

ARTICLE

THE HISTORICAL DEVELOPMENT AND MISPLACED JUSTIFICATION FOR THE DERIVATIVE WORK RIGHT

KINDRA DENEAU*

ABSTRACT

Contrary to popular belief, authors enjoyed a derivative work right before the 1976 Copyright Act. Just as society's conception of substantial copying infringement has advanced over the years, society's conception of the scope of the derivative work right should also advance into a more workable legal doctrine. The policy of the Copyright Act is to maximize all prospective authors' incentives to create new works and share them with the public. Pursuant to this policy, this article advocates that the exclusive derivative work right should be deleted from the Copyright Act, because the derivative work right already subsists in the rest of authors' enumerated rights. It further argues that courts should carefully consider the appropriate remedies for derivative work infringement, concluding that injunctive relief for infringement is inappropriate when a derivative author has contributed substantial new creativity relative to the portion of the preexisting work infringed.

I. INTRODUCTION

Since the enactment of the Copyright Act of 1976 ("1976"), the courts and the public have had substantial difficulty ascertaining the purposes of the derivative work right expressly contained within the 1976 Act. This article attempts to unravel the elusive purposes of the derivative work right. Part II traces the historical origins of the derivative work right and reviews how it has been applied in the courts. Part III evaluates both the legal and practical justifications for maintaining a separate derivative work right today and concludes that the exclusive derivative work right should be removed from the 1976 Act. Part IV traces the origin of infringing derivative work disqualification from copyright protection, discusses the extent to which an infringing derivative work should qualify for copyright protection, and concludes that injunctive relief for derivative work infringement is inappropriate when the derivative work author contributes substantial new

* Principal Attorney, The Deneau Law Firm PLLC, Scottsdale, Arizona; J.D. 2005, Arizona State University, Sandra Day O'Connor College of Law, Tempe, Arizona. The American Society of Composers, Authors and Publishers' National 2005 Nathan E. Burkan Memorial Competition awarded the author Arizona State University's first prize entry for this article.

creativity.

The United States Constitution declares that Congress shall have the power “to Promote the Progress of Science and useful Arts, by securing for limited Times, to Authors and Inventors, the exclusive Right to their respective Writings and Discoveries.”¹ One way that Congress exercises this power is by giving copyright protection to original works of authorship.² As such, copyright protection extends to an author’s creative expression and not to the ideas or facts contained within the expression.³ Authors who have made fixed writings or works originating from their own creative minds (as opposed to works copied or duplicated directly from another person’s works) have qualified for federal copyright protection in the United States since Congress passed the 1790 Copyright Act (“1790 Act”).

The more original, creative works disclosed to the public, the better.⁴ However, originality is not monolithic, since “[i]n truth, in literature, in science and in art, there are, and can be, few if any, things, which in an abstract sense, are strictly new and original throughout.”⁵ Furthermore, originality does not require novelty; two authors could independently create two “original,” yet identical works, and both would qualify for separate copyright protection.⁶ The Copyright Act does not guarantee authors a monopoly or any financial remuneration from their works. Rather, the policy of the Copyright Act is to maximize all prospective authors’ incentives to create new works and share them with the public.⁷

¹ U.S. CONST. art. I, § 8, cl. 8.

² 17 U.S.C. § 102(a) (2006) (giving copyright protection only to “original works of authorship”).

³ See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991) (stating that “[o]riginality is a Constitutional requirement” and that copyrightable works must possess “at least some minimal degree of creativity” or “creative spark”); 17 U.S.C. § 102(a) (2006) (giving copyright protection only to “original works of authorship”).

⁴ The first 1790 Copyright Act was titled, “for the encouragement of learning, by securing. . .” access to creative works. The assumption being that we as a society learn when individuals share their creative ideas. Today, “[p]owering the great ongoing changes of our time is the rise of human creativity as the defining feature of economic life.” RICHARD FLORIDA, *THE RISE OF THE CREATIVE CLASS* 15 (Basic Books 2005) (2002); see also Ralph S. Brown, Jr., *The Widening Gyre: Are Derivative Works Getting Out of Hand?*, 3 *CARDOZO ARTS & ENT. L.J.* 1, 23 (1984) (“The ultimate aim [of copyright law] is, by this incentive, to stimulate artistic creativity for the general public good.” (quoting *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1970))).

⁵ *Emerson v. Davies*, 8 F. Cas. 615, 619 (C.C.D. Mass. 1845).

⁶ See *Feist*, 499 U.S. at 345–46.

⁷ H. COMM. ON THE JUDICIARY, 87TH CONG., REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 6 (Comm. Print 1961) [hereinafter REPORT OF THE REGISTER 1961], reprinted in 3 GEORGE S. GROSSMAN, *OMNIBUS COPYRIGHT REVISION LEGIS. HISTORY* at 6 (2001) (“Within limits, the author’s interests coincide with

Ultimately, this article argues that the Copyright Act should be updated to reflect the fact that the derivative work right is not a separately exclusive right, but instead, a subset of the other exclusive rights to reproduce, distribute, perform, and display a work.⁸ Congress did not sufficiently contemplate this crossover effect of the exclusive rights when it enacted the 1976 Act. The derivative work right potentially gives copyright owners monopolies on ideas, and will continue to improperly do so until the statute is revised to balance the tug-of-war between the interests of the public, copyright owners, and prospective copyright owners.⁹

II. THE HISTORICAL DEVELOPMENT OF THE DERIVATIVE WORK RIGHT.

Congress revised the original 1790 Act over the years to try and adequately account for the diverse, original, and accumulative nature of creative works. The progressive enactments from the 1790 Act through the 1976 Act demonstrate that Congress increasingly recognized that derivative works (works derived or based upon a preexisting work) should sometimes be entitled to copyright protection even though they are not purely original works. However, this progression also reveals that Congress and the courts found it difficult to define and discern when an unauthorized derivative work should constitute infringement of a preexisting work and when it should alternatively qualify for separate copyright protection.

Treading on new legal grounds, Congress and the courts initially understood infringement to mean the exact replication of a copyright protected work.¹⁰ With the exception of initially finding no infringement in derivative translations and abridgements, courts have consistently found that subsequent works infringe preexisting works if they contain substantial copying from or are substantially similar to the preexisting work.¹¹ Meanwhile, Congress and the courts increasingly recognized that copyright owners are exclusively entitled to create particular derivative works from their original works.¹² For example, the 1870 Act granted authors the exclusive rights to translate and dramatize their copyright protected works, both of which are derivative work rights that involve substantial copying of the original works.¹³ Then, in the 1976 Copyright Act, Congress for the first time expressly adopted the generic exclusive derivative work right as a purportedly distinctive right from authors'

those of the public. Where they conflict, the public interest must prevail. The ultimate task of the copyright law is to strike a fair balance between the author's right to control the dissemination of his works and the public interest in fostering their widest dissemination."').

⁸ See *infra* Part III.

⁹ See *infra* Part IV.

¹⁰ See *infra* Part II.A.1.

¹¹ See *infra* Part II.A–E.

¹² See *infra* Part II.A–D.

¹³ See *infra* Part II.A–D.

exclusive rights to reproduce, distribute, perform and display their works.¹⁴ Unlike the earlier Copyright Act grants of certain specific rights to create derivative works such as dramatizations, the 1976 Act derivative work right encompassed the right to create any type of subsequent derivative work based on the copyright-protected work.¹⁵

The following subparts outline the historical development of the derivative work right to explain how Congress and the courts initially recognized certain, unauthorized derivative works as infringements of authors' reproduction right.

A. *The Statutory Origin of the Derivative Work Right.*

1. The 1790 Copyright Act and Its Amendments.

The 1790 Act granted authors of maps, charts, and books "the sole right and liberty of printing, reprinting, publishing and vending" their original work.¹⁶ In 1802, Congress supplemented the 1790 Act to grant to authors

who shall invent and design, engrave, etch or work, *or from his own works and inventions*, shall cause to be designed and engraved, etched or worked, *any historical or other print or prints, . . . the sole right and liberty* of printing, re-printing, publishing and vending such print or prints, for the term of fourteen years . . . as prescribed by law for maps, charts, book or books . . .¹⁷

The first part of the grant provision gave authors of new works copyright protection in such works. The second part granted copyright protection to authors of historical works or prints, if they caused their works to be designed and engraved, etched or worked. The second grant more specifically served to entice existing authors to disclose their older, historical works.¹⁸ It did not specify whether unauthorized derivative works should be entitled to any separate copyright protection.

In the same 1802 Supplement to the 1790 Act ("1802 Supplement"), Congress also resolved that a person commits copyright infringement if he or she

within the time limited by this act, shall engrave, etch or work, as

¹⁴ See *infra* Part II.E.

¹⁵ See *infra* Part II.E.

¹⁶ Act of May 31, 1790, ch. 15, 1 Stat. 124.

¹⁷ Act of April 29, 1802, ch. 37, 2 Stat. 171 (emphasis added).

¹⁸ See *Wheaton v. Peters*, 33 U.S. 591, 661 (1834) (deciding that copyright protections under state common law did not afford an author "the sole right and liberty of printing" published historical writings that had not been recorded with Congress for copyright protection, because "congress, in passing the act of 1790, did not legislate in reference to existing rights"). Thus, Congress passed the Copyright Act to entice authors to record both their new and older works with Congress in order to qualify for copyright protection.

2013]

THE DERIVATIVE WORK RIGHT

aforesaid, or in any other manner copy or sell, or cause to be engraved, etched, copied or sold, in the *whole or in part*, by *varying, adding to, or diminishing* from the main design, or . . . *any parts thereof*, without the consent of the proprietor¹⁹

The phrase “in the whole or in part” could be construed as giving copyright owners an implied exclusive derivative work right. However, the drafters may have intended to limit unauthorized derivative infringement to copying from the “main design” of the work so that insubstantial copying of minor features to create new works would not constitute infringement.

2. The 1831 Copyright Act and Its Amendments.

Congress repealed the 1790 Act and the 1802 Supplement with the Copyright Act of 1831 (“1831 Act”).²⁰ Like the 1790 Act, Congress granted authors of books, maps, and charts copyright protection. Unlike the 1790 Act, Congress for the first time granted copyright protection to authors of musical compositions.²¹ The 1831 Act retained the 1802 Supplement’s print infringement provision, which stated that a person infringes a copyrighted “print, cut, or engraving, map, chart or musical composition . . . by varying, adding to, or diminishing the main design.”²² Congress for the first time added that print infringement occurs when a derivative author varies the original work of another author with the “intent to evade the law.”²³

Similarly to the 1802 Supplement, the 1831 Act granted copyright protection to authors who

invent, design, etch, engrave, work, or cause to be engraved, etched or worked *from his own design*, any print or engraving . . . the *sole right* and liberty of printing, reprinting, publishing, and vending such book or books, map, chart, musical composition, print, cut, or engraving, in *whole or in part*²⁴

In contrast, the 1802 Supplement had only stated the “in whole or in part” language in the definition for infringement and not within the delegation of copyright authors’ exclusive rights. Hence, the 1831 Act resolved that original authors were the only persons that could be entitled to copyright protection for works that were derived and copied “in whole or in part” from their own

¹⁹ *Id.* at 172 (emphasis added); *see also* William F. Patry, *Statutory Revision*, COPYRIGHT LAW AND PRACTICE, <http://digital-law-online.info/patry/patry6.html> (last visited Sept. 24, 2012) (providing a more in-depth summary of statutory history).

²⁰ Act of Feb. 3, 1831, ch. 16, 4 Stat. 436.

²¹ *Id.* at 436.

²² *Id.* at 438; Act of April 29, 1802, ch. 37, 2 Stat. 172.

²³ Act of Feb. 3, 1831, ch. 16, 4 Stat. 438.

