COPYRIGHT FOR VISUAL ART IN THE DIGITAL AGE: A MODERN ADVENTURE IN WONDERLAND

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I. INTRODUCTION

Lewis Carroll[1] took us through the looking glass into the wonderland he imagined. When our children were young I often told them stories which were adaptations of this idea. We imagined ourselves entering the scenes in various paintings on our walls or in book illustrations. Elaborate stories developed as we climbed to the other side of mountains, followed the road over the horizon, climbed through windows, or opened doors. Today, with computer technology, I could scan both the picture and photographs of ourselves and actually produce a tangible copy of the image which had once existed only on our mental screens. If I chose to share our stories, I could then produce a book incorporating the combined images or, better yet, a computerized version permitting the owner to incorporate the image of the child to whom the story is being told. The looking glass dissolves and we can now enter worlds heretofore only imagined.

These new forms of creativity will tax lawyers' imaginations. In the fifteenth century, the invention of the printing press made cheap copies of literary works possible. More than two centuries later, in England, the law responded with the invention of copyright, a law intended to establish a property right in works of the human mind.[2] Digital manipulation and transmission are a new challenge to the legal system of authors' rights. The modern age cannot afford 200 years of experience to elapse before it responds with an appropriate legal structure.

The purpose of American copyright law is to encourage creativity through economic incentives.[3] Copyright gives the author[4] a monopoly on the use of his work for a limited time. After the term

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[1] Lewis Carroll is a pseudonym for the Oxford mathematics professor Charles Lutwidge Dodgson, who published *Alice's Adventures in Wonderland* in 1865.

[2] The Statute of Anne was passed in 1710 and titled "An act for the encouragement of learning, by vesting the copies of printed books in the authors or purchasers of such copies . . . ." *See generally* L. RAY PATTERSON & STANLEY W. LINDBERG, THE NATURE OF COPYRIGHT, A LAW OF USERS' RIGHTS (1991); PAUL GOLDSTEIN, COPYRIGHT'S HIGHWAY: FROM GUTENBERG TO THE CELESTIAL JUKEBOX (1994).

[3] U.S. CONST. art. I, § 8, cl. 8. "The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . . ." For a discussion of the limitations of economic incentives in promoting such progress, see Stephen Breyer, *The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs*, 84 HARV. L. REV. 281 (1970).

[4] Both the Constitution and the federal law codified at 17 U.S.C. relating to copyright refer to "authors." In this article, because the principal topic is visual art, the term "artist" may be used to describe the "author" of a work of visual art.

of copyright ends, the author's work becomes freely available, as part of the public domain. During the copyright term, the author can demand payment from those who wish to copy, publish, perform, display, adapt, or distribute the product of his efforts.[5] The economic rewards are intended to encourage authors to create and disseminate more new works, thus benefiting both the public and the author during the copyright term, ultimately enriching the public domain once the term ends. The first law of copyright broke the monopoly of the publishers, the Stationers' Company of England, by giving each author the right to claim ownership by registering his copyright.[6] Today, everyone can be an author, publisher, or artist through the manipulation of images on an electronic screen. It may be that the copyright monopoly will fail to achieve its objective of advancing the arts and sciences unless it is modified to accommodate rights which were unknown at the time the copyright was instituted.

My examination of copyright in the digital age will concentrate on the visual arts, including painting, sculpture, and photography because they are all excellent examples of human creativity and particularly well suited to a global "information highway." The visual arts cross linguistic and cultural boundaries and have fascinated human beings since the first artists "fixed" their visions on cave walls. Yet they are under-appreciated, the stepchildren of the copyright laws. As noted above, copyright was first established to protect literary works. As will be described, copyright has slowly expanded to include other forms of creative work, including works of visual art. This article will examine the application of these copyright principles to non-literary forms of expression, specifically the use of images produced by form and value.

Within the visual arts, I am most interested in the fine arts. Fine art is not defined in the Copyright Act of 1976 ("Copyright Act") nor does the Copyright Act differentiate in terms of aesthetics. The analysis of the copyright issues of originality and creative expression are identically applied to the graphics in a cigarette commercial, to the composition of an Ansel Adams' photograph, or to a Georgia O'Keefe watercolor.[7] Yet, if the purpose of copy-

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[5] Copyright Act of 1976, 17 U.S.C. § 106 (1994).

[6] PATTERSON & LINDBERG, *supra* note 2, at 20-29.

[7] In the case of Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 251-52 (1903), Justice Holmes made the following observation:

> A picture is none the less a picture and none the less a subject of copyright that it is used for an advertisement. . . . It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations . . . . [If the pictures] command the interest of

right is to encourage creativity, the visual fine arts may be more clearly related to this objective than any other graphic art. In this sense, the fine arts are defined as works primarily intended to express the artist's aesthetics as opposed to communicate a commercial message or to serve a utilitarian purpose. Of course, this distinction is not exact, nor is it impossible for works to include both aesthetic and commercial expression, as well as being useful. However, the promotion of aesthetics is one aspect of human creativity that is not specifically addressed in the copyright law. A legal framework that is flawed or poorly understood as applied to the visual arts in general may be particularly inadequate for fine art.

The Visual Artists Rights Act of 1990 ("VARA")[8] is an exception to the general rule that visual arts are treated equally under copyright. VARA provides additional rights for authors of certain works of visual art. The works affected are defined not in terms of aesthetics but rather in terms of numbers of authorized and signed copies existing.[9] Works of "recognized stature" receive another layer of protection,[10] but such works are not defined in the statute. Aesthetic principles appear to be irrelevant in terms of copyright protection even when the visual arts are specifically addressed. Artistic works created using a computer and that are infinitely reproducible without loss of quality, as well as multimedia works that incorporate works of visual art are protected by the United States copyright laws.[11] However, the application of the copyright laws is problematic, and any problems will be magnified in the digital age when reproduction, alteration, and publication of all the arts will be accelerated and commonplace.

> any public, they have a commercial value — it would be bold to say that they have not an aesthetic and educational value — and the taste of any public is not to be treated with contempt.

In this case "tawdry pictures," which were used to advertise a circus, were accorded copyright protection. *Id.* at 241.

[8] The Judicial Improvements Act of 1990, Pub. L. No. 101-650, 104 Stat. 5089, 5128, 5133 (codified in scattered sections of 17 U.S.C.).

[9] 17 U.S.C. § 101 (1994) defines a "work of visual art" as

> (1) a painting, drawing, print, or sculpture, existing in a single copy, in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author, or, in the case of a sculpture, in multiple cast, carved, or fabricated sculptures of 200 or fewer that are consecutively numbered by the author and bear the signature or other identifying mark of the author; or
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> (2) a still photographic image produced for exhibition purposes only, existing in a single copy that is signed by the author, or in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author.

[10] 17 U.S.C. § 106A(a)(3)(B) provides that authors of a "work of recognized stature" have the right to prevent destruction of that work through gross negligence or an intentional act.

[11] 17 U.S.C. § 102 (1994).

Marci Hamilton, a professor of law at the Benjamin N. Cardozo School of Law, raised the issue of whether aesthetic value should influence law in her response to the Annual Bauer Lecture delivered on November 1, 1993.[12] Her response posed four questions relating to any theory of aesthetics and the law. Her first was, "Why do we treat art in our legal culture like non-art?"[13] Her discussion suggests that the creative arts may be a square peg in the legal hole. The economic incentives for a cigarette commercial may be different than those for the creator of artistic photography. Professor Hamilton continues, "We have built an entire system of copyright protection on the untested assumption that more remuneration motivates artists to create more and better art. Every aesthetic theory within the legal culture must be careful as it treads across this wide expanse of quicksand."[14]

Copyright protects "original works of authorship fixed in any tangible medium of expression"[15] with the threat of civil and criminal sanctions. Copying without the author's permission is prohibited.[16] The originality required for copyright is minimal.[17] Something somewhat expressive must originate with a human being; even accidental expression will suffice, such as paint spattering on a picture as long as the artist adopts it as his own. The second requirement for copyright protection, fixation, is another central concern in the digital translation of works of authorship.[18] The idea and plan for its expression is the original work of authorship in the copyright scheme. It can be an original contribution to the "progress of the arts and sciences," but it is not legally protectable until it is "fixed" in a tangible mode of expression.[19] For example,

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12 Marci A. Hamilton, *Four Questions About Art*, 13 CARDOZO ARTS & ENT. L.J. 119 (1994).

13 *Id.* at 119.

14 *Id.* at 122.

15 17 U.S.C. § 102(a).

16 PATTERSON & LINDBERG, *supra* note 2, at 146-59. The authors argue that the right to copy is not an independent right, but rather means the right to copy when combined with another exclusive right (to adapt, publish, perform, and display). The parameters of the right to copy as interpreted by the courts will be explored later in this article.

17 *Id.* at 97. "The 1976 act provides copyright protection for only three kinds of original works of authorship: an imaginative work, such as a novel; a derivative work, such as a motion picture based on a novel; or a compilation, such as a telephone directory." *Id. But see* Feist Publications v. Rural Tel. Serv., 499 U.S. 340 (1991). The telephone directory in *Feist* was held not entitled to copyright because "[t]he selection, coordination, and arrangement of Rural's white pages [the facts] do not satisfy the minimum constitutional standards for copyright protection." *Id.* at 362. However, it appears that, while the example chosen by Patterson and Lindberg may no longer be a valid subject for copyright, the authors' intent is to indicate that a work of non-fiction, such as a biography, would be protected as a compilation of facts.

18 17 U.S.C. § 101.

19 17 U.S.C. § 102(a).

fixation can be words on a printed page or captured on audiotape, or images painted on canvas or caused by the action of light on a film negative. That fixed version of the work constitutes a "copy" in law even if only one version exists, as is often the case with fine art. How digital translation of that copy affects the author's and others' legal rights is the central concern of this article. Before those rights are analyzed, an understanding of how that copy is digitally translated is necessary.

Professor Hamilton's last and most intriguing question at the Bauer lecture was, "[w]hat is the difference between the *experience* of art and a well-earned nap?"[20] She continued, "[t]hey are both restorative, pleasurable, refreshing, revitalizing. They each assist the individual in gaining much-needed perspective. . . . My experience of my dreams is not so far removed from my experience of a novel or a painting."[21] The vision of the digital age is to unleash the creativity of every man, to teach him, to entertain him, to permit him to create and to share his creations. We are all potential artists and we will be building on the arts of others, literally as well as figuratively. I can scan a painting, adapt it by incorporating my unique creative vision, and produce a new art work, all without using traditional tools or skills of the visual arts. Will I be an outlaw as I achieve my dream?

II. How 1's and 0's Become Fine Art

Or, as Alice said, "'Dear, dear! How queer everything is today!'"[22]

In Wonderland, nothing was as expected, as it had been the day before. The computer is an excellent example of a human creation which alters our perception of reality.[23] Computer memory is simply an arrangement of electronic (or magnetic) devices with two modes, on and off.[24] But what can be accomplished with this concept, combined with the principle of substitution, is astounding. The numerals 1 and 0 represent the status of the electronic current as either pulsing or not.[25] Series of 1's and 0's can

20 Hamilton, *supra* note 12, at 123.

21 *Id.*

22 Lewis Carroll, Alice's Adventures in Wonderland & Through the Looking Glass 9 (Bantam Books 1988) (1865).

23 "'The future isn't what it used to be.' Although Yogi Berra, the former New York Yankee, has probably never used Adobe Photoshop [a popular graphics program], his well-known quote may be one of the best ways to describe the ever-changing world of digital images." Adele D. Greenberg & Seth Greenberg, Digital Images: A Practical Guide 2 (1995).

24 Mike Morrison, The Magic of Image Processing 8 (1993).

25 *Id.*

represent any number, letter, and, as the series become increasing long, any color. Information is stored in a computer in units of information called bits. Each bit represents either 1 or 0 and the string of 1's and 0's is termed the computer's object code.[26] Eight bits, termed a byte, contain 256 possible combinations of 1's and 0's.[27] As bytes are combined, it becomes clear that an enormous number of variations is possible. And, since computers process these numbers tirelessly and rapidly, the length of the string of bits is of little importance.

Two dimensional images, such as the *Mona Lisa* or an advertisement for beer, are a systematic collection of colors. A block of color, with its shadings, is perceived by the human brain as a shape and, if recognizable, give a meaning. We see a person in what is in reality patches of colored oil on a canvas. The *Mona Lisa*'s face is an oval of light colored oils surrounded by dark colored oils; to the human mind it has character and depth. Representational artists understand that their choice of subject is frequently subsidiary to the arrangement of shapes achieved by shadings of color.[28] Modern art takes these concepts to the point where the subject is the shape.

Colors, like letters, are represented in a computer by a string of 1's and 0's, the computer's object code.[29] The image to be represented is first divided into a grid of squares. Each square, called a pixel, is assigned one color, created by a combination of bits representing varying amounts of the primary colors.[30] The more bits in a pixel, the more colors can be represented in the program. For example, a computer which uses eight bits of memory for each color component can provide approximately 16.7 million shades of color.[31]

The resolution of an image is described as the number of pixels per linear inch or per millimeter.[32] The greater the resolution, the sharper the image. The images which we see on a computer screen are:

> modern-day optical illusions. . . . [They] are actually composed of tiny black, white, gray, or colored squares. These squares are

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26 *Id.*
27 *Id.*
28 The painting popularly known as *Whistler's Mother* was titled *An Arrangement in Black and White* by the artist. It seems clear from this title that the woman in the picture was his vehicle for achieving his artistic vision, not the object of his vision.
29 MORRISON, *supra* note 24, at 9-10.
30 *Id.*
31 GREENBERG & GREENBERG, *supra* note 23, at 54.
32 *Id.* at 114-18.

> packed so closely together that your mind blends them into continuous tones to form realistic looking images. In many respects, viewing a digital image onscreen is like looking at a painting by Georges Seurat: both use small dots rather than large strokes to create wondrous images.[33]

Images are loaded into a computer's memory in a variety of ways. They can be created on the computer, electronically scanned with a device attached to the computer, transmitted to the computer through a modem from an on-line source, or loaded from a floppy disk or a digital camera.[34] Since all of these devices store images as pixels in the computer's object code, images are loaded into a computer's memory in the same manner as the written word. The limitation associated with art images is that more memory is required for the object code to represent a wide variety of color.[35]

Returning to the example with which this article began, if I scan a fine art reproduction from a coffee table art book, it will be displayed on my video screen and stored in temporary, or random access, memory ("RAM"). Unless I download the object code representing the image to a floppy disk or to my hard drive, the image will disappear when the computer is turned off and cannot be retrieved unless it is rescanned. If, however, I store the image, I can retrieve it at will.

Once the visual image is displayed on my computer screen from the random access memory, I can change it using commercially available software.[36] I can identify a block of color and change it with a mouse click. I can "draw" a line around a portion of the picture, erase it, and then insert an image scanned from another source, such as a photograph. The scale of images can be altered and pictures can be juxtaposed.[37] The shape of an image, such as a face, can be gradually changed to another, completely different image, by a process called morphing.[38] Dithering changes the spacing of the little dots of color which compose the

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[33] *Id.* at 114.

[34] *Id.* at 17. *See generally* ELAINE WEINMANN & PETER LOUREKAS, PHOTOSHOP FOR WINDOWS (1996).

[35] GREENBERG & GREENBERG, *supra* note 23, at 21-3.

[36] *Id.* at ch. 4.

[37] The Corcoran Gallery of Art had on display in the spring of 1995 digitally altered fine art photography by Pedro Meyer. Digital alterations of photos were demonstrated and explained in a multimedia exhibit accompanying the photography. In the good old days, photographs never lied. Today, people who never met can appear to do the most unlikely things together.

[38] In the April 1995 issue of *Scientific American*, author Lillian Schwartz explains how morphing was used to determine that the *Mona Lisa's* face was probably modeled on Leonardo da Vinci's own rather than that of his original model. Lillian Schwartz, *The Art Historian's Computer*, SCI. AM., Apr. 1995, at 106.

image and varies the hue. My alterations can be stored, printed, and/or transmitted to another computer in the same manner as the original image. All of this manipulation results in no change to the fine art reproduction with which I started. The copy is intact, but the copyright is at risk.

