View metadata, citation and similar papers at core.ac.uk

brought to you by CORE

provided by Case Western Reserve University School of Law

Case Western Reserve Law Review

Volume 35 | Issue 1

1984

Overlapping Interests in Derivative Works and Compilations

Christine Wallace

Follow this and additional works at: https://scholarlycommons.law.case.edu/caselrev

Part of the Law Commons

Recommended Citation

Christine Wallace, *Overlapping Interests in Derivative Works and Compilations*, 35 Case W. Res. L. Rev. 103 (1984)
Available at: https://scholarlycommons.law.case.edu/caselrev/vol35/iss1/7

This Note is brought to you for free and open access by the Student Journals at Case Western Reserve University School of Law Scholarly Commons. It has been accepted for inclusion in Case Western Reserve Law Review by an authorized administrator of Case Western Reserve University School of Law Scholarly Commons.

OVERLAPPING INTERESTS IN DERIVATIVE WORKS AND COMPILATIONS*

Copyright protection of derivative works and compilations raises some compelling problems for the present scheme of copyright law. At what point does the protection of a work undercut the protection afforded another work? And at what point does the protection of a work invade the public domain? This Note examines the unique problems created by the admixture of original and preexisting elements in derivative works and compilations.

INTRODUCTION

A COPYRIGHTABLE[1] derivative work or compilation will contain at least two elements: preexisting materials or rights, which are either in the public domain or protected by a prior author's copyright, and original elements of the derivative work or compilation that are protected by a separate copyright.[2] This Note examines those instances in which the copyright protection afforded a derivative work has the effect of protecting materials or rights which either are already in the public domain or are protected by an original[3] author's copyright.

Section I of this Note begins with a brief history of developments in the law of copyright protection, with a special emphasis on the original author's increasing right to control derivative uses of his work.[4] Concepts necessary for a more complete understanding of the problems attending the copyright of derivative works also are discussed. These include the notions of originality,[5] infringement,[6] and the idea-expression dichotomy.[7]

---

* First prize, Nathan Burkan Memorial Competition, Case Western Reserve University School of Law (sponsored by the American Society of Composers, Authors, and Publishers (ASCAP)).

1. In this Note, the term "copyrightable" means that the work is original, and hence capable of having *its own copyright*, distinct from the copyright in the original work.

2. *See* Goldstein, *Derivative Rights and Derivative Works in Copyright*, 30 J. COPYRIGHT SOC'Y 209, 243 (1983) (identifying three elements typically included in a derivative work). *See also infra* notes 168-70 and accompanying text.

3. For the purpose of this Note, the term "original author" refers to the author of the work upon whioh a derivative work or compilation is based. The term "original work" refers to the work which was the basis of the derivative work or compilation.

4. *See infra* notes 36-78 and accompanying text.

5. *See infra* notes 62-83 and accompanying text.

6. *See infra* notes 84-99 and accompanying text.

7. *See infra* notes 100-08 and accompanying text.

Section II discusses the protection of a compiler's research—protection which enables a compiler to protect the expression of his research labors,[8] even though the components of his work are not entirely original. Copyright may not be the most effective means of protecting the interests of both an original author and a subsequent compiler.[9] This Note discusses unfair competition as an alternative to copyright protection[10] and also explores the interests of persons whose access to preexisting materials may be blocked effectively by a compiler's copyright.[11] In this context, the fair use defense will be discussed as a means of ensuring free access to preexisting materials.[12]

In Section III, the Note analyzes the competing interests present when a derivative author transforms a preexisting work into a new medium or alternative form. While an unlicensed derivative work may infringe upon the original author's exclusive right to create derivative works,[13] recognition of the original author's right does not mean necessarily that all adaptations of his work to a new medium must fall within the purview of his copyright. At the same time, the originality standard compels protection of the derivative author's variations on the preexisting work.[14]

Protection of compilations and derivative works serves copyright's important goals of protecting and encouraging original expressions. As copyright law evolves, the competing interests of original and derivative authors will test the integrity of these goals.

I. The Development of Copyright Protections

The Copyright Act of 1976[15] grants an author several exclusive rights, including the right to reproduce his work[16] in compilations[17]

8. *See infra* notes 109-17 and accompanying text.
9. *See infra* notes 122-30 and accompanying text.
10. *See infra* notes 131-44 and accompanying text.
11. *See infra* note 166 and accompanying text.
12. *See infra* notes 145-67 and accompanying text.
13. *See infra* notes 18, 95.
14. *See infra* note 181 and accompanying text.
15. 17 U.S.C. §§ 101-810 (1982).
16. *Id.* § 106(1).
17. A compilation is defined by the Act as a "work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." *Id.* § 101. The preexisting material *may*, but need not, be copyrightable. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 57, *reprinted in* 1976 U.S. CODE CONG. & AD. NEWS 5659, 5670. Thus, a compilation may be a collection of previously copyrighted material, or a collection of uncopyrightable facts.

or otherwise, and to prepare derivative works[18] based upon the original work.[19] The Act also grants a separate set of rights to derivative works and compilations,[20] provided that they are original.[21] The copyright in a derivative work or compilation, though, "extends only to the material contributed by the author of such work, . . . and does not affect or enlarge . . . any copyright protection in the preexisting [work]."[22] Thus, copyright subsists only in what is original to a derivative work or compilation, and not in any preexisting material.

The 1976 Act is the product of an increasing awareness that copyright's primary objective is to protect authors, and thereby promote the public good.

A. *Historical Background*

The United States Constitution expressly provides for copyright and patent laws "to promote the progress of science and useful arts."[23] The statement of copyright's purpose in the Constitution indicates its two correlative functions. First, copyright encourages authors to create and publish their works, by granting them a monopoly over the economic exploitation of their works.[24] Second, it ensures a constant source of new works for the public, which pro-

18. 17 U.S.C. § 106(2) (1982). A derivative work is defined by the Act as "a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, . . . or any other form in which a work may be recast, transformed, or adapted." *Id.* § 101. "[T]he 'pre-existing work' must come within the general subject matter of copyright . . . regardless of whether it is or was ever copyrighted." H.R. REP. No. 1476, *supra* note 17, at 57.

19. Other exclusive rights granted by the Act include the right to distribute copies of the work, the right to perform the work publicly, and the right to display the work publicly. 17 U.S.C. § 106 (1982).

20. Section 103 of the Copyright Act states in pertinent part:

> The subject matter of copyright as specified by section 102 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.

Id. § 103(a).

21. *Id.* § 102.

22. *Id.* § 103(b).

23. U.S. CONST. art. I, § 8, cl. 8. The copyright clause was barely discussed by the Framers, showing a basic belief in the necessity of copyright. This is rather surprising, because the first British copyright statute, the Statute of Anne, 8 Anne, ch. 19 (1709), had been enacted less than 90 years before. *See infra* note 37. One of the few contemporary sources discussing the copyright clause stated: "The utility of this power will scarcely be questioned. . . . The public good fully coincides in both [copyright and patent], with the claims of individuals. The States cannot separately make effectual provision for either . . . ." THE FEDERALIST No. 43, at 294 (J. Madison) (M. Walter Dunne ed. 1901).

24. B. KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 74-75 (1967).

motes thought, and assures that the works eventually will be free for others to use to create further new works.[25]

The 1976 Act is the first United States copyright statute which truly encourages the publication of new works. Under prior acts, federal copyright operated only when a work was published; state common law copyright virtually nullified the federal law's encouragement of publication, though, by protecting works prior to publication for an unlimited period of time.[26] The 1976 Act preempts common law copyright and, in contrast with earlier copyright statutes, grants protection to a work from the time that it is created.[27] Thus, the 1976 Act encourages an author to publish his work immediately, so that he may realize its full economic value.

Encouraging the creation and publication of works obviously is not an end in itself.[28] The policy reasons behind the current copyright provisions are the same as those behind the first British copyright statute.[29] Copyright protects public access to new information, expressions, and ideas.[30] This in turn promotes individual thought, personal growth, and the development of society.[31]

The two purposes of copyright potentially conflict because of the disparate interests that copyright attempts to promote: the creator's economic interest in monopolizing his work, and the public's interest in the free flow of ideas.[32]

Copyright strikes a balance between these purposes, in part, by limiting the subject matter of copyright. Copyright protects only expression, not ideas, and is not intended, by its protections, to impede the free flow of ideas.[33] Copyright's limited duration ensures

---

25. *Id.*

26. *See* H.R. REP. NO. 1476, *supra* note 17, at 130, 134. On the relationship between federal and common law copyrights, see, e.g., Goldstein, *Copyright and the First Amendment*, 70 COLUM. L. REV. 983, 1000-03 (1970).

