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Derivative Works and Making Sense of the Maxim that 'Others are Free to Copy the Original. They are Not Free to Copy the Copy.'

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University of Georgia School of Law
Research Paper Series
Paper No. 2018-41



Repository Citation

David E. Shipley, *Derivative Works and Making Sense of the Maxim that 'Others are Free to Copy the Original. They are Not Free to Copy the Copy.'*, 44 U. Dayton L. Rev. 271 (2019),
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**DERIVATIVE WORKS AND MAKING SENSE OF
THE MAXIM THAT “OTHERS ARE FREE TO COPY
THE ORIGINAL. THEY ARE NOT FREE
TO COPY THE COPY.”¹**

*David E. Shipley**

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¹ *Bleistein v. Donaldson Lithographic Co.*, 188 U.S. 239, 249 (1903). This opinion is authored by Justice Oliver Wendell Holmes. Thus, he is accredited with the creation of this maxim.

Some of the most entertaining as well as challenging cases in America's copyright law jurisprudence concern derivative works as copyrightable subject matter,² and the closely related right to prepare derivative works.³ The cases are entertaining because they involve works of authorship like a high-end, reduced-scale reproduction of a famous sculptural work,⁴ mass produced plastic versions of a cast iron Uncle Sam bank,⁵ Teddy Ruxpin dolls,⁶ photographs of Thomas & Friends toy train characters,⁷ novels based upon fictionalized versions of historical subjects,⁸ notecards mounted on ceramic tiles,⁹ photographs of bottles of Skyy Vodka,¹⁰ iconic songs,¹¹ and digital models of Toyotas.¹² The cases are challenging because the rulings are often difficult to reconcile¹³ due to the fact that the courts are grappling with copyright's elusive originality standard¹⁴ as applied to derivative works,¹⁵ as well as a copyright owner's right to prepare derivative works.¹⁶

One frequently litigated issue concerns the extent to which the creator of a derivative work has to recast, transform, or adapt a preexisting work in

² 17 U.S.C. §§ 103, 101 (2012) (definition of "derivative work").

³ *Id.* § 106(2). See generally CRAIG JOYCE ET AL., COPYRIGHT LAW 229 n.3 (Carolina Acad. Press ed., 10th ed. 2016) (discussing the two functions served by the term derivative work). The author has been teaching copyright law since the Fall of 1977, either as part of an intellectual property survey class or as a stand-alone course. The 1977 starting date is important because the current copyright statute, often referred to as the Copyright Act of 1976, became effective on January 1, 1978.

⁴ See, e.g., *Alva Studios, Inc. v. Winninger*, 177 F. Supp. 265 (S.D.N.Y. 1959) (holding small scale reproduction of Rodin's public domain sculpture, *Hand of God*, was protected by copyright).

⁵ See, e.g., *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486 (2d Cir. 1976) (holding no copyright protection for a plastic reproduction of a cast iron, public domain Uncle Sam bank).

⁶ See, e.g., *Worlds of Wonder, Inc. v. Vector Intercontinental, Inc.*, 653 F. Supp. 135 (N.D. Ohio 1986); *Worlds of Wonder, Inc. v. Veritel Learning Sys., Inc.* 658 F. Supp. 351 (N.D. Tex. 1986). In both of these cases, it was held that the defendants' cassette tapes – which were compatible with the tapes inside the plaintiff's teddy bear that moved and spoke – were infringing derivative works.

⁷ See, e.g., *Schrock v. Learning Curve Int'l, Inc.*, 586 F.3d 513 (7th Cir. 2009) (photographs of the train characters held to be copyrightable).

⁸ See, e.g., *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972 (2d Cir. 1980); *Sheldon v. Metro-Goldwyn Pictures, Corp.*, 81 F.2d 49 (2d Cir. 1936).

⁹ Compare *Lee v. A.R.T. Co.*, 125 F.3d 580 (7th Cir. 1997) (establishing permissible use of plaintiff's note cards) with *Mirage Editions, Inc. v. Albuquerque A.R.T. Co.*, 856 F.2d 1341 (9th Cir. 1988) (finding an infringing use of plaintiff's note cards).

¹⁰ See, e.g., *Ets-Hokin v. Skyy Spirits, Inc.*, 323 F.3d 763 (9th Cir. 2003) (holding photographs of vodka bottle held to be copyrightable).

¹¹ See, e.g., *We Shall Overcome Found. v. Richmond Org.*, No. 16cv2725(DLC), 2017 U.S. Dist. LEXIS 146228, at *1–2 (S.D.N.Y. 2017) (determining "We Shall Overcome" was not a copyrightable derivative work based upon public domain song).

¹² See, e.g., *Meshwerks, Inc. v. Toyota Motor Sales U.S.A. Inc.*, 528 F.3d 1258, 1260 (10th Cir. 2008) (finding digital model of Toyota not copyrightable).

¹³ See, e.g., JOYCE ET AL., *supra* note 3, at 87–88 n.11–12, 230–35 n.3–12; MARSHALL A. LEAFFER, UNDERSTANDING COPYRIGHT LAW 59–72 (Carolina Acad. Press ed., 6th ed. 2014).

¹⁴ Diane Zimmerman, *The Story of Bleistein v. Donaldson Lithographing Company: Originality as a Vehicle for Copyright Inclusivity*, in INTELLECTUAL PROPERTY STORIES 106 (Jane C. Ginsburg & Rochelle Cooper Dreyfuss eds., 2006).

¹⁵ A derivative work is one "based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgement, condensation, or any other form in which a work may be recast, transformed, or adapted." 17 U.S.C. § 101 (2018). Another way to look at derivative works is to say that they are second-generation works adapted from preexisting materials such as turning a first-generation work like a novella into a play. JOYCE ET AL., *supra* note 3, at 220–21.

¹⁶ 17 U.S.C. § 106(2) (2018).

order for the new version to be entitled to copyright protection. What is the “minimal degree of creativity” that a derivative work author has to show in order for his or her creation to be protected by copyright as required by the United States Supreme Court’s 1991 landmark decision in *Feist Publications, Inc. v. Rural Telephone Service*?¹⁷ Another often litigated issue is whether a defendant’s unauthorized use of the plaintiff’s copyrighted work infringes the plaintiff’s exclusive right to prepare derivative works; was there an actionable recasting or transformation of the underlying work?¹⁸

The Supreme Court acknowledged over a quarter century ago in *Feist* that the originality threshold is very low, and that most works cross the hurdle with room to spare because they will possess some creative spark.¹⁹ This has been substantiated by the hundreds of decisions that have applied the *Feist* standard.²⁰ Still, the problem for courts deciding these cases, lawyers advising their clients, and copyright scholars is that the scope of the originality requirement remains obscure generally,²¹ and is particularly problematic in regard to derivative works.²² Moreover, scholars have argued that the originality threshold is too low,²³ that the law needs to be changed so that the scope of protection enjoyed by a work of authorship would depend on the extent of the work’s originality,²⁴ that courts are not able to explain how a work is original,²⁵ and that our understanding of originality needs to be changed in response to evolving and new digital technologies like 3D printing.²⁶

These criticisms of the originality standard and the arguments for change are well founded, but in my opinion it is unlikely that the Supreme Court will revise what it said about originality in *Feist* or even tweak the standard.²⁷ Also, notwithstanding calls for a comprehensive revision of the Copyright Act, it is unlikely that Congress will amend the originality standard through legislation. After all, the Court grounded the *Feist* opinion in the Constitution’s Copyright Clause, explaining that “[a]s a constitutional matter, copyright protects only those constituent elements of a work that possess

¹⁷ 499 U.S. 340, 345 (1991).

¹⁸ See *infra* Section II.B.

¹⁹ *Feist*, 499 U.S. at 345.

²⁰ Edward Lee, *Digital Originality*, 14 VAND. J. ENT. & TECH. L. 919, 923 (2012). See generally David Shipley, *Thin But Not Anorexic: Copyright Protection for Compilations and Other Fact Works*, 15 J. INTELL. PROP. L. 91, 98–130 (2007).

²¹ Lee, *supra* note 20, at 920; Zimmerman, *supra* note 14, at 106.

²² See JOYCE ET AL., *supra* note 3, at 229–35.

²³ Joseph S. Miller, *Hoisting Originality*, 31 CARDOZO L. REV. 451, 456, 458 (2009).

²⁴ Gideon Parchomovsky & Alex Stein, *Originality*, 95 VA. L. REV. 1505, 1523 (2009).

²⁵ Eva Subotnik, *Originality Proxies: Toward a Theory of Copyright and Creativity*, 76 BROOK. L. REV. 1487, 1494 (2011).

²⁶ Lee, *supra* note 20, at 921–22.

²⁷ Cf. Craig Joyce & Tyler Ochoa, *Reach Out and Touch Someone: Reflections on the 25th Anniversary of Feist Publications, Inc. v. Rural Telephone Service Co.*, 54 HOUS. L. REV. 257, 260 (2016) (noting that “the Court firmly reinvigorated a standard for originality that has proven durable, flexible, and occasionally controversial in meeting the challenges of copyright law in the 21st century.”).

more than a *de minimis* quantum of creativity.”²⁸ Accordingly, this Article is premised on the belief that we need to live with the originality standard as it has evolved from the *Sarony* and *Bleistein* decisions in 1884 and 1903 respectively,²⁹ the *Feist* ruling in 1991,³⁰ and the many trial and appellate cases interpreting and applying these landmarks to derivative works. The courts, counsel, and copyright commentators fully understand that the standard is not a high threshold.

Instead of attempting to say something “original” about originality, the *sine qua non* of copyright, the goal for this Article is to make sense out of these entertaining but sometimes contradictory decisions concerning derivative works. It does this by discussing seven recurring problems and common scenarios and relates these situations to how courts have handled these problems and scenarios in the context of the familiar maxim announced by Justice Holmes in 1903 that it is permissible to copy the original but not the copy.³¹ Although Justice Holmes made this statement in connection with his discussion of copyright’s originality standard, it relates to this Article’s goals because a derivative work is a copy of the copy in that it adapts or modifies a preexisting work of authorship. This copy of the copy ordinarily will infringe if it is done without permission of the copyright owner, but this copy of the copy might be copyrightable as a derivative work when it is done with permission.³²

It is not arbitrary to categorize copyright law decisions dealing with derivative works and the right to prepare derivative works by discussing recurring problems and common scenarios. For example, taxonomies have been recognized, discussed, and analyzed in connection with copyright’s fair use doctrine generally and the transformative use doctrine in particular.³³ Providing structure like this is more than an exercise of selecting and sorting. Rather, the problems and scenarios in this article illustrate the basic challenge of balancing the intellectual property rights of authors which provides an incentive to create, against the need for subsequent authors to build upon and adapt the works of other authors.³⁴ After all, derivative works by definition

²⁸ *Feist Publ’ns, Inc. v. Rural Tel. Servs.*, 499 U.S. 340, 363 (1991). See also *Joyce & Ochoa*, *supra* note 27, at 288. The Court constrained the power of Congress to legislate under the Copyright Clause in affording protection to works that do not meet the constitutional requirement of originality. *LEAFFER*, *supra* note 13, at 60–61. Congress could, however, heighten the standard, perhaps requiring more than a modicum of creativity. See *id.*

²⁹ See generally *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903); *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884).

³⁰ See generally *Feist*, 499 U.S. 340.

³¹ *Bleistein*, 188 U.S. at 249.

³² See *infra* notes 56–74 and accompanying text.

³³ See, e.g., David Shipley, *A Transformative Use Taxonomy: Making Sense of the Transformative Use Standard*, 63 WAYNE L. REV. 267, 267–68 (2018); Neil Netanel, *Making Sense of Fair Use*, 15 LEWIS & CLARK L. REV. 715 (2011); Michael Madison, *A Pattern-Oriented Approach to Fair Use*, 45 WM. & MARY L. REV. 1525 (2004).

³⁴ Shipley, *supra* note 33, at 269.

build upon preexisting works,³⁵ and it was said long ago in an important copyright law decision that few things are “strictly new and original throughout” and every work “in literature, science and art, borrows, and must necessarily borrow, and use much which was well known and used before.”³⁶ Also, it is hoped that this Article’s discussion of these problems and scenarios might, as a practical matter, help lawyers when they advise a client about the pros and cons of going forward with a particular creative project, the pluses and minuses of asserting an infringement claim, or the odds which might be faced in fighting allegations of infringement. But first, it is necessary to state some fundamental principles about the originality standard and derivative works.

I. BLACK LETTER LAW – ORIGINALITY AND DERIVATIVE WORKS

In 1884, the United States Supreme Court broadly defined the terms “author” and “writing” in the Copyright Clause³⁷ in *Burrow-Giles Lithographic Co. v. Sarony*.³⁸ It stated:

An author . . . is “he to whom anything owes its origin; originator; maker; one who completes a work of science or literature.” . . . By writings in that clause is meant the literary productions of those authors, and Congress very properly has declared these to include all forms of writing, printing, engraving, etching, [et]c., by which the ideas in the mind of the author are given visible expression. . . .

We entertain no doubt that the Constitution is broad enough to cover an act authorizing copyright [protection] of photographs, so far as they are representatives of original intellectual conceptions of the author.³⁹

The Court made clear that to qualify for copyright protection a work had to be an original intellectual conception: the product of a person’s intellectual invention.⁴⁰ Moreover, there was little doubt that plaintiff Napoleon Sarony had satisfied the originality standard in how he posed the subject of the

³⁵ “[A] work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization . . .” 17 U.S.C. § 101 (2018) (defining “derivative works”).

³⁶ *Emerson v. Davies*, 8 F. Cas. 615, 619 (C.C.D. Mass. 1845) (No. 4,436).

³⁷ Congress shall have the power “[t]o promote the [p]rogress of science and useful [a]rts, by securing for limited [t]imes to [a]uthors and [i]nventors the exclusive [r]ight to the their respective [w]ritings and [d]iscoveries. . . .” U.S. CONST. art. I, § 8, cl. 8 (emphasis added).

³⁸ 111 U.S. 53 (1884).

³⁹ *Id.* at 57–58. See also *Trade-Mark Cases*, 100 U.S. 82, 94 (1875) (stating “while the word *writings* may be liberally construed, . . . it is only such as are *original*, and are founded in the creative powers of the mind. The writings which are to be protected are *the fruits of intellectual labor*, embodied in the form of books, prints, engravings and the like.”) (emphasis added).