III. Art in the Digital Age

"[S]aid the Mouse . . . . '[T]he patriotic archbishop of Canterbury, found it advisable—'

'Found *what*?' said the Duck.

'Found *it*,' the Mouse replied rather crossly: 'of course you know what "it" means.'"[39]

The use of digital technology in the visual arts alters the nature of artistic expression. While a painting can be a fixed object on a wall or in a museum, it can also be transformed into a variable, useable database, reproducible and ephemeral. The questions are: What is "it?" What is the "work," the subject of copyright?

Artistic images can be used in a computer in a variety of ways. The computer screen can be a sketch pad on which the artist varies color and composition. A representational work can be transformed into an abstract expression. A portrait or a landscape, for example, can be transformed into a value study in shades of grey, black, and white. Sculpture can be perceived on a screen as three dimensional shapes, around which the viewer can proceed and which the viewer can rearrange.

Contemporary artists are using computers to produce creative work. Jack Youngerman uses his computer to alter composition and color, thereby creating multiple variations on his chosen image and avoiding time-consuming studies done by hand.[40] Harold Cohen has produced a program which permits the computer itself to produce the art, raising the interesting questions of who is the "artist," and what it means to "create."[41] Vera Molnar produces

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39 Carroll, *supra* note 22, at 16.

40 Frank Popper, Art of the Electronic Age 80 (1993).

41 John Schwartz, *Is Aaron's Work Creative Art or Just High-Tech Doodling?*, Wash. Post, Apr. 10, 1995, at A3. Aaron is the name of the computer program developed by Harold Cohen, a British artist who gave up painting more than 20 years ago to work with computer art. Aaron operates a robot which composes works based on information Cohen has been inputting about color, shape, and composition. Cohen notes that he "dare[s] not sit down at the keyboard while everyone is watching [Aaron work]" because they will think a human being is directing the work. *Id.* Cohen also comments that he no longer draws; "The machine draws much better than I do." *Id.* The computer's work has been displayed and sold in galleries, alongside that of human artists. "Aaron raises the question of whether a human artist also somehow draws from an internal set of rules when composing a work. Although its range of creation is obviously limited, Aaron forces observers to confront what it means to create." *Id.*; *see also* Popper, *supra* note 40, at 81.

simple geometric shapes on the screen and uses a program to help slightly rearrange the shapes repeatedly, producing interesting and intricate works.[42] Richard W. Maile's *Birth of Elvis* is a digital combination of a reproduction of Botticelli's *The Birth of Venus* and the image of Elvis Presley.[43]

Interactive art works are also part of the art landscape today. In her article on the Interactive Media Festival held in June 1995 in Los Angeles, *Wall Street Journal* reporter Tessa DeCarlo described the work that won the $10,000 top award at the festival:

> [Genetic Images were] . . . the most beautiful work[s] in the show . . . . [Its sixteen] screens display a series of abstract images, of which viewers can select up to four favorites by pressing sensors . . . . A powerful supercomputer then uses the selected images to create a new set of [sixteen] through a mathematical process mimicking evolution.
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> As the process is repeated it produces an array of intensely pleasing pictures in styles ranging . . . from severe abstract expressionism to lushly weird biomorphism. Says the festival's creative director, Lisa Goldman, "It raises the question: Is creativity a uniquely human attribute, or is it something that more and more can be seen in our machines?"[44]

Interactive art works are original and creative, but unorthodox in many respects. The very concept of the "work" is altered when it exists in a database, in numerical form. For certain artists, "an important feature of Computer Art is its non-materiality since its 'works' are abstract algorithms or databases."[45] As Michael Gaumnitz explained in *Artifices: Exhibition Catalogue,* for an exhibit at Saint-Denis:

> With the new electronic tools the image has radically changed its status: from being a fixed, eternal image in traditional painting, it has become changeable, revealing the processes of its genesis and as quickly disappearing. . . . *To the notion of space in painting is added duration.* Perception, once considered a finality, has today become a way of living.[46]

The issue of the "work" is implicated in computer manipulation in other respects. Jean-Pierre Yvaral in 1989 performed twelve visual studies of Leonardo da Vinci's *Mona Lisa.* He broke down

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[42] POPPER, *supra* note 40, at 81.
[43] *Id.* at 84.
[44] Tessa DeCarlo, *Web Sightings: On Gallery Walls . . . ,* WALL ST. J., July 12, 1995, at A12.
[45] POPPER, *supra* note 40, at 86-87 (discussing artist Tom DeWitt).
[46] JEAN-LOUIS BOSSIER, ARTIFICES: INVENTION, SIMULATION 16 (Exhibition Catalogue Saint-Denis 1990), *quoted in* POPPER, *supra* note 40, at 93 (emphasis added).

the image into measurable elements, strictly geometric structures, to determine the constitution of the original image. As Yvaral put it: "Any whole form can be considered as a geometric combination of elementary units available for reconstruction. It is in the systematic exploitation of this field that the artist hopes to create visual phenomena in which figuration and abstraction are no longer in opposition."[47]

The attribution of the original work thus disassembled into its geometric components and then reconstituted leads to an important question relating to this type of art: Who owns it? Da Vinci's work is not copyrighted. Yvaral avoided that problem for the time being.

Microsoft's Bill Gates has collected the digital rights to art works in the Seattle Art Museum, Russia's St. Petersburg Museum, London's National Gallery, and the elusive Barnes Foundation.[48] Microsoft has produced a compact disk in read-only ("CD-ROM") format, entitled *Art Gallery: The Collection of the National Gallery, London.* This CD permits the user to proceed through the gallery's collection and view the art from different angles, with tutorials incorporated at the user's option.[49]

By transforming or producing art into digital form, the art work is fundamentally transformed, rendering it malleable plastic. As Edmund Couchot explained in the catalogue for *Artifices*:

> [T]he image decomposes itself into its ultimate constituents — pixels. But while this decomposition renders it, theoretically at least, unalterable, infinitely reproducible, transmittable without any loss, and therefore totally stable, fixed, completely composed, at the same time it confers on the properties of the traditional image — photography, cinema, television, painting — the fluidity of numbers and language, the capacity to respond to the sightest [sic] demands of the viewer, to the most unexpected. *The digital process of decomposition makes the image unstable, mobile, motile, changeable, penetrable.*[50]

Artists who use computer technology have an original perspective in evaluating and using art. Contemporary art is a rich combination of traditional forms and materials as well as provocative and unique approaches, philosophies, and techniques. Not all of contemporary art fits neatly into the copyright scheme.

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47 POPPER, *supra* note 40, at 84.

48 *The Top 100 Collectors in America*, ART & ANTIQUES, Mar. 1995, at 76.

49 Ben Davis, *The Gallery in the Machine*, SCI. AM., May 1995, at 108.

50 BOSSIER, *supra* note 46, at 38, *quoted in* POPPER, *supra* note 40, at 115 (emphasis added).

One relatively new movement in the field of art, appropriation, is based on copying, or the use of "ready-formed images . . . as part of a reexamination of . . . originality and authenticity in the growing corporate mass culture."[51] Appropriation artists freely use other's images, rearranging, copying, and incorporating them into other work. Artists Sherrie Levine and Mike Bidlo produce exact copies of well-known works from the history of art, presenting the issue: Can an artist express himself through the ready-made expression of someone else? Artists such as David Salle, Richard Prince, John Baldissari, Sara Charrlesworth, and Victor Burgen rephotograph photographs or use photographs in collage, in order to "deconstruct the myth of the masterpiece, challenging the notion of inventiveness and originality in an image-saturated culture."[52]

Appropriation without permission could be copyright infringement. The Second Circuit's decision in *Rogers v. Koons*[53] demonstrates the high price an artist can pay if copyright infringement is found.[54] In a recent article, *The Art of Appropriation: Puppies, Piracy, and Post-Modernism*, Lynne A. Greenberg, a New York intellectual property attorney, argued:

> The art of appropriation, in its borrowing of everyday products and goods from the world of consumerism, and in its borrowing and expanded use of artistic imagery from the past, represents the most radical challenge to the copyrights laws to date. Indeed, appropriation art virtually renders the Copyright Act's insistence on creativity and originality obsolete.[55]

The appropriation art movement has an interesting philosophical basis. In his essay *The Death of the Author*, published in 1967, Roland Barthes, a French literary critic, suggested that all so-called original work is in reality the appropriation of others' efforts. As he put it:

> [A] text is not a line of words releasing a single "theological" meaning . . . but a multidimensional space in which a variety of writings, none of them original, blend and clash. . . . The text is a tissue of quotations drawn from the innumerable centers of

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51 JONATHAN FINEBERG, ART SINCE 1940: STRATEGIES OF BEING 455 (1995).

52 Lynne A. Greenberg, *The Art of Appropriation: Puppies, Piracy, & Post-Modernism*, 11 CARDOZO ARTS & ENT. L.J. 1, 21 (1992).

53 960 F.2d 301 (2d Cir. 1992), *cert. denied*, 506 U.S. 934 (1992).

54 *Id.* Jeff Koons, who produced four sculptures modeled on a copyrighted photograph and had sold three of the four for $367,000, was held to be liable to the owner of the photo for all profits attributable to the use of the photo and was held in contempt for refusing to surrender the unsold sculpture, the artist's copy.

55 Greenberg, *supra* note 52, at 33.

> culture. . . . The writer can only imitate a gesture that is always anterior, never original. . . . Did he wish to *express himself,* he ought at least to know that the inner "thing" he thinks to "translate" is itself only a ready-formed dictionary . . . .[56]

The notion that originality and creativity as applied in a copyright analysis are a shaky foundation upon which to erect a monopoly is not limited to those concerned with the visual arts. In a recent article in the *Virginia Law Review,* Professor Wendy J. Gordon suggested:

> A culture could not exist if all free riding were prohibited within it. Every person's education involves a form of free riding on his predecessors' efforts, as does every form of scholarship and scientific progress. Further, a bedrock proposition of the common law is that persons ordinarily should not be required to pay for the benefit of others' labor unless they have agreed in advance to do so, by contract.[57]

Appropriation art is the visual artist's way of stating Professor Gordon's position. It is, arguably at least, a legitimate form of creative expression, but one which may well be outlawed by copyright. In the digital age, much of the art produced by computer use will "appropriate" other's images and result in a "work" which may not be included in the appropriation art movement but will certainly have involved a form of "free riding" on another's efforts.

Copyright attempts to encourage and protect original and creative work. In order to determine whether the law encourages or has a chilling effect on "it," an understanding of the statutory provisions and the courts' interpretations of these provisions is necessary.

IV. Copyright Rights, The Legal Labels and Their Effects

> Or, "if you drink from a bottle marked 'poison,' it is almost certain to disagree with you, sooner or later."[58]

The labels used to describe copyright rights appear straightforward but have surprising complications. The terminology has a long history beginning in the early eighteenth century in England and culminating in the United States in the Copyright Act of 1976, as amended.

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56 Fineberg, *supra* note 51, at 454 (citing Roland Barthes, *The Death of an Author, in* Image-Music-Text, 146 (Stephen Heath trans. 1977).

57 Wendy J. Gordon, *On Owning Information: Intellectual Property and the Restitutionary Impulse,* 78 Va. L. Rev. 149, 167 (1992).

58 Carroll, *supra* note 22, at 6.

The rights of the owner of a copyright currently granted by statute are:

> [T]he exclusive rights to do and to authorize any of the following:
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> (1) to reproduce the copyrighted work in copies or phonorecords;
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> (2) to prepare derivative works based upon the copyrighted work;
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> (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
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> (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly; and
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> (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly.[59]

The rights described above grant the owner of a copyright in visual art the rights to copy, prepare derivative works, distribute the works to the public, and display publicly. The right to perform publicly is not associated with visual art. Each right may be assigned individually. However, the right to display accompanies the transfer of the material object embodying the visual art.[60]

Copyright attaches to an original work of authorship upon its creation and, unless the work is a "work made for hire,"[61] is owned by the author/artist.[62] Sale of a work of visual art by an artist does not automatically transfer all of the rights of copyright. Section 202 of the copyright law provides that ownership of the copyright(s) is distinct from ownership of the material object in which the work is fixed and that transfer of the material object does not automatically convey any of the copyrights.[63] Section 204(a) requires that any conveyance of the rights of copyright be evidenced by an instrument in writing, signed by the owner of the right(s)

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59 17 U.S.C. § 106.

60 17 U.S.C. §§ 109(c), 201(d)(1) (1994).

61 A "work made for hire" is defined in the copyright statute at 17 U.S.C. § 101. If an author produces a "work made for hire," the employer or person for whom the work is created owns all of the copyright rights unless the parties have agreed otherwise by an instrument in writing. 17 U.S.C. § 102(b). For a discussion of the complexities of the "work made for hire" doctrine, see Community for Creative Non-Violence v. Reid, 490 U.S. 730 (1989).

62 17 U.S.C. §§ 201(a), 302(a) (1994).

63 17 U.S.C. § 202 (1994).

conveyed.[64]

The requirement that a work be original for copyright to attach was specified in the Copyright Act of 1976 and is codified in section 102(a).[65] Previously, courts required originality on the basis of constitutional interpretation. In an early Supreme Court decision, *Burrow-Giles Lithographic Co. v. Sarony*,[66] the Court was presented with the issue of whether photographs are proper subjects of copyright or "mere mechanical reproductions[s] of the physical features or outlines of some object."[67] The Court suggested that the constitutional clause empowering Congress to give authors an exclusive right to their writings for a limited time implies that, in order to be eligible for copyright, a work must be the product of the "original intellectual conception of the author."[68] If the work is not produced by the author but by "mere mechanical reproduction,"[69] it is not the author's work, as required by the Constitution, and therefore not a proper subject for copyright protection. In *Burrow-Giles*, the Court held that the photographs in question were original works of art and eligible for copyright protection.[70]

Originality does not involve novelty, ingenuity, or any advance in the arts. "Originality in this context 'means little more than a prohibition of actual copying.'"[71] An artist is free to use the same subject matter, but is not free to copy another's work. As Justice Holmes stated: "Others are free to copy the original [subject matter]. They are not free to copy the copy."[72] The originality re-

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64 17 U.S.C. § 204(a) (1994). In Franklin Mint Corp. v. National Wildlife Art Exchange, Inc., 195 U.S.P.Q. 31 (E.D. Pa. 1977), the lower court held that an endorsement on the back of a check, "For Cardinal Painting 20 x 24 including all rights—reproduction etc.," was sufficient to transfer all copyright rights. *Id.* at 33. The Third Circuit did not address this issue in its decision. Franklin Mint Corp. v. National Wildlife Art Exchange, Inc., 575 F.2d 62 (3d Cir.), *cert. denied*, 439 U.S. 880 (1978).

See also Playboy Enters., Inc. v. Dumas, 831 F. Supp. 295 (S.D.N.Y. 1993), *aff'd in part, rev'd in part, vacated in part*, 53 F.3d 549 (2d Cir.), *cert. denied*, 116 S. Ct. 567 (1995). In *Playboy* the court held that the written evidence of an assignment of copyright rights must contain words of transfer of the rights or there must be other evidence of an oral agreement to transfer the rights. In other words, the written instrument need not specify that the rights are conveyed if there is sufficient evidence that the writing memorializes an oral agreement to convey.

See also Museum Boutique Intercontinental, Ltd. v. Picasso, 880 F. Supp. 153, 162 (S.D.N.Y. 1995).

65 17 U.S.C. § 102.

66 111 U.S. 53 (1884).

67 *Id.* at 59.

68 *Id.* at 58.

69 *Id.* at 59.

70 *Id.* at 53.

71 Alfred Bell & Co. v. Catalda Fine Arts, 191 F.2d 99, 103 (2d Cir. 1914) (quoting Hoague-Sprague Corp. v. Frank C. Meyer, Inc., 31 F.2d 583, 586 (E.D.N.Y. 1929)).

72 *Bleistein*, 188 U.S. at 249.

quirement for copyright in the visual fine arts assumes added importance in consideration of copyrights for art reproductions, a form of derivative work, which will be considered later in this article.

