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DERIVING ORIGINALITY IN DERIVATIVE WORKS: CONSIDERING THE QUANTUM OF ORIGINALITY NEEDED TO ATTAIN COPYRIGHT PROTECTION IN A DERIVATIVE WORK

Steven S. Boyd*

"[T]here is no new thing under the sun."

I. INTRODUCTION

Innovations in science and technology constantly expand the concept of creative expression, yielding media never before contemplated. These novel and diverse forms of expression continue to challenge the boundaries of the existing rubric of copyright laws by forcing jurists and scholars to reconsider fundamental concepts of intellectual property protection, such as originality in copyright law, in the context of cutting edge media. At times, the legal community must

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3. See J. Lahore, Reprography Reproduction, in INFORMATION TECHNOLOGY: THE CHALLENGE TO COPYRIGHT (J. Lahore ed., 1984) (“In no branch of the law other than copyright has the incidence of new technologies revealed so many gaps and deficiencies for which the remedy can only be regulation and supervision [by the legislature].”) (quoting Comment on the Review of Audiovisual Copyright Law in Australia, 56 Austl. L.J. 621, 622 (1982)); David Ladd, Securing the Future of Copyright: A Humanist Endeavor, 9 Colum.-VLA J.L. & Arts 413, 414 (1985); Michael Wurzer, Note, Infringement of the Exclusive Right to Prepare Derivative Works: Reducing Uncertainty, 73 Minn. L. Rev. 1521, 1524 n.16 (1989) (offering that technological innovation is a problem that will always affect copyright law) (citing Sony Corp. v. Universal Studios, 414
modify existing boundaries to accommodate technology, demonstrating that copyright law is not written in stone but, to the contrary, is a morphing set of rules designed to adapt to modern applications.

When viewing copyright law at its most fundamental level, two concepts form the threshold for receiving copyright protection. First, a work must be an “original work of authorship.” Second, the work must be “fixed in any tangible medium of expression, now known or later developed, from which it can be perceived, reproduced, or otherwise communicated,” with or without “the aid of a machine or device.”

From this basis, the two touchstones of copyright protection—“originality” and “fixation”—continue to develop distinct meanings peculiar to the law of copyright. Focusing on the prerequisite of originality, courts repeatedly hold that a work is original if the author independently created the work and the work “possesses at least some minimal degree of creativ-

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U.S. 417, 430 (1983)).


(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

(1) literary works;
(2) musical works, including any accompanying words;
(3) dramatic works, including any accompanying music;
(4) pantomimes and choreographic works;
(5) pictorial, graphic, and sculptural works;
(6) motion pictures and other audiovisual works;
(7) sound recordings; and
(8) architectural works.

(b) 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.

Id.

6. See NEIL BOORSTYN, BOORSTYN ON COPYRIGHT 2-2 (Supp. 1995 & 1996). But see Universal Athletic Sales Co. v. Salkeld, 511 F.2d 904, 908 (3rd Cir. 1975) (“It is true that originality is not a prerequisite of copyright, and even a modicum of creativity may suffice for a work to be protected.”) (emphasis added).
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ity."7 Even at this most fundamental level of copyright law, courts continually struggle to resolve the friction between traditional concepts of copyright protection and the increasingly innovative applications of those concepts.

This article encapsulates the subtleties that have developed throughout the courts' progress in defining the essential concept in copyright law known as originality—specifically the originality required in derivative works.6 Initially, this article introduces the basic concept of originality, describing the constitutional and statutory framework that grants courts the authority to mold its meaning and application.9 After filtering out the integrated ideas of novelty and creativity from the distinct requirement of originality,10 the focus of this article shifts to the quantum of originality necessary to attain copyright protection.11 Although proof of a quantum of originality serves as a threshold requirement for any work seeking copyright protection,12 this discussion ultimately focuses on the vacillating quantum of originality necessary to secure copyright protection in the emerging arena of derivative works.13 Finally, the discussion proffers a proposal for simpli-

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7. See, e.g., Feist Publications, 499 U.S. at 345; Mitel, Inc. v. Iqtel, Inc., 124 F.3d 1366, 1373 (10th Cir. 1997).
9. See infra Parts I.A and I.B.1–2 (discussing the fundamental and statutory bases for copyright protection).
10. See infra Part I.B.3–4 (distinguishing originality from the concepts of novelty and creativity).
11. See infra Part II (introducing the basis of copyright law and addressing the rudimentary concerns in copyright law).
13. See infra Parts III and IV (illustrating the development and nuances in assessing the quantum of originality needed to attain protection in a derivative work, regardless of the public domain status of the underlying work). As stated in 17 U.S.C. § 101:

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

fying the copyright application process, requiring the same quantum of originality to attain copyright protection in a derivative work, regardless of the status of the work.14

A. The Sine Qua Non of Copyright

"A prime requisite for copyright protection under the Constitution is originality."15 As Justice O'Connor stated in Feist Publications v. Rural Telephone Service Co., "[t]he sine qua non of copyright is originality."16 Even a cursory review of concepts inherent to copyright protection establishes originality as the very essence of protection. Throughout copyright jurisprudence, the originality requirement remains the single pervading prerequisite to copyright protection, regardless of the form of work.17

Originality is itself a fluid concept, not an objective criterion. Therefore it is constantly being refined by the courts. As a starting point for analyzing originality, it can be described as a foundation for protection,18 requiring that a given work be original to the author.19 Because originality flows from the efforts of a particular author, it necessarily follows that an original work must not be more than a mere copy.20 The work must embody some modest amount of individual intellectual labor in order to qualify as a "work of authorship" entitled to copyright protection.21

Although originality appears to be objective in nature,
various interpretations of artistic originality have developed, proving the difficulty in examining this multifaceted concept. For example, as a threshold matter, artistic originality does not equate to the legal concept of originality in the Copyright Act.22 As Circuit Judge Frank stated in *Alfred Bell & Co. v. Catalda Fine Arts*,23 "[n]o matter how poor artistically the 'author's' addition, it is enough if it be his own."24 Courts struggle to adapt the concept of originality to increasingly complex and novel scenarios. However, the intricacies of originality require the exploration of the evolution leading to the modern interpretation of originality. Such analysis begins with the basis of the authority granting the judiciary the power to take these evolutionary steps—the Constitution of the United States—and its role in copyright law.

B. The Constitutional Underpinnings of Originality

The authors of the Copyright Act of 1976 ("Copyright Act") drafted it both to reward the creators of copyrighted works and to promote "broad public availability of literature, music, and the other arts."25 However, before reaping the benefits of such protections, a copyright seeker must satisfy certain requirements. One such requirement, originality, is both a statutory and constitutional prerequisite for copyright protection.26 Rather than reviewing a work in terms of the labor or effort involved in its creation, statutory and common law developments have focused on originality as the fundamental basis for receiving copyright protection.27 This belief that a person should be rewarded for his or her contribution to society is supported by the Constitution, which provides for

22. See *Gracen v. Bradford Exch.*, 698 F.2d 300, 304 (7th Cir. 1983) ("Artistic originality indeed might inhere in a detail, a nuance, a shading too small to be apprehended by a judge.").
24. *Id. at 103* (citing *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 239 (1903)).
Congress’s authority to encourage creative activity by rewarding the author with the potential for monetary gain. “The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in ‘Science and useful Arts.’”

The Constitution empowers Congress “[t]o promote the Progress of Science . . . by securing for limited times to Authors . . . the exclusive Right to their respective Writings . . . .” The statement of a copyright’s purpose in the Constitution indicates its two correlative functions. First, copyright law encourages authors to create and publish their works by granting them a monopoly over the economic exploitation of their works. Second, it ensures a constant source of new works for the public. This promotes thought and assures that the works eventually will be free for others to use to create further new works. Considering these correlative functions, the Supreme Court defined “authors” and “writings” in two decisions from the late nineteenth century. The Court continues to hold that these cases presuppose a degree of originality.

1. Originality in “Writings” from the Trade-Mark Cases

In the Trade-Mark Cases, the Supreme Court addressed the constitutional scope of “writings” in the context of originality. Justice Miller, writing for the Court, considered what was necessary for classification “under the head of writings of authors.” He explained:

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29. Feist Publications, 499 U.S. at 346. In full, Clause 8 authorizes Congress “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” U.S. CONST. art. I, § 8, cl. 8.
31. See id. at 105–06.
32. See Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53 (1884); The Trade-Mark Cases, 100 U.S. 82 (1879).
33. See Feist Publications, 499 U.S. at 346.
34. The Trade-Mark Cases, 100 U.S. at 82.
35. See id. at 94; Feist Publications, 499 U.S. at 346.
36. The Trade-Mark Cases, 100 U.S. at 93–94 (considering the “insurmountable difficulties” with identifying the essential characteristics of a trademark with inventions and discoveries in the arts and sciences, or with the
In this, as in regard to inventions, originality is required. And while the word writings may be liberally construed, as it has been, to include original designs for engraving, prints, etc., it is only such as are original, and are founded in the creative powers of the mind. The writings which are to be protected are the fruits of intellectual labor, embodied in the form of books, prints, engravings, and the like. Thus, some indicia of originality must be present in a “writing” before it may be afforded copyright protection.

2. Originality in “Authors” in Burrow-Giles

In *Burrow-Giles Lithographic Co. v. Sarony*, five years after the *Trade-Mark Cases*, the Court considered the issue of originality as it relates to “authors.” Consistent with the Court’s finding of an originality requirement in the meaning of “writings” in the *Trade-Mark Cases*, the Court ultimately distilled the same originality requirement from the Constitution’s use of the word “authors.” In *Burrow-Giles*, Justice Miller defined “author,” in a constitutional sense, to mean “he to whom anything owes its origin; originator; maker.” As in the *Trade-Mark Cases*, the Court emphasized the creative component of originality. Justice Miller described copyright as being limited to “original intellectual conceptions of the author” and stressed the importance of requiring an author who accuses another of infringement to prove “the existence of those facts of originality, of intellectual production, of thought, and conception.” Justice Miller found originality in “the subject so as to present graceful outlines, arranging and disposing the light and shade, suggesting and evoking the desired expression, and from such disposition, arrangement, or representation, made entirely by plaintiff.”

writings of authors).

37. *Id.* at 94 (emphasis added).
41. *Id.* at 58.
42. *See Feist Publications*, 499 U.S. at 346.
43. *Burrow-Giles Lithographic*, 111 U.S. at 58.
44. *Id.* at 59–60.
45. *Id.* at 60.

These findings, we think, show this photograph to be an original work of art, the product of plaintiff’s intellectual invention, of which plaintiff is the author, and of a class of inventions for which the constitution intended that congress should secure to him the exclusive right to use,
“The originality requirement articulated in [the] Trade-
Mark Cases and Burrow-Giles remains the touchstone of
copyright protection today.” While courts continue to shape
the concept of originality, it is clear that originality is distinct
from the concepts of novelty and creativity.

3. **Unnecessary Novelty**

Though not explored in early copyright cases, neither
congressional intent nor judicial construction of copyright
protection includes a novelty requirement. Instead, courts
require the presence of independent creation. As a result of
this legal construction, a work can enjoy copyright protection
even though it is substantially similar to an existing work.
In short, the standard for copyright protection does not re-
quire “novelty, ingenuity, or esthetic merit,” but rather only
mandates that the work “display something irreducible,
which is one man’s alone,’ not that the work be novel in com-
parison with the works of others.”

Analogously, Justice Clark, while considering a patent
case, stated that “[i]nnovation, advancement, and things
which add to the sum of useful knowledge are inherent requi-
sites in a patent system which by constitutional command
must ‘promote the Progress of . . . useful Arts.’ This is the
standard expressed in the Constitution and it may not be ig-
nored.” Unlike patent law, which rewards the first in time,
copyright law protects originality. Copyright law then confers on the owner the sole right to both reproduce the work and control all channels through which the work may reach the market.  

