity of this argument and although Clean Flicks may plausibly characterize its use as non-commercial in nature, the “nature and purpose of the use” factor is likely to weigh against Clean Flicks. For a court to find otherwise would inject even more uncertainties into copyright law.

2. Nature of the Copyrighted Work Itself

When looking at the nature of the copyrighted work, courts consider whether copyright protection is more or less likely to have been intended for that work—"The law generally recognizes a greater need to disseminate factual works than works of fiction or fantasy.” Factual works tend to be more educational in nature, whereas fictional works tend toward entertainment. Works that are categorized as entertainment or fictional are more a product of the imagination of their creators and are exactly the sort of work copyright laws are intended to protect—"In general, fair use is more likely to be found in factual works than in fictional works.” With the exception of documentaries, movies are the ultimate works of fiction or fantasy. Even biographical films take creative license with historical fact. This factor of fair use is likely to weigh against Clean Flicks.

40. Tom Brook, Denzel's Hurricane Stirs Controversy, BBC NEWS ONLINE, Jan. 8, 2000 ("[O]n closer inspection, The Hurricane does seem to be more Hollywood confection than accurate rendering of the truth."); Tom Brook, Critics' Beautiful Debate, BBC NEWS ONLINE, Feb. 9, 2002 ("[A] New York Times film critic, Charles Taylor . . . who praised certain aspects of A Beautiful Mind also found that the story was 'almost entirely counterfeit.'").
3. Amount and Substantiality of Part of Work Used

Typically this part of the analysis looks at how much of the copyrighted work is used in some other work. In the case of movies edited to remove content, the analysis is turned on its head. When the rap group 2 Live Crew recorded a parody of the song, *Pretty Woman*, on *AS CLEAN AS THEY WANNA BE* (Luke Records, 1989), the group was sued for copyright infringement. The United States Supreme Court considered not just how much of the original work was copied, but also the "relation to the purpose of the copying." Given that in the case of each edited movie, Clean Flicks' purpose was to provide a version of the movie with profanity, sex, violence, and other "objectionable" content removed, one can argue that this third factor weighs on the side of Clean Flicks. It is essential for Clean Flicks to use as much of the original movie as possible to preserve the storyline and the director's vision, so it is reasonable that much of the content remains intact. This is similar to the situation in *Sony*, where home viewers videotaped entire television programs for later viewing. In that case, the Court held that such videotaping "does not have its ordinary effect of militating against a finding of fair use." Of course in *Sony*, this interpretation is within the context of the home viewer's use being non-commercial in nature, which distinguishes it from the Clean Flicks case. In this case, the amount and substantiality of what Clean Flicks copied from each movie is likely to weigh against a finding of fair use.

4. Effect of the Use on the Potential Market for or the Market Value of the Copyrighted Work.

Clean Flicks argues that its one-to-one ratio of edited videos to original unedited videos ensures that its actions do not take any revenue away from the copyright holders. This is a rather simplistic approach to the revenue potential available to the copyright holders - the Studios. Clean Flicks' argument assumes that a studio would charge the same price for a content edited version of the film as it would charge for the director's original vision. However, since Clean Flicks has already shown that purchasers are willing to pay a

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premium for the edited version, a studio also might charge a premium. So, despite the fact that Clean Flicks buys one video for each one it edits, it still is siphoning off potential revenues from the copyright holders, which would cause the fourth factor to weigh heavily against Clean Flicks. According to Annette Hurst, a San Francisco intellectual property attorney, “if the movie studios argue that this new technology is discouraging people from buying these derivative works from the studios, it might turn out to not be fair use.”

Furthermore, courts also will consider the aggregate effect of “unrestricted and widespread conduct” similar to that of Clean Flicks and whether such conduct “would result in a substantial adverse impact on the potential market” for the original. By selling, or proposing to sell, franchises in the 50 states, Clean Flicks itself is ensuring the substantiality of any adverse impact from its conduct.

Another way to interpret this factor is whether the use of the copyrighted work “affects or materially impairs the marketability of the copyrighted motion pictures.” One side effect on DVDs of Clean Flicks’ editing process is that all bonus content (such as foreign language or special commentary soundtracks, “making of” documentaries, etc.) is deleted, leaving only the edited feature film with no extras. Once a DVD has been edited in this fashion, Clean Flicks has no control over who sees the edited DVD nor does it have any control over whether a viewer of the edited DVD knows that there is an original version available that contains all the extras. Someone who is unaware of what this editing process does to the DVD might mistakenly believe, after viewing an edited version, that a DVD of GLADIATOR, for example, has no director’s track and no production notes, nor any of the other bonus materials that are on the original DVD. This could have a significant adverse effect on the

44. Clean Flicks charges roughly $14 for editing VHS tapes and $18.50 for editing DVDs. See the Clean Flicks’ website, at http://www.cleanflicks.com.