Creativity is not specifically required for copyright. Interpretation of the 1909 Act by the Copyright Office and the courts, however, have "invoked at least a minimal requirement of creativity over and above the requirement of independent effort," and this interpretation continues under present law.[73] The requirement of creativity appears to be a policy determination that some original work is "too trivial or insignificant to support copyright."[74]

In the case of works of art, however, the creativity requirement appears to involve different considerations. The Nimmer treatise on copyright law asserts that art requires some creativity by definition.[75] This interpretation is supported by the cases, but the quantum and type of creativity required is difficult to describe. In *Bleistein v. Donaldson*, Justice Holmes stated:

> It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, *outside of the narrowest and most obvious limits.* At the one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge.[76]

Lack of creativity was the stated grounds for denial of copyright for a cardboard star design,[77] a logo of angled arrows,[78] and a plastic flower corsage.[79] On the other hand, sufficient creativity existed for copyright in an arrangement of colors for artist's supplies,[80] in a statue of a cocker spaniel in show position, even though the "details [infringed were perhaps] too subtle for appre-

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73 MELVILLE NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.01[B] (1995).

74 *Id.*

75 *Id.* § 2.08[B][1]. "With respect to works of art, however, the requirement of minimal creativity is applied not as a matter of policy, but rather as a matter of definition." *Id.*

76 *Bleistein*, 188 U.S. at 251-52 (emphasis added).

77 Bailie v. Fisher, 258 F.2d 425 (D.C. Cir. 1958).

78 John Muller & Co. v. New York Arrows Soccer Team, 802 F.2d 989 (2d Cir. 1986).

79 Gardenia Flowers, Inc. v. Joseph Markovits, Inc., 280 F. Supp. 776 (S.D.N.Y. 1968).

80 Pantone, Inc. v. A. I. Friedman, Inc., 294 F. Supp. 545 (S.D.N.Y. 1968).

ciation by anyone but a fancier of the dog represented,"[81] and in an artificial rose which "bears practically a photographic likeness to the natural article."[82] In an interesting twist, another court confronted with photographs of naked babies held that "the poses in which those babies are photographed [are not] the proper material for copyright."[83] Indeed, copyright protection was denied in this case on the grounds that "the plaintiff, in using her copyrighted expression (lighting, choice of background, camera angle, etc.) has not expanded on the idea of a photograph of a naked baby . . . . This is not meant to minimize the plaintiff's work in any way; *its simplicity is its creativity.*"[84] The standard of creativity required for copyright protection becomes even more difficult to apply when authorized or otherwise lawful derivative works are considered,[85] as will be explored later.

The Copyright Act requires no registration, no notice, or any publication for copyright to attach to an original work of authorship.[86] The mandatory copyright notice that had been a feature of American law was replaced by voluntary notice in the Berne Implemention Act of 1988.[87] While notice of copyright ownership is not a factor in determining whether infringement has occurred, the defense of innocent infringement is considered in assessing damages and may be considered in assessing costs and attorney's fees.[88] Fraudulent addition, alteration, or removal of a copyright notice is a criminal offense.[89] However, those who reasonably rely on the presence or absence of a copyright notice can be innocent infringers, subject to suit and required to prove their innocence.[90]

Given the ease with which copyright notice can be attached or removed in digital transmissions, even accidentally, courts may be

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81 F. W. Woolworth Co. v. Contemporary Arts, Inc., 193 F.2d 162, 164 (1st Cir. 1951), *aff'd*, 344 U.S. 228 (1952).

82 First Am. Artificial Flowers, Inc. v. Joseph Markovits, Inc., 342 F. Supp. 178, 186 (S.D.N.Y. 1972). While acknowledging that the copyright may be valid, this court refused to issue a preliminary injunction against a competitor's rose because the copyright was "relatively weak" and the burden of proving copying "will be that much more difficult." *Id.*

83 Gentieu v. John Muller & Co., 712 F. Supp. 740, 742 (W.D. Mo.), *dismissed without opinion*, 881 F.2d 1082 (8th Cir. 1989).

84 *Gentieu*, 712 F. Supp. at 744 (emphasis added).

85 Gracen v. Bradford Exch., 698 F.2d 300 (7th Cir. 1983).

86 *See* 17 U.S.C. §§ 408(a), 401(a), and 302(a) (1994).

87 Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 (1988) (codified as amended in scattered sections of 17 U.S.C.).

88 *See* 17 U.S.C. §§ 501, 504(c)(2), and 505 (1994).

89 *See* 17 U.S.C. § 506(c)-(d) (1994).

90 17 U.S.C. § 504(c)(2) provides in part:

> In a case where the infringer sustains the burden of proving, and the court finds, that such infringer was not aware and had no reason to believe that his or her acts constituted an infringement of copyright, the court [in] its discretion may reduce the award of statutory damages to a sum of not less than $200.

called upon to decide whether reliance on the presence or absence of a copyright notice on digitally transmitted visual art can be considered reasonable. There are no cases directly on point; however, cases under earlier law involving reliance on the lack of a copyright notice have held that unauthorized removal of a copyright notice does not affect the copyright owner's rights.[91] In addition, current law provides that removal, destruction, or obliteration of the notice, without the authorization of the copyright owner does not affect protection under the copyright law.[92]

The copyright term is, in general, for the life of the author plus fifty years.[93] Currently before Congress is a proposal to substantially lengthen the copyright term to the life of the author plus seventy years.[94] The rights and the term of copyright today are substantially greater than those contemplated at the beginnings of copyright. It is instructive to trace briefly the expansion of copyright law to cover works, rights, and "authors" not included in the first statute for a much longer period than originally provided.

The Statute of Anne was the first copyright act, passed in 1710 in England.[95] As originally conceived, copyright entitled the owner to print, reprint, publish, and sell and was intended to protect authors of published materials by giving them the exclusive right to publish for a limited time. In effect, the authors profited by selling their copyright to publishers who then could exclude others from printing and selling the work. The stated purpose of the statute was to promote learning. This was accomplished by assuring that the products of creative labor would be available to the public during the copyright term (the requirement of publication) and thereafter as part of the public domain.[96] Engravings included in printed books were the only type of artwork covered by the early statutes.

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91 Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487 (2d Cir. 1960). This case concerned copyrighted designs imprinted on fabric with the notice printed at regular intervals along the selvage edge (the woven margin, usually white or ivory, approximately 1/2" wide on each side of a length of fabric). The selvage is always covered in a finished garment and is frequently removed during the cutting process. The issue presented was whether the copyright owner who produced and sold the fabric with the required notice, but knowing of the practice of removing/covering the selvage, retained his rights against one who copies his design from the finished garment. The court held that the copyright owner retained all rights against the infringer.

92 17 U.S.C. § 405(c) (1994).

93 17 U.S.C. § 302(a).

94 S. REP. No. 483, 104th Cong., 2d Sess. (1996).

95 *See* PATTERSON & LINDBERG, *supra* note 2, at 27-29.

96 In fact, the creation of the idea of a public domain is one of the legal innovations of the Statute of Anne. The Stationers' monopoly had been perpetual. *Id.* at 29. *See supra* note 6 and accompanying text (describing the Stationers' monopoly).

The first United States Copyright Act was passed in 1790 and was limited to books, maps, and charts; the rights specified were to print, reprint, publish, and sell; the term was limited to a renewable fourteen year period.[97] Translations and abridgements of copyrighted works were permitted uses, and were not included in the rights of copyright.[98] The copyright owner had no right to the derivative works created from his original work of authorship.[99]

The 1870 Act expanded copyright protection to include the right to translate and the right to dramatize,[100] the first derivative works protected by copyright. In addition, during the nineteenth century, the subject matter of copyright was enlarged to include works of art[101] and photographs.[102] The right "to copy" originally applied only to the copyright owner of works of art, such as engravings and prints.[103] It may be that until the invention of photocopy machines, copying of printed materials was time-consuming and laborious and was unlikely to be an economic threat to the publishers, whereas copying a work of art by, for example, painting a copy, was a direct threat to the economic interests of the owner.[104] The original term of copyright was also increased during the nineteenth century to twenty-eight years.[105]

Two major revisions of copyright law in the twentieth century in 1909 and 1976 substantially increased the scope and length of the copyright monopoly. For example, the 1909 Act added the right to copy as one of the rights applying to all copyrighted works.[106] While certain commentators believe that the addition of this right to copy was inadvertent,[107] infringement of that right has become a frequent basis for infringement suits in the twentieth

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97 PATTERSON & LINDBERG, *supra* note 2, at 60.

98 *Id.*

99 Story v. Holcombe, 23 F. Cas. 171 (C.C.D. Ohio 1847) (No. 13,497); Stowe v. Thomas, 23 F. Cas. 201 (C.C.E.D. Pa. 1853) (No. 13,514). "Under the 1790 Act, derivative works were considered to be wholly new works, apart from the materials upon which they were based. The courts took a very literal view of 'copying' or reproduction; hence anything short of stealing a work, word for word, did not amount to infringement." Christine Wallace, *Overlapping Interests in Derivative Works and Compilations*, 35 CASE W. RES. L. REV. 103, 108 (1985).

100 Act of July 8, 1870, ch. 320, § 86, 16 Stat. 198, 212, *cited in* Wallace, *supra* note 98, at 108; PATTERSON & LINDBERG, *supra* note 2, at 81-85.

101 PATTERSON & LINDBERG, *supra* note 2, at 82 (referring to the Act of 1802).

102 *Id.* at 78 (explaining the new privileges given by the Act of 1870).

103 *Id.* at 82-83; *see id.* at 77 n.5 (citing 2 Stat. 171-72 (1845); 4 Stat. 436-39 (1845)).

104 "While the exclusive right to publish furnishes the copyright owner of a book adequate protection, it provides little protection for the copyright owner of a work of art, such as etchings, engravings, paintings, and statuary." PATTERSON & LINDBERG, *supra* note 2, at 82.

105 *Id.* at 71.

106 *Id.* at 81, 146-59.

107 *Id.*

century. For works created after January 1, 1978, the duration of copyright was increased to the life of the author plus fifty years.[108]

This article will explore the right of reproduction and the right to prepare derivative works in some detail. The distribution, display, and performance rights are also implicated in digital uses of visual art, as is made clear by the report of the task force on the National Information Infrastructure (so-called *White Paper on Intellectual Property Rights*).[109] The rights of distribution, performance, and display are limited by statute to distributions to the public as well as to public performances and displays; such limitation is not included in the statutory definitions of the right to reproduce and the right to prepare derivative works.[110] It is hoped that by discussing the two copyright rights not limited to "public use," it will be possible to highlight some of the important problem areas in adapting the law of copyright to new forms of creativity.

The thesis of this article is that the copyright law as applied to the visual arts lacks predictability, and, as a result, inhibits the use of copyrighted visual works. A law that most courts and commentators agree contains several important areas that are ill-defined and vague cannot operate effectively to promote the use of copyrighted work and production of new works. The copyright laws were written by lawyers to apply to literary works. Their application to visual works is difficult, requiring balancing and value judgments. The application of the copyright laws to the visual arts borders on the incomprehensible.

The statutory scheme was originally conceived to break up the Stationers' monopoly, to protect authors of literary works for a very limited time, and to promote learning. Today, the statutory scheme confers broad, exclusive rights for a substantially lengthened period on owners of copyrights in a wide variety of works. Copyright rights as interpreted by the courts and applied to digital technology may threaten the underlying purpose of the statute, which is the wide dissemination of knowledge. As applied to visual

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108 See 17 U.S.C. § 302 for copyright term applicable to joint works, anonymous works, and works made for hire.

109 INTELLECTUAL PROPERTY AND THE NATIONAL INFORMATION INFRASTRUCTURE: THE REPORT OF THE WORKING GROUP ON INTELLECTUAL PROPERTY RIGHTS (1995) (Bruce A. Lehman) [hereinafter WHITE PAPER ON INTELLECTUAL PROPERTY RIGHTS]. The full text of this report is available on the World Wide Web at <http://www.uspto.gov/web/ipnii>. The White Paper on Intellectual Property Rights emphasizes the ambiguity in the law relating to the right of distribution by computer transmission and recommends certain amendments to the Copyright Act to "expressly recognize that copies or phonorecords of works can be distributed to the public by transmission, and that such transmissions fall within the exclusive distribution right of the copyright owner." *Id.* at 213.

110 *See* 17 U.S.C. § 106.

fine art, these rights are particularly problematic in the digital age. In fact, they are bound to disagree with any serious "consumer" of fine art sooner or later.

V. The Right To Reproduce

Or, "'I've often seen a cat without a grin,' thought Alice; 'but a grin without a cat!'"[111]

Whether the right to reproduce a work is, or should be, a dependent or independent right in the copyright scheme, is a primary concern in the digital age. Generally, a grin is not independent of a face, except in Wonderland. It may be that the right to reproduce should be construed to be dependent, that is, it may be exercised only in conjunction with the exercise of another copyright right.[112] In an age when copying through digital translation is a primary means of using information, giving the copyright owner the exclusive right to reproduce a work may be extending the copyright monopoly to the point where it interferes with its underlying purpose of advancing learning.

A. *Definition of Right To Reproduce*

Under current law, the right to reproduce a copyrighted work appears to be broadly defined to include all forms of reproduction[113] and to be unqualified in terms of use. In their influential treatise on copyright, the Nimmers state that:

> One who makes infringing [presumably meaning unauthorized] copies . . . of a work infringes the copyright owner's reproduction right under Section 106(1), even if he does not also infringe the Section 106(3) distribution right by sale or other disposition of such copies . . . . Therefore, subject to the privilege of fair use, and subject to certain other exemptions [citing the exemptions for libraries, archives, government and nonprofit organizations], copyright infringement occurs whenever an unauthorized copy or phonorecord is made, even if it is used solely for the private purposes of the reproducer, or even if the other uses are licensed.[114]

Some commentators and judges appear to be uneasy with the broad scope of the reproduction right.[115] In general, however, the

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111 Carroll, *supra* note 22, at 49.
112 Patterson & Lindberg, *supra* note 2, at 148.
113 17 U.S.C. § 106.
114 Nimmer & Nimmer, *supra* note 73, § 8.02[C] and note 27.
115 *See* Goldstein, *supra* note 2, at 150 (discussing Williams & Wilkins Co. v. United States, 487 F.2d 1345 (Ct. Cl. 1973) (Stevens, J.), *aff'd*, 420 U.S. 376 (1975)).

courts have followed the "plain language" of the Copyright Act.[116]

The right to reproduce is defined in the Copyright Act in terms of making "copies or phonorecords."[117] "Copies" is defined as:

> Material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term "copies" includes the material object, other than a phonorecord, in which the work is first fixed.[118]

In order to be a "copy," the work must be "fixed." According to the Act, "[a] work is 'fixed' in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration."[119]

The Copyright Act lists the right to reproduce and the right to prepare derivative works separately. It is useful to try to make a distinction between these rights in the analytical framework of copyright. A "derivative work" is defined in the Copyright Act as:

> A work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, 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."[120]

The derivative work must incorporate the underlying work or works in some "concrete or permanent 'form,'"[121] and, therefore, by definition, appears to overlap with the right of reproduction. In fact, Nimmer suggested in his treatise on copyright that the right to prepare derivative works is largely superfluous.[122] At least one court, however, has suggested in dicta that, while a derivative work must be fixed to be copyrightable, it need not meet the fixation

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116 Sega Enters. v. Accolade, Inc., 977 F.2d 1510, 1518 (9th Cir. 1992).
117 17 U.S.C. § 106(1).
118 17 U.S.C. § 101.
119 *Id.*
120 *Id.*
121 Lewis Galoob Toys, Inc. v. Nintendo of America, Inc., 964 F.2d 965, 967 (9th Cir. 1992), *cert. denied*, 507 U.S. 985 (1993).
122 NIMMER & NIMMER, *supra* note 73, § 8.09[A].

requirement to infringe.[123] This distinction has significance in terms of digital technology.[124] In addition, the distinction between the reproduction and derivative works' rights has implications in terms of assignments of copyrights. For example, assignment of the right to reproduce without concurrent assignment of the right to prepare derivative works may not authorize any variations, however trivial, from the original copy.[125] The Copyright Act distinguishes between the two rights and, although there is substantial overlap in the cases, it is useful to discuss the rights separately in order to understand the intent of the legislation.