Circuit Judge Frank differentiated the constitutional requirements for patent and copyright protection in *Alfred Bell & Co. v. Catalda Fine Arts.* Judge Frank stated that "the very language of the Constitution differentiates (a) ‘authors’ and their ‘writings’ from (b) ‘inventors’ and their ‘discoveries.’" Those who penned the Constitution, of course, knew the difference. He explained that the term "inventor" carried "an implication which excludes the result of only ordinary skill," and that "nothing in the Constitution commands that copyrighted matter be strikingly unique or novel."  

In short, to satisfy the originality standard in copyright law, an author must produce an independent creation, not copied from other works. Contrary to patent law's novelty requirement, an author's original work may receive copyright protection even if a completely identical work exists, provided the author did not copy his work from the prior identical work. As Judge Learned Hand stated, "[i]f by some magic a man who had never known it were to compose anew Keats's Ode On a Grecian Urn, he would be an 'author,' and, if he copyrighted it, others might not copy that poem, though they might of course copy Keats's."  

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55. *Alfred Bell & Co.*, 191 F.2d at 100.
56. Id.
57. Id. at 102 (quoting *Bleistein*, 188 U.S. at 250).
58. Id.
60. See, e.g., *Novelty Textile Mills, Inc. v. Joan Fabrics Corp.*, 558 F.2d 1090, 1092 (2d Cir. 1977).
61. *Sheldon v. Metro-Goldwyn Pictures Corps.*, 81 F.2d 49, 54 (2d Cir. 1936). As one commentator has offered on Judge Hand's holding, the key, then, to understanding this definition of "originality" is Judge Hand's premise that the second author "had never known" Keats's poem. In Hand's view, because the second poet had no access to Keats's poem, the second poem was, by definition, "original." This understanding of originality makes it clear that the second poem's literal identity, or exact similarity, does not make it unoriginal. "Originality," then, under this view, means simply "uncopied." Russ VerSteeg, *Sparks in the Tinderbox: Feist, "Creativity," and the Legislative History of the 1976 Copyright Act*, 56 U. PITT. L. REV. 549, 580–81 (1995) (em-
Whether the seekers of copyright protection must demonstrate creativity, however, is another matter entirely.

4. Contrasting Creativity with Originality

Courts have consistently viewed creativity as distinct from originality.62 "To constitute a 'work of authorship,' the material deposited with the Register must pass a 'creativity' threshold, i.e., it must embody 'some modest amount of intellectual labor.'"63

It is important to distinguish among three separate concepts—originality, creativity, and novelty. A work is original if it is the independent creation of its author. A work is creative if it embodies some modest amount of intellectual labor. A work is novel if it differs from existing works in some relevant respect. For a work to be copyrightable, it must be original and creative, but need not be novel.64

Circuit Judge Eschbach in Baltimore Orioles, Inc. v. Major League Baseball Players Ass’n,65 clarified:

Although the requirements of independent creation and intellectual labor both flow from the constitutional prerequisite of authorship and the statutory reference to original works of authorship, courts often engender confusion by referring to both concepts by the term “originality.” For the sake of clarity, we shall use “originality” to mean independent authorship and “creativity” to denote intellectual labor.66

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63. Atari Games Corp. v. Oman, 888 F.2d 878, 882 (D.C. Cir. 1989) (citing Baltimore Orioles, Inc. v. Major League Baseball Players Ass’n, 805 F.2d 663, 668 n.6 (7th Cir. 1986) (distinguishing the concepts ‘originality,’ ‘creativity,’ and ‘novelty,’ and observing that “[f]or a work to be copyrightable, it must be original and creative, but need not be novel”).

64. Baltimore Orioles, 805 F.2d at 668 n.6 (emphasis added) (referring to MELVILLE NIMMER, 1 NIMMER ON COPYRIGHTS §§ 1.06[A], 1.08[C][1], 2.01[A]–[B] (1985)).

65. Id. at 663.

66. Id. at 668 n.6 (emphasis added).
a. A Minimal Element of Creativity

Courts seek a "minimal element of creativity over and above the requirement of independent effort" in the concept of originality. In order to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form. In Feist Publications, Inc. v. Rural Telephone Service Co., Inc., Justice O'Connor clarified that "the requisite level of creativity is extremely low; even a slight amount will suffice." Therefore, courts require only a modicum of creativity to be present in a work for it to be copyrightable. Judges in subsequent court decisions are quick to state that "it is a mistake . . . to conclude that the Supreme Court in Feist sought to elevate the originality standard."

"[O]nly an unmistakable dash of originality need be demonstrated in law of copyright; high standards of uniqueness in creativity are dispensed with." The vast majority of works make the grade quite easily, as they possess some creative

   (a) In order to be acceptable as a pictorial, graphic, or sculptural work, the work must embody some creative authorship in its delineation or form. The registrability of such a work is not affected by the intention of the author as to the use of the work or the number of copies reproduced. The availability of protection or grant of protection under the law for a utility or design patent will not affect the registrability of a claim in an original work of pictorial, graphic, or sculptural authorship.
70. Id. at 345. See Goldstein v. California, 412 U.S. 546, 561 (1972) (interpreting writings to include "any physical rendering of the fruits of creative intellectual or aesthetic labor"); L. Batlin & Son, 536 F.2d at 490 (stating that the concept of originality implies a creativity requirement quite separate from a requirement of independent effort); Harcourt, Brace & World, Inc. v. Graphic Controls Corp., 329 F. Supp. 517, 523 (S.D.N.Y. 1971) (holding that computer-scored answer sheets involved sufficient creativity).
71. See, e.g., Baltimore Orioles, 805 F.2d at 669 n.7 (citing L. Batlin & Son, 536 F.2d at 486; Gilles-Widmer Co. v. Milton Bradley Co., 313 F.2d 143, 146 (7th Cir. 1963); Wihtol v. Wells, 231 F.2d 550, 553 (7th Cir. 1956); Alfred Bell & Co. v. Catalda Fine Arts, 191 F.2d 99, 102 (2d Cir. 1951); Nimmer, supra note 64, §§ 1.08[C][1], 2.01[B], 2.08[B][II]).
72. Oasis Publ'g Co., Inc. v. West Publ'g Co., 924 F. Supp. 918, 923 (D. Minn. 1996).
73. Weissmann v. Freeman, 868 F.2d 1313, 1321 (2d Cir. 1989). See VerSteeg, Sparks in the Tinderbox, supra note 61, at 558 n.49 (outlining the eventual deletion of "creative" from the language of § 102).
spark, "no matter how crude, humble or obvious." Just as originality does not connote novelty, creativity only applies to works bearing a spark of distinctiveness in copyrightable expression. Therefore, a proponent must merely demonstrate a distinctive "unmistakable dash of originality."

b. The Essence of Originality

Creativity exists as a critical component of originality because a copyrightable work must be not only "created," in the sense of being brought into existence, but it must also be minimally "creative." "Creative" is defined as "[i]nventive; imaginative . . . exhibiting imagination as well as intellect and thus [is] differentiated from the merely critical, 'academic,' journalistic, professional, mechanical, etc. in literature or artistic production." In fact, there may be a "reciprocal relationship" between originality and creativity so that the smaller the effort, the greater the creativity necessary for protection.

Imagination serves as the touchstone of creativity. As District Judge Zagel explained in American Dental Ass'n v.

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75. See supra Part I.B.3 (dispelling the need for a work seeking copyright protection to demonstrate novelty).

76. See Warren Publ'g, Inc. v. Microdos Data Corp., 115 F.3d 1509, 1524 (11th Cir. 1997).

77. Weissmann, 868 F.2d at 1321. But see Russ VerSteeg, Rethinking Originality, 34 WM. & MARY L. REV. 801, 826 (1993) [hereinafter VerSteeg, Rethinking Originality] ("Feist's creativity requirement appears to have collided with Congress' express intent assiduously to avoid using creativity as an element of copyrightability.").


79. American Dental Ass'n, 39 U.S.P.Q.2d at 1720 (citing 3 OXFORD ENGLISH DICTIONARY 1135 (2d ed. 1989)).

80. See Brian Dahl, Comment, Originality and Creativity in Reporter Pagination: A Contradiction in Terms?, 74 IOWA L. REV. 713, 718 (1989) (citing Universal Athletic Sales Co. v. Salkeld, 511 F.2d 904, 908 (3rd Cir. 1975) (citing NIMMER, supra note 64, § 2.01[B], at 2-15)).

81. See American Dental Ass'n, 39 U.S.P.Q.2d at 1720.
notions of de minimis creativity do not quite jibe with the concept of "imagination" if it is defined as "the creative faculty of the mind in its highest aspect; the power of framing new and striking intellectual conceptions; poetic genius." If copyrightability were dependent on qualities of poetic genius, the body of material suitable for copyright would be slim indeed.\(^8\)

Because determinations of degrees of imagination are inherently subjective, and therefore ill-suited for judicial resolution, "a less artistically demanding—and less subjective—definition is necessary. So it may be conceptually more helpful to simply define 'imagination' as '[t]he power which the mind has of forming concepts beyond those derived from external objects.'\(^8\)

Jurisprudence and judicial interpretation of statutory law establish a set of building blocks upon which copyright law is structured. Each component not only serves as the foundation for another concept, but also depends on an underlying concept for support. In cursory review of the infrastructure, "copyrightability depends on originality, originality on creativity, and creativity on imagination."\(^8\) With the understanding that originality is a distinct concept from either novelty or creativity, the question becomes qualitative in nature. By analyzing discussions of the originality prerequisite for copyright protection in the large body of statutory and common law, it is possible to decipher whether there is, in fact, a formulaic pattern to determining the quantum of originality needed to attain status as an "original work of authorship"\(^8\) entitled to copyright protection.

II. "ORIGINAL WORKS OF AUTHORSHIP"

The legislature purposely left the phrase "original works of authorship"\(^8\) undefined in the Copyright Act of 1976.\(^8\)

\(^{82}\) Id. at 1721.
\(^{83}\) Id. (citation omitted).
\(^{84}\) Id.
\(^{85}\) Id. (discussing the syllogism and inherent difficulties with administering a subjective test).
\(^{87}\) Id.
\(^{88}\) See H.R. REP. NO. 94-1476, supra note 2, at 51. See also Patterson & Joyce, supra note 62, at 759 n.139 ("Apparently, Congress felt that prior case
Congress intended to incorporate without change the standard of originality established by the courts under the Copyright Act of 1909. Therefore, understanding the meaning of originality requires a review of the case law under the 1909 Act.

The 1909 Act neither defined originality nor even expressly required that a work be original to receive protection. However, the courts uniformly applied the originality element, affording copyright protection only to "authors" or their successors in interest. In fact, Congress did not explicitly recognize the originality requirement in a copyright statute until 1976, because the legislature "intended to incorporate without change the standard of originality established by the courts." Following the legislature's lead, a discussion of the court decisions reviewing the concept of originality in copyright law serves as a necessary and logical starting point.

The following discussion begins with a distinction between "first generation" works (works wholly created by the author) and "second generation" works (works that rely on law would provide the courts adequate guidelines for construing this requirement.

89. See H.R. REP. NO. 94-1476, supra note 2, at 51; see also CRAIG JOYCE ET AL., COPYRIGHT LAW 60 (3rd ed. 1994) ("You will search § 101 of the 1976 Act in vain for any definition of this key term.").
90. See NIMMER, supra note 64, § 2.01.
92. But see Universal Athletic Sales Co. v. Salkeld, 511 F.2d 904, 908 (3rd Cir. 1975) ("It is true that originality is not a prerequisite of copyright... ").
93. See 17 U.S.C. § 102(a) (1994) ("Copyright protection subsists... in original works of authorship... ") (emphasis added). See also H.R. REP. NO. 94-1476, supra note 2, at 51 ("This standard does not include requirements of novelty, ingenuity, or esthetic merit, and there is no intention to enlarge the standard of copyright to require them.").
94. 17 U.S.C. § 102(a); see also VerSteeg, Sparks in the Tinderbox, supra note 61, at 550–51 n.5 (criticizing the drafting process of the 1976 Copyright Act) (quoting Jessica Litman, Copyright, Compromise, and Legislative History, 72 CORNELL L. REV. 857, 860–61 (1987)).