45. Infinity Broad. Corp. v. Kirkwood, 150 F.3d 104, 110 (2d Cir. 1998) (“The fourth factor... is concerned with secondary uses that, by offering a substitute for the original, usurp a market that properly belongs to the copyright-holder.”).

46. Wilson, supra note 37.

47. 4 NIMMER ON COPYRIGHT, § 13.05[A][4] (2003).


49. See the Clean Flicks/Clean Films website, at http://www.cleanfilms.com/faq.html (“Most menu items found on original, un-edited DVDs are lost during the editing process.” For example, if an original, un-edited DVD contains a menu option to view the DVD movie with Spanish subtitles, that option will not be available on the edited copy of that movie.).
market for the original DVD version of the movie because DVD buyers have come to expect bonus material for the premium prices they pay for DVDs.\(^{50}\)

5. Conclusion

Considering all four factors, Clean Flicks is unlikely to prevail on a fair use defense. The use is commercial in nature. The copyrighted works are movies and as such are entertainment – fiction or fantasy – even when based on an actual person or event. How much content is edited out varies from movie to movie, from mere seconds to minutes, but in all cases a substantial portion of the copyrighted work is retained and duplicated. Finally, the use is likely to have an adverse effect on the potential market for the original works either by incorrectly associating the original with the content-edited version or by usurping a potential market from the copyright holders.

B. Directors' and Directors Guild of America's False Designations of Origin Claim

The Directors and the DGA (on behalf of its members) filed a counterclaim, alleging that Clean Flicks has “without authorization, altered and/or mutilated the original works of the Director Counterclaimants and other DGA members, and offered these altered and/or mutilated works to the public as the creations of the Director Counterclaimants and other DGA members.”\(^{51}\) The Directors and the DGA (“Counterclaimants”) further assert that the counterdefendants “willfully caused the Director Counterclaimants and other DGA members to be falsely associated and confused with versions of feature films that are altered and/or mutilated versions of the . . . original creations . . . [and] willfully have presented the Director Counterclaimants and other DGA members . . . as creators of works not their own.”\(^{52}\) The Lanham Act calls this “false designations of origin” and provides:

Any person who . . . uses in commerce . . . any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which (A) is likely to cause

50. Video Pipeline, 192 F. Supp. 2d at 342 (“[A] key issue in fair use cases is whether the defendant’s work tends to diminish or prejudice the potential sale of plaintiff’s work.”) (citing Meeropol v. Nizer, 560 F.2d 1061, 1070 (2d Cir. 1977)).

51. Proposed Amended Counterclaim, supra note 3, ¶ 79.

52. Id. ¶ 80.
confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person . . . or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act. 53

In order to prevail, the Directors and the DGA must show that Clean Flicks' actions "[create] a likelihood of confusion in the minds of potential consumers as to the source, affiliation, or sponsorship" of the edited films. 54 To determine whether a Clean Flicks edited film is likely to be confused with the original director's version, the Court will consider a number of factors including:

1. Similarity of Products or Services

The movies Clean Flicks edits are almost identical to the originals, thus common sense dictates a high likelihood of consumer confusion. John Dixon, Clean Flicks' president, who notes "[t]he cuts are inconspicuous and will only alter a movie by a few minutes," reinforces this opinion. 56 Fred Ball, a local Utah radio personality and supporter of Clean Flicks concurs: "[T]he movies are viewed and cleared of profanity, adult themes and gory violence. The edits are seamless. Unless a person has already seen the film, he or she would never know a word or scene had been deleted [emphasis added]." 57

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54. Elvis Presley Enters., Inc. v. Capece, 141 F.3d 188, 193 (5th Cir. 1998).
55. Id. at 194 (indicating that the Court identifies as a "non-exhaustive list").
2. Identity of Retail Outlets and Purchasers

While both versions of the movie are sold through similar distribution channels, the customer groups for each version are likely to include different people. Clean Flicks sells and rents videos, whether VHS or DVD, in physical locations and online. Clean Flicks has physical locations in a number of states, similar in appearance to any small independent video retailer. Clean Flicks' online distribution is similar to Netflix, an online DVD rental and sales service. Clean Flicks' physical franchises are set up as a cooperative with its customers being members of the co-op. For a monthly membership fee, a co-op member has unlimited video borrowing privileges. This differs from traditional video rental stores where membership usually is free and customers pay rental fees with each transaction. Clean Flicks' online distribution program is modeled after Netflix, with customers paying a flat monthly fee to be able to borrow videos that are mailed to them and returned by mail. Clean Flicks calls this monthly fee a membership fee and Netflix calls it a subscription rate. Aside from what the fees are called, the two models are identical.

