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# AN AUTHOR'S RIGHT TO RETURN TO A THEME: PROTECTING ARTISTIC FREEDOM IN VISUAL, MUSICAL AND LITERARY WORKS

David W. Melville\*

## I. INTRODUCTION

Throughout the history of art, painters and sculptors have looked to their past creations as inspiration for current works. Some artists return to basic themes time and time again. "Winslow Homer's schoolboys, Monet's facade of Rouen Cathedral, and Bingham's flatboat characters"<sup>1</sup> all served as catalysts to expand the boundaries of the visual arts. Many composers, both classic and modern, continue to write music in one style, employing the same conventions throughout their careers. Writers often return to well-known characters in order to invent new stories. Whether the writer is devising a world of fantasy or spinning the latest detective yarn, characters from previous stories bring continuity and depth to the plot.

An author who returns to a theme poses a curious problem for copyright law when he no longer owns rights in the original piece: the author may be sued for infringing his own work. Since every author is only a finite source of ideas and expressions, copyright law may undermine its Constitutional purpose by chilling authorship.<sup>2</sup> In addition, variations on a theme are often used to push the frontiers of an art. The spirit of experimentation may be stifled if copyright law is too restrictive.

Because separate policy concerns are involved when an author returns to a theme, this article will draw a distinction between authors who return to works they created in the past as a source of new ideas and authors who use the works of others as a source of inspiration. Part II investigates this distinction in the context of artists who use the same

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1. *Franklin Mint Corp. v. National Wildlife Art Exch.*, 575 F.2d 62, 66 (3d Cir. 1978).

2. "The Congress shall have Power . . . [t]o 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." U.S. CONST. art. I, § 8, cl. 8.

subject matter to design separate visual works,<sup>3</sup> and proposes a test for determining infringement that safeguards experimentation and progress in the arts.<sup>4</sup> Part III addresses the problem of composers accused of writing songs which infringe rights in musical works they devised.<sup>5</sup> Part IV examines a literary author's right to create sequels with characters that appear in a work which is no longer owned by the author.<sup>6</sup>

## II. VISUAL WORKS

An artist can infringe upon the copyright in a visual work he created in the same manner as an artist who had no part in shaping the original: in both cases, the artist is attempting to fashion a new work from the same subject matter.<sup>7</sup> As a result of the differing policy concerns in each case, this article proposes that courts use separate tests to determine if infringement has occurred depending on whether or not the artist created the original visual work.

### A. Copying the Subject Matter of an Original Work

#### 1. Artists Who did not Create the Original

Justice Holmes declared in *Bleistein v. Donaldson Lithographing Co.*<sup>8</sup> that, "[o]thers are free to copy the original. They are not free to copy the copy."<sup>9</sup> One artist cannot preclude another from utilizing a particular

3. See *infra* notes 7-109 and accompanying text.

4. See *infra* parts II.B.2, II.C.

5. See *infra* notes 139-65 and accompanying text.

6. See *infra* notes 166-91 and accompanying text.

7. It is, of course, copyright infringement to reproduce an original work by directly copying it, regardless of whether the person is the original author who has transferred his ownership rights in the work, or someone who never had any rights at all. 17 U.S.C. § 106 (1988). See *Dodd, Mead & Co. v. Lilienthal*, 514 F. Supp. 105 (S.D.N.Y. 1981) (author liable for publishing copies of his own book in contravention of an exclusive publication contract). Rather, the type of infringement which this section focuses on occurs in the form of creating another separate work by copying at least some of the subject matter of the original work. An example of this would be a photographer taking a picture using the same models and setting as the first photograph, instead of simply reproducing from the negatives themselves.

8. 188 U.S. 239 (1903).

9. *Id.* at 249. A large body of cases make it clear that a third party may not copy the copy. See, e.g., *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884); cf. MELVILLE B. NIMMER & DAVID NIMMER, 2 NIMMER ON COPYRIGHT § 8.01[C], at 8-18 (1993). "[T]he availability of

model or subject matter to create a second work. As with most truisms, Holmes' statement is valid as a general matter, but the proposition is in no way absolute. It is certainly true that copyright in a photograph or painting does not give an artist copyright protection in the underlying subject itself.<sup>10</sup> But in many circumstances Justice Holmes' aphorism has not been followed. In those situations, "[o]thers are not 'free to copy the original' . . . any more than they may copy the copy."<sup>11</sup> Subsequent artists may only use the original subject matter to the extent that they are not, in effect, simply "copying the copy" by appropriating the first author's expression in the original work.<sup>12</sup> Generally, courts apply the idea-expression dichotomy to visual works, at least metaphorically. The copyrightable elements of a work include only the artist's particular expression of the subject.<sup>13</sup> Unprotectable "ideas" include elements such as color, perspective and positioning of basic geometric shapes.<sup>14</sup> Protectable "expression" lies in the artist's combination and arrangement of these elements.<sup>15</sup>

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such a common source will not immunize the defendant from liability if in fact he copied from plaintiff and not from the common source. . . ." *Id.* However, if the second artist's work was the result of independent creation then it is not a copy of the first work regardless of the amount of similarity between them. *Id.* at 8-17.

It seems that Justice Brandeis had doubts about giving copyright protection to "non-artistic" photographs in *International News Service v. Associated Press*, 248 U.S. 215 (1918) (Brandeis, J., dissenting). "The mere record of isolated happenings, whether in words or by photographs not involving artistic skill, are denied such protection." *Id.* at 254. Although Brandeis' view has not been followed, "it supports the proposition that the scope of protection for an ordinary photograph is narrow." David E. Shipley, *Conflicts Between Copyright and the First Amendment After Harper & Row, Publishers v. Nation Enters.*, 1986 B.Y.U. L. REV. 983, 1029 n.302 (1986).

10. *Pagano v. Chas. Beseler Co.*, 234 F. 963 (S.D.N.Y. 1916); *Pohl v. Mills*, 218 Cal. 641 (1933); see also *Jack Adelman, Inc. v. Sonners & Gordon, Inc.*, 112 F. Supp. 187, 189 (S.D.N.Y. 1934). In a case involving a human model, one court remarked that the plaintiff could not copyright the use of the model in another commercial because "they did not create her." *Chuck Blore & Don Richman, Inc. v. 20/20 Advertising Inc.*, 674 F. Supp. 671, 676 (D. Minn. 1987).

11. 2 NIMMER, *supra* note 9, § 8.01[C], at 8-20.

12. See *Dallas Cowboys Cheerleaders, Inc. v. Scoreboard Posters, Inc.*, 600 F.2d 1184 (5th Cir. 1979); *Chuck Blore*, 674 F. Supp. at 671; *Alt v. Morello*, 227 U.S.P.Q. 49 (S.D.N.Y. 1985).

13. See Lynne A. Greenberg, *The Art of Appropriation: Puppies, Piracy, and Post-Modernism*, 11 CARDOZO ARTS & ENT. L.J. 1, 19 (1992).

14. PAUL GOLDSTEIN, 2 GOLDSTEIN ON COPYRIGHT § 8.2, at 63 (1989).

15. *Id.* Difficulties in determining exactly when protectible expression has been appropriated prompted Judge Learned Hand to state:

Obviously, no principle can be stated as to when an imitator has gone beyond copying the "idea," and has borrowed its "expression." Decisions must therefore inevitably be ad hoc. . . . No one disputes that the copyright extends beyond a photographic reproduction of the design, but one cannot say how far an imitator

Attempts to circumvent copyright law by making an exact replica of the original subject matter, instead of simply reproducing the actual physical depiction, arose as early as the nineteenth century. In *Turner v. Robinson*,<sup>16</sup> Henry Wallis painted "The Death of Chatterton" which was placed in the Royal Academy of Art in London in 1856. A few years later, James Robinson observed the painting on exhibit in Dublin. After viewing the painting, Robinson studied several biographical accounts of the event and arranged a pallet, table and box in front of a canvas screen painted by a scenic artist. Robinson placed a servant on the pallet and took several stereoscopic photographs which he advertised as "The Life and Death of Chatterton."<sup>17</sup> Robinson's photograph copied even the minute details of the painting's coloring.<sup>18</sup> The Irish Court of Appeals ruled that the photograph had been contrived to make a perfect representation of the painting and "no Court of Justice can admit that an act, illegal in itself, can be justified by a novel or circuitous mode of effecting it."<sup>19</sup>

An even more unusual situation occurred in *Hanfstaengl v. H.R. Baines & Co.*<sup>20</sup> In that case, the plaintiff owned the copyright in a series of German paintings. Several people posed on stage as characters from the painting in a performance at the Empire Theater in London. The actors created a real life representation of the German paintings by forming "living pictures."<sup>21</sup> The defendant attended the performance and published sketches of the living pictures in the *Daily Graphic* newspaper along with an account of the performance. The House of Lords held that one work may be a reproduction of another even though it was not copied directly

must depart from an undeviating reproduction to escape infringement.

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

16. 10 Ir. Jur. 121 (1859), *aff'd*, 10 Ir. Jur. 521 (1860).

17. *Id.* at 125-26.

18. *Id.* at 144.

19. *Turner v. Robinson*, 10 Ir. Jur. 510, 521 (1860). Both opinions rely on strained notions of publication, since at the time there was no statute giving an artist copyright in a painting. *Turner v. Robinson*, 10 Ir. Jur. 121, 131 (1859). As a result, the decisions turned on whether the painting had been published by exhibition, divesting the plaintiff of copyright protection at common law. *Turner v. Robinson*, 10 Ir. Jur. 510, 513 (1860).

20. 20 App. Cas. 20 (1894).

21. *Id.* at 22. The plaintiff had acquired the copyright in four pictures which were presented on stage including: "First Love," "Loves me, loves me not," "Charity," and "Pets." *Id.* at 25. Lord Herschell was careful to note that countenances of the persons who posed in the Living Pictures did not bear a close resemblance to those depicted by the artist. *Id.*

from the work itself.<sup>22</sup> Instead of focusing on differences in minor details or leading features, Lord Shand resolved the infringement issue by determining whether the second work adopted the essential features and substance of the original.<sup>23</sup> However, Lord Watson realized that "a copy, by an eminent hand, may display merits which the original does not possess."<sup>24</sup> He recognized that in some circumstances, a talented artist may create a variation with enough distinctions that it would not infringe upon the original.

A court may be particularly inclined to find infringement in a case such as *Alt v. Morello*,<sup>25</sup> where a relatively famous artist used his position to steal the secrets of a less well-known artist.<sup>26</sup> In *Alt*, Joe Morello was an established photographer while Howard Alt's career was at its beginning. Alt had previously been employed by Morello, but started working as an apprentice in the studio of Frederic Finkelstein. During his association with Finkelstein, Alt created a photograph of a pencil and a Cross pen framed against a dark background. The tips of the pen and pencil crossed in the center of the picture and were lit from below.<sup>27</sup> While Alt was working on his photograph, Morello observed the set up during a visit to the studio and later saw the finished version in Alt's portfolio. Soon after, Alt became aware that Morello had produced a markedly similar photograph and left Finkelstein's studio. Alt began marketing his portfolio to several advertising agencies, but found little success because numerous art directors had already received copies of Morello's second photograph. Alt found

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22. *Hanfstaengl*, 20 App. Cas. at 30. *Hanfstaengl* and *Turner* clearly indicate that copyright "protects against unauthorized copying not only in the original medium in which the work was produced, but also in any other medium as well." 1 NIMMER, *supra* note 9, § 2.08[E], at 2-127. See also *Lumiere v. Pathe Exch.*, 275 F. 428 (2d Cir. 1921).