27. 17 U.S.C. §§ 301-302 (1982).

28. While it is possible that encouragement of the author's personal growth and development is the main purpose of copyright, that may not be its only purpose. People would no doubt continue to be creative in the absence of copyright protection. KAPLAN, *supra* note 24, at 76.

29. Statute of Anne, 8 Anne, ch. 19 (1709).

30. B. KAPLAN, *supra* note 24, at 74-76.

31. *Id.*

32. Professor Goldstein has observed:

> Complete vindication of the creator's economic interest would logically require that the statutory monopoly be absolute. Likewise, the logic of full vindication of the immediate public interest in free access would require that no statutory monopoly at all be permitted. The copyright statute reflects a reasoned compromise between these competing interests.

Goldstein, *supra* note 26, at 1006.

33. 17 U.S.C. § 102 (1982).

that the public will have access to expressions within a relatively short period of time.[34] On the other hand, copyright protection is broad enough, and its duration is long enough, to ensure that the author will make the effort because he will have sufficient opportunity to obtain rewards for it.

Both the subject matter and the duration of copyright have been broadened significantly through time.[35] Developments in copyright legislation evince an especially significant increase in the scope of protection given to authors.

1. *Acts of 1790 and 1870*

The first United States copyright act[36] reflected copyright's British heritage as protection for publishers[37] by protecting only the right to reproduce the work.[38] An author had no protection against

---

34. *Id.* §§ 302-304.

35. The 1790 Act protected only books, maps, and charts for a term of 14 years. Act of May 31, 1790, ch. 15, 1 Stat. 124 (repealed 1831). In contrast, the 1976 Act protects "original works of authorship fixed in any tangible medium of expression . . . from which they can be perceived . . . or otherwise communicated" for the life of the author plus 50 years. 17 U.S.C. §§ 102(a), 302 (1982).

36. Act of May 31, 1790, ch. 15, 1 Stat. 124 (repealed 1831).

37. Copyright has its roots in the practices of the British Stationers' Company. In 1557, Queen Mary chartered the Stationers' Company to "provide a suitable remedy against [the printing of] seditious and heretical material." L. PATTERSON, COPYRIGHT IN HISTORICAL PERSPECTIVE 29 (1968). The stationers were granted broad powers to carry out the Crown's wish to censor printed materials, including the power to impose penalties which resulted in the loss of the right to print. *Id.* at 39.

Since the Crown's primary concern was with censorship, not ownership of "copy," the stationers were free to develop their own rules concerning property rights in the books they printed. *Id.* at 36. After initial licensing by the Queen's representative, *id.* at 37, the Company required its members to obtain an allowance to publish the work. *Id.* at 52. This allowance was entered on the Company's register, *id.* at 52, and thereafter prevented any other member of the company from printing the work. *Id.* at 43-44.

The stationers' copyright was entirely a publisher's right, not an author's. *Id.* at 65. Although the author did have some rights as the initial owner of the manuscript, and by common understanding with the stationers, *id.* at 64-77, he had virtually no control over his work once he sold his manuscript. B. KAPLAN, *supra* note 24, at 5.

When the licensing provisions, and thus the justification for their monopoly, expired in 1695, *id.* at 6, the stationers unsuccessfully attempted to convince Parliament to continue regulation of the book trade. L. PATTERSON, *supra* note 37, at 138-42. In desperation, they changed tactics and argued, not for censorship, but for protection of property rights in books, *id.* at 142, to prevent piracy which might discourage "Persons from writing Matters, that might be of great Use to the Publick." *Id.* at 142 (quoting XV H.C. JOUR. 313 (1706)). Parliament agreed with this rationale, and passed the Statute of Anne in 1709, fittingly entitled "An act for the encouragement of learning, by vesting the copies of printed books in the authors, or purchasers, of such copies, during the times therein mentioned." 8 Anne, ch. 19.

38. Act of May 31, 1790, ch. 15, 1 Stat. 124 (repealed 1831). The act stated that the author was to have "the sole right and liberty of printing, reprinting, publishing and vending" his work.

derivative uses of his work, such as abridgements[39] or translations.[40]

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.[41]

The 1856 amendment to the 1790 Act recognized that copyright protected authors, not publishers, by creating a right to perform a dramatic work publicly.[42] The expansion of protection to include the right to perform a work forced courts to look beyond the literal similarities between two works and to recognize that more general similarities also could constitute infringement.[43]

The 1870 Act further expanded authors' rights to include those of dramatization and translation.[44] The right to dramatize particularly should be noted, as it is the first protection of an author's right to transform his work into other media. This recognition made it difficult to maintain the distinction between ideas and expressions, the traditional, invisible line dividing what copyright would and would not protect.[45]

The courts nevertheless maintained the idea/expression dichot-

---

39. Story v. Holcombe, 23 F. Cas. 171 (C.C.D. Ohio 1847) (No. 13,497).

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

41. In Story v. Holcombe, 23 F. Cas. 171 (C.C.D. Ohio 1847) (No. 13,497), for instance, the court clearly distinguished between a noninfringing abridgement and an infringing combination of extracts from a prior work. The former involved a significant amount of independent labor and judgment, and therefore could be considered a wholly new work, even "though it may injure the original." *Id.* at 175.

42. Act of Aug. 18, 1856, ch. 169, 11 Stat. 138. Professor Goldstein characterized this act as "[t]he first great intellectual leap, auguring copyright's break from the confines of 'copies,' and the eventual statutory expansion of derivative rights." Goldstein, *supra* note 2, at 213.

43. Daly v. Palmer, 6 F. Cas. 1132 (C.C.S.D.N.Y. 1868) (No. 3,552) epitomizes the courts' new approach. Rather than looking for literal similarities between the two plays involved in the action, the *Daly* court instead looked to more general similarities in the sequence of events and of emotions created by the two works:

> [I]t is a piracy, if the appropriated series of events, when represented on the stage, although performed by new and different characters, using different language, is recognized by the spectator . . . as conveying substantially the same impressions to, and exciting the same emotions in, the mind, in the same sequence and order.

Id. at 1138. Thus, even though there were few literal similarities between the two plays, the court found that performance of the defendant's play would infringe upon the plaintiff's performance rights. *Id.*

44. Act of July 8, 1870, ch. 320, § 86, 16 Stat. 198, 212.

45. B. KAPLAN, *supra* note 24, at 32.

omy, justifying the right to dramatize under the necessary and proper clause:

> The law confines itself to a particular, cognate and well known form of reproduction. If to that extent a grant of monopoly is thought a proper way to secure the right to the writings this court cannot say that Congress was wrong.[46]

2. *Acts of 1909 and 1976*

The 1909 Act further extended copyright protections to include an author's right to abridge his work (as well as to translate and to dramatize it), and "to make any other version thereof."[47] This Act made apparent the change in thinking about derivative rights. Under prior acts, derivative rights were treated as ad hoc exceptions to the general rule that copyright protects only the right to reproduce.[48] The 1909 Act, in contrast, treated derivative works as variants of the original, not as wholly separate works.[49] Clearly, more than "form" was being protected.[50]

The 1976 Act extended the right to prepare derivative works to any copyrightable work, not just to literary works as the 1909 Act had done.[51] This extension brought copyright around a full 180 degrees from its beginnings as a protection of copies for publishers to a protection of content for authors.[52]

The 1976 Act is an attempt to balance the author's rights in his creation against the interests of a subsequent author who makes use of the first author's work. Derivative works and compilations continue to be separately copyrightable under the 1976 Act, as they were under the 1790 Act.[53] Their copyright is limited, however, by the original author's rights to reproduce his work and to prepare derivatives. Section 103(b) distinguishes between the original author's and the compiler's or derivative author's copyrights, extending protection "only to the material contributed by the author" of the derivative work or compilation,[54] and not to any portion of

46. Kalem Co. v. Harper Bros., 222 U.S. 55, 63 (1911) (Holmes, J.).

47. Act of March 4, 1909, ch. 320, § 1(b), 353 Stat. 1075. The Act goes on to state that these rights only apply to "literary works."

48. The 1870 Act stated that "authors may *reserve* the right to dramatize or to translate their own works." Act of July 8, 1870, ch. 320, § 86, 16 Stat. 198, 212 (emphasis added).

49. *See supra* note 47 and accompanying text.