Despite the similarity of the distribution channels, Clean Flicks would argue that its customers are not customers of the traditional retail outlets. In fact, the company insists the purchases its customers make are wholly incremental sales because its customers would not purchase the original versions of the movies Clean Flicks edits. Since many of the company's customers are members of the Mormon Church and the church has advised its members not to watch "objectionable" movies, Clean Flicks may be correct in this hypothesis.

58. Netflix rents and sells DVDs via the Internet. To rent, a person becomes a subscriber to Netflix by paying a monthly fee. This flat rate entitles the subscriber to an unlimited number of video rentals each month, with no late fees, because the subscriber can keep the DVD for as long as she or he wants. There is a limit on the number of DVDs that a subscriber can have at any given time, which is governed by the subscription rate.

59. See Kieth Merrill, Movie Ratings Not Reliable, MERIDIAN MAGAZINE, at http://www.meridianmagazine.com/arts/991105movieratings.html (last visited Apr. 18, 2004) ("In his address to the Aaronic priesthood, April conference, 1986, President Ezra Taft Benson, [a high-ranking member of the Church of Mormon], said: 'We counsel you, young men, not to pollute your minds with such degrading matter, for the mind through which this filth passes is never the same afterwards. Don't see R-rated movies or vulgar videos or participate in any entertainment that is immoral, suggestive, or pornographic [which would include most movies, including those rated PG-13].").
3. Identity of Advertising Media Used

When the lawsuit was first filed, Clean Flicks received broad media coverage in print, broadcast, and on the Internet. Aside from that, Clean Flicks does not appear to be doing any noticeable national advertising aside from hosting a website that can be found through a basic Google search.  

4. Defendant’s Intent

It is not necessary that the Counterclaimants prove Clean Flicks has the intent to confuse the public. Clean Flicks’ intent is clear. It wants to provide its customers with a version of a popular commercial movie that has “objectionable” content removed. According to Ray Lines, Clean Flicks’ founder and CEO, “We take [the word hell] out. We take out the damns, the f-words, the a-words and references to deity.” In fact, Clean Flicks’ actions have taken on the feel of a crusade to clean up Hollywood.  

5. Evidence of Actual Confusion.

Neither side has shown any evidence of actual confusion and the Court points out that “[e]vidence of actual confusion is not necessary to a finding of a likelihood of confusion.” Given the near identical nature of the original video and the edited version, and Clean Flicks’ practice of using a movie’s DVD cover on its website to promote the content-edited version, confusion is likely. Consider director Ridley Scott’s film GLADIATOR for example.

60. A Google search on “sanitized movies” yields a number of articles on Clean Flicks, including links to the website. The author is unaware of any local advertising efforts.


63. Crossman, supra note 56 (“[I]f moviemakers would just listen to what people want, they would clean the things up themselves.”); Vosepka, supra note 21 (“I believe that we’re corrupting society with the things that we use for entertainment,” said Cronin.”); Ball, supra note 59 (“[M]y favorite movies are the ones that are simply good, clean entertainment, which ... are becoming something of a rarity.”); L. Brent Bozell III, Utah David vs. Hollywood Goliath, MEDIA RESEARCH CENTER, Feb. 8, 2001 (“I don’t think teenagers, and adults, for that matter, need to see all that sex and hear curse words and see all that blood.”).

64. Elvis Presley Enters., 141 F.3d at 203.
Clean Flicks’ website displays the Director’s Cut version of the DVD, with Ridley Scott’s signature clearly visible. While it might be reasonable to assume that a customer in a Clean Flicks retail store or on its website knows the videos on display are edited for content, that customer may have no reason to know that the director and studio did not approve the editing. Neither can Clean Flicks control the secondary market, where consumer confusion is likely to be high.

6. Droit Moral or Moral Right.

In 1975 the British comedy troupe known as Monty Python’s Flying Circus (“Monty Python”) sought an injunction against American Broadcasting Company (ABC-TV) to keep the latter from broadcasting an unauthorized edited version of three episodes of the popular sketch comedy program. While acknowledging that American copyright law does not recognize moral rights, the Court nevertheless directed the district court to issue the sought-after injunction. The Court’s opinion in *Gilliam* acknowledged the conflict between American copyright law and artists’ rights. When courts have upheld an artist’s proprietary right in his or her creation, underlying the decision was a reliance on “theories outside the statutory law of copyright, such as contract law.” At the heart of any decision in a case such as *Gilliam* or Clean Flicks lies the


66. *Id.* at 16.

67. *Id.* at 24 (“Nevertheless, the economic incentive for artistic and intellectual creation that serves as the foundation for American copyright law [citations omitted] cannot be reconciled with the inability of artists to obtain relief for mutilation or misrepresentation of their work to the public on which the artists are financially dependent.”).