B. *What is an Infringing Reproduction?*

The Nimmer treatise on copyright states that copies must be tangible, fixed, and intelligible in order to infringe the reproduction right.[126] These requirements are found in the terms of the statute. Copies must be "material objects in which a work is fixed" and must be "sufficiently permanent or stable to be perceived."[127] Within these broad requirements, there is a wide variety of reproductions which can involve this right.

1. Example #1: Infringement by Work in Progress

A copy need not be a finished work in order to infringe the reproduction right; it can be a step on the way to making a finished work which may not infringe. In *Walt Disney Productions v. Filmation Associates*,[128] the defendant created story boards, scripts, a story reel, and other materials in the process of creating a film. The defendant argued that until the film was completed, there was no copy that could infringe. The court held that the right to reproduce was independent of any other copyright right, that it was not necessary for a work to be ready for distribution or published in order to infringe. Even if the works produced were to be used only by the defendant's employees, Filmation's animators, they can infringe if they are unauthorized copies.

The holding in *Walt Disney Productions* is consistent with the language of the statute and with other courts' interpretation of the

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123 *Lewis Galoob Toys*, 964 F.2d at 967. In this case, the court held that the altered displays did not incorporate a portion of the copyrighted work and therefore did not infringe.

124 *See* WHITE PAPER ON INTELLECTUAL PROPERTY RIGHTS, *supra* note 109, at 26-28.

125 NIMMER & NIMMER, *supra* note 73, § 8.09[A].

126 *Id.* § 8.02[B].

127 17 U.S.C. § 101.

128 628 F. Supp. 871 (C.D. Cal. 1986).

statute.[129] It raises an interesting issue in terms of digital use. If digital translation is a reproduction, any such unauthorized use may infringe the reproduction right of copyrighted material even if computer use of the work is simply a step on the way to producing an entirely different work or a means of viewing or studying the work, a kind of "reading." The multimedia art described earlier could be infringing if any image briefly shown while morphing into another image, or transforming in response to the viewer's choices, is a copy of a copyrighted work. Scanning a representational work and then using a graphics program to render it abstract in order to change the composition or to add additional features may be an infringement, because the first step would involve the reproduction right.

2. Example #2: Infringement by "Digitizing"

In its *White Paper on Intellectual Property Rights*, the Clinton Administration has presented its view of the current state of copyright law as applied to digital copies as well as proposals for "minor clarification[s]" of the law.[130]

According to the *White Paper on Intellectual Property Rights*, "[i]t has long been clear under U.S. law that the placement of copyrighted material into a computer's memory is a reproduction of that material (because the work in memory then may be, in the law's terms, 'perceived, reproduced, or . . . communicated . . . with the aid of a machine or device')."[131] Several cases appear to confirm that assertion.

In *Advanced Computer Services of Michigan v. MAI System Corp.*,[132] the court, citing sections 101 and 107 of the Act, held: "This language supports a reading of the Act that recognizes that electrical impulses of a program in RAM [random access memory] are material objects, which, although themselves imperceptible to the ordinary observer, can be perceived by persons with the aid of a computer."[133]

The first case to hold that loading a computer program into random access memory is copying for the purposes of the Copyright Act was *MAI System Corp. v. Peak Computer, Inc.*[134] The court in *Peak Computer, Inc.* surveyed the cases involving use of computer

129 *See, e.g., Sega Enters.*, 977 F.2d at 1518 (citing Walker v. University Books, 602 F.2d 859, 863-64 (9th Cir. 1979)).

130 WHITE PAPER ON INTELLECTUAL PROPERTY RIGHTS, *supra* note 109, at 17.

131 *Id.* at 64-65 (citation omitted).

132 845 F. Supp. 356 (E.D. Va. 1994).

133 *Id.* at 363.

134 991 F.2d 511 (9th Cir. 1993), *cert. dismissed*, 510 U.S. 1033 (1994).

programs and found that, while none specifically held that loading a program into the random access memory constituted a copy, there was support for the proposition that loading software into a computer constituted copying, without specifying whether random access memory ("RAM"), the hard drive, or the read only memory ("ROM") were used.[135] The court reasoned that since "the copy created in the RAM can be 'perceived, reproduced, or otherwise communicated,' we hold that the loading of software into the RAM creates a copy under the copyright Act."[136]

In *Triad System Corp. v. Southeastern Express Co.*,[137] the lower court (in an unpublished opinion) considered certain implications of the holding that the RAM can contain a copy for copyright infringement purposes. The copyrighted software at issue was loaded into the RAM by a competing service organization (Southeastern) to operate the computer and produced no video display. The court reasoned that the lack of a video display and the fact that the RAM of the computer may contain the digital copy for only an instant were immaterial, and the court did not disturb the previous finding that the copies were sufficiently fixed to infringe Triad's copyright in its software.[138]

The Ninth Circuit affirmed the lower court's grant of a preliminary injunction against Southeastern's use of Triad's copyrighted software.[139] Recent cases confirm the premise that the right to reproduce can be infringed by a digital "copy" in a computer's memory.[140]

3. Example #3: Infringement by Computer Transmission

Proceeding logically from the premise that all digital "copies"

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135 *Id.* at 519 (citing Vault Corp. v. Quaid Software Ltd., 847 F.2d 255, 260 (5th Cir. 1988)); *see* NIMMER & NIMMER, *supra* note 73, § 8.08[A][1] ("Moreover, this expanded definition [in the Copyright Act as amended] makes clear that the input of a work into a computer results in the making of a copy, and hence, that such unauthorized input infringes the copyright owner's reproduction right.").

136 *Peak Computer, Inc.*, 991 F.2d at 519 (citing 17 U.S.C. § 101).

137 1994 U.S. Dist. LEXIS 5390 (N.D. Cal. Mar. 18, 1994), *aff'd*, 64 F.3d 1330 (9th Cir. 1995), *cert. denied*, 116 S. Ct. 1015 (1996).

138 *Id.* at *14-19.

139 Triad Sys. Corp. v. Southeastern Express Co., 64 F.3d 1330 (9th Cir. 1995), *cert. denied*, 116 S. Ct. 1015 (1996).

140 *See In re* Independent Serv. Orgs. Antitrust Litig., 910 F. Supp. 1537 (D. Kan. 1995); NLFC, Inc. v. Devcom Mid-America, Inc., 45 F.3d 231 (7th Cir. 1995), *cert. denied*, 115 S. Ct. 2249 (1995). Several commentators have criticized this trend in copyright law. *See, e.g.*, Jane C. Ginsburg, *Putting Cars on the "Information Superhighway": Authors, Exploiters, and Copyright in Cyberspace*, 95 COLUM. L. REV. 1466, 1476 n.39 (citing David Post, *New Wine, Old Bottles: The Case of the Evanescent Copy*, AM. LAW., May 1995, at 103); Pamela Samuelson, *Legally Speaking: The NII Intellectual Property Report*, COMM. OF THE ACM, Dec. 1994, at 21-23; Jessica Litman, *The Exclusive Right to Read*, 13 CARDOZO ARTS & ENT. L.J. 29, 40-43 (1994).

are reproductions in the copyright sense, the courts are finding liability (or the potential for liability) for copyright infringement on the part of third parties who transmit these digital signals. Recently, courts have held that computer bulletin board operators and Internet service providers could be, or were, liable for copyright infringement when infringing reproductions were transmitted by their users.[141]

In *Playboy Enterprises v. Frena*,[142] the court held the operator of a bulletin board liable for direct infringement of Playboy's copyrights in its magazine photographs. In this case, the photos were loaded onto and distributed through the system, were exact copies, and were publicly displayed in copyright terms by being projected on the user's screens. While the court's holding of direct copyright infringement rested on the copyright owner's display right, its holding implicated the reproduction right as well. "There is no dispute that Defendant Frena supplied a product containing unauthorized copies of a copyrighted work. It does not matter that Defendant Frena claims he did not make the copies itself [sic]."[143]

The liability of computer services for both direct and contributory infringement in making copies of copyrighted material was directly addressed in a later case, *Sega Enterprises v. Maphia*.[144]

> Sega has established a *prima facie* case of direct copyright infringement . . . when [its] games are uploaded to the MAPHIA bulletin board . . . [and] also . . . when they are downloaded to make additional copies by users. . . . Even if Defendants do not know exactly when games will be uploaded to or downloaded from the MAPHIA bulletin board, their role in the copying, including provision of facilities, direction, knowledge and encouragement, amounts to contributory copyright infringement.[145]

Religious Technology Center v. Netcom On-Line Communication Serv-

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141 A recent case, Religious Technology Ctr. v. Netcom On-Line Communications Servs., Inc., 907 F. Supp. 1361 (N.D. Cal. 1995) discusses the differences between direct and contributory copyright infringement. In brief, direct infringement is established by demonstrating "(1) ownership of a valid copyright and (2) 'copying' of protectable expression . . . . In this context, 'copying' is shorthand for the infringing of any of the copyright owner's five exclusive rights." *Id.* at 1366-67, n.7. Contributory infringement involves establishing that the defendant, "with knowledge of the infringing activity, induces, causes or materially contributes to the infringing conduct of another." *Id.* at 1373 (citing Gershwin Publishing Corp. v. Columbia Artists Management, Inc., 443 F.2d 1159, 1162 (2d Cir. 1971)).

142 839 F. Supp. 1552 (M.D. Fla. 1993).

143 *Id.* at 1556.

144 857 F. Supp. 679, 686-87 (N.D. Cal. 1994).

145 *Id.* (citing Casella v. Morris, 820 F.2d 362 (11th Cir. 1987) (quoting *Gershwin Publishing Corp.*, 443 F.2d at 1162)).

ices, Inc.[146] addressed the possibility of direct and contributory infringement by a large Internet access provider. This court was unwilling to find liability for direct infringement, stating, "[a]lthough copyright is a strict liability statute, there should still be some element of volition or causation which is lacking where a defendant's system is merely used to create a copy by a third party."[147]

On the issue of contributory infringement, however, the court held that it is possible for a plaintiff to establish sufficient ground to hold an Internet server liable. The court discussed the factors to be considered, such as knowledge of the infringing activity, presence of copyright notices on the material transmitted, and the degree of control exercised by the server.[148]

The court in *Religious Technology* also addressed the possibility of vicarious liability in the context of the Internet. In situations where the third party has the right and ability to control the party who is directly infringing and when the third party derives a direct financial benefit from the infringing activities, the court reasoned that vicarious liability for infringement could be established.[149] In this case, however, the court held that the plaintiff had not raised a triable issue on financial benefit to Netcom even though the server did receive payments from its users.[150]

In *Fonovisa Inc. v. Cherry Auction Inc.*,[151] a recent Ninth Circuit decision, the court found that a flea-market operator could be held contributorily and vicariously liable for the sale of infringing recordings by vendors renting space. The court found that the operator of the flea-market obtained a financial benefit from admission fees, concession-stand sales, and parking fees. The distinction between this case and *Religious Technology* may be that in the latter case the payments were fixed fees while the flea-market operator's revenues varied with increased sales and attendance.

Vicarious liability for copyright infringement does not include the element of knowledge of the infringing activity.[152] The *Fonovisa* decision could have far-reaching ramifications in the on-line area if the analogy is made to network servers.

The extent of the knowledge, control, benefit, and/or encouragement required for a third party to be contributorily liable for

146 907 F. Supp. 1361 (N.D. Cal. 1995).
147 *Id.* at 1370.
148 *Id.* at 1373-75.
149 *Id.* at 1375-77.
150 *Id.* at 1361
151 76 F.3d 259 (9th Cir. 1996).
152 *Id.*

copyright infringement is an area still being explored by the courts.[153] It appears, however, that reproduction by digital translation of a visual image can be an infringement both by the person operating the computer and, under certain circumstances, by a third party who provides transmission services.

C. *Is There a "Private" Use Exception to the Right of Reproduction?*

The literal terms of the Copyright Act provide that the copyright owner has the exclusive right to reproduce and to authorize reproduction of copyrighted material. The Copyright Act provides no exception for so-called "private" use in the definitional scope of this right. There are specific exceptions to the right of reproduction in the Copyright Act. For example, libraries are authorized to make limited copies.[154] However, private use is not among the exceptions listed.

The legislative history on the reach of the right to reproduce into the area of private use is ambiguous. The House Judiciary Committee Report on the Copyright Act provides justification for including all reproduction, including copying for private use, in the right of reproduction.[155] The Report defines the right of reproduction as follows:

> As under the present law, a copyrighted work would be infringed by reproducing it in whole or in any substantial part, and by duplicating it exactly or by imitation or simulation. Wide departures or variations from the copyrighted works would still be an infringement as long as the author's "expression" rather than merely the author's "ideas" are taken.[156]
>
> Infringement takes place when any one of the rights is violated: where, for example, a printer reproduces copies without selling them . . . . The references to 'copies or phonorecords,' although in the plural, are intended here and throughout the bill to include the singular (17 U.S.C. § 101).[157]

On the other hand, the debate on the Copyright Act of 1976 on the floor of the House of Representatives included the following exchange between a principal sponsor of the Copyright Act, Robert Kastenmeier of Wisconsin, who served as Chair of the

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153 The Supreme Court in Sony Corp. of America v. Universal City Studios, Inc., 464 U.S. 417 (1984), discussed the considerations involved in contributory infringement in a case involving video recorders.

154 17 U.S.C. § 108(d)(1), (e)(1) (1994).

155 HOUSE JUDICIARY COMMITTEE REPORT ON THE COPYRIGHT ACT OF 1976, H.R. REP. NO. 1476, 94th Cong., 2d Sess. (1976).

156 *Id.* at 61.

157 *Id.*

House Intellectual Property Subcommittee, and Abraham Kazen, Jr. of Texas:

> MR. KAZEN: Am I correct in assuming that the bill protects copyrighted material that is duplicated for commercial purposes only?
>
> MR. KASTENMEIER: Yes.
>
> MR. KAZEN: In other words, if your child were to record off a program which comes through the air on the radio or television, and then used it for her own personal pleasure, for listening pleasure, this use would not be included under the penalties of this bill?
>
> MR. KASTENMEIER: This is not included in the bill. I am glad the gentleman raises the point. On page 7 of the report, under "Home Recordings," Members will note that under the bill the same practice which prevails today is called for; namely, this is considered both presently and under the proposed law to be fair use. The child does not do this for commercial purposes. This is made clear in the report.[158]

This colloquy provides some support for the view that copying for private use is not intended to be an infringement of the right of reproduction.

It is far from clear, however, what the intent of Congress was in terms of a private use exception. In his dissent in *Sony Corp. of America v. Universal City Studios, Inc.*,[159] Justice Blackmun quotes the language from the floor debate and argues that, in his view, these comments related to home reproduction of sound recordings, a relatively new area of copyright protection, and did not demonstrate a congressional intent "to create a generalized home-use exemption from copyright protection."[160] Justice Blackmun argued that Congress knew how to make a general exception and chose not to do so. In fact, the specific exemptions and limitations provided in the Copyright Act[161] suggest "[w]hen Congress intended special and protective treatment for private use . . . it said so explicitly."[162]

The majority in *Sony* declined to decide the issue of whether copying for private use was an infringement. Justice Stevens had

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158 117 CONG. REC. 34, 748-49 (1971), *quoted in Sony*, 464 U.S. at 472 (Blackmun, J., dissenting).

159 464 U.S. at 472 (Blackmun, J., dissenting).

160 *Id.* at 473.

161 For example, the exemption for library photocopying appears in 17 U.S.C. §§ 108(d)(1) and (e)(1), and the performance right is specifically limited to public performances by § 106(4).