*Hanfstaengl* is rather bizarre, because the defendant had no part in setting up or positioning the subject matter. *Hanfstaengl*, 20 App. Cas. at 28. Interestingly, Lord Ashbourne seemed to entertain a freedom of the press argument that the sketches "were intended to represent what could be seen at the Empire Theater, and were not intended as copies . . ." *Id.* at 29.

23. *Id.* at 31. The other Lords each agreed that the sketches were an infringement (with the exception of Lord Ashbourne), but refused to articulate any sort of test. For example, Lord Watson remarked:

The possibility of laying down any canon which will afford in every case a useful test of what constitutes a copy or colourable imitation of the work or its design is, in my opinion, very doubtful. At all events, it is much easier to arrive at what does not than to define what does constitute a proper test.

*Id.* at 26.

24. *Id.* at 26-27.

25. 227 U.S.P.Q. 49 (S.D.N.Y. 1985).

26. *Id.*

27. *Id.* at 50.

himself in the unfortunate position of having others believe he had actually copied Morello's picture.<sup>28</sup>

Morello's version contained only slight variations from the original. Morello merely used a different brand of pen and pencil, slightly varying the angles at which they intersected. The court had little problem finding access to the work and substantial similarity.<sup>29</sup> "The differences between the two photographs are so insignificant that 'the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same.'"<sup>30</sup>

In *Kisch v. Ammirati & Puris Inc.*,<sup>31</sup> both the original and subsequent photographs were taken at the Village Vanguard, a nightclub in Manhattan, with the same mural serving as the background. The plaintiff's black and white picture featured a young woman seated holding a concertina. In contrast, the defendant's color photograph featured a musician, John Lurie, seated holding a saxophone with a bottle of lime juice in the forefront.<sup>32</sup> The court denied the defendant's motion for summary judgment concluding that the mood of the defendant's photograph was similar enough to the original conception that a rational trier of fact could find infringement.<sup>33</sup> *Kisch*, however, marked the high point for judicial protection of subject matter used in an another original work.

In *Edwards v. Ruffner*,<sup>34</sup> the court indicated that, even if the defendant had copied from Edwards, she took no more than unprotectible ideas in creating her own work. Edwards designed a photograph of a ballet dancer in the fifth position entitled "Leg Warmers." Aptly enough, the photograph depicted a dancer's leg covered by torn leg warmer socks from her feet to slightly above the knee-caps.<sup>35</sup> One of the defendants used a

28. *Id.* The situation which resulted is similar to reverse confusion in trademark law where consumers believe that the goods sold by the first user of the trademark are actually those of the second user. See RESTATEMENT OF UNFAIR COMPETITION § 20 cmt. f (Tentative Draft No. 2, 1990); *Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co.*, 408 F. Supp. 1219 (D. Colo. 1976), *aff'd*, 561 F.2d 1365 (10th Cir. 1977).

29. *Alt*, 227 U.S.P.Q. at 51.

30. *Id.* at 57 (citing *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960)).

31. 657 F. Supp. 380 (S.D.N.Y. 1987).

32. *Id.* at 384. The two photographs are reproduced in ALAN LATMAN ET AL., COPYRIGHT FOR THE NINETIES 423 (1989).

33. *Kisch*, 65 F. Supp. at 384. See also *Chuck Blore & Don Richman, Inc. v. 20/20 Advertising Inc.*, 674 F. Supp. 671 (D. Minn. 1987); *Dallas Cowboys Cheerleaders, Inc. v. Scoreboard Posters, Inc.*, 600 F.2d 1184, 1186 (5th Cir. 1979).

34. 623 F. Supp. 511 (S.D.N.Y. 1985).

35. *Id.* at 512.

photograph entitled "Toe Shoes" on its greeting cards. This picture also portrayed a ballet dancer in the fifth position wearing leg warmers. As the court related the facts, the appearance of the leg warmers and ballet shoes in the second picture were in "stark contrast" with Edwards' depiction. The photographs were taken at different angles and portrayed the classic fifth position pose in a noticeably different fashion.<sup>36</sup> As a result, Edwards failed to meet the likelihood of success on the merits standard necessary to obtain a preliminary injunction. The court found that the two photographs shared only common "ideas," ruling that Edwards could not "preclude others from depicting a ballet dancer in the classic 'fifth position.'"<sup>37</sup>

In summary, Justice Holmes' remark that "[o]thers are free to copy the original . . . [but] [t]hey are not free to copy the copy"<sup>38</sup> must be qualified. Subsequent artists are free to copy the original subject matter to the extent that they are not merely "copying the copy" by appropriating the first artist's expression.<sup>39</sup> Often, however, even significant variation in positioning, coloring, and use of models will not avoid infringement.<sup>40</sup>

## 2. Artists Who Created the Original

Artists often return to the subject matter of a work they devised in the past in order to create a new version highlighting different aspects of the subject, or using a different perspective to fashion a new expression. "[T]he very act of authorship in any medium is more akin to translation and recombination than it is to creating Aphrodite from the foam of the sea."<sup>41</sup> The difficulty in copyright law arises when an artist no longer owns rights in the original work. If courts simply apply the same tests and principles to determine whether an original artist has infringed upon his own work as they do when determining if another artist has infringed upon the work, copyright law may work against itself to stifle the very authorship it seeks to foster.

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36. *Id.*

37. *Id.* at 513. Cf. *International Biotical Corp. v. Associated Mills, Inc.*, 239 F. Supp. 511, 514 (N.D. Ill. 1964): "Plaintiff's copyrights cannot monopolize the various poses used in these photographs since its copyrights can protect only Plaintiff's particular photographic expression of these poses and not the underlying ideas . . ." *Id.*

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

39. 2 NIMMER, *supra* note 9, § 8.01[D], at 8-20.

40. See, e.g., *Kisch v. Ammirati & Puris Inc.*, 657 F. Supp. 380 (S.D.N.Y. 1987).

41. Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965, 966 (1990) (emphasis omitted).



## a. State of the Law

Courts have approached the problem of common authorship with varying degrees of sensitivity and varying results.<sup>42</sup> The Second Circuit first addressed this issue in *Gross v. Seligman*.<sup>43</sup> In *Gross*, an artist named Rochlitz posed a nude model for a photograph entitled "Grace of Youth." Rochlitz assigned the copyright to the plaintiffs and took another photograph of the same model entitled "Cherry Ripe" two years later. While the court indicated that "the artist was careful to introduce only enough differences to argue about," the description of the photographs indicates that the second version may have contained tenable differences.<sup>44</sup> For example, the young woman who was sedate in "Grace of Youth" wears a smile in the second picture and holds a cherry stem between her teeth. In addition, the backgrounds are different and the contours of the woman's figure had changed from the passing of the years.<sup>45</sup> However, the court found that because of the similarities in pose, light, and shade, the second work would "seem to be a copy to the ordinary purchaser who did not have both photographs before him at the same time."<sup>46</sup>

The opinion is disturbing on two counts. First, the court equated the facts of this case with those in *Turner v. Robinson*<sup>47</sup> and *Hanfstaengl v. H.R. Baines & Co.*,<sup>48</sup> even though those cases involved indirect copying by a second artist.<sup>49</sup> The court did not recognize a potential difference when the original author created both works. Second, the standard the court used to determine substantial similarity is extremely restrictive regardless of who created the second work.<sup>50</sup> An ordinary purchaser

42. 2 GOLDSTEIN, *supra* note 14, § 8.2, at 65.

43. 212 F. 930 (2d Cir. 1914).

44. *Id.* at 931.

45. *Id.* at 930-31.

46. *Id.* at 931-32.

47. 10 Ir. Jur. 121 (1859), *aff'd*, 10 Ir. Jur. 510 (1860). See *supra* notes 16-19 and accompanying text.

48. 20 App. Cas. 20 (1894). See *supra* notes 20-24 and accompanying text.

49. *Gross v. Seligman*, 212 F.2d 930, 931 (2d Cir. 1914).

50. *Id.* The court opined that:

the identities are much greater than the differences, and it seems to us that the artist was careful to introduce only enough differences to argue about, while undertaking to make what would seem to be a copy to the ordinary purchaser who did not have both photographs before him at the same time.

*Id.* See also *Gross v. Van Dyk Gravure Co.*, 230 F. 412 (2d Cir. 1916) (determining that publication of another photograph of the same model, "At Ease," did not destroy the copyrightability of "Grace Of Youth").

might easily believe that photographs of different trees or even different babies were copies if not allowed to compare the pictures.<sup>51</sup>

While the *Gross* court may have failed to address the different concerns involved with original authors, other courts have at least recognized the problem.<sup>52</sup> For example, in *Esquire, Inc. v. Varga Enterprises*,<sup>53</sup> the defendant made a series of drawings which were published as a monthly feature in *Esquire* magazine. The drawings, commonly known as "Varga Girls," portrayed women in a state of semi-nudity that over-emphasized many physical details of the female anatomy. After Varga's contract ran out, he continued making and selling his drawings as calendars. The magazine claimed that four of his subsequent drawings infringed upon some of the pictures he had drawn for them. In ruling that the new drawings contained a significant number of distinctions from the old, the court recognized that:

[the] defendant's artistic talent is limited to the portrayal of the female figure in varying degrees of undress. His success in this line of endeavor can undoubtedly be attributed to the remarkable physical characteristics of his finished product, e.g., the exaggerated torso and the subtly curved but unduly long leg. . . . 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.<sup>54</sup>

Although the court recognized that different concerns might be involved, it did not articulate a standard of infringement but instead simply found that the distinctions were sufficient to avoid infringement.<sup>55</sup>

Currently, the Third Circuit has provided the strongest protection of an artist's right to return to a theme. In *Franklin Mint Corp. v. National Wildlife Art Exchange*,<sup>56</sup> Albert Gilbert, a nationally recognized wildlife artist, agreed to paint a watercolor of cardinals for the National Wildlife Art

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51. The test used by the court is more analogous to consumer confusion in trademark than substantial similarity. See RESTATEMENT OF THE LAW OF UNFAIR COMPETITION § 20 (Tentative Draft No. 2, 1990) ("One is subject to liability for infringement of another's trademark . . . [if] the actor uses a designation that is likely to cause confusion."). The standard relies on confusion of the consumer in the marketplace and not on a side-by-side comparison of the marks.

52. *Schiller & Schmidt, Inc. v. Nordisco Corp.*, 969 F.2d 410 (7th Cir. 1992); *Franklin Mint Corp. v. National Wildlife Art Exch.*, 575 F.2d 62 (3d Cir. 1978); *Gentieu v. John Muller & Co.*, 712 F. Supp. 740 (W.D. Mo. 1989); *Esquire v. Varga Enters., Inc.*, 81 F. Supp. 306 (N.D. Ill. 1948), *aff'd in part, rev'd in part*, 185 F.2d 14 (7th Cir. 1950).

53. 81 F. Supp. 306 (N.D. Ill. 1948), *aff'd in part, rev'd in part*, 185 F.2d 14 (7th Cir. 1950).

54. *Id.* at 307-08.

55. *Id.* at 308.

56. 575 F.2d 62 (3d Cir. 1978).

Exchange. Gilbert used source material such as color slides, photographs, sketches, and two stuffed cardinal specimens to fashion "Cardinals on Apple Blossom."<sup>57</sup> A few years later, Gilbert painted a watercolor for Franklin Mint. He used essentially the same collection of source material with the addition of a few more slides and sketches to compose "The Cardinal."<sup>58</sup> The Third Circuit noted conventional limits in ornithological art, such as minute attention to detail of the plumage and stance of the bird, which tend to restrict the novelty of a depiction. "[T]he fact that the same subject matter may be present in two paintings does not prove copying or infringement. Indeed, an artist is free to consult the same source for another original painting."<sup>59</sup>

The *Franklin Mint* Court recognized that the law must grant artists the freedom to utilize basic subject matter more than once.<sup>60</sup> The court equated the right to create "'variations on a theme' . . . as another way of saying that an 'idea' may not be copyrighted and only its 'expression' may be protected."<sup>61</sup> While the court's formulation is seductive, it misses the heart of the problem. By recasting the scenario as another version of idea and expression, the court's phrasing is applicable to all authors, whether they created the original work or not.