68. *Id.*
appropriate application of the Lanham Act to "properly vindicate the author's personal right to prevent the presentation of his work to the public in a distorted form." 69

The Counterclaimants in this case make a similar claim to the appellants in Gilliam, that "the editing . . . mutilated the original work and . . . violated the Lanham Act." 70 In both cases, the parts that were removed were deemed by the artists to be essential to the work. In the case of the comedy skits, important parts of the set ups were deleted. Similarly, Clean Flicks deleted content it found objectionable, but which may be essential to the "schematic development of a story line." 71 In the most extreme instances, Clean Flicks editing would be expected to have the same effect attributed by the Second Circuit to the ABC-TV broadcast at issue in Gilliam – that it "impaired the integrity of appellants' work and represented to the public as the product of appellants what was actually a mere caricature of their talents." 72 The damage to a director's reputation cannot be overstated when the editing destroys the director's vision. According to Kathryn Bigelow, director of K-19: THE WIDOWMAKER (Paramount Pictures, 2002), "[t]he distortion and manipulation of a film . . . is the distortion and manipulation of the reputation and achievement of the director whose name is attached to that film." 73

7. Conclusion.

The Directors and the DGA have a viable claim of false designations of origin against Clean Flicks. Considering the five factors in the aggregate, there is a likelihood of a consumer confusing the Clean Flicks version of a movie with the original version of that same movie. Furthermore, in light of Gilliam, the Directors and the DGA have a very strong case for distortion and false impression of origin.

C. Directors' and Directors Guild of America's Trademark Dilution Claim

The Counterclaimants further allege that Clean Flicks "diluted the distinctive quality of the Counterclaimants' trademarks in

69. Id.
70. Id.
72. Id.
violation of 15 U.S.C. § 1125(c)." The Lanham Act provides for only injunctive relief against someone who dilutes the famous trademark of another, "unless the person against whom the injunction is sought willfully intended to trade on the owner's reputation or to cause dilution of the famous mark." The Counterclaimants have identified "the name of each of the Director Counterclaimants and other DGA members" as the famous trademark within the meaning of 15 U.S.C. § 1125(c).

Throughout the counterclaim the Counterclaimants characterize Clean Flicks' conduct as "willful," but the burden of proof is on the Counterclaimants to show willful behavior by Clean Flicks. However, before offering evidence of proof of willfulness or trademark dilution, the Counterclaimants must show that the mark they are defending is famous and distinctive. The Lanham Act provides a non-exhaustive list of factors the court may consider in making this determination, only some of which are directly relevant to this case. They are:

1. the degree of inherent or acquired distinctiveness of the mark;
2. the geographical extent of the trading area in which the mark is used;
3. the channels of trade for the goods or services with which the mark is used;
4. the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom injunction is sought; and
5. the nature and extent of use of the same or similar marks by third parties.

Factors 2 through 4 are not likely to be disputed. The original movies are marketed all over the United States and throughout the world. Both versions are sold or rented online to anyone with Internet access, and the edited versions currently are rented in physical retail

74. Proposed Amended Counterclaim, supra note 3, ¶ 72.
76. Proposed Amended Counterclaim, supra note 3, ¶ 71.
77. Ringling Bros. – Barnum & Bailey Combined Shows, Inc. v. B.E. Windows Corp., 937 F. Supp. 204, 213 (S.D.N.Y. 1996) ("Predatory intent 'requires a showing that the junior user adopted its mark hoping to benefit commercially from association with the senior mark.' [citation omitted] Moreover, 'the absence of predatory intent by the junior user is a relevant factor in assessing a claim under the anti-dilution statute,... since relief under the statute is of equitable origin.' [citation omitted]).
establishments in only ten states.\textsuperscript{79} The fourth factor, the degree of recognition of the mark in the trading areas and channels of trade, is directly related to the distinctiveness of the mark.

1. Distinctiveness of Mark.

Asking the court to pass judgment on the distinctiveness of the names of various movie directors is asking for an ego-crush for most of the DGA members. In \textit{Christopher D. Smithers Foundation, Inc. v. St. Luke's-Roosevelt Hospital Center}, the court held that "personal names used as trademarks are generally regarded as descriptive terms, not arbitrary or fanciful terms; they are thus protected only if, through usage, they have acquired \textit{distinctiveness} and secondary meaning."\textsuperscript{80} Certainly there is a great degree of distinctiveness associated with names like Ridley Scott, Steven Spielberg, Robert Redford, and Martin Scorsese. But there is less likely to be the same degree of distinctiveness associated with names like Taylor Hackford, Curtis Hanson, Betty Thomas, and Irwin Winkler. There would be still less distinctiveness associated with names like Bille August, Alfonso Arau, Roger Michell, or Sharon Maguire.\textsuperscript{81} Lesser known directors would not fare well in this analysis as the "the degree of fame required for protection . . . must exist in the general marketplace, not in a niche market. . . . [F]ame limited to a particular . . . segment of industry or service . . . is not sufficient to meet that standard."\textsuperscript{82} So, even if a relatively unknown director has a particularly avid fan following, the fame she or he would enjoy among that small but loyal base would not rise to the level of fame required to meet the distinctiveness standard.\textsuperscript{83}

\textsuperscript{79} Crossman, \textit{supra} note 56. ("Taylor's is one of 78 franchises in 18 states managed by . . . CleanFlicks."). Since the publication of the Crossman's article, the number of retail locations for Clean Flicks has changed.