²⁴ *Id.* at 436 (emphasis added).

original works in harmonization with the infringement provision.²⁵

In 1856, Congress continued to expand the subject matter of copyright and supplemented the 1831 Act to extend to authors a new exclusive right “to the author or proprietor of any dramatic composition, designed or suited for public representation, . . . to act, perform, or represent the same, or cause it to be acted, performed, or represented, on any stage or public place.”²⁶ Congress did not expressly grant a general derivative work right to authors but began to recognize that authors should enjoy the exclusive right to adapt and convert their own dramatic composition from a written format into a performance format.²⁷

3. The 1870 Copyright Act.

In 1870, Congress repealed the 1831 Act and its Supplements to once again consolidate the Act’s progressive amendments and grant additional copyright protections to authors.²⁸ The 1870 Copyright Act (“1870 Act”) stated in pertinent part that an

author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print, or photograph or negative thereof, or of a painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts, . . . shall . . . have the sole liberty of printing, reprinting, publishing, *completing, copying, executing, finishing*, and vending the same; and *in the case of a dramatic composition, of publicly performing* or representing it, or causing it to be performed or represented by others; and authors may reserve the right to *dramatize or to translate* their own works.²⁹

Thus, for the first time, Congress expressly granted copyright protection to new subject matters, such as photographs and negatives in accordance with the 1865 Supplement to the 1831 Copyright Act, and to paintings and drawings.³⁰ Congress also replaced the 1831 Copyright Act’s exclusive right to print a work “in whole or in part” language by granting authors the new exclusive

²⁵ *Id. Cf. infra* Parts II.A.3 & B. (Congress removed the general “in whole or in part” language from the grant clause of the 1870 Act, but kept it in the infringement section of the same Act. Then, the “in whole or in part” language was removed from the infringement section of the 1976 Act).

²⁶ Act of Aug. 18, 1856, ch. 169, 11 Stat. 138, 139; *see also* Paul Goldstein, *Derivative Rights and Derivative Works in Copyright*, 30 J. COPYRIGHT SOC’Y U.S.A., 209, 213 (1982) (characterizing this supplement as the first expansion of rights to derivative works).

²⁷ *Id.* at 139.

²⁸ Act of July 8, 1870, ch. 230, 16 Stat. 198.

²⁹ *Id.* at 212 (emphasis added).

³⁰ *See* Act of March 3, 1865, ch. 126, 13 Stat. 540, 540.

2013]

THE DERIVATIVE WORK RIGHT

rights to complete, copy, execute, finish, and “to dramatize or to translate” their works, and to perform their dramatic works. As in the 1831 Act, infringement in the 1870 Act meant to “engrave, etch, work, copy, print, publish, or import, either in whole or in part, or by varying the main design with intent to evade the law.”³¹

Interestingly, the 1870 Act’s asserted rights to complete, copy, execute, finish, dramatize, translate and perform are today protected under the penumbra of the 1976 Act’s exclusive rights in parentheses as follows: to complete (derivative right and right to reproduce), to execute (rights to distribute and display), to finish (derivative right and right to reproduce) to dramatize (derivative right and right to reproduce), to translate (derivative right and right to reproduce), and to perform (right to perform).³² The increasing exclusive rights under 1870’s Act shows a trend towards recognizing that an infringer can infringe through creating a derivative work such as a translation of a book—even though the translation itself is not a verbatim copy of the original copyright protected book.

The basic standard for determining copyright infringement ultimately became a question of whether the taking from the copyrighted work was “substantial” enough to be considered an infringement.³³ Under the substantial similarity infringement test, an unauthorized translation or dramatization of a copyright protected work infringes the original author’s exclusive right to reproduce his or her work by taking the “heart” of the creative original work.³⁴ To illustrate, translating a book from one language to another does not involve literal copying of the work and requires significant labor, but it also requires substantial “copying” of the work’s written expression. Notwithstanding the differences between languages, a derivative translation of an English novel into French contains a substantial copy of the original novel in violation of the author’s right to “print” and “reprint” their work under the 1870 Act and, likewise, in violation of the author right to “reproduce” their work under the 1976 Act.

Motion pictures were not granted express copyright protection until 1912.³⁵

³¹ Copyright Act of 1870, ch. 230, 16 Stat. 198, 214.

³² Copyright Act of 1976, 17 U.S.C. § 106 (2006).

³³ *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930).

³⁴ *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 565 (1985).

³⁵ Act of Aug. 24, 1912, Pub. L. No. 62-303, ch. 356, sec. 5, § 5(l)–(m), 37 Stat. 488, 488 (1912); *see also* William F. Patry, *Amendments to the 1909 Act*, COPYRIGHT LAW AND PRACTICE, <http://digital-law-online.info/patry/patry7.html> (last visited Oct. 12, 2012) (proposing that the purpose of the amendment was to limit movie producer’s infringement liability for adapting non-dramatic works into movies, motivated by the result in *Kalem Co. v. Harper Bros.*, 222 U.S. 55 (1911)). The right to public performance in non-dramatic works was not effectively granted until 1953 pursuant to the Act of July 30, 1947, Pub. L. No. 80-281, ch. 391, § 1(d), 61 Stat. 652, 653.

Nevertheless, the translation and dramatization reservation rights within the 1870 Act gave authors the additional ability to license others to copy and distribute their work, while holding onto the exclusive right to translate or dramatize their work as they saw fit so long as they reserved that right. For instance, if an author licensed a publisher to publish (and in the process make copies of) his or her book and the author wanted to keep his or her right to later translate or dramatize his or her book, the author had to expressly reserve his or her translation and dramatization rights. It was the author's burden to expressly reserve their translation and dramatization rights under the 1870 Act.³⁶

The 1870 Act and subsequently the 1909 Act incorporated granting authors the new exclusive right to complete and finish a work. It is almost impossible to determine when a work is "complete" or "finished," though. Creative minds can and will disagree. Some writings and art pieces are never finished. Under the 1976 Act, a "derivative work" is defined "as a work based upon one or more preexisting works."³⁷ No distinction is made as to whether the preexisting work is finished or not. Thus, completing a preexisting, albeit unfinished work would be a derivative work under our current Copyright laws.

Hypothetically speaking, if a would-be infringer were to take an incomplete sculpture and finish it in these modern times, he or she would first certainly be guilty of common criminal theft. Secondly, if after finishing the sculpture, the infringer then tries to sell it in the marketplace, he or she would commit copyright infringement by violating the original author's exclusive right to "display" his or her sculpture to the public. Under the 1870 Act, the infringer would infringe by completing and finishing the work.

This sculpture hypothetical demonstrates that the 1870 Act and 1909 Act's adoption of the exclusive right to complete and finish a work are akin to moral rights authors enjoy today. The goal of the 1976 Act's moral right is to preserve the integrity of authors' visual arts.³⁸ Included under the moral rights section, is the right of a visual art author "to prevent any intentional distortion, mutilation, or other modification of that work which would be prejudicial to his or her honor or reputation."³⁹ Assuming no derivative work right exists,

³⁶ *Stewart v. Abend*, 495 U.S. at 245 (quoting Act of July 8, 1870, ch. 230, § 86, 16 Stat. 198, 212) ("The Act of 1870, which gave the author the 'sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing, and vending,' made a limited start toward further protection, providing that 'authors may reserve the right to dramatize or to translate their own works.'").

³⁷ 17 U.S.C. § 101 (2006).

³⁸ Justin Hughes, *The Line Between Work and Framework, Text and Context*, 19 *CARDOZO ARTS & ENT. L.J.* 19, 21–22 (2001); *but see* REPORT OF THE REGISTER 1961, *supra* note 7, at 4 (stating that the United States had never previously recognized that authors have moral rights in their copyright protected works prior to joining the Berne Convention).

³⁹ 17 U.S.C. § 106A(a)(3)(A) (2006).

2013]

THE DERIVATIVE WORK RIGHT

under our stolen sculpture hypothetical, the wronged author in today's age could claim that the thief not only stole his unfinished sculpture, but he modified it in a way that is "prejudicial to his or her honor or reputation" in violation of his moral rights under the 1976 Act. If the derivative work right did not separately exist under the 1976 Act and the thief never tried to sell the sculpture though, the author may have a difficult time proving he or she suffered damage to his or her reputation to qualify for this moral right. Unlike less tangible works of visual art like photographs, sculptures are not as easily copied or duplicated.⁴⁰ Thus, in the event Congress decides to remove the derivative work right from the Copyright Act, unique, tangible works like original sculptures would need added copyright protection within the moral rights section of the 1976 Copyright Act.

Copyright law is restricted to protecting authors' expression and not their ideas.⁴¹ In the interest of promoting progress, copyright protection cannot give authors the exclusive right to create any and all derivative works, irrespective of the level of copying involved and amount of originality added by an unauthorized author. The 1870 Act incorporated a substantial copying limitation by specifying that authors have the exclusive rights to create translations and dramatizations, as opposed to re-incorporating the 1831 Act's over-generalized grant giving authors the sole right to copy any "part" of the original work.

None of the Copyright Acts or Supplements discussed above attempted to resolve the issue of when an infringing derivative work could separately qualify for copyright protection, but Congress made it clear that derivative works created from the public domain, or by the author of the preexisting work, could sometimes qualify for separate copyright protection.⁴²

B. Separate Copyright Protection of Non-Infringing Derivative Works.

Courts gradually became more willing to grant copyright protection for works that had been adapted or modified from public domain works, even though they were not purely original. For example, the New York Circuit Court held in *Jollie v. Jacques* that a derivative work may be copyrighted if it

⁴⁰ Intangible works like software programs can be changed and revised, while backing up and preserving the first software design the derivative work is based on. Hence, there is less risk that the original program itself would be destroyed, as compared to the sculpture hypothetical. If a derivative author steals a copy of a software program and adds to it before selling it to buyers, the derivative author would still have violated the original software author's right to reproduce and distribute the original software by substantially copying it—without the need for a derivative work right.

⁴¹ 17 U.S.C. § 102(b) (2006). The protection of ideas is for the patent office to decide under the rigorous standard of nonobviousness. 35 U.S.C. § 103 (2006); *Mazer v. Stein*, 347 U.S. 201, 217 (1954).

⁴² See *infra* Part V.

is “substantially a new and original work[,] and not a copy of a piece already produced, with additions and variations, which a writer of music with experience and skill might readily make.”⁴³ In another case in the New York Circuit Court, the court applied the 1831 Act and held that music taken from a public domain opera and subsequently rewritten by the author arranger to include “many” of his own original alterations and additions qualified for copyright protection.⁴⁴ The court found that the rewritten opera was sufficiently original to qualify for copyright protection, despite the fact that it originated from an opera already in the public domain.

Additionally, courts granted copyright protection to works derived from the authors’ own earlier works, or from the licensing of other authors’ works, even though they were not purely original. For example, courts granted separate copyright protection to the improved portions of new editions to books and maps.⁴⁵ This allowed authors the flexibility of severing their rights in separate versions of a given work under licensing agreements.⁴⁶ For example, an author could grant one publisher the right to publish a textbook on Psychology, but reserve the right for a different publisher to potentially publish a second edition of the textbook. Granting copyright protection to works derived from public domain works and to works derived from an author’s own copyrighted works was not a controversial development in copyright law.⁴⁷

C. Derivative Work Infringements.

Copyright was initially instituted “to deal only with easy cases, the pirate reprinting of books or restaging of plays. At the start of the nineteenth century, courts typically found no infringement in what leading French commentary

⁴³ *Jollie v. Jacques*, 13 F. Cas. 910, 913 (C.C.S.D.N.Y. 1850) (holding that “the adaptation to one instrument of the music composed for another, requires but an inferior degree of skill, and can be readily accomplished by any person practiced in the transfer of music” and that the defendant’s polka version for the clarinet was substantially similar to the plaintiff’s version for the piano).

⁴⁴ *Atwill v. Ferrett*, 2 F. Cas. 195, 198 (C.C.S.D.N.Y. 1846).

⁴⁵ *Farmer v. Calvert Lithographing Co.*, 8 F. Cas. 1022, 1025 (C.C.E.D. Mich. 1872) (holding that new editions of maps could secure Copyright protection under the Act of 1831).

⁴⁶ *See Lawrence v. Dana*, 15 F. Cas. 26 (C.C.D. Mass. 1869) (holding that an author could transfer his right to use his notes and improvements to create certain book editions and obtain copyright protection for same, while retaining his own copyright protection in the notes and improvements as a separate original work).

⁴⁷ *See Lesser v. Sklarz*, 15 F. Cas. 396 (C.C.S.D.N.Y. 1859) (holding that an English translation from the Hebrew Book of Moses was an appropriate subject matter to qualify for copyright protection, and also holding that copying a language translation verbatim constituted copyright infringement when plaintiff presented evidence that the defendant had plaintiff’s translation in his possession).

called “[t]he transmutation of form that the translator causes the original to undergo.”⁴⁸ Derivative works adapted from separately authored copyright protected works without the other author’s permission are more problematic than works derived from public domain works or works that authors derive from their own copyrighted work or from another author’s work with their permission.⁴⁹ Faced with the dilemma of unauthorized works, courts had to determine when such works constitute infringement of the underlying work.