50. Note, *Derivative Works and the Protection of Ideas,* 14 GA. L. REV. 794, 798 (1980).

51. Act of Oct. 19, 1976, 17 U.S.C. § 106(2) (1982); *see supra* note 47 and accompanying text.

52. Note, *supra* note 50, at 799.

53. 17 U.S.C. § 103(a) (1982).

54. *Id.* § 103(b) states:

the underlying work. The two copyrights are to be "independent."[55]

Section 103(a) declares that copyright protection will "not extend to any part of the [derivative work or compilation] in which [preexisting] material has been used unlawfully."[56] This precludes copyright protection even for original portions of the derivative work or compilation in which the preexisting work is used without a license.[57]

Section 103 confines copyright protection to those portions of a derivative work or compilation which are themselves original; to the extent that preexisting work underlies the original work of the derivative author or compiler, he must be licensed to use it. By limiting protection to what is original in a derivative work or compilation, copyright encourages the production of original material, a result that comports with copyright's overriding purpose "to promote the progress of . . . useful Arts."[58]

B. *Conceptual Background*

The originality requirement,[59] infringement,[60] and the idea/expression dichotomy[61] are related concepts which are applied to determine whether and to what extent a work will be protected.

1. *Originality*

For a work to obtain copyright protection, it must be original. The 1976 Act was the first of the copyright statutes to recognize the originality requirement explicitly,[62] although prior to enactment of

> The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

55. *Id.*

56. *Id.* § 103(a).

57. Whether a work is excluded from copyright protection is determined by the nature of the compilation or derivative work. If the preexisting work underlies the entire derivative or compilation, then the derivative or compilation is totally unprotected. An example of this is an unauthorized translation. However, if the preexisting work underlies only a small part of the derivative or compilation, only that portion of the derivative or compilation is unprotected. H.R. REP. NO. 1476, *supra* note 17, at 57-58.

58. U.S. CONST. art. I, § 8, cl. 8.

59. *See infra* notes 62-83 and accompanying text.

60. *See infra* notes 84-99 and accompanying text.

61. *See infra* notes 100-08 and accompanying text.

62. "Copyright protection subsists . . . in *original* works of authorship . . . ." 17 U.S.C. § 102(a) (1982) (emphasis added).

the statute, courts had incorporated this concept into copyright analysis. The House Report on the Act indicates that Congress intended to bring the concept as applied by the courts into the new statute.[63]

Originality is the threshold requirement for copyright protection. It requires neither skill nor creativity. It merely requires that the work contain some expressive element which is not copied from a preexisting work.[64] The expressive elements, however, must be more than "trivial."[65] The courts have refused to apply any requirement of artistic merit, recognizing that the existence of copyright protection must be based on something other than the tastes and aesthetic predispositions of particular judges. Thus, the application of the originality standard results in protection of a broad array of works, including advertisements[66] and lamps[67] under certain circumstances.

Originality under copyright law does not require novelty, as patent law does. A work may be precisely the same as a preexisting work, but still claim copyright protection because it was independently conceived.[68] Thus, the ultimate test of originality is that the work must originate with the author, without conscious, or perhaps even unconscious,[69] reference to prior works.[70]

a. *Triviality.* As stated above, the new, expressive element must be more than trivial to entitle a work to copyright protection.[71] One test defines a trivial change as one that is merely mechanical, such as anyone might do.[72] A similar test defines trivi-

63. "The phrase 'original works of authorship' . . . is intended to incorporate without change the standard of originality established by the courts . . . ." H.R. REP. No. 1476, *supra* note 17, at 51.

64. *See* Bleistein v. Donaldson Lithographing Co., 188 U.S. 239 (1903); Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99 (2d Cir. 1951).

65. *See, e.g.*, Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 103 (2d Cir. 1951).

66. Bleistein v. Donaldson Lithographing Co., 188 U.S. 239 (1903).

67. Mazer v. Stein, 347 U.S. 201 (1954).

68. "[I]f by some magic a man who had never known it were to compose anew Keats' Ode on a Grecian Urn, he would be an 'author,' and if he copyrighted it, others might not copy that poem, though they might of course copy Keats'." Sheldon v. Metro-Goldwyn Pictures Corp., 81 F.2d 49, 54 (2d Cir.), *cert. denied*, 298 U.S. 669 (1936).

69. Fred Fisher, Inc. v. Dillingham, 298 F. Supp. 145 (S.D.N.Y. 1924).

70. Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53 (1884).

71. *See, e.g.*, Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 103 (2d Cir. 1951).

72. *See, e.g.*, Grove Press, Inc. v. Collector's Publications, Inc., 264 F. Supp. 603, 605 (C.D. Cal. 1967) (holding that 40,000 changes in spelling, punctuation, and grammar were "trivial," because they were changes that "any high school graduate" could make).

ality as the exercise of only physical, as opposed to artistic, skill.[73] A third test defines a trivial variation as one that is insubstantial;[74] this test seeks to define triviality through a synonym, and thus forsakes certainty for circularity.[75]

The purpose of requiring that variations be more than trivial is to allow copyright protection for the most minimal contributions, but to draw the line at variations so minor that protection of them would harass authors more than promote "the useful arts."[76] Although the policy justification for the triviality test is clear, the obscurity of this test is nonetheless a burden on the courts.[77]

b. *Skill, Judgment, and Effort.* A second test for the level of originality necessary to gain copyright protection examines the amount of skill, judgment, or effort expended to produce a work, rather than its distinction from prior works.[78] A highly skillful, exact replica of a prior work thus may be protected.[79] Similarly, the exercise of judgment in the selection and/or arrangement of compiled materials may also be protected.[80] Some courts even go so far as to hold that the sheer amount of effort involved in creating a

---

73. *See, e.g.*, L. Batlin & Sons, Inc. v. Snyder, 536 F.2d 486 (2d Cir.) (holding that a plastic reproduction of an antique "Uncle Sam" bank, long in the public domain, was not copyrightable because it displayed merely "manufacturing skill"), *cert. denied*, 429 U.S. 857 (1976).

74. *See, e.g.*, Andrews v. Guenther Publishing Co., 60 F.2d 555 (S.D.N.Y. 1932).

75. In trying to refine the standard, courts used such phrases as "a modicum of creative work," *id.* at 557, or "merely a colorable attempt to use someone else's work," Northern Music Corp. v. King Record Distrib. Co., 105 F. Supp. 393, 399 (S.D.N.Y. 1952), to define the necessary degree of variation.

76. "There comes a point where the use of material is so close as not to give the public anything really new. At that point, the ideal of encouraging independent creation ceases to operate." Chafee, *Reflections on the Law of Copyright: I*, 45 COLUM. L. REV. 503, 514 (1945).

77. *See, e.g.*, Oppenheimer, *Originality in Art Reproductions: "Variations" in Search of a Theme*, 27 COPYRIGHT L. SYMP. (ASCAP) 207 (1982); Note, *Arrangements and Editions of Public Domain Music: Originality In a Finite System*, 34 CASE W. RES. L. REV. 104 (1983); Note, *Copyright—Originality—Confusing the Standards for Granting Copyrights and Patents*, 79 W. VA. L. REV. 410 (1977) [hereinafter cited as Note, *Confusing the Standards*].

78. Professor Nimmer has noted that there seems to be a "reciprocal relationship" between the amounts of creativity and effort required to meet the originality requirement; the more effort that is involved in creating a work, the less creativity must be shown, and vice versa. 1 M. NIMMER, NIMMER ON COPYRIGHT § 3.04 (1984).

79. Alva Studios, Inc. v. Winninger, 177 F. Supp. 265 (S.D.N.Y. 1959) (reduced-scale replica of public domain statue found to be original because of the great amount of skill needed to reproduce the work so precisely).

80. The originality of such works was recognized as far back as Story v. Holcombe, 23 F. Cas. 171, 174 (C.C.D. Ohio 1847) (No. 13,497) ("In [a compilation] the judgment may be said to be exercised to some extent in selecting and combining the extracts. Such work enti-

work may entitle it to protection.[81]

Once a work is found to be original, it is entitled to copyright protection for all that is original to it.[82] Such protection includes the right to prepare derivatives and to reproduce the work. Thus, if the original work is a derivative, the author may create further derivatives for the original portions of his work.[83]

2. *Infringement*

The test for whether one work infringes upon the copyright in another is whether the two works are "substantially similar."[84] Substantial similarity generally is treated as a two-part test: first, the allegedly infringing work must copy the other work, and second, it must appropriate the other work's expression.[85]

The first part of the test is met by showing that the alleged infringer copied the prior work in creating his work. Copying is often proved by showing that the alleged infringer had access to the prior work, and that the two works are substantially similar.[86] For example, proof that the alleged infringer possessed the prior work (access) and that his work contained the same typographical errors as the prior work (substantial similarity) would probably be enough to establish that he copied the prior work.[87]

Even if the alleged infringer copied the prior work, he did not infringe unless he took the prior author's expression. This classic distinction between an unprotectible idea and its protectible expression is discussed in the following subsection.[88] Suffice it to say that the distinction lies in the difference between the form that a work finally takes and the underlying structure upon which it is built.