\textsuperscript{81} Bille August directed \textit{SMILLA'S SENSE OF SNOW} (Twentieth Century Fox, 1997). Alfonso Arau directed \textit{A WALK IN THE CLOUDS} (Twentieth Century Fox, 1996). Roger Michell directed \textit{NOTTING HILL} (Polygram Films, 1999). Sharon Maguire directed \textit{BRIDGET JONES' DIARY} (Miramax Films, 2001).

\textsuperscript{82} \textit{Christopher D. Smithers Found.}, 2003 U.S. Dist. LEXIS 373 at 15.

\textsuperscript{83} In some very limited situations, courts will grant dilution protection for marks that are famous in niche markets. Thane Int'l, Inc. v. Trek Bicycle Corp., 305 F.3d 894, 908 (9th Cir. 2002) ("Niche fame protection is, however, limited. The statute protects a mark only when a mark is famous within a niche market and the alleged diluter uses the mark within that niche.").
2. Nature or Extent of Use of Mark by Third Parties.

When a director's name is used in relation to a movie, it is standard practice to attribute the work to the director, despite the fact that hundreds of artists and technicians are involved in making a movie. So, when Clean Flicks' synopsis of GLADIATOR includes the words "masterfully directed by Ridley Scott," Clean Flicks is using Mr. Scott's mark in exactly the same way any other movie distributor would use it. The mark also is used to the extent that Clean Flicks displays the DVD cover on its website and in its stores, since most covers include the director's name, as well as the names of the actors and the title of the movie. Actors could make a similar argument, particularly well-known actors like Russell Crowe (GLADIATOR). 84

This suggests that whether a director's name is sufficiently well known to be considered famous would be addressed on a case-by-case basis. If true, this does not lend itself to an aggregation of all such cases, which is what the current joining of all directors would seem to be seeking. Nevertheless, assuming the requirement of showing fame and distinctiveness has been met, dilution of the famous mark still must be proven.

Dilution is defined as "blurring the distinctiveness of a famous mark" or "tarnishing or disparaging a distinctive mark." 85 Where trademark infringement requires a showing of consumer confusion, trademark dilution does not. 86 In fact, the Ninth Circuit points out "[i]n contrast to trademark infringement, the injury from dilution usually occurs when consumers aren't confused about the source of a product." 87 The court describes the two laws, trademark infringement and dilution, as being antithetical to one another. Trademark infringement law requires consumer confusion in order for relief to be granted. Trademark dilution law, on the other hand, "seeks to protect the mark from association in the public's mind with wholly unrelated goods and services. The more remote the good or service associated

85. Ringling Bros. - Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev., 170 F.3d 449, 452 (4th Cir. 1999) ("[The] legislative history further indicates that 'dilution' might result either from 'uses that blur the distinctiveness of [a famous] mark or [that] tarnish or disparage it.'" (citing H.R. REP. NO. 104-374, at 2 (1995)).
86. 15 U.S.C. § 1127 (2002) ("The term 'dilution' means the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of . . . likelihood of confusion, mistake, or deception.").
87. Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894, 903 (9th Cir. 2002).
with the junior use, the more likely it is to cause dilution rather than trademark infringement."\textsuperscript{88} The court explains further "[w]hereas trademark law targets ‘interference with the source signaling function’ of trademarks, dilution protects owners ‘from appropriation of or free riding on’ the substantial investment that they have made in their marks."\textsuperscript{89}

In a recent decision, the United States Supreme Court further clarified what constitutes a showing of dilution. In \textit{Moseley v. Victoria's Secret Catalogue}, the Court held that to prove trademark dilution a plaintiff must show actual dilution and not merely a likelihood of dilution.\textsuperscript{90} In \textit{Moseley}, a Kentucky couple owned a small retail store called “Victor’s Little Secret,” where they sold lingerie and various novelty items of a sexual nature.\textsuperscript{91} Upon learning of the existence of the store, the owners of the VICTORIA'S SECRET trademark sought to prevent the couple from using the name.\textsuperscript{92} Using the facts of \textit{Ringling Bros.}, the Court explained that even though people driving in Utah might be reminded of the circus when they see license plates with the slogan the “greatest snow on earth,” “it by no means follows that they will associate ‘the greatest show on earth’ with skiing or snow sports, or associate it less strongly or exclusively with the circus.”\textsuperscript{93} Applying this analogy to the Directors’ allegation of trademark dilution against Clean Flicks, Ridley Scott, for example, will have to show that the Clean Flicks version of \textit{GLADIATOR} actually causes moviegoers to associate the director Ridley Scott with the sanitized version of his film. In \textit{Moseley}, the Court goes further to state that neither blurring nor tarnishing is a “necessary consequence of mental association.”\textsuperscript{94} While this decision may be somewhat of a blow to the Directors, the Court does acknowledge that circumstantial evidence, such as identical junior and senior marks, may be sufficient to prove actual dilution.\textsuperscript{95} Since both films, the Clean Flicks version and the original version, identify Ridley Scott as the director, there may be sufficient