In 1841, the Massachusetts District Court heard *Folsom v. Marsh* and expressly recognized an exception to print infringement for derivative authors who created an abridgement of another author’s work, so long as there was a “substantial condensation of the materials, and intellectual labor and judgment bestowed thereon; and not merely the facile use of the scissors; or extracts of the essential parts, constituting the chief value of the original work.”⁵⁰ The court reasoned that “we must. . . look to the nature and objects of the selections made, the quantity and value of the materials used, and the degree in which the use may prejudice the sale, or diminish the profits. . . of the original work. . . . [M]uch must. . . [also] depend upon the nature of the new [derivative] work, the value and extent of the copies, and the degree in which the original authors may be injured thereby.”⁵¹

In its opinion, the *Folsom* court recognized the importance of considering the amount of originality an unauthorized author both takes and contributes to a derivative work. However, the court should have more heavily weighed the fact that the entire derivative work consisted of portions of the preexisting work, i.e., the derivative author may have spent considerable effort condensing the preexisting work but did not otherwise add any originality to the derivative work besides copied, albeit condensed text.

In 1845, the Massachusetts District Court heard *Emerson v. Davies*, a case where the defendant’s book contained many of the same arithmetic lessons, examples, illustrations, and tables as the plaintiff’s book.⁵² The court applied the 1831 Act, which stated that a person infringes a copyrighted “print, cut, or engraving, map, chart or musical composition. . . by varying, adding to, or

⁴⁸ Paul Edward Geller, *Hiroshige vs. Van Gogh: Resolving the Dilemma of Copyright Scope in Remediating Infringement*, 46 J. COPYRIGHT SOC’Y U.S.A. 39, 46–47 (1999) (citing 2 AUGUSTIN-CHARLES RENOARD, TRAITÉ DES DROITS D’AUTERS 37 (1838–39)).

⁴⁹ See *Farmer*, 8 F. Cas. at 1025 (holding that new editions of maps could secure Copyright protection under the Act of 1831); *Atwill* 2 F. Cas. at 198 (holding that a musician’s work that rewrote an opera in the public domain qualified for copyright protection).

⁵⁰ *Folsom v. Marsh*, 9 F. Cas. 342, 345 (C.C.D. Mass. 1841) (recognizing the abridgement exception in dicta, but holding the actual defendants in the case liable for copyright infringement because too great a portion of the original work had been copied).

⁵¹ *Id.* at 348–49.

⁵² *Emerson v. Davies*, 8 F. Cas. 615, 623 (C.C.D. Mass. 1845).

diminishing the main design” with “intent to evade the law”⁵³ Finding that the defendant infringed plaintiff’s book, the court defined the infringement test as whether the defendant had “in substance, copied these pages . . . from plaintiff’s work, with merely colorable alterations and devices to disguise the copy, or whether the resemblances are merely accidental, and naturally or necessarily grew out of the defendant, Davies’s work, without any use of the plaintiff’s.”⁵⁴ Thus, the court inferred from the substantial similarity between the two works that the defendant copied the plaintiff’s book and made only minor modifications to it with the intent to evade copyright law. *Emerson* struck a better testing balance than *Folsom* because the court thoroughly considered both the extent to which the defendant copied from the preexisting work, and the extent to which the defendant added new originality to the derivative work.

In 1853, the Pennsylvania Circuit Court held that the defendant’s German translation of Uncle Tom’s Cabin in *Stowe v. Thomas* did not infringe Harriet Beecher Stowe’s copyright in the original book written in English.⁵⁵ Like *Emerson*, the Court described the test as not “whether the defendant has used the thoughts, conceptions, information or discoveries promulgated by the original, but whether his composition may be considered a new work, requiring invention, learning and judgment, or only a mere transcript of the whole or parts of the original, with merely colorable variations.”⁵⁶ The court further explained that the author’s sole right to copy does not encompass a property right in the author’s “original conceptions” because a purchaser should be able to “improve it, imitate it, translate it, oppose its sentiments; but he buys no right to publish the identical work.”⁵⁷ Thus, the court found no infringement because the defendant contributed substantial intellectual efforts into the derivative translation. Like *Folsom*, the court failed to address whether the defendant substantially copied from the original English text in order to complete a German translation of its contents.⁵⁸ *Stowe* was quickly overruled by Congress’s enactment of the 1870 Copyright Act, which for the first time granted authors the exclusive right to reserve translation of their works into other languages.⁵⁹

While the courts did not apply a uniform test for infringement, they generally considered whether an accused defendant substantially copied plaintiff’s work, the caliber and quantity of the intellectual labors and originality a derivative author contributed to the derivative work, and whether

⁵³ Copyright Act of 1831, ch. 15, 4 Stat. 436.

⁵⁴ *Emerson*, 8 F. Cas. at 623.

⁵⁵ *Stowe v. Thomas*, 23 F. Cas. 201, 208 (C.C.E.D. Pa. 1853).

⁵⁶ *Id.* at 207.

⁵⁷ *Id.*

⁵⁸ See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 565 (1985).

⁵⁹ Copyright Act of 1870, ch. 230, 16 Stat. 198, 212.

2013]

THE DERIVATIVE WORK RIGHT

the defendant objectively and subjectively intended to evade copyright law.

D. The Enactment and Application of the 1909 Copyright Act.

Recall that the 1870 Act granted copyright protection to the following subject matter categories: “book, map, chart, dramatic or musical composition, engraving, cut, print, or photograph or negative thereof, or of a painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts.”⁶⁰ Section 5 of the 1909 Act provided a more detailed listing of copyright subject matter as follows:

- (a) Books, including composite and encyclopedic works, directories, gazetteers, and other compilations;
- (b) Periodicals, including newspapers;
- (c) Lectures, sermons, addresses, prepared for oral delivery;
- (d) Dramatic or dramatic-musical compositions;
- (e) Musical compositions;
- (f) Maps;
- (g) Works of art; models or designs for works of art;
- (h) Reproductions of a work of art;
- (i) Drawings or plastic works of a scientific or technical character;
- (j) Photographs;
- (k) Prints and pictorial illustrations⁶¹

Like the 1870 Copyright Act, Section 1 of the 1909 Copyright Act granted copyright owners the exclusive right “[t]o print, reprint, publish, copy, and vend the copyrighted work”.⁶² It also granted copyright owners the exclusive right to “deliver or authorize the delivery of the copyrighted work in public for profit if it be a lecture, sermon, address, or similar production,”⁶³ to perform dramatic works and musical performances, make mechanical reproductions of musical compositions subject to a compulsory license fee,⁶⁴ and to

translate the copyrighted work into other languages or dialects, or make any other version thereof, if it be a literary work; to dramatize it if it be a nondramatic work; to convert it into a novel or other nondramatic work if it be a drama; to arrange or adapt it if it be a musical work; to complete, execute, and finish it if it be a model or design for a work of art.⁶⁵

⁶⁰ *Id.*

⁶¹ Copyright Act of 1909, Pub. L. 60-349, 35 Stat. 1075, 1077–78.

⁶² *Id.* at 1075; Copyright Act of 1870, ch. 230, 16 Stat. 198, 212; *see also* Story v. Holcombe, 23 F. Cas. 171, 175 (C.C.D. Ohio. 1847).

⁶³ Copyright Act of 1909, Pub. L. 60-349, 35 Stat. 1075, 1075.

⁶⁴ *Id.* at 1082. The Sound Recording Act was not enacted until 1971. Sound Recording Act of 1971, Pub. L. No. 92-140, 85 Stat. 391, 392 (1976).

⁶⁵ Copyright Act of 1909, Pub. L. 60-349, 35 Stat. 1075, 1075.

The 1909 Act did not define what it means to “reprint”, “copy”, “convert”, or “arrange or adapt” a work.⁶⁶ The 1909 Act extended the performance right to include both dramatic works like it had in the 1870 Act and also musical compositions for profit.⁶⁷

Like the 1870 Act, Congress granted authors the exclusive right to create derivative dramatizations and translations.⁶⁸ However, unlike the 1870 Act, Congress granted authors the automatic right to create such derivative works, without the need to expressly reserve them as exclusive rights.⁶⁹ Unlike the 1870 Act, Congress also granted authors the exclusive right to convert their original works “into a novel or other nondramatic work if it be a drama,” and arrangements and adaptations of musical works from their original works. Like translating or dramatizing a work, converting a work into another commercial output medium or adapting music to a different instrument requires substantial copying of the original work.

With respect to infringement, section 25 of the 1909 Act for the first time refrained from defining infringement and generally stated that infringers “shall be liable” as provided, and that the “[r]ules and regulation for practice and procedure” relating to liability “shall be prescribed by the Supreme Court of the United States.”⁷⁰ By deleting any definition on the measurement of infringement, Congress conformed authors’ enumerated rights with the infringement section related to those same rights.⁷¹ In contrast, after repealing the 1831 Act, Congress had transferred authors’ rights to copy their work “in whole or in part” to the infringement section under the 1870 Copyright Act.⁷² The 1976 Act similarly does not contain a definition for the measurement of infringement under its infringement section so that the focus of infringement measurement must be solely interpreted from the exclusive grant provision.⁷³ As a result, the determination of what measures up to a copyright infringement based upon the 1976 Act’s exclusive rights granted to authors has been mostly left up to the courts.⁷⁴

⁶⁶ *Id.*

⁶⁷ *Id.* at 1075.

⁶⁸ *Id.*; *see supra* II.A.3.

⁶⁹ Copyright Act of 1909, Pub. L. 60-349, 35 Stat. 1075, 1075.

⁷⁰ *Id.* at 1081; Act of May 31, 1790, ch. 15, 1 Stat. 124, 123–25; Act of Feb. 3, 1831, ch. 16, 4 Stat. 436, 438; Copyright Act of 1870, ch. 230, 16 Stat. 198, 214–15.

⁷¹ *See* Copyright Act of 1831, ch. 15, 4 Stat. 436 (including copying as a form of infringement but failing to list copying in the list of authors’ enumerated rights); *see also* Copyright Act of 1790, ch. 15, 1 Stat. 124.

⁷² Copyright Act of 1870, ch. 230, 16 Stat. 198, 214 (infringement meant to “engrave, etch, work, copy, print, publish, or import, either in whole or in part, or by varying the main design with intent to evade the law”).

⁷³ *See* 17 U.S.C. § 501 (2006).

⁷⁴ *See supra* II.A.3.

With greater recognition of how often people derived segments of their creations from others, courts continued to struggle with the factual question of when a defendant had copied enough material to substantiate an infringement of the underlying copyright. The Michigan Circuit Court summarized this difficulty, writing that “courts . . . have at all times and in all countries recognized the right of subsequent authors, compilers, and publishers to use the works of others to a certain extent, but the great difficulty has always been, and always must be, to determine where such use ceases to be legitimate, and becomes an invasion of the rights of others.”⁷⁵

In *Condotti, Inc. v. Slifka*, the Southern District Court of New York ruled that the defendants did not infringe the plaintiff’s original, copyrighted textile designs.⁷⁶ After listing a comparison of each element of the two works, the court explained that the works bore both “striking similarities” and “significant differences.”⁷⁷ Based upon its comparative analysis, the court found that the only “apparent similarity of the respective designs” were the ideas expressed and the similar colors used to express the ideas.⁷⁸ Thus, the defendants’ “aesthetic mutations, reflecting major changes and significant alterations” of the plaintiff’s designs, did not infringe the plaintiff’s designs.⁷⁹

The *Condotti* court presumed that the test for copyright infringement should be whether there are “striking similarities” and/or “striking differences” between the preexisting work and potential infringer’s work, not a separate derivative work right analysis.⁸⁰ The defendants did not try to feign or claim independent creation as a defense—they claimed that they did not infringe because their designs were different enough compared to the plaintiff’s designs not to amount to infringement.⁸¹ The Southern District Court of New York

⁷⁵ Farmer v. Calvert Lithographing Co., 8 F. Cas. 1022, 1026 (C.C.E.D. Mich. 1872).

⁷⁶ Addison-Wesley Publ’g Co. v. Brown, 223 F. Supp. 412, 415 (S.D.N.Y. 1963).

⁷⁷ *Id.* at 414. There were “striking similarities in structural characteristics, in uses of shading, stippling, colors and color combinations, and in spatial arrangements and configurations. But equally obvious [were] the many striking dissimilarities and variations.” *Id.* at 415.

⁷⁸ *Id.* at 413.

⁷⁹ *Id.* at 415 (citing *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960) (“[B]oth [garment] designs have the same general color, and the arches, scrolls, rows of symbols, etc. on one resemble those on the other though they are not identically. Moreover the patterns in which these figures are distributed to make up the design as a whole are not identical. However, the ordinary observer, unless he set out to detect these disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same.”).