162 *Sony*, 464 U.S. at 468.

suggested that the issue of private copying be addressed as a matter of statutory interpretation during the deliberations preceding the Court's decision. The late Justice Thurgood Marshall's papers, housed at the Library of Congress, include Justice Stevens' suggestions for what was then the minority position finding no infringement in home taping: "Quite remarkably, in the detailed revision of the entire law, Congress studiously avoided any direct comment on the single-copy-private-use question."[163]

In fact, as Paul Goldstein reports in his recent book *Copyright's Highway*, Justice Stevens thought there should be a statutory exception for private copying for the following reasons:

> (1) the privacy interests implicated whenever the law seeks to control conduct within the home; (2) the principle of fair warning that should counsel hesitation in branding literally millions of persons as lawbreakers; and (3) the economic interest in not imposing a substantial retroactive penalty on an entrepreneur who has successfully developed and marketed a new and useful product . . . .[164]

The final majority in *Sony* was silent, however, on the issue of private copying. The decision rested on the holding that the manufacturers and retailers of video copying equipment could not be held liable for contributory copyright infringement where there was a substantial non-infringing use for the equipment and inadequate demonstration of potential harm to either the market for or value of any copyrighted works reproduced.[165]

In *Williams & Wilkins Co. v. United States*,[166] which was affirmed without opinion by a divided Supreme Court, the lower court analogized copying by hand for personal use with photocopying for personal use and suggested that, since such hand copying had customarily been a permissible use, all copying for personal use may be outside the scope of copyright.[167] The court reasoned that the fact that photocopying facilitated the copying did not change the nature of the use.

Justice Blackmun discussed *Williams & Wilkins* in his *Sony* dissent.[168] He noted that there are no reported cases holding that hand copying for personal use is permissible. His fundamental dispute, however, was with the analysis that photocopying for personal

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163 GOLDSTEIN, *supra* note 2, at 150.
164 *Id.*
165 *Sony*, 464 U.S. at 456.
166 487 F.2d 1345 (Ct. Cl. 1973), *aff'd*, 420 U.S. 376 (1975).
167 *Id.*
168 *Sony*, 464 U.S. at 467 n.16.

use was analogous to hand copying. Blackmun argued that hand copying was different in kind because the "drudgery involved in making hand copies ordinarily ensures that only necessary and fairly small portions of a work are taken. . . . The harm to the copyright owner . . . thus is minimal."[169] Neither of these opinions, however, is controlling as to the issue of private copies or copying for personal use.

The issue of private copying is "a black hole in the center of American copyright legislation."[170] Indeed, the very meaning of "private copying" is unclear. What is personal use? To what extent are commercial uses included in use for personal convenience? Can a corporation or other business entity engage in "personal" use?

Given the stream of court decisions holding that digital "copies" can be an infringement—direct, contributory, and/or vicarious—the lack of guidance on permissible private use is particularly troubling. These issues will continue to be a source of litigation and unforeseen liability and may have unanticipated consequences for the progress of the arts and sciences.

D. *The Fair Use Defense to Copyright Infringement*

Fair use is a defense to copyright infringement.[171] In other words, given the language of the statute, the courts find any substantial copying to be a possible infringement subject to the limitations codified in section 107 of the Copyright Act:

> Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—
>
> (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
>
> (2) the nature of the copyrighted work;
>
> (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and

169 *Id.*
170 GOLDSTEIN, *supra* note 2, at 132.
171 17 U.S.C. § 107 (1994).

(4) the effect of the use upon the potential market for or value of the copyrighted work.

The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.[172]

Fair use is the most complex and difficult concept in copyright law.[173] Fair use analysis is fact-specific and has resulted in conflicting decisions, particularly in the area of computer technology.[174] In addition, once the issue of fair use is reached, the user has already been subject to suit, has been found to have engaged in potentially infringing activity, and has the burden of persuading the court that the infringement is excused by fair use.[175] In spite of its limitations, however, fair use appears to be the primary defense to copyright infringement by computer use.[176] It is therefore vitally important to understand the court decisions dealing with fair use in a digital environment or in analogous circumstances.

In a recent case, *American Geophysical Union v. Texaco Inc.*,[177] the Second Circuit considered whether scientists can lawfully photocopy articles occasionally from scientific journals. Copies of the journals were purchased by Texaco, circulated through its research department, and finally catalogued in the company's library. Scientists who found articles of interest would make copies to keep in their offices for future reference. The court held that this copying was not a fair use. As part of its analysis, the court suggested that given the relatively recent development of photocopy licens-

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172 *Id.*

173 GOLDSTEIN, *supra* note 2, at 196.

174 *See infra* notes 175-80, 182-93 and accompanying text.

175 American Geophysical Union v. Texaco, 60 F.3d 913, 918 (2d Cir. 1994) (citing Campbell v. Acuff-Rose, 114 S. Ct. 1164, 1177 (1994)).

176 17 U.S.C. § 117 (1994) permits the owner of a computer program to make a copy if it is required to use the program or if the copy is for archival purpose. Vault Corp. v. Quaid Software, Ltd., 847 F.2d 255 (5th Cir. 1988) relied on this provision to hold that there was no infringement. The court in *Vault* held that software purchasers are permitted to make copies for purposes not intended by the copyright owner if they meet the other requirements of this section. This decision has been criticized. *See* Arthur Miller, *Copyright Protection for Computer Programs, Databases, & Computer-Generated Works: Is Anything New Since CONTU?*, 106 HARV. L. REV. 977, 1016 (1993).

In a recent decision, the United States District Court for the Western District of Wisconsin held that section 117 permits the owner of copyrighted software to download unprotected material using the program (thereby copying it) and then make that unprotected material available over the Internet without liability for infringement. ProCD, Inc. v. Matthew Zeidenbert & Silken Mountain Web Servs., 908 F. Supp. 640 (W.D. Wis. 1996). There is language in this decision which suggests that this section is susceptible to extension to include a more generalized right of private use. *Id.* at 649; *see also* Aymes v. Bonnelli, 47 F.3d 23 (2d Cir. 1995).

177 60 F.3d 913 (2d Cir. 1994), *cert. dismissed*, 116 S. Ct. 592 (1995).

ing arrangements for individual articles,[178] the scope of fair use has changed and today excludes what may have been reasonable and customary use of copyrighted materials in the past. The court stated:

> Despite Texaco's claims to the contrary, it is not unsound to conclude that the right to seek payment for a particular use tends to become legally cognizable under the fourth fair use factor when the means for paying for such a use is made easier. This notion is not inherently troubling: it is sensible that a particular unauthorized use should be considered "more fair" when there is no ready market or means to pay for the use, while such an unauthorized use should be considered "less fair" when there is a ready market or means to pay for the use.[179]

This court found it reasonable that uses which had been customary and free are subject to a different fair use analysis when the market develops mechanisms to secure payment. The court specifically limited its holding to the institutional environment presented by this case.[180] However, the concept that "a reasonable and customary use becomes unfair when the copyright holder develops a way to exact an additional price for the same product" may have ramifications beyond the institutional setting.[181] Digital technology enables copyright owners to identify and charge users with great efficiency. The Second Circuit's analysis heavily weighs the fourth fair use factor against free use for digital use of copyrighted materials. It remains to be seen whether Congress or the courts will allow the area of fair and free use of information to be diminished as technology improves the efficiency of the marketplace.

Another aspect of the *Texaco* decision has implications for digital uses of copyrighted material. The Second Circuit found the "[m]echanical 'copying' of an entire document, made readily feasible and economical by the advent of xerography . . . [to be] an activity entirely different from creating a work of authorship."[182] The court reasoned that the traditional fair use analysis was developed to balance the interests of the original author and a second author who "'copies' a portion of the original work *in the course of*

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178 The court discussed the CCC, the Commerce Clearing Center, "a central clearinghouse established in 1977 primarily by publishers to license photocopying. . . . Most publishers are registered with the CCC, but the participation of for-profit institutions that engage in photocopying has been limited, largely because of uncertainty concerning the legal questions at issue in this lawsuit." *Id.* at 929 n.16.

179 *Id.* at 930-31.

180 *Id.* at 916.

181 *Id.* at 934 (Jacobs, J., dissenting).

182 *Id.* at 917.

producing what is claimed to be a new work."[183] The copying by Texaco's research scientists—of material that they could use in developing new products—was held to be mechanical copying and entirely different from the creative copying permitted by fair use.

This distinction between mechanical and creative copying is troubling. In the early Supreme Court case, *Burrow-Giles*,[184] the Court suggested that mere mechanical reproduction of an original work of art would not qualify for copyright protection because it lacked originality. However, in that case, the issue was whether a photograph included aspects of originality and whether the reproduction itself, the finished product, could be copyrighted. Where the reproduction is not the finished product, but a step along the way toward creating something new, it seems that the analysis should be different. It seems entirely possible for mechanical copying to be related to creative work. Personal notes of a lecture, notes taken from the transcript of a lecture, and an unauthorized photocopy of the transcript on which the user makes notes all provide similar assistance in the development of creative work. To distinguish between them in copyright terms appears to complicate rather than encourage the spread of knowledge and the enhancement of creativity.[185]

Digital translation is, of course, a kind of mechanical copying, using electricity. Digital copies of visual art can be used directly as a basis for the creation of new works. The reasoning of the Second Circuit, if extended to apply to digital use, appears to identify such copying as mechanical and non-creative and thus, very possibly, not a fair use.

The Ninth Circuit's analysis of fair use in *Sega Enterprises v. Accolade, Inc.*[186] resulted in a finding that even in a commercial setting copying could be fair. This case involved the unauthorized decompiling (involving exact copying) of a video game produced by Sega in order to discover the requirements for compatibility with equipment produced by Sega for playing its games, the so-called Genesis console. The defendant thereby produced games which users could play on Genesis. Because Sega produces games for its consoles, the defendant's games appear to have been in direct competition with Sega's. The defendant's games, however, did not incorporate any of the Sega program object code.

The court identified this kind of copying as "intermediate

183 *Id.* (emphasis added).
184 111 U.S. 53.
185 *See Texaco*, 60 F.3d at 934-36 (Jacob, J., dissenting).
186 977 F.2d 1510 (9th Cir. 1992).

copying," which, "[i]n light of the unambiguous language of the Act . . . may infringe the exclusive rights granted to the copyright owner in § 106 of the Copyright Act regardless of whether the end product of the copying also infringes those rights."[187] The issue, therefore, was not whether the end product was infringing but whether the copying used to produce that product was an infringement; this is part of the so-called "black hole" of copyright law—or, as the Ninth Circuit phrased it, "a question of first impression."[188] This court was reluctant to depart from the Ninth Circuit's precedent[189] which "was based on the plain language of the Act,"[190] but was also concerned about the extent of the copyright owner's monopoly versus the public interest. The court framed the considerations involved:

> We further note that we are free to consider the public benefit resulting from a particular use notwithstanding the fact the alleged infringer may gain commercially. . . . Public benefit need not be direct or tangible, but may arise because the challenged use serves a public interest. . . . In the case before us, Accolade's [the defendant's] identification of the functional requirements for Genesis compatibility has led to an increase in the number of independently designed video game programs offered for use with the Genesis console. It is precisely this growth in creative expression, based on the dissemination of other creative works and the unprotected ideas contained in those works, that the Copyright Act was intended to promote.[191]

The holding that the intermediate copying involved was a fair use rested on the finding that "the only way to gain access to the ideas and functional [non-copyrightable] elements embodied in a copyrighted computer program" was through disassembly of that program, and "where there is a legitimate reason for seeking such access, disassembly is a fair use."[192] The legitimate reason here was the development of competing games.

Advanced Computer Services of Michigan, Inc. v. MAI Systems Corp.[193] concerned the copying of a computer operating programs by a competitor seeking to service the plaintiff's computers. In order to gain access to the computers produced by MAI systems, it was necessary to use the MAI operating and diagnostic software.

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187 *Id.* at 1519.
188 *Id.*
189 Walker v. University Books, 602 F.2d 859 (9th Cir. 1979).
190 *Sega Enters.*, 977 F.2d at 1523.
191 *Id.*
192 *Id.*
193 845 F. Supp. 356 (E.D. Va. 1994).

Competitors seeking to service MAI computers must load these programs and, of course, MAI would not authorize such copying. This court found that the copying was not a fair use because it was a commercial use not outweighed by any public benefit achieved by lower service fees.[194] The character of the use by copying was not creative, the copying of the entire work "weighs against . . . fair use," and there was a "likelihood of future harm to the potential market."[195]

These cases illustrate the unpredictability of a fair use analysis when applied to the right of reproduction.[196] All three cases involve for-profit entities and exact mechanical copying of the entire work. In *Sega* and *MAI*, authorization to copy had been requested and refused, and competing products or services were produced. Only the *Sega* court found fair use, though.

E. *Conclusion: Who is in Wonderland, the Courts or Us?*

Techniques for making copies of graphic and literary art have improved dramatically in the twentieth century. Technology is now available to make good, reasonably priced color reproductions from either the original or a digital copy. Some computer reproductions of artistic images improve the original by sharpening the image, enhancing colors or light, or adjusting images in the composition.[197] In the past, fine art originals have been of central concern to artists. Because of computer technology, reproductions can be an additional source of remuneration for artists, a vehicle for disseminating their artistic conceptions more widely, as well as a cause for concern regarding infringement.

The Internet is another element in today's culture which vastly alters the means we use to communicate. The Internet is a system of interconnected computers.[198] Digital "copies" are made throughout this system; without digital copying the system would not function. The courts' reasoning in terms of copyright law appears to have little relevance to this new world of cyberspace. Indeed, G. Burgess Allison, author of a book on the Internet

194 In fact the court stated, "[m]oreover, MAI's higher service rates cannot be said to violate the public interest because MAI should be entitled to rely on service fees to recoup its investment costs in developing the software." *Id.* at 365.

195 *Id.* at 366.

196 *See* DSC Communications Corp. v. DGI Technologies, 898 F. Supp. 1183 (N.D. Tex. 1995), *aff'd* 81 F.3d 597 (5th Cir. 1996)(finding fair use); Compaq Computer Corp. v. Procom Technology, 908 F. Supp. 1409 (S.D. Tex. 1995) (finding no fair use).

197 If the owner of the copyright in an image authorized another to produce a reproduction using computer technology, there may be an issue of whether the resulting image is a joint work. *See* Ginsburg, *supra* note 140, at 1470-72.

198 G. BURGESS ALLISON, THE LAWYER'S GUIDE TO THE INTERNET 29-43 (1995).

published by the American Bar Association, described copyright law in cyberspace in the following manner:

> If you put something out on the net, it's generally treated as though you've turned it over to the public domain. The Internet community has an expansive and what I'm sure some would call a "novel" perspective on the fair-use exception to copyright law. Not to put too fine a point on it, but if a net user can somehow grab an electronic copy of something—by scanning it, running it through OCR [optical character reader], or grabbing a copy off a newspaper wire service—then that text or picture is likely to be spread around the net without regard to copyright protection or intellectual property rights.[199]

In contrast, the recent cases which have considered the right of reproduction contain the seeds of liability across a broad range of digital use of copyrighted material. Added to this is the fact that advancing technology may well make it possible for copyright owners to trace use of their works and demand payment.

It is difficult to predict the effect of the segregation between the realities of computer use and the reasoning adopted by the courts. One result may well be a decrease in the use of original materials in a computer context. In a recent book, *Digital Images: A Practical Guide*, the authors counsel:

> Tip #2: Assume Everything is Protected
> Prior to 1989, you could assume that any image or text published in the U.S. without a copyright notice was not protected under copyright law. That's because the law then required that all published works have a copyright notice on them.
>
> In 1989, that all changed. Copyright notice became optional. Now you have to assume that *all* images, text, and other works are protected by copyright law, regardless of whether there is a copyright notice on the work or not. This may put a crimp in your style; you should not copy anything published since 1922 unless there is a statement that the work is in the public domain. Still, it's better not to copy than it is to make a copy and get sued for it later. When in doubt, don't copy anyone else's work.[200]

This kind of *in terrorem* counselling may be wise but is hardly conducive to creative use of copyrighted material. When computers are employed to produce derivative works, which may be original and creative in terms of copyright law, the "black hole" of

199 *Id.* at 37.
200 GREENBERG & GREENBERG, *supra* note 23, at 273.

copyright law and the reach of the right of reproduction may well prevent the escape of creative endeavor.