\textsuperscript{88} \textit{Id.} at 904.
\textsuperscript{89} \textit{Id.} at 903 (citing P.P. Lund Trading ApS v. Kohler Co., 163 F.3d 27, 50 (1st Cir. 1998)).
\textsuperscript{91} \textit{Id.} at 423.
\textsuperscript{92} \textit{Id.}
\textsuperscript{93} \textit{Id.} at 433–34.
\textsuperscript{94} \textit{Id.}
\textsuperscript{95} \textit{Id.} at 434.
circumstantial evidence to show actual dilution of Ridley Scott the trademark, for the purposes of proving trademark dilution.

3. Willful Intent

The Countercomplainants will have a difficult time showing that Clean Flicks had the willful intent to trade on the directors' reputations or cause trademark dilution. There is ample evidence of Clean Flicks wanting to spur the studios to provide "cleaner" versions of popular commercial movies. John Dixon chastises directors, as a proxy for the entertainment industry, for not providing these movies already. According to Dixon, studios have been promising to deliver "cleaner" versions of its movies and that Clean Flicks is merely delivering on the promise the studios failed to keep. Ray Lines goes a little further. "We are sending a message...[w]e can either allow [more wickedness, pornography, and junk] to continue or we can do something about it. And that is what we are attempting to do." Although these comments show that the Clean Flicks management team knows what it's doing, and that it was purposeful in its quest to "clean up movies," the comments do not show the willful intent that is required for damages in addition to injunctive relief.

In Ringling Bros., the Fourth Circuit upheld the district court's grant of defendant's motion for summary judgment on the issue of willful intent to dilute plaintiff's trademark. In 1966, defendant, Utah Division of Travel Development ("Utah"), began using the mark, THE GREATEST SNOW ON EARTH, to attract tourists to its winter resorts. When Utah applied to register its mark, Ringling Bros. filed an opposition. The United States Patent and Trademark Office granted Utah's mark and Ringling Bros. filed a cause of action in trademark dilution against Utah, claiming that Utah's mark diluted Ringling Bros.' mark, THE GREATEST SHOW ON EARTH. In reaching its decision, the court noted that the willful intent requirement that the offender seeks to "trade on an owner's reputation" is similar to "predatory intent" that "requires a showing that the junior mark adopted its mark hoping to benefit commercially

96. Crossman, supra note 56.
97. Eddington, supra note 21.
from association with the senior mark.\textsuperscript{100} Ringling Bros. argued that because Utah was aware of the Ringling Bros. mark and continued to promote its own mark in spite of this knowledge, Utah willfully infringed Ringling Bros.' mark. The court rejected this argument as being insufficient to show willfulness. The court stated that "while knowledge of a famous mark is necessary to demonstrate that a subsequent mark was adopted deliberately to dilute or trade upon the owner's reputation, that knowledge, by itself, is not sufficient to demonstrate that a defendant 'willfully intended' to violate the protection granted by the [Lanham] Act."\textsuperscript{101}

Similarly, Clean Flicks' knowledge of a famous director's association with a particular film does not translate into a willful intent to trade on that director's reputation. The Directors may argue that editing a movie is completely different from creating a new mark as in Ringling Bros., and that such editing is in itself an attempt to trade on the director's reputation through association of the edited version of the movie with its original. It is tempting to accept this argument. To do so, however, requires a belief that Clean Flicks is trading on reputation of a director and not on the film. In other words, one must believe that by editing GLADIATOR, Clean Flicks sought to trade on the reputation of its director, Ridley Scott, and not on the reputation of the film itself. The court is unlikely to make such a leap.