⁸⁰ *Id.* at 414–15.

⁸¹ *Id.* at 413 (“[V]arious representatives of the defendants have admitted to the trade that the defendants have copied the plaintiff’s designs and that whatever changes were effected by the defendants were of such a nature as to accomplish copying while supplying the defendants with the defense that their designs were different.”).

found that people had a limited inherent right to copy lawfully “ideas” from existing copyright-protected works so long as the “plaintiff’s ‘expression’” is not copied.⁸² The mere fact that the defendants’ textile designs were derived from the plaintiff’s designs did not lead the court to conclude that the defendants had unlawfully adapted the plaintiff’s work. Unlike a language translation or an adaptation of novel into a dramatic work, the defendants merely created distinct textile designs that incorporated ideas from the plaintiff’s textile designs. Thus, whether there was substantial similarity between the preexisting work and copied work was the appropriate test, not a separate derivative work infringement analysis.

Converting textile designs into a three-dimensional sculpture could have amounted to infringement under the 1909 Act’s exclusive right “to complete, execute, and finish” a copyrighted work.⁸³ However, it appears that the 1909 Act’s adaptation grants did not attempt to provide greater protection to copyright-protected works when the alleged infringement took place across different media. Rather, it only meant to extend uniformly the substantial similarity test for “copying” to the conversion of works across different commercial media because of a prior lack of judicial conformity in such cases.⁸⁴ Hence, even if the defendants in *Condotti* had adapted only portions of the plaintiff’s textile designs into an artistic sculpture, they would not have infringed, because the defendants would not have substantially copied the plaintiff’s expression. Irrespective of the medium in which an infringer employs the infringing material, copyright law does not protect ideas.

In *Greenbie v. Noble*, the Southern District Court of New York explained that “[t]he second author may also use the copyrighted books as a means of reference to the original [nonfiction] sources, and such use does not amount to a violation of the exclusive rights granted by the Copyright Act.”⁸⁵ The court held that defendant Noble independently created his book, despite his admitted use of Greenbie’s work as one of his reference materials. Because Noble’s book was found to only contain insubstantial portions of Greenbie’s book and had substantial originality, the court found there was no infringement.⁸⁶

⁸² *Id.* at 415.

⁸³ Copyright Act of 1909, Pub. L. No. 349, 35 Stat. 1075 (previously codified at 17 U.S.C. §§ 1–216).

⁸⁴ *Compare* *Stowe v. Thomas*, 23 F. Cas. 201, 208 (C.C.E.D. Pa. 1853) (holding that a translation of a novel was not an infringement), *and* *Folsom v. Marsh*, 9 F. Cas. 342 (C.C.D. Mass. 1841) (stating in dicta that an abridgement was not necessarily an infringement), *with* *Grove Press, Inc. v. The Greenleaf Pub’g Co.*, 247 F. Supp. 518 (E.D.N.Y. 1965) (holding that a translation copied from an unregistered translation was an infringing substantial copy of the copyright protected underlying work).

⁸⁵ *Greenbie v. Noble*, 151 F. Supp. 45, 67 (S.D.N.Y. 1957) (citing *West Pub’g Co. v. Edward Thompson Co.*, 169 F. 833 (C.C.E.D.N.Y. 1909)).

⁸⁶ *Id.* at 70.

2013]

THE DERIVATIVE WORK RIGHT

Moreover, the Court ruled, “Mrs. Greenbie’s efforts to obtain a copyright for her [non-fiction] book so that she could thereafter ‘hold the thing for the motion pictures’ cannot be interpreted as a monopolization by her of the Anna Ella Carroll story, even though Mrs. Greenbie may have acted in this belief.”⁸⁷

With regard to fair use, the court also stated that “how far the copied matter will tend to supersede the original or interfere with its sale” must be considered in an action for infringement.⁸⁸ According to the *Greenbie* court, in certain circumstances

a subsequent publisher may draw from the earlier publication its identical words, and make use of them. This is peculiarly so with reference to works in regard to the arts and sciences, using those words in the broadest sense, because, with reference to them, any publication is given out as a development in the way of progress, and, to a certain extent, by common consent, including the implied consent of the first publisher, others interested in advancing the same art or science may commence where the prior author stopped. This includes medical and legal publications, in which the entire community has an interest, and which the authors are supposed to give forth, not only for their own pecuniary profit, but for the advancement of science.⁸⁹

Under the fair use doctrine, the court held that defendant Noble’s fictionalized depiction of Anna Ella Carroll did not undermine the marketability of plaintiff Greenbie’s biography of Anna Ella Carroll because Greenbie’s book was pulled off of the market before Noble ever even published his book.⁹⁰ Greenbie’s intention to eventually fictionalize her book could not reserve to her a monopoly on selling a fictionalized version to a movie producer.

Like the hypothetical conversion of the *Condotti* textile design into an artistic statue comprising only of insubstantial copying from the original design, defendants in *Borden v. General Motors Corp.* allegedly copied only a set of principles of persuasion for a book entitled, “How to Win A Sales Argument” from one page in the book to convert them into a dramatic sales movie without authorization.⁹¹ The Southern District Court of New York rejected the plaintiffs’ claim that General Motors “substantially copied” from their book, stating that “general principles or ideas or thoughts in themselves . . . are not the subject of valid copyright.”⁹² The court summarized

⁸⁷ *Id.* at 62.

⁸⁸ *Id.* at 69 (internal citation omitted).

⁸⁹ *Id.* at 67–68.

⁹⁰ *Id.* at 69.

⁹¹ *Borden v. Gen. Motors Corp.*, 28 F. Supp. 330, 331 (S.D.N.Y. 1939).

⁹² *Id.* at 332. The court quoted Judge Learned Hand’s comment that “[t]here is a point in this series of abstractions where they are no longer protected, since otherwise the playwright

that “[a]ssuming . . . that the defendant’s film was produced after a showing of access to the copyrighted work, and that there was an appropriation in substantially similar phrase in the exact order of the six principles recited,” defendant’s film was still not an infringement because such sales “rules” cannot be dramatized into an infringing “dramatic theme.”⁹³

The *Borden* court properly recognized that sometimes expression should only have limited copyright protection against literal copy infringement, whether the alleged infringing work is a derivative work adapted for another medium or not. This copyright limitation is essential when the ideas expressed are highly functional.⁹⁴

Both the *Borden* and the *Greenbie* courts rationally determined that the separate adaptation right must be subject to the substantial similarity copy test just like a regular copy infringement would.⁹⁵ It makes sense that insubstantial copying of some expression should not amount to an infringement when there is sufficient independent creation, irrespective of whether the lawsuit involves a reproduction claim or a derivative work right claim. As a result, unlike the *Stowe* translation of Uncle Tom’s Cabin into German, Noble’s novel and General Motors’ movie not only contained originality, they also did not contain substantial copying from *Greenbie*’s book and *Borden*’s book.⁹⁶

The *Borden* court only mentioned the market effects of its decision in passing, whereas the *Greenbie* court included the fair use doctrine as a part of its finding of non-infringement.⁹⁷ Yet the *Greenbie* court did not explain how much it relied upon the fair use doctrine to reach the outcome of the case.⁹⁸ Thus, it is unclear to what extent the court intended to hold that defendant Noble’s work was non-infringing because it only insubstantially copied from *Greenbie*’s work, and to what extent it was non-infringing because it was a fair use that did not interfere with the marketability of Noble’s biographical book.

For uniformity, Congress intended for the 1909 Act to extend the substantial similarity infringement test to conversion copying across language translations and different mediums of art. Perhaps, courts like the *Stowe* court had essentially applied an unspoken judge-made fair use defense for derivative works that did not impede the marketability of the preexisting work. But in *Greenbie*, the related marketability of the two books was not an issue that the

could prevent the use of his ‘ideas,’ which, apart from their expression, his property is never extended.” *Id.* at 333 (citing *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930)).

⁹³ The court also noted the following fair use observation: “it does not seem that the book originally was intended primarily for the use of salesmen.” *Id.* at 332.

⁹⁴ See *Baker v. Seldon*, 101 U.S. 99, 105 (1880).

⁹⁵ See, e.g., *Borden*, 28 F. Supp. at 332; *Greenbie*, 151 F. Supp. at 68.

⁹⁶ See *Borden*, 28 F. Supp. at 332; *Greenbie*, 151 F. Supp. at 70.

⁹⁷ Compare *Borden*, 28 F. Supp. at 332-33, with *Greenbie*, 151 F. Supp. at 67.

⁹⁸ See generally *Greenbie*, 151 F. Supp. at 67-68.

2013]

THE DERIVATIVE WORK RIGHT

court needed to reach because without substantial copying, Noble did not infringe Greenbie's copyright in the first place.⁹⁹ The *Greenbie* court seemed to mix up the factual question of whether an infringement ever took place with whether a fair use defense was equitably applicable to exonerate a proven infringement.¹⁰⁰ Once an infringement was established, whether a derivative translation, abridgement, adaptation or otherwise, the burden then shifted to the defendants prove that their infringement should be excused pursuant to any defense such as the fair use doctrine.¹⁰¹

E. The Enactment and Application of the Copyright Act of 1976.

As a recap, prior to the 1870 Act and the 1909 Act, derivative works were not uniformly understood to be unlawful copies of the underlying copyright-protected works. As Congress granted particular derivative works rights to authors, everyone's conception of authors' reproduction and performance rights expanded to include derivative works.¹⁰² Under the 1909 Act, it was an infringement to create certain unauthorized derivative works that contained tangible or intangible, substantial copying of the underlying works.¹⁰³ In contrast with other potential infringements, however, unauthorized derivative work infringements were sometimes granted judge-made fair use protection because adaptations in new mediums were considered to have a less significant impact on the marketability of the underlying copyright protected work, since derivative work infringement was less likely to compete with the underlying work from which it was based.¹⁰⁴ Instead of allowing the courts to create a fair use derivative work exception to copyright infringement or to restrict the definition of "copy," the 1870 Act and 1909 Act granted authors specific

⁹⁹ *Greenbie*, 151 F. Supp. at 70.

¹⁰⁰ See also *Addison-Wesley Publ'g Co. v. Brown*, 223 F. Supp. 219 (E.D.N.Y. 1963) (holding that an unauthorized solution book to physics textbooks was a copyright infringement because it substantially copied physics questions solutions, but not considering the separate question of whether there was a fair use defense based on the fact that the solutions book did not affect the marketability of the textbook).

¹⁰¹ Today, the fair use defense has a statutory backbone. See Copyright Act of 1976, 17 U.S.C. § 107 (2006).

¹⁰² E.g., *Kalem Co. v. Harper Bros*, 222 U.S. 55, 61–62 (1911) (stating that a public exhibition of a movie can constitute an infringing dramatization because a dramatization could be improperly achieved in a "visual impression" previously recorded or by live performance).

¹⁰³ Copyright Act of 1909, Pub. L. No. 349, 35 Stat. 1075 (declaring it an infringement to "translate the copyrighted work into other languages or dialects, or make any other version thereof, if it be a literary work; to dramatize it if it be a nondramatic work; to convert it into a novel or other nondramatic work if it be a drama; to arrange or adapt it if it be a musical work; to complete, execute, and finish it if it be a model or design for a work of art").

¹⁰⁴ *Brown*, *supra* note 4, at 23.

adaptation rights so that almost any substantial taking from a copyrighted work was a presumptive infringement. In addition to clarifying that certain derivative works were subject to the infringement provision of the Copyright Act, the 1909 Act removed the overly general “in whole or in part” language that had not proven helpful in measuring the amount of copyright that amounted to an actionable infringement.

“In 1955 Congress authorized the Copyright Office to undertake a program of studies leading to general revision of the U.S. copyright law.”¹⁰⁵ According to the report summarizing and analyzing these studies, an overhaul revision of the 1909 Act was necessary because of the vast technological advancements that had occurred since the adoption of the 1909 Act. More specifically, the report explained that

[c]ommercial radio and television were unknown in 1909. Motion pictures and sound recordings were in a rudimentary stage. New techniques for reproducing printed matter and recorded sounds have since come into use. These and other technical advances have brought in new industries and new methods for the reproduction and dissemination of the literary, musical, pictorial, and artistic works that comprise the subject matter of copyright. And the business relations between creators and users of copyright materials has evolved into new patterns.¹⁰⁶

Mr. Abraham L. Kaminstein, the Register of Copyrights, later coined such technological advancements as the 20th century’s “revolution in communications.”¹⁰⁷ Due to this revolution in communications, the report concluded that the 1909 Act was “uncertain, inconsistent, or inadequate in its application to present-day conditions.”¹⁰⁸

The Report summarized the state of copyright law at the time as a legal device that

does not preclude others from using the ideas or information revealed by the author’s work. It pertains to the literary, music, graphic, or artistic form in which the author expresses intellectual concepts. It enables him to prevent others from reproducing his individual expression without his consent. But anyone is free to create his own expression of the same concepts, or to make practical use of them, as long as he does not copy the author’s form of expression.¹⁰⁹

¹⁰⁵ REPORT OF THE REGISTER 1961, *supra* note 7, at ix.