⁴⁰ *Joyce & Ochoa*, *supra* note 27, at 267.

photograph, set up the lights, arranged the setting and the accessories to the photograph, and evoked the desired expression.⁴¹

Less than two decades later, in a dispute over whether posters advertising a circus could be protected by copyright, the Court had this to say about originality:

It is obvious also that the plaintiffs' case is not affected by the fact, if it be one, that the pictures represent actual groups - visible things. They seem from the testimony to have been composed from hints or description, not from sight of a performance. But even if they had been drawn from the life, that fact would not deprive them of protection. The opposite proposition would mean that a portrait by Velasquez or Whistler was common property because others might try their hand on the same face. Others are free to copy the original. They are not free to copy the copy. The copy is the personal reaction of an individual upon nature. Personality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible, which is one man's alone. That something he may copyright unless there is a restriction in the words of the act.⁴²

Justice Holmes made this statement in his very influential *Bleistein v. Donaldson Lithographing* opinion. This landmark decision clarified copyright law's originality standard while upholding protection for the plaintiff's circus posters.⁴³ The decision's impact on copyright was dramatic because it set a very low threshold for originality,⁴⁴ and *Bleistein* remained the Supreme Court's last word on originality until the *Feist* decision in 1991.⁴⁵

Feist is another copyright landmark decision.⁴⁶ The facts were simple. Rural Telephone published a standard white pages directory with names and phone numbers listed in alphabetical order, and Feist, a competing publisher of phone books, copied about 1300 of Rural's names and numbers.⁴⁷ The trial court found infringement, and the Tenth Circuit Court

⁴¹ *Burrow-Giles*, 111 U.S. at 60.

⁴² *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 249-50 (1903).

⁴³ Zimmerman, *supra* note 14, at 77-78. The lower courts had denied protection for the posters, saying that they were mere advertisements unconnected with the fine arts. The Supreme Court rejected this argument. Joyce & Ochoa, *supra* note 27, at 268-69.

⁴⁴ Joyce & Ochoa, *supra* note 27, at 269 (commenting that the case "set forth an extremely modest standard of originality").

⁴⁵ See generally *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991). See also Zimmerman, *supra* note 14, at 100.

⁴⁶ See generally *Feist*, 499 U.S. 340.

⁴⁷ *Id.* at 344.

of Appeals affirmed, but the Supreme Court reversed.⁴⁸ It held that Rural's copyright did not protect the names and numbers copied by Feist, and it declared that originality – independent creation and a modest degree of creativity – is a constitutional requirement for copyright.⁴⁹ This decision arguably raised the originality hurdle ever so slightly from *Bleistein*, but the requirement remains far from stringent.⁵⁰

Because this Article discusses the challenge of applying the originality standard to close questions about protection for derivative works and questions about the scope of that protection, it is important to set forth some of the originality principles that emerged from the Court's 1991 *Feist* ruling denying copyright protection for Rural's compilation. The Court stated that the concept of originality – the *sine qua non* of copyright – explains the tension between two fundamental principles: that facts are not copyrightable, but compilations of facts are copyrightable.⁵¹ An original work is one that is independently created by its author and that possesses at least a minimal degree of creativity. The requisite level of creativity is low,⁵² and most works will satisfy this standard since they will possess some creative spark.⁵³ The Court emphasized that it does not matter whether a work is crude or humble or obvious. Novelty is not required,⁵⁴ but the Court clearly rejected the labor, industrious collection, and sweat-of-the-brow theories of copyright protection.⁵⁵

Although the *Feist* decision concerned copyright protection for a standard telephone directory,⁵⁶ the decision “affects all varieties of works of authorship when the issue of originality arises.”⁵⁷ Accordingly, it is necessary to ask how the standard applies to works of authorship which are original in the “independent creation” sense, but are based upon or adapted from a preexisting work of authorship. A derivative work is defined in the Copyright Act as:

⁴⁸ *Id.* at 363–64.

⁴⁹ *Id.*

⁵⁰ *Id.* at 358.

⁵¹ *Id.* at 345.

⁵² *Id.* at 347 (relying on the premise that “a modicum of intellectual labor . . . clearly constitutes an essential constitutional element”).

⁵³ *Id.* at 345.

⁵⁴ *Id.* at 345–46. See also Shipley, *supra* note 20, at 94–98.

⁵⁵ See Joyce & Ochoa, *supra* note 27, at 270–82, 296 (discussing the development of these theories of copyright protection and explaining that *Feist* banished sweat of the brow.) Other courts have said that the demonstration of physical skill or special training to convert something from one material to another is often not enough to satisfy the originality standard. See, e.g., *L. Batlin & Son v. Snyder*, 536 F.2d 486 (2d Cir. 1976).

⁵⁶ Directories fit within the compilation category of copyrightable subject matter defined as “a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.” 17 U.S.C. § 101 (2018). See also *id.* at § 103.

⁵⁷ LEAFFER, *supra* note 13, at 60.

[A] work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgement, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a “derivative work.”⁵⁸

It is well established that derivative works can be based upon works in the public domain which are no longer protected by copyright as well as upon copyrighted works.⁵⁹ Of course, when one wants to adapt or recast a work of authorship that is still protected by copyright, it is necessary to secure permission from the copyright owner to create a derivative work based upon that work.⁶⁰ The statute also provides that copyright in a derivative work “does not extend to any part of the work in which [the preexisting] material has been used unlawfully,”⁶¹ and several courts have said that changes in medium generally do not involve sufficient originality to justify copyright protection.⁶² The key limitation on the scope of protection enjoyed by the creator of a derivative work is that copyright in the new version extends only to the material added by the second author, and does not affect the copyright or public domain status of the preexisting work that was adapted.⁶³

Well over thirty years ago, Judge Richard Posner espoused an argument for an elevated originality standard for derivative works.⁶⁴ He

⁵⁸ 17 U.S.C. § 101.

⁵⁹ See, e.g., *Schrock v. Learning Curve Int’l, Inc.*, 586 F.3d 513 (7th Cir. 2009) (holding the plaintiff’s photographs of the “Thomas & Friends” characters, taken with permission of the copyright owner, were copyrightable derivative works); *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951) (holding the plaintiff’s mezzotint reproductions of old masters contained the necessary amount of originality in order to be protected).

⁶⁰ Under 17 U.S.C. § 106(2) the owner of a copyright has the exclusive right “to prepare derivative works based upon the copyrighted work.” See generally *Pickett v. Prince*, 207 F.3d 402 (7th Cir. 2000) (holding that plaintiff’s original and creative use of the late entertainer’s copyrighted symbol could not be protected by copyright because the symbol was used without Prince’s permission and hence unauthorized). See also 17 U.S.C. § 103(a); Meagan Flynn, *Harper Lee’s estate sues over ‘To Kill a Mockingbird’ Broadway adaptation. Atticus at issue.*, WASH. POST (Mar. 15, 2018), https://www.washingtonpost.com/news/morning-mix/wp/2018/03/15/harper-lees-estate-sues-over-to-kill-a-mockingbird-broadway-adaptation-atticus-at-issue/?noredirect=on&utm_term=.a05f9c2bc3d7 (article about the Estate of Harper Lee filing suit over a Broadway adaptation of the novel “To Kill a Mockingbird” and arguing that screenwriter Aaron Sorkin’s script wrongly altered Atticus Finch and other copyrightable characters in the book).

⁶¹ 17 U.S.C. § 103(a).

⁶² See, e.g., *Random House, Inc. v. Rosetta Books, LLC*, 150 F. Supp. 2d 613, 622–23 (S.D.N.Y. 2001), *aff’d*, 283 F.3d 490 (2d Cir. 2002); *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 910 (2d Cir. 1980); *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 491 (2d Cir. 1976).

⁶³ The statute states that “[t]he copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material.” 17 U.S.C. § 103(b).

⁶⁴ *Gracen v. Bradford Exch.*, 698 F.2d 300, 304 (7th Cir. 1983). He later wrote that “[s]ome courts have required that the increment [of new expression] be significant, worrying that if it is set too low, and

asserted that requiring a slightly higher quantum of originality for derivative works might prevent potential overlapping claims.⁶⁵ For example, assume that two separate creators of second-generation works each have a license from the copyright holder with both licensees authorized to make small toys based upon a copyrighted cartoon character; derivative work copyright claimant #1 comes out first with its toy and argues that derivative work claimant #2 did not copy the underlying protected cartoon character (the original) but instead copied its toy (the copy) – derivative work #1; the first licensee is thus able to use its derivative work copyright to harass the second licensee of the copyright owner.⁶⁶ Another way to appreciate Posner’s concern about overlapping claims is to recognize that requiring a higher standard of originality for derivative works might make it easier to determine whether a second derivative work creator copied the underlying copyrighted work (the original) or the other creator’s derivative work (the copy).⁶⁷

Although Judge Posner’s law and economics argument for a higher originality hurdle for derivative works had followers,⁶⁸ the Seventh Circuit ultimately decided against going with a higher standard in its *Shrock* decision.⁶⁹ Accordingly, the prevailing view is that the originality standard as announced in *Feist* applies to derivative works without change.⁷⁰ The copyrightability question for derivative works “is whether there is sufficient nontrivial expressive variation in the derivative work to make it distinguishable from the underlying work in some meaningful way.”⁷¹ An adaptation that is not sufficiently original cannot be considered a derivative work.⁷² This is no more demanding than the originality standard as applied to other works. It is a low hurdle, but the derivative work still must exhibit more than a trivial variation from the underlying public domain work or

if the original and derivative copyrights happen to be in different hands . . . the costs of determining infringement could be prohibitive.” William M. Landes & Richard A. Posner, 18 J. LEGAL STUD. 325, 356 (1989).

⁶⁵ *Gracen*, 698 F.2d at 304.

⁶⁶ *Durham Indus.*, 630 F.2d at 910.

⁶⁷ *Entm’t Research Grp. v. Genesis Creative Grp.*, 122 F.3d 1211, 1220 (9th Cir. 1997). Judge Posner illustrated this concern with a hypothetical involving the Mona Lisa. See *Gracen*, 698 F.2d at 304. See also JOYCE ET AL., *supra* note 3, at 232 n.5–6; LEAFFER, *supra* note 13, at 67–68, n.92.

⁶⁸ *Entm’t Research.*, 122 F.3d at 1220.

⁶⁹ JOYCE ET AL., *supra* note 3, at 230 n.4; LEAFFER, *supra* note 13, at 69. Nevertheless, derivative work claimants, who have slightly adapted or modified public domain works, continue to assert their rights against persons who wish to use the public domain work. See, e.g., *Klinger v. Conan Doyle Estate, Ltd.*, 755 F.3d 496, 498 (7th Cir. 2014) (unwilling to pay for license to use Sherlock Holmes, plaintiff sued for declaratory judgment that he was free to use materials from 50 Holmes stories in the public domain); *We Shall Overcome Found. v. The Richmond Org., Inc.*, No. 16cv2725(DLC), 2017 U.S. Dist. LEXIS 146228, at *1–2 (S.D.N.Y. Sept. 8, 2017) (unwilling to obtain license to use “We Shall Overcome,” the plaintiff obtained a declaratory judgment that the melody and first verse of the song were in the public domain).

⁷⁰ *Schrock v. Learning Curve Int’l, Inc.*, 586 F.3d 513, 521 (7th Cir. 2009).

⁷¹ *Id.* at 521. See also *Sherry Mfg. Co. v. Towel King of Florida, Inc.*, 753 F.2d 1565, 1568 (11th Cir. 1985) (holding that trivial, insubstantial contributions resulting in miniscule variations do not meet the originality requirement).

⁷² *Wood v. Bourne Co.*, 60 F.3d 978, 992 (2d Cir. 1995).

copyrighted work upon which it is based in order to be protected.⁷³ The copyrightable element of a derivative work is the newly added material contributed by its author.⁷⁴

The black letter law is thus relatively easy to state: the originality standard for derivative works is the same as the originality standard for works in general. Still, application and explanation of the standard in the contexts of both copyrightability analysis and determining infringement can sometimes be a challenge. Here are some of the recurring problems as well as the application of some familiar, often-quoted principles of copyright law.

II. DERIVATIVE WORKS AND THE HOLMES MAXIM

This Article does not claim to be a comprehensive analysis of all decisions involving derivative works and the right to prepare derivative works. Instead, it presents a selection of decisions which best illustrate the scenarios and the problems. I have been teaching many of the cases discussed in this Article during my forty plus year career in legal education, I have written exam questions about many of them, I have my favorites, and I have long wanted to put them together to make sense of all of them.

A. Notwithstanding the Holmes maxim, copying the copy is sometimes permissible, but ordinarily quite risky.

The *Bleistein* decision established a low threshold for satisfying the originality standard.⁷⁵ As a practical matter, the Court held that the plaintiff's poster depicting a circus scene with acrobats and bicycles was copyrightable, and that it was permissible for another artist to depict those acrobats and bicycles (copy the original); but by reason of the plaintiff's copyright, the other artist could not copy the plaintiff's depiction (copy the copy).⁷⁶ Notwithstanding the pedigree of this familiar maxim about copying the original but not the copy, it has been tested in several cases in which courts ultimately held that it was permissible for a defendant to copy someone else's copy instead of making its own version of the original work.⁷⁷

A case involving toys based on Disney characters illustrates an exception to the maxim as well as Judge Posner's concern about overlapping claims. Tomy Corporation made three-inch wind-up plastic toys based on Mickey Mouse and other copyrightable Disney characters.⁷⁸ They did this

⁷³ LEAFFER, *supra* note 13, at 68.

⁷⁴ A derivative work must be substantially copied from a preexisting work so that it would be regarded as infringing if done without permission. *Litchfield v. Spielberg*, 736 F.2d 1352 (9th Cir. 1984).

⁷⁵ *Joyce & Ochoa*, *supra* note 27, at 308; *Zimmerman*, *supra* note 14, at 101. See generally *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903).

⁷⁶ *Bleistein*, 188 U.S. at 251–252.

⁷⁷ See, e.g., *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905 (2d Cir. 1980); *Entm't Research Grp., Inc. v. Genesis Creative Grp., Inc.*, 122 F.3d 1211 (9th Cir. 1997).

⁷⁸ *Durham Indus.*, 630 F.2d at 908. See *supra* notes 64–71.

under license from Disney because otherwise these reproductions, though in different mediums, would have infringed Disney’s copyrights as unauthorized derivative works.⁷⁹ Durham Industries conceded it used Tomy’s toys as models for its wind-up plastic toys – it copied Tomy’s copies of the copyrighted Disney characters – and it sought a declaratory judgment that it had not infringed.⁸⁰ Tomy counterclaimed for infringement, but the trial court dismissed that claim on Durham’s motion for summary judgment, ultimately concluding that Tomy’s adaptations of the familiar characters were not copyrightable because they “lacked even a modest degree of originality.”⁸¹ The Second Circuit affirmed. It acknowledged that Tomy’s creations were derivative works, which are explicitly included in the subject matter of copyright, but limited in the following ways.⁸²

First, to support a copyright the original aspects of a derivative work must be more than trivial. Second, the scope of protection afforded a derivative work must reflect the degree to which it relies on preexisting material and must not in any way affect the scope of any copyright protection in that preexisting material.⁸³

Accordingly, the only aspects of Tomy’s wind-up toy renditions of Disney’s characters entitled to protection were whatever nontrivial original features it had contributed to Mickey, Donald Duck, Pluto, and others.⁸⁴ The court said that reproducing the characters in three-dimensions and in plastic did not constitute originality for purposes of copyright protection, and that Tomy had not shown that its toys had any distinguishable variation or independent creation from Disney’s characters.⁸⁵ Moreover, the court warned that extending protection to miniscule variations “would simply put a weapon for harassment in the hands of mischievous copiers.”⁸⁶ The court explained that:

[i]f we were to recognize Tomy’s derivative copyrights in its figures, those who, like Durham, have obtained from Disney the right to copy Disney’s own characters would, as a practical matter, have to make substantial changes in these characters in order to avoid infringing Tomy’s rights. In

⁷⁹ *Id.* at 909.