---

tles the compiler, under the statute, to a right of property."). It is also specifically recognized under the 1976 Act. 17 U.S.C. § 101, *quoted supra* note 17.

Where the nature of the preexisting material directs the form of the arrangement, such an arrangement may not be protectible. *See, e.g.*, Norman v. Columbia Broadcasting System, Inc., 333 F. Supp. 788 (S.D.N.Y. 1971); *see also* Taylor, *The Uncopyrightability of Historical Matter: Protecting Form Over Substance and Fiction Over Fact*, 30 COPYRIGHT L. SYMP. (ASCAP) 35, 39-42 (1983).

81. *See, e.g.*, Toksvig v. Bruce Publishing Co., 181 F.2d 664 (7th Cir. 1950); Adventures in Good Eating, Inc. v. Best Places to Eat, Inc., 131 F.2d 809 (7th Cir. 1942); Leon v. Pacific Tel. & Tel., 91 F.2d 484 (9th Cir. 1937).

82. 17 U.S.C. §§ 102-103 (1982).

83. *Id.* § 106(2).

84. *See, e.g.*, Arnstein v. Porter, 154 F.2d 464 (2d Cir. 1946).

85. *Id.* at 468.

86. *See, e.g.*, Southwestern Bell Tel. Co. v. Nationwide Indep. Dir. Serv., Inc., 371 F. Supp. 900 (W.D. Ark. 1974).

87. *Id.*

88. *See infra* notes 100-08 and accompanying text.

While an author cannot prevent others from taking his general themes or characters,[89] he can protect the more specific elements of his work.[90]

Under the copying half of the infringement analysis, the court looks to external, individual factors like typographical errors, stylistic similarities, or similarities in plot. Under the appropriation half of the test, however, the court must look to more subjective and generalized elements. This second part of the test asks whether the "casual" or "ordinary" observer would find that the two works were substantially the same, and would tend to overlook the differences between them.[91]

The functions of the originality requirement and the infringement standard must be distinguished. Originality is the minimum requirement for obtaining copyright protection. As such, the originality requirement should be very flexible and easy to meet, to ensure that copyright performs its basic function of encouraging authors to create and publish their works.[92] The infringement standard, however, determines how much of a work will be protected, and concomitantly, how much will be free for others to use. Proof of infringement should be more difficult, because the protection it gives to authors may impede the free flow of information and ideas.[93]

Derivative works and compilations may infringe the copyright in prior works and nonetheless be original. A derivative work will, by definition, be based upon one or more preexisting works.[94] Unless such a work is licensed, it may infringe upon the copyright in the preexisting work.[95] However, it may also contain wholly origi-

---

89. *See, e.g.*, Nichols v. Universal Pictures Corp., 45 F.2d 119 (2d Cir. 1930), *cert. denied*, 282 U.S. 902 (1931). In *Nichols*, Judge Hand scrupulously assumed that everything about plaintiff's play was wholly original, and nevertheless found that the defendant's use of it was not an infringement, because he had taken only the most generalized abstractions from the plaintiff's themes and characters. He thus had taken only the plaintiff's ideas, not her expression. *Id.* at 122.

90. *See id.* at 121 ("But we do not doubt that two plays may correspond in plot closely enough for infringement . . . . Nor need we hold that the same may not be true as to the characters . . . .").

91. *See, e.g.*, Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487 (2d Cir. 1960).

92. *See* Note, *Confusing the Standards*, *supra* note 77, at 411.

93. *See generally id.* at 420-21 (arguing that a strict standard of originality fails to recognize the minimal amount of protection actually given to derivative works).

94. 17 U.S.C. § 101 (1982). Recall, however, that a compilation need not be "based upon" prior works; it may consist of a collection of uncopyrightable material. *See supra* note 17.

95. The term "based upon" may encompass uses which are not infringements, however.

nal elements which are themselves entitled to copyright. The casual observer may tend to overlook the differences, but if they are not trivial they may be sufficient to justify a separate copyright.[96]

Nonetheless, the originality and infringement standards are related. Infringement will be found only if there is a taking of the author's expression; there is no infringement if the copied portions of the work were not original to it.[97]

Section 103(b) explicitly applies these standards to derivative works and compilations. A derivative work or compilation is entitled to protection under this provision only for what is original to it, and its copyright is not to affect or enlarge the scope, duration, or ownership of copyright in the underlying work.[98] The copyright in the derivative work or compilation thus cannot cover the preexisting material upon which it is based.[99]

The derivative work may take only ideas from the original work, but nonetheless be "based upon" the original work. *See* B. KAPLAN, *supra* note 24, at 56-58; Goldstein, *supra* note 2, at 218-26.

96. *See* Note, *Confusing the Standards, supra* note 77, at 420-21.

97. *See* 1 M. NIMMER, *supra* note 78, § 3.04, at 3-15.

98. 17 U.S.C. § 103(b) (1982). Allowing the derivative author's copyright to protect materials covered by the original author's copyright would affect the scope of protection given to the original work. For example, if the derivative work passed into the public domain, the elements protected by its copyright would pass with it. The original author's right to control subsequent uses of his work would then be diminished, to the extent that he could not control others' use of his work as it appeared in the derivative work.

If elements protected by the original author's copyright were also protected by the derivative author's copyright, the derivative author would presumably be entitled to reproduce those elements and to create further derivatives based upon them. Once again, the original author's right to control the uses made of his work would be diminished. *See* 1 M. NIMMER, *supra* note 78, § 3.07[A]. *But see* Comment, *Copyright—Infringement—Photocopy of Dedicated Translation Constitutes Infringement of Underlying Work*—Grove Press, Inc. v. Greenleaf Publications Co., 247 F. Supp. 518 (S.D.N.Y. 1965), 79 HARV. L. REV. 1716, 1719 (1966) (arguing that the first scenario is the necessary result of the derivative work passing into the public domain, and that the second could be prevented by court rule).

The duration of the copyright protection in the underlying work would be similarly affected because the copyright terms for the underlying work and the derivative works are not coterminous. If the copyright in the derivative work expires before the copyright in the original, others may be able to use the original work as it appears in the derivative before the copyright expires in the original work itself.

Finally, ownership of copyright would be affected by granting the derivative author copyright protection for the preexisting material he used. Before the derivative work was created, only the original author would have had any copyright protection in the underlying work, but both the original and the derivative authors would have a copyright in some portions of the underlying work after the derivative was created.

99. *Contra* Goldstein, *supra* note 2, at 243; Jaszi, *When Works Collide: Derivative Motion Pictures, Underlying Rights, and the Public Interest*, 28 UCLA L. REV. 715, 807-12 (1981).

3. *Idea/Expression Dichotomy*

Copyright will protect only the author's expression of an idea, and not the idea itself.[100] The line is an easy one to draw for so-called "practical works." An idea, such as a system of accounting[101] or the rules of a game,[102] is not protected, but the expression—the description given by the author—is protected. Thus, one may use the system of accounting or the rules of the game with impunity, but may not copy the author's description of them.[103]

Attempts to apply the idea-expression dichotomy to other kinds of works, though, quickly become vexatious. While expression clearly includes more than form,[104] it is not clear just where expression ends, and idea begins.[105]

Because ideas and expressions have been so difficult to extricate, it has been suggested that the dichotomy should be ignored, and that the courts should recognize that copyright does protect ideas to a limited extent.[106] Some courts have chosen to limit the scope of the protection given to works whose ideas and expressions are intertwined so inextricably that protecting the expression would prevent others from using the idea.[107] Given that the copyright clause and the first amendment require that only expressions be protected,[108]

---

100. *See* 17 U.S.C. § 102 (1982); *see also* Mazer v. Stein, 347 U.S. 201, 217 (1954) ("[A] copyright gives no exclusive right to the art disclosed; protection is given only to the expression of the idea—not the idea itself.").

101. Baker v. Selden, 101 U.S. 99 (1879) (where the Court saw copyright as protecting only the author's description of a bookkeeping system).