¹⁰⁶ *Id.*

¹⁰⁷ *Hearings before the Subcomm. on Patents, Trademarks, and Copyrights of the Comm. on the Judiciary*, 89th Cong. (1965) (statement of Abraham L. Kaminstein), *reprinted* in 8 GEORGE S. GROSSMAN, *OMNIBUS COPYRIGHT REVISION LEGIS. HISTORY* at 6 (2001).

¹⁰⁸ REPORT OF THE REGISTER 1961, *supra* note 7, at x.

¹⁰⁹ *Id.* at 3.

2013]

THE DERIVATIVE WORK RIGHT

It then explained that in copyright law “[t]he real danger of monopoly might arise when many works of the same kind are pooled and controlled together.”¹¹⁰

With respect to derivative works, the Report advised that the new Copyright Act needed to clarify the requirement that “‘new versions’ of preexisting works” must be copyrightable subject matter and qualify for copyright protection when they “themselves represent original creative authorship” and are fixed in a tangible form.¹¹¹ Interestingly, the collaborative report at the same time acknowledged that having an exclusive right to create new versions of a preexisting work “would appear to be a form of ‘copying.’”¹¹² Nevertheless, the report still concluded that the rights to make translations, dramatizations, and to execute models or designs have been a part of the Copyright Act since 1870 and, therefore, the right to make new versions should be retained as a separate right in the new Copyright Act to “avoid any doubt” about the extent of an authors’ copyright protection.¹¹³

Under the guidance of the Report, Congress took on the daunting task of drafting a comprehensive revision of the 1909 Act from 1961 to 1976. In the initial bill drafts, Congress referred to the derivative work right as the right of “making new versions” of a copyright-protected work.¹¹⁴ Congress first attempted to define a derivative work in a preliminary draft dated January 16, 1963 as

a work based *and dependent for its existence* upon one or more pre-existing works, such as a translation, arrangement, instrumentation, abridgment, summary, index, dramatization, motion picture version, sound recording, art reproduction, or any other form of adaptation by which the work of an author may be recast or transformed. A derivative work consisting of editorial revisions, annotations, modifications, deletions, or elaborations shall be subject to copyright if the alterations, considered as a whole, represent an original work of authorship.¹¹⁵

After multiple bill revisions, in 1964 Congress incorporated the right “to prepare derivative works based upon the copyrighted work” as an exclusive

¹¹⁰ *Id.* at 5.

¹¹¹ *Id.* at 9.

¹¹² *Id.* at 22.

¹¹³ *Id.* The report also addressed many other topics, including the need to incorporate the judicially developed fair use doctrine into the statute.

¹¹⁴ 1 THE KAMINSTEIN LEGISLATIVE HISTORY PROJECT: A COMPENDIUM AND ANALYTICAL INDEX OF MATERIALS LEADING TO THE COPYRIGHT ACT OF 1976 165 (Alan Latman & James F. Lightstone eds., 1981) [hereinafter KAMINSTEIN LEGISLATIVE HISTORY PROJECT].

¹¹⁵ *Id.* at 62. The first cases that expressly mentioned “derivative” works were *Nom Music, Inc. v. Kaslin*, 343 F.2d 198, 200 (2d Cir. 1965) and *Grove Press, Inc. v. The Greenleaf Publishing Co.*, 247 F. Supp. 518, 525 (E.D.N.Y. 1965).

right within the scope of copyright protection and removed the prior drafted right for “making new versions” of a copyright protected work.¹¹⁶ Similarly to the 1909 Act, Congress also distinguished a derivative work from a pre-existing work in that copyright protection in a derivative work “is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of any copyright protection in the pre-existing material.”¹¹⁷

Congress did not adequately ponder the ramifications of expansively granting a separate derivative work right, giving authors a monopoly on any subsequent works “based upon” their copyright protected work. The description “based upon” is certainly more general than the initial draft description requiring that an unauthorized, infringing derivative work be “based and dependent for its existence upon” the preexisting work. As applied in the prior cases, “dependent for its existence” distinguished the derivative works that were based entirely on the preexisting works such as the German translation in *Stowe*, from works that were just insubstantially derived from preexisting works such as in *Borden* and *Greenbie*.

Granting this broad, separate derivative work right was destined to confuse courts and the public, because it directly conflicted with the Copyright Act’s express disallowance of the copyright protection of ideas. In effect, the new exclusive right to create any work “based upon” the original copyright-protected work alone implies that the *Borden* and *Greenbie* plays would have been infringements of the underlying books because access and insubstantial copying was arguably proven. Yet, prior to the 1976 Act, the substantial similarity standard for infringement had been equally applied to alleged adaptation infringement cases in the courts, as it had been in alleged reproduction and performance infringement cases. Thus, under the prior Copyright Acts, the courts had adeptly treated the predecessors of the derivative work right as a subset of the other enumerated exclusive rights of authors, not as a distinct right that is separately actionable from the other rights.¹¹⁸ The 1976 Act should have better reflected this trend that simply placed derivative works within the definition of infringing works when the shoe fit.¹¹⁹

¹¹⁶ KAMINSTEIN LEGISLATIVE HISTORY PROJECT, *supra* note 114, at 194–95.

¹¹⁷ *Id.* at 66.

¹¹⁸ Keep in mind that the 1909 Act first made the mistake of separately recognizing an adaptation right. However, copyright owners had not yet taken advantage of this conception error. See discussion *supra* Part II.D.

¹¹⁹ Before the 1976 Act, courts sometimes found that substantially similar derivative works were not copyright infringements because they contained substantial new originality. Congress added more and more adaptive works into the grant provisions of the pre-1976 Copyright Acts, and then under the 1976 Act completely shifted the burden of proof to defendants who substantially copied to defend their copying under the fair use defense. See discussion *infra* Part V.

2013]

THE DERIVATIVE WORK RIGHT

Instead, Congress adopted the Copyright Act of 1976, which for the first time recognized copyright protection of “derivative” works as a separate right and superseded the 1909 Act. Pursuant to the 1976 Amendment, 17 U.S.C. § 101 defined a “derivative work” as

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

The words “recast, transformed, and adapted” and “editorial revisions, transformed, or adapted” were left undefined and continue to be left undefined in today’s statute.¹²⁰

Like the 1961 report, the House Judiciary Committee reviewed the final 1976 Act and recognized in a 1976 report that “[t]he exclusive right to prepare derivative works . . . overlaps the exclusive right of reproduction to some extent.”¹²¹ Contrary to the 1961 report, however, the 1976 report indicated that derivative works have broader copyright protection “in the sense that reproduction requires fixation in copies or phonorecords, whereas the preparation of a derivative work, such as a ballet, pantomime, or improvised performance, may be an infringement even though nothing is ever fixed in tangible form.”¹²² Unlike the 1963 draft of the Copyright Act, in which Congress initially intended to give the exclusive derivative right to create summaries, indexes, and instrumentations derived from preexisting works as derivative works, the 1976 report further explained that “to constitute a violation of section 106(2), the infringing work must incorporate a portion of the copyrighted work in some form; for example a detailed commentary on a work or a programmatic musical composition inspired by a novel would not normally constitute infringement under this clause.”¹²³

While the 1976 House Committee report resolved that a derivative work could only be an infringement if it “incorporated” portions of the original work, the report missed the boat when it made the distinction that certain derivative works do not have to be fixed and, therefore, could avoid infringement of the underlying work. If anything, the distinction actually exemplifies why a separate derivative work right is inappropriate. The report’s reasoning was misguided because an original written choreography for a ballet, for example, is fixed, but a performance of the choreography with some

¹²⁰ 17 U.S.C. § 101 (2006).

¹²¹ H.R. REP. NO. 94-1476, at 62 (1976).

¹²² *Id.*

¹²³ *Id.*

variations from the fixed choreography for a ballet would constitute an infringement of the original choreographer's performance right.

Furthermore, the derivative author would never be entitled to separate copyright protection of a derivative performance because copyright law only grants copyright protection to fixed works.¹²⁴ Thus, the 1976 Act already granted and protected against infringement of authors' exclusive rights to perform and display their works to cover these types of unfixed infringements.¹²⁵ Insubstantially varying the performance of the written choreography to make it an unfixed derivative work does not allow the derivative performance to escape performance infringement so long as the performance incorporates substantial copying from the written choreography. On the other hand, as Congress itself pointed out, merely taking some inspiration from the ideas expressed in a preexisting work should not rise to actionable infringement. The House Report misunderstood the historical underpinnings of the derivative work right. Ultimately, copyright protected works must be fixed whether they are original works or derivative works, and infringing works do not have to be fixed to constitute infringement of protected works.¹²⁶

In contrast to the questions surrounding the incorporation of the derivative work right into the new Act, all of the revision drafts undisputedly included authors' exclusive rights to make a copy of or reproduce their work.

Congress took the advice of the 1961 report to incorporate a separate

¹²⁴ H. COMM. ON THE JUDICIARY, 87TH CONG., COPYRIGHT LAW REVISION PART 5: 1964 REVISION BILL WITH DISCUSSION AND COMMENTS (Comm. Print 1961) [*hereinafter* COMMENTS ON THE 1964 REVISION BILL], reprinted in 4 GEORGE S. GROSSMAN, OMNIBUS COPYRIGHT REVISION LEGISLATIVE HISTORY 58, 304 (1976) (Mr. Sargoy stated during on a meeting on the 1964 Revision Bill that the exclusive rights section does not pertain to copyrightability, but to "derivative utilizations" that constitute infringement).

¹²⁵ Copyright Act of 1976, ch. 1, Pub. L. No. 94-553, 90 Stat. 2541 (1976) (codified at 17 U.S.C. 106(4), (5)). Likewise, these separate exclusive rights relate to infringement and are unrelated to allowing the copyrightability of unfixed works.

¹²⁶ H.R. REP. NO. 94-1476, at 52-53 (1976) (Conf. Rep.) ("[A]ssuming it [a live transmission recording of a football game] is copyrightable—as a 'motion picture' or 'sound recording,' for example—the content of a live transmission should be regarded as fixed and should be accorded statutory protection if it is being recorded simultaneously with its transmission. On the other hand, the definition of 'fixation' would exclude from the concept purely evanescent or transient reproductions such as those projected briefly on a screen shown electronically on a television or other cathode ray tube, or captured momentarily in the 'memory' of a computer."). The House Report provides a discussion on authors' "[r]ights of public performance and display." *Id.* at 62. The television recording is fixed in an electronic medium, and any unauthorized live public display in an unfixed form is an infringement of that copyright author's exclusive right to display the recorded television program.

2013]

THE DERIVATIVE WORK RIGHT

derivative work right.¹²⁷ In its analysis, Congress explained

The exclusive right to prepare derivative works, specified separately in clause (2) of section 106, overlaps the exclusive right of reproduction to some extent. It is broader than that right, however, in the sense that reproduction requires fixation in copies or phonorecords, whereas the preparation of a derivative work, such as a ballet, pantomime, or improvised performance, may be an infringement even though nothing is ever fixed in tangible form.”¹²⁸

Today, the exclusive rights to reproduce, perform, and display a work more flexibly means substantial copying of a protected work.¹²⁹ Hence, it seems outmoded to retain a separate exclusive right for derivative works that was intended to be a subset of the other rights. Either the courts find that a defendant infringed by substantially copying an original work in creating a fixed (reproduction), or non-fixed (performance or display) derivative work, or the defendant permissibly copied the original author’s ideas in the creation of his or her derivative work without violating the original author’s rights. As the 1961 report warned in relation to the movie industry, “[t]he real danger of monopoly might arise when many works of the same kind are pooled and controlled together.”¹³⁰ The derivative work right promotes the growth of such dangerous monopolies, because it can only separately protect against insubstantial copying of ideas, not expression.