## b. Policy Perspectives and Artistic Freedom

Since separate concerns are involved when an author returns to a theme, the law should recognize a distinction between the original artist and subsequent artists. As a matter of policy, an artist who created the first work should be allowed to cut closer to the expression contained in the original without infringing upon the copyright.

### 1. Personality Traits

Each artist has his or her individual style of portraying a subject—a unique way of expressing an idea. "The copy is the personal reaction of an individual upon nature. Personality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of

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57. *Id.* at 63.

58. *Id.*

59. *Id.* at 65 (citing *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903)).

60. *Franklin Mint*, 575 F.2d at 66.

61. *Id.*

art has in it something irreducible, which is one man's alone."<sup>62</sup> While the touch and stroke of an artisan's brush clearly leaves traces of the human who painted them, photographs also contain elements of personality embodied in the selection of the background, angle, timing, shading and lighting used to shape the picture.<sup>63</sup> Judge Hand observed that "no photograph, however simple, can be unaffected by the personal influence of the author, and no two will be absolutely alike."<sup>64</sup>

Just as every artist is unique, every artist is also a finite source.<sup>65</sup> There are only a limited number of ways a single personality will tend to express itself. As a result, an artist's expression will naturally tend to fall into demarcated patterns.<sup>66</sup> As one commentator noted, "[b]ecause both the memory and the inventive powers of even the most brilliantly creative mind are limited, some degree of repetition within the works of a single author is inevitable."<sup>67</sup>

If an artist's innate mode of expression falls within natural bounds, each work he or she portrays will be composed of the same set of characteristics. It is the repetitive nature of expression that allows an artist to form an "identity." When the artist returns to the same subject, separate depictions will appear to be similar due to the inherent predilections of the artist. As one court noted, "[i]f Cezanne painted two pictures of Mont. St. Victoire, we should expect them to look more alike than if Matisse had painted the second, even if Cezanne painted the second painting from life rather than from the first painting."<sup>68</sup>

62. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903).

63. *See Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884); *Rogers v. Koons*, 960 F.2d 301, 307 (2d Cir. 1992), *cert. denied*, 113 S. Ct. 365 (1992); *Chuck Blore & Don Richman, Inc. v. 20/20 Advertising Inc.*, 674 F. Supp. 671, 677 (D. Minn. 1987); *Kisch v. Ammirati & Puris, Inc.* 657 F. Supp. 380, 382 (S.D.N.Y. 1987); *Jeweler's Circular Pub. Co. v. Keystone Pub. Co.*, 274 F. 932, 934 (S.D.N.Y. 1921), *aff'd*, 281 F. 83 (2d Cir. 1922), *cert. denied*, 259 U.S. 581 (1922); 1 *Nimmer, supra* note 9, § 2.08[E] at 2-126.

64. *Jeweler's Circular Pub. Co. v. Keystone Pub. Co.*, 274 F. 932, 934 (S.D.N.Y. 1921).

65. Consistency is what makes both personalities and artists recognizable, *cf. Esquire v. Varga Enters. Inc.*, 81 F. Supp. 306, 307-08 (N.D. Ill. 1948).

66. *See Warner Bros. v. CBS*, 216 F.2d. 945, 950 (9th Cir. 1954), *cert. denied*, 348 U.S. 971 (1954) ("The characters of an author's imagination and the art of his descriptive talent, like a painter's or like a person with his penmanship, are always limited and always fall into limited patterns.") *Id.*

67. Laurie Stearns, *Copy Wrong: Plagiarism, Process, Property, and the Law*, 80 CAL. L. REV. 513, 543-44 (1992). Stearns made this statement in the context of self-plagiarism which "occurs when a work echoes an earlier work by the same author." *Id.* at 543. She continues, "It becomes objectionable only when it results from laziness or the desire to mislead." *Id.* at 544.

68. *Schiller & Schmidt, Inc. v. Nordisco Corp.*, 969 F.2d 410, 414 (7th Cir. 1992).

Thus, if the same methods of determining infringement are applied, the law will be unjustifiably harsh on the artist who conceived the first work since that artist naturally leans toward his unique manner of expression. The artist must avoid at least some of the essential characteristics in his expression to avoid infringement. The odd result is that the first artist will be more constrained in his depiction of the subject than another artist who can employ the entire breadth of her own peculiar style. In essence, the original author is being penalized for having breathed life into the work.

## 2. Depletion of Subject Matter

Using the same standard of infringement for all artists may have a disproportionate effect on the number of original authors willing to risk litigation to depict an old subject. Even if a court applies the same standard with tacit leniency,<sup>69</sup> an artist's fear and uncertainty about the prospects of an infringement action may deter him from generating a work which might invite a lawsuit.<sup>70</sup> The chilling effect is disproportionate because there is every reason to expect that two works by the same artist are more likely to look alike than if another artist devised the second.<sup>71</sup> Applying the typical standard of infringement may also have a tendency to punish specialists. In order to develop a specialty, an artist will naturally create several versions of the same general subject matter, such as paintings of cardinals.<sup>72</sup> Unless a court is aware of the special need of artists to return to a theme, the law may inhibit the ability of the specialist to refine his craft in a way he otherwise might.<sup>73</sup>

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69. Although one cannot be certain, the Third Circuit, for example, may have "masked" their decision in *Franklin Mint* by applying the "copying" standard less stringently to an artist accused of infringing his own work by finding that copyright in the original was "weak." 575 F.2d 62, 65 (1978). See generally Amy B. Cohen, *Masking Copyright Decision Making: The Meaninglessness of Substantial Similarity*, 20 U.C. DAVIS L. REV. 719 (1987).

The problem, of course, is that while the court may have been applying the test less rigorously, it gives other artists nothing that can be used to measure their own conduct and thus creates uncertainty. That uncertainty can be as much of a chill as simply using the same yardstick to determine infringement as is used for other artists.

70. This fear is especially valid in light of the Copyright Act's provision for injunctions, statutory damages without showing injury, and attorney's fees. 17 U.S.C. §§ 501-11 (1988).

71. *Schiller & Schmidt, Inc. v. Nordisco*, 969 F.2d 410, 414 (7th Cir. 1992).

72. See *Franklin Mint Corp. v. National Wildlife Art Exch.*, 575 F.2d 62 (3d Cir. 1978); *Esquire, Inc. v. Varga Enters.*, 81 F. Supp. 306 (N.D. Ill. 1948).

73. See *Franklin Mint*, 575 F.2d at 66-67.

Rather than precluding artists from revisiting old ideas or forcing them to alter the very process by which they create, copyright law should treat the creation of subsequent works by the same artist as distinct. The original artist requires more leeway in expressing the idea because his personal imprimatur is embodied in his expression. In order to allow access to the idea, the first artist must have a limited degree of access to that expression.<sup>74</sup> Otherwise, the chilling effect may prevent artists from returning to past subject matter altogether.

### 3. Experimentation

Artists commonly use a single subject as a vehicle to experiment with elements of style and technique. For example, Claude Monet would often use a single subject or set of subjects to create a "series" of works.<sup>75</sup> When word got out that Monet was devising a new series of paintings, patrons would offer to purchase a piece sight unseen, sometimes even before he had begun to paint.<sup>76</sup> If an art connoisseur was successful in purchasing the first painting in the series along with its copyright, current law would likely afford the first purchaser a colorable claim of infringement against Monet for the subsequent works.<sup>77</sup>

The threat of litigation by the owner of a copyrighted work may have the unfortunate effect of deterring experimentation by artists, even if the suit is ultimately unsuccessful. Monet himself used his series of paintings based on a single subject as a catalyst for experimentation.<sup>78</sup> In painting over forty pictures of the Rouen Cathedral, the facade "is observed from the

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74. For a discussion of the merger doctrine in *Franklin Mint* see HOWARD B. ABRAMS, THE LAW OF COPYRIGHT § 14.03(1)(1), at 14-51 (1993).

75. BERNARD MYERS, METHODS OF THE MASTERS - MONET 88 (1990).

76. *Id.* at 102.

77. The *Franklin Mint* court indicated that "[a] painter like Monet when dwelling upon impressions created by light on the facade of the Rouen Cathedral is apt to create a work which can make infringement attempts difficult." 575 F.2d 62, 65 (1978). Although the court's statement may have been clouded by the pre-eminence of the artist in question (considering its decision to term the copyright in the painting of the cardinals as "weak"), this court may have actually so decided if faced with the question. However, other courts applying the typical standard of infringement would probably at least struggle with Monet's subsequent paintings. Compare *Gross v. Seligman*, 212 F.2d 930 (2d Cir. 1914) (changes in the emotional expression of the model and background were not enough to avoid infringement) with *Kisch v. Ammirati & Puris Inc.*, 657 F. Supp. 380 (S.D.N.Y. 1987) (changing the instrument and the model did not entitle the defendant to summary judgment).

78. HORST DE LA CROIX & RICHARD G. TANSEY II, GARDNER'S ART THROUGH THE AGES 855 (8th ed. 1986).

same point of view, but at different times of day and under various climatic and atmospheric conditions. Monet, with a scientific precision, gives us an unparalleled and unexcelled record of the passing of time as seen in the movement of light over identical forms."<sup>79</sup> Monet described his work by commenting, "I was trying to do the impossible . . . to paint light itself."<sup>80</sup>

While artists certainly are free to experiment with techniques using different subjects, a series of works centered around a single subject is particularly conducive to pushing the boundaries of an art. The use of a single subject provides the artist with an excellent opportunity to compare the use of different methods and techniques. The visual artist is able to assess how well a particular technique or perspective worked far better than if he could only compare the results with different subjects or models. As an example, Monet chose the grain stacks as an apt subject to generate a series of over thirty works because they were so unpromising and banal. The grain stacks' unremarkable appearance insured that nothing would distract from his experiment in color and shade.<sup>81</sup> Monet was able to focus solely on the portrayal of the subject rather than having to bend the techniques he was experimenting with in order to adjust to a new subject.<sup>82</sup>

As can be seen, allowing artists to return to prior subject matter provides an excellent vehicle to challenge the boundaries of conventional perspectives and technique. Thus, in order to promote experimentation and advance progress in the arts, copyright law should be interpreted in a manner that grants the first artist easier access to the subject.

79. *Id.* at 855-56.

80. MYERS, *supra* note 75, at 92.

81. *Id.* Monet told the Duc de Treviso about the beginnings of the grain stack series of paintings:

I first of all believed that two canvases would do, one for grey weather and one for the sun. One day I saw that the light had changed. I asked my step-daughter to fetch another canvas, then another; still another. I worked on each one only when I had my effect . . . . The sun sets so fast that I cannot follow it. I work so slowly that I am desperate . . . the more I continue, the more I see . . . . More than ever I am dissatisfied with things that come easily, in one stroke.

*Id.* at 90.

82. Monet used the single subject matter to experiment with the juxtaposition of colors on the canvas using short, choppy brush strokes. See DE LA CROIX & TANSEY, *supra* note 78, at 855.