102. Chamberlin v. Uris Sales Corp., 150 F.2d 512 (2d Cir. 1945).

103. Baker v. Selden, 101 U.S. at 102-04; Chamberlin v. Uris Sales Corp., 150 F.2d at 513.

104. Note, *supra* note 50, at 798.

105. Judge Learned Hand's oft-quoted explanation of the problem bears repetition:

> 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. . . . [B]ut 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. Nobody has ever been able to fix that boundary, and nobody ever can.

Nichols v. Universal Pictures Corp., 45 F.2d 119, 121 (2d Cir. 1930) (citations omitted), *cert. denied*, 282 U.S. 902 (1931). *See also* Note, *supra* note 50, at 804-09, which gives several examples of cases in which the trial and appellate courts came to opposite conclusions based only upon different notions of where to draw the line between idea and expression.

106. Note, *supra* note 50, at 812. "Where the idea is not easily extricable from the expression, the idea-expression dichotomy provides no guidance for the identification of the protectable as opposed to the non-protectable elements." *Id.* at 800.

107. Herbert Rosenthal Jewelry Corp. v. Honora Jewelry Co., Inc., 509 F.2d 64 (2d Cir. 1974); Herbert Rosenthal Jewelry Corp. v. Kalpakian, 446 F.2d 738 (9th Cir. 1971).

108. 1 M. NIMMER, *supra* note 78, §§ 1.08[D], 1.10.

and that ideas remain in the public domain, the latter view seems to be more consistent with the basic tenets of copyright.

II. You Cannot "Copy the Copy"[109]

A compilation consists of at least two elements. First, it contains preexisting materials, such as the names and addresses in a telephone directory, or the individual poems or stories in an anthology. Second, a compilation contains its original selection or arrangement of the preexisting materials. In addition, many compilations contain other original expressions, such as originally expressed evaluations of the materials presented, or even original expressions of the preexisting materials themselves, apart from the selection or arrangement.

In addition to protecting the original expressions, copyright currently may protect the preexisting materials in a compilation. Thus, a subsequent compiler may be precluded from using the first compiler's research and efforts. In *Leon v. Pacific Telephone & Telegraph*,[110] the court held that the defendant's use of the plaintiff's telephone directory to create a numerical listing of telephone numbers constituted an infringement on the plaintiff's copyright in the directory. The court did not rely upon the originality of the plaintiff's selection and arrangement of data in finding that the defendant's use infringed.[111] Rather, it found that the defendant had infringed because he had appropriated the plaintiff's labor and ex-

109. Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 249 (1903). Many of the cases allowing copyright protection for the preexisting material contained in a compilation drew this phrase out of context and used it as support for their holdings. *See, e.g.*, C.S. Hammond & Co. v. International College Globe, Inc., 210 F. Supp. 206, 218 (S.D.N.Y. 1962).

The issue in *Bleistein* was the originality of photographs. The defendant argued that photographs were not original because they merely copied reality. The Court held that photographs were nevertheless expressive, and so, while one might go back and copy the reality, one could not copy the photographs' depiction of reality. The *Bleistein* Court was thus protecting the photographer's expression.

In the compilation cases, however, the protection is extended to the preexisting materials, not to the compiler's expression. *See infra* notes 110-17. Thus *Bleistein* provides no support whatever.

110. 91 F.2d 484 (9th Cir. 1937).

111. There is, however, some indication that the court believed that the defendant's directory was an infringement of the plaintiff's right to prepare derivatives from its directory. In response to the defendant's claim of fair use, the court stated that although the infringing work served a different market than the plaintiff's, it was not necessarily a fair use: "The inversion, without license, is not permitted merely because the holder of the copyright has not so used it." *Id.* at 487.

pense in compiling the data.[112]

The court in *Toksvig v. Bruce Publishing Co.*[113] granted similar protection for the gathering of historical data. In her biography of Hans Christian Andersen, the plaintiff translated several letters that had never before appeared in print. The defendant quoted these letters in her biography of Andersen.[114] In finding that these quotations were an infringement, the court did not rely on the originality of the plaintiff's translations, although it might have. Instead, it found that the defendant had made "substantial and unfair use" of the plaintiff's work by using the plaintiff's research rather than doing her own.[115]

The courts in these cases have explained that the previous compiler has no copyright in the preexisting material itself.[116] Thus, if the subsequent compilers went back to the original sources, they would be free to use the material. But, the courts have held that subsequent compilers cannot copy the material from a prior compilation, and thereby "reap the benefits"[117] of a previous author's labor and effort.

A. *Original Expressions and the Scope of Protection*

The originality requirement sets a low threshold for copyright protection, requiring only that the work "originate" with the author.[118] A telephone directory can meet this standard with as much ease as a more elaborate biography or novel.

It is clear, however, that the preexisting works or data that the compiler uses are not original to him. They existed prior to his expression of them, and so, as to these discrete elements, he cannot claim origination.[119]

Some courts have attempted to distinguish between the preexisting materials and the research involved in discovering those materi-

112. *Id.* at 485-86.

113. 181 F.2d 664 (7th Cir. 1950).

114. *Id.* at 666.

115. *Id.* at 667. The court was especially concerned about the time that the defendant had saved by using the plaintiff's work rather than doing her own research.

116. *See, e.g.*, Adventures in Good Eating, Inc. v. Best Places to Eat, Inc., 131 F.2d 809, 812-13 (7th Cir. 1942).

117. 1 M. NIMMER, *supra* note 78, § 3.04.

118. *See supra* notes 62-70 and accompanying text.

119. Taylor, *supra* note 80, at 34-36; 1 M. NIMMER, *supra* note 78, § 2.01[A].

als. The trial court in *Miller v. Universal City Studios, Inc.*[120] found that research was a creative endeavor, analogous more "to the expression of the facts than to the facts themselves."[121] It instructed the jury that copyright protects research but not facts.[122] The appellate court, however, held that protection of research was tantamount to protection of the facts themselves, and therefore refused to allow copyright protection for research.[123]

To some extent, copyright does reward the exercise of effort; the originality requirement attests to that. But copyright does not protect intellectual endeavors which have not been reduced to some tangible medium.[124] The activity of fact-gathering is not protected; copyright protection only exists when the research is compiled and given a tangible form.

Of course, the compiler can protect his expression, i.e., his selection and arrangement of the materials he finds.[125] The subsequent compiler may use the same materials, but may not copy a previous compiler's expression.[126]

Nevertheless, protection of an author's research might serve a dual function. It would encourage authors to engage in research by assuring them that others would not be able to appropriate the result of their efforts.[127] It would also discourage subsequent compil-

---

120. 460 F. Supp. 984 (S.D. Fla. 1978), *rev'd and remanded,* 650 F.2d 1365 (5th Cir. 1981).

In *Miller,* the plaintiff's novel, *83 Hours Till Dawn,* was a true story about a kidnapping in which the victim was buried alive for five days. The plaintiff claimed that the defendant had copied the facts from the novel in creating its movie, *The Longest Night. Id.* at 985-86.

121. *Id.* at 987.

122. Miller v. Universal City Studios, Inc., 650 F.2d at 1368.

123.

> The valuable distinction in copyright law between facts and the expression of facts cannot be maintained if research is held to be copyrightable. There is no rational basis for distinguishing between facts and the research involved in obtaining facts. To hold that research is copyrightable is no more or no less than to hold that the facts discovered as a result of research are entitled to copyright protection.

Id. at 1372.

124. *See supra* notes 65-83 and accompanying text.

125. "A copyright in a directory . . . is properly viewed as resting on the originality of the selection and arrangement of the factual material, rather than on the industriousness of the efforts to develop the information." *Miller* at 1369, *citing* 1 M. NIMMER, *supra* note 78, § 3.04. *See, e.g.,* Adventures in Good Eating, Inc. v. Best Places to Eat, Inc., 131 F.2d 809 (7th Cir. 1942).

126. *Cf.* Millworth Converting Corp. v. Slifka, 276 F.2d 443 (2d Cir. 1960) (plaintiff copied public domain embroidery, creating three-dimensional effect on fabric; defendant copied the public domain pattern from plaintiff, but did not copy the embroidery effect; held not to be infringement).

127. Gorman, *Copyright Protection for the Collection and Representation of Facts,* 76 HARV. L. REV. 1569, 1585-86 (1963); Taylor, *supra* note 80, at 49.

ers from depending upon the original compiler's work, forcing them to return to the original sources. Society would benefit from this because the total body of knowledge in the area would increase, and there would be a built-in check on the accuracy and currency of the information given to the public.[128]

On the other hand, forcing the later compiler to ignore prior works in his field is both unrealistic[129] and unwise because it would be unlikely to promote accuracy or to prevent duplication of effort.[130] In addition, the copyright protection for the compiler's selection of the preexisting materials would prevent wholesale copying, and would encourage others to create more accurate and better-organized compilations.