F. The Derivative Work Right’s Entanglement With the Other Exclusive Rights.

As the above sections illustrate, Congress and the courts gradually recognized that derivative works with sufficient originality should be entitled to copyright protection and that unauthorized persons who create a derivative work from preexisting, protected works are committing copyright infringement. Courts’ broad development of the definition for “copy” infringement into the reproduction, performance, and display rights coalesced with the growth of the definition for “derivative work” infringement. According to the courts, any person that had access to the copyrighted work and substantially copied the work infringed that work.¹³¹ Judge Learned Hand defined the substantial similarity test as when “the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and

¹²⁷ KAMINSTEIN LEGISLATIVE HISTORY PROJECT, *supra* note 114, at 195.

¹²⁸ H.R. REP. NO. 94-1476, at 62 (1976) (Conf. Rep.).

¹²⁹ *Rogers v. Koons*, 960 F.2d 301, 307 (2d Cir. 1992); *see also* Natalie Heineman, *Computer Software Derivative Works: The Calm Before the Storm*, 8 J. HIGH TECH. L. 235, 255 (2008) (summary of substantial similarity test provided.)

¹³⁰ REPORT OF THE REGISTER 1961, *supra* note 7, at 5.

¹³¹ *Rogers*, 960 F.2d at 301.

regard their aesthetic appeal as the same.”¹³² Pursuant to this test, a language translation is a substantial copy that infringes the original work. Likewise, converting a musical piece into a different key encompasses a substantial copy that infringes the original work.

The Copyright Act’s grant to authors of an exclusive right to create derivative works hinders its fundamental policy of maximizing all prospective authors’ incentives to create new works and share them with the public.¹³³ In reality, the derivative work right originated under the founders’ and subsequent drafters’ unconscious purpose of exploring the significance of substantially copying from the time when copying was first thought to mean exact replica copying only.¹³⁴ Courts originally were hesitant to find infringement in unauthorized derivative works, because derivative authors often add significant new originality to derivative works and the fact that derivative works have stronger fair use characteristics. Congress has been hard-pressed to get rid of the derivative work right due to the opposition of existing copyright owners and the apprehension of revising the Copyright Act.¹³⁵ Interestingly, the real difficulty is and has always been the fuzzy line between substantial copying and non-infringement, which will continue to be debated. But, “[t]he test for

¹³² Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487, 489 (2d Cir. 1960).

¹³³ Some argue that the exclusive right potentially violates the Constitution because overly broad protection of ideas will not further the progress of science and, therefore, will deter content speech without adequate justification. See, e.g., Christina Bohannon, *Taming the Derivative Works Right: A Modest Proposal for Reducing Overbreadth and Vagueness in Copyright*, 12 VANDERBILT J. ENT. AND TECH. L. 669, 689 (2010); see generally U.S. CONST. art. I, § 8, cl. 8; U.S. CONST. amend. I.

¹³⁴ See *supra* Part II.A.1.

¹³⁵ Copyright protection has explosively grown from the Copyright Act’s inception, and Congress seemed to feel pressure to maintain the pace when it adopted the 1976 Copyright Act. In this author-friendly atmosphere, various commercial authors expressed dissension about Congress’s proposed incorporation of the fair use doctrine before it was eventually adopted into the 1976 Copyright Act. E.g., Letter from the Authors League of America (Nov. 17, 1964), reprinted in 4 GEORGE S. GROSSMAN, OMNIBUS COPYRIGHT REVISION LEGISLATIVE HISTORY 237 (1976) (suggesting that the defense of fair use should be deleted from Section 6 entirely and left to the Courts to decide). From a defensive standpoint, commercial authors’ opposition to the fair use exemption may have had something to do with why in 1976 Congress did not bother to re-assess whether it would be proper to retain what they referred to as the “frequently misunderstood problem of copyright in ‘compilations and derivative works.’” H. COMM. ON THE JUDICIARY, 89TH CONG., SUPPLEMENTARY REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE COPYRIGHT LAW: 1965 REVISION BILL at 6 (Comm. Print 1965), reprinted in 4 GEORGE S. GROSSMAN, OMNIBUS COPYRIGHT REVISION LEGISLATIVE HISTORY 6 (1976). Within this context, Congress thought “it would seem unfair to narrow or deny copyright protection” to authors in derivative work cases. *Id.* at 7.

2013]

THE DERIVATIVE WORK RIGHT

infringement of a copyright is of necessity vague.”¹³⁶

According to Nimmer, the derivative work right

may be thought to be completely superfluous because . . . if the latter [subsequent] work does not incorporate sufficient of the pre-existing work as to constitute an infringement of either the reproduction right, or of the performance right, then it likewise will not infringe the right to make derivative works because no derivative work will have resulted.¹³⁷

In opposition to this rule of thumb, Nimmer immediately then states that “[c]ountless works are ‘inspired by’ or ‘based on’ copyrighted works, and in that lay sense constitute ‘derivative works.’ But unless the product is substantially similar to its forbear, it remains nonactionable.”¹³⁸ So, by implication, the derivative work right grants authors a monopoly on subsequent works based upon their work, regardless of the magnitude of any alleged piracy.

In contrast, the reproduction, performance and display rights all require substantial copying to be taken from the preexisting work. Unlike the derivative work right, the performance and display rights are distinguishable from the reproduction right because they separately protect against infringing non-fixed works. It seems that Congress was afraid that the performance right would not sufficiently protect against unfixed derivative work right infringements. Yet, granting a separate derivative work right causes frivolous actions to become infringements. For example, under the separate derivative work right it would be an infringement for me to perform, without fixation of the performance, a lawfully purchased choreography in the confines of my home. The performance right requires that a performance be public. My hypothetical home performance could only be infringement of the choreographer’s derivative work right. It is too difficult to try and imply licenses left and right, when the derivative work right simply over-protects authors’ copyrighted works. What remains is that the derivative work right can only independently protect against less than substantial copying of copyright protected works, and against unfixed, non-public displays and performances of

¹³⁶ *Peter Pan Fabrics, Inc.*, 274 F.2d at 489.

¹³⁷ 2 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 8.09[A] (1978 & Supp. 2008); see also Tyler T. Ochoa, *Copyright, Derivative Works and Fixation: Is Galoob A Mirage, or Does the Form(Gen) of the Alleged Derivative Work Matter?*, 20 SANTA CLARA COMPUTER & HIGH TECH. L.J. 991, 1020 (2004) (stating “[m]y interpretation is simply this: the exclusive right to prepare derivative works is *not* independent of the other four exclusive rights, but is infringed only in conjunction with at least one of the other four exclusive rights.”). Professor Ochoa’s analysis pointed out the fact that this interpretation “leaves all private performances of a derivative work, whether fixed or unfixed, outside the realm of copyright infringement.” *Id.*

¹³⁸ NIMMER & NIMMER, *supra* note 137, at § 8.09[A].

copyright protected works.

III. AN EXAMINATION OF THE DERIVATIVE WORK RIGHT.

Pursuant to a legislative report written with respect to the Copyright Act of 1909, “[i]n enacting a copyright law Congress must consider . . . two questions: First, how much will the legislation stimulate the producer and so benefit the public, and, second, how much will the monopoly granted be detrimental to the public?”¹³⁹ Where the interests of authors and the public conflict, the public’s interests must prevail.¹⁴⁰ The following subsections analyze the appropriateness of the derivative work right¹⁴¹ in accordance with this proffered test.

Back in 1879, the Supreme Court wisely stated that “[t]he very object of publishing a book on science or the useful arts is to communicate to the world the useful knowledge which it contains. But this object would be frustrated if the knowledge could not be used without incurring the guilt of piracy of the book.”¹⁴² For this reason, the Copyright Act expressly excludes the protection of ideas and leaves the protection of ideas to patent law.¹⁴³ Yet, courts already apply the substantial copying test, which accounts for both the level of qualitative and quantitative copying incorporated into a subsequent work.¹⁴⁴ Hence, the only insubstantial copying that could plausibly remain is the copying of ideas.

Granting copyright protection to non-public performances and displays and in ideas can only inhibit the progress of science in violation of the Copyright Act’s purpose.¹⁴⁵ Potential authors face too high of a risk of infringement and have little inspiration to grow their creative vines. In conclusion, the

¹³⁹ REPORT OF THE REGISTER 1961, *supra* note 7, at viii (quoting H.R. REP. NO. 60-2222 (1909)).

¹⁴⁰ *Id.* at 6.

¹⁴¹ Keep in mind that this section was written with the opinion and under the assumption that mounting legally purchased works onto ceramic tiles or into frames without making any unauthorized reproduction or physical alteration of the works will not constitute derivative work infringement, especially in lieu of the first sale doctrine. *See Precious Moments, Inc. v. La Infantil, Inc.*, 971 F. Supp. 66 (D.P.R. 1997); *cf. Mirage Editions, Inc. v. Albuquerque A.R.T. Co.*, 856 F.2d 1341 (9th Cir. 1988).

¹⁴² *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 350 (1991) (quoting *Baker v. Seldon*, 101 U.S. 99, 103 (1880)).

¹⁴³ 17 U.S.C. § 102(b) (2006) (“In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”).

¹⁴⁴ *Rogers v. Koons*, 960 F.2d 301, 307 (2d Cir. 1992); *see also Heineman, supra* note 129, at 255 (providing a summary of substantial similarity test analysis).

¹⁴⁵ U.S. CONST. art. I, § 8, cl. 8.

2013]

THE DERIVATIVE WORK RIGHT

derivative work right is an illegitimate right that must be a subset of authors' exclusive rights to reproduce, perform, and display their work. As such, it should be shelved as a rudimentary learning block that no longer serves its purpose.

Many cases have found that plaintiffs must prove substantial similarity in derivative work actions to establish infringement, which is exactly how standard reproduction infringement cases are determined.¹⁴⁶ Thus, getting rid of the derivative work right will simplify copyright infringement cases and for the most part not change the legal infringement analysis that courts apply. The derivative work right is redundant and confusing. Justice Story in *Emerson* stated:

Every book in literature, science and art, borrows, and must necessarily borrow, and use much which was well known and used before. No man creates a new language for himself, at least if he be a wise man, in writing a book. He contents himself with the use of language already known and used and understood by others. No man writes exclusively from his own thoughts, unaided and uninstructed by the thoughts of others. The thoughts of every man are, more or less, a combination of

¹⁴⁶ *Mulcahy v. Cheetah Learning LLC*, 386 F.3d 849, 853 (8th Cir. 2004) (overturning district summary judgment decision of non-infringement because condensing “the qualitative core of one marketable portion” of a multi-purpose copyright protected work can constitute substantial similarity infringement). The district court had found that the works had “many substantive details in common,” but had found no infringement because they were functionally different. *Mulcahy v. Cheetah Learning LLC*, No. Civ. 02-791(PAM/RLE), 2003 WL 21909570, rev'd in part by 386 F.3d 849 (8th Cir. 2004). Whether works “function” differently is a fair use question. See *Greenbie v. Noble*, 151 F. Supp. 45, 69 (S.D.N.Y. 1957) (similarly conflating infringement and the equitable defense for fair use); *Well-Made Toy Mfg. Corp. v. Goffa Int'l Corp.*, 354 F.3d 112 (2d Cir. 2003) (rejecting plaintiff's argument that defendant's doll infringed its derivative work right even though it was undisputed that it was not a substantial copy of plaintiff's work); *Atkins v. Fischer*, 331 F.3d 988 (D.C. Cir. 2003) (requiring that a derivative work be substantially similar to preexisting work to constitute an infringement); *Dun & Bradstreet Software Servs., Inc. v. Grace Consulting, Inc.*, 307 F.3d 197 (3rd Cir. 2002) (rejecting de minimis copying defense when derivative work was admittedly created from defendant's literally copying plaintiff's work); *United States v. Manzer*, 69 F.3d 222, 227 (8th Cir. 1995) (holding that “Manzer infringed on the copyright by preparing one or more derivative works or computer programs, or by reproducing or selling unauthorized copies of the computer program” when “the computer files sold by Manzer were more than seventy-percent similar to the copyrighted software”); *Kindergartners Count, Inc. v. Demoulin*, 249 F. Supp. 2d 1214, 1229 (D. Kan. 2003) (stating that “supersubstantial similarity” is the test for infringement when dealing with works entitled to only thin copyright protection); *Eden Toys, Inc. v. Florelee Undergarment Co.*, 697 F.2d 27 (2d Cir. 1982) (holding that defendant did not infringe plaintiff's Paddington bear picture that substantially copied another author's Paddington bear picture with the other author's authorization).

what other men have thought and expressed, although they may be modified, exalted, or improved by his own genius or reflection.¹⁴⁷

If all creative works in existence include portions of preexisting works, then there is no justifiable purpose for having the separate, exclusive derivative work right. What makes more sense is retaining the derivative work right as a subset incorporated into all of the other rights to give authors the continued flexibility to separately retain derivative revision rights when entering into licensing agreements.