#### 4. Public Benefits

Courts should strive to define a standard of infringement that furthers the constitutional purpose of copyright law by encouraging authorship.<sup>83</sup> In this situation, the artist has sold his rights in a work he created to a third party buyer and now wishes to use the subject matter of that work to create a new version which would enrich society. By furnishing incentives, society receives a greater quantity and quality of artistic works. However, in this instance, the person who holds the copyright is not someone who creates. Rather, the third party buyer may be attempting to restrain the artist from using a prior subject matter at the expense of society. Copyright law should not give the buyer of a work a benefit that stifles the source of the bargain.

The artist is in a peculiar position with regard to exploiting the incentive system. If the artist holds the copyright in the original, he is free to experiment as much as he wants. However, in order to exploit the work he must sell it to a third party.<sup>84</sup> If the original artist does not have enough room to experiment with the subject matter, the incentive system conflicts with itself. The artist is forced to either relinquish much of his freedom to experiment in order to reap the benefits of the incentive system, thus slowing progress in the arts, or the artist will not be able to exploit the work, resulting in less incentive to create. Often, the interest in protecting buyers of copyrighted works runs parallel to promoting authorship—the buyer provides a viable market, which creates the economic incentive. In this instance, however, corralling the spirit of creation by withdrawing subjects and styles from which an individual can draw protects the buyer at the expense of stifling authorship. As a result, a standard of infringement permitting an original author to cut closer to the original expression is essential.

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83. See Litman, *supra* note 41, at 969; *Feist Publications, Inc. v. Rural Telephone Serv. Co.*, 499 U.S. 340 (1991).

84. A second artist who also wishes to use the subject matter never conceived of the original work and, therefore, has less claim to the amount of room he should be given to experiment.



## B. The Appropriate Standard for Determining Infringement

### 1. Standard Infringement Tests

#### a. Copying

In order to prove infringement of a visual work, the plaintiff must demonstrate that the defendant copied the work and that the copying constituted improper appropriation.<sup>85</sup> The first element of infringement signifies that the defendant used the copyrighted work as a model or even for inspiration in creating the second work.<sup>86</sup> In general, the plaintiff must either introduce direct evidence of copying, such as an admission by the defendant, or rely on circumstantial evidence.<sup>87</sup> Proof of copying by circumstantial evidence requires a showing that the defendant had access to the copyrighted work and that there is substantial similarity between the works of a degree that negates any inference of independent creation.<sup>88</sup> Once copying has been shown, the court will assume any similarities in protectible expression are a result of the copying.

When an author returns to a theme, similarities between the works alone are not indicative of copying.<sup>89</sup> An artist may not have the details of the past expression in mind when recreating an idea. For example, if an artist sold a picture of the Golden Gate Bridge painted from a hill in San Francisco, and then returned a few years later to erect his easel on the same spot, he may simply prefer the hues the sun casts on the bay from this vantage point. It does not necessarily follow that merely because the artist is revisiting an idea, he will recall the details of the prior expression. In *Schiller & Schmidt, Inc. v. Nordisco Corp.*,<sup>90</sup> the Seventh Circuit remanded an infringement claim against a photographer who created separate pictures of the same product for a catalog advertisement. The court found

85. 3 NIMMER, *supra* note 9, § 13.01[B], at 13-8, 13-9. *See, e.g.*, *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946); *Stillman v. Leo Burnett Co.*, 720 F. Supp. 1353, 1358 (N.D. Ill. 1989).

86. 3 NIMMER, *supra* note 9, § 13.01[B], at 13-8.

87. *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946).

88. 3 NIMMER, *supra* note 9, § 13.02[A], at 13-16; *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946); *De Acosta v. Brown*, 146 F.2d 408 (2d Cir. 1944), *cert. denied*, 325 U.S. 862 (1945); *Smith v. Little, Brown & Co.*, 245 F. Supp. 451 (S.D.N.Y. 1965), *aff'd* 360 F.2d 928 (2d Cir. 1966).

89. However, "[a] virtually conclusive inference of access can also be drawn from the evidence that the same individual or individuals who created plaintiff's copyrighted work also created defendant's work." 2 GOLDSTEIN, *supra* note 14, § 7.2.1, at 10.

90. 969 F.2d 410 (7th Cir. 1992).

the evidence was not clear on the issue of whether the photographer "had been copying himself, rather than hitting independently on the same solution to the same rather narrow problem of layout . . . ."91

In a case involving common authorship, similarities between the works do not support an inference that the artist copied the protectible expression. Although even unconscious copying may form a basis for infringement when a different artist has access to a work,<sup>92</sup> substantial similarity tends to negate any inference of independent creation. When an artist returns to a theme, however, there is every reason to expect that two works created by the same author will appear similar even if they were both the result of independent creation.<sup>93</sup> For instance, in *Franklin Mint*, the Third Circuit found that an artist did not "copy" his first effort by painting a second water color of a cardinal.<sup>94</sup> The panel upheld the lower court's ruling that the "similarity between the works necessarily reflected the common theme or subject and each painting was a separate artistic effort."<sup>95</sup>

In some cases, it may be that the defendant addressed the subject with the details of the first expression firmly in mind. If so, the court must determine if the copying by the defendant in creating the variation went too far.<sup>96</sup> However, in other cases, the artist may have simply recreated the idea with only the common theme in mind. In the latter case, no matter how closely the works resemble each other, the similarities in expression may only be a result of the artist's inherent personality traits.<sup>97</sup> The second work cannot be an infringement since it is the result of independent creation.<sup>98</sup> This determination is a question of fact that the judge or jury must weigh and decide.

#### b. Substantial Similarity

Once copying has been established, courts use various subtests to determine if the copying amounted to improper appropriation.<sup>99</sup> Each

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91. *Id.* at 414.

92. *Fred Fisher, Inc. v. Dillingham*, 298 F. 145, 148 (S.D.N.Y. 1924).

93. *Schiller & Schmidt, Inc. v. Nordisco Corp.*, 969 F.2d 410, 414 (7th Cir. 1992); *Esquire, Inc. v. Varga Enters.*, 81 F. Supp. 306 (N.D. Ill. 1948).

94. *Franklin Mint Corp. v. National Wildlife Exch.*, 575 F.2d 62 (3d Cir. 1978).

95. *Id.* at 66.

96. *See supra* notes 25-28 and accompanying text.

97. *See supra* note 93 and accompanying text.

98. *See 2 NIMMER, supra* note 9, § 8.01[C], at 8-20.

99. *2 GOLDSTEIN, supra* note 14, at § 8.2.

subtest focuses on whether the second work is substantially similar to the first.<sup>100</sup> While these tests may arguably achieve the proper balance in a typical infringement action, they fail to account for the special concerns involved when an artist returns to a theme.

The objective observer or audience test requires the finder of fact to determine "whether an average lay observer would 'recognize the alleged copy as having been appropriated from the copyrighted work.'"<sup>101</sup> Many courts apply the test to visual works by removing the unprotectible "ideas" from their analysis and instead comparing the remaining protectible expression with that of the second work.<sup>102</sup> The Third Circuit seems to have favored this approach in *Franklin Mint*.<sup>103</sup> Often, courts will apply a variation of the audience test proposed by Learned Hand.<sup>104</sup> According to this approach, the court determines whether "the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same."<sup>105</sup> Although the audience test and its variations may be helpful in the standard infringement case, application of the test in this context becomes problematic. By ignoring disparities between works, the court focuses solely on the parts of the expression that contain the artist's innate personality traits. These elements will naturally tend to look alike since the same artist created both works. In the process, the analysis downplays whatever new ideas and perspectives the artist introduced into the work. Thus, the audience test increases the likelihood that the trier of fact will find that the second work is an infringement, posing a significant threat to an artist who wishes to reuse a basic idea.<sup>106</sup>

100. See 3 NIMMER, *supra* note 9, § 13.03[A], at 13-27.

101. *Kisch v. Ammirati & Puris Inc.*, 657 F. Supp. 380, 383 (S.D.N.Y. 1987) (quoting *American Greetings Corp. v. Easter Unlimited, Inc.*, 579 F. Supp. 607, 614 (S.D.N.Y. 1983)).

102. 2 GOLDSTEIN, *supra* note 14, § 8.2, at 64; see, e.g., *Gentieu v. John Muller & Co.*, 712 F. Supp. 740 (W.D. Mo. 1989).

103. 575 F.2d 62 (3d Cir. 1978).

104. 2 GOLDSTEIN, *supra* note 14, § 8.2, at 64.

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

106. The Ninth Circuit's bifurcated test for infringement articulated in *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977), puts a different spin on the *Arnstein* doctrine. The issue is resolved by focusing on the "extrinsic" or general similarity of the ideas of the works where "analytic dissection and expert testimony are appropriate." 562 F.2d at 1165. The second step or the "intrinsic test" depends "on the response of the ordinary reasonable person." *Id.* See also *Shaw v. Linheim*, 919 F.2d 1353 (9th Cir. 1990) (characterizing *Sid & Marty Krofft* as a subjective and objective test).

While the *Sid & Marty Krofft* test has not been followed outside the Ninth Circuit, the test is particularly inappropriate in this situation since its effect has been to "greatly . . . contract the role of the court, at least in its powers to rule for the defendant as a matter of law."

Some courts in typical infringement actions have couched their decisions in terms of the "total concept and feel" of the works.<sup>107</sup> However, this approach has been soundly criticized:

[T]he touchstone of "total concept and feel" threatens to subvert the very essence of copyright, namely the protection of original expression. "Concepts" are statutorily ineligible for copyright protection; for courts to advert to a work's concept as the essence of its protectible character seems ill-advised in the extreme. Further, the addition of "feel" to the judicial inquiry, being a wholly amorphous referent, merely invites an abdication of analysis.<sup>108</sup>

This approach is especially dangerous in a case involving common authorship.<sup>109</sup> In order to incorporate subjects which have been portrayed in the past, the artist must inevitably use some of the same ideas and concepts. In addition, an artist's expression is likely to retain the same "feel" regardless of the subject or emotion which is being portrayed. If the "total concept and feel" approach is consistently applied, the ability of artists to experiment will be severely restrained.

## 2. Proposed Test for Unlawful Appropriation

In order to protect an artist's freedom to return to a theme, this Article proposes a separate test to determine whether a visual artist has infringed upon the copyright in a work he no longer owns. The purpose is to encourage, or at least permit, artists to return to a basic subject in order to fashion new works while preventing the artist from merely appropriating the value of the previous work. As a result, the test focuses on what the artist has added to enhance the work so that it will not be characterized as an infringement simply because the same personality traits manifest themselves in both works.

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3 NIMMER, *supra* note 9, § 13.03[E], at 13-100. If an artist fears that the *Sid & Marty Krofft* test might be applied, the artist will be more likely to err on the side of caution by declining to experiment with old subject matter rather than face the uncertainty of a jury with the diminished hope of dismissing the case at the outset on summary judgment.

107. 2 GOLDSTEIN, *supra* note 14, § 8.2, at 64. See, e.g., *Malden Mills, Inc. v. Regency Mills, Inc.*, 626 F.2d 1112, 1113 (2d Cir. 1980) ("The two designs are of such likeness with regard to subject matter, style of representation, shading, composition, relative size and placement of components, and mood as to obviously [be] substantially similar.").

108. 3 NIMMER, *supra* note 9, § 13.03[A], at 13-40.

109. None of the cases in which an artist is accused of infringing the copyright of a work that he created explicitly uses the "total concept and feel" test.

To decide whether a visual artist who no longer owns the copyright in a work has unlawfully appropriated the original expression, the trier of fact should determine whether an objective observer would view the second work as containing enough dissimilarities to create a different aesthetic effect. In other words, the inquiry focuses on whether the artist introduced enough differences in the expression to allow a lay observer to view the second work as a separate artistic effort.