Most of the statutory language was not drafted by members of Congress or their staffs at all. Instead, the language evolved through a process of negotiation among authors, publishers, and other parties with economic interests in the property rights the statute defines. In some cases, affected parties agreed upon language, which was then adopted by Congress, while disagreeing about what the language meant.

Id.
Previous works. Next, it resolves that as the level of independent creation increases, so does the level of protection afforded by copyright law. Under the Copyright Act, a wholly creative, “first generation” work is entitled to the most protection. Consequently, “second generation” works, derivative works and compilations, receive less protection. Finally, works devoid of creativity receive no copyright protection at all.

In short, copyright law more vigorously protects highly original and highly expressive works than functional and nonfiction works. This article ultimately attempts to unravel some of the conflicts developing in achieving the quantum of originality necessary to acquire copyright protection, focusing primarily on emerging issues in one of the two types of “second generation” works: the derivative work.

A. “First Generation” Works—Wholly Original Works

“A work that is neither a compilation nor a derivative work falls into the abyss of the undefined; the Copyright Act does not label or define noncompilations or nonderivatives.”

Classifying all works as either compilations or derivatives,

95. See Patterson & Joyce, supra note 62, at 758 n.135.
It may be useful to think of § 102(a) works as “first generation” works, to distinguish them from § 103(a) derivative works and compilations, which are “second generation” works in the sense that they are composed, at least in significant part, of materials drawn from preexisting works (in the case of derivative works) or the public domain (in the case of compilations).

96. See, e.g., Warren Publ’g, Inc. v. Microdos Data Corp., 115 F.3d 1509, 1515 (11th Cir. 1997).

97. See id.; see also VerSteeg, Rethinking Originality, supra note 77, at 805 n.11 (“Professor Ginsburg has advocated a recognition of ‘low authorship’ and ‘high authorship’ works. The distinction between Professor Ginsburg’s types turns in part on the status of the work in question, that is, whether it is a compilation, derivative, or freestanding work.”) (citing Jane Ginsburg, Creation and Commercial Value: Copyright Protection of Works of Information, 90 COLUM. L. REV. 1866–72 (1990)).

98. See Warren Publ’g, 115 F.3d at 1515.


100. VerSteeg, Rethinking Originality, supra note 77, at 816. “Arguably, there can be no freestanding works under the Act. Such an argument rests upon the assumption that every work is, to some degree, either a compilation of preexisting elements and/or works, or else a derivation of a preexisting work or works.” Id.
however, is not sound copyright policy. Although all works are to some extent compilative or derivative,"first generation"
works do exist. As a general rule, a "first generation" work is a work that is not substantially similar to any preexisting works or materials; if it were substantially similar, then it would be either a compilation or a derivative work. An exception to this general rule would arise when a work does bear a substantial similarity to a preexisting work or material, but the substantial similarity is coincidence and not a result of copying.101

Thus, first generation works require some creative intellectual or aesthetic labor. However, "a very slight degree of such labor [and] almost any ingenuity in selection, combination, or expression, no matter how crude, humble, or obvious, will suffice."102 Comparing unoriginal to original first generation works demonstrates the need for originality in copyright protection.

1. Works Not Up to the Challenge—Unoriginal Works

"[E]ven a 'first generation' work must surmount the barrier of nontrivial originality before it is entitled to copyright."103 Some works simply cannot demonstrate this minimal level of creativity. For example, "[p]hrases and expressions conveying an idea typically expressed in a limited number of stereotyped fashions are not subject to copyright protection [because each] contain[s] little in the way of original expression."104 "The Copyright Office routinely denies registration, for example, for names, titles, catchwords, catch phrases, mottoes, slogans, and short advertising expressions."105 For instance, in Morrissey v. Procter & Gamble Co.,106 the rules for a sweepstakes involving the use of the participants' social security numbers were so straightforward and simple that originality could not attach.107

Courts have likewise deemed numbers, on the whole, as being unworthy of copyright protection. In Toro Co. v. R & R

101. Id. at 817 (citations omitted) (emphasis added) ("freestanding" replaced with "first generation" for uniformity throughout this article).
102. West Publ'g Co. v. Mead Data Cent., Inc., 799 F.2d 1219, 1223 (8th Cir. 1986).
103. Patterson & Joyce, supra note 62, at 760 n.144.
104. Narell v. Freeman, 872 F.2d 907, 911 (9th Cir. 1989).
105. Patterson & Joyce, supra note 62, at 760 n.144.
107. See id. at 679.
Products Co., the Eighth Circuit denied copyright protection for professional lawn care machine replacement part numbers and held that "the system lacks the requisite originality for copyright protection." Circuit Judge Timbers stated:

[Toro's] parts numbering "system" falls short of even the low threshold of originality. The random and arbitrary use of numbers in the public domain does not evince enough originality to distinguish authorship. The expression itself is nothing more than the public domain numbers. There is no variation, other than the trivial hyphen, to establish authorship. . . . Originality is a very low threshold, but still a threshold.

Analogously, facts are not copyrightable. Perhaps "[t]he most fundamental axiom of copyright law [states] that 'no author may copyright his ideas or the facts he narrates.'"

"No one may claim originality as to facts." . . . This is because facts do not owe their origin to an act of authorship. The distinction is one between creation and discovery: The first person to find and report a particular fact has not created the fact; he or she has merely discovered its existence.

"The same is true of all facts—scientific, historical, biographical, and news of the day." They may not be copyrighted and are part of the public domain available to every person. Unlike facts, numbers, and catch phrases, some first generation works manage to evidence enough originality to warrant copyright protection.

2. Original Works—Above and Beyond

First generation works merit copyright protection when
the work results from an independent creation. 117 Even if the work is completely identical to prior work, it is original for purposes of copyright protection if it is not copied from the prior work. 118 Thus, fulfillment of the ultimate test of originality requires proof that the work originated with the author,119 without conscious or even unconscious reference to prior works. 120

Original Appalachian Artworks, Inc., v. McCall Pattern Co., 121 though dealing with an infringement, illustrates that an original work is entitled to copyright protection despite similarities with already existing products. Original Appalachian Artworks, Inc., owners of the interests to “The Cabbage Patch Kids,”122 sued McCall Pattern Company for selling patterns used to create soft-sculpture dolls called “Blossom Babies.”123 District Judge Tidwell held that “McCall’s evidence establishes that its dolls were independently created by Faye Wine.”124 Therefore, though there may be a similarity to existing works, independently created works enjoy copyright protection.

The minimum creativity requirement applied to “first generation” works appears to generate bright-line rules, even if those rules depend ultimately on the author’s prior exposure to previous existing materials. However, courts sub-

117. See, e.g., L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486, 490 (2d Cir. 1976) (“There must be independent creation, but it need not be invention in the sense of striking uniqueness, ingenuity, or novelty . . . .”).


119. See, e.g., Feist Publications, 499 U.S. at 345 (emphasis added).

120. See generally Abkco Music, Inc. v. Harrisongs Music, Ltd., 722 F.2d 988, 997–99 (2d Cir. 1983) (finding copyright infringement based on a theory of subconscious copying because “He’s So Fine” had been the most popular song in the United States for five weeks and among the thirty top hits in England for seven weeks during the year in which George Harrison composed “My Sweet Lord,” the infringing song). But see Jewel Music Publ’g Co. v. Leo Feist, Inc., 62 F. Supp. 596, 598 (S.D.N.Y. 1945) (holding that even though almost 10,000 copies of the complaining song had been distributed or sold and the music had also been broadcast on national performances, the showing of access was insufficient to support infringement).


122. See id. at 833 (explaining that “Cabbage Patch Kids” are soft-sculpture dolls sold with birth and adoption certificates).

123. See id. (explaining that Faye Wine, a doll collector and designer, granted to McCall the right to manufacture and sell patterns of soft-sculpture dolls designed by her).

124. Id. at 836.
ject "second generation” works to a more rigorous creativity standard, implying that a different quantum of originality may be required depending on the type of work involved.

B. “Second Generation” Works—The Dwarf on the Giant’s Shoulders

While § 103(a) of the Copyright Act provides that compilations and derivative works fall within the purview of copyright law, such protection will not shield a work making unlawful use of preexisting, copyrighted material. "[T]he criteria of copyrightable subject matter stated in section 102 apply with full force to works that are entirely original and to those containing preexisting material." Succinctly stated, while courts and the legislature interpret copyright law as protecting compilations and derivative works, the basic tenet remains the same. Originality serves as the cornerstone of proving a work copyrightable, and as such, copyright law protects only those aspects of an author's compilation or derivative work that are original to the author.

"The most important point here is one that is commonly misunderstood today: copyright in a 'new version' covers only the material added by the later author, and has no effect one


126. See 17 U.S.C. § 103(a) (1994). “The subject matter of copyright as specified by section 102 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used lawfully.” Id. “Section 103 complements section 102.” H.R. REP. NO. 94-1476, supra note 2, at 57–58; see also Micro Star v. FormGen Inc., 154 F.3d 1107, 1112 (9th Cir. 1998) (“[A] work will be considered a derivative work only if it would be considered an infringing work if the material which it has derived from a preexisting work had been taken without the consent of a copyright proprietor of such preexisting work.”) (citations omitted).

127. H.R. REP. No. 94-1476, supra note 2, at 57.


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

Id.
The following section does not attempt to explore all of the diverse facets of “second generation works.” Instead, the section briefly introduces the evolving law of compilations, Justice O'Connor's opinion in *Feist Publications, Inc. v. Rural Telephone Service Co.*, and *Feist*'s impact on the law concerning originality.

1. **Compilations**

Section 101 of the 1976 Act defines a “compilation” as “a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.” The statutory definition expressly emphasizes that collections of facts are not copyrightable per se. The statute identifies three distinct elements of a compilation and requires applicants to fulfill each before the work qualifies as a copyrightable compilation: (1) the collection and assembly of pre-existing material, facts, or data; (2) the selection, coordination, or arrangement of those materials; and (3) the creation, by virtue of the particular selection, coordination, or arrangement, of an “original” work of authorship.

The first requirement merely describes the normal concept of a compilation—a collection of pre-existing material,

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129. H.R. REP. NO. 94-1476, supra note 2, at 57.
130. See id. (stating that “there is necessarily some overlapping between the two, but they basically represent different concepts”).
132. 17 U.S.C. § 101. “A ‘compilation’ results from a process of selecting, bringing together, organizing, and arranging previously existing material of all kinds, regardless of whether the individual items in the material have been or ever could have been subject to copyright.” H.R. REP. NO. 94-1476, supra note 2, at 57; Matthew Bender & Co. v. West Publ'g Co., 158 F.3d 674, 679 (2d Cir. 1998).
133. See Feist Publications, 499 U.S. at 357.
134. See id. (“This tripartite conjunctive structure is self-evident, and should be assumed to 'accurately express the legislative purpose.'”) (quoting Mills Music, Inc. v. Snyder, 469 U.S. 153, 164 (1985)). See also Patterson & Joyce, supra note 62, at 757–58 n.136 (citing W. Patry, Latman's Copyright Law 63–64 (6th ed. 1986)).
facts, or data. The third requirement emphasizes that a compilation, like any other work, may prove copyrightable only if it satisfies the originality requirement. The key to the definition of compilation is the second requirement, which instructs the courts determining whether a fact-based work is an original work of authorship to focus on the manner in which the collected facts have been selected, coordinated, and arranged. As such, "[n]ot every selection, coordination, or arrangement will pass muster." As Justice O'Connor stated in *Feist*, "though a work qualifies as a copyrightable compilation, that copyright protects only the author's original contributions—not the facts or information conveyed." The copyright in a compilation . . . extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material.

a. A *Feisty Court* in *Feist Publications*

*Feist Publications, Inc. v. Rural Telephone Service Co.* is the seminal case regarding the requisite level of originality required for receiving copyright protection in a compilation. In summary, Rural Telephone Service Company ("Rural") ob-

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135. See *Feist Publications*, 499 U.S. at 357. ("What makes it significant is that it is not the sole requirement. It is not enough for copyright purposes that an author collects and assembles facts.").