Whereas, keeping the derivative work right as a separate exclusive will only give authors the incentive to try to push the envelope to expand their copyright protection into the protection of their ideas. For example, in *Madrid v. Chronicle Books*, the plaintiff was an author of a one-page poem who claimed that the movie, *Monster's, Inc.*, infringed her poem because she could prove that the defendant producing company had access to her poem prior to producing the film.¹⁴⁸ This case illustrates the rare instance when a derivative work right infringement could be separately claimed from a reproduction right infringement because the plaintiff admitted that “no similarities [were] readily apparent between her poem and *Monsters, Inc.*”¹⁴⁹ The District Court of Wyoming, however, found that there was no derivative work right infringement because plaintiff could not prove any substantial similarity between the two works. This case illustrates the potentially harmful effect of the separate derivative work right in action. With more close calls like *Madrid*, courts and authors may begin to wonder whether Congress really meant to give the derivative work right such a wide breadth of copyright protection in addition to authors other exclusive rights. Courts perilously may start to find infringement in cases like *Madrid*.

The derivative work right provides potential authors with less incentive to create new works because it subjects them to infringement actions when they have only insubstantially copied from preexisting works. In contrast, existing authors only have the capacity to produce a limited span of creative works in their lifetime so that flooding such authors with additional incentives could only allow limited, creative incentives. Providing incentive to everyone within the scope of people's limited lifetime resources practically outweighs granting extra incentives to only certain individuals.

The following is a non-exhaustive list of possible resolutions to derivative work rights impermissibly protecting ideas:¹⁵⁰ (1) requiring authors to comply

¹⁴⁷ Heineman, *supra* note 129, at 238, n.16 (quoting Emerson v. Davies, 8 F. Cas. 615, 619 (C.C.D. Mass. 1845)).

¹⁴⁸ *Madrid v. Chronicle Books*, 209 F. Supp. 2d 1227 (D. Wyo. 2002).

¹⁴⁹ *Id.* at 1235.

¹⁵⁰ Other proposed resolutions by professionals in the field include: (1) “impos[ing] a standard of infringement that would require the copyright owner to show exact or nearly exact duplication of the underlying work”; (2) “creat[ing] a doctrine parallel to the ‘blocking

2013]

THE DERIVATIVE WORK RIGHT

with compulsory licenses for allowing derivative authors to create derivative works that do not substantially resemble (works cannot copy) the original copyrighted work;¹⁵¹ (2) devising exceptions to the derivative work right; (3) applying a more lenient fair use defense in the cases of unauthorized derivative works that are not substantial copies of an original copyrighted work; and (4) getting rid of the separate derivative work right, while allowing other areas of law to balance any remaining legal issues such as trademark and unfair business practice law.

Few works are purely original works. Thus, it would likely be too cumbersome and erratic to implement options 1 and 2. Option 3 is also not desirable because derivative works will not infringe alike, especially considering the widespread copyright subject matter involved. Requiring potential authors to have to defend themselves under the fair use doctrine without justification impracticably destroys their incentives to create any new derivative works to the public's detriment. It also unfairly grants original authors additional protection without giving them any additional incentive to develop new works.

Option 4 appears to make the most sense under the circumstances. Deleting the separate derivative work right would prevent future encroachments on ideas and confusion in the application of copyright law. As pointed out by Nimmer's characterization of the derivative work right as "superfluous,"¹⁵² an unauthorized derivative work automatically violates the author's reproduction, performance, or display right so long as it is substantially similar to the original protected work.¹⁵³

To optimize progress, the Copyright Act must provide incentive to existing and future authors alike to produce and disclose as much original work to the public as possible. Currently, all of the other exclusive rights besides the derivative work right already require substantial copying. By implication,

patent' rule, which provides patent protection for inventions added to already patented inventions while still holding that new inventor liable for infringing the existing patent"; and (3) basing derivative work right infringement determination on whether the use of the preexisting work was a customary use. Amy B. Cohen, *When Does A Work Infringe the Derivative Works Right of a Copyright Owner*, 17 *CARDOZO ARTS & ENT. L.J.* 644-45 (1999) (citing to Glynn Lunney, Jr., *Reexamining Copyright's Incentives-Access Paradigm*, 49 *VAND. L. REV.* 483, 650 (1996); Mark A. Lemley, *The Economics of Improvement in Intellectual Property Law*, 75 *TEX. L. REV.* 989, 1000-13 (1997)).

¹⁵¹ "[W]hen a music composer allows a composition to be recorded and distributed to the public, anyone else may record and distribute that composition, provided that a statutory royalty is paid and minimal notice requirements are satisfied." Scott L. Bach, Note, *Music Recording, Publishing, And Compulsory Licenses: Toward A Consistent Copyright Law*, 14 *HOFSTRA L. REV.* 379 (1986).

¹⁵² NIMMER & NIMMER, *supra* note 137, § 8.09[A].

¹⁵³ Courts should simply vary the remedies for copyright infringement in furtherance of the Constitution's purpose to promote the progress of science.

literal copying is not necessary for copyright infringement of the reproduction right, distribution right, performance right, and display right, each of which thereby incorporate the derivative work right when an action involves unauthorized, substantial copying. Thus, all that is left is a derivative work right that could only remain “exclusive” by protecting an author’s right to *insubstantially* copy and create derivative works based upon such insubstantial copying.

Based on the foregoing, the grant right should be revised to expressly state that the derivative work right is a subset right of each of the other enumerated rights, so that authors can continue to separately license or retain their subset derivative work rights when entering into contractual relationships.¹⁵⁴ Getting rid of the derivative work right would promote the creation of more works merely because people would no longer be deterred from creating any and all derivative works from other authors’ works based upon the prohibitive language of the Copyright Act. With the possibility of increased derivative works, courts would continue to have to contend with the difficulty of distinguishing between substantial copying and the copying of ideas, which is a fact finding question the courts have now been resolving ad hoc for over two centuries.¹⁵⁵ The increased proliferation of derivative works might temporarily increase the amount of litigation over copyright cases because potential infringers might initially believe that they can create derivative works containing unauthorized substantial copying of preexisting works without infringing. Once the fog clears, however, the public will be left with more intellectual enrichment to choose from.

IV. NEW COPYRIGHT PROTECTION OF INFRINGING DERIVATIVE WORKS.

Early on, works were not as widely circulated as they are now, and infringers were therefore not as likely to get caught infringing. For example, infringers could strategically limit their distribution of an infringing work to certain states to avoid the original copyright owner’s learning of the infringement. In contrast, copyright owners have had a difficult time acquiring name recognition to position their commercial advantage and less means to monitor potential infringement problems. In the balance, a potential infringer had significant incentive to risk infringement of an original work in return for earning profits at hardly any expense because they were not likely to get caught infringing. At the time, Congress may not have even contemplated the possibility that people could copy minor portions of a copyrighted work and then incorporate substantial originality to an arguably new, derivative work.

¹⁵⁴ Recall that part of the rationale underlying the 1870 Act that first began to recognize authors’ ability to reserve their rights to “*dramatize or to translate*” their works to enable authors such licensing opportunities. Act of July 8, 1870, ch. 230, 16 Stat. 198, 212 (emphasis added).

¹⁵⁵ *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).

2013]

THE DERIVATIVE WORK RIGHT

Lack of efficient enforcement measures may have even precluded such a situation from practically coming to a head for some time.

On February 15, 1819, Congress extended jurisdiction to the circuit courts to “grant injunctions according to the course and principles of courts of equity, to prevent the violation of the rights of any authors or inventors, secured to them by any laws of the United States”¹⁵⁶ Granting the courts the power to enter injunctions against infringers from selling infringing works added a greater deterrent against potential infringers’ risking time and money to create a copyright-protected derivative work that could be taken away from them entirely upon a finding of infringement. Nevertheless, it was unclear what should happen to the enjoined derivative work, i.e., whether it would be enjoined from public distribution forever because it was owned by the derivative infringer or transferred to the original copyright owner as a matter of equitable fairness. The Constitution and Copyright Act certainly never anticipated that copyright protection would permanently foreclose the disclosure of original works to the public, because copyright law was born from the founders’ goal of proliferating creativity and knowledge.¹⁵⁷ Thus, the question of what to do with these unequivocally infringing works remained unanswered.

A. *The 1831 Copyright Act.*

Story v. Holcombe held that defendant Holcombe’s first 100 pages in his book infringed plaintiff Story’s book, but the defendant’s subsequent 200 pages was copyrightable material despite the infringement.¹⁵⁸ “To amount to an infringement, it is not necessary that there should be a complete copy or imitation in use throughout; but only that there should be an important and valuable portion which operates injuriously to the copyright of the plaintiff.”¹⁵⁹ Thus, “a book may, in one part of it, infringe the copyright of another book, and in other parts be [sic] no infringement; and in such a case, the remedy will not be extended beyond the injury.”¹⁶⁰

A book author could hypothetically copy verbatim another author’s poem within one page of his or her 300 page novel that otherwise is comprised of completely original material. To find that the author not only infringes the poem but also loses any right to copyright protection would be inequitable. The incorporation of infringing material into an abundantly original work should not necessarily preclude the author from receiving any copyright

¹⁵⁶ Act of Feb. 15, 1819, ch. 19, 15 Stat. 481.

¹⁵⁷ U.S. CONST. art. I, § 8, cl. 8.

¹⁵⁸ *Story v. Holcombe*, 23 F. Cas. 171, 175 (C.C.D. Ohio 1847) (holding that an abridgement is not a bona fide abridgement if it impairs the value of the original work, but instead constitutes an infringing “compilation”).

¹⁵⁹ *Id.*

¹⁶⁰ *Id.*

protection nor from disclosing it to the public.

Unlike *Story*, the *Stowe* court found no infringement in the translation of the original Uncle Tom's Cabin, thereby avoiding the potentially difficult task of parsing out which portions infringed, and which translation portions were copyrightable non-infringement. This decision seems reasonable, because a translation inexorably comprises the preexisting work and the derivative translation intertwined together, making it extremely difficult to draw lines between where the infringement ends and where the new derivative work originality begins. Either the plaintiff had to win or the defendant had to win and acquire copyright protection in the translated originality. Of course, as mentioned earlier, the 1870 Act subsequently granted authors the right to reserve their ability to translate their own works into other languages. Although the decision was contrary to the 1870 Act because it was decided under the 1831 Act, *Stowe* soundly considered the importance of leaving the public free to criticize and comment on creative works.¹⁶¹ The court's finding of non-infringement may have also been related to the fact that derivative works tend to be less competitive in the marketplace with the original work than literal copy infringements. Finally, the decision logically rested on the fact that translations require substantial labor, the fruits of which provided the public with more widespread disclosure of Uncle Tom's Cabin, a historically renowned and treasured novel.

B. *The 1870 Copyright Act.*

After the enactment of the 1870 Act, in *Kalem Co. v. Harper Brothers*, defendant movie maker's counsel advocated that the *Stowe* court based its decision on the belief that the German translation did not constitute a "copy" of the original Uncle Tom's Cabin.¹⁶² Defendant Kalem Co. further argued that it did not dramatize plaintiff's novel when it created its movie based upon the novel instead of exhibiting a live dramatization of the novel with live actors.¹⁶³ The Supreme Court rejected defendant's position, holding that "moving pictures are only less vivid than reflections from a mirror."¹⁶⁴ Thus, the Supreme Court upheld the injunction, recognizing movies as a "known form of reproduction" that violated plaintiff's copyright.¹⁶⁵

Pursuant to the 1870 Act, the *Kalem Co.* court had the discretion to order an injunction. The Court should have weighed the appropriateness of such a harsh remedy when the defendant moviemaker likely contributed substantial

¹⁶¹ The public has the right to "oppose its [a work's] sentiments." *Stowe v. Thomas*, 23 F. Cas. 201, 207 (C.C.E.D. Pa. 1853).

¹⁶² *Kalem Co. v. Harper Bros.*, 222 U.S. 55, 55 (1911) (applying the 1870 Act after the 1909 Act had already been enacted).

¹⁶³ *Id.* at 62.

¹⁶⁴ *Id.* at 61.

¹⁶⁵ *Id.* at 63.