The analysis should be qualitative in nature rather than simply counting the number of differences the artist introduced. It may be possible that a single change at the core of the expression would be sufficient to allow a trier of fact to view the second work as a separate artistic effort.<sup>110</sup> For example, if the photographs in *Kisch v. Ammirati & Puris, Inc.*<sup>111</sup> had both been created by the same artist, instead of separate artists, under the proposed test a jury could easily find that the second work constituted a new artistic effort, as a matter of fact.<sup>112</sup> In that case, the first photograph was a black and white picture of an unidentified woman holding a concertina in front of a mural. The second photograph depicted, in color, a famous male musician in front of the same mural holding a saxophone with a bottle of lime juice in the foreground.<sup>113</sup> Switching models and instruments, in this instance, seems to alter the perspective in a way which arguably changes the aesthetic effect. Applying the standard outlined above, if the same artist created both works, enough differences were introduced to view the second picture as a separate work.<sup>114</sup>

Since infringement standards in copyright law generally focus on the similarities between works, a standard emphasizing dissimilarities between

110. *But see* *Esquire, Inc. v. Varga Enters., Inc.*, 81 F. Supp. 306, 309 (N.D. Ill. 1948) (indicating that "quite possibly no single item of distinction would, in itself, render a particular painting free of infringement . . .").

111. 657 F. Supp. 380 (S.D.N.Y. 1987).

112. In *Kisch*, the court denied the defendant's motion for summary judgment ruling that "a rational trier of fact could find sufficient similarities to prove 'copying.'" *Id.* at 384 (citations omitted).

113. *Id.*

114. Notice that on the facts of *Alt v. Morello*, 227 U.S.P.Q. 49, 51 (S.D.N.Y. 1985), even if the same artist created both photographs, the second work would be very likely be characterized as an infringement no matter which test was applied. In that case, Morello simply "changed the brand [name] of [the] pen and pencil and slightly altered their angle from each other . . ." *Id.* at 51. Minor variations of this type are unlikely to be viewed as creating enough of a difference in the aesthetic appeal as to qualify as a separate artistic effort.

works can be viewed as an antithesis to the customary test.<sup>115</sup> However, in some circumstances "a defendant may legitimately avoid infringement by intentionally making sufficient changes in a work that would otherwise be regarded as substantially similar to plaintiff's."<sup>116</sup> Considering the special concerns in this narrow area of copyright, a test that will adequately maintain the freedom of artists to return to a theme, yet preserve the value of the original work, can be justified.

In fact, when an artist was accused of infringing upon his own work in *Esquire, Inc. v. Varga Enterprises*,<sup>117</sup> the court focused almost exclusively on the disparities between the clothing and hair of the women in Vargas' drawings while recognizing that the similarities in the exaggerated torsos and unduly long legs were due to the fact 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."<sup>118</sup> The court was sensitive to the concern that many of the similarities<sup>119</sup> were attributable to the personal characteristics of the artist and concentrated on whether "all of the distinguishing elements, considered in the aggregate, undeniably constitute a new creative work of art."<sup>120</sup>

Focusing on dissimilarities rather than similarities allows the finder of fact to observe the differences and recognize them as an attempt to refine or broaden the work's appeal by incorporating new techniques or perspectives. The differences must add to the new work so that it does not merely exploit the value of the original. If the dissimilarities were ignored in this context, the finder of fact would weigh only those segments of the expression that contain the artist's innate personality traits embodied in both works. However, if the disparities were given adequate weight, the finder of fact could concentrate on the essential question: whether or not the artist was successful in shedding new light on an old subject. Creating a

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115. See 2 NIMMER, *supra* note 9, § 13.03[B], at 13-55. ("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.") See also *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 56 (2d Cir. 1936) ("[N]o plagiarist can excuse the wrong by showing how much of his work he did not pirate.").

116. 2 NIMMER, *supra* note 9, § 13.03[B], at 13-58; cf. *Gross v. Van Dyk Gravure Co.*, 230 F. 412, 413 (2d Cir. 1916) ("Rochlitz was entirely successful in what he started out to do, and that he did make two clearly distinguishable and independent poses of the model, each one a separate piece of artistic copyright, each capable of statutory copyright.").

117. 81 F. Supp. 306 (N.D. Ill. 1948).

118. *Id.* at 307-08.

119. *Id.* at 309.

120. *Id.* at 307-09.

separate test for infringement will safeguard the freedom to experiment without the fear of liability stifling advancement in the arts.

### C. Application of the Proposed Test

The medium, style, and type of subject an artist portrays can create particularly perplexing problems in determining infringement. This section will illustrate how the proposed test can be applied when the artist depicts an object found in nature or uses photography to shape the visual image. In general, the more accurate the portrayal, the less protection the work is likely to enjoy.<sup>121</sup> Therefore, when common authorship is involved, an artist may also be more likely to infringe upon the prior work since the subject and medium allow less opportunity for variation of expression.<sup>122</sup> As a result, a standard of infringement which focuses on the dissimilarities between two works may be especially useful in this situation.

#### 1. Subjects Found in Nature

A work depicting a subject found in nature will often receive less protection from infringement.<sup>123</sup> For instance, the *Franklin Mint* court found that the copyright in a painting of a cardinal was "weak" due to the nature of the subject matter.<sup>124</sup> The latitude for novelty in creating a work may be limited by the need to accurately portray the subject.<sup>125</sup>

121. *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738 (9th Cir. 1971); *Gentieu v. John Muller & Co.*, 712 F. Supp. 740 (W.D. Mo. 1989); *Streeter v. Rolfe*, 491 F. Supp. 416 (W.D. La. 1980).

122. *See, e.g.*, *Gross v. Seligman*, 212 F. 930 (2d Cir. 1914).

123. *See Streeter*, 491 F. Supp. 416 (W.D. La. 1980). In *Streeter*, the court faced the question of infringement in the context of two turkey decoys. Both decoys attempted to represent the likeness of a creature found in nature. The court noted that the margin for difference in the representation of the head, neck, and body of a turkey was small. *Id.* at 421. As a result, the court purported to limit protection of the plaintiff's decoy to an exact copy of its likeness. *See also Herbert Rosenthal Jewelry Corp. v. Kapakian*, 446 F.2d 738 (9th Cir. 1971) (finding no substantial similarity in a jeweled bee pin).

124. *Franklin Mint Corp. v. National Wildlife Art Exch.*, 575 F.2d 62 (3d Cir. 1978).

125. *Id.* at 65-66. *See also Streeter*, 491 F. Supp. 416 (W.D. La. 1980). One commentator has suggested that others are free to copy an original subject found in nature, such as the Eiffel Tower or the Brooklyn Bridge, even if it resembles the first work, but others are not free to copy the original if it was conceived of and posed by the first photographer. Robert A. Gorman, *Copyright Protection For The Collection And Representation Of Facts*, 76 HARV. L. REV. 1569, 1598 (1963). *See also Joan Infarinto, Copyright Protection for Short-Lived Works Of Art*, 51 FORDHAM L. REV. 90, 124 (1982). The theory springs from a notion that subjects found in nature

This problem can be particularly acute when the subject is not manipulated or positioned by the artist.<sup>126</sup> Even though a work depicting a subject in nature usually receives less protection, the original artist is more likely to infringe upon the past work because of the limited number of ways a subject can be portrayed while still remaining identifiable. This problem is illustrated by portrayals of the unclothed human form.

When a fully or even partially clothed human model is depicted in a visual work, the artist is able to vary the position and style of the fabric to foster a new image.<sup>127</sup> However, a nude model provides less opportu-

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which have not been arranged by the artist are equivalent to unprotectible "facts," while posing a model such as the young women in *Gross v. Seligman* qualifies as "a creative product of the artist's mind." However, this distinction cannot withstand careful scrutiny. While the photographer does not pose or manipulate the Eiffel Tower itself, the artist does arrange the structure in the fashion which he desires. By doing so, he has arranged the photograph of the tower much like the artist in *Gross* arranged the photograph of the young woman. The photographer has constructed the angles, timing, lighting and background to position the subject as raw material in order to create a product of his own mind.

126. Professor Goldstein suggested the problem of a photographer who takes a picture of the moonrise over Hernandez, New Mexico and a later photographer returns to take another from the same spot. 2 GOLDSTEIN, *supra* note 14, § 2.11.1, at 154. The second photographer studies the precise date, time, and camera angle used in the first work. However, Goldstein discusses the problem in terms of the amount of originality required in order to receive copyright protection. Goldstein's position is that "Courts will withhold copyright from the second photographer to the extent that it duplicates the original since the public has gained nothing from the second effort that it has not already enjoyed from the first." *Id.* at 155.

Contrary to comments published in a discussion in David O. Carson, *Copyright Protection for Factual Compilations After Feist: A Practitioner's View*, 17 U. DAYTON L. REV. 1007, 1009 (1992), Goldstein does not discuss the "Moonrise over Hernandez" problem in terms of infringement. For example, one person states:

[W]hat I still think he says is if you authors go shoot that picture, you cannot get a copyright; it is not original what you did, but that is not an infringement of Ansel Adams' picture because you did not make a copy. What you really did was copy his idea which is not protected.

*Id.* at 1013. While the discussion contains an interesting view of infringement, the proposition is contrary to the case law and certainly not what Professor Goldstein stated. In fact, his view seems to be exactly opposite considering another comment in his treatise discussing compilations. "If a copyrighted painting or photograph were involved, and the defendant set out to paint the same scene or to photograph the same model from the same vantage or in the same pose employed by the plaintiff, a court might find that defendant's work infringed plaintiff's copyright." 2 GOLDSTEIN, *supra* note 14, at § 8.4.1, at 103.

127. See *Chuck Blore & Don Richman, Inc. v. 20/20 Advertising, Inc.*, 674 F. Supp. 671, 674 (D. Minn. 1987) (model depicted in rapid edit television advertisement composed of several frames each with different clothes and jewelry). See also *Esquire, Inc. v. Varga Enters.*, 81 F. Supp. 306 (N.D. Ill. 1948). "Although it is certainly not decisive, it should be noted for the record that the articles of 'clothing' (this term is used euphemistically, for said articles are about as concealing as the ordinary window pane) vary from picture to picture." *Id.* at 308.



nity to devise sufficient variances between works.<sup>128</sup> In a case such as *Gross v. Seligman*,<sup>129</sup> if the photographer wishes to retain the model's original pose, there is little else to change besides the background and her expression.<sup>130</sup> However, in *Gross*, the changes in the contours of the model's body and the addition of the cherry stem between her teeth were unsuccessful in shifting the exterior appearance of the model to a degree sufficient to avoid infringement.<sup>131</sup> While an artist can change the angles and lighting to arrange the pictures, there are fewer external factors an artist can manipulate.

Analyzing the works in terms of whether an objective observer would view the dissimilarities as creating a separate aesthetic appeal grants the court the flexibility to measure the differences in light of the options available to the artist. The finder of fact may consider whether the subject matter of a work is of the type which limits the ability of the artist to create a different effect. If so, subtler disparities might be sufficient to distinguish the work. On the other hand, if the subject is fanciful in nature, an objective observer would seem likely to demand a higher degree of demarcation in perspective or technique to view the second as a separate artistic effort.<sup>132</sup> After all, the artist is not restrained by conventional limitations in depicting fanciful subjects. As a result, the more unique the subject matter, the stronger the changes would have to be to create a non-infringing work.

128. It must be noted that a change in the positioning of the clothing must be in a sufficient form to alter the work's aesthetic appeal. See *Dallas Cowboys Cheerleaders v. Scoreboard Posters, Inc.*, 600 F.2d 1184 (5th Cir. 1979) (the unbuttoning of the women's halter tops in the second poster did not avoid infringement where the women stood in an identical pose with identical uniforms); *Esquire, Inc. v. Varga Enters.*, 81 F. Supp. 306 (N.D. Ill. 1948) (differences in clothing were "not decisive").