VI. The Right to Prepare Derivative Works

Or, *"Twas brillig, and the slithy toves . . . ."*

"'It seems very pretty,' [Alice] said . . . , 'but it's *rather* hard to understand!' . . . 'Somehow it seems to fill my head with ideas—only I don't exactly know what they are!'"[201]

A derivative work is a "work based on one or more pre-existing works."[202] A lawful derivative work can have its own copyright but that copyright is limited to the original material contributed by the author.[203] Infringement of the right to prepare derivative works is an issue when there is "substantial similarity" between a copyrighted work and an unlicensed second work.[204] The principles seem simple until the courts attempt to apply them to the facts, and then they can become rather hard to understand. In fact, the Nimmers, in their treatise on copyright, state, "the determination of the extent of similarity that will constitute a *substantial* and hence, infringing similarity presents one of the most difficult questions in copyright law."[205] Again—a *most difficult* question!

The issues involved in copyright infringement of the derivative work right are indeed complex in the visual arts, particularly with respect to digital use of such art.[206] The speed and versatility of computers in altering visual images is a continuing source of creativity in the arts and confusion in copyright.

A. *Infringement of Derivative Work Right*

The scope and type of similarity required for infringement of the right to prepare derivative works has been examined by both commentators and the courts. Many different formulations of the general principles have been developed. The Nimmers state the problem this way:

It is clear that slight or trivial similarities are not substantial and

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201 Carroll, *supra* note 22, at 119.

202 17 U.S.C. § 101.

203 17 U.S.C. § 103(a)-(b) (1994).

204 *See* Alan Latman, *"Probative Similarity" as Proof of Copying: Toward Dispelling Some Myths in Copyright Infringement*, 90 Colum. L. Rev. 1187 (1990); Arnstein v. Porter, 154 F.2d 464 (2d Cir. 1946).

205 Nimmer & Nimmer, *supra* note 73, § 13.03[A].

206 One such added complication involves the issue of whether fixation is required for a work to infringe upon the derivative work right. As noted earlier in this paper, the court in *Lewis Galoob Toys, Inc.*, 964 F.2d at 968, suggested in dicta that, while fixation is required for a copyright in a derivative work, it is not necessary that a work be fixed in copyright terms to infringe.

> therefore non-infringing. But it is equally clear that two works may not be literally identical and yet, for purposes of copyright infringement, may be found to be substantially similar. The problem, then, is one of line drawing. Somewhere between the one extreme of no similarity and the other of complete and literal similarity lies the line marking off the boundaries of "substantial similarity." Judge Learned Hand has said that this line "wherever it is drawn will seem arbitrary" and that "the test for infringement of a copyright is of necessity vague."[207]

In an article published after his death, Alan Latman, longtime Dean of the copyright bar, discussed the analysis appropriate for a copyright infringement case.[208] First, copying must be proven, followed by "improper appropriation" of copyrightable expression.[209] Copying is an essential element of a violation of the right to produce derivative works. Copyright does not protect against another author's *independent* creation which is substantially similar to the first work, only against copying of the first work.[210]

Analysis of the similarity between the two works is used both to support an inference of copying and to prove improper appropriation. The evidence of similarity and standard of proof are different depending on which of the two elements is at issue. In his article, Alan Latman suggested that different terms be used for the two types of similarity involved: "probative similarity" to support an inference of copying and "substantial similarity" to prove improper appropriation. The above suggestion will be followed in this article in the interest of reducing confusion.

1. Probative Similarity: Largely Irrelevant

Probative similarity is important if direct evidence of copying is unavailable. In order to establish probative similarity, it is necessary to demonstrate that the defendant had access to the copyrighted work and that there is sufficient similarity between the two works to infer that the second was copied from the first. Probative similarity can be similarity of non-copyrightable expression, evidence of unusual errors repeated in both works, or identity of expression which is *de minimus* in quantity but unlikely to occur without copying.[211] The quotation from *Alice* which introduces this

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207 NIMMER & NIMMER, *supra* note 73, § 13.03[A] (footnotes omitted).
208 Latman, *supra* note 204.
209 *Id.* at 1192 (citing *Arnstein*, 154 F.2d at 468).
210 *Id.*
211 *Id.* at 1196.

section, "Twas brillig, and the slithy toves."[212] is clear evidence of copying because of the unusual nature of the "words." Expert evidence can be used to establish probative similarity and "dissection" of the work is appropriate.[213]

In the case of digital use of visual art, however, most cases will contain direct evidence of copying since the work must be copied to be used.[214] The *White Paper on Intellectual Property Rights* broadly defined the reproduction right to include all of the following computer uses of copyrighted material:

> * When a work is placed into a computer, whether on a disk, diskette, ROM, or other storage device or in RAM for more than a very brief period, a copy is made.
> * When a printed work is "scanned" into a digital file, a copy—the digital file itself—is made.
> * When other works—including photographs, motion pictures, or sound recordings—are digitized, copies are made.
> * Whenever a digitized file is "uploaded" from a user's computer to a bulletin board system (BBS) or other server, a copy is made.
> * Whenever a digitized file is "downloaded" from a BBS or other server, a copy is made.
> * When a file is transferred from one computer network user to another, multiple copies are made.
> * Under current technology, when an end-user's computer is employed as a "dumb" terminal to access a file resident on another computer such as a BBS or Internet host, a copy of at least the portion viewed is made in the user's computer. Without such copying into the RAM or buffer of the user's computer, no screen display would be possible.[215]

If use of a digitized image in a computer (absent a valid defense such as license or fair use) is a violation of the reproduction right, it may not be necessary to proceed to determine the issue of "substantial similarity" between the original and resulting work. The very act of using a computer to view the visual art would be an infringement; use to produce another work, even one bearing little or no similarity to the original, would be an infringement, albeit

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212 CARROLL, *supra* note 22, at 119.

213 Latman, *supra* note 204, at 1192.

214 Probative similarity could be an issue if the artist creates a work on the computer without first creating a digital copy of the work being used as a model. In this case, the computer is a tool analogous to oils and brushes and the copyright analysis likewise will be analogous to that applied to any two copies of visual art.

215 WHITE PAPER ON INTELLECTUAL PROPERTY RIGHTS, *supra* note 109, at 65-66 (citations omitted).

potentially difficult to prove. This could lead to inconsistent results.

For example, it is possible to establish that a particular copyrighted representational work by artist A was scanned to produce a computer image by artist B, who then manipulated the image to produce an abstract rendition of the original work. Artist A's and artist B's completed works may have little visual similarity to each other. Artist B, however, would have infringed artist A's reproduction right *if the scanning was unauthorized and unexcused by fair* use. Artist B's work would, in addition, probably meet the statutory definition of a derivative work because it is "based on a preexisting work." An interesting and thus far undecided issue in the visual arts is whether an abstract image can infringe the copyright in a representational image, or vice versa. It is possible that artist B's abstract rendition of artist A's work would be non-infringing because of a lack of substantial similarity.

In contrast, artist C may produce an abstract rendition of artist A's representational work by creating a computer image while viewing a lawfully obtained reproduction of A's work. In fact, the reproduction could be the same one used by B, the same image which he scanned to produce the digital copy. If the derivative work right in A's representational image is not infringed by the abstract version, C would have no liability for infringement of A's copyright, even if his work and B's were indistinguishable.

Probative similarity is largely irrelevant in the copyright analysis of computer-generated derivative works, given the court decisions holding digital translations to be "copies" for infringement purposes.[216] As the above illustration demonstrates, however, some computer uses are more akin to viewing or reading than traditional reproductions.

2. Substantial Similarity of Copyrightable Expression

If digital copying is either authorized or otherwise lawful, then improper appropriation of copyrighted expression, or "substantial similarity," is the key issue with respect to infringement of the right to prepare derivative works.[217] Alan Latman divided the derivative work analysis into three elements:

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[216] *See* NLFC, Inc. v. Devcom Mid-America, Inc., 45 F.3d 231, 234 (7th Cir. 1995); MAI Sys. Corp. v. Peak Computer, Inc., 991 F.2d 511 (9th Cir. 1993); *In re* Independent Serv. Orgs. Antitrust Litig., 910 F. Supp. 1537, 1541 (D. Kan. 1995); Advanced Computer Servs. of Mich., Inc. v. MAI Sys. Corp., 845 F. Supp. 356 (E.D. Va. 1994); Triad Sys. Corp. v. Southeastern Express Co., 31 U.S.P.Q.2d (BNA) 1239 (N.D. Cal. 1994).

[217] Latman, *supra* note 204, at 1189.

> (1) The defendant must have seen or heard the plaintiff's work at some time prior to creating his or her own work *and* have used plaintiff's work in some fashion as a model. Thus, "copying" in the first instance is the obverse of independent creation. [Probative copying.]
>
> (2) The material copied by the defendant from plaintiff's work must be such as enjoys protection under copyright. Thus, if all defendant copied from plaintiff's work was a report originally issued by the Department of Defense, such material is excluded by the statute from copyright protection, and defendant will not be held to have infringed.
>
> (3) Not only must defendant copy, rather than independently create, and not only must he or she copy protected material, but also such protected material must be "substantial." Thus, to satisfy this requirement, plaintiff would have to show a substantial degree or order of similarity or "substantial similarity" between the works of plaintiff and defendant.[218]

The improper appropriation analysis includes the latter two elements: the material copied must be copyrightable and must be substantial. Both of these elements require examination to understand their application to the visual arts.

a. What's Copyrightable in a Picture?

The issue of copyrightability of the material borrowed is fundamental. As the Supreme Court stated in *Feist Publications v. Rural Telephone Service*, "[n]ot all copying . . . is copyright infringement."[219] In *Feist*, the copying was of non-expressive, factual information, the white pages of a telephone directory. Only original works, not factual information, are proper subjects for copyright.[220]

Likewise, while copyright protects expression, the idea expressed cannot be monopolized. This distinction originated in case law and is now codified in the definition of copyrightable subject matter. Section 102(b) of the Copyright Act provides: "[i]n no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work."[221]

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218 *Id.* (citation omitted).
219 499 U.S. 340, 361 (1991).
220 The selection and arrangement of factual information may be copyrightable, but the facts themselves are not. *See id.*
221 17 U.S.C. § 102(b).

The idea/expression distinction seems like a fairly simple concept, but it can be difficult to apply in a consistent manner. This is particularly true of non-literary works. In *Warner Brothers, Inc. v. ABC, Inc.*,[222] the court was confronted with the issue of whether the fictional character, Ralph Hinkley, in the television show *The Greatest American Hero*, infringed the character of Superman. As the court stated, "[w]hen, as in this case, the claim concerns infringement of a character, rather than a story, the idea-expression distinction has proved to be especially elusive."[223]

In the visual arts the subject matter is sometimes equated with the idea. The original subject matter corresponds to the idea, the treatment to the expression. In *Kisch v. Ammirati & Puris Inc.*,[224] two photographs were compared to determine if there was an infringement. The similarities included: use of the same site, use of an individual holding a musical instrument against the same "striking mural" in the background, and use of similar lighting and camera angle.[225] Otherwise, there were numerous differences: the original was black and white, while the defendant's was in color, the person in each photograph was different, and they were holding different musical instruments.[226] The idea and expression were difficult to distinguish, making the court uneasy:

> Troublesome, too, is the fact that the same general principles are applied in claims involving plays, novels, sculpture, maps, directories of information, musical compositions, as well as artistic paintings. Isolating the idea from the expression and determining the extent of copying required for unlawful appropriation necessarily depend to some degree on whether the subject matter is words or symbols written on paper, or paint brushed onto canvas.[227]

The court found that the second, colored photograph infringed the copyright of the original, black and white picture.

At times the courts seem to reach the conclusion regarding infringement first, then use the idea/expression formula as justification. In *Herbert Rosenthal Jewelry Corp. v. Kalpakian*,[228] a copy of a piece of jewelry in the shape of a jeweled bee was held to be non-infringing.[229] The court explained: "We think the production of

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222 720 F.2d 231 (2d Cir. 1983).
223 *Id.* at 240.
224 657 F. Supp. 380 (S.D.N.Y. 1987).
225 *Id.* at 384.
226 *Id.*
227 *Id.* at 383; *see Franklin Mint Corp.*, 575 F.2d at 65; *see also Warner Bros.*, 720 F.2d at 241.
228 446 F.2d 738 (9th Cir. 1971).
229 *Id.*

jeweled bee pins is a larger private preserve than Congress intended to be set aside in the public market without a patent. *A jeweled bee pin is therefore an 'idea' that defendants were free to copy.*"[230]

In *F. W. Woolworth Co. v. Contemporary Arts, Inc.*,[231] in contrast, a copy of a statue of a cocker spaniel in show position was held as infringing even though the original statue was a reasonably close representation of this type of show dog.[232] In fact, the court noted that none of the following aspects of the work were copyrightable: size, material, color (because cockers are of only certain colors), and stance (because the show position is standard).[233] The copyrightable expression included "proportion, form, contour, configuration, and conformation, perhaps the latter in details too subtle for appreciation by anyone but a fancier of the dog represented."[234] "Twas brillig, and the slimey toves"[235] is almost as easy to understand as this distinction.

Gentieu v. John Muller & Co.[236] involved photographs of babies and illustrates another aspect of the idea/expression analysis. The court in *Gentieu* held that the plaintiff could not copyright her photographs of "floating naked babies" on the grounds that the subject matter was an idea and the poses of the babies were inseparable from the idea.[237] In fact, the court commented, "[s]ome ideas permit only a limited number of expressions. When there is essentially only one way to express an idea, the idea and its expression are inseparable and copyright is no bar to copying the expression."[238]

While merger of idea and expression results in lack of copyright protection for the work, the court also held that when there are only a limited number of ways of expressing an idea, copyright protection is weak and the plaintiff's burden of proof is substantially greater.[239] As the court in *Gentieu* phrased it, "[t]his [proof of near identity between the works] is necessary because, as idea and expression merge, fewer and fewer aspects of a work embody a unique and creative expression of the idea."[240]

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230 *Id.* at 742 (emphasis added).
231 193 F.2d 162 (1st Cir. 1951), *aff'd*, 344 U.S. 228 (1952).
232 *Id.*
233 *Id.* at 164-65.
234 *Id.* at 164.
235 CARROLL, *supra* note 22, at 119.
236 712 F. Supp. 740 (W.D. Mo.), *dismissed without opinion*, 881 F.2d 1082 (8th Cir. 1989).
237 *Id.* at 743.
238 *Id.*
239 *Id.* The Nimmers have criticized this position. *See* NIMMER & NIMMER, *supra* note 73, § 13.03[B][3].
240 712 F. Supp. at 743.

The language in *Gentieu* suggests that creativity is the focus in the idea/expression analysis as applied to works of art. The common thread appears to be that an uncommon means of expression of the subject matter is necessary for copyright protection. Where "unique and creative" aspects of the work of art cannot be convincingly identified, the courts are reluctant to protect it on the grounds that the work expresses nothing beyond an idea.[241] It is ironic that, even though creativity is not specified or defined in the Copyright Act, the idea/expression analysis of cases involving the visual arts supports the Copyright Office's and the Nimmers' position that creativity is a basic definitional requirement for protection of works of art.[242]

The court in *Universal Athletic Sales Co. v. Salkeld*,[243] described the relationship between creativity and effort: "[t]he smaller the effort (e.g. two words) the greater must be the degree of creativity in order to claim copyright protection."[244] In this case, simple figures drawn to illustrate use of exercise equipment were held non-infringing. It appears that the lack of "effort" is akin to a lack of artistic skill and training — or use of that skill in producing a work. In fact, the figures at issue in this case were so simple that they were not creative or a unique way of expressing the idea.[245]

Creativity, however, is an amorphous requirement. In fact, a convincing argument can be made that it is inappropriate for those "trained only in the law" to make judgments regarding the creative aspects of a work of visual art.[246] One popular dictionary defines "creative" as "marked by originality and expressiveness; imaginative."[247] In contrast to the legal definition of "originality" for copyright purposes, the dictionary definition of original is "fresh and unusual; . . . new; . . . inventive; . . . an authentic work of art."[248]

The implications of using a statute written by lawyers for the protection of literary works to protect works of visual art become more obvious when more of the cases are examined. The distinctions between idea and expression, between the non-copyrightable fact or *scenes a faire* and creative expression of a realistic or commonplace scene, and between the public domain and the original use of that domain are central to copyright protection. They re-

241 *Id.*
242 *See supra* text accompanying notes 73-85.
243 511 F.2d 904 (3d Cir.), *cert. denied*, 423 U.S. 863 (1975).
244 *Id.* at 908 (citation omitted).
245 *Id.* at 904.
246 *See supra* note 7.
247 THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 48 (3d ed. 1992).
248 *Id.* at 1276.

quire an examination of images, forms, shapes, values, colors and shades of colors, and composition by "men trained only in the law."

b. Quality, Size, and Medium of Expression are Not Relevant

Certain principles are often restated. First, a work of visual art can be an infringing derivative work regardless of differences in quality, size, and medium of expression. In *Bleistein*, "cheap electrotype plates" of circus posters were held to be infringing copies.[249] In *Rogers*,[250] the infringing copies were substantially more valuable than the original, in fact "bettered the price of the copied work by a thousand to one."[251]

Rogers demonstrates that the reproduction can be in a different medium as well. In this case, the original photograph of a couple with a litter of puppies was copied in sculpture. The lower court surveyed copyright cases and determined that "[i]n copyright law the medium is not the message, and a change in medium does not preclude infringement. . . . Differences which relate merely to size and material are not important."[252]

The court continued that a chair manufacturer could copy a photograph with a picture stamped on the leather bottoms and backs,[253] a piece of statuary could infringe a picture of the statuary,[254] and a doll can be a copy of a cartoon.[255] In *Rogers*, a large sculpture of a couple holding a litter of puppies was produced using a postcard reproduction of the original photograph. There was direct evidence of copying; the postcard was sent to those fabricating the sculpture to use as the model. Although generally the copyrightable expression in a photograph consists of the lighting, placement, and expressions of the subjects, in this case a large three-dimensional, and immensely more valuable, sculpture was held to have appropriated the photographer's expression.[256]

In another case, *Time Inc. v. Bernard Geis Associates*,[257] an art-

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249 *Bleistein*, 188 U.S. at 241.