136. See id.

137. See id. at 358 (offering that this is a straightforward application of the originality requirement because facts are never original so the only chance for originality is in the presentation); see also *Matthew Bender & Co.*, 158 F.3d at 682–83.

The creative spark is missing where: (i) industry conventions or other external factors so dictate selection that any person composing a compilation of the type at issue would necessarily select the same categories of information . . . or (ii) the author made obvious, garden-variety, or routine selections. . . . In sum, creativity in selection and arrangement therefore is a function of (i) the total number of options available, (ii) external factors that limit the viability of certain options and render others non-creative, and (iii) prior uses that render certain selections "garden variety."

*Id.* (citations omitted).


139. Id. at 340.

140. Id. at 359.

141. Id. (emphasis added) (citing 17 U.S.C. § 103(b) (1994)); see also *Matthew Bender & Co.*, 158 F.3d at 687.

tained data for its directory from its subscribers and published a typical telephone directory consisting of white pages and yellow pages. Feist Publications extracted listings from Rural's directory without Rural's consent. Rural sued Feist for copyright infringement based on Feist's use of the information contained in Rural's white pages. Both the district court and the Court of Appeals for the Tenth Circuit held that Rural's telephone directories were copyrightable. On certiorari, Justice O'Connor noted regarding compilations, "[i]t is this bedrock principle of copyright that mandates the law's seemingly disparate treatment of facts and factual compilations." Unlike mere facts, factual compilations may possess the requisite originality for copyright protection.

The compilation author typically chooses which facts to include, in what order to place them, and how to arrange the collected data so that they may be used effectively by readers. These choices as to selection and arrangement, so long as they meet the independence and creativity requirements, are sufficiently original that Congress may protect such compilations through the copyright laws.

As discussed below, despite the fact that factual compilations

143. See id. at 343.
144. See id. at 342.
145. See id.

Feist began by removing several thousand listings that fell outside the geographic range of its area-wide directory, then hired personnel to investigate the 4,935 that remained. These employees verified the data reported by Rural and sought to obtain additional information. . . . 1309 of the 46,878 listings in Feist's 1983 directory were identical to listings in Rural's 1982-1983 white pages. Four of these were fictitious listings that Rural had inserted into its directory to detect copying.

Id. at 343-44.
146. See id. at 344.
148. Feist Publications, 499 U.S. at 347 (offering that census takers, for example, do not "create" the population figures that emerge from their efforts; in a sense, they copy these figures from the world around them) (citing Robert C. Denicola, Copyright in Collections of Facts: A Theory for the Protection of Non-fiction Literary Works, 81 COLUM. L. REV. 516, 525 (1981)).
149. See id. at 348.
150. Id. (citing Nimmer, supra note 64, §§ 2.11[D], at 3.03). "Thus, even a directory that contains absolutely no protectible written expression, only facts, meets the constitutional minimum for copyright protection if it features an original selection or arrangement." Id. See also, e.g., Kregos v. Associated Press, 937 F.2d 700, 703 (2d Cir. 1991).
are copyrightable, the *Feist* court nevertheless found that Rural's white pages lacked the requisite originality necessary for copyright protection.

b. **Elusive Expression—The “Thin Copyright”**

The expressive element is more elusive where the compilation author "lets the facts speak for themselves," rather than adding any written expression. The only conceivable expression is the manner in which the compiler has selected and arranged the facts. Thus, if the selection and arrangement are original, these elements of the work are eligible for copyright protection." This has been termed a "thin copyright."

c. **The Death of “Sweat of the Brow”**

The theory of "sweat of the brow" or "industrious collection," a concept premised on the notion that an author should be rewarded primarily for effort, likewise cannot es-

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151. See *Feist Publications*, 499 U.S. at 349.
152. Id. See William F. Patry, *Copyright in Compilations of Facts (or Why the “White Pages” Are Not Copyrightable)*, 12 COM. & LAW 37, 64 (Dec. 1990). No matter how original the format, however, the facts themselves do not become original through association. *See Patterson & Joyce, supra* note 62, at 776; *see also* Matthew Bender & Co. v. West Publ’g Co., 158 F.3d 674, 688–89 (2d Cir. 1998) (explaining that "our decisions establish a low threshold of creativity, even in works involving selection from among facts").
153. *Feist Publications*, 499 U.S. at 349 (“This inevitably means that the copyright in a factual compilation is thin. . . . A subsequent compiler remains free to use the facts contained in another’s publication to aid in preparing a competing work, so long as the competing work does not feature the same selection and arrangement.”). *See generally* David Luettgen, *Functional Usefulness vs. Communicative Usefulness: Thin Copyright Protection for the Nonliteral Elements of Computer Programs*, 4 TEX. INTELL. PROP. L.J. 233, 234 (1996) (explaining how copyright started off broad but is getting thinner); Dale Olson, *Thin Copyrights*, 95 W. VA. L. REV. 147, 157 (1992) (exploring *Feist’s* role in establishing “thin copyright”).
154. The classic formulation of “sweat of the brow” was embodied in *Jeweler’s Circular Publ’g Co. v. Keystone Publ’g Co.*, 281 F. 83, 88 (2d Cir. 1922). Circuit Judge Rogers stated:

The right to copyright a book upon which one has expended labor in its preparation does not depend upon whether the materials which he has collected consist or not of matters which are publici juris, or whether such materials show literary skill or originality, either in thought or in language, or anything more than industrious collection. The man who goes through the streets of a town and puts down the names of each of the inhabitants, with their occupations and their street number, acquires material of which he is the author.

*Id.*
cape the prerequisite of originality. Proof of effort, even in vast degrees, does not alone establish that even a modicum of originality exists in the work. A painstaking copy still remains a copy, regardless of the effort involved in its creation. Even under the 1909 Act, "sweat of the brow" did not alone provide sufficient justification for copyright protection. In *International News Service v. Associated Press*, the Court held that the 1909 Act conferred copyright protection only on those elements of a work original to the author. The standard of originality may be low, but it does exist.

With respect to Rural's white pages, the Court held that the selection, coordination, and arrangement of the materials did not satisfy the minimum constitutional standards for copyright protection. The Court determined that Rural merely gathered the data provided by its subscribers and listed the information alphabetically by surname to produce a garden-variety white pages directory, devoid of even the slightest trace of creativity. Even though the directory represents a "selection" of a sort, "it lacks the modicum of creativity necessary to transform mere selection into copyrightable expression."

Because Rural's white pages lacked the requisite originality, Feist's use of the listings did not constitute infringement. As a reprieve, the Court admonished the parties that its decision "should not be construed as demeaning Rural's efforts in compiling its directory, but rather as making clear that copyright rewards originality, not effort."

With Justice O'Connor's wisdom in mind, one may con-

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156. See id. at 359-60.
157. See id. at 353 (offering that the "[d]ecisions of this Court applying the 1909 Act make clear that the statute did not permit the "sweat of the brow" approach").
159. See id. at 235.
160. See *Feist Publications*, 499 U.S. at 362 (citing Patterson & Joyce, supra note 62, at 760, n.144 (stating "[w]hile this requirement is sometimes characterized as modest, or a low threshold, it is not without effect") (internal quotation marks omitted; citations omitted)).
161. See id.
162. See id.
163. Id. at 362-63 ("Rural expended sufficient effort to make the white pages directory useful, but insufficient creativity to make it original.").
164. See id. at 364.
165. Id. (emphasis added).
template the issue of whether conventional interpretation of the law involving compilations remains consistent when considering the other "second generation" work, derivative works. Faced with a distinct variation in analysis depending upon the public domain status of the underlying work, courts struggle to resolve whether such distinction warrants disparate treatment in derivative work cases.

2. Derivative Works

A derivative work exists as a functional variation of a preexisting work that is either protected by copyright or in the public domain.\textsuperscript{166} The use of public domain material does not preclude a finding of originality because "[a]nyone can copyright anything, if he or she adds something original to its expression."\textsuperscript{167} Regardless of the nature of the underlying work, originality remains essential to a derivative work.\textsuperscript{168}

The Copyright Act, 17 U.S.C. § 101, defines a derivative work as:

\begin{quote}
[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."\textsuperscript{169}
\end{quote}

The scope of copyright protection of a derivative work, however, extends only to the material contributed by the author of such work, as distinguished from the preexisting material.\textsuperscript{170}

\begin{footnotes}
\item[166] 17 U.S.C. § 101 (1994). "A 'derivative work,' on the other hand, requires a process of recasting, transforming, or adapting 'one or more preexisting works'; the 'preexisting work' must come within the general subject matter of copyright set forth in section 102, regardless of whether it is or was ever copyrighted." H.R. REP. No. 94-1476, supra note 2, at 57-58.
\item[168] See, e.g., L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486, 490 (2d Cir. 1976); NIMMER, supra note 64, § 3.03.
\item[169] 17 U.S.C. § 101; see Micro Star v. FormGen, Inc., 154 F.3d 1107, 1110 (9th Cir. 1998) ("The statutory language is hopelessly overbroad, however, for '[e]very book in literature, science and art, borrows and must necessarily borrow, and use much which was well known and used before.") (citations omitted).
\item[170] 17 U.S.C. § 103(b).
\end{footnotes}
The term “derivative work” is in some sense redundant. All works might be considered derivative in that they employ previously existing elements. One cannot write without using letters or language, paint without colors and forms, or compose without notes and structures that have been previously created. Even where preceded by no mortal hand or eye, the sculptor may employ the grain of the wood or the composer may seek to integrate the babble of a brook. Of course, drawing from a common stock of elements is not what makes for a derivative work under the statute or as the term is commonly used.\(^7\)

Despite the dichotomy involved in “second generation” works between compilation and derivative works, courts consistently apply the originality standard. In the wake of court decisions like Feist Publications, the question forms as to how much originality is necessary. In order to appreciate the evolving complexity of the issue, this article considers a thorough, fact-specific analysis of the court interpretations of the quantum of originality necessary to receive protection in a derivative work.

### III. The Necessary Quantum of Originality in Derivative Works

After exploring the cases that transformed the originality requirement for derivative works into the mutating target that it is today, this article investigates the present relationship between the public domain status of the underlying work and the quantum of originality necessary to achieve protection of a derivative work. Finally, to achieve greater equality among the treatment of derivative works, this article humbly offers a unification of the quantum of originality for all derivative works, regardless of the public domain status of the underlying work.

#### A. A “More Than Merely Trivial” Minimum in Bleistein

To attain copyright protection, a derivative work must demonstrate sufficient originality by evidencing a “distinguishable variation” from the prior work, where such variation is the product of the author’s independent effort and

quantified as *more than merely trivial*. In order for a work to be copyrightable, it must result from certain minimal levels of creativity and originality. Justice Holmes described this concept in *Bleistein v. Donaldson Lithographing Co.*

The dispute in *Bleistein* involved the copying of three chromolithographs portraying a lifelike scene from a privately owned circus. The chromolithographs expressed three ordinary circus scenes: one of a ballet, one of a number of men and women performing on bicycles, and one of groups of men and women whitened to represent statues. When considering originality with regard to circus performers, whose performances were in the public domain, Justice Holmes stated:

Personality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible which is one man's alone. The something he may copyright unless there is a restriction in the words of the act.