⁸⁰ *Id.* at 907.

⁸¹ *Id.* at 905, 908, 911.

⁸² *Id.* at 909.

⁸³ *Id.* (citing 17 U.S.C. § 103(b) (2018)).

⁸⁴ *Id.* (citing *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486 (2d Cir. 1976) (en banc)).

⁸⁵ *Id.* at 910. See also LEAFFER, *supra* note 13, at 66.

⁸⁶ *Durham Indus.*, 630 F.2d at 910 (quoting *Batlin*, 536 F.2d at 492). The Compendium of the U.S. Copyright Office Practices, Third Edition, states at section 313.4(A) that a toy model that is an exact replica of a useful article where no creative expression has been added is not copyrightable. Mere copies of another work of authorship are not copyrightable. U.S. Copyright Office, Compendium of U.S. Copyright Office Practices § 313.4(A) (3d ed. 2017) [hereinafter *Compendium*]. The court’s concerns about harassment can also be explained as trying to avoid overlapping claims. See *supra* notes 64–71 and accompanying text.

theory, of course, there would be no infringement of Tomy's rights if Durham copied Disney's characters and not Tomy's figures, but because proof of access plus substantial similarity can support a finding of infringement, Durham would at the very least be vulnerable to harassment. Yet[,] any significant changes made by Durham to avoid liability would carry it away from the original Disney characters, in which Tomy concededly has no copyrights, and Disney's right to copy (or to permit others to copy) its own creations would, in effect, be circumscribed.⁸⁷

*Entertainment Research Group, Inc. v. Genesis Creative Group, Inc.*⁸⁸ is similar to Tomy's dispute with Durham over the Disney toys. Entertainment Research Group ("ERG") made large inflatable costumes worn by people at publicity events.⁸⁹ These costumes were based upon copyrightable two-dimensional cartoon characters like the Pillsbury Doughboy and Cap'n Crunch, and were made with permission of the copyright owners.⁹⁰ ERG had a business relationship with defendant Genesis that deteriorated and ultimately resulted in a suit in which ERG alleged that Genesis and another entity had, among other things, infringed the copyrights on its costumes.⁹¹ The district court granted summary judgment for the defendants, holding that ERG did not possess valid copyrights in its costumes based upon the preexisting copyrighted two-dimensional cartoon characters.⁹²

The Ninth Circuit affirmed, after distinguishing its earlier *Doran* ruling, in which it had upheld copyright protection for a three-dimensional inflatable version of a public domain rendition of Santa Claus.⁹³ The court relied upon the Second Circuit's decision in *Durham* and said that this case was different from its earlier Santa dispute because ERG's costumes were based upon cartoon characters still protected by copyright.⁹⁴ The variations between ERG's costumes and those protected characters were too trivial to warrant protection.⁹⁵ The court explained that if protection for adaptations of copyrighted works was afforded too easily, "the owner of the underlying copyrighted work would effectively be prevented from permitting others to copy her work since the original derivative copyright holder would have a de facto monopoly due to her 'considerable power to interfere with the creation

⁸⁷ *Durham Indus.*, 630 F.2d at 911. *Supra* note 86.

⁸⁸ 122 F.3d 1211 (9th Cir. 1997).

⁸⁹ *Id.* at 1214.

⁹⁰ *Id.* at n.2.

⁹¹ *Id.* at 1215.

⁹² *Id.* at 1216.

⁹³ *Id.* at 1219–20 (distinguishing *Sunset House Distrib. v. Doran*, 304 F.2d 251 (9th Cir. 1962)).

⁹⁴ *Id.* at 1220.

⁹⁵ *Id.* at 1222–24.

of subsequent derivative works from the same underlying work.”⁹⁶ This statement echoed the concerns raised by the Second Circuit in the *Durham* decision about affording protection for adaptations of copyrighted works with only trivial variations from the underlying work.⁹⁷

A variation on this theme is seen in *We Shall Overcome Foundation v. The Richmond Organization*.⁹⁸ The defendants held two copyrights to the musical composition “We Shall Overcome,” registered as a derivative work in the early 1960s. The plaintiffs, who had paid the defendants \$15,000 for a license to use “We Shall Overcome” in the movie “The Butler,” were refused a synchronization license by the defendants in 2015. They sought a declaratory judgment in 2016 that the defendants’ copyrights did not cover the melody or the familiar lyrics to the iconic song.⁹⁹ On the plaintiffs’ motion for summary judgment, the court determined that “We Shall Overcome” was based on an earlier version that had entered the public domain in the 1940s and that defendants’ changing of “will” to “shall” and “down in my heart” to “deep in my heart” did not make the defendants’ disputed version sufficiently original to be entitled to protection as a derivative work based on the public domain song.¹⁰⁰ In essence, the defendants had no valid copyright in the words and melody of the first verse of “We Shall Overcome.”¹⁰¹ The court did not agree with the defendants’ expert who said that those changes in the public domain work rendered the meanings of the two versions different and entitled the defendants’ version to copyright protection as a derivative work.¹⁰² In short, it was permissible for the plaintiffs to use the defendants’ copy because the copy did not have sufficiently distinguishable variations from the original song to be entitled to copyright protection.¹⁰³ Thus, it was impermissible for the defendants to insist that the plaintiffs pay to use their only slightly-altered version of the public domain song.¹⁰⁴ This is another illustration of the risk of affording copyright protection to a derivative work that has only trivial differences from a public domain work.

⁹⁶ *Id.* at 1220 (quoting *Gracen v. Bradford Exch.*, 698 F.2d 300, 305 (7th Cir. 1983)).

⁹⁷ See also *supra* notes 86–87 and accompanying text.

⁹⁸ No. 16cv2725(DLC), 2017 U.S. Dist. LEXIS 146228 (S.D.N.Y. Sept. 8, 2017).

⁹⁹ *Id.* at *21

¹⁰⁰ *Id.* at *26, *35–37.

¹⁰¹ *Id.* at *57

¹⁰² For a variation on this theme of seeking declaratory relief to the effect that your work doesn’t infringe the defendant’s work because it is based on works in the public domain, see *Cabell v. Zorro Prods.*, No. 5:15-cv-00771-EJD, 2018 U.S. Dist. LEXIS 80262, *2-4, *41 (N.D. Cal. May 11, 2018) (in which the plaintiff, the author of the 1996 musical titled “Z – The Musical of Zorro,” was declared not to have infringed copyrights held by defendant Zorro Productions because the plaintiff was able to show that the musical was based entirely on works with the character Zorro that were both in the public domain, a 1919 story and a 1920 silent movie). See also Robert Loerzel, *Lawsuits aim to put iconic folk songs back in the public domain*, ABA J. (Nov. 2016), http://www.abajournal.com/magazine/article/this_song_is_our_song; John Patterson, *Copyright Law: Overcoming Claims of Copyright Protection for Derivative Works*, BAKER STERCHI COWDEN & RICE (Jan. 11, 2018), <https://www.bscl-law.com/?t=40&an=71848&format=xml&stylesheet=blog&p=5258>.

¹⁰³ *We Shall Overcome*, 2017 U.S. Dist. LEXIS 146228, at *31–32, *51–54.

¹⁰⁴ *Id.* at *57.

The parties in these cases got away with copying a copy without a license or permission instead of adapting the original work. Whether one agrees with the concerns about the risk of being too lenient with applying the originality standard to derivative works, it is safe to say that if it appears that a company has reproduced another's authorized copy of a preexisting copyrighted work, that company is likely to be sued for copyright infringement. The alleged infringer of the authorized copy might ultimately prevail if it can show it copied the original protected work with permission, or that the copy it copied was not protected by copyright because it failed to meet the originality standard. Still, the alleged infringer will have to bear the costs of defending the claim. Even though the Copyright Act provides for the award of attorney's fees to the prevailing party,¹⁰⁵ given the closeness of these and similar derivative work cases, the award of fees to the prevailing party is not a sure thing.¹⁰⁶

B. Copying the copy is risky even when the original is in the public domain.

Is it permissible to copy the copy when the original work of authorship is in the public domain? The answer is “sometimes,” but the safest approach is to copy the public domain original as the United States Postal Service (“USPS”) learned the hard way when it mistook a Las Vegas replica of the real Statue of Liberty in creating its 2010 “forever” stamp.¹⁰⁷ The Post Office picked a photo for its new stamp by searching Getty Images, released the stamp in 2010, and in 2011, after printing 3 billion stamps, a collector determined that the USPS had used a photographic image of the wrong Lady Liberty.¹⁰⁸ The replica's sculptor sued for infringement, the court determined that his replica of the Statue of Liberty in front of a Las Vegas casino had sufficient artistic variations from the public domain gift from France to be protectable as a derivative work, and awarded him \$3.5 million in damages.¹⁰⁹ The USPS got in trouble for copying the copy instead of the public domain original, and this is not an uncommon scenario as illustrated by the following cases.

¹⁰⁵ 17 U.S.C. § 505 (2018).

¹⁰⁶ See generally David Shipley, *Discouraging Frivolous Copyright Infringement Claims: Fee Shifting under Rule 11 or 28 U.S.C. § 1927 as an Alternative to Awarding Attorney's Fees under Section 505 of the Copyright Act*, 24 J. INTEL. PROP. L. 33, 35–41 (2016).

¹⁰⁷ Ashley May, *Postal Service Misidentifies Statute of Liberty in Stamp in a \$3.5 million Mistake*, USA TODAY (July 6, 2018, 6:39 AM), <https://www.usatoday.com/story/news/nation-now/2018/07/06/postal-service-misidentifies-statue-liberty-stamp-million-mistake/762306002/>.

¹⁰⁸ *Id.*

¹⁰⁹ *Statue of Liberty stamp mistake to cost U.S. Postal Service \$3.5M*, CBS NEWS (updated July 8, 2018), <https://www.cbsnews.com/news/statue-of-liberty-stamp-mistake-to-cost-u-s-postal-service-3-5-million/>. See also Frankfurt Kurnit Klein & Selz, *Clear All Copyrights: Original Subject, Derivative Version, Photograph . . .*, FRANKFURT KURNIT KLEIN & SELZ (updated July 12, 2018), available at <http://www.mondaq.com/unitedstates/x/718504/Copyright/Clear+All+Copyrights+Original+Subject+Derivative+Version+Photograph>.

In *Bridgeman Art Library, Ltd. v. Corel Corp.*, the plaintiff claimed that Corel had infringed the copyright on its digital and photographic reproductions of public domain paintings; in essence, it had copied Bridgeman's copies, not the original public domain works that it could have copied without permission.¹¹⁰ Bridgeman has a large library of photographs of public domain works, both transparencies and in digital format, and it asserted that Corel's CD-ROM of photos of old masters had reproduced its digital photographs.¹¹¹ Both parties moved for summary judgment in the original action. The court ruled in favor of defendant Corel, and then reached the same result on reconsideration.¹¹²

In the first ruling the court applied the law of the United Kingdom and held that Bridgeman's reproductions were not original and thus unprotected by copyright.¹¹³ These particular reproductions were in a different medium, but they were exact copies – without any avoidable additions, alterations to, or transformations of the public domain works.¹¹⁴ In the second proceeding, the court applied United States law and came out the same way.¹¹⁵ The definition of derivative works includes art reproductions,¹¹⁶ and Bridgeman's transparencies and digital reproductions required considerable technical skill and effort, but they did not satisfy the originality standard announced in *Feist* because Bridgeman sought absolute fidelity in making its copies of famous public domain paintings.¹¹⁷ They were slavish copies.¹¹⁸ Bridgeman's labor and effort to make its copies did not qualify them for copyright protection.¹¹⁹ Corel was free to copy Bridgeman's non-copyrightable copies of the old masters as well as to make its own reproductions of those original public domain paintings.¹²⁰ Of course, copying Bridgeman's copies resulted in lengthy litigation.

¹¹⁰ *Bridgeman Art Library, Ltd. v. Corel Corp.*, 25 F. Supp. 2d 421 (S.D.N.Y. 1998), *reconsideration granted*, 36 F. Supp. 2d 191 (S.D.N.Y. 1999).

¹¹¹ *Bridgeman Art Library*, 25 F. Supp. 2d at 423–24.

¹¹² *Bridgeman Art Library*, 36 F. Supp. 2d at 192, 199.

¹¹³ *Bridgeman Art Library*, 25 F. Supp. 2d at 426.

¹¹⁴ *Id.* In contrast, the artist in the Statue of Liberty stamp litigation argued successfully that his mother-in-law's face inspired his design and that he had made the statue's appearance a little more modern and a little more feminine than the original statue in New York's harbor. See sources cited *supra* note 109.

¹¹⁵ See generally *Bridgeman Art Library*, 36 F. Supp. 2d 191.

¹¹⁶ 17 U.S.C. § 101 (2018) (definition of "derivative work").

¹¹⁷ *Bridgeman Art Library*, 36 F. Supp. 2d at 197.

¹¹⁸ *Gaste v. Kaiserman*, 863 F.2d 1061, 1066 (2d Cir. 1988) (anything that is slavish is not original); 1 M. Nimmer § 2.08[E][1], at 2-130 – 2-31 (a photograph is not copyrightable when it is nothing more than a slavish copy).

¹¹⁹ *Bridgeman Art Library*, 36 F. Supp. 2d at 196–97. *Bridgeman Art Library* is cited in the Compendium to support the proposition that mere copies of another work of authorship are not entitled to copyright protection without any original contributions. The Compendium also states that an exact copy of the Mona Lisa, indistinguishable from the original, could not be copyrighted. *Compendium* § 313.4(A). "Whether photographs of a copyrighted work are derivative works is the subject of deep disagreement among courts and commentators alike." *Schrock v. Learning Curve Int'l, Inc.*, 586 F.3d 513, 518 (7th Cir. 2009).

¹²⁰ *Bridgeman Art Library*, 25 F. Supp. 2d at 409.

The decision in *L. Batlin & Son, Inc. v. Snyder* is similar.¹²¹ Snyder made a plastic replica of a public domain, folk-art, cast-iron “Uncle Sam” bank and alleged that Batlin had reproduced its replica (copied the copy) instead of making its own reproduction of the original bank.¹²² Snyder lost because it was unable to show that its replica had any substantial originality above and beyond the preexisting public domain work.¹²³ Accordingly, its copy, though derivative, was not copyrightable.¹²⁴ The change in medium by Snyder, from cast-iron to plastic, was not a sufficient transformation of the original to qualify its replica for protection.¹²⁵

In contrast to the *Bridgeman* and *Batlin* decisions, the courts in *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*¹²⁶ and *Alva Studios, Inc. v. Winninger*¹²⁷ ruled in favor of the creators of derivative works based upon public domain works, and held that the defendants had infringed by copying the plaintiffs’ derivative works (copying the copies) instead of copying the public domain originals. In each of these cases, the plaintiffs had highly skilled artisans craft exacting reproductions of famous works of art. However, *Alfred Bell* was decided in 1951 and *Alva Studios* in 1959, both long before the passage of the Copyright Act of 1976 and the *Feist* decision in 1991.¹²⁸

The works at issue in *Alfred Bell* were mezzotint engravings that reproduced a museum’s paintings through a laborious process that resulted in a copy that could be reprinted easily in a book.¹²⁹ Defendant Catalda copied Alfred Bell’s mezzotint copies of some of these old masters,¹³⁰ so Alfred Bell sued for infringement. Catalda argued that Alfred Bell’s reproductions were not copyrightable because they were faithful copies of the public domain paintings.¹³¹ In essence, Catalda contended that it could copy the plaintiff’s copies instead of the original old masters because the plaintiff’s mezzotint versions could not be protected by copyright.¹³²

¹²¹ 536 F.2d 486 (2d Cir. 1976) (en banc).