250 Rogers v. Koons, 751 F. Supp. 474 (S.D.N.Y. 1990), *aff'd*, 960 F.2d 301 (2d Cir.), *cert. denied*, 506 U.S. 934 (1992).

251 *Rogers*, 960 F.2d at 303.

252 *Rogers*, 751 F. Supp. at 477.

253 *Id.* (citing Falk v. T. P. Howell & Co., 37 F. 202 (S.D.N.Y. 1888)).

254 *Id.* (citing King Features Syndicate v. Fleischer, 299 F. 533, 536 (2d Cir. 1924)).

255 *Id.* at 478 (citing Fleischer Studios, Inc. v. Ralph A. Freundlich, Inc., 73 F.2d 276 (2d Cir. 1934)); *see* NIMMER & NIMMER, *supra* note 73, § 2.08[E].

256 *Rogers*, 751 F. Supp. at 308.

257 293 F. Supp. 130 (S.D.N.Y. 1968). In this case, Abraham Zapruder, a Dallas dress manufacturer, happened to be filming President John F. Kennedy's car during the assassination. Zapruder's films and the copyrights were purchased by *Life* and still frames were made from the film. These stills were then sketched by an artist for the defendant in this case, after *Life* refused permission for use of the pictures in a book on the assassination. *Id.*

ist's charcoal sketches of copyrighted still photos were held to be copies that would be infringing in the absence of fair use. Photographs can be infringing copies of a theatrical work.[258]

From these cases it appears clear that digital images can be infringing versions of any copyrighted work regardless of the medium of the original work or the quality of either the original or the digital version.

c. Identity of Artist

An artist who prepares an original work for hire or assigns his rights in his work to another must consider whether subsequent work is substantially similar to the earlier version. It is theoretically possible for an artist to infringe a copyright in his own, earlier work. In the computer context, the speed with which works can be created, altered, transmitted, and printed may create a lively interest in this possibility.

Courts appear to be reluctant to find copyright infringement where the same artist is involved, but the similarity analysis explicitly applied does not differ when the same artist produced both the original and the infringing work. Given the difficulties of the similarity analysis, particularly as applied to visual art, artists can be in the unenviable position of being unsure of the extent to which their earlier work may limit later expression.

In *Gross v. Seligman*,[259] an original photograph entitled *Grace of Youth* was sold with all rights to the plaintiff. Two years later, using the same model in a slightly different pose and with a somewhat different background, the photographer made a second picture which was found to infringe the right to reproduce the first. The court stated:

> Whether the model in the second case was posed, and light and shade, etc., arranged with a copy of the first photograph physically present before the artist's eyes, or whether his mental reproduction of the exact combination he had already once effected was so clear and vivid that he did not need the physical reproduction of it, seems to us immaterial.[260]

It is well established that "copying from memory is no less actionable than is copying from direct view."[261] Therefore, in the

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[258] Nikanov v. Simon & Schuster, Inc., 246 F.2d 501 (2d Cir. 1957); Walt Disney Prods. v. Mature Pictures Corp., 389 F. Supp. 1397 (S.D.N.Y. 1975).

[259] 212 F. 930 (2d Cir. 1914).

[260] *Id.*

[261] NIMMER & NIMMER, *supra* note 73, § 13.01[B] (citation omitted).

case of computer use of art, an infringing derivative work could be created by an artist who recreates a "substantially similar" image without actually reproducing his own earlier version in a digitized copy.

In *Franklin Mint Corp. v. National Wildlife Art Exchange, Inc.*,[262] a watercolorist produced a painting of *Cardinals on Apple Blossom* which he sold, with copyrights, to National Wildlife Exchange. Later, using some of the same source material as well as different photographs and slides, he produced *The Cardinal* for the Franklin Mint Corporation. The court opined that while "[c]opying done from memory is as objectionable as that done by tracing or direct view,"[263] an artist must be able to produce variations on the same theme. Here the court found that the later painting did not infringe because a realistic painting has a weak copyright. As stated by the court, "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*."[264]

A problem raised but not resolved by this court is whether an artist using a more distinctive style can infringe the copyright in one of his own works once that work has been assigned with all rights. Many artists develop a distinctive style and return to the same subject matter, as Degas in his studies of ballerinas or Monet in his depictions of the Rouen Cathedral. The court in *Franklin Mint* examined the issue of infringement as though the copyright owners were the artists. The ground for the decision was that the copyright in realistic watercolor was weak. Although the court mentioned the fact that the same artist produced both works as relevant to the fact that one can copy from memory, there was no indication that one cannot infringe a copyright in one's own work.

In *Esquire, Inc. v. Varga Enterprises, Inc.*,[265] the lower court was confronted with an artist having a distinctive style and the allegation of infringement of the copyright in artwork owned by *Esquire* magazine by later work of the same artist. The plaintiff corporation had employed the artist to produce what they refer to as "'girl' painting[s] . . . [a] particular form of art [which] portrays women in a state of semi-nudity and emphasizes, or rather over-emphasizes, many of the physical details peculiar to the female anat-

262 575 F.2d 62 (3d Cir.), *cert. denied*, 439 U.S. 880 (1978).
263 *Id.* at 64.
264 *Id.* at 65 (emphasis added).
265 81 F. Supp. 306, 307 (N.D. Ill. 1948), *aff'd in part* (on copyright infringement), *rev'd in part*, 185 F.2d 14 (7th Cir. 1950).

omy."[266] These paintings appear to have been in a style which could not be termed "realistic" and which did not portray women with photographic accuracy. At the termination of his relationship with the plaintiff corporation, the artist furnished similar paintings for the defendant which were published on calendars; hence the suit for infringement. The court suggests that this artist will never produce anything substantially different:

> It is apparent from the testimony that this is all he has ever drawn and seems to be all he ever will draw. It follows, therefore, that all his future drawings will bear some similarity to his previous work, whether or not his past creations are before him at the time he is painting. He has a certain type of art in his mind and, consequently, that is all he is able to express on the drawing board.[267]

Instead of attempting to refine copyright principles to deal directly with this problem, unique to the visual arts, the court then proceeded to find differences in the paintings to justify a holding that the calendars were not reproductions, again analyzing the works using the same principles applied to works by different artists. It seems that visual artists may be subject to suit for infringement when their later works "copy" their earlier works, in whatever medium. While courts are understandably reluctant to find infringement in these cases, the applicable legal standards leave artists vulnerable.[268] The rapidity and pervasiveness of digital use of visual work exacerbates this vulnerability.

In reviewing the lower court's holding in *Esquire,* the Seventh Circuit Court of Appeals made observations which are relevant to the right to prepare derivative works. On appeal, the plaintiffs argued that the lower court had, in essence, held that because there were sufficient differences between the plaintiff's copyrighted drawings and the defendant's subsequent drawings, there was no infringement irrespective of whether there was copying in the first instance. The Seventh Circuit disagreed, finessing the issue of whether copying is an infringement in the absence of an infringing derivative work, and held that the lower court's position was that "there were . . . distinctions sufficient to remove [the works] from

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266 *Id.*

267 *Id.* at 307-08.

268 Artists would be well advised to seek a contractual solution to this vulnerability to suit, if possible. Unfortunately, given the inequality of bargaining power between the individual artist and the businesses in the market for their works, it is unlikely that the artist could obtain this kind of concession. Likewise, businesses are understandably anxious that the products they use are perceived as unique by consumers. The equities require more delicate balancing than is now applied in the copyright analysis of the visual arts.

the category of copied works."[269]

It seems that an artist can use a copyrighted work as a model and vary his own work sufficiently to avoid infringement of the derivative work right.[270] How much variation is sufficient and how much of the original can be used by a second artist is difficult to predict. Various formulations have been suggested by both the courts and commentators.

d. Comprehensive Nonliteral Similarity and Fragmented Literal Similarity: Do These Approaches Aid Us in Comparing Works?

The Nimmers describe two kinds of similarity analyses which can be employed to determine if unlawful copying has occurred: comprehensive nonliteral similarity and fragmented literal similarity.[271]

Fragmented literal similarity occurs when there is virtual copying of a portion of a copyrighted work, but neither the substance nor the overall composition of the work has been copied.[272] For example, a part of a painting or photograph could be scanned and combined with other images to produce a new work. A collage is essentially a collection of images produced by others. With new technology, two or more photographs can be combined to form strikingly different compositions. The issue is "[a]t what point does such fragmented similarity become substantial so as to constitute the borrowing an infringement?"[273]

While the rules are clear, their application to the visual arts is not. If what is taken is a "qualitatively important" aspect of the copyrighted work, then there is infringement.[274] Even if what is taken is an unimportant part of the second work, infringement can occur if what is taken is of importance to the copyrighted work. The test to be applied was stated by Justice Story: "If so much is taken, that the value of the original is sensibly diminished, or the labors of the original author are substantially to an injurious extent appropriated by another, that is sufficient, in point of law, to constitute a piracy *pro tanto*."[275]

The application of this test requires a value judgment by the

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269 Esquire, Inc. v. Varga Enters., Inc., 185 F.2d 14 (7th Cir. 1950).
270 NIMMER & NIMMER, *supra* note 73, § 13.03[B].
271 *Id.* at § 13.03[A][1].
272 *Id.*
273 *Id.*
274 *Id.*
275 Folsom v. Marsh, 9 F. Cas. 348 (C.C. Mass. 1841) (No. 4,901), *cited in* NIMMER & NIMMER, *supra* note 73, § 13.03[A].

trier of fact and the results are difficult to predict. Returning to the children's book with which this paper began, if I scanned several copyrighted fine art reproductions, taking a mountain from one, a cottage from another, trees and other foliage from several others and combined these in my own composition with my photograph of a child, the issue of copyright infringement would be different for each work I use. I could be an infringer even though my final product bears no resemblance to any of the works I copied.

Comprehensive nonliteral similarity relates to a more substantial borrowing from a copyrighted work. In this case, there is not necessarily literal copying. The Nimmers describe this as "similarity not just as to a particular line or paragraph or other minor segment, but where the fundamental essence or structure of one work is duplicated in another."[276] This definition was clearly written for literary works but appears to be generally applicable across the range of copyrighted materials. In fact, the cases cited in support of the definition include computer software cases such as *Computer Associates International Inc. v. Altai Inc.*[277] This definition could clearly provide a basis for finding an abstract version of a representational painting to be infringing because the structure of the work is copied. How much of an artistic composition, however, is commonplace or an idea unprotectable by copyright, is difficult to assess.

Judge Hand suggested the "abstractions test" as a guide:

> Upon any work, and especially upon a play a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the play is about and at times consist only of its title, but there is a point in this series of abstractions where they are no longer protected since otherwise the playwright could prevent the use of his ideas, to which, apart from their expression, his property is never extended.[278]

Professor Zechariah Chafee added the pattern test:

> No doubt the line [between expression and idea] does lie somewhere between the author's idea and the precise form in which he wrote it down. I like to say that the protection covers the "pattern" of the work . . . the sequence of events and the devel-

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[276] NIMMER & NIMMER, *supra* note 73, § 13.03[A][1] (citations omitted).

[277] 982 F.2d 693, 701 (2d Cir. 1992).

[278] Nichols v. Universal Pictures Co., 45 F.2d 119, 121 (2d Cir. 1930), *quoted in* NIMMER & NIMMER, *supra* note 73, § 13.03[A][1][b].

opment of the interplay of characters.[279]

The comparison of the total image, including unoriginal aspects, may be appropriate in the copyright analysis of visual arts. In *Roth Greeting Cards v. United Card Co.*, the court coined the phrase "total concept and feel" of the two works to be compared as a standard of similarity.[280] In *Roth*, the court was explicit that the entire work, including non-copyrightable text, should be included in the comparison:

> [T]he textual matter of each card, considered apart from its arrangement on the cards and its association with artistic representations, was not original to Roth and therefore not copyrightable. However, proper analysis of the problem requires that all elements of each card, including text, arrangement of text, art work, and association between art work and text, be considered as a whole.[281]

This rubric, "total concept and feel," was reiterated in the important Ninth Circuit case, *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*[282] *Krofft* established the extrinsic/intrinsic test for copyright analysis. In the words of the Ninth Circuit:

> The test for infringement therefore has been given a new dimension. There must be ownership of the copyright and access to the copyrighted work. But there also must be substantial similarity not only of the general ideas but of the expressions of those ideas . . . . The determination of whether there is substantial similarity in ideas may often be a simple one. . . . We shall call this the "extrinsic test." It is extrinsic because it depends not on the responses of the trier of fact, but on specific criteria which can be listed and analyzed. . . .
>
> The determination of when there is substantial similarity between the forms of expression is necessarily more subtle and complex. . . . The test to be applied in determining whether there is substantial similarity in expressions shall be labeled an intrinsic one—depending on the response of the ordinary reasonable person.[283]

The court used a painting and a plaster recreation of a nude as an example of the application of these tests. The Ninth Circuit stated that a painting of a nude would not employ the same idea as

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279 Zechariah Chafee, *Reflections of the Law of Copyright*, 45 COLUM. L. REV. 503, 513 (1945), *quoted in* NIMMER & NIMMER, *supra* note 73, § 13.03[A][1][b].
280 429 F.2d 1106, 1110 (9th Cir. 1970).
281 *Id.* at 1109 (citation omitted).
282 562 F.2d 1157, 1166-67 (9th Cir. 1977).
283 *Id.* at 1164.

a plaster recreation of a nude human figure and therefore could not infringe.[284] Given the long line of cases holding that copying of an original art work can be actionable regardless of the medium employed, this aside surely requires some explanation. The court continued to say that the criteria used to apply the extrinsic test include "the type of artwork involved, the materials used, the subject matter, and the setting for the subject."[285]

The intrinsic test uses the impression of the "ordinary reasonable person" as the criterion for the similarity analysis. Expert testimony is irrelevant because the issue is "whether defendant took from plaintiff's works so much of what is pleasing to the ears of *lay* listeners, who comprise the audience for whom such popular music is composed, that defendant wrongfully appropriated something which belongs to the plaintiff."[286] In general, the trier of fact is to make this determination based on his "net impression" of the works, "ignoring any particular impressions of similarity found by dissecting and examining elements of the two works."[287]

This so-called "audience test" has been criticized as "an attempt at applying the 'reasonable person' doctrine . . . found in other areas of the law to copyright."[288] Whereas a reasonable person can judge what is negligent by comparing his own responses to those of the defendant's, the critics suggest that the layman is not equipped to determine whether the defendant author achieved his results through copying, particularly when his conclusions are based on his "impressions." As Judge Clark put it in his dissent in *Arnstein v. Porter*, "I find nowhere any suggestion of two steps in the adjudication of this issue [similarity], one of finding copying which may be approached with musical intelligence and assistance of experts, and another that of illicit copying which must be approached with complete ignorance . . . ."[289]