It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations. At the one extreme, some works of genius would be sure to miss appreciation. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. We are of opinion that there was evidence that the plaintiffs have rights entitled to the protection of the law.

Justice Holmes propounded a basic threshold. This threshold, however, does not fully embody the quantum of originality necessary to receive copyright protection. The court interpretation of this originality requirement focused on whether a derivative work's underlying work is in the public domain.

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173. See id.; see also supra Part I.B.3–4.
175. *Id.* at 248.
176. *See id.*
177. *Id.* at 250–52. (emphasis added) (extolling the dangers for the legal system to make artistic judgments).
178. *See id.*
179. *See id.* at 248–52.
B. Applying the Baseline to Public Domain Derivatives


Applying Bleistein's reasoning to a derivative work based on the public domain, Circuit Judge Frank breathed life into this minimum level and established the "more than trivial" standard in *Alfred Bell & Co. v. Catalda Fine Arts, Inc.* Judge Frank literally and figuratively put Justice Holmes's words to the test. Alfred Bell & Co. ("Bell") created reproductions of paintings by old masters in the public domain using a special engraving process known as mezzotint. Bell sued Catalda Fine Arts ("Catalda"), claiming infringement of eight mezzotints. Catalda argued that the mezzotints lacked originality, being merely reproductions of public domain works, and, therefore, were not copyrightable.

Judge Frank held that originality in copyright requires "little more than a prohibition of actual copying. No matter how poor the 'author's' addition, it is enough if it be his own." Thus, in general, it follows that if any author's independent efforts contain sufficient skill to motivate another's copying, there is *ipso facto* a sufficient quantum of originality to support a copyright.

Despite this slight quantum threshold, which accepts even the most modest amount of originality as sufficient, there are works that cannot demonstrate more than trivial or insignificant efforts. Moreover, trivial efforts usually do not encompass unintentional efforts, therefore establishing that the quantum of originality requires not only proof of at least some original effort, but also requires proof of some degree of intention to produce an original result. Circuit Judge Frank explained that unintentional actions could, at times, consti-

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182. See id.
183. See *Alfred Bell & Co.*, 191 F.2d at 104.
184. Id. at 103; see *Entertainment Research Group v. Genesis Creative Group, Inc.*, 122 F.3d 1211, 1221 (9th Cir. 1997).
185. See *Nimmer, supra* note 64, § 2.01[B], at 2-14 (citing *Drop Dead Co. v. S.C. Johnson & Son, Inc.*, 326 F.2d 87, 92 (9th Cir. 1963)).
tute originality, while under other circumstances inadvertent independent efforts could render a work devoid of the requisite quantum of originality. A copyist’s bad eyesight or defective musculature, or a shock caused by a clap of thunder, may yield sufficiently distinguishable variations. Having hit upon such a variation unintentionally, the ‘author’ may adopt it as his and copyright it. However, some inadvertent “efforts” fail to yield this distinction. For example “[s]etting fire to the Louvre might well transform many preexisting works beyond recognition, much less beyond trivial variation. But unless arson were considered the writing of an ‘author,’ the damaged fragments might not properly be regarded as derivative works.

Additionally, though some works cannot demonstrate enough independent effort to fulfill this minimal level of originality, “even the most commonplace and banal results of independent effort may command copyright protection.” At the same time, copyright law will not vehemently protect merely trivial variations of public domain material. The courts have defined the necessary quantum of authorship using terms such as “a modicum,” “a minimum,” or “an appreciable amount” of original, creative expression. Even expressions as commonplace as a three-dimensional Santa Claus still command protection, as illustrated in Doran v. Sunset House Distributing Corp.

188. See Alfred Bell & Co., 191 F.2d at 104.
190. Page, supra note 171, at 420 n.51 (citing Goldstein v. California, 412 U.S. 546, 561 (1972)); see also id. at 420 n.52 (rejecting the proposal that this problem could be dismissed as unlawful use under 17 U.S.C. § 103(a)).
191. NIMMER, supra note 64, § 2.01[B], at 2-16 (citing Heim v. Universal Pictures Corp., Inc., 154 F.2d 490, 488 n.17 (2d Cir. 1946)); see Drop Dead Co. v. S.C. Johnson & Son, Inc., 326 F.2d 87, 93 (9th Cir. 1963).
193. Id.
2. Saving Santa with Doran

In *Doran v. Sunset House Distributing Corp.*, Doran manufactured a red plastic bag that, after being filled with crumpled newspaper, looked like a three-dimensional Santa Claus for display as a Christmas decoration. Two years after Doran started selling this product, Sunset House started selling similar Santa Clauses packed with similar instructions. During the ensuing lawsuit, the defendants conceded that by Doran’s product “inspired” them.

Sunset House argued that “since Santa Claus is in the public domain, a work of art embodying this legendary figure cannot be the subject of a valid copyright.” As Circuit Judge Chambers explained on appeal, “Santa Claus belongs to the whole world, and next he may be exported to outer space. He belongs to none of the parties.” However, district court Judge Byrne held that, “[t]he fact that a copyrighted article depicts a figure, theme or idea in the public domain, does not in itself void the copyright.” The analysis in this case dealt expressly with the determination of whether this medium of expression—a tangible representation of the familiar figure of Santa Claus in a three-dimensional, plastic form—sufficiently displayed original thought and creation to support the grant of protection under copyright law.

Judge Byrne stated “[t]o be copyrightable, a work must be ‘original’ in that the author has created it by his own skill, labor and judgment.” Using Alfred Bell & Co.’s “merely triv-
ial" variation standard, the court held that because Doran "first envisioned, and then created by their own skill, labor and judgment, a Santa Claus in the form of a threedimensional figure made of plastic, Doran's product was sufficiently original. "[T]he originality here lies in the form—three-dimensional—and the medium—plastic—which plaintiffs used to express the idea of Santa Claus. As far as the record reveals, plaintiffs were the first to reproduce the traditional character in this particular form and medium. Based on these facts, Judge Byrne held that Doran's Santa represented an "original' [creation] because of its form and medium, and this originality is sufficient to form the basis of a valid copyright.

C. Raising the Bar When the Underlying Work is Still Protected

1. Winding Down Mickey, Donald, and Pluto in Durham Industries

Saving Santa Claus generated criticism from a case that considered the other type of derivative works: those based on underlying works still protected, but not belonging to the public domain. In Durham Industries, Inc. v. Tomy Corporation, Tomy Corporation asserted nine counterclaims against Durham Industries for copying eight pairs of Tomy's toys, three of which were Disney figures and five of which were other miscellaneous toys. Tomy claimed the copyright on three wind-up plastic Disney figures: Mickey Mouse, Don-

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205. See Alfred Bell & Co. v. Catalda Fine Arts, 191 F.2d 99, 103 (2d Cir. 1951) (emphasis added).
207. Id.
208. Id. at 945.
209. Durham Indus., Inc. v. Tomy Corp., 630 F.2d 905, 907 (2d Cir. 1980).
210. See id. at 907–08. Eight counterclaims alleged copyright infringement; the ninth alleged unfair competition under both the Lanham Act, 15 U.S.C. § 1125(a), and state law in regard to the eight Tomy products. See id.
211. See id. at 907. In January of 1979, Tomy accused Durham of systematically copying eight Tomy toys and threatened to take legal action if the matter was not immediately resolved by other means. Beating Tomy to court, in February of 1979, Durham filed an action against Tomy seeking a declaratory judgment to the effect that in marketing its line of toys, Durham had violated no legal rights of Tomy. See id.
212. See id. at 908.
ald Duck, and Pluto. Durham manufactured and distributed virtually indistinguishable versions of these Disney figures. Durham admitted that they used Tomy's Disney figures as models in the creation of the Durham products. As a result, Tomy asserted that Durham infringed upon Tomy's exclusive right to copy its own creations.

As a threshold matter, Circuit Judge Meskill stated that "a party must demonstrate the existence and the validity of its copyright, for in the absence of copyright... protection, even original creations are in the public domain and may be freely copied." Holding transformation of an existing recognizable form from one media to another alone provides insufficient grounds for supporting a copyright, Messkill deemed Tomy's copyrights on the three Disney figures invalid. The three Tomy figures are instantly identifiable as embodiments of the Disney characters in yet another form: Mickey, Donald and Pluto are now represented as small, plastic, wind-up toys.

One look at Tomy's figures reveals that, in each, the element of originality that is necessary to support a valid copyright is totally lacking. For half a century or so Disney's characters have peered at us from movie screens, comic books, television sets, posters, clothing, watches, dolls, and a variety of other media, and it would be safe to say that they have a recognition factor that any politician or celebrity would envy.

Neither party contested that Walt Disney created and owns
the underlying works in the three characters. Judge Meskill explained that the classification of these items as derivative works bore no relation to the copyright law analysis and certainly did not create a de facto bar to copyrightability. Nonetheless, copyright law does subject derivative works to two important and related limitations.

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

Based on this two-part test, Judge Meskill deduced that "the only aspects of Tomy's Disney figures entitled to copyright protection are the non-trivial, original features, if any, contributed by the author or creator of these derivative works." Judge Meskill cited an earlier decision from the Second Circuit, L. Batlin & Son, Inc. v. Snyder. Though Batlin dealt with the concepts of originality and triviality as they applied to a derivative work based on an article in the public domain, Judge Meskill held that "the standard announced in Batlin by which the copyrightability of a derivative work is to be determined is fully applicable" to "preexisting works [that] are themselves the subjects of copyrights and are therefore not in the public domain."

Judge Meskill focused on the Batlin court's explicit refusal to infer originality in the mere reproduction of a work of art in a different medium or by the demonstration of some "physical," as opposed to "artistic," skill. Finding no copyrightability, the Durham Industries court declined to follow Doran. In doing so, Durham Industries seemed to establish

220. See id. at 909.
221. See Durham Indus., 630 F.2d at 909 ("Derivative works are explicitly included in the subject matter of copyright as defined by the Copyright Act.") (citing 17 U.S.C. § 103 (1994)).
223. Id.
224. L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486 (2d Cir. 1976) (en banc).
225. See Durham Indus., 630 F.2d at 909.
226. Id.
227. See id. at 910 (citing L. Batlin & Son, 536 F.2d at 491).
an alternative analysis for derivative works based on copyrighted materials as opposed to those based on information in the public domain. Judge Meskill held:

[The mere reproduction of the Disney characters in plastic, even though the adaptation of the preexisting works to this medium undoubtedly involved some degree of manufacturing skill, does not constitute originality as this Court has defined the term. Tomy has demonstrated, and the toys themselves reflect, no independent creation, no distinguishable variation from preexisting works, nothing recognizably the author's own contribution that sets Tomy's figures apart from the prototypical Mickey, Donald, and Pluto, authored by Disney and subsequently represented by Disney or its licensees in a seemingly limitless variety of forms and media.229

Any less of a standard "would simply put a weapon for harassment in the hands of mischievous copiers . . ."230 Recognizing that this case examined derivative works based on protected underlying works, Judge Meskill stated,

In the instant case, our concern is with carrying out the statutory command that protection of a derivative work not affect the scope of copyright protection in an underlying work. If we were to recognize Tomy's derivative copyrights in its figures, those who, like Durham, have obtained from Disney the right to copy Disney's own characters would, as a practical matter, have to make substantial changes in these characters in order to avoid infringing Tomy's rights. . . . Thus it is clear that the originality requirement imposed by the Constitution and the Copyright Act has particular significance in the case of derivative works based on copyrighted preexisting works.231

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229. Durham Indus, 630 F.2d at 910 (emphasis added) (citing L. Batlin & Son, 536 F.2d at 490; Alfred Bell & Co. v. Catalda Fine Arts, 191 F.2d 99, 102-03, 105 (2d Cir. 1951)).
230. Id. (citing L. Batlin & Son, 536 F.2d at 492).
231. Id. at 910-11 (emphasis added). Judge Meskill added:

In theory, of course, there would be no infringement of Tomy's rights if Durham copied Disney's characters and not Tomy's figures . . . but because proof of access plus substantial similarity can support a finding of infringement, Durham would at the very least be vulnerable to harassment. Yet any significant changes made by Durham to avoid liability would carry it away from the original Disney characters, in which Tomy concededly has no copyrights, and Disney's right to copy (or to permit others to copy) its own creations would, in effect, be circumscribed.
Based on this reasoning, Circuit Judge Meskill concluded that Tomy’s Disney figures lacked “even a modest degree of originality,” finding the work not copyrightable.232

2. Working Durham Industries’s Test in Weissmann

Courts continually apply Durham Industries’s two-part test, as the Second Circuit did when it considered the professor/assistant relationship in Weissmann v. Freeman.233 However, Weissmann demonstrates that the Durham Industries two-part test does not savagely preclude the formation of derivative works simply because the underlying work still enjoys copyright protection.234

Dr. Heidi Weissmann and Dr. Leonard Freeman formed their professional relationship in 1977.235 Beginning in 1980, they worked together as researchers and co-authors of a number of papers focusing on various aspects of nuclear medicine, particularly iminodiacetic acid imaging.236 In 1985, Weissmann authored an article entitled “Hepatobiliary Imaging, (P-i)” (“P-1”) and reported on a relatively new diagnostic technique employing radioactive analogs of the agent iminodiacetic acid.237 As opposed to strictly independent authorship, Weissmann derived this paper from a virtually verbatim culmination of previous papers jointly written by the parties during the course of their professional relationship.238

In response to an invitation to present a review course on nuclear medicine in the summer of 1987, Freeman used Weissmann’s P-1, replacing her name with his own and add-

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232. Id. at 911 (citations omitted).
233. Id. The copyrights in the miscellaneous toys were valid.
234. See id.
235. See id. at 1315.
236. See id. at 1315–16.
237. See id. at 1316.
238. See id.

Although P-1 appears to restate the central propositions asserted in the prior works, Weissmann’s exhibits include the following new elements: (1) a new selection of photo illustrations and associated captions; (2) references to four recent reports in the pertinent literature; (3) new textual additions; and (4) reorganization of previous material. [Freeman] conceded at trial that this material in P-1 was created solely by [Weissmann].

Id.
ing three words to the title.\footnote{See Weissmann, 868 F.2d at 1316. \textit{Eighty} copies of the article were made. See id.} Prior to the beginning of the course, Weissmann requested that her revised article not be circulated.\footnote{See id.} Freeman acquiesced to the removal of the article from the packet of course materials and delivered his lecture not only without including materials added to P-1 by Weissmann, but also without including excerpts from the portion of P-1 for which he could be accredited authorship.\footnote{See id.} Nonetheless, Weissmann filed suit alleging copyright infringement.\footnote{See id.}

The district court concluded that Freeman's use of P-1 did not violate any of Weissmann's rights.\footnote{See id.} The court held that certain materials contained within P-1 could be attributed solely to Weissmann's efforts, but constituted too trivial an addition to qualify for protection as a derivative work under the copyright statute.\footnote{See id.} On appeal, Circuit Judge Cardamone addressed this issue.\footnote{See id.}

Since Freeman admitted to copying the article, the only question remaining to establish a claim of copyright infringement involved "whether Dr. Weissmann owned a valid copyright in a so-called derivative work."\footnote{Citing Durham Industries's two-part test, Judge Cardamone addressed the originality requirement in derivative works. See id.} Following \textit{Alfred Bell & Co. v. Catalda Fine Arts, Inc.}, Judge Cardamone explained that "[a]ll that is needed to satisfy both the Consti-

\footnote{239. See Weissmann, 868 F.2d at 1316. \textit{Eighty} copies of the article were made. See id.}
\footnote{240. See id.}
\footnote{241. See id.}
\footnote{242. See id. at 1316. Weissmann requested a declaration that Freeman had committed actionable infringement, an injunction permanently restraining him from infringing, and an award of actual damages and profits. See id.}
\footnote{243. See id. (citing Weissmann v. Freeman, 684 F. Supp. 1248, 1260 (S.D.N.Y. 1988)).}
\footnote{244. See id. (adding that even were Freeman not a joint author of the allegedly infringed work, and even were P-1's new matter copyrightable, Freeman's purported use of P-1 was a fair use within the purview of § 107 of the Copyright Act) (citing Weissmann, 684 F. Supp. at 1261–62).}
\footnote{245. See Weissmann, 868 F.2d at 1313.}
\footnote{246. \textit{Id.} at 1320–21 ("Although [Weissman's] certificate of registration 'constitute[s] prima facie evidence of the validity of the copyright and of the facts stated in the certificate,' it is not conclusive on the issue of copyrightability; it merely creates a presumption of validity.") (citing 17 U.S.C. § 410(c) (1994); Durham Indus., Inc. v. Tomy Corp., 630 F.2d 905, 908 (2d Cir. 1980); Past Pluto Prods. Corp. v. Dana, 627 F. Supp. 1435, 1440 (S.D.N.Y. 1986)).}
\footnote{247. See id.}
\footnote{248. \textit{Alfred Bell & Co. v. Catalda Fine Arts, Inc.}, 191 F.2d 99 (2d Cir. 1951).}
tution and the statute is that the ‘author’ contributed something more than a ‘merely trivial’ variation, something recognizably ‘his own.’ The originality requirement for a revised version represents a “minimal” or “modest” original addition.\textsuperscript{250}

District Judge Pollack believed that “the update was done as part of the evolution of the stock piece” and that Weissmann’s modifications of the preexisting joint works did not warrant copyright protection.\textsuperscript{251} Circuit Judge Cardamone criticized this belief by opining, “the district court implausibly overlooked the fact that appellant’s 1985 selection of subject matter and content drawn from prior works and their rearrangement in P-1 is sufficiently the product of original authorship to warrant copyright protection.” Based on these sources of originality, “Dr. Weissmann’s additions and modifications to the preexisting joint work satisfy the modest requirements set forth in § 103(b) and in the relevant case law sufficiently to make P-1 entitled to copyright protection as a derivative work.”

\textit{Weissmann} typifies the complex issues facing courts in the arena of derivative works. More importantly, the analysis also proves that the two-part test in \textit{Durham Industries} has the capacity to provide guidance in determining the originality required in a derivative work based on a protected underlying work. While capable of producing diametrically opposite conclusions, as shown by comparing \textit{Durham Industries} to \textit{Weissmann}, the sliding scale approach to originality provides courts with flexibility. Despite the prolific use of the \textit{Durham Industries} two-part test, some courts promote a more stringent standard to receive copyright protection in a derivative work.

D. \textit{Propelling the Standard to New Heights}

In contrast to the established test in \textit{Durham Industries},

\textsuperscript{249} Weissmann, 868 F.2d at 1321 (emphasis added) (citing Alfred Bell & Co., 191 F.2d at 102–03).
\textsuperscript{250} See id.
\textsuperscript{251} Id. at 1322 (explaining that the district court concluded that P-1 and its predecessors had evolved over an extended period of time and that Weissmann’s additions were minuscule, demonstrating little originality) (citing Weissman v. Freeman, 684 F. Supp. 1248, 1261 (S.D.N.Y. 1988)).
\textsuperscript{252} Id.
\textsuperscript{253} Id. at 1323.
some courts require a higher standard of originality for derivative works if based on protected underlying works. Circuit Judge Posner's decision in *Gracen v. Bradford Exchange* exhibits a demand for what may ultimately prove too high of a quantum of originality.

1. **Going Too Far with Gracen's “Substantial Difference”**

   In 1939, MGM produced and copyrighted the movie “The Wizard of Oz.” In 1976, MGM licensed Bradford Exchange to use characters and scenes from the movie in a series of collectors’ plates. Bradford Exchange invited several artists to submit paintings of Dorothy as played by Judy Garland, with the understanding that the artist submitting the best painting would be offered a contract for the entire series.

   Jorie Gracen produced a painting of Dorothy as played by Judy Garland. A shopping center exhibited Gracen's painting along with the other contestants' paintings for passersby to select a winner. Though Gracen won, she refused to sign Bradford Exchange's contract. Bradford Exchange then employed a non-competitor, James Auckland, and furnished him Gracen's painting to assist him in preparing his painting of Dorothy.

   Gracen, after obtaining a copyright registration on her painting, sued MGM, Bradford, Auckland, and the manufacturer of the plates for copyright infringement. The district court granted summary judgment against Gracen because she could not copyright her paintings and drawings as they were not original. The court further assessed Gracen as an in-

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255. See id. at 301.
256. See id.
257. See id. Bradford supplied each artist with photographs from the movie and instructions for the painting that included the following: “We do want your interpretation of these images, but your interpretation must evoke all the warm feeling the people have for the film and its actors. So, your Judy/Dorothy must be very recognizable as everybody's Judy/Dorothy.” Id.
258. See id.
259. See id.
260. See *Gracen*, 698 F.2d at 301.
261. See id. at 301.
262. See id. at 302. MGM and Bradford counterclaimed, alleging among other things that Gracen had infringed the copyright on the movie by showing her drawings and a photograph of her painting to people whom she was soliciting for artistic commissions. See id.
263. See id.
fringer of MGM's copyright. Judge Posner, writing for the Seventh Circuit, focused on "whether there [was] enough difference between the derivative and the underlying work to satisfy the statutory requirement of originality." He explained that "the concept of originality in copyright law has as one would expect a legal rather than aesthetic function—to prevent overlapping claims." Demonstrating a very result-oriented approach, Judge Posner analogized:

Suppose Artist A produces a reproduction of the Mona Lisa, a painting in the public domain, which differs slightly from the original. B also makes a reproduction of the Mona Lisa. A, who has copyrighted his derivative work, sues B for infringement. B's defense is that he was copying the original, not A's reproduction. But if the difference between the original and A's reproduction is slight, the difference between A's and B's reproductions will also be slight, so that if B had access to A's reproductions the trier of fact will be hard-pressed to decide whether B was copying A or copying the Mona Lisa itself.

Extending this analogy, Judge Posner conceded that there were "perceptible differences" between Gracen's painting and the underlying work, but ultimately concluded that:

[If the differences between Miss Gracen's painting of Dorothy and the photograph of Judy Garland as Dorothy were sufficient to make the painting original in the eyes of the law, then a painting by an Auckland also striving, as per his commission, to produce something "very recognizable as everybody's Judy/Dorothy" would look like the Gracen painting, to which he had access; and it would be difficult for the trier of fact to decide whether Auckland

264. See id. The court entered judgment for $1500 on MGM and Bradford's counterclaim. See id.
265. Id. (citing 17 U.S.C. § 102(a) (1994)). The court first decided whether Bradford Exchange had granted Gracen the authority to create a derivative work. See id. "[P]rotection 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." 17 U.S.C. § 103(a).
266. Gracen, 698 F.2d at 304 (citing L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486, 491–92 (2d Cir. 1976)).
267. Id. at 301 (emphasis added) (focusing on infringement instead of first establishing originality).
268. See id. at 304.
had copied her painting or the original movie stills.²⁶⁹ So the court “simplified” the process by requiring “a sufficiently gross difference between the underlying and the derivative work to avoid entangling subsequent artists depicting the underlying work in copyright problems.”²⁷⁰

Employing this reasoning, had Gracen painted Judy Garland from life, her painting would be copyrightable “even if we thought it kitsch; but a derivative work must be substantially different from the underlying work to be copyrightable.”²⁷¹ Evidencing his obvious bias against derivative works based on copyrighted underlying works, Judge Posner commented that “we do not think the difference is enough to allow her to copyright her painting even if, as we very much doubt, she was authorized by Bradford to do so.”²⁷² Needless to say, Gracen’s vast departure from the accepted two-part test in Durham Industries prompted criticism from commentators.²⁷³

Four years later, perhaps recognizing the impact of the Gracen holding, Posner retreated from Gracen’s “substantial

²⁶⁹. Id. at 304–05 (emphasis added). But see Pinkham v. Sara Lee Corp., 983 F.2d 824, 829 (8th Cir. 1992) (refusing to follow Judge Posner’s reasoning in Gracen).