2013]

THE DERIVATIVE WORK RIGHT

originality to its infringing movie. Instead, the public lost access to the creative movie. The Court correctly found that the defendant infringed, because the defendant never denied substantially copying from the novel. However, the Court stripped the defendant of any separate copyright protection or right to disclose his movie without even considering the practical ramifications of such a decision. Damages for the infringement may have been the better remedy in the interest of promoting the progress of science, depending upon the amount and severability of the originality contributed to the movie. Moreover, the defendant should have arguably received copyright protection in the movie subject to a compulsory license. A losing defendant is not likely to help the opposing plaintiff copy his or her movie so that the plaintiff can unfairly take all of the credit and profits under his or her original copyright protection. Thus, without any copyright protection, a derivative author is inclined to keep the movie out of the public's eye.

C. The 1909 Copyright Act.

Congress addressed whether an infringing author qualifies for copyright protection in section 6 of the 1909 Act as follows:

[c]ompilations or abridgements, adaptations, arrangements, dramatizations, translations, or other versions of works in the public domain, *or of copyrighted works when produced with the consent of the proprietor of the copyright in such works, or works republished with new matter*, shall be regarded as new works subject to copyright under the provisions of this Act¹⁶⁶

In this section, Congress limited “new” derivative work copyright protection to “versions of works in the public domain” and to “copyrighted works when produced with the consent of the proprietor of the copyright in such works.”¹⁶⁷ Thus, an unauthorized derivative author did not qualify for new copyright protection under the 1909 Act.

Authorized derivative works and works derived from public domain works were and are typically required to contain substantial new originality to qualify for any copyright protection.¹⁶⁸ In *Douglas International Corp. v. Baker*, the

¹⁶⁶ Copyright Act of 1909, ch. 320, 35 Stat. 1075, 1077 (1909) (previously codified at 17 U.S.C. §§ 1–216) (emphasis added).

¹⁶⁷ *Id.*

¹⁶⁸ *Gracen v. Bradford Exch.*, 698 F.2d 300, 305 (7th Cir. 1983) (stating that the originality requirement for derivative works must be broader than for original works because “the purpose of the term in copyright law is not to guide aesthetic judgments but to assure a sufficiently gross difference between the underlying and the derivative work to avoid entangling subsequent artists depicting the underlying work in copyright problems.”); *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 910 (2d Cir. 1980) (holding that the “mere reproduction of a work of art in a different medium” did not meet the derivative originality requirement).

Southern District Court of New York found that the defendant substantially copied from and infringed plaintiff's copyright-protected book when he adapted the book into a play.¹⁶⁹ The defendant alleged, among other arguments, that he should not be enjoined from producing his play because like derivative works from public domain works, his play contained substantially new originality that should qualify for copyright protection. The court disposed of this claim, stating that "[t]he fact that certain parts of Baker's play may be novel and original does not allow the defendants to incorporate therein copyrighted materials belonging to plaintiffs."¹⁷⁰

With regard to derivative work injunctions, the defendant and the court in *Douglas International Corp.* both failed to consider how section 6 of the 1909 Act should be applied under the facts of the case. Nevertheless, the court followed section 6 when it held that the defendant's new originality in the unauthorized play did not affect plaintiff's "subsisting copyright" in the underlying book. Unlike the entire language translation in *Stowe*, however, it was not clear how much of the originality in the adapted play was intertwined with the infringing material from the copyright-protected book. It was also unclear if the new originality added was more significant than the infringing portions taken from the book. Hence, like in *Kalem*, the court did not weigh the equities before concluding that an injunction of the play was the appropriate remedy for the infringement.

D. *The 1976 Copyright Act.*

Pursuant to the 1976 Act, "protection for a work employing preexisting material in which copyright subsists does not extend to any *part* of the work in which such material has been used unlawfully."¹⁷¹ Unlike the 1909 Act, the statute reasonably excludes copyright protection in the unlawful "part[s]"¹⁷² of a derivative work instead of withholding copyright protection in the derivative work entirely.

¹⁶⁹ *Douglas Int'l Corp. v. Baker*, 335 F. Supp. 282 (S.D.N.Y. 1971).

¹⁷⁰ *Id.* at 285.

¹⁷¹ 17 U.S.C. § 103(a) (2006) (emphasis added).

¹⁷² The courts are currently in conflict over whether an infringing derivative work may qualify for some copyright protection in its original expression under the Copyright Act. Compare *Picket v. Prince*, 207 F.3d 402, 406 (7th Cir. 2000) (stating in dicta that 103(a) does not grant copyright protection to derivative authors who incorporate infringing preexisting materials into their works), with *Eden Toys, Inc. v. Florelee Undergarment Co.*, 697 F.2d 27, 34 n.6 (2d Cir. 1982) (implying that an infringing derivative work could qualify for some copyright protection if the infringing authorized use does not "pervade" the derivative work). I agree with *Picket* to the extent that 103(a) was not intended to authorize anyone to infringe preexisting works or to qualify for copyright protection in the "parts" of their works that embody such infringements. However, the "parts" that are non-infringing are not disqualified from copyright protection under the Copyright Act.

Even though the 1976 Act more flexibly allows copyright protection in the non-infringing portions of infringing derivative works, the problem still remains that courts are too quickly inclined to enjoin infringing derivative works.¹⁷³ A creative distinction exists between infringing derivative works that contain insubstantial originality and those that contain substantial, new originality. Courts should weigh the relative infringement and new originality added to balance the interests of authors, prospective authors, and the public. Remedies need to keep pace with balancing authors' incentives when the sharing of creativity is in abundance, especially when it can be unmanageably difficult for authors to locate all potential preexisting authors to obtain their consent. Thus, a movie with 38 scenes may contain an infringing derivative work from a book in only two of the 38 scenes.¹⁷⁴ Yet, from a remedy standpoint, a court must not ignore the remaining original 36 scenes of the movie when determining whether an injunction of the two scenes is an appropriate remedy for the derivative infringements.

To remedy the remedy issue, courts should weigh the following factors: (1) the extent of relative new originality added in comparison to the substantial copying taken; (2) how much the new originality is entangled with the substantial copying taken; (3) the creativeness or independent public value of the derivative work generally;¹⁷⁵ (4) whether the derivative work is a transformative use of the original work; and (5) whether an injunction furthers the progress of science or hinders it. Damages are the appropriate remedy when an injunction would give the preexisting work an unjustified monopoly on the subsequent derivative work.¹⁷⁶

¹⁷³ Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 202 (1998); see also Dennis S. Karjala, *Harry Potter, Tanya Grotter, and the Copyright Derivative Work*, 38 ARIZ. ST. L.J. 17, 39 (2006) ("The most obvious way for national courts to limit authorial control is to be more cautious about injunctions against the distribution of creative derivative works involving protected characters in new stories.").

¹⁷⁴ Keep in mind that this problem is not limited to infringing "derivative" works, but also to infringing subsequent works. For example, a work that synchronizes a song along with a scene from a movie, without revising the song. Again, derivative works cannot infringe unless they infringe one of the other exclusive rights anyway. Therefore, the remedy determination should be handled in the same manner, whether the infringing work is derivative or not.

¹⁷⁵ See Dennis S. Karjala, *Copyright and Misappropriation*, 17 U. DAYTON L. REV. 885, 889 (1992) (noting that complete failure to account for the effort and social desirability of works that contain minimal or no new originality stifles creative incentives).

¹⁷⁶ In 1992, the Supreme Court overturned the "sweat of the brow" doctrine and, for the first time, ruled that besides meeting the requirements of original authorship and fixation, works must also contain a minimum level of creativity to qualify for copyright protection. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991). The Court stated that works must contain sufficient originality to qualify for copyright protection, but it does not

When dealing with highly creative derivative works, courts should be more predisposed to grant only damages instead of injunctions. Any new copyright protection in the untainted parts of a derivative work that contains substantially new originality should be entitled to copyright protection according to section 103(a) of the Copyright Act. As such, enjoining these derivative works inappropriately destroys any copyright protection in the new originality.

In contrast with most cases, injunctions may sometimes be the more appropriate remedy for derivative advertising infringements and sequel infringements of highly creative works from both a moral authorship and creative incentive standpoint. For example, in *Video Pipeline, Inc. v. Buena Vista Home Entertainment, Inc.*, Video Pipeline purchased retail copies of Buena Vista movies, then copied and created derivative work trailers of the movies without Buena Vista's authorization in purported violation of the parties' licensing agreement.¹⁷⁷

Popular creative works like movies are more at risk for being misappropriated via unauthorized advertising. Opportunistic infringers are likely to try to find illegal access to such original works, easily manipulate the works, capitalize on the works' popularity to profit on unrelated products or services, and dilute the genuine marketing scheme of the original works. Under these circumstances, it is important to keep highly creative authors living in fear that people will pounce on their work the moment it is disclosed to the public. In the balance, subsequent authors are still left with the lawful ability to insubstantially copy from such works for first sale doctrine purposes.

Like the high risk involved in derivative work advertising infringement, sequels¹⁷⁸ are usually only created when a particular work is highly successful.¹⁷⁹ For example, opportunistic infringers may try to create their own subsequent movie sequel based on the movie the Matrix Trilogy, indirectly play it off as a continuance of the Matrix, and interfere with genuine sequels of the Matrix. This is because the value of the "expression" in the Matrix does not revolve around just wearing black suits and sunglasses while

hold that the amount of work a copyright holder put into an original work or an infringing person put into a subsequent work is unrelated to copyright remedies. *Id.* at 359–60.

¹⁷⁷ *Video Pipeline Inc. v. Buena Vista Home Entm't*, 210 F. Supp. 2d 552, 555 (D.N.J. 2002).

¹⁷⁸ The "Game Genie" that gave game players extra lives in *Lewis Galoob Toys, Inc. v. Nintendo of America, Inc.* is not the type of broad definition of "sequel" that I have in mind in this context because even if the court had found infringement, the number of player lives available was not the highly creative portion of the Nintendo game. *Lewis Galoob Toys, Inc. v. Nintendo of America, Inc.*, 964 F.2d 965, 967 (9th Cir. 1992).

¹⁷⁹ *See, e.g., TMTV, Corp. v. Mass Prods., Inc.*, 345 F. Supp. 2d 196, 209 (D.P.R. 2004) (holding that defendants violated plaintiff's derivative work right by substantially copying from plaintiff's television show and leading viewers to believe that "they would merely have to tune to another television station to continue watching the same sitcom.").

2013]

THE DERIVATIVE WORK RIGHT

performing martial arts, the value also comprises of the public's trust in the quality of Warner Brothers's Matrix products. Therefore, copyright injunctions should maybe be more readily available in these infringement cases. It would not be productive for movie producers to waste resources on fighting with others to produce a sequel to their already successful movie.

V. CONCLUSION

Congress incrementally incorporated the derivative work right into the Copyright Act. What distinguishes derivative work infringements from reproduction infringements is that derivative works tend to emanate greater fair use characteristics. As such, it is arguable that unauthorized derivative authors should be given more leniency than other infringing defendants. Instead, the United States Copyright Act inappropriately grants authors an exclusive derivative work right that broadly protects ideas while the other enumerated rights already protect against insubstantial copying, and non-fixed public displays and performances of preexisting works. Congress needs to remove the exclusive derivative work right language from the Copyright Act to prevent courts from confusing the scope of copyright protection under copyright claims based solely on infringement of the author's derivative work right.¹⁸⁰ It would also prove helpful for Congress to clarify that the derivative work right is a subset right of all of the other enumerated rights.

The earlier courts factored how much new originality defendants added to their derivative works into finding infringement or non-infringement of a preexisting work.¹⁸¹ Before ordering injunctions on infringing derivative works, courts should similarly consider: (1) the extent of relative new originality added in comparison to the substantial copying taken; (2) how much the new originality is entangled with the substantial copying taken; (3) the creativeness or independent public value of the derivative work generally; (4) whether the derivative work is a transformative use of the original work; and (5) whether an injunction furthers the progress of science or hinders it.

The policy of the Copyright Act is to maximize all prospective authors' incentives to create new works and share them with the public. From a global standpoint, granting too much copyright protection to commercial markets under an exclusive derivative work right will cause one of two undesirable results. Either the rest of the world will follow suit with the United States and everyone in the world will lose exposure to a wider array of creative "derivative" works, or the United States standing alone will lose a significant competitive edge against its global counterparts to provide extravagant protection to copyright owners. Cultures and civilizations are built upon creative works, which are built from past creative works. In conclusion, in

¹⁸⁰ See, e.g., *Madrid v. Chronicle Books*, 209 F. Supp. 2d 1227, 1236 (D. Wyo. 2002).

¹⁸¹ See, e.g., *Folsom v. Marsh*, 9 F. Cas. 342, 348 (C.C.D. Mass. 1841).

present legislative form and injunctive practice, the derivative work right provides no further incentive to potential authors and could potentially hinder our blossoming culture and civilization in the race to coin every corner of the market.