¹²² *Id.* at 487–88.

¹²³ *Id.* at 492.

¹²⁴ *Id.* at 490–92.

¹²⁵ *Id.* at 491. The Copyright Office states that a derivative work that merely reduces or enlarges the size of a preexisting work, without any creative input, may not be copyrighted. *Compendium* § 313.2. The results of cases raising the issue of whether a change in medium is sufficient to satisfy the originality standard so that the resulting derivative work is copyrightable are mixed. *See* JOYCE ET AL., *supra* note 3, at 235 n.12.

¹²⁶ 191 F.2d 99, 105 (2d Cir. 1951).

¹²⁷ 177 F. Supp. 265, 268 (S.D.N.Y. 1959).

¹²⁸ Both courts were applying the 1909 Copyright Act. *See also* LEAFFER, *supra* note 13, at 66–67.

¹²⁹ *Alfred Bell*, 191 F.2d at 105.

¹³⁰ *Id.*

¹³¹ *Id.* at 104.

¹³² *Id.*

The trial court ruled for Alfred Bell, holding that its reproductions were copyrightable, and the Second Circuit affirmed.¹³³ In determining that Alfred Bell's derivative works were copyrightable, the court said that:

They “originated” with those who make them, and . . . amply met the standards imposed by the Constitution and the statute. There is evidence that they were not intended to, and did not, imitate the paintings they reproduced. But even if their substantial departures from the paintings were inadvertent, the copyrights would be valid. A copyist's bad eyesight or defective musculature, or a shock caused by a clap of thunder, may yield sufficiently distinguishable variations. Having hit upon such a variation unintentionally, the “author” may adopt it as his and copyright it.¹³⁴

The defendants in *Alfred Bell* lost because they copied the plaintiff's copyrightable derivative works based upon public domain works of art instead of reproducing the originals.¹³⁵ This result is consistent with Holmes' famous maxim. Moreover, Judge Posner indicated in *Bucklew v. Hawkins, Ash, Baptie & Co.* that *Alfred Bell* and *Bleistein* were unchanged by *Feist* because a more burdensome or demanding standard of copyrightability would require judges to make aesthetic judgments.¹³⁶

Similarly, in *Alva Studios* the court held that the plaintiff's exacting, reduced-scale reproduction of Rodin's sculpture, the “Hand of God,” requiring great skill on the part of the artisans who reproduced it, was copyrightable.¹³⁷ In granting an injunction to block the defendant's copying, the court said that to be entitled to copyright, the plaintiff's derivative work “must be original in the sense that the author has created it by his own skill, labor and judgment without directly copying or evasively imitating the work of another”¹³⁸ and that

Plaintiff has sustained this burden. Its copyrighted work embodies and resulted from its skill and originality in producing an accurate scale reproduction of the original. In a work of sculpture, this reduction requires far more than an abridgement of a written classic; great skill and originality is

¹³³ *Id.*

¹³⁴ *Id.* at 104–05.

¹³⁵ *Id.* at 104–05.

¹³⁶ *Bucklew v. Hawkins, Ash, Baptie & Co., LLP*, 329 F.3d 923, 929 (7th Cir. 2003). *See also* Zimmerman, *supra* note 14, at 107.

¹³⁷ *Alva Studios, Inc. v. Winninger*, 177 F. Supp. 265, 267 (S.D.N.Y. 1959). *But see* *Compendium* § 313.2 (stating that the Copyright Office will not register a work that merely reduces the size of a preexisting work without any creative input).

¹³⁸ *Alva Studios*, 177 F. Supp. at 267.

called for when one seeks to produce a scale reduction of a great work with exactitude.

It is undisputed that the original sculpture owned by the Carnegie Institu[te] is 37 inches and that plaintiff's copyrighted work is 18½ inches.

The originality and distinction between the plaintiff's work and the original also lies in the treatment of the rear side of the base. The rear side of the original base is open; that of the plaintiff's work is closed. We find that this difference when coupled with the skilled scaled sculpture is itself creative.¹³⁹

The defendant copied the plaintiff's copy of a public domain work instead of making its own reproduction of the original Rodin sculpture.¹⁴⁰ Here again, the result is consistent with the often-quoted maxim by Justice Holmes.¹⁴¹

What should be said to someone who is thinking about marketing reproductions of public domain works? Is it too cautious to say he or she should do their own reproductions and not copy another's replicas of those works? Should that advice be qualified by saying there is no reason to worry if those other reproductions are low quality in contrast to the high-end reproductions your client's artisans plan to make and sell? Will it matter much to a client that *Alfred Bell* and *Alva Studios* are from 1951 and 1959 respectively, pre-Copyright Act of 1976 and pre-*Feist*, and that they might have been undermined by later decisions like *Batlin* and *Bridgeman* as well as *Feist*?

What should be said if there are other entities selling art reproductions like those the artisan wants to market? Do not say, "don't worry" because the odds are good that there will be a suit alleging "you copied my copyrightable copy" instead of the original public domain work. Win, lose, or settle, there will be time and money spent on the issues of infringement and whether the copies are copyrightable art reproductions.¹⁴²

¹³⁹ *Id.*

¹⁴⁰ *Id.* at 268.

¹⁴¹ For a variation on this theme involving a translation of works written in 1637 in Spain, see *Oliveras v. Univ. of Chicago*, 213 F. Supp. 3d 757 (M.D.N.C. 2016) (stating that defendants, who had used plaintiff's 2000 edition of the original stories in doing their translation of the works into English, argued unsuccessfully on a summary judgment motion that the plaintiff's punctuation corrections and changes in paragraph breaks were not sufficiently creative to be entitled to copyright protection since the defendants had copied the copy). See also *infra* notes 266–271 and accompanying text.

¹⁴² See LEAFFER, *supra* note 13, at 66–67 (explaining why the decisions involving artistic reproductions are difficult to reconcile, and the risk of courts making aesthetic judgments about the level of artistic skill needed to make a high end art reproduction in contrast to a mass produced, low end, plastic reproduction).

*C. It is risky to copy or use without permission another creator's highly representational and accurate work, like a photograph, even if that photograph is ordinary.*¹⁴³

The scope of copyright protection for a photograph can range from relatively robust,¹⁴⁴ to thin,¹⁴⁵ and to non-existent.¹⁴⁶ There is not agreement on whether photographs of a copyrighted work are derivative works.¹⁴⁷ Still, the unauthorized copying of even a thinly-protected photograph can result in litigation for violation of the reproduction right as well as violation of the right to prepare derivative works.¹⁴⁸ Does the subject of the photograph at issue make a difference? For instance, what if the photo is a studio portrait of an individual? What if the photo is a nature scene or a wildlife photograph? What if the subject of the photo is a utilitarian object that is not copyrightable? The answers to these questions are “it depends” and “there could be litigation.”¹⁴⁹

An often-discussed decision from 1914, *Gross v. Seligman*,¹⁵⁰ provides a good starting point. A photographer posed a model in the nude and took a studio-style photo of her from the side, seated on the floor, with her arms clasped around her knees and her head tilted slightly toward the camera.¹⁵¹ He titled this photo “Grace of Youth” and then assigned his rights to the plaintiff.¹⁵² Two years later he photographed the same model, posing

¹⁴³ There is some disagreement on whether an ordinary photograph is copyrightable. *Compare* *Jewelers' Circular Publ'g Co. v. Keystone Publ'g Co.*, 274 F. 932, 934 (S.D.N.Y. 1921) (Judge Learned Hand suggested that all photographs are affected by the personal influence of the photographer and thus copyrightable), *aff'd*, 281 F. 83 (2d Cir. 1922), *with* *Oriental Art Printing, Inc. v. Goldstar Printing Corp.*, 175 F. Supp. 2d 542 (S.D.N.Y. 2001) (photographs of food dishes on a menu were not sufficiently original and hence not copyrightable).

¹⁴⁴ *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884) (posed studio photograph of Oscar Wilde reproduced by defendant); *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444 (S.D.N.Y. 2005) (a posed photograph of the pro-basketball player Kevin Garnett used in a magazine story copied by a billboard for Coors).

¹⁴⁵ Judge Hand said that “no photograph, however simple, can be unaffected by the personal influence of the author, and no two will be absolutely alike.” *Jewelers' Circular Pub. Co. v. Keystone Pub. Co.*, 274 F. 932, 934 (S.D.N.Y. 1921), *aff'd*, 281 F. 83 (2d Cir. 1922) (holding that photographs of jewelers' trademarks illustrating a trade circular were copyrightable).

¹⁴⁶ *Bridgeman Art Library, Ltd. v. Corel Corp.*, 25 F. Supp. 2d 421 (S.D.N.Y. 1998), *reconsideration granted*, 36 F. Supp. 2d 191 (S.D.N.Y. 1999) (photographs and digital transparencies of public domain paintings not copyrightable under U.K. and U.S. law).

¹⁴⁷ *Schrock v. Learning Curve Int'l, Inc.*, 586 F.3d 513, 518 (7th Cir. 2009); *Ty Inc. v. Publ'ns Int'l Ltd.*, 292 F.3d 512, 519 (7th Cir. 2002) (determining photographs of plaintiff's Beanie Babies dolls were derivative works).

¹⁴⁸ 17 U.S.C. §§ 106(1)–(2) (2018).

¹⁴⁹ *See, e.g., Culver Franchising Sys., Inc. v. Steak n Shake Inc.*, No. 16 C 72, 2016 U.S. Dist. LEXIS 103091, *18–*20 (N.D. Ill. Aug. 5, 2016) (claim against Steak n Shake for alleged infringement of television commercial dismissed without prejudice on Rule 12(b)(6) motion in part because many of the elements in the ad alleged to be taken, such as grilling burgers, pressing the grilling burgers with a spatula, and displaying a corporate logo at the beginning or end of the advertisement were not protectable; the plaintiff was granted leave to file an amended complaint).

¹⁵⁰ 212 F. 930 (2d Cir. 1914).

¹⁵¹ For a side-by-side example of these portraits, *see* Michael Risch, *Can You Copyright a Pose?*, WRITTEN DESCRIPTION (Feb. 6, 2018), <https://writtendescription.blogspot.com/2018/02/can-you-copy-right-pose.html>.

¹⁵² *Gross*, 212 F. at 931.

her almost exactly the same way.¹⁵³ The only differences were that she was wearing a smile and holding a cherry stem between her teeth.¹⁵⁴ He titled this photograph “Cherry Ripe.”¹⁵⁵ Litigation soon followed with the copyright owner for “Grace of Youth” claiming that the photographer’s new version, “Cherry Ripe,” infringed.¹⁵⁶ After noting differences between the two photographs, the court found infringement saying that “[t]he identity of the artist and the many close identities of pose, light, and shade, etc., indicate very strongly that the first picture was used to produce the second.”¹⁵⁷ Did the photographer copy the copy? One could argue that he copied the original by using the same model and having her pose the same way as before. Incidentally, later research revealed that in finding infringement the court in *Gross v. Seligman* relied incorrectly upon a dissent from an 1895 House of Lords decision, *Hanfstaengl v. Baines & Co.*,¹⁵⁸ thinking it was the majority opinion.¹⁵⁹ The English court had, in fact, found no infringement on a similar set of facts.¹⁶⁰

The Third Circuit’s decision in *Franklin Mint Corp. v. National Wildlife Art Exchange, Inc.*¹⁶¹ stands in contrast to *Gross*. A wildlife artist painted a very realistic, representational watercolor titled “Cardinals on Apple Blossom” and then transferred his rights to the National Wildlife Art Exchange, which distributed 300 prints of the painting.¹⁶² This artist then painted a series of birdlife pictures including one titled “Cardinal” that was very similar to his earlier “Cardinals on Apple Blossom.”¹⁶³ He did this series for the Franklin Mint Corporation and used the same preliminary sketches, slides, photographs, and working drawings that he used in creating the first work.¹⁶⁴ National Wildlife accused the artist and Franklin Mint of infringement, the trial court held that there was no infringement, and the United States Court of Appeals for the Third Circuit affirmed.¹⁶⁵

After noting that copyright does not protect thematic concepts, and that having the same subject matter in two paintings does not prove infringement,¹⁶⁶ the court acknowledged that

¹⁵³ *Id.*

¹⁵⁴ Risch, *supra* note 151.

¹⁵⁵ David W. Melville, *An Author's Right to Return to a Theme: Protecting Artistic Freedom in Visual, Musical and Literary Works* 14 LOY. L.A. ENT. L. REV. 427, 434 (1994).

¹⁵⁶ *Gross*, 212 F. at 931.

¹⁵⁷ *Id.* at 931.

¹⁵⁸ L.R. [1895] A.C. 20.

¹⁵⁹ Arthur Seidel, *A Case of Variations on a Theme: Cardinal Paintings and Copyright Laws Clash in Court*, THE PHILADELPHIA LAWYER, Spring 2001, at 48.

¹⁶⁰ *Id.*

¹⁶¹ 575 F.2d 62 (3d Cir. 1978).

¹⁶² *Id.* at 63–64.

¹⁶³ *Id.* at 64.

¹⁶⁴ *Id.*

¹⁶⁵ *Id.* at 63, 67.

¹⁶⁶ *Id.* at 65.

an artist who produces a rendition with photograph-like clarity and accuracy may be hard pressed to prove unlawful copying by another who uses the same subject matter and the same technique. A copyright in that circumstance may be termed “weak,” . . . limitations imposed upon the artist by convention are also factors which must be considered. A scientific drawing of a bird must necessarily be more similar to another of the same nature than it would be to an abstract version of the creature in flight.¹⁶⁷

There were obvious similarities between these highly representational paintings “[b]ut there [were] also readily apparent dissimilarities in the paintings in color, body attitude, position of the birds and linear effect.”¹⁶⁸ Moreover, the Third Circuit did not want to prevent artists from returning to basic themes in order to paint variations, and it equated such themes with ideas which cannot be protected by copyright.¹⁶⁹ In other words, notwithstanding the similarities between the realistic paintings, the artist was able to show that he had copied the original and not his initial copy. Given the subject matter, theme, and the desire for accuracy, the first painting he created would have been infringed by only a slavish, virtually identical copy.¹⁷⁰

Pieter A. Folkens v. Wyland Worldwide LLC is a recent decision involving wildlife artists depicting the same subject matter.¹⁷¹ The plaintiff alleged that the defendant’s 2011 painting of an underwater scene with three dolphins, two of which were crossing, infringed his 1979 pen and ink illustration depicting two dolphins crossing each other as one swims horizontally and the other vertically.¹⁷² The lower court granted summary judgment for the defendant, saying that the idea of dolphins swimming underwater close together is not a copyrightable element of a work “because natural positioning and physiology are not protectable.”¹⁷³ On appeal, the plaintiff contended that his depiction of the dolphins was unique because the dolphins in his illustration were posed by professional animal trainers in an

¹⁶⁷ *Id.* (internal citations omitted).