4. Conclusion

The court is likely to be facing a dilemma when considering the Directors' trademark dilution complaint against Clean Flicks. On the one hand, the similarity between the two movies (the original version and the content-edited version) is certain to create consumer confusion, which would argue against trademark dilution. The Directors must be clear that they are themselves the trademarks that are being diluted and, using the Moseley analysis, that by putting their names on the content-edited films without their permission, Clean Flicks is diluting their marks. On the other hand, the Directors are surely in need of protection from Clean Flicks' appropriation of and free riding on the substantial investment the Directors and others have invested in creating these movies. The problem may be exacerbated if the court tries to consider the distinctiveness of all of the Directors

\textsuperscript{100} Id. at 603 n.15 (citing Judge Sweet's concurring opinion in Mead Data Cent., Inc. v. Toyota Motor Sales, 875 F.2d 1026, 1037 (2d Cir. 1989)).

\textsuperscript{101} Ringling Bros II, 955 F. Supp. at 604.
collectively. Furthermore, unless the Directors can point to evidence of willful intent, the most they will be able to do is stop Clean Flicks from renting or selling any edited movies and from future movie editing without authorization. Between false designations of origin and trademark dilution, the latter is the weaker of the two claims, however, the Directors may have a viable case for trademark dilution.

D. Clean Flicks’ Underlying Motive

Clean Flicks’ ultimate objective is probably not to prevail in a declaratory ruling, which is fortunate since the company is unlikely to win. Total victory for Clean Flicks would be a decision by the Studios to grant the company a license to edit objectionable content from movies and recommence the selling of edited movies. But Clean Flicks does not need total victory. It only needs for the Studios to release to the general public the versions of movies they already create for television and the airlines.

Clean Flicks has reason to hope for a favorable resolution with the studios. First, the studios have known for a long time that Clean Flicks and others were editing content out of movies. According to Ray Lines, there was some initial grumbling from Hollywood when he first edited TITANIC, but since then “the film industry has been silent.”

Second, even in light of the complaint filed against the Directors, the studios were relatively silent on the matter until they were joined as co-defendants. Professor Doris Long “suspects the studios may remain silent rather than sue and risk reams of bad publicity and more congressional scrutiny over movie content.”

When asked about the legality of Clean Flicks’ video lending co-op argument, Cheryl Glenn, a spokeswoman for movie studio Dream Works (which produced GLADIATOR) replied, “We’re going to have no comment on that.”

Although Dream Works is one of the studios arguing direct infringement in opposition to Clean Flicks’ co-counterdefendants’ motion for summary judgment, the studios failed to file a counterclaim alleging copyright infringement against Clean

102. Vosepka, supra note 21.

103. Kieth Merrill, Cleaning Up the Movies, Part I, MERIDIAN MAGAZINE, at http://www.meridianmagazine.com/arts/020604clean.html (last visited Apr. 25, 2004) (“Valenti [Jack Valenti, MPAA President] was silent for 3-months. Finally an attorney called from Washington ‘on behalf of Jack Valenti’s attorney’ to offer a formal response. ‘We don’t like what you are doing. We feel it is a violation of copy right, but to be honest with you this is not a priority with the studios right now.’”).

104. Eddington, supra note 21.

105. Vosepka, supra note 21.
Clean Flicks, a non-moving party with respect to the motion for summary judgment.\textsuperscript{106} The Motion Picture Association of America (MPAA), best known for its ratings board, has yet to weigh in on the issue. Individual directors and the DGA, however, have gone on the record condemning the practice of third-party editing.\textsuperscript{107} DGA President Martha Coolidge puts it simply:

"What these companies are doing is wrong, plain and simple. It is wrong to cut scenes from a film — just as it is to rip pages from a book — simply because we don't like the way something was portrayed or said, then resell it with the original title and creator's name still on it.

"It is wrong to circumvent the studios, who are the copyright holders, and the director, who is the film's creator — all in the name of turning a profit. It is unethical, it is shameful, and the DGA will aggressively pursue these claims."\textsuperscript{108}

But the most promising development for Clean Flicks' crusade is the appearance of some allies within the entertainment industry. The hypocrisy of the Directors' position is not lost on some people in Hollywood. Joel Schumacher, a well-known director of commercially successful movies acknowledges that the filmmakers' ultimate point may be moot, "because almost all our films are purchased by television, they're all cut up anyway."\textsuperscript{109} Clean Flicks is only asking for the studios to make these "cut up" versions available to sell or rent to Clean Flicks members.

Some may argue that the studios won't follow Clean Flicks' lead and edit movies to remove sex, violence, and profanity because the market and the profit margins are too small.\textsuperscript{110} Others may argue that the studios will greedily grab for every dime they can to offset the escalating production cost of films. The truth, not surprisingly, is likely to lie somewhere in the middle. In his article for the Los

\textsuperscript{106} Proposed Amended Counterclaim, supra at note 13 at p. 4.

\textsuperscript{107} Ray Richmond, Clean Flicks Update: The Battle Continues, DGA MAGAZINE, Mar. 2003 (condemning the edits made to Shindler's List, Proof of Life, The Horse Whisperer, Dr. Doolittle, and Traffic, and quoting City of Angels director, Brad Silberling); Richmond, supra note 14 (According to DGA National Executive Director Jay Roth, "[t]he function these companies perform without the permission of the copyright holder is illegal.").