B. *Unfair Competition*

The danger in using copyright to protect the compiler's research is that the protection afforded goes too far, protecting not only against competitive uses but also against noncompetitive ones as well. Futhermore, the duration of the standard copyright protection is much longer than is necessary to protect the author's ability to compete. The unfair competition law offers an alternative method of protecting the compiler's economic interest in his research.

The unfair competition doctrine originally was developed to prevent a manufacturer from passing off another manufacturer's product as his own, deceiving or confusing consumers as to the product's source. The court in *International News Service v. Associated Press*[131] extended this doctrine into an area analogous to copyright. The court enjoined International News Service (I.N.S.) from using Associated Press' (A.P.) uncopyrighted news dispatches to compete with it on the west coast. Although the news itself was not protectible, the court held that I.N.S., by tapping A.P.'s resources to compete against it, had appropriated A.P.'s facilities for gathering information. In the court's view, this amounted to "unfair competition."[132] Thus, it transmuted a misrepresentation theory into a

128. Gorman, *supra* note 127, at 1585.

129. "[I]t is both customary and reasonable for biographers to refer to and utilize earlier works" because it encourages the development of historical knowledge. Rosemont Enter., Inc. v. Random House, Inc., 336 F.2d 303, 307 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967).

130. B. KAPLAN, *supra* note 24, at 59 (citing Gorman, *supra* note 127, at 1570).

131. 248 U.S. 215 (1918).

132. *Id.* at 239-40.

misappropriation theory.[133]

Some state courts have used a similar analysis to find that a defendant has usurped the market value of the product of the plaintiff's labor and expense. For example, in *Madison Square Garden Corp. v. Universal Pictures Co., Inc.*,[134] the defendant's motion picture contained a fictional account of a professional hockey game in New York City. Several scenes appeared to have been filmed at Madison Square Garden, and to have shown games being played by the New York Rangers, a hockey team then owned by Madison Square Garden. In addition, the defendant had distributed a circular promoting the film which frequently referred to Madison Square Garden. The owners had not authorized the defendant to use the facilities or the hockey team in the film. The court found that the plaintiff had developed a lucrative business in licensing photographs of Madison Square Garden for use in motion pictures, and that the defendant's "evident purpose . . . was to appropriate the financial value [that Madison Square Garden and the Rangers] had acquired through the plaintiff's labor, expenditure and skill."[135]

The major difficulty with the misappropriation doctrine is that it may run afoul of the preemption provision of the 1976 Act.[136] Under section 301, two elements are necessary to find that a state

---

133. Although *I.N.S.* was a pre-*Erie*, federal common law decision, it has value as a model for state protection of labor and effort. A.P. was protected against competitors who might tap its resources and decrease the commercial value of its newspapers. The protection would last only as long as the news had commercial value to A.P. 248 U.S. at 239-40. Presumably, a use of A.P.'s facilities which did not compete with A.P.'s use would not be prevented. Thus, by analogy, the concern about others "reaping the benefits" of an author's research would be met without requiring unnecessary duplication of effort or unnecessarily preventing those not in competition with the compiler from gaining access to information.

134. 255 A.D. 459, 7 N.Y.S. 2d 845 (1938).

135. *Id.* at 467, 7 N.Y.S. 2d at 852. *See also* Roy Export Co. v. Columbia Broadcasting System, 672 F.2d 1095 (2d Cir. 1982); American Television and Communications Corp. v. Manning, 651 P.2d 440 (Colo. Ct. App. 1982); Metropolitan Opera Ass'n v. Wagner-Nichols Recorder Corp., 199 Misc. 786, 101 N.Y.S.2d 483 (1950), *aff'd mem.*, 279 A.D. 632, 107 N.Y.S.2d 795 (1951); *cf.* Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977) (allowing protection for a performer's "right of publicity").

136. Act of Oct. 19, 1976, 17 U.S.C. § 301 (1982). The Act reads:

> (a) [A]ll legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103 . . . are governed exclusively by this title . . .
>
> (b) Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to—
>
> (1) subject matter that does not come within the subject matter of copyright . . . ; or . . .
>
> (3) activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright . . . .

cause of action is preempted by the federal copyright law. First, the state cause of action must protect rights generally equivalent to those protected by copyright. Second, the state cause of action must protect works within the general subject matter of copyright.

A work lies outside the subject matter of copyright when it is not an expression in a tangible medium.[137] Lack of originality is not sufficient to take a work outside the general subject matter of copyright,[138] nor is it enough that the work partially consists of uncopyrightable material.[139] Without such large scope provisions, states would be able to encroach upon the domain of federal legislation.[140]

The majority of courts considering the misappropriation theory have found that it has been preempted.[141] If the work is within the general subject matter of copyright, the courts have found that the rights protected by the misappropriation theory are equivalent to those protected by copyright, because both a copyright and a misappropriation claim would require proof of copying.[142]

The legislative history of section 301, recognizes, however, that " 'misappropriation' is not necessarily synonymous with copyright infringement."[143] The courts' approach fails to recognize that both a copyright and a misappropriation claim allege that the defendant has taken different elements of the plaintiff's work. While copyright protects the expressive elements in a work, misappropriation in this context protects the nonexpressive elements: the plaintiff's investment of labor, skill, and effort to locate information.[144] If, however,

---

137. H.R. REP. NO. 1476, *supra* note 17, at 131; *see also* Comment, *The Evolution of the Preemption Doctrine and its Effect on Common Law Remedies*, 19 IDAHO L. REV. 85, 102-03 (1983).

138. H.R. REP. NO. 1476, *supra* note 17, at 131.

139. Harper & Row Publishers v. Nation Enter., 723 F.2d 195, 200 (2d Cir. 1983).

140. "Were this not so, states would be free to expand the perimeters of copyright protection . . . on the theory that preemption would [not bar] state protection of material not meeting federal statutory standards." 723 F.2d at 200.

141. Comment, *supra* note 137, at 110.

142. *See, e.g.*, Mitchell v. Penton Indus. Publishing Co., 486 F. Supp. 22, 26 (N.D. Ohio 1979); Schuchart & Assoc., Professional Eng'rs, Inc. v. Solo Serve Corp., 540 F. Supp. 928, 944 (W.D. Tex. 1982).

143. H.R. REP. NO. 1476, *supra* note 17, at 132.

> [A] cause of action labelled as "misappropriation" is not preempted if it is in fact based neither on a right within the general scope of copyright . . . nor on a right equivalent thereto. For example, state law should have the flexibility to afford a remedy (under traditional principles of equity) against a consistent pattern of unauthorized appropriation by a competitor of the *facts* (i.e., not the literary expression) constituting "hot" news . . . .

Id. (emphasis added).

144. *See* 1 M. NIMMER, *supra* note 78, at § 1.01[B][2][b]("[T]he limitations of the Copy-

the plaintiff contends that the defendant has gained a competitive advantage by taking the plaintiff's expression rather than creating his own expression,[145] then copyright and misappropriation would be protecting "equivalent" rights, and the misappropriation claim would be preempted.[146]

C. *Fair Use*

An increasing number of courts have used the fair use doctrine to avoid giving excessive protection to compilers when the material taken by a subsequent compiler is within the scope of the prior compiler's copyright.

The 1976 Act is the first of the copyright statutes to recognize fair use.[147] Congress indicated that it wanted only to recognize the common law doctrine, without limiting the evolution of the common law.[148]

Fair use, an exception to the exclusive monopoly granted by copyright, allows "others than the owner of a copyright to use the copyrighted material in a reasonable manner without [the copyright owner's] consent."[149] Its purpose is to "promote the progress of science and useful arts" by allowing critical,[150] educational,[151] or

---

right Clause preclude statutory copyright in facts, and therefore offer no basis for preemption of state protection of facts . . . .").

145. *See* Schuchart & Assoc., Professional Eng'rs, Inc. v. Solo Serve Corp., 540 F. Supp. 928, 943-44 (W.D. Tex. 1982) (setting out elements of misappropriation claim).

146. *See id.*

147. Act of Oct. 19, 1976, 17 U.S.C. § 107 (1982), states that "the fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching . . ., scholarship, or research, is not an infringement of copyright." The Act then lists four factors to be considered in determining whether a use is "fair":

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

Id.