129. 212 F. 930 (2d Cir. 1914).

130. Changing the actual pose of the model could be sufficient. See *Gross v. Van Dyk Gravure Co.*, 230 F. 412 (2d Cir. 1916). The fact that the model's head tilted toward her knees was the only difference between "Grace of Youth" and "At Ease." However, the court found the difference sufficient so that both works were copyrightable. *Id.* at 413.

131. *Gross*, 212 F. at 931. See also *Gentieu v. John Muller & Co.*, 712 F. Supp. 740 (W.D. Mo. 1989) (limiting protection in the picture of "floating naked babies" to an identical copy).

132. *C.f. Franklin Mint Corp. v. National Wildlife Art Exch.*, 575 F.2d 62, 65-66 (3d Cir. 1978).

## 2. Artist's Choice of Medium and Style

The medium in which an artist chooses to work may also have implications for the degree of protection a copyrighted work will receive.<sup>133</sup> In general, works created with paint and canvas will probably receive more protection than those created with lens and film.

A photograph is inevitably a more precise record of its subject than is a painting; thus it is far more difficult for a photographer to avoid "copying" an earlier work of his when shooting the identical subject in a similar setting than it is for a painter to do so when painting the identical subject in a similar setting.<sup>134</sup>

Even applying the test this article proposes, it is possible for a painter to portray the identical scene from the same angle without infringing a past work which may not be possible through film.<sup>135</sup>

Even among painters, the style an artist uses to portray a work may also affect the ability to return to a theme. A lay observer will be able to distinguish between reality and the subjective effect of an artist's work more readily if the artist paints in an impressionistic style rather than with photographic clarity.<sup>136</sup> Other modern styles may even achieve greater subjectivity.<sup>137</sup> For instance, a Parisian artist spoke of one post-impressionist:

Gauguin freed us from all the restraints which the idea of copying nature had placed upon us. For instance, if it was permissible to use vermilion in painting a tree which seemed reddish . . . why not stress even to the point of deformation the curve of a beautiful shoulder or conventionalize the symmetry of a bough . . . ?<sup>138</sup>

133. *Id.* at 65.

134. ALAN LATMAN ET. AL, COPYRIGHT FOR THE NINETIES 431 (1989).

135. *Id.*

136. *Franklin Mint Corp. v. National Wildlife Art Exch.*, 575 F.2d 62, 65 (3d Cir. 1978). One commentator defines style as "the particular way in which the forms that make up any given work of art are chosen and fitted together." Michelle Brownlee, *Safeguarding Style: What Protection Is Afforded To Visual Artists By The Copyright And Trademark Laws?*, 93 COLUM. L. REV. 1157 (1993).

137. For instance, Paul Cézanne said of Monet, "He is only an eye, but what an eye!" MYERS, *supra* note 75, at 94. Renoir also told an influential art dealer in 1883, "I had wrung Impressionism dry, and I finally came to the conclusion that I knew neither how to paint nor how to draw. In a word, Impressionism was a blind alley, as far as I was concerned . . ." DE LA CROIX, *supra* note 78, at 864.

138. DE LA CROIX, *supra* note 78, at 869.

As a style of painting becomes more fanciful in its portrayal of a subject, the artist must introduce larger differences between the depictions to avoid infringement since the artist has a greater variety of options to choose from in producing the second work.

Although some artists may be prohibited from experimenting with a subject more than others because of the style they employ, this result seems almost inevitable. Fostering experimentation to advance an art form challenges artists to break the bounds of convention. That endeavor naturally encourages artists to invest more subjective personality traits into their work. The proposed test may alleviate some of this prejudice, but to a certain extent the disparity is the inevitable cost which the artist must pay for choosing a style which allows for less creativity.

### III. MUSICAL WORKS

While visual artists often deliberately use past subjects as a source for new works, composers of musical compositions may unintentionally write a piece which sounds similar to a work they composed in the past.<sup>139</sup> The composer may be accused of infringing upon the past efforts if the composer no longer owns rights in the work.<sup>140</sup> This section investigates the concerns involved in permitting musical composers to write in their own style, and advocates a test which focuses on the dissimilarities between works as the standard for determining infringement.

#### A. *Infringement of a Prior Composition*

Musical works created by the same composer are more likely to sound alike than those created by someone else since song writers often employ the same conventions and blend of styles throughout their works.<sup>141</sup> As one musician proclaimed, "How can you not sound like

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139. See *Fantasy, Inc. v. Fogerty*, 984 F.2d 1524, 1532 (9th Cir. 1993), *cert. granted*, 113 S. Ct. 2992 (1993). See also *ABKCO Music, Inc. v. Harrisongs Music, Ltd.*, 722 F.2d 988 (2d Cir. 1983); *Fred Fisher, Inc. v. Dillingham*, 298 F. 145 (S.D.N.Y. 1924).

140. *Fantasy, Inc. v. Fogerty*, 664 F. Supp. 1345 (N.D. Cal. 1987), *aff'd* 984 F.2d 1524 (9th Cir. 1993), *cert. granted*, 113 S. Ct. 2992 (1993).

141. See *Schiller & Schmidt, Inc. v. Nordisco Corp.*, 969 F.2d 410, 414 (7th Cir. 1992); *Warner Bros. Pictures v. CBS*, 216 F.2d 945, 950, *cert. denied*, 348 U.S. 971 (1954); *Jeweler's Circular Pub. Co. v. Keystone Pub. Co.*, 274 F. 932, 934 (S.D.N.Y. 1921); Stearns, *supra* note 67, at 543-44.

yourself?"<sup>142</sup> A musical composition which sounds similar to a prior work is more likely to be the result of a musician's tendency to invoke the same types of rhythms, harmonies, tempos, and tone colors than any conscious attempt to appropriate the value of a past work.<sup>143</sup>

A jury recently acquitted John Fogerty, a contemporary composer and recording artist, of infringing "Run Through the Jungle," a song he had written in 1970 as a member of the band Creedence Clearwater Revival.<sup>144</sup> Fantasy, the record company that owned rights in the work, claimed that Fogerty's new song "Old Man Down the Road" was merely "Run Through the Jungle" with new words.<sup>145</sup> Fogerty argued to the jury

142. Harriet Chiang, *Fogerty Cleared Of Stealing Own Song*, S.F. CHRON., Nov. 8, 1988, at A1. Fogerty claimed, "The ramifications would have been horrendous. I could see John Lennon, Shakespeare, Bob Dylan, and even Springsteen saying, 'Wait a minute, John. Don't blow this.' How can you not sound like yourself?" *Id.*

Fogerty testified at trial about his composing style. "I fiddle with the guitar until I come up with something that seems keepable." Harriet Chiang, *John Fogerty Sings His Head Off On Witness Stand*, S.F. CHRON., Nov. 1, 1988, at A2. Fogerty described his style to the jury, "I call it swamp music . . . [b]ut it is by no means recognized by the Julliard School of Music—most rock fans know what I mean." Joel Selvin, *Fantasy Records Suits John Fogerty's Run Through The Legal Jungle*, S.F. CHRON., Oct. 30, 1988, Sun. Datebook, at 49.

While Fogerty is from Berkeley, California, his music has a distinctive "southern, delta roots sound." Discussing the imagery of "Proud Mary," his most successful song, he commented,

I could have put it on the Sacramento River, but I loved the sound of all those Southern places . . . New Orleans, Memphis, . . . [s]o, "Proud Mary" had to be on the Mississippi River.

I started doing that with other songs. I'd put my own experiences in that special setting. In "Born on the Bayou," for instance, I just described my own childhood. I had a dog, I went to picnics on the Fourth of July. I didn't run through the backwoods bare, but I did with swimming trunks. I just threw in a little voodoo images to create this special little world and it stuck.

Robert Hilburn, *Fogerty's Nightmare Is Over*, L.A. TIMES, Jan. 6, 1985, at F54.

143. "The principal tools for originality in musical composition are rhythm, melody and harmony. Each affects a different sensibility in the listener." 2 GOLDSTEIN, *supra* note 14, § 8.3, at 83.

144. Harriet Chiang, *Fogerty Cleared of Stealing Own Song*, S.F. CHRON., Nov. 8, 1988, at A1. The jury took less than three hours to reach unanimous verdict. After the verdict was announced Fogerty shook hands and signed autographs for members of the jury. The plaintiff's attorney claimed "We were upstaged by a superstar." One must consider the extent to which Fogerty's celebrity status aided his prevailing at trial. However, the jury foreman remarked, "'There may have been similarities, but there were not substantial similarities.'" *Id.*

Fogerty responded by filing suit for more than \$400,000 in attorney's fees claiming that the litigation was brought in bad faith. *Id.* See *Fantasy*, 984 F.2d 1524.

145. *Fantasy*, 984 F.2d at 1524. Before the case went to trial, the district court denied the plaintiff's motion for summary judgment maintaining that "reasonable minds could differ as to the absence or existence of substantial similarity between Jungle and Old Man." *Fantasy*, 664 F. Supp. 1345, 1350 (N.D. Cal. 1987).

that the similarities between the two songs were part of his composing style.<sup>146</sup> "At stake is whether a person can continue to use his own style, or is he to be prevented from ever sounding like himself again."<sup>147</sup>

Particularly in popular genres, musicians strive to achieve their own distinct sound.<sup>148</sup> The drive to realize a unique and identifiable style of songwriting can lead to increased vulnerability to self-infringement claims as well as the expected financial and artistic rewards. The problem is particularly acute in the context of musical works.<sup>149</sup> "Aesthetic convention and the limits of the human ear impose substantial constraints on invention and variety in musical composition. . . . In popular music, . . . convention imposes particularly stringent limits on invention. Popular music will usually follow in the well-worn grooves of its particular genre."<sup>150</sup>

The small margin for error in applying infringement tests to musical works intensifies when a composer is accused of infringing the copyright in a piece he invented.<sup>151</sup> Composers naturally tend to employ similar harmonies, keys, time signatures, and scalar modes in creating individual works.<sup>152</sup>

146. John Volland, *Morning Report: Pop & Rock*, L.A. TIMES, Nov. 2, 1988, at F2. The district court would not allow Fogerty to make a First Amendment defense that Fogerty's songwriting style was constitutionally protected finding that "[t]he 'idea/expression' dichotomy serves to accommodate any 1st [sic] Amendment concerns expressed by defendants." 664 F. Supp. 1345, 1351 (N.D. Cal. 1987).

147. Larry Olmstead, *Can You Plagiarize Yourself?*, DET. FREE PRESS, Nov. 5, 1988, at 12C.

148. See *id.*

149. "Musical compositions pose distinctively difficult problems for copyright infringement determinations. The core of the difficulty is that the vocabulary available for musical composition is far less rich and enables far less invention than the vocabulary of literature, drama and the visual arts." 2 GOLDSTEIN, *supra* note 14, § 8.3, at 82.

150. 2 GOLDSTEIN, *supra* note 14, § 8.3, at 85. See also *Darrell v. Joe Morris Music Co.*, 113 F.2d 80 (2d Cir. 1940) ("[W]hile there are an enormous number of possible permutations of the musical note of the scale, only a few are pleasing . . . . Recurrence is not therefore an inevitable badge of plagiarism.").

151. See 2 GOLDSTEIN, *supra* note 14, § 8.3.1, at 87.

152. Consistency among those elements contributes to the recognizability of a musician's style. For example, discussing his new "Eye of the Zombie" album, Fogerty commented, "[I]t had to be different from my other albums, especially 'Centerfield.' That doesn't mean you won't find bits and pieces that sound like Creedence. That music is indigenous to me. There's no way I can escape that sound." Robert Hilburn, *The Fogerty Revival, Part II*, L.A. TIMES, Sept. 14, 1986, at F64.