²⁷⁰. Gracen, 698 F.2d at 305 (emphasis added) (“We are speaking, however, only of the requirement of originality in derivative works. If a painter paints from life, no court is going to hold that his painting is not copyrightable because it is an exact photographic likeness.”).

²⁷¹. Id. (emphasis added) (relying on L. Batlin & Son, 536 F.2d at 491); see Patterson & Joyce, supra note 62, at 763 n.157 (describing Judge Posner’s “substantially different” test as peculiar).

²⁷². Gracen, 698 F.2d at 305 (emphasis added); see Jaszi, supra note 8, at 460 n.12 (criticizing Judge Posner’s holding).

²⁷³. Judge Posner’s “peculiar” “substantial difference” test has elicited the following response:

As the father of the “law and economics” movement, Judge Posner should know better. The “law and economics” movement holds that legal doctrine is essentially an instrument to serve and promote the operation of free markets. Thus, the merit of any legal rule should be evaluated in terms of whether it tends to promote the “efficient” allocation of resources. Followers of the movement pride themselves on their willingness to apply their methodology to all bodies of legal doctrine, including those that one might assume should properly be shaped by non-economic considerations.

Quite apart from the fact that “law and economics” seems inimical to the Romantic vision of “authorship,” Judge Posner has specifically questioned this aspect of Romanticism. Here, consciously or unconsciously, he embraces it.

Jaszi, supra note 8, at 460 n.12 (citations omitted).
difference” test in *Saturday Evening Post Co. v. Rumbleseat Press.* The Saturday Evening Post Company granted Rumbleseat Press an exclusive license to manufacture porcelain dolls derived from Norman Rockwell illustrations published in the *Saturday Evening Post.* After the Saturday Evening Post Company cancelled the license, Rumbleseat continued making the dolls directly contrary to the terms of the license agreement.

Judge Posner, while citing *Gracen,* offered a different, seemingly lower standard for the requisite quantum of originality in derivative works. He stated “[w]orks derived from copyrighted material—‘derivative works’ as they are called—are copyrightable provided the derivative work has some incremental originality; the copyright in the derivative work is limited to that increment.”

2. *Encouraging the Confusion in Entertainment Research Group*

Despite Posner’s slight retreat in *Saturday Evening Post,* some jurists remain undaunted by both criticism of the “substantial difference” test and the inauguration of the slightly less imposing standard announced in *Saturday Evening Post.* Allowing the heightened standard to continue unabated, cases such as *Entertainment Research Group, Inc., v. Genesis Creative Group, Inc.* prove that novel elements of law, such as *Gracen*’s “substantial difference” test, sometimes prove surprisingly difficult to dispel or erase once incorporated.

For sixteen years, Entertainment Research Group, Inc. (ERG) designed and manufactured three-dimensional inflatable costumes based on cartoon characters for use in pub-

275. See id. at 1192–93.
276. See id.
277. *Gracen,* 698 F.2d at 300.
278. *Saturday Evening Post,* 816 F.2d at 1193 (emphasis added) (citing 17 U.S.C. §§ 101, 103(b) (1994); *Gracen,* 698 F.2d at 304–05; Durham Indus., Inc. v. Tony Corp., 630 F.2d 905, 909 (2d Cir. 1980)).
280. See id.
281. See id. at 1214. “For example, Pillsbury purchased ‘Pillsbury Doughboy’ costumes, Toys "R" Us purchased ‘Geoffrey the Giraffe’ costumes, and Quaker Oats Company purchased ‘Cap'n Crunch’ costumes.” *Id.* at 1214 n.2.
licity events, such as shopping mall openings. Genesis Creative Group, Inc. ("Genesis") sold ERG's products and performed related repair and maintenance services on a commission basis for ERG. By September 1990, more than forty-eight ERG-manufactured costumes representing thirteen different cartoon characters had apparently been sold and distributed by Genesis to at least nine different companies.

Though ERG and Genesis disagreed concerning the specifics of how their business relationship came to an end, Genesis apparently entered into a formal business relationship with Aerostar, an ERG competitor, to sell inflatable walk-around costumes manufactured by Aerostar to Genesis's customers. Amongst numerous related claims, ERG alleged that Genesis infringed its copyrights in these costumes.

While ERG urged the court to analyze the case in light of the Doran test, Circuit Judge Rea refused, as "Doran involved the copyrightability of a derivative work where the

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282. See id. at 1214.
283. See id. at 1215.
284. See id.
286. See id. at 1215.
287. See id.
288. See id. at 1219.
preexisting work belonged to the public domain" and was not copyrighted. The court stated that "[t]his difference is critical because in deciding whether to grant copyright protection to a derivative work, courts must be concerned about the impact such a derivative copyright will have on the copyright privileges and rights of the owner of the underlying work." The court reasoned that the body of derivative copyright law must balance between the holder of a copyright in the underlying work and the author of a work created by copying a substantial portion of that underlying work. Judge Rea concluded "because the Doran test completely fails to take into account the rights of the holder of the copyright for the underlying work, the Doran test should not be applied to determine the copyrightability of a derivative work that is based on a preexisting work that is itself copyrighted.

Rather, Judge Rea used the two-part test in Durham Industries 293 "to determine whether ERG's costumes are copyrightable as derivative works." Based on the assumption that "any aspects of ERG's costumes that are purely functional, utilitarian or mechanical will not be given any copyright protection," Judge Rea deemed that "any artistic differences in the costumes are merely trivial." Though ERG exercised a number of creative decisions in the development of an efficient and successful manufacturing process for the costumes, Judge Rea noted that "the courts and commentators seem to agree that making decisions that enable one to reproduce or transform an already existing work into another

289. Id. (emphasis added).
290. Id. at 1219 (citing 17 U.S.C. § 103(b) (1994)).
291. See Entertainment Research Group, 122 F.3d at 1219 (citing, Durham Indus., Inc. v. Tomy Corp., 630 F.2d 905, 910-11 (2d Cir. 1980)).
292. Id. ("In addition, it is not clear that we ever adopted the Doran test since our opinion affirming the district court's decision really focused on the similarity between the Santa Claus products at issue, rather than on the different 'forms' of the products.").
293. Id. at 1220.
294. Id.
295. Id. at 1221 (citing Fabrica Inc. v. El Dorado Corp., 697 F.2d 890, 893 (9th Cir. 1983)).
296. Id. at 1222.
297. See Entertainment Research Group, 122 F.3d at 1222 ("The problem with ERG's argument, however, is that originality is not present solely because Mr. Breed placed a lot of thought and effort into figuring out how to transform the two-dimensional copyrighted characters into three-dimensional inflatable costumes.").
medium or dimension—though perhaps quite difficult and intricate decisions—is not enough to constitute the contribution of something 'recognizably his own.'

Deciding that the differences in form, texture, and proportionality stemmed from functional considerations, "these so-called artistic differences are really nothing more than changes necessitated by utilitarian concerns." Because ERG's costumes were "instantly identifiable as embodiments" of the underlying copyrighted characters in "yet another form," the court concluded "that ERG's artistic contributions were merely trivial contributions."

Up to this point, Judge Rea's reasoning encouraged a peaceful slumber for Gracen's higher standard. Though discriminating against derivative works based on the status of the underlying work as either copyrighted or within the public domain, Judge Rea had not resuscitated Gracen's result-oriented reasoning. However, Judge Rea departed from this approach when considering the district court's erroneous interpretation of the second prong of Durham Industries's two-part test.

In reconsidering the second prong of the Durham Industries two-part test, Judge Rea rationalized that the second prong ensures that copyright protection is not afforded to derivative works whose originality consists of merely trivial additions. The court feared that granting copyright protection to a derivative work virtually identical to the underlying work would greatly interfere with the rights possessed by the owner of the underlying copyrighted work. Specifically, the owner of the derivative work, by virtue of that copyright, could meaningfully control the destiny of both the derivative work and the original underlying copyrighted work by deny-

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298. Id.; see, e.g., NIMMER, supra note 64, § 2.08(C), at 2; see also, e.g., Gallery House, Inc. v. Yi, 582 F. Supp. 1294, 1297 (N.D. Ill. 1984).
299. Entertainment Research Group, 122 F.3d at 1223.
300. Id. at 1223 (emphasis added).
301. See id. at 1219.
302. See id. at 1220 ("Section 103(b) mandates that the copyright protection for derivative works not affect the scope of any copyright protection in the underlying work. Copyright protection for underlying works would be affected—and, thus, § 103(b) would be violated—if derivative works without adequate originality were given copyright protection."). See, e.g., Gracen v. Bradford Exch., 698 F.2d 300, 304–05 (7th Cir. 1983); Durham Indus., Inc. v. Temy Corp., 630 F.2d 905, 910–11 (2d Cir. 1980); Moore Pub'g., Inc. v. Big Sky Mktg., 756 F. Supp. 1371, 1374 (D. Idaho 1990).
ing any other person the right to create a second derivative work based on the same underlying original. The derivative copyright holder would wield a *de facto* monopoly due to the "considerable power to interfere with the creation of subsequent derivative works from the same underlying work." Rather than allowing the original creator to approve or disapprove of the creation of derivative works from the underlying copyrighted item, as envisioned by the drafters of copyright law, this right would be shared between the original author and the author of the derivative work. Such results would not promote the goals of copyright law. Though a far cry from the "substantial difference" test enunciated in *Gracen*, *Entertainment Research Group* reinforces the pall of suspicion continually cast on derivative works based on protected underlying works.

While the holding in *Gracen* has inflated the quantum of originality needed to receive protection in derivative works based on a protected underlying work, the holding in *Entertainment Research Group* created an equally troubling conflict at the bottom end, or "floor," of the originality spectrum.

E. **Troubles with Tiles at the Floor of Originality**

The unpredictable and complex landscape of the law developing in assessing the quantum of originality necessary to create a derivative work has generated some interesting conflicts.

Just as some courts may be overly severe in their treatment of derivative works, others have taken a view so liberal as to make even the 'merely trivial' standard meaningless. This may be explained by an attempt to reward skilled artisans, punish unethical defendants, or offer a consolation prize for an underlying work that has arguably tumbled into the public domain.

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303. *Entertainment Research Group*, 122 F.3d at 1220 (citing *Gracen*, 698 F.2d at 305; *Durham Indus.*, 630 F.2d at 911).

This conclusion finds support in our decisions in the somewhat analogous context where we have decided not to grant copyright protection to an artist's presentation of a song—even under an unfair competition theory—where doing so would undermine the rights of the song's copyright holder by exposing her licensees to potential litigation.

*Id.* (citing *Sinatra v. Goodyear Tire & Rubber*, 435 F.2d 711, 718 (9th Cir. 1970)).

As demonstrated by the three-dimensional Santa Claus in *Doran*, a work may receive copyright protection as a derivative work even though the only derivation was to perform a mechanical transformation, such as by forming a three-dimensional Santa Claus.\(^{305}\) Other cases have held that such minuscule variations, imperceptible to the casual observer, are insufficient.\(^{306}\) Cases such as *Mirage Editions, Inc. v. Albuquerque A.R.T. Co.*,\(^{307}\) and *Lee v. A.R.T. Co.*\(^{308}\) illustrate the vastly different outcomes which occasionally arise when courts attempt to quantify originality in derivative works. Such varied results, caused by the application of differing originality standards, present a clear need for courts to develop a consistent requirement for the quantum of originality necessary to receive copyright protection of derivative works.