148. H.R. REP. No. 1476, *supra* note 17, at 66.

149. Rosemont Enter., Inc. v. Random House, Inc., 366 F.2d 303, 306 (2d Cir. 1966) (quoting H. BALL, THE LAW OF COPYRIGHT AND LITERARY PROPERTY 260 (1944)), *cert. denied*, 385 U.S. 1009 (1967).

150. *See, e.g.*, Berlin v. E.C. Publications, Inc., 329 F.2d 541, 554 (2d Cir. 1964) (parody as a form of social and literary criticism held to be fair use; constitutional purpose of copyright means that the copyright holder's financial interests must be subordinated to the "greater public interest in the development of art, science and industry"), *cert. denied*, 379 U.S. 822 (1964).

151. 17 U.S.C. § 107 (1982), *quoted supra* note 147.

other socially beneficial uses of copyrighted works.[152]

Most of the compilation cases have dealt with historical works, in which the public benefit asserted was the advancement of society's understanding of history.[153] This social benefit comports with those listed by the Act as examples of the uses that would be considered "fair."[154] In such cases, the expression taken by the subsequent compiler was typically the prior compiler's expression of the facts themselves, as contrasted with the prior compiler's selection or arrangement of materials.[155] However, the "public benefit" rationale has been applied in at least one case involving the protection of a compiler's selection or arrangement of preexisting materials.

In *New York Times Co. v. Roxbury Data Interface, Inc.*,[156] the plaintiff had created an index to the *New York Times*. The defendant wished to create a further index showing the location of references to personal names in the plaintiff's index. The nature of the defendant's work required that the defendant copy the plaintiff's work.[157] The court assumed that the plaintiff's copyright covered the use of the names indexed in its work,[158] but nonetheless found that the defendant's use of the plaintiff's index was fair.

The court believed that the defendant's profit motive for creating its index was overcome by its other purpose, namely, to save the public the time and effort of going through every volume of the plaintiff's index to find all references to a particular name.[159] Moreover, the effect of the defendant's work on the plaintiff's market was slight, and may even have been beneficial, since the defendant had not copied the plantiff's listing of references to *New York Times* articles (generally regarded as the most useful aspect of the plaintiff's work). A meaningful use of the defendant's work therefore re-

---

152. The Act also lists news reporting and research as examples of the kinds of uses that will be considered "fair." *Id.*

153. *See, e.g.*, Rosemont Enter., Inc. v. Random House, Inc., 366 F.2d 303 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967); Time, Inc. v. Bernard Geis Assoc., 293 F. Supp. 130 (S.D.N.Y. 1968).

154. All of the "fair uses" listed by § 107 promote society's interest in the development or dissemination of ideas, thus advancing first amendment concerns. Promoting the development of historical knowledge similarly implies an interest in the development of ideas.

155. *See, e.g.*, Rosemont Enter., Inc. v. Random House, Inc., 366 F.2d 303 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967); Time, Inc. v. Bernard Geis Assoc., 293 F. Supp. 130 (S.D.N.Y. 1968).

156. 434 F. Supp. 217 (D.N.J. 1977).

157. *Id.* at 220-21. The defendant had to copy the plaintiff's work so that he could make page references to it, and collect all the variant spellings of names.

158. *Id.* at 221.

159. *Id.*

quired use of the plaintiff's work as well.[160] Because the defendant's work would be beneficial to the public, and would not harm the plaintiff's market, the court held that the defendant's use was fair.[161]

Despite the emphasis that the *New York Times* court placed upon the public benefit of the defendant's work, it is the economic harm to the plaintiff that typically has been the controlling factor in fair use cases.[162] In determining the economic harm to the work, courts will consider both its original and its potential markets.[163] In *New York Times*, if the plaintiff's copyright had covered the names as indexed, the defendant's work would have caused economic harm to the plaintiff by impairing its ability to market a derivative index. Under the usual analysis, then, the defendant's use would have been considered unfair.

In addition, the public benefit found in *New York Times* may not be one of those intended to be promoted by the fair use defense. The uses normally allowed by fair use obviously are intended to help advance ideas,[164] and thus have strong first amendment implications. The essence of the *New York Times* decision was the promotion of public convenience, arguably a less compelling interest than the advancement of ideas. On the other hand, the court's decision might be interpreted as promoting the free dissemination of information, which is a value protected by the first amendment.[165]

The interest in public access to information could be protected more directly. Protection of a compiler's rights in his selection and/or arrangement of preexisting materials might prevent others from access to the information itself, particularly where the arrangement is dictated by the nature of the materials. Such protection would be contrary to the constitutional mandate that the copyright protect only "[w]ritings."[166] Therefore, a court might hold that only exact copying of the selection and/or arrangement

160. *Id.* at 223-24.

161. *Id.* at 226.

162. *See* Goldwag, *Copyright Infringement and the First Amendment*, 29 COPYRIGHT L. SYMP. (ASCAP) 1, 19-24 (1983); Cohen, *Fair Use in the Law of Copyright*, 6 COPYRIGHT L. SYMP. (ASCAP) 43, 62 (1955).

163. 17 U.S.C. § 107(4) (1982), *quoted supra* note 147. *Cf.* Taylor, *supra* note 80, at 67-68 (courts are not generally agreed on effect of commercial dormancy of copyrighted work on fair use defense; question whether future markets for the work should be considered); Cohen, *supra* note 162, at 62-64.

164. *See supra* note 158.

165. For example, news reporting.

166. U.S. CONST. art. I, § 8, cl. 8; *see* 1 M. NIMMER, *supra* note 78, § 1.08[D].

would be prohibited, to preserve the free availability of the information.

Such an analysis has been used in other cases in which courts have found that broad protection of an author's expression would come too close to protecting his ideas.[167] The author's expression was protected, but the scope of the protection was limited, to preserve the free availability of the ideas.

D. *Summary*

Copyright is an improper means for protecting a compiler's labor and expense in collecting his data, as copyright is intended to protect expressions, not labor. Thus, even though a compilation is protected by copyright, the scope of that protection does not encompass the preexisting works or information that the compiler uses, because these are not his expressions.

However, a state law claim for misappropriation may be available to protect the compiler's interest in gaining the benefits from his labors. Most courts have found that the misappropriation doctrine, as applied to protection of compilers' interests, is preempted by the 1976 Act. Yet since the interest protected by the misappropriation doctrine is labor, rather than expression, preemption is not a necessary conclusion, nor is it entirely consistent with the language and history of the Act.

Even when the compiler's expression is being protected, that protection must be limited to ensure that copyright is not used to protect elements that are not expressions. One court has done this through the fair use defense. Arguably, a better approach would recognize that the protection of a compiler's expression may, in some cases, come too close to protecting the information itself. In such cases, the limits of protection should extend only as far as the compiler's precise, expressive contribution to the work.

III. PROTECTION OF NONORIGINAL MATERIAL IN DERIVATIVE WORKS

A derivative work usually contains three elements: first, those that are copied from the preexisting work;[168] second, those that are necessary to transform the original work into the new form or me-

167. *See, e.g.*, Herbert Rosenthal Jewelry Corp. v. Honora Jewelry Co., 509 F.2d 64 (2d Cir. 1974); Herbert Rosenthal Jewelry Corp. v. Kalpakian, 446 F.2d 738 (9th Cir. 1971).

168. For example, a direct quote from the dialogue of a novel in a movie version. Goldstein, *supra* note 2, at 243.

dium;[169] and third, those that are entirely original to the derivative work.[170] If the derivative is unlicensed, the first element may infringe upon the original author's right to reproduce his work, and the second may infringe upon his right to create derivatives.

A. *Originality in Derivative Works*

A derivative author certainly can protect his adaptation or transformation of a preexisting work through a license from its original author.[171] But can he protect it through the copyright in the derivative work, as an original element in itself?

Professor Nimmer has argued that there is nothing original in a change of medium alone. The derivative author did not originate either the medium or the underlying work; by adapting the underlying work to the new medium, the derivative author simply reproduced the underlying work in the new medium.[172] Thus, granting copyright protection to a derivative work only because it adapts a preexisting work to a different form or medium would violate the principle that copyright protects only original material.[173]

Nimmer's argument makes sense from an historical perspective. Derivative works were once considered to be noninfringing.[174] Thus, the transformation of a work into a new form or medium was believed to add an original, expressive element. As copyright expanded to encompass derivative rights, though, the law has come to recognize that an author's expression includes more than form; an adaptation of a work to a different form or medium would now infringe the author's right to protect his expression.