## B. Proposed Test for Determining Infringement

### 1. Standard Infringement Tests

In order to show infringement, the plaintiff must prove that the defendant copied the plaintiff's work and that the copying "went so far as to constitute improper appropriation."<sup>153</sup> Copying may be demonstrated through direct evidence or by showing access and substantial similarity between the works.<sup>154</sup> Expert testimony is admissible in order to ascertain whether the similarities between the works are probative of copying.<sup>155</sup> In order to decide whether there was improper appropriation, courts generally determine protectible subject matter by dissecting the melody, rhythm and accompaniment of the works.<sup>156</sup> After separating the unprotectable elements, the finder of fact must apply the "audience test"<sup>157</sup> to determine "whether defendants took from plaintiff's work 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."<sup>158</sup>

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153. *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946).

154. In cases involving infringement of musical works, most courts require the plaintiff to prove that the defendant had some form of access to the defendant's work in order to prove copying. *GOLDSTEIN*, *supra* note 14, § 8.3.1, at 87. See, e.g., *Selle v. Gibb*, 741 F.2d 896 (7th Cir. 1984). Absent proof of access, "the similarities must be so striking as to preclude the possibility that the defendant independently arrived at the same result." *Id.* at 903. The Ninth Circuit applies the "Inverse Ratio Rule" where "a very high degree of similarity is required in order to dispense with proof of access, it must logically follow that where proof of access is offered, the required degree of similarity may be somewhat less than would be necessary in the absence of such proof." *Shaw v. Lindheim*, 919 F.2d 1353, 1361 (9th Cir. 1990) (quoting 2 *NIMMER*, *supra* note 9, § 143.4, at 634).

155. See, e.g., *ABKCO Music, Inc. v. Harrisongs Music, Ltd.*, 722 F.2d 988 (2d Cir. 1983).

156. 2 *GOLDSTEIN*, *supra* note 14, § 8.3.2, at 93-95. Courts often focus on whether the musical phrase is original or whether it is "so elemental that the court will deny protection on the ground that, to give plaintiff a monopoly over so simple a phrase would improperly curb musical composition generally." *Id.* at 93.

157. See *supra* note 101 and accompanying text.

158. *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946). The Ninth Circuit test for improper appropriation of a musical composition also involves dissection and the reaction of the lay audience.

It appears that the Ninth Circuit's "subjective test" is essentially what other circuits refer to as the "audience test." The Ninth Circuit divides improper appropriation into a test for objective, extrinsic similarity, in which expert testimony is appropriate, and a subjective, intrinsic evaluation, equivalent to what other circuits refer to as the audience test. *Chiate v. Morris*, 972 F.2d 1337, n.4, 1992 WL 197591, at \*\*7 (9th Cir. 1992) (unpublished disposition). The Ninth Circuit's version of improper appropriation now seems to be roughly equivalent to other circuits,

Application of the standard approach becomes problematic when common authorship is involved. Expert testimony relying on computer analysis is ill-suited to meet the special concerns involved with musicians, who naturally tend to compose in their own personal style. The type of analysis which merely plots the intervals of the notes on a computer drawn chart concentrates on patterns within the works that may simply relate to the composer's writing style.<sup>159</sup> Even if a jury vindicates the defendant by applying the audience test, the songwriter must face years of litigation and substantial legal fees in an action he may not wish to settle.<sup>160</sup> Copyright law should formulate an infringement test which allows songwriters to work in their own style, without fear of judicial intervention.

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since either way, the finder of fact is privy to expert testimony pertaining to the similarities between the works but ultimately decides the matter by listening to the actual song and trusting their ears.

*Chiate* applied the Ninth Circuit's revised test in *Shaw v. Lindheim*, 919 F.2d 1353 (9th Cir. 1990) (involving infringement of a television script), without specifying the exact standard of the subjective test in the context of musical works. *Baxter v. MCA, Inc.*, 812 F.2d 421 (9th Cir. 1987), contained a clearer statement of how the intrinsic and extrinsic tests of *Sid & Marty Krofft* applied to musical works before *Shaw* revised the circuit's standard of infringement. *Baxter* declares that the intrinsic test, now the subjective test, is determined by "the response of the ordinary reasonable person to the works. 'Analytic dissection' and expert testimony are not called for . . ." 812 F.2d 421, 424 (1987).

159. In John Fogerty's case, he testified at his own trial for two days on the witness stand with his guitar. Fogerty explained how the works were distinct compositions.

"Run Through the Jungle" is syncopated. . . . It's not happening on the beat. . . .

In "Old Man Down the Road," each note falls on the beat. . . . The idea in blues is that you can take those unique notes and use them in different ways.

I don't think Beethoven used these blues notes in a bluesy way. . . . That's the difference between Bo Diddley and Beethoven.

Harriet Chiang, *S.F. Trial John Fogerty Notes Fine Distinctions*, S.F. CHRON., Nov. 2, 1988, at A7. Fogerty also called a musicologist to testify on his behalf. However, attorneys for Fantasy used computer generated comparisons of the melody, bass line and harmony for each of the songs. Leslie Guevarra, *Expert Says Rocker's Songs Do Differ*, S.F. CHRON., Oct. 29, 1988, at A2. In the end, however, both sides empowered the jury to "trust your own ears." *Play It By Ear, Attorneys Tell Fogerty Jurors*, S.F. CHRON., Nov. 5, 1988, at A3.

160. Even though Fogerty ultimately prevailed at trial, he suffered through three years of litigation, spent \$400,000 in attorney's fees defending the case and even broke his hand punching a chair in frustration. Larry Olmstead, *DET. FREE PRESS*, Nov. 5, 1988, at 12C; Harriet Chiang, *Fogerty Cleared Of Stealing Own Song*, S.F. CHRON., Nov. 8, 1988, at A1.

## 2. Proposed Infringement Test

Similarities between songs composed by the same musician are no more indicative of copying than similarities between visual works created by the same artist. If the song was the result of independent creation, then the second work is not an infringement.<sup>161</sup> Although the *Fantasy* Court allowed the parties to present expert testimony,<sup>162</sup> the practice may tend to confuse the jury since the testimony focuses on objective criteria such as note structure without recognizing that the songs may sound alike simply because they were created by the same person regardless of whether they were copied. However, the songwriter should still be able to testify as to the manner in which the song was composed in order to determine whether it was independently created.

If copying is established, the court should separate protectible and non-protectible subject matter as the first step in determining that the copying was improper appropriation. Concentrating on the melody and other central aspects of the piece allows the court to remove some of the elements such as preference for certain harmonies, instrument selections or tone colors that may make the work sound similar merely because of the inherent tendencies of the artist in developing a style.<sup>163</sup> Because characterizing protectible expression is essentially a legal inquiry, the court need not allow expert testimony on the issue.<sup>164</sup>

The second step of the proposed standard for improper appropriation is a variation of the audience test equivalent to that suggested for visual works. The determination should focus on whether an objective observer hearing both compositions would determine that the second work contains enough dissimilarities to create a different aesthetic effect. The composition must contain enough qualitative differences to allow a lay audience to perceive the second song as a distinct artistic effort in order to avoid infringement. By focusing on the disparities between the songs, the finder of fact will be less likely to consider the inherent personality traits of the composer embodied in both works while determining infringement.<sup>165</sup>

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161. 2 NIMMER, *supra* note 9, § 8.01[C], at 8-20.

162. 664 F. Supp. 1343. See Leslie Guevarra, *Expert Says Rocker's Songs Do Differ*, S.F. CHRON., Oct. 29, 1988, at A2.

163. See 2 GOLDSTEIN, *supra* note 14, § 8.3.2.1, at 93-94.

164. See, e.g., *Fred Fisher, Inc. v. Dillingham*, 298 F. 145 (S.D.N.Y. 1924) (determining whether the accompaniment was protectible as a legal matter without the aid of expert testimony).

165. See *Alt v. Morello*, 227 U.S.P.Q. 49 (S.D.N.Y. 1985); see also *supra* notes 25-28 and accompanying text.



## IV. CHARACTERS IN LITERARY WORKS

Literary characters developed over the course of several narratives bring a sense of depth and continuity to a story. Writers commonly use characters from one novel in a series of subsequent works.<sup>166</sup> Disputes arise when the author sells the copyright in a story to a publisher or film producer who then claims that the author has also abandoned all his rights in the characters which shaped the plot.<sup>167</sup> This article argues that parties who wish to divest an author of rights in characters of the author's invention should face a presumption that those rights were not transferred with the copyright, unless the document clearly indicates that the author intended to relinquish his right to create sequels.

A. *Recognition of Protection for Literary Characters*

Literary characters consist of at least two ingredients: a name and a set of physical and personality traits.<sup>168</sup> An author paints the image of the character in the mind of the reader through descriptions, action and dialogue.<sup>169</sup> Because literary characters consist of a series or combination of abstractions, courts have been reluctant to grant copyright protection in them unless the characters have been fully developed to a point where they represent more than an amorphous idea. Judge Learned Hand articulated the generally accepted guidelines for protection in *Nichols v. Universal Pictures Corp.*:<sup>170</sup>

If *Twelfth Night* were copyrighted, it is quite possible that a second comer might so closely imitate Sir Toby Belch or

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166. See *Goodis v. United Artists Television, Inc.*, 425 F.2d 397, 406 (2d Cir. 1970) (Waterman, J., concurring in part).

167. *Trust Company Bank v. MGM/UA Entertainment Co.*, 593 F. Supp. 580 (N.D. Ga. 1984), *aff'd*, 772 F.2d 740 (4th Cir. 1984); *Warner Bros. Pictures v. CBS*, 216 F.2d 945 (9th Cir.), *cert. denied*, 348 U.S. 971 (1954); *Gillete v. Stoll Film Co.*, 200 N.Y.S. 787 (1922). See also *Burroughs v. Metro-Goldwyn-Mayer, Inc.*, 683 F.2d 610 (2d Cir. 1982).

168. E. Fulton Brylawski, *Protection Of Characters—Sam Spade Revisited*, 22 COPY. BULL. 77 (1975).

169. Leslie A. Kurtz, *The Independent Legal Lives Of Fictional Characters*, 1986 WIS. L. REV. 429, 451. Literary characters receive less protection than pictorial or cartoon characters because they are less concrete. Unlike pictorial characters, literary characters provide nothing with which to make a side-by-side physical comparison. *Id.* See, e.g., *Detective Comics, Inc. v. Bruns Publications, Inc.*, 111 F.2d 432 (2d Cir. 1940) (granting copyright protection to "Superman").

170. 45 F.2d 119 (2d Cir. 1930).

Malvolio as to infringe, but it would not be enough that for one of his characters he cast a riotous knight who kept wassail to the discomfort of the household, or a vain and foppish steward who became amorous of his mistress. These would be no more than Shakespeare's "ideas" in the play, as little capable of monopoly as Einstein's Doctrine of Relativity, or Darwin's theory of the Origin of Species. It follows that the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly.<sup>171</sup>

Thus, the standard set forth in *Nichols* recognizes that a character can be copyrighted "quite independently of the 'plot,'"<sup>172</sup> but only if its personality has been fully defined.<sup>173</sup>

### B. Authors Who Created the Character

An author typically must sell the copyright in a short story or novel in order to exploit the incentive system and reap the benefits of his labor. Rarely, however, does the writer suspect that in selling the work he may also be parting with his right to control the development of his characters or to generate sequels.<sup>174</sup> While strong policy concerns may compel courts to protect against the unrestrained pilfering of characters by other writers, these concerns hold significantly less strength when another party seeks to divest an author of rights in characters the author invented.