¹⁶⁸ *Id.* at 66.

¹⁶⁹ *Id.*

¹⁷⁰ With the trial judge’s permission, the defendant artist painted a third work of a Cardinal and apple blossoms during the course of the five-day trial without referring to his two earlier works. The artist’s lawyer did this to demonstrate artistic variations and the absence of copying. *Id.* at 66. *See also* Seidel, *supra* note 159, at 48.

¹⁷¹ *Folkens v. Wyland Worldwide, LLC*, 882 F. 3d 768, 770 (9th Cir. 2018).

¹⁷² *Id.* at 770-71.

¹⁷³ *Id.* at 773. *See also* Sarah Bro, *Attempt to Claim ‘Common Heritage of Human Kind’ Sinks Infringement Case*, MCDERMOTT WILL & EMERTY (May 29, 2018), <https://www.mwe.com/fr-fr/thought-leadership/newsletters/2018/05/ip-update>.

enclosed environment and did not appear in nature in such a configuration.¹⁷⁴ The Ninth Circuit affirmed and stated:

As a general rule, under our copyright law, an artist may not use copyright law to prevent others from depicting such ideas first expressed by nature. The basic idea of copyright law is to protect unique expression, . . . it is not to give to the first artist showing what has been depicted by nature a monopoly power to bar others from depicting such a natural scene.¹⁷⁵

The plaintiff's copyright was thin and the court said that the work's protectable elements were not infringed by the defendant's picture.¹⁷⁶ In short, even if defendant had copied plaintiff's idea of crossing dolphins, this was not infringement because that idea cannot be protected by copyright.¹⁷⁷ The two artists depicted the original – the idea of crossing dolphins – differently.¹⁷⁸

In *Ets-Hokin v. Skyy Spirits, Inc.* a photographer alleged that the defendant infringed his commercial photographs of a bottle of Skyy Vodka.¹⁷⁹ The lower court dismissed, but the Ninth Circuit reversed and remanded.¹⁸⁰ It first held that the vodka bottle itself, as a utilitarian object, was not copyrightable, but the plaintiff's photos were protectable because he had made creative decisions about shading, lighting, angle, and background.¹⁸¹ After further proceedings, the case returned to the appellate court and it concluded that defendant's photos of the same Skyy Vodka bottle were not infringing because they differed from the plaintiff's photos in terms of angle, lighting, shadow, reflection, and background.¹⁸² The plaintiff's and defendant's photographs both portrayed accurately the same unadorned bottle that was not itself copyrightable.¹⁸³ Once that unprotected subject matter was filtered out, the copyrightable expressions in the respective photographs were not substantially similar.¹⁸⁴

¹⁷⁴ *Folkens*, 882 F. 3d at 770.

¹⁷⁵ *Id.* at 770–71.

¹⁷⁶ *Id.* The Ninth Circuit relied on an earlier decision, *Savata v. Lowry*, in which the court said that where the only areas of commonality between two works are elements first found in nature, expressing ideas that nature has already expressed for all, a court need not permit the case to go to trial. *Id.* at 770.

¹⁷⁷ *Id.* at 776.

¹⁷⁸ *Id.* To view the images side-by-side, see Risch, *supra* note 151.

¹⁷⁹ *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1071 (9th Cir. 2000), *aff'd*, 323 F.3d 763 (9th Cir. 2003).

¹⁸⁰ *Ets-Hokin*, 225 F.3d at 1082.

¹⁸¹ *Id.* at 1077.

¹⁸² *Ets-Hokin v. Skyy Spirits, Inc.*, 323 F.3d 763, 764–66 (9th Cir. 2003).

¹⁸³ *Ets-Hokin*, 225 F.3d at 1081.

¹⁸⁴ *Id.* at 766. See also Mark Sableman, *Two skyline photo cases, two different result*, THOMPSON COBURN LLP (Aug. 9, 2018), <https://www.thompsoncoburn.com/insights/blogs/in-focus/post/2018-08-09/two-skyline-photo-cases-two-different-results> (discussing two recent cases in which one photographer's picture of the Indianapolis skyline was infringed by its use, without authorization, on the defendant's website while the other photographer's sunset photo of Philadelphia's Center City was not infringed by an Anheuser-Busch neon sign).

Another way to explain this is that the defendant was able to prove that it copied the original and not the plaintiff's thinly-protected photos of the same subject. As in the *Franklin Mint*, "Cardinals on Apple Blossom" litigation, it is likely that only a slavish – almost exact – reproduction would have infringed the relatively thin copyright on plaintiff's photos of the vodka bottle.¹⁸⁵ Still, even though it can be said that defendant copied the original and not the copy, the similarities between the parties' respective advertising photographs resulted in several years of expensive litigation, including two trips to the Ninth Circuit.

The risks associated with realism, accuracy and applying the Holmes maxim are also seen in *Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.*;¹⁸⁶ a decision that is not about photographs or representational paintings, but exact digital models of Toyotas that were used on the company's website and in other media. According to the court, these digital models were superior to photographs because:

[w]ith a few clicks of a computer mouse, the advertiser can change the color of the car, its surroundings, and even edit its physical dimensions to portray changes in vehicle styling; before this innovation, advertisers had to conduct new photo shoots of whole fleets of vehicles each time the manufacturer made even a small design change to a car or truck.¹⁸⁷

Meshwerks went through the painstaking and precise digital modeling process to create two and three-dimensional wire-frame depictions of the Toyotas that appeared in three dimensions on screen.¹⁸⁸ The depictions were completely unadorned.¹⁸⁹ They were used by the several defendants for advertisements in print, online, and television media.¹⁹⁰ Once the defendants started using these depictions in ways alleged to be outside the scope of the Meshwerks' contract, it sued for copyright infringement.¹⁹¹ The defendants moved for summary judgment, arguing that plaintiff's wire-frame models lacked sufficient originality to be protected by copyright.¹⁹² The trial court granted summary judgment for the defendants and the court of appeals affirmed, saying that:

we think Meshwerks' models are not so much independent creations as (very good) copies of Toyota's vehicles. . . . [they] depict nothing more than unadorned Toyota vehicles

¹⁸⁵ See *Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.*, 528 F.3d 1258, 1269 (10th Cir. 2008).

¹⁸⁶ *Id.* at 1260.

¹⁸⁷ *Id.*

¹⁸⁸ *Id.* at 1261.

¹⁸⁹ *Id.* at 1260–61.

¹⁹⁰ *Id.* at 1261.

¹⁹¹ *Id.* at 1261–62.

¹⁹² *Id.* at 1261.

– the car as car. And the unequivocal lesson from *Feist* is that works are not copyrightable to the extent they do not involve any expression apart from the raw facts in the world. . . . [I]n short, its models reflect none of the decisions that can make depictions of things or facts in the world, whether Oscar Wilde or a Toyota Camry, new expressions subject to copyright protection.¹⁹³

This is a close case. Toyota and its advertising agency got away with using Meshwerks' depiction of the vehicles (copying the copies) instead of doing new digital model versions of the cars for advertising purposes (copying the original). Although the court of appeals emphasized that digital technology can be employed to create new expression that is fully protected by copyright,¹⁹⁴ it also noted that the plaintiff's digital models depicted no more than vehicles as vehicles and that the "designs of the vehicles . . . owe their origins to Toyota, not to Meshwerks, and so we are unable to reward Meshwerks' digital wire-frame models, no doubt the product of significant labor, skill, and judgment, with copyright protection."¹⁹⁵

The court did not try to distinguish cases in which defendants used plaintiffs' photographs in ways outside the scope of any express or implied license were held liable for infringement,¹⁹⁶ or at least had to defend on the merits.¹⁹⁷ Perhaps the critical difference is that Meshwerks' digital models were not copyrightable, while the plaintiffs' photographs in those other cases were found to be copyrightable even though they depicted defendants' products. Moreover, the digital models were exact copies of objects that are not copyrightable.

The *Meshwerks* decision raises the issue of whether the representational depiction of a non-copyrightable object is entitled to copyright protection. Is the depiction – whether a photograph, a digital model, or an otherwise exact reproduction – a derivative work? The legislative history accompanying the Copyright Act of 1976 says that the preexisting work, that is the basis for a derivative work, must come with the general subject matter of copyright as set forth in § 102,¹⁹⁸ but the

¹⁹³ *Id.* at 1264–65.

¹⁹⁴ *Id.*

¹⁹⁵ *Id.* at 1270. The court noted earlier in its opinion, a key point underscored by the Supreme Court in *Feist*: in assessing originality, one looks "only at the final *product*, not the process, and the fact that intensive, skillful, and even creative labor is invested in the process of creating a product does not guarantee its copyrightability." *Id.* at 1268 (citing *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 359–60 (1991)).

¹⁹⁶ *SHL Imaging, Inc. v. Artisan House, Inc.*, 117 F. Supp. 2d 301, 303 (S.D.N.Y. 2000) (holding plaintiff's photographs of defendant's mirrored picture frames were copyrightable, were not works for hire, and defendant's use of them exceeded any license).

¹⁹⁷ *Schrock v. Learning Curve Int'l, Inc.*, 586 F.3d 513, 515–16 (7th Cir. 2009) (reversing summary judgment for defendants reversed because the plaintiff's photos were copyrightable, and it was necessary to determine the scope of the contractual understandings between the parties).

¹⁹⁸ H.R. REP. NO. 94-1476, at 57 (1976).

characterization of the rendition as a derivative work does not make a difference in deciding whether the rendition is copyrightable. The originality standard applies regardless.¹⁹⁹ As stated in the beginning of this subsection, it is risky to copy or use without permission another creator's highly representational and accurate work, like a photograph, even if that photograph is ordinary.²⁰⁰

D. It is always risky to borrow, adapt, or otherwise use another author's characters.

Characters, if sufficiently developed, can be protected by copyright apart from the story in which they appear.²⁰¹ In addition, it is common for authors to use their characters in sequels and prequels. For example, Ian Fleming's James Bond – Agent 007 – has been the central character in seventeen novels and stories, starting with *Casino Royale*, and concluding with *Octopussy* and *The Living Daylights*. The sixteen novels and stories published after *Casino Royale* that feature Bond are derivative from that first novel.²⁰² Not surprisingly, litigation often results from the unauthorized use of well-developed, copyrighted characters. There have been victories for authors against the creators of works which might not otherwise infringe their published works but for the unauthorized use of their characters. There also have been unsuccessful efforts to enforce copyrights to characters which had passed into the public domain.²⁰³

An illustration of a successful effort to block the unauthorized use of copyrighted characters is *Anderson v. Stallone*.²⁰⁴ Anderson wrote a thirty-one-page treatment using Stallone's characters Rocky, Adrienne, Apollo Creed, Clubber Lang, and Paulie after seeing the movie "Rocky III."²⁰⁵ He sent his treatment to Stallone, hoping that it would be turned into another blockbuster.²⁰⁶ Stallone's "Rocky IV" was subsequently released, and it was a big hit. Anderson thought that the story line for this movie was similar to

¹⁹⁹ Cf. JOYCE ET AL., *supra* note 3, at 234–35 n.11.

²⁰⁰ See *supra* note 143.

²⁰¹ This includes literary characters and characters depicted in comics, cartoons and other graphic works. See, e.g., *Gaiman v. McFarlane*, 360 F.3d 644, 661 (7th Cir. 2004) (holding characters in graphic story entitled to copyright protection); *Silverman v. CBS, Inc.*, 870 F.2d 40, 42 (2d Cir. 1989) (holding Amos 'n' Andy characters were copyrightable as developed in radio scripts); *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930) (Learned Hand's often quoted statement about well-developed characters being copyrightable but holding that the plaintiff's characters were not adequately developed); *King Features Syndicate v. Fleischer*, 299 F. 533, 538 (2d Cir. 1924) (holding comic book characters sufficiently developed for copyright protection);

²⁰² See *Klinger v. Conan Doyle Estate, Ltd.*, 755 F.3d 496, 501 (7th Cir. 2014); *Silverman*, 870 F.2d at 49–50.

²⁰³ See generally Scott Locke, *Parallel Novels and the Reimagining of Literary Notables by Follow-On Authors: Copyright Issues When Characters are First Created by Others*, 17 CHI.-KENT J. INTEL. PROP. 271 (2017).

²⁰⁴ 11 U.S.P.Q.2d 1161 (C.D. Cal. 1989).

²⁰⁵ *Id.* at 1162.

²⁰⁶ See *id.*

the treatment he submitted, but was not compensated for this use of his treatment, therefore he sued for infringement.²⁰⁷ Stallone defended by asserting that his “Rocky IV” was not substantially similar to Anderson’s treatment, and he also counterclaimed for copyright infringement, alleging that Anderson had created an unauthorized derivative work by basing his treatment on Stallone’s copyrightable characters without permission.²⁰⁸ The court ruled for Stallone and MGM, holding that Anderson’s treatment was not substantially similar to “Rocky IV,”²⁰⁹ and that his treatment, using Stallone’s copyrighted characters, was an unauthorized derivative work.²¹⁰ After all, the characters that Anderson used without Stallone’s permission permeated his proposed screenplay.²¹¹

The Second Circuit’s influential decision in *Silverman v. CBS, Inc.* concerned the fictional characters Amos and Andy.²¹² The plaintiff wanted to do a musical using these characters but was refused a license by defendant CBS.²¹³ He then sought a declaratory judgment that the Amos ‘n’ Andy radio program broadcast between March 1928 and March 1948 were in the public domain, and that he was free to use the content of those programs including the characters, character names, and plots.²¹⁴ The trial court ruled that the scripts of the pre-1948 programs were no longer protected because the copyrights had not been renewed.²¹⁵ The court of appeals later said that the Amos ‘n’ Andy characters were sufficiently delineated in those old radio scripts “to have been placed in the public domain when the scripts entered the public domain.”²¹⁶ This meant that Silverman could use the characters as developed and depicted in the pre-1948 scripts, but he could not use “any further delineation of the characters contained in the post-1948 radio scripts and the television scripts and programs.”²¹⁷ The appellate court went on to say that “[s]ince only the increments of expression added by the films are protectable, Silverman would infringe only if he copies these protectable increments.”²¹⁸ Still, Silverman could copy any physical features adequately described in the old scripts even though such characteristics were visually

²⁰⁷ *Id.*

²⁰⁸ *Id.* at 1167, 1169–70.

²⁰⁹ *Id.* at 1174.

²¹⁰ *Id.* at 1167.