In general, dissection of a work is inappropriate in the similarity analysis.[290] As noted above, the audience test relies on the nonanalytic impressions of the lay audience for which the work is intended. In *Aliotti v. R. Dakin & Co.*,[291] the court made clear that

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284 *Id.*
285 *Id.*
286 *Arnstein*, 154 F.2d at 473 (emphasis added).
287 NIMMER & NIMMER, *supra* note 73, § 13.03[E][2] (citing Solomon v. RKO Radio Pictures, 44 F. Supp. 780 (S.D.N.Y. 1942)); *see* Universal Athletic Sales Co. v. Salkeld, 511 F.2d 904 (3d Cir. 1975).
288 NIMMER & NIMMER, *supra* note 73, § 13.03[E][2].
289 154 F.2d at 476.
290 *See Roth Greeting Cards*, 429 F.2d 1106; Aliotti v. R. Dakin & Co., 831 F.2d 898 (9th Cir. 1987); McCulloch v. Albert E. Price, Inc., 823 F.2d 316 (9th Cir. 1987).
291 831 F.2d 898.

the similarity analysis cannot rely on an analysis of dissimilar characteristics.[292] The Nimmers emphasize the point that: "It is entirely immaterial that, in many respects, plaintiff's and defendant's works are dissimilar, if in other respects, similarity as to a substantial element of plaintiff's work can be shown. 'No plagiarist can excuse the wrong by showing how much of his work he did not pirate.'"[293]

In *Data East USA, Inc. v. Epyx, Inc.*,[294] the Ninth Circuit found the dissection permissible. The court held that, in order to determine whether substantial similarity resulted from unprotectable ideas, dissection of similarity is permissible and, if this demonstrates that *all* similarities flow from the use of common ideas, then there can be no finding of substantial similarity.[295]

After this analysis is performed, it appears that the works must be considered as a whole to compare the total concept and feel of the works. The "total concept and feel" cases support the proposition that non-copyrightable aspects of the works are included in the similarity analysis—unless *all* similarities arise from common ideas and are therefore non-copyrightable.[296]

In the visual arts it would be unusual to find that all similarities necessarily flow from the expression of a common idea. In addition, it is difficult for the non-artist to determine which expressions *necessarily* flow from an idea and which expressions are unique.

B. *Example:* Steinberg v. Columbia Pictures. *Did the Movie Ad "Copy" the Magazine Cover?*

Whether these formulations are helpful in assessing the copyrightable portions of a work of visual art is unclear. In order to assess their utility it may be helpful to examine a specific example dealing with a rather well-known image.

In *Steinberg v. Columbia Pictures Industries*,[297] two posters were compared, one created to advertise the movie *Moscow on the Hudson* and the other prepared by artist Saul Steinberg for the cover of *The New Yorker*, illustrating "a parochial New Yorker's view of the world."[298] Both posters present a "myopic view" of the world in which the buildings and streets of New York are emphasized and

292 *Id.* at 901.
293 *See* NIMMER & NIMMER, *supra* note 73, § 13.03[B][1][a] (citing Sheldon v. Metro-Goldwin Pictures Corp., 81 F.2d 49 (2d Cir. 1936)); *Universal Athletic Sales Co.*, 511 F.2d at 904.
294 862 F.2d 204 (9th Cir. 1988).
295 *Id.*
296 *Aliotti*, 831 F.2d at 901.
297 663 F. Supp. 706 (S.D.N.Y. 1987).
298 *Id.* at 709.

the view of the rest of the world miniaturized; both sought to achieve a "recognizably New York look."[299]

Steinberg did not use any actual buildings in New York but was inspired by the general look of the city. Likewise, the *Moscow* poster created the same impression without using actual structures. Many of the details in the posters are different, such as the sizes of the buildings, the placement of pedestrians and vehicles, and the backgrounds. However, this court rejected the defendant's position that the plaintiff's poster contained an uncopyrightable depiction of a standard street scene; a wide avenue intersecting two avenues, with the background telescoping into miniature details. This court found the artist's "choice of perspective and lay-out" as well as his "style" to be protectable expression.[300]

There was evidence of copying of certain details, fragmented literal similarity, in this case which may have affected the outcome as much as the similarity in general impression created by the two posters, comprehensive nonliteral similarity. The court noted, "[t]he close similarity [between the posters] can be explained only by the defendants' artist having copied the plaintiff's work. Similarly, the locations and size, the errors and anomalies of Steinberg's shadows and streetlight, are meticulously imitated."[301] In contrast, the simplicity of the design of the Steinberg poster, in conjunction with the standard artist's technique of telescoping a cityscape and the pedestrian street scene depicted, could have militated against a finding of unique expression.

In its dissection of the two posters, however, the *Steinberg* court made no explicit distinction between probative and substantial similarity, between uncopyrightable and original expression. Certain of the similarities are standard artist's techniques, analogous to the literary *scene a faire*; others are standard street scene details. The total impression created by the posters, including non-copyrightable aspects, appear to have factored in the court's similarity analysis.

This case could have focused on the idea/expression dichotomy in copyright analysis. The idea that New Yorkers believe their city is the center of the universe is expressed by telescoping the rest of the world. Another common image is the map of the United States from the viewpoint of a resident of Cape Cod. In this view, Cape Cod is enormous and the rest of the continent is a small ap-

299 *Id.* at 710.
300 *Id.* at 712.
301 *Id.* at 713.

pendage. The idea of telescoping appears to flow from the idea of egocentricity expressed in an image. The exaggeration of the Cape is using a geographical feature in relation to another geographical feature. The enlargement of the city in relation to a state or another city could be analogous, flowing from the idea that New Yorkers/Cape Codders lack perspective.

Can these ideas be expressed in another image? Can they be expressed as clearly? Or are these images part of our culture, the imagery we use as a visual language? If the images are part of our visual language, then it is not surprising that two posters which express the same idea are substantially similar. The second would not improperly appropriate anything belonging to the first artist because this imagery is not *his* but *ours*.[302]

The various formulations and distinctions developed by the courts to assist in the comparison of two works to determine if one is "based on" or "derived from" another clearly assist us in analyzing the two posters in *Steinberg*, but do not assist in predicting a result. The court justified its result in copyright terms. However, as demonstrated by the discussion above, the opposite result could have just as easily been justified.

The similarity analysis required to determine whether a derivative work infringes the copyright in another work is beset with difficulties, and is "of necessity vague."[303] The Third Circuit in *Universal Athletic Sales Co.* concluded, "[a] review of copyright infringement decisions confirms the observation that most cases are decided on an *ad hoc* basis."[304]

C. *Copyright in a Derivative Work*

If a derivative work is lawful and fixed, it can be copyrighted. The statute specifies that the copyright in a derivative work extends only to the original contribution of the author of the derivative work and does not in any way affect any rights which may exist in the original.[305] It is conceivable that computerized manipulation of a visual image may be authorized by the copyright owner, perhaps in return for a fee for the license. The issues then involve the

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[302] When I was teaching art to children, I used a very similar street scene as that in the Steinberg poster to teach perspective. This is a common exercise in art classes and always includes the buildings, vehicles, and cross streets. The New York court's finding of infringement may be proof of the idea expressed in the Steinberg poster, the New Yorker's myopic view of the world.

[303] Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487, 489 (2d Cir. 1960).

[304] Universal Athletic Sales Co. v. Salkeld, 511 F.2d 904, 907 (3d Cir. 1975).

[305] 17 U.S.C. § 103(b).

second artist's rights in his new work.[306]

Some of the issues are similar to those implicated in the copyright analysis of a non-derivative original work, but they are complicated by the rights of the original author and the balancing required to accommodate the rights of other authors and society's interests.

The originality required to support a copyright in a work is minimal. If that work is based on another copyrighted work, it would seem logical that the originality required for the derivative would be similar. That conclusion, however, is not supported by the case law.

In *Gracen v. Bradford Exchange*,[307] the court refused to allow the plaintiff to copyright her painting of Dorothy from *The Wizard of Oz* on the grounds that there was an insufficient difference between the plaintiff's Dorothy, a derivative work, and the original copyrighted photographs of Dorothy and the original copyrighted movie.[308] This court required a greater degree of originality for copyright in a derivative work. The court held that there must be "a sufficiently gross difference between the underlying and the derivative work to avoid entangling subsequent artists depicting the underlying work in copyright problems . . . [a] derivative work must be *substantially different* from the underlying work to be copyrightable."[309] The court went on to note that if the plaintiff had painted Dorothy from life—rather than from copyrighted images, photos, or the movie (her memory of the movie, specifically)—her work would be copyrightable. The greater degree of originality is required only because her work was a derivative one. To paraphrase Justice Holmes, others must be free to copy the original (uncopyrighted) subject matter, even if all the copies end up looking substantially alike.

The *Gracen* court's holding is consistent with holdings in other

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306 It is conceivable that an authorized digital art reproduction could be a joint work, as well. 17 U.S.C. § 101 defines a joint work as "a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole." While I will not discuss this aspect of the copyright in detail, it is important to note that art work which is created with the intention of transforming it into digital form, perhaps in an interactive environment with the user, could have multiple authors. Each author has a copyright in a joint work, an issue that should be fully explored by artists in this environment.

307 698 F.2d 300 (7th Cir. 1983).

308 An additional factor in this decision was the court's understanding of the scope of the license granted by the copyright owner to the plaintiff. The court questioned whether the owner had licensed the plaintiff both to copy *and to obtain a copyright* in her work. In view of this language, artists who obtain the right to use another's work should also secure by contract the right to copyright their original contributions to a derivative work.

309 *Id.* at 305.

circuits. In *Durham Industries v. Tomy Corp.*,[310] the court held that the derivative works, licensed copies of Disney characters, lacked sufficient originality for independent copyright. The court noted that if they were to permit a derivative copyright in Tomy's toys, others who were licensed by Disney to copy its characters may have to substantially vary the character to avoid infringing upon Tomy's rights, or at least could be subject to the harassment of a lawsuit. The court reasoned that this would affect the underlying work's owner's (Disney) rights to continue to license derivative works, a result proscribed by the Copyright Act.[311]

The originality required to support a copyright in a derivative work is unclear. In *Batlin & Son v. Snyder*,[312] the court denied copyright protection to a small bank on the grounds that "the mere reproduction of a work of art in a different medium should not constitute the required originality."[313] This court required more than a demonstration of "physical skill" or "special training" in making a reproduction copyrightable, stating that "[a] considerably *higher* degree of skill is required, true artistic skill."[314]

In contrast, in *Alva Studios, Inc. v. Winninger*,[315] a smaller scale reproduction of Rodin's *Hand of God* was given copyright protection. In *Alva* the court held that the reduction in size and exact replication of Rodin's work required artistic skill and many hours.[316] While *Feist* stands for the proposition that copyright does not protect a work simply because it requires extensive labor, *Alva* seems to stand for the principle that when effort is combined with skill the work is protectable, even though the objective of the work is to *reproduce as exactly as possible*, on a different scale, a work in the public domain. In *Alva* there was some evidence that the defendant had used the reproduction to make his copies rather than using the original. The result in *Alva*, however, appears to conflict with the originality requirement espoused by the *Gracen* court. Certainly the defendant in *Gracen* used artistic skill and hours of effort to produce a reproduction of Dorothy. The distinction may be that the original works which were reproduced in *Gracen* and *Tomy* were still copyrighted and Rodin's work was in the public domain. Exact reproduction of a work in the public domain does not

310 630 F.2d 905 (2d Cir. 1980).
311 *Id.*
312 536 F.2d 486 (2d Cir.), *cert. denied*, 429 U.S. 857 (1976).
313 *Id.* at 491 (citation omitted).
314 *Id.*
315 177 F. Supp. 265 (S.D.N.Y. 1959).
316 *Id.*

implicate any other copyright owner's rights to authorize derivative works.

If this analysis is correct, then the originality required for copyright in an "art reproduction," which is a type of derivative work in the Copyright Act, will differ depending upon what is being reproduced. If the original is still the subject of a valid copyright, the author of a lawful derivative work will have a higher burden in order to protect his work. In the case of licensed digital uses of works of art, whether copyrighted or not, the extent of originality required for copyright of the derivative work and the question of whether the mechanical nature of digital manipulation will militate against a finding of originality are issues yet to be resolved by the courts.

Use of digital technology to produce derivative works of visual art is an area of unpredictability and uncertainty in the law. Yet this technology is widely used and improving daily, increasing our capacity to both create artistic works and potentially infringing works. It may be wise to reexamine the ever expanding web of copyright protection to determine whether the law is fostering or stifling creativity, increasing or diminishing the value of artistic work, promoting respect for the law and other's rights, or encouraging the vast majority of the computer literate among us to be lawbreakers.

VII. CONCLUSION

"'Why do you sit out here all alone?' said Alice, not wishing to begin an argument.

'Why, because there's nobody with me!' cried Humpty Dumpty. 'Did you think I didn't know the answer to *that*? Ask another.'"[317]

Sometimes a response doesn't *really* answer the question. Likewise, copyright, the law's answer to the concerns of society and authors, may not be the best response, at least as it is now applied to the visual arts. Artists producing visual fine art are certainly interested in financial remuneration. The starving artist is a romantic image, but better imagined than lived. Other motivations may well be involved in the production of fine art and the benefits to society of artistic works, though difficult to quantify, are intuitively clear. Imagine a world without man-made beauty, without aesthetic interest, without art. Commercial artists are not likely to be disadvantaged by the current state of the law. These artists gener-

[317] CARROLL, *supra* note 22, at 165.

ally produce work for corporate entities that can afford a stable of lawyers to work with the copyright laws and to protect the corporation's rights as an owner of the copyrights in artistic work. Even well-financed corporate owners, however, can run afoul of the law of copyright as the *Steinberg* case demonstrates.[318] If MGM's lawyers can misinterpret the law (assuming they were consulted before the poster for *Moscow on the Hudson* was published), how much more at risk is the artist, who has an aesthetic vision and lacks legal training or even an interest in legal analysis?

Unlike Humpty Dumpty, I have no facile answer to this dilemma. My study of the case law and the statutory provisions has convinced me that the law is too vague and unpredictable to be useful in the visual arts. It may be that the scope of the copyright monopoly should be narrowed in the digital age to allow for digital use of copyrighted materials and to encourage creativity. Certainly in the visual arts, the exclusive right to produce derivative works as now applied is chilling to artistic expression. At a minimum, the right of reproduction should be defined to exclude copying for private use.

The trend, however, appears to be toward expanding the copyright monopoly in terms of both length and breadth of coverage. As noted earlier, there is a proposal in Congress to lengthen the copyright term to life of the author plus seventy years.[319] In addition, the *White Paper on Intellectual Property Rights* recommends amending the Copyright Act to state definitively that computer transmissions constitute a distribution and/or publication under current law, thereby, arguably at least, expanding the reach of copyright by resolving any ambiguity in the law in favor of the copyright monopoly.[320] The *White Paper on Intellectual Property Rights* also defines the right of reproduction to include virtually any computer use of images and information.[321] The problems addressed in this paper, problems which make the application of copyright law unpredictable and possibly chilling to original expression, are not addressed by these proposals. International transmission of images and other information exacerbate the problems. As owners and users of the public domain, we should be wary of vagueness in a law which requires no intent for an infraction and may involve liability for contributory infringement by those who provide equipment and services. Clearly, proposals for legislation to increase the

318 *Steinberg*, 663 F. Supp 706.
319 *See* S. REP. No. 483, *supra* note 94.
320 *See supra* text accompanying notes 109-10.
321 *See supra* text accompanying notes 214-16.

scope of copyright are deserving of careful scrutiny. At the same time, Congress should consider legislation that removes the cloud that now hangs over the large and growing number of people who use digital images and information for noncommercial and other legitimate purposes.

The question is a difficult one: what should be done to improve copyright law? To paraphrase Humpty—did you think I'd know the answer to *that*? Ask another!