This correspondingly implies that the form of a work is not the original, expressive element that entitles the work to protection. An author has the exclusive right to transform his work into different forms and media. Any rights that the derivative author acquires in

---

169. For example, translation of the sentence, "Jane was frightened," in a novel to an actor's expression of fear in a movie version. *Id.* The translation might be done in a number of ways; Jane might show her fear by widening her eyes, or by running, or by letting her mouth gape open.

170. For example, adding scenes or dialogue in the movie version of a novel. *Id.*

These three elements overlap. The hypothetical novel, for instance, might say, "They chatted pleasantly for a few minutes." The moviemaker wanting to recreate that scene would have to make up new dialogue for it. The dialogue would be "necessary" to the transformation, but would also be "original."

171. *See, e.g.*, G. Ricordi & Co. v. Paramount Pictures, Inc., 189 F.2d 469, 471 (2d Cir. 1951).

172. 1 M. NIMMER, *supra* note 78, § 2.08[C].

173. *Id.*

174. *See supra* notes 38-41 and accompanying text.

his realization of the author's right must be derived from the author's right.

At the same time, Nimmer and other commentators have recognized that protection of the author's right to transform his work does not mean necessarily that the transformation cannot be original.[175] While there is no originality in a work which merely reproduces another, preexisting work in a new form or medium, the derivative work may significantly change the underlying work in adapting it to the new form or medium. These variations originated with the derivative author, and therefore should be considered original to his work under the traditional, minimal standard of originality.[176]

The court in *Doran v. Sunset House Distribution Corp.*,[177] found that the plaintiff's adaptation of Santa Claus to three-dimensional plastic was original under that standard.[178] Admittedly, all aspects of the plaintiff's work except its three-dimensional and plastic elements were traditional, nonoriginal elements of the Santa Claus character.[179] The court found that the defendant had copied the three-dimensional and plastic elements from the plaintiff's work in creating its Santa Claus figure, and therefore had infringed.[180] Professor Nimmer, however, has argued that the plaintiff in *Doran* originated neither the character, the three-dimensional form, nor the plastic medium. Thus, there was nothing original about the plaintiff's work, and he should not have received protection.[181]

In *L. Batlin & Son, Inc. v. Snyder*,[182] the plaintiff made a number of changes in adapting an antique mechanical toy bank to plastic.[183] The court found that, because the changes in the underlying work were necessary[184] to the adaptation and also substantively trivial, they merely displayed physical skill, and so were not

175. 1 M. NIMMER, *supra* note 78, § 2.08[C]; Goldstein, *supra* note 2, at 243.

176. 1 M. NIMMER, *supra* note 78, § 2.08[C], at 2-99 to 2-100.

177. 197 F. Supp. 940 (S.D. Cal. 1961), *aff'd*, 304 F.2d 251 (9th Cir. 1962).

178. *Id.* at 944.

179. *Id.*

180. *Id.* at 947-48.

181. 1 M. NIMMER, *supra* note 78, § 2.08[C].

182. 536 F.2d 486 (2d Cir.), *cert. denied*, 429 U.S. 857 (1976).

183.

> Appellant Snyder claims differences not only of size but also in a number of other very minute details: the carpetbag shape of the plastic bank is smooth, the iron bank rough; the metal bank bag is fatter at its base; the eagle on the front of the platform in the metal bank is holding arrows in his talons while in the plastic bank he clutches leaves . . . .

Id. at 489.

184. *Id.*

original.[185] It feared that protection of such minute changes would create too great a potential for harassment; the threat of suit for infringement might drive other authors away from creating derivative works, even though they technically would not infringe if they did not copy the prior derivative work. Thus, the first person to adapt a work to a particular medium would have an effective monopoly.[186]

The potential for harassment, however, is an accepted cost of having a minimal originality standard.[187] Copyright protection would not bar others from doing their own adaptation of a preexisting work; it would only bar them from copying a previous adaptation. Furthermore, the prior derivative author would have to prove that a subsequent derivative author copied his work. If the changes made were obvious, the plaintiff's proof would be correspondingly more difficult.

Protection of a derivative author's variations on a preexisting work would not extend to the transformation itself. Nor would it require protection for those changes essential to the transformation.[188] *Durham Industries, Inc. v. Tomy Corp.*[189] illustrates the harassment which may result from adopting an originality standard which is too low. Walt Disney Productions authorized both Tomy and Durham to create plastic wind-up toy versions of Disney characters.[190] Tomy claimed that Durham had copied its toy and therefore infringed its copyright. The court refused to recognize Tomy's copyright, arguing that Tomy had done no more than change the form in which the Disney character appeared.[191] Like the court in

---

185. *Id.* at 491.

186. *Id.* at 492.

Professor Nimmer has argued that this rationale would lead to the "ludicrous result that the first person to execute a public domain work of art in a different medium thereafter obtains a monopoly on such work in such medium, at least as to those persons aware of the first such effort." Such a result would not be correct, because the medium itself is not an original element. 1 M. NIMMER, *supra* note 78, § 2.08 [C], at 2-99 to 2-100.

187. Goldstein, *supra* note 2, at 243.

188. Changes essential to the transformation are those which must be made and in only one way. "To grant protection [when the possible permutations of expression are few] would permit appropriation of the subject matter." A. LATMAN, THE COPYRIGHT LAW 32 (5th ed. 1979). *Cf. supra* notes 107, 166-67 and accompanying text.

189. 630 F.2d 905 (2d Cir. 1980).

190. *Id.* at 911.

191.

> [T]he mere reproduction of the Disney characters in plastic . . . does not constitute originality as this Court has defined the term. Tomy has demonstrated, and the toys themselves reflect, no independent creation, no distinguishable variation from preexisting works, nothing recognizably the author's own contribution that sets Tomy's figures apart from the prototypical [Disney characters] . . . .

Batlin, it stated that, if given protection, Tomy could harass subsequent derivative authors, and thus interfere with Disney's right to license derivative works.[192]

The court understated the problem. Unlike the plaintiff's work in *Batlin*, there was no indication that Tomy had contributed anything original to the Disney characters in adapting them to the new form.[193] Rather, it reproduced the characters in the new form, and therefore did not create an original derivative work apart from the Disney character. Thus, while Tomy might have been able to protect its transformation through a license from Disney, it should not have been able to do so through a separate copyright interest.

B. *Summary*

The right to create derivative works was given to the original author to encourage him to create and publish his work. Separate protection of the derivative author merely because he reproduced the original work in a new form or medium would detract from this incentive. The subsequent author who transforms the work acquires the right to do so from the author of the underlying work, and has done nothing original vis-à-vis the work, the medium, or the form with which he works.

However, the originality standard should ensure that copyright protection is available for any changes that the derivative author makes beyond a mere change in form or medium. Even if some changes were necessary to transform the work, the derivative author had to exercise judgment in determining the particular changes that would be made. Thus, the changes originated with the derivative author and were not copied. To maintain the minimal originality standard, such changes must be considered original.

IV. CONCLUSION

Derivative works and compilations can be described broadly as containing both preexisting and original materials.[194] There is, however, an area of overlap, in which both kinds of materials are present. Whether the copyright in the derivative work or compilation can protect the overlapping elements turns on the question

---

Id. at 910.

192. *Id.* at 910-11.

193. *Id.* at 910, *quoted supra* note 191.

194. *See supra* notes 1-2.

whether these elements can be considered to be the original expression of the derivative author or compiler.

Research is one area in which preexisting and original materials overlap.[195] The materials discovered by the researcher existed before the researcher discovered them, and so they are not original to him. However, the researcher may have expended a great deal of time and effort in collecting the materials, and in that sense, the research is original. In the context of copyright, research is not an expression; it is only labor.[196] Thus, even though certain policies would indicate that research should be protected, copyright is not the proper means. A state law claim for misappropriation is better suited to provide protection in this area. Even when a compiler's expression, i.e., his selection and arrangement of the preexisting materials, is being protected, that protection should be limited to ensure that copyright is not used to protect the preexisting material itself.

The transformation of a work to a new form or medium also raises questions about the protection of overlapping materials or rights. The author of the preexisting work has the right to transform his work to different forms and media.[197] Yet, a derivative author who prepares a transformation of the original work to a different form or medium may exercise judgment and effort which meets the originality standard's "origination" requirement.[198] Such an author should be protected to the extent of his contribution. The author's right to transform or adapt his work, however, indicates that the form or medium in itself cannot be considered original. A derivative author who reproduces a work in a new form or medium only can protect what his license from the original author gives him authorization to do.

CHRISTINE WALLACE

195. *See supra* notes 109-17.
196. *See supra* notes 118-26.
197. *See supra* notes 172-74.
198. *See supra* notes 175-76.