²¹¹ Most of the opinion focused on the copyrightability of the characters. *Id.* But see generally *Olson v. Nat’l Broad. Co.*, 855 F.2d 1446 (9th Cir. 1988) (holding as unsuccessful, a claim that NBC’s A-Team show had infringed the plaintiff’s work with the court noting that the plaintiff’s lightly sketched characters in his unpublished screenplay were unprotected by copyright).

²¹² *Silverman v. CBS, Inc.*, 870 F.2d 40, 42 (2d Cir. 1989).

²¹³ *Id.* at 43.

²¹⁴ *Id.*

²¹⁵ *Id.*

²¹⁶ *Id.* at 50.

²¹⁷ *Id.*

²¹⁸ *Id.*

apparent in the films and tapes that were still under copyright, such as the fact that Amos and Andy were black.²¹⁹

*Klinger v. Conan Doyle Estate Ltd.*²²⁰ illustrates an unsuccessful effort to block an unlicensed use of well-developed characters. Sir Arthur Conan Doyle's Sherlock Holmes "canon" with Dr. John Watson covers sixty novels and stories, fifty of which were published before 1923 and are in the public domain.²²¹ Conan Doyle's characters, Holmes and Watson, were distinctive and copyrightable from the outset in 1887, and the incremental addition of features by the author in subsequent novels and stories resulted in slightly altered characters that are derivative works.²²² Leslie Klinger wanted to publish an anthology of stories using Holmes and Watson written by modern authors, but he was told by the Conan Doyle Estate that this could not be done without a license to use the characters.²²³ Unwilling to spend \$5000 for this license, Klinger sought a declaratory judgment that he was free to use the materials in the fifty Holmes stories and novels in the public domain (but nothing from the ten works still under copyright) to the extent those works had sufficient originality to be protected.²²⁴

Klinger won, and the Seventh Circuit, citing *Silverman*, said that "when a story falls into the public domain, story elements – including characters covered by the expired copyright – become fair game for follow-on authors."²²⁵ The copyrights on the fifty public domain works "were not extended by virtue of the incremental additions of originality in" the last ten Holmes stories.²²⁶ The court explained that:

The ten Holmes-Watson stories in which copyright persists are derivative from the earlier stories, so only original elements added in the later stories remain protected. The freedom to make new works based on public domain materials ends where the resulting derivative work comes into conflict with a valid copyright, as Klinger acknowledges. But there is no such conflict in this case.²²⁷

The court concluded by stating that "[t]he spectre of perpetual, or at least nearly perpetual, copyright . . . looms, once one realizes that the [Conan] Doyle estate is seeking 135 years (1887-2022) of copyright protection for the

²¹⁹ *Id.* See also *Burroughs v. Metro-Goldwyn-Mayer, Inc.*, 683 F.2d 610 (2d Cir. 1982) (holding that Tarzan, as delineated in Burroughs' public domain works, passed into the public domain along with those stories and does not receive continuing protection from the copyrights on the author's later derivative works).

²²⁰ 755 F.3d 496 (7th Cir. 2014).

²²¹ *Id.* at 497.

²²² *Id.* at 503.

²²³ *Id.* at 497.

²²⁴ *Id.* at 498.

²²⁵ *Id.* at 500.

²²⁶ *Id.* at 501.

²²⁷ *Id.* (internal citations omitted).

character of Sherlock Holmes as depicted in the first Sherlock Holmes story.”²²⁸

So what is the lesson about using someone else’s characters? If the character is well- developed and under copyright, one should not use it without permission of the copyright owner. Here again, the Holmes maxim applies. Follow-on authors run the risk of infringement whenever they use a copyrighted character (copy of the copy). However, even well-developed characters enter the public domain, and if the copyright on a character has expired, then one can freely use that character in his or her fan fiction.²²⁹ If some of the character’s attributes are still under copyright, then the fan fiction author who wants to use that character has to be careful not to copy those aspects of the character’s persona.²³⁰

E. It is risky to reproduce a work in a different medium without permission because the new version might be an unauthorized derivative work.

There are cases in which a preexisting work is sufficiently “recast, transformed, or adapted” by a change in medium so that the resulting secondary work is held to be a copyrightable derivative work.²³¹ However, there are cases in which the change in medium alone did not satisfy the originality requirement.²³² The basic issue is whether, in the course of changing the work from one medium to another, the creator of the secondary work made sufficient expressive choices to warrant copyright protection for the resulting follow-on work.²³³ As in the other scenarios discussed in this Article, this issue comes up with some frequency in copyright infringement

²²⁸ *Id.* at 503. The Holmes estate was successful for many years in securing license fees from other authors wanting to use these characters. For instance, Nicholas Meyer’s novel, *The Seven-Per-Cent Solution: Being a Reprint from the Reminiscences of John H. Watson, M.D.*, published and copyrighted in 1974 and later made into a successful motion picture, used Holmes and other characters such as Professor Moriarty, Watson, and Mycroft Holmes with the permission of Baskerville Investments, Ltd.

²²⁹ See also *Cabell v. Zorro Prods.*, No. 5:15-cv-00771-EJD, 2018 U.S. Dist. LEXIS 80262, *2-4, *41 (N.D. Cal. May 11, 2018) (the author of a 1996 musical titled “Z-The Musical of Zorro,” obtained a declaratory judgment that his work did not infringe the defendant’s copyrights, because the author was able to show that his musical was based entirely on two public domain works with the fictional character Zorro, a 1919 story and a 1920 silent movie).

²³⁰ See generally Locke, *supra* note 203, at 279–82 (discussing the implications of staggering copyright protection in characters).

²³¹ *Schrock v. Learning Curve Int’l, Inc.*, 586 F.3d 513, 518, 522–23 (7th Cir. 2009) (holding that the plaintiff’s photographs of the copyrighted 3-D Thomas & Friends train characters were copyrightable derivative works); *Alfred Bell & Co. v. Catalda Fine Arts Inc.*, 191 F.2d 99, 104 (2d Cir. 1951) (holding mezzotint reproductions of public domain old masters were copyrightable derivative works); *Alva Studios Inc. v. Waininger*, 177 F. Supp. 265 (S.D.N.Y. 1959) (holding reduced-scale reproduction of public domain sculptural work was copyrightable derivative work).

²³² *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068 (9th Cir. 2000) (holding that an advertising photo of a vodka bottle copyrightable but not a derivative work); *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 492 (2d Cir. 1976) (holding plastic reproduction of public domain cast-iron Uncle Sam bank was not a copyrightable derivative work); *Bridgeman Art Library, Ltd. v. Corel Corp.*, 25 F. Supp. 2d 421, 427 (S.D.N.Y. 1998) (holding that photos and digital transparencies of public domain old masters lacked sufficient originality and were not copyrightable derivative works).

²³³ *Schrock*, 586 F.3d at 521; JOYCE ET AL., *supra* note 3, at 235 n.12.

litigation, and it also presents variations on the Holmes maxim about not copying the copy, although it is okay to copy the original.

For example, a photograph of a three-dimensional object reproduces it in two dimensions. Is that photograph copyrightable? Is that photo a derivative work? The results are mixed. The Ninth Circuit, in *Ets-Hokin v. Skyy Spirits, Inc.*, said that a photograph of a vodka bottle was not a derivative work after determining that the bottle itself was not copyrightable.²³⁴ The photograph was, however, held to be copyrightable due to the photographer's decisions about lighting, shading, angle, and background.²³⁵ Nevertheless, the court found that the photograph was not infringed by the defendant's photograph of a bottle of the same brand of vodka.²³⁶

Similarly, in *SHL Imaging, Inc. v. Artisan House, Inc.*, the court held that although the plaintiff's photographs of defendant's mirrored frames were copyrightable,²³⁷ they were not derivative works because they merely depicted the frames and did "not recast, adapt or transform any authorship that may exist in the frames."²³⁸ Finally, Bridgeman Art Library's color transparencies and digital images of public domain works of art were not copyrightable because they reproduced the works with absolute fidelity and without the spark of originality necessary for protection.²³⁹ In contrast, after explaining that copyrightable original expression in a photograph is generally found in the photographer's rendition of the subject matter,²⁴⁰ the Seventh Circuit in *Schrock v. Learning Curve International, Inc.* said that "[i]f the photographer's rendition of a copyrighted work varies enough from the underlying work to enable the photograph to be distinguished from the underlying work (aside from the obvious shift from three dimensions to two), then the photograph contains sufficient incremental originality to qualify for copyright" as a derivative work.²⁴¹

The lesson here is the same as expressed earlier: the use of another's photograph without permission will often give rise to litigation.²⁴² In addition, even if the ultimate determination is that the copyright on the copied photograph is either invalid or not infringed, the defendant might have

²³⁴ *Ets-Hokin*, 225 F.3d at 1081.

²³⁵ *Id.* at 1077–82.

²³⁶ *Ets-Hokin v. Skyy Spirits, Inc.*, 323 F.3d 763, 766 (9th Cir. 2003).

²³⁷ *SHL Imaging, Inc. v. Artisan House, Inc.*, 117 F. Supp. 2d 301, 310–11 (S.D.N.Y. 2000).

²³⁸ *Id.* at 306.

²³⁹ *Bridgeman Art Library Ltd. v. Corel Corp.*, 36 F. Supp. 2d 191, 195, 197 (S.D.N.Y. 1999). See also *Meshwerks, Inc. v. Toyota Motor Sales, Inc.*, 528 F.3d 1258, 1267–69 (10th Cir. 2008) (citing to *Bridgeman*, while explaining why the plaintiff's digital models of Toyota vehicles were not copyrightable); *We Shall Overcome Found. v. Richmond Org.*, No. 16cv2725(DLC), 2017 U.S. Dist. LEXIS 146228 (S.D.N.Y. 2017); *JOYCE ET AL.*, *supra* note 3, at 234.

²⁴⁰ *Schrock v. Learning Curve Int'l, Inc.*, 586 F.3d 513, 519 (7th Cir. 2009).

²⁴¹ *Id.* at 522. The court determined that the plaintiff's advertising photos of the "Thomas & Friends" toys, though accurate, contained minimally sufficient variation in angle, perspective, lighting, and dimension to be distinguishable from the underlying toys and thus not slavish copies. *Id.*

²⁴² See *supra* Section II.C.

avoided litigation by taking its own photographs instead of using the plaintiff's photo. In a nutshell, it is better to photograph the original object instead of using another's photograph (copy) of that object.

A variation on this theme is seen in *Pickett v. Prince*.²⁴³ During a substantial period of his career, the late entertainer Prince referred to himself by an unpronounceable symbol that resembled the Egyptian hieroglyph, *ankh*, and he licensed the use of this copyrightable symbol on jewelry, clothing, and musical instruments.²⁴⁴ The plaintiff, Ferdinand Pickett, made a guitar in the shape of the Prince symbol, showed this instrument to Prince, and ultimately sued for infringement after Prince appeared in public playing a similar guitar without Pickett's permission.²⁴⁵ Prince counterclaimed for copyright infringement and won.²⁴⁶ The court said that:

Pickett could not make a derivative work based on the Prince symbol without Prince's authorization even if Pickett's guitar had a smidgeon of originality. This is a sensible result. A derivative work is, by definition, bound to be very similar to the original. Concentrating the right to make derivative works in the owner of the original work prevents what might otherwise be an endless series of infringement suits posing insoluble difficulties of proof.²⁴⁷

Another variation on the risks involved with changing mediums is the repurposing of a work of authorship for a new market. The litigation in *Lee v. A.R.T. Company* is a good example.²⁴⁸ The defendant bought the plaintiff's copyrighted note cards and small lithographs, mounted them on ceramic tiles, covered the tiles with a clear epoxy resin, and then sold the tiles.²⁴⁹ This repurposing did not implicate the reproduction right, and due to the first sale doctrine, reselling the cards is not actionable.²⁵⁰ The plaintiff sued for violation of her right to prepare derivative works.²⁵¹ The trial court and the United States Court of Appeals for the Seventh Circuit concluded that mounting the plaintiff's works on the tiles did not implicate the adaptation right because the note cards were not recast, adapted, or transformed within the definition of derivative works in the Copyright Act.²⁵² According to the appellate court, putting the note cards on the tile was no different "from

²⁴³ See generally 207 F.3d 402 (7th Cir. 2000).

²⁴⁴ *Id.* at 403–04.

²⁴⁵ *Id.* at 404.

²⁴⁶ *Id.*

²⁴⁷ *Id.* at 406.

²⁴⁸ See generally 125 F.3d 580 (7th Cir. 1997).

²⁴⁹ *Id.* at 580.

²⁵⁰ *Id.* at 581. See also 17 U.S.C. §§ 106(1) & 109(a) (2018).

²⁵¹ *Lee*, 125 F.3d at 580. The plaintiff could not claim a violation of her reproduction right since the note cards were not copied, and under the first sale doctrine, the defendant had a right to resell the cards it had purchased. *Id.* at 581.

²⁵² *Id.* at 582.

displaying a painting in a frame or placing a medallion in a velvet case. No one believes that a museum violates § 106(2) every time it changes the frame of a painting that is still under copyright.”²⁵³

There are, however, decisions in other circuits that treat this kind of repurposing as within the copyright owner’s right to prepare derivative works.²⁵⁴ While one court held that adding advertising material to the text of a book is infringing,²⁵⁵ another court held that adding advertising to the blank “lead-in” on purchased copies of videocassettes was not infringing.²⁵⁶ One of the arguments in support of treating this kind of repurposing as within the right to prepare derivative works is that a transformation within the statute’s definition has occurred because a new work has been created for a new market.²⁵⁷

The generic issue continues to generate litigation. For example, do I infringe the copyright on a magazine like *Sports Illustrated* if I purchase copies featuring front cover photos of athletes who competed for the University of Georgia, like Matthew Stafford, Hines Ward, Champ Bailey, and Bubba Watson, remove the covers, mount the covers on plaques, and then sell the plaques? I think I will be okay if I am sued in the Seventh Circuit, but I might be in trouble for violating *Sports Illustrated’s* right to prepare derivative works elsewhere.²⁵⁸ One court recently stated that separating the cover from the magazine and cutting the cover to fit the plaque substantially alters the magazine, and because of these alterations, the first sale doctrine does not apply.²⁵⁹ Fortunately, I live in Athens, Georgia and there is Eleventh Circuit authority that I can rely upon if I am sued by *Sports Illustrated* in the United States District Court for the Middle District of Georgia.²⁶⁰

²⁵³ *Id.* at 581. See JOYCE ET AL., *supra* note 3, at 490 n.4–5

²⁵⁴ *Munoz v. Albuquerque A.R.T. Co.*, No. 93-35743, 1994 U.S. App. LEXIS 29405, *2–3 (9th Cir. Oct. 19, 1994); *Mirage Editions, Inc. v. Albuquerque A.R.T. Co.*, 856 F.2d 1341, 1343 (9th Cir. 1988).

²⁵⁵ *Nat’l Bank of Commerce v. Shaklee Corp.*, 503 F. Supp. 533, 544 (W.D. Tex. 1980).

²⁵⁶ *Paramount Pictures Corp. v. Video Broad. Sys., Inc.*, 724 F. Supp. 808, 821 (D. Kan. 1989).