Authors such as Shakespeare who succeed in creating numerous interesting and memorable characters are rare indeed. Writers who invent

171. *Id.* at 121.

172. *Id.*

173. One commentator notes:

Fully realized characters in literature are little different from fully defined personalities in daily life, and it is no surprise that the test of protectibility that courts apply to literary characters is closely akin to the criterion that individuals apply in daily life to determine whether they in truth know someone.

1 GOLDSTEIN, *supra* note 14, § 2.7.2, at 128.

Literary characters have been recognized as capable of copyright protection in a number of cases. See *Silverman v. CBS, Inc.*, 870 F.2d 40 (2d Cir. 1989); *Burroughs v. Metro-Goldwyn-Mayer, Inc.*, 683 F.2d 610 (2d Cir. 1982); *Stallone v. Anderson*, 1989 Copyright L. Dec. (CCH) 26,427 at 22,665 (C.D. Cal. 1989); *Filmvideo Releasing Corp. v. Hastings*, 509 F. Supp. 60 (S.D.N.Y. 1980), *aff'd in part, rev'd in part*, 668 F.2d 91 (2d Cir. 1981).

174. *Trust Company Bank v. MGM/UA Entertainment Co.*, 593 F. Supp. 580 (N.D. Ga. 1984), *aff'd*, 772 F.2d 740 (4th Cir. 1984); *Goodis v. United Artists Television, Inc.*, 425 F.2d 397, 406 (2d Cir. 1970) (Waterman, J., concurring).

only a handful of notable characters during their entire literary careers are far more typical.<sup>175</sup> "The characters of an author's imagination and the art of his descriptive talent, like a painter's or like a person with his penmanship, are always limited and always fall into limited patterns."<sup>176</sup> There are only so many unique characters one author can invent. As a result, copyright law should be especially cautious not to seize the only vehicle an author has to continue the story.

In addition, writers often take great personal interest in the development of their characters. For example, Margaret Mitchell Marsh, author of *Gone with the Wind*, refused to sell the rights in her characters to the movie industry so that they could make a sequel. A letter written by her husband to MGM in 1940 stated:

You may be certain that we will take steps to prevent any sale or use of this purported sequel, for Mrs. Marsh does not intend to have her sequel rights infringed upon in any way. Of course, the rights are worth a lot of money to her, but, beyond that, she feels a personal interest in Scarlet, Rhett, and the other characters she created and she would fight to defend them from misuse and abuse by some other writer.<sup>177</sup>

The power to choose not to develop a story any further can be very important to an author. As with *Gone With The Wind*, a writer may decide that a story has reached its end and was meant to go no further.<sup>178</sup> The right to control how a character is used may be a significant part of the incentive system. If a writer does decide that a sequel is appropriate, the quality and integrity of the subsequent work is likely to be much greater

175. For instance, even writers such as F. Scott Fitzgerald and Ernest Hemingway may have had an incredible gift for the descriptive art, but were successful in creating only a few characters that are memorable in and of themselves apart from the story line.

176. Warner Bros. Pictures, Inc. v. CBS, 216 F.2d 945, 950 (9th Cir. 1954).

He must be a poor creature that does not often repeat himself. Imagine the author of the excellent piece of advice, "Know Thyself", never alluding to that sentiment again during the course of a protracted existence! Why, the truths a man carries about with him are his tools; and do you think a carpenter is bound to use the same plane but once to smooth a knotty board with, or to hang up his hammer after it has driven its first nail?

*Id.* at 950 n.5 (quoting OLIVER W. HOLMES, M.D., *THE AUTOCRAT OF THE BREAKFAST TABLE* 9 (1858)).

177. Trust Company Bank v. MGM/UA Entertainment Co., 593 F. Supp. 580, 583 (N.D. Ga. 1984).

178. Unfortunately, her wishes were short lived since her heirs proceeded to sell her sequel rights after her death. *Id.* Were she alive today, Mitchell might say that Scarlet and Rhett have since been "abused and misused by some other writer" in a new novel. See ALEXANDRA RIPLEY, *SCARLETT: THE SEQUEL TO MARGARET MITCHELL'S GONE WITH THE WIND* (1991).

than if "some other writer"<sup>179</sup> continues the narration. No one knows a character as well as the person who guided the pen which brought it to life.

In order to inspire high quality sequels, contracts which are silent as to the transfer of rights in characters should be construed against the buyer of the copyright. The Ninth Circuit took this approach in *Warner Bros. Pictures, Inc. v. CBS*.<sup>180</sup> In that case, Dashiell Hammett wrote *The Maltese Falcon*, a mystery novel centered around a detective named Sam Spade. Hammett sold Warner Brothers radio and television rights to the *The Maltese Falcon* and then used Sam Spade and other characters in new stories which he sold to CBS. Warner Brothers claimed that they had the exclusive right to use Hammett's characters in motion picture, television and radio. The court held that if a contract is silent, the court will presume that the parties did not intend to transfer the rights in the characters.<sup>181</sup>

In recognition of the unequal bargaining power between authors and publishers, the law should require the buyer of the copyrighted work to meet a higher burden of proof in order to divest an author of rights in characters he invented.<sup>182</sup> Because an unrepresented author faced with a lengthy standard form contract may be subject to significant overreaching by large production companies, the publisher should face a rebuttable presumption that the parties did not intend to transfer the rights to the characters in the transaction.<sup>183</sup> The publisher could only rebut the presumption by clear and convincing evidence of the intent of the parties within the document itself. For example, in a lengthy standard form contract that was not the subject of negotiation by the parties, the publisher would be required to spell out the exact nature of the rights the author is

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179. See *supra* note 177 and accompanying text.

180. 216 F.2d 945 (9th Cir. 1954).

181. *Id.* at 949. See also *Trust Company Bank v. MGM/UA Entertainment Co.*, 593 F. Supp. 580 (N.D. Ga. 1984).

182. Cf. Michael V.P. Marks, *Legal Rights Of Fictional Characters*, 25 COPYRIGHT L. SYMP. (ASCAP) 35, 44 (1975) (The court could have invoked the principle that a plaintiff seeking to prove it has acquired exclusive rights in literary property has a more difficult burden to meet where it is seeking to assert such rights against an author or his assigns than where the rights are asserted against a "stranger."); *Gillette v. Stoll Film Co.*, 200 N.Y.S. 787, 789 (N.Y. Sup. Ct. 1922); *O'Neill v. General Film Co.*, 157 N.Y.S. 1028, 1036 (N.Y. App. Div. 1916) (more evidence is required to establish a prima facie case of adverse possession of literary property rights against the author or his assigns).

183. Although Margaret Mitchell Marsh was well represented in her contract negotiations, many writers may not be so fortunate. Even despite clear wording that sequel rights would remain with Marsh in the contract, MGM still brought suit against her assigns to halt any deals on a sequel to *Gone With The Wind*. *Trust Company Bank v. MGM/UA Entertainment Co.*, 593 F. Supp. 580 (N.D. Ga. 1984).

giving away and that part of the contract would need to be signed separately.<sup>184</sup> The exclusive right to generate sequels can be an important bargaining chip for an author.<sup>185</sup> Since few authors know the full value of their work prior to publication, a strong presumption against depriving writers of sequel rights provides a mechanism to equalize the bargaining power of the parties.<sup>186</sup>

In *Warner Bros.*, the Ninth Circuit may have in fact gone a step further to protect an author's right to make sequels with characters he invented. The court stated that even if Dashiell Hammett assigned complete rights in *The Maltese Falcon* to Warner Brothers, including exclusive rights in the character Sam Spade, Hammett was not precluded from using the character again because he was only a vehicle for telling the story and not the story being told.<sup>187</sup> While courts and commentators have read this statement as proposing a very restrictive test for recognizing copyright protection of characters in general, considering the context of the opinion, the court may have actually been advancing a test solely for determining whether an author who created the characters could be precluded from using them again. This reading would go far toward unraveling the court's notorious statement: "It is conceivable that the character really constitutes the story being told, but if the character is only the chessman in the game of telling the story he is not within the area of the protection afforded by the copyright."<sup>188</sup>

184. The following language, in large print, would suffice if the author had also signed the document near the clause:

The author acknowledges that this agreement transfers all rights the author possesses in the characters within this work. The author recognizes that he or she gives up all rights to create sequels or use the characters in any other way without the express consent of the buyer.

"The clearest language is necessary to divest the author of the fruits of his labor." *Warner Bros. Pictures, Inc. v. CBS*, 216 F.2d 945, 949 (9th Cir. 1954).

185. *Trust Company Bank*, 593 F. Supp. at 584.

186. This mechanism is similar to the renewal period under the old act where after 28 years from publication the original creator had the right to renew the copyright irrespective of who owned the copyright at the time. See 17 U.S.C. § 28 (1909); see also *Fred Fisher Music Co. v. M. Witmark & Sons*, 318 U.S. 643 (1943).

Even if an author is held to have transferred all rights in his characters, if the buyer accuses the author of infringement for creating another character with some similar attributes, the test proposed for infringement of visual and musical works may be appropriate. The trier of fact could focus on the dissimilarities between the characters to determine if a persona with a distinct appeal has been created. See *supra* notes 25-28 and accompanying text.

187. *Warner Bros.*, 216 F.2d at 950. See *supra* note 46 and accompanying text.

188. *Warner Bros.*, 216 F.2d at 950.

by too many business types.”<sup>192</sup>

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192. RALPH S. BROWN & ROBERT C. DENICOLA, *CASES ON COPYRIGHT* 248 (5th ed. 1990).

Instead of formulating a rule for recognizing copyright protection in a character, the court was declaring that exclusive rights to the use of characters can only be transferred from the author if they constitute the story itself.<sup>189</sup> If a character *is* the story, it would not be possible for the author to create a sequel without infringing the work. However, if the characters are only vehicles for telling the story, as a matter of policy they cannot be transferred away.<sup>190</sup> The court ruled that the copyright statute does not allow authors to transfer all of their rights in characters because the copyright's purpose in promoting authorship may be stifled if writers were not allowed to return to characters they invented.<sup>191</sup> In any event, a court should be reluctant to divest an author's rights in characters he invented absent clear and convincing evidence of the parties' intent.

## V. CONCLUSION

Art, music, and literature flow from finite sources. The law must be cautious not to bind an artist's hands by granting copyright owners broad power to control an artist's subsequent creations. Rather, copyright law should draw a distinction between authors who created the original work and those who did not in order to insure that fear of infringement does not extinguish the spirit of creation. As a juror in the *Fantasy* trial proclaimed, "Creative people have got to have rights to create without being harassed

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189. The court stated:

We conclude that even if the Owners assigned their complete rights in the copyright to the Falcon, such assignment did not prevent the author from using the characters use therein, in other stories. The characters were vehicles for the story told, and the vehicles did not go with the sale of the story.

*Id.* See Kurtz, *supra* note 169, at 453.

190. See *supra* notes 149-58 and accompanying text for discussion of the policy implications.

191. The opinion investigates the problem solely from the standpoint of an author being precluded from using characters he created, rather than in terms of copyright protection in general. If the opinion is read in this context, the standard the court proposes makes much more sense.

The practice of writers to compose sequels to stories is old, and the copyright statute, though amended several times, has never specifically mentioned the point . . . . If Congress had intended that the sale of the right to publish a copyrighted story would foreclose the author's use of its characters in subsequent works for the life of the copyright, it would seem Congress would have made specific provision therefor. . . . The restriction argued for is unreasonable, and would effect the very opposite of the statute's purpose which is to encourage the production of the arts.

*Warner Bros.*, 216 F.2d at 950 (citation omitted).