\textsuperscript{108} Richmond, supra note 14.

\textsuperscript{109} Wilson, supra note 37.

\textsuperscript{110} See, e.g., Gwendolyn Mariano, Trilogy Studios to Offer Home Censor Kit, CNET NEWS.COM, Nov. 15, 2001, at http://news.com.com/2100-1023-275873.html ("I doubt that the actual market for a service like this is...as large as the perceived market,' Sinnreich [Jupiter Media Metrix research analyst] said.").
Angeles Times, staff writer Dave Wilson noted that not one of the major studio representatives he contacted for an article on Movie Mask would comment.111

IV. CONCLUSION

Undoubtedly the studios feel like they are living the lyrics of the 1980s hit by the rock group The Police – trapped "between the Scylla and Charybdis."112 On one side are all the groups who want them to tone down the sex and violence in entertainment, or to at least provide G- and PG-rated alternatives to commercial hits. On the other side are the directors, artists and technicians on which the studios rely to make the movies that make their profits. It is anybody’s guess which side is the Scylla and which Charybdis! But that is not what is important. What is important is whether the studios will successfully navigate the waters between the monstrous Scylla and the deadly whirlpool home of Charybdis.

At the heart of the problem is the perennial Hollywood conflict—creative control v. profit motive. Are movies works of art or are they commercial products? If movies are works of art, not to be tampered with, why do directors approve versions for television and airlines that remove certain content to meet those industries broadcast standards? Movie studios are businesses and most have shareholders, meaning they have an underlying profit motive. Dick Rolfe of the Dove Foundation urges people interested in making “family friendly” movies more available to buy, use, and give videos that were originally edited for television broadcasts. Mr. Rolfe believes other studios, in addition to the advocacy group’s partner New Line

111. Wilson, supra note 37. Movie Mask is a software application that allows a viewer to skip objectionable scenes in a movie without changing the content on the DVD because “...[its] censorship instructions reside in the video playback device.” The software application, which runs on Windows PCs and on Microsoft’s Xbox, also allows viewers to add content such as digital clothing to nude actors or educational content such as links to websites with more information. Mariano, supra note 110.

112. STING, Wrapped Around Your Finger, on SYNCHRONICITY (Magnetic Publishing Ltd. 1983) (referring to the mythological creatures Scylla and Charybdis and synonymous with "trapped between a rock and a hard place." The Scylla and Charybdis were immortalized in Virgil’s Aeneid: Book III – “Far on the right, her dogs foul Scylla hides: / Charybdis roaring on the left presides, / And in her greedy whirlpool sucks the tides; / Then spouts them from below: with fury driv’n, / The waves mount up and wash the face of heav’n. / But Scylla from her den, with open jaws, / The sinking vessel in her eddy draws, / Then dashes on the rocks. A human face, / And virgin bosom, hides her tail’s disgrace: / Her parts obscene below the waves descend, / With dogs inclos’d, and in a dolphin end.”).
Cinema, will start releasing the television versions of their movies if there's a proven market for them.\(^{113}\)

If the case actually comes to trial, Clean Flicks probably will lose (its demand for a jury trial notwithstanding). As Professor Long states, "if it ever came to a court decision, I suspect copyright owners would win . . . But it probably would be a pyrrhic victory."\(^{114}\) The optimal solution, the win-win, for everyone would be for the studios to agree to release the movie versions edited for television and airlines into the home video distribution market. Mick LaSalle, movie critic for the San Francisco Chronicle, thinks this is a good idea—"This sounds like a way to give the people what they want without infringing on the freedom of the studios [and filmmakers] to make art in their own way."\(^{115}\) The library of sanitized movies would increase dramatically and the chance that the directors might have authorized the versions offered would increase, and those versions would be consistent (as opposed to the varying unauthorized versions edited by others).

A compromise settlement will not alleviate the problem of third party editing, however. In order to do that, the case must come to trial and the studios and Counterclaimants must be granted an injunction against all the Clean Flicks of the world. By releasing the television versions for home video distribution, the studios will go a long way to making the inevitable injunction palatable to the thousands (and even tens of thousands) of consumers who are buying content-edited videos and content-editing technology today. New Line Cinema, through its partnership with Dove Foundation, could be the true pioneer, pointing the way through these dangerous waters to an equitable solution to this problem.

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\(^{113}\) See St. Louis Metro Voice, Dove Foundation Partners with New Line Cinema to Produce "Family-Friendly" Versions of Videos, at www.metrovoice.net/0501stlweb/0501features/dovefoun.html (last visited Apr. 18, 2004).

\(^{114}\) Eddington, supra note 21.