²⁵⁷ PAUL GOLDSTEIN, COPYRIGHT: PRINCIPLES, LAW AND PRACTICE § 5.3.1 (2d ed. 1996). *But see* *Worlds of Wonder, Inc. v. Veritel Learning Sys., Inc.*, 658 F. Supp. 351, 355–56 (N.D. Tex. 1986) (plaintiff made a doll into which tapes were inserted whereby the doll would tell stories while the eyes, nose, and mouth of the doll moved—in essence, the doll was animated—defendants were held to have created an infringing derivative work by making compatible tapes telling different stories while animating the doll’s features); *Worlds of Wonder, Inc. v. Vector Intercontinental, Inc.* 653 F. Supp. 135, 140 (N.D. Ohio 1986); WILLIAM F. PATRY, COPYRIGHT LAW AND PRACTICE 823–24 (BNA Books 1994).

²⁵⁸ *See, e.g., Rosebud Entm’t v. Prof’l Laminating*, 958 F. Supp. 2d 600, 608 (D. Md. 2013) (finding that a company selling customized laminated plaques containing pages from newspaper and magazine articles held to infringed); *Greenwich Workshop Inc. v. Timber Creations, Inc.* 932 F. Supp. 1210, 1215 (C.D. Cal. 1996) (removing reduced scale version of plaintiff’s copyrighted artwork from plaintiff’s book infringing plaintiff’s rights).

²⁵⁹ *Rosebud Entm’t*, 958 F. Supp. 2d at 608. *But see* *Allison v. Vintage Sports Plaques*, 136 F.3d 1443, 1444, 1451 (11th Cir. 1998) (permitting defendant to purchase trading cards, mount, and frame them without alteration on an acrylic sheet pursuant to first sale doctrine).

²⁶⁰ *Allison*, 136 F.3d at 1451.

F. The risks of translating, colorizing, and digitizing without permission.

Prior to 1870, the copyright statute did not grant authors the right to control translations of their works.²⁶¹ In Harriet Beecher Stowe's unsuccessful pre-Civil War action, against an unauthorized German language translation of her influential novel, *Uncle Tom's Cabin*, the court said that the translation did not infringe because the defendant did not use the same "language in which the conceptions of the author are clothed."²⁶² Amendments to the Copyright Act in 1870 established that the translation of a literary work from one language to another is a derivative work.²⁶³ Accordingly, if you want to translate the latest John Grisham novel into another language, you will need the permission of the copyright owner. On the other hand, a person can translate a public domain novel by Jack London into another language without needing anyone's permission, but the copyright on that translation will be limited to the expressive choices that owe their origin to the translator.²⁶⁴ Thus, a person's copyrightable translation of *The Call of the Wild* to Japanese would not bar another person from doing a Japanese translation of that novel, so long as he or she did not copy the first translator's version.²⁶⁵ The second translator needs to translate the original, not the first translator's copy.

A recent dispute over a translation of a public domain work is *Olivares v. University of Chicago*.²⁶⁶ At issue were stories written in 1637 by Zayas, a Spanish author, where the plaintiff created another Spanish edition of these *novelas orosas* in 2000 after making changes to the original punctuation and paragraph breaks.²⁶⁷ The University of Chicago published an English translation of selected stories by Zayas including four from the *novelas orosas*.²⁶⁸ The editors, who did the translations for the University of Chicago, used Oliveras' 2000 edition of the stories and this resulted in Oliveras' infringement claim that these editors copied his copy instead of copying the original Zayas work.²⁶⁹ The defendants challenged the copyrightability of Oliveras' 2000 edition of the *novelas orosas*, alleging that his corrections of the original author's punctuation and paragraph breaks were not sufficiently creative to be entitled to copyright protection.²⁷⁰ The court

²⁶¹ See Joyce, *supra* note 3, at 488 n.1.

²⁶² *Stowe v. Thomas*, 23 F. Cas. 201, 207 (C.C.E.D. Pa. 1853) (No. 13,514).

²⁶³ 17 U.S.C. § 101 (2018) (definition of "derivative work"). Congress amended the Copyright Act in 1870 to give authors the right to prevent unauthorized translations of their works. This was in large part due to the unauthorized translation of Harriet Beecher Stowe's novel. See Joyce, *supra* note 3, at 488 n.1.

²⁶⁴ See generally *Merkos L'Inyonei Chinuch, Inc. v. Otsar Sifrei Lubavitch*, 312 F.3d 94 (2d Cir. 2002) (holding that a Jewish prayerbook translated from Hebrew to English was copyrightable and infringed). See also 17 U.S.C. § 103(b).

²⁶⁵ LEAFFER, *supra* note 13, at 64–65.

²⁶⁶ See generally 213 F. Supp. 3d 757 (M.D.N.C. 2016).

²⁶⁷ *Id.* at 762.

²⁶⁸ *Id.*

²⁶⁹ *Id.*

²⁷⁰ *Id.* at 767–68.

denied the defendants' motion for summary judgment, stating there was a genuine issue of material fact over the originality of the plaintiff's punctuation corrections and paragraph breaks.²⁷¹

What about taking a movie shot in black and white, and converting it to color? Does the colorizer need permission of the copyright owner? If there is permission, is the resulting colorized version copyrightable? Colorizing a movie seems analogous to translating a book, and it was fairly common in the 1980s. The Copyright Office announced in 1987 that it would permit copyright registration of colorized versions of black and white motion pictures as derivative works if several requirements were satisfied.²⁷² The announcement acknowledged that mere variations in coloring were not subject to copyright,²⁷³ but stated that there might be sufficient creative choices from an extensive color inventory made by the colorizer that would modify the appearance of the film sufficiently, and thus satisfy the "modicum of creativity" requirement of the originality standard. The announcement emphasized that the colorizing had to be done by humans, and that colorizing a public domain black-and-white film would not affect the unprotected status of that film nor prevent another colorizer from modifying that film.²⁷⁴ To paraphrase the famous maxim, the second colorizer could copy the "original" public domain black-and-white movie, but could not copy the first colorizer's "copy" of the original movie.²⁷⁵

Given the treatment of translations and colorized black and white films as derivative works, what is the appropriate classification for an eBook version of a traditional hard copy literary work? What about the remastering of an old sound recording? Are the new "versions" copyrightable? Are they derivative works? Do you need permission of the copyright owner before making the eBook or the remastered digital version of the analog recording? The results are mixed.

In *Peter Mayer Publishers, Inc. v. Shilovskaya*, the court held that the conversion of a print version of a novel into an electronic version implicates the reproduction right, but the resulting electronic version is not a derivative work.²⁷⁶ This means that the reproduction right encompasses a digital version of a work of authorship, however the resulting eBook version is not protectable as a derivative work. In a nutshell, making the eBook version copies the copy, but assuming permission to reproduce the work in digital

²⁷¹ *Id.* at 769.

²⁷² *See generally* 37 C.F.R. § 202 (2018); 52 Fed. Reg. 119 (June 22, 1987).

²⁷³ 37 C.F.R. § 202.1(a).

²⁷⁴ *See generally* 37 C.F.R. § 202; 52 Fed. Reg. 119. *See also* LEAFFER, *supra* note 13, at 68–69. On the other hand, the Copyright Office will not, absent creative input, register a conversion from analog to digital format such as transferring a movie from VHS to DVD as a derivative work. *Compendium* § 313.2

²⁷⁵ *See* LEAFFER, *supra* note 13, at 68–69.

²⁷⁶ *Peter Mayers Publishers, Inc. v. Shilovskaya*, 11 F. Supp. 3d 421, 428–29 (S.D.N.Y. 2014).

form, there is nothing sufficiently creative about making an electronic version that warrants treating the digital version as a derivative work.

In the *Peter Mayer* case, the plaintiff possessed the right to publish an English language version of a Russian novel in print format, and sought a declaratory judgment that this right also included publishing the novel in eBook form, after permission to do so was refused by the licensor/copyright owner.²⁷⁷ The copyright owner contended that the plaintiff's right to publish an English translation of the novel in print did not extend to publishing an eBook version, because that would be an entirely new derivative work.²⁷⁸ The court said that the statute did not give the plaintiff "the right to use the [w]ork to create a new work in an entirely different medium of expression."²⁷⁹ The court disagreed, saying that the forms of all works listed in the Copyright Act's definition of "derivative work" reference changes in both the content and medium of the work, and it noted that a translation "requires the selection of new words, phrases, and idioms that are not part of the original work."²⁸⁰ The court also noted that a change in medium alone does not generally require sufficient originality to justify derivative work protection for the work embodied in the new medium.²⁸¹ While an eBook is a separate medium from a print version, the process of transferring the work from print to eBook involves "nothing more than rote copying," so it lacked sufficient originality and could not constitute a derivative work.²⁸² The unauthorized conversion of a print version translation of the novel into eBook format would infringe the reproduction right in the novel, but the eBook version is not a derivative work because scanning or digitizing the novel involves no authorship.²⁸³

Sound recordings fixed prior to February 15, 1972, were not covered by the Copyright Act of 1909. Instead, these old analog format recordings were protected against reproduction, if at all, by common law copyright and/or state anti-record piracy statutes.²⁸⁴ It is common to remaster these

²⁷⁷ *Id.* at 423–24.

²⁷⁸ *Id.* at 424. A translation falls within the definition of derivative work. 17 U.S.C. § 201 (2018).

²⁷⁹ *Peter Mayers*, 11 F. Supp. 3d at 422. The novel, *The Master and Margarita*, had fallen into the public domain in the United States because of noncompliance with the formalities of our law. The plaintiff's predecessor commissioned the publication of an English translation while the work was unprotected by copyright. The novel's copyright was restored in 1996, and the plaintiff, as a reliance party, was able to continue to exploit the work so long as it paid reasonable compensation to the defendants. *See id.*

²⁸⁰ *Id.* at 427.

²⁸¹ *Id.* (citing *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 910 (2d Cir. 1980); *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 491 (2d Cir. 1976)).

²⁸² *Id.* at 428. The Copyright Office has stated that photocopying, scanning, or digitizing a literary work is a mere copy not entitled to copyright protection absent some additional authorship. *Compendium* § 313.4(A).

²⁸³ 17 U.S.C. § 106(1). *But see* *Authors Guild, Inc. v. HathiTrust*, 755 F.3d 87, 95 (2d Cir. 2014) (holding that the recasting of a novel as an ebook is an example of a derivative work).

²⁸⁴ *See generally* Joyce, *supra* note 3, at 205–06 (discussing the history of U.S. protection for sound recordings). The Music Modernization Act, which was signed into law on October 11, 2018, extended copyright protection to pre-1972 sound recordings. *See* Kevin J. Hickey, *The Music Modernization Act*:

analog recordings into new formats. The question is whether a sound engineer's remastering of an old recording is a copyrightable derivative work. The answer is yes, if that engineer subjectively and artistically alters the work in certain ways.²⁸⁵ Even though the Copyright Office has said that dubbing a sound recording from a preexisting recording is a mere copy that is not copyrightable absent any additional authorship,²⁸⁶ the modification or conversion process with a remastered recording is sometimes more comparable to colorizing a black and white film than it is to digitizing a print version of a book to create an eBook.

The Copyright Office explains in one of its circulars that:

The preexisting recorded sounds must be rearranged, remixed, or otherwise altered in sequence or character, or the recording must contain additional new sounds. The new or revised sounds must contain at least a minimum amount of original sound recording authorship. [This new authorship is the basis for the copyright claim.] Examples of derivative sound recordings include:

- A mashup comprising tracks and sounds from multiple sources.
- Additional tracks added to a previously published album.

Mechanical changes or processes [applied to a sound recording], such as a change in format, declipping, or noise reduction, generally do not contain enough original authorship to warrant registration.²⁸⁷

This Copyright Office Circular was interpreted and applied in *ABS Entertainment, Inc. v. CBS Corporation* in which the Ninth Circuit, reversing a summary judgment favoring CBS, held that remastered pre-1972 sound recordings that had been publicly performed by CBS were not copyrightable derivative works.²⁸⁸ The works in question included recordings by Al Green, Johnny Tillotson, the Everly Brothers, Andy Williams, and Jackie Wilson.²⁸⁹ The basic argument against treating these remastered recordings as copyrightable was that they were simply digital conversions optimized for

Extending Copyright Protection to Pre-1972 Sound Recordings, CRS LEGAL SIDEBAR, Oct. 15, 2018, <https://fas.org/sgp/crs/misc/LSB10181.pdf>.

²⁸⁵ See generally U.S. COPYRIGHT OFFICE CIRCULAR NO. 56, *Copyright Registration for Sound Recordings*.

²⁸⁶ *Compendium* § 313.4(A).

²⁸⁷ *Supra* note 285, at 3-4.

²⁸⁸ *ABS Entm't, Inc. v. CBS Corp.*, 900 F.3d 1113, 1131, 1139 (9th Cir. 2018).

²⁸⁹ *ABS Entm't, Inc. v. CBS Corp.*, No. CV 15-6257 PA (AGRx), 2016 U.S. Dist. LEXIS 71470, at *2-3 (C.D. Cal. May 30, 2016).

digital formats using only mechanical processes.²⁹⁰ In essence, they had not been modified or altered with new sounds.²⁹¹ The lower court said that they had undergone sufficient changes during the remastering process to qualify for copyright protection as derivative works, as evidenced by additional reverberation, different musical keys, altered tempos, different channel assignments, and adjustments in equalization.²⁹² The lower court said that these changes were not merely mechanical, such as trivial modifications to reduce noise and declipping.²⁹³ Rather, the changes constituted creative authorship by sound engineers,²⁹⁴ so the remastered recordings contained copyrightable original expression added during the remastering process.²⁹⁵

The Ninth Circuit reversed, saying that fixing sound defects and making other adjustments during remastering from analog to digital did not result in a new work.²⁹⁶ “Although we do not hold that a remastered sound recording cannot be eligible for derivative work copyright, a digitally remastered sound recording made as a copy of the original analog sound recording will rarely exhibit the necessary originality to qualify for independent copyright protection.”²⁹⁷ Accordingly, both the original pre-1972 recordings and the remastered digital versions remain unprotected by federal copyright law.²⁹⁸

Another relevant decision on remastering and copyright protection is *Capitol Records, Inc. v. Naxos of America, Inc.*, in which the New York Court of Appeals held, on a certified question, that pre-1972 sound recordings were protected from unauthorized duplication under state law even after they had entered the public domain in their country of origin.²⁹⁹ Naxos converted Capitol’s pre-1972 classical music sound recordings from the original shellac

²⁹⁰ *Id.* at *21.

²⁹¹ *Id.* at *21–22.

²⁹² *Id.* at *28–29.

²⁹³ *Id.*

²⁹⁴ *Id.* at *28–29. See also *Pryor v. Jean*, No. CV 13-02867 DDP (AJWx), 2014 U.S. Dist. LEXIS 143515, at *8–9 (C.D. Cal. Oct. 8, 2014) (quoting 1 NIMMER ON COPYRIGHT § 2.10[A][2][b]). But see *Compendium* § 313.2 (stating that the Copyright Office will not register works produced by machine or mechanical process that operates automatically without creative input such as de-clipping or reducing the noise in a pre-existing sound recording or converting it from monaural to stereo).

²⁹⁵ *ABS Entm’t*, 2016 U.S. Dist. LEXIS 71470, at *45.

²⁹⁶ *ABS Entm’t*, 900 F.3d at 1131.

²⁹⁷ *Id.* at 1132 (emphasis removed). Incidentally, in reaching this conclusion, the Ninth Circuit discussed many of the decisions discussed in this Article, including *L. Batlin & Son, Meshwerks, ERG, Durham Industries, Bleistein*, and *Fiest*. *Id.* at 1122–1126.

²⁹⁸ “Th[is] ruling could allow owners of classic recordings by artists like Al Green, the Everly Brothers, Jackie Wilson, and King Floyd to claim royalties under California law and potentially the laws of other states. If the records were covered by federal law [as copyrightable derivative works], the owners of some copyrights [could not] collect compensation when digital services played them.” Anandashankar Mazumdar, *Remastering Oldie Record Doesn’t Make it New, Court Rules*, BLOOMBERG LAW (Aug. 20, 2018, 6:06 PM), https://www.bloomberglaw.com/document/X4NTKA34000000?bna_news_filter=ip-law&jcsearch=BNA%25200000016558fcedd2da377d8ff3f800003#jcite.

²⁹⁹ See generally *Capitol Records, Inc. v. Naxos of Am., Inc.*, 830 N.E.2d 250 (N.Y. Ct. App. 2005) (holding that certain pre-1972 recordings remain protected by state law until Feb. 15, 2067).

format onto compact discs without Capitol's permission.³⁰⁰ In response to Capitol's infringement claim, Naxos argued that it had created a new product,³⁰¹ but the court held that this new product defense failed as a matter of New York law.³⁰²

This result is consistent with the Ninth Circuit's conclusion in *ABS Entertainment* that remastered pre-1972 sound recordings cannot be protected under federal law as derivative works. Naxos copied Capitol's original shellac format sound recordings without permission. However the *Naxos* court did not address whether any original expression was added by Naxos during its remastering process of converting the shellac recordings to compact discs, nor whether any modifications it might have made would have qualified the compact discs for federal protection as derivative works.³⁰³ The *Naxos* court was only addressing whether the conversion of the shellac recordings violated Capitol's reproduction right under New York's common law copyright principles.³⁰⁴ In rejecting Naxos' new product defense, the New York Court of Appeals did not address directly the issue of whether nontrivial changes made during the remastering process might qualify the remastered recording for copyright protection as a derivative work. As noted above, the Ninth Circuit acknowledged that some remastering of old recordings could result in a copyrightable derivative work.³⁰⁵

The case law involving translations fits nicely with the general jurisprudence on derivative works, the right to prepare derivative works, and the Holmes maxim. The Copyright Act's definition includes translations, but for perhaps trivial changes with punctuation and paragraph breaks, copyright's originality standard is easily satisfied. If a protected work is being translated, the translator/editor needs permission of the copyright owner. If the original work being translated is in the public domain, then the translator/editor needs to work on that original work and not another's translation: to copy the original and not the copy. Colorization has fallen out of favor, but the digitization of works of authorship has not. Digitizing a book implicates the reproduction right but the resulting eBook will not be treated as a derivative work since it lacks distinguishable variations from the original work, notwithstanding the change of medium. On the other hand, the digitization of pre-1972 analog sound recordings, unprotected by federal copyright, can result in a protectable derivative work if the work of the sound engineers and technicians evidences sufficient creativity in the change of medium from vinyl or shellac to digital format. In regard to post-1972 sound

³⁰⁰ *Id.* at 253.

³⁰¹ *Id.* at 267.

³⁰² *Id.*

³⁰³ *Cf.* *ABS Entm't, Inc. v. CBS Corp.*, No. CV 15-6257 PA (AGRx), 2016 U.S. Dist. LEXIS 71470, at *27 (C.D. Cal. May 30, 2016).

³⁰⁴ *Naxos*, 830 N.E.2d at 252.

³⁰⁵ *See supra* note 296 and accompanying text.

recordings, which are protected by copyright, the digitizer needs permission of the copyright owner because converting the sound recording to digital format implicates the reproduction right and perhaps the right to prepare derivative works as well.

G. The Holmes maxim, Learned Hand, historical fiction, and the risks of copying the fiction instead of the history.

Sheldon v. Metro-Goldwyn Pictures Corp. is a classic Learned Hand copyright infringement opinion,³⁰⁶ often paired with his earlier opinion in *Nichols v. Universal Pictures*.³⁰⁷ Judge Hand's careful approach in these opinions, deciding whether or not there is substantial similarity of protected expression between the parties' works, remains the model for copyright infringement opinions today. He discusses the plots, story lines, and characters of the respective works; determines what is and is not protected by copyright in the plaintiff's work; states basic copyright principles; and explains whether the defendants copied too much of the plaintiffs' protected expression.³⁰⁸

What ties Learned Hand's *Sheldon* opinion to the Holmes maxim about copying the original but not the copy is that the plaintiff's play, *Dishonored Lady*, and defendant's movie, *Letty Lynton*, were both based on a celebrated and highly publicized real-life soap opera involving a murder, the arrest of a Scottish socialite named Madeleine Cary, her trial, and her acquittal.³⁰⁹ Although the actual events occurred in the 1850s, they provided the skeleton for plaintiff Sheldon's play that was published in 1925.³¹⁰ A novel based on these events, titled *Letty Lynton*, was written by Lowndes and published in 1927.³¹¹ Common to all was "the acquittal of a wanton young woman, who to extricate herself from an amour that stood in the way of a respectable marriage, poisoned her lover."³¹² Defendant MGM negotiated with the plaintiff about using *Dishonored Lady*, but things did not work out due to concerns that it would be regarded as obscene by Will Hays. MGM turned to Lowndes and his *Letty Lynton* novel.³¹³ Litigation ensued, with the court ultimately holding that MGM's movie infringed the plaintiff's play; it

³⁰⁶ See generally *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49 (2d Cir. 1936). Later, the Supreme Court also announced an influential copyright law decision in which it upheld the apportionment of defendant's profits in the calculation of the award of damages to Sheldon, the playwright whose work had been infringed by the defendant's movie. The Court recognized that a substantial percentage of the defendant's profits were attributable to the star power of the actors, the director's talents, and other factors, not just the plaintiff's play. *Sheldon v. Metro-Goldwyn Pictures Corp.*, 309 U.S. 390, 407-09 (1940).

³⁰⁷ See generally 45 F.2d 119 (2d Cir. 1930). See also JOYCE ET AL., *supra* note 3, at 670-75, 676-78 n.2-6.

³⁰⁸ See JOYCE ET AL., *supra* note 3, at 663-69, 676-78 n.4-6.

³⁰⁹ See generally *Sheldon*, 81 F.2d 49.

³¹⁰ *Id.* at 49-50.

³¹¹ *Id.* at 49, 51.

³¹² *Id.* at 50.

³¹³ *Id.* at 52.

had taken too much of the plaintiff's *Dishonored Lady* copy, instead sticking with the Madeleine Cary original "true to life" soap opera. Hand stated:

Borrowed the work must indeed not be, for a plagiarist is not himself pro tanto an "author"; but if by some magic a man who had never known it were to compose anew Keats's Ode on a Grecian Urn, he would be an "author," and, if he copyrighted it, others might not copy that poem, though they might of course copy Keats's.³¹⁴

That is another way to say that you are free to copy the original, but you should not copy the copy.

Another decision of this genre involved the cause of the explosion and destruction of the German zeppelin Hindenburg while landing at Lakehurst, New Jersey, on May 6, 1937. This well-publicized disaster was investigated by both the FBI and German authorities and widely covered in the press on both sides of the Atlantic. Sabotage was never ruled out. For this Article's purposes, the disaster was also the subject of copyright infringement litigation in the late 1970s concerning a movie that allegedly used too much of plaintiff A.A. Hoehling's 1962 book, *Who Destroyed the Hindenburg*, instead of relying on the original sources:³¹⁵ copying his copy instead of relying on the historical record (the original).³¹⁶

Hoehling's book, written in an "objective, reportorial style[.]" espoused sabotage as the cause of the disaster.³¹⁷ The official investigations in the United States and in Nazi Germany also raised the possibility of deliberate destruction, as did an unpublished movie treatment written in 1957 by Nelson Gidding.³¹⁸ John Toland published a book in 1957 with a chapter on the Hindenburg, and Dale Titler devoted a chapter to the disaster in a 1962 book.³¹⁹ The sabotage theory did not originate with Hoehling.³²⁰ Central to the ensuing litigation was a 1972 book by Michael Mooney, who admitted to using Hoehling's book in writing his spin on the catastrophe.³²¹ Mooney's book was more literary than historical.³²² Universal City Studios bought movie rights to Mooney's book, and the director, Robert Wise, hired Giddings – who had worked on the topic 20 years earlier – to do the final screenplay.³²³

³¹⁴ *Id.* at 54 (citing *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 249 (1903)).

³¹⁵ *See generally* *Hoehling v. Universal City Studios*, 618 F.2d 972 (2d Cir. 1980).

³¹⁶ *Id.* at 977–78.

³¹⁷ *Id.* at 975.

³¹⁸ *Id.*

³¹⁹ *Id.*

³²⁰ *Id.* at 979.

³²¹ *Id.* at 976.

³²² *Id.*

³²³ *Id.* at 975.

Hoehling tried to block the movie, and ultimately lost on a summary judgment motion granted for the defendants.³²⁴

The court's opinion, written by Judge Kaufman, followed the Learned Hand approach by discussing the historical accounts of the great dirigible and the tragedy; the multiple accounts published in the late 1930s about the Hindenburg's voyage and the explosion in New Jersey; the several books and chapters written in the 1950s and 60s, including the Hoehling and Mooney versions; and the movie itself.³²⁵ The plaintiff's principal claim was that Universal and Mooney had copied his book's sabotage plot.³²⁶ After stating that such a theory, even if original to Hoehling, was not protected by copyright,³²⁷ the court concluded that:

[a]ll of Hoehling's allegations of copying [] encompass material that is non- copyrightable as a matter of law, rendering summary judgment entirely appropriate. . . . In works devoted to historical subjects, it is our view that a second author may make significant use of prior work, so long as he does not bodily appropriate the expression of another. . . . Knowledge is expanded [] by granting new authors of historical works a relatively free hand to build upon the work of their predecessors.³²⁸

In short, when the underlying topic is factual, like an historical event or the news, it is possible for subsequent authors to build upon the works of their predecessors (use another's copy) instead of relying solely on original sources.³²⁹

A third example of this variation on the Holmes maxim in the context of historical accounts is found in *Jean-Etienne De Becdelievre v. Anastasia Musical*.³³⁰ The underlying tale involves the daughter of the Tsar, Grand Duchess Anastasia Romanov. She was rumored to have fled to Europe after surviving the 1918 assassination of the Tsar and his family. During the 1920s and 1930s, several women came forward claiming to be the Grand Duchess in hopes of claiming some of the fortune that the deceased Tsar had deposited in foreign banks.³³¹ Members of the Romanov family in exile always denounced these claimants as imposters.³³² One of these imposters named Anna Anderson inspired a 1940 play by a French author, Marcelle Maurette,

³²⁴ *Id.* at 977.

³²⁵ *Id.* at 978–79.

³²⁶ *Id.* at 977.

³²⁷ *Id.* at 977–79.

³²⁸ *Id.*

³²⁹ “As [Hoehling] illustrates, absent wholesale usurpation of another's expression, claims of copyright infringement when works of history are at issue are rarely successful.” *Id.* at 974.

³³⁰ See generally No. 16 Civ. 9471(AKH), 2018 U.S. Dist. LEXIS 55815 (S.D.N.Y. Apr. 2, 2018).

³³¹ *Id.* at *7–8, *10–11.

³³² *Id.* at *8.

that presented a fictionalized version of some of these events.³³³ With this author's permission, the play was translated into English in 1952 by Guy Bolton.³³⁴ This play and translation were licensed to 20th Century Fox in 1956 to be made into the movie "Anastasia," starring Ingrid Bergman in the title role.³³⁵ Fox did an animated version of this work in 1997, and there was an authorized *Anastasia on Ice* in 1996-97.³³⁶

All of this was known to the defendant, Terrence McNally, who wrote a musical called "Anastasia" that premiered in 2017.³³⁷ He was able to get a license from Fox, but not from the plaintiffs who held the rights to the play by Maurette and the translation by Bolton.³³⁸ They sued for infringement, alleging that the musical was an unauthorized derivative work.³³⁹ McNally moved for summary judgment, and the court had to determine whether there was substantial similarity of protected expression after extracting the non-copyrightable historical facts from the respective works.³⁴⁰ Sticking with the basic format of the opinions in *Sheldon* and *Hoehling*, the court summarized the historical facts, the play, and the musical; set forth the basic legal principles; and concluded that summary judgment was not appropriate even though both sides relied on historical events.³⁴¹ In short, McNally copied too much of the protected copies, instead of relying on the factual accounts of Anna Anderson's claim to be the Duchess Anastasia.³⁴²

III. CONCLUSION

This Article has classified copyright law decisions dealing with derivative works and the right to prepare derivative works by discussing several recurring problems and common scenarios and applying the familiar Holmes maxim that it is permissible to copy the original but that you should not copy the copy. Providing this structure has been more than an exercise of selecting and sorting. Rather, the problems and scenarios illustrate the basic copyright law challenge of balancing the intellectual property and ownership rights of authors as an incentive to create against the need for subsequent authors to build upon and adapt the works of others.³⁴³ After all, derivative works build upon the works of others,³⁴⁴ and it was said long ago in a copyright law decision that few things are "strictly new and original throughout" and every work "in literature, science and art, borrows, and must

³³³ *Id.* at *1-2.

³³⁴ *Id.* at *1.

³³⁵ *Id.* at *5.

³³⁶ *Id.*

³³⁷ *Id.* at *1-2.

³³⁸ *Id.* at *5-8.

³³⁹ *See id.* at *2.

³⁴⁰ *Id.* at *1-2, *7.

³⁴¹ *See generally id.*

³⁴² *Id.* at *9.

³⁴³ Shipley, *supra* note 33, at 269.

³⁴⁴ 17 U.S.C. § 101 (2018) (definition of "derivative works").

necessarily borrow, and use much which was well known and used before.”³⁴⁵ Still, unless a creator is doing something new with a public domain work or has permission from the copyright owner to transform a protected work, the Holmes maxim remains true: you are usually safe to copy the original, but it is ordinarily risky to copy the copy. As a practical matter, this Article’s discussion of the seven recurring problems and scenarios should help lawyers when they advise a client about going forward with a particular creative project which builds upon preexisting works, the pros and cons of asserting an infringement claim when another author has arguably copied his or her copy, or the odds which might be faced in fighting an infringement claim when the client is alleged to have taken too much from a protected work.

³⁴⁵ Emerson v. Davies, 8 F. Cas. 615, 619 (C.C.D. Mass. 1845) (No. 4,436).