1. *The Mirage of Originality in Mirage Editions*

In *Mirage Editions, Inc. v. Albuquerque A.R.T. Co.*,\(^{309}\) Albuquerque A.R.T. purchased the commemorative book, a compilation of selected copyrighted individual art works and personal commentaries, entitled *NAGEL: The Art of Patrick Nagel*.\(^{310}\) Mirage Editions (“Mirage”) exclusively published and also owned the copyrights to many of Nagel’s works.\(^{311}\)

Albuquerque A.R.T. employees purchased artwork prints or books, glued each individual print onto a rectangular sheet of black plastic material, exposed a narrow black margin around the print, and fixed the black sheet onto the surface of a rectangular white ceramic tile.\(^{312}\) Next, Albuquerque A.R.T. employees applied a transparent plastic film over the print and offered the tile with artwork mounted thereon for sale in

\(^{305}\) See, e.g., Lone Ranger Television, Inc. v. Program Radio Corp., 740 F.2d 718, 722 (9th Cir. 1984); Paul Goldstein, Copyright: Principles, Law and Practice § 5.3.1 (2d ed. 1996) (suggesting that a transformation is covered by 17 U.S.C. § 106(2) whenever it creates a “new work for a different market”).


\(^{308}\) Lee v. A.R.T. Co., 125 F.3d 580, 580 (7th Cir. 1997).

\(^{309}\) See *Mirage Editions*, 856 F.2d at 1341.

\(^{310}\) See id. at 1342 (“Patrick Nagel was an artist whose works appeared in many media including lithographs, posters, serigraphs, and as graphic art in many magazines, most notably Playboy.”).

\(^{311}\) See id.

\(^{312}\) See id.
the retail market.\textsuperscript{313}

Pertinent to the resulting litigation, Albuquerque A.R.T. performed this process with images from the Nagel book,\textsuperscript{314} essentially resulting in a product transformed from an underlying copyrighted work. In response, Mirage brought an action alleging infringement of registered copyrights in the artwork of Nagel and in the book.\textsuperscript{315}

Granting Mirage's motion for summary judgment,\textsuperscript{316} the court enjoined "appellants from removing individual art images from the book, mounting each individual image onto a separate tile and advertising for sale and/or selling the tiles with the images mounted thereon."\textsuperscript{317} Reviewing the production process of Albuquerque A.R.T.'s tile art, the district court "concluded that the resulting products comprised derivative work."\textsuperscript{318}

Consistent with the district court's reasoning, Circuit Judge Brunetti, speaking for the Ninth Circuit, extolled that "[t]he protection of derivative rights extends beyond mere protection against unauthorized copying to include the right to make other versions of, perform, or exhibit the work."\textsuperscript{319} Judge Brunetti reasoned that what Albuquerque A.R.T. "has clearly done here is to make another version of Nagel's art works... and that amounts to preparation of a derivative work."\textsuperscript{320} The court advanced the legislative history sur-

\textsuperscript{313} See id.
\textsuperscript{314} See id.
\textsuperscript{315} See Mirage Editions, 856 F.2d at 1342. Mirage also alleged trademark infringement and unfair competition. See id.
\textsuperscript{316} See id. at 1343 (basing the motion for summary judgment on both Lanham Act and Copyright Act causes of action).
\textsuperscript{317} Id.
\textsuperscript{318} Id. (stating that the Copyright Act of 1976 grants the right to prepare derivative works based upon the copyrighted work).
\textsuperscript{319} Id. (quoting Lone Ranger Television v. Program Radio Corp., 740 F.2d 718, 722 (9th Cir. 1984); Russell v. Price, 612 F.2d 1123, 1128 n.16 (9th Cir. 1979)). See Recent Case: Copyright Law—Derivative Works—Seventh Circuit Holds That Mounting Copyrighted Notecards on Ceramic Tiles Does Not Constitution Preparation of Derivative Works in Violation of the Copyright Act—Lee v. A.R.T. Co., 125 F.3d 580 (7th Cir. 1997), 111 HARV. L. REV. 1365, 1368–69 (1998) [hereinafter Recent Case] (analyzing the paradigms for copyright protection in an effort to understand Circuit Judge Brunetti's holding).
\textsuperscript{320} Mirage Editions, 856 F.2d at 1343 (citations omitted). The court reasoned that "[b]y borrowing and mounting the preexisting, copyrighted individual art images without the consent of the copyright proprietors—Mirage and Dumas as to the art works and Van Der Marck as to the book—appellant has prepared a derivative work and infringed the subject copyrights." Id.
rounding derivative works\textsuperscript{321} to sustain its conclusion that Albuquerque A.R.T. "has certainly recast or transformed the individual images by incorporating them into its tile-preparing process."\textsuperscript{322}

Ignoring the viability of the first sale doctrine\textsuperscript{323} defense to Mirage's infringement claims,\textsuperscript{324} the court concluded that Albuquerque A.R.T.'s tile-preparing process created derivative works that infringed Mirage's exclusive rights.\textsuperscript{325} This court did not apply the Durham Industries two-part test; instead, Judge Brunetti employed a Doran-type analysis to find a minimal amount of originality in the tile creation process. Mirage Edition granted authors holding rights in underlying works more protection than other courts. Unfortunately, the trend continued.

The Ninth Circuit applied consistent reasoning in the unpublished decision of Munoz v. Albuquerque A.R.T. Co.\textsuperscript{326} Reviewing a similar tiling process, the court again ruled that the mere transformation of the underlying work satisfied all prerequisites to obtain protection as a derivative work.\textsuperscript{327} Following the holding in Mirage Editions, the court held that incorporating Rie Munoz prints onto ceramic tiles constituted

\textsuperscript{321} See id. at 1343–44 ("The legislative history of the Copyright Act of 1976 indicates that Congress intended that for a violation of the right to prepare derivative works to occur 'the infringing work must incorporate a portion of the copyrighted work in some form.'").

\textsuperscript{322} Id. at 1344.

\textsuperscript{323} See 17 U.S.C. § 109(a) (1994) ("Notwithstanding the provisions of Section 106(3), the owner of a particular copy or phonorecord lawfully made under this title, or any person authorized by such owner, is entitled, without the authority of the copyright owner, to sell or otherwise dispose of the possession of that copy or phonorecord.").

\textsuperscript{324} See Mirage Editions, 856 F.2d at 1344. The court stated:

We recognize that, under the "first sale" doctrine as enunciated at 17 U.S.C. § 109(a) . . ., [Albuquerque A.R.T. Co.] can purchase a copy of the Nagel book and subsequently alienate its ownership in that book. However, the right to transfer applies only to the particular copy of the book which appellant has purchased and nothing else. The mere sale of the book to the appellant without a specific transfer by the copyright holder of its exclusive right to prepare derivative works, does not transfer that right to [Albuquerque A.R.T. Co.].

\textit{Id.} at 1344.

\textsuperscript{325} See id. (stating that Dumas and Van Der Marck also have the right to create derivative works).


\textsuperscript{327} See id.
derivative works.\textsuperscript{328}

2. \textit{Less Leeway for Derivative Works in Lee}

Though the Ninth Circuit continues to find derivative works in what may be described as mere mechanical transformations,\textsuperscript{329} other courts, such as the Seventh Circuit in \textit{Lee v. A.R.T. Co.},\textsuperscript{330} continue to apply a more traditional, logical approach.

Annie Lee sold her works of art to Deck the Walls, a commercial dealer of art.\textsuperscript{331} Deck the Walls sold some of Lee's notecards and small lithographs to A.R.T. Company.\textsuperscript{332} A.R.T. employees bought the work legitimately, mounted it on a tile, and resold what it had purchased.\textsuperscript{333} In contrast to \textit{Mirage Editions}, Circuit Judge Easterbrook, speaking for the Seventh Circuit, reasoned that "[b]ecause the artist could capture the value of her art's contribution to the finished product as part of the price for the original transaction, the economic rationale for protecting an adaptation as 'derivative' is absent."\textsuperscript{334}

\textsuperscript{328} See \textit{id.}; see also \textit{Greenwich Workshop, Inc. v. Timber Creations, Inc.}, 932 F. Supp. 1210 (C.D. Cal. 1996) (following the binding precedent of \textit{Mirage Editions}, the court held that the matting and framing artwork removed from copyrighted book constituted derivative work infringing copyright in book and artwork).

\textsuperscript{329} See \textit{Recent Case, supra} note 319, at 1368 (criticizing the Ninth Circuit's definition of derivative works).

\textsuperscript{330} \textit{Lee v. A.R.T. Co.}, 125 F.3d 580 (7th Cir. 1997).

\textsuperscript{331} See \textit{id.}

\textsuperscript{332} See \textit{id.} at 580.

\textsuperscript{333} See \textit{id.} at 581. District Court Judge Norgle stated that "the \textit{Munoz} case involved strikingly similar facts." \textit{Lee v. Deck The Walls, Inc.}, 925 F. Supp. 576, 578 (N.D. Ill. 1996).


An alteration that includes (or consumes) a complete copy of the original lacks economic significance. One work changes hands multiple times, exactly what \$ 109(a) permits, so it may lack legal significance too. But \$ 106(2) creates a separate exclusive right, to "prepare derivative works," and Lee believes that affixing the art to the tile is "preparation," so that A.R.T. would have violated \$ 106(2) even if it had dumped the finished tiles into the Marianas Trench.

\textit{Id.} See \textit{Recent Case, supra} note 319, at 1365 (criticizing the breadth of the Seventh Circuit's approach).

The Seventh Circuit reached the proper result in rejecting the plaintiff's unjustifiably broad interpretation of 106(2) of the Copyright Act. However, the court's introductory dicta—that derivative works protection should depend exclusively on economic considerations—repre-
District Court Judge Norgle concluded that A.R.T.'s mounting of Lee's works on tile did not constitute an "original work of authorship" because it did not differ in form or function from displaying a painting in a frame or placing a medallion in a velvet case.\(^{335}\) In contrast to Munoz and Mirage Editions, Lee refused to recognize that the bonding of the art by epoxy resins to a tile created a derivative work.\(^{336}\) Essentially, Lee concurred with the cases discussed above, in which works created from copyrighted underlying works did not receive derivative work status where the creator proved only a transformation in form from the original work.

Judge Easterbrook agreed with the district court, holding that the tiles did not amount to art reproductions.\(^{337}\) A.R.T. simply purchased and mounted Lee's original works without changing them or creating an original addition within the newly created piece.\(^{338}\) Judge Easterbrook, mindful of the absurd implications from the holding in Mirage Editions, playfully mused over whether a purchaser would create a derivative work by jotting a note on one of the note cards, using it as a coaster for a drink, applying his collector seal, or cutting it in half.\(^{339}\) Based on these spiraling connotations, Judge Easterbrook retorted that "[a] definition of derivative work that makes criminals out of art collectors and tourists is jarring despite Lee's gracious offer not to commence civil litigation."\(^{340}\)

\(^{335}\) See Lee, 125 F.3d at 581 ("No one believes that a museum violates § 106(2) every time it changes the frame of a painting that is still under copyright, although the choice of frame or glazing affects the impression the art conveys, and many artists specify frames (or pedestals for sculptures) in detail.").

\(^{336}\) See id. (recognizing, in contravention of Mirage Editions, that the normal means of mounting and displaying art are easily reversible).

\(^{337}\) See id. at 582 (discussing how A.R.T.'s actions do not fit the definition of recast, transformed, or adapted).

\(^{338}\) See id. (stating that the tiles still depicted the same image that they contained when they left Lee's studio in disapproval of Mirage Editions) (citing 2 WILLIAM F. PATRY, COPYRIGHT LAW AND PRACTICE 823–24 (1994)).

\(^{339}\) See id.

\(^{340}\) Id. (refuting Lee's explanation that "as a practical matter artists would not file suit").
3. Precious Guidance from Precious Moments

Like stalwart warriors locked in fierce opposition, the Seventh Circuit and the Ninth Circuit existed deadlocked at the shallow end of the originality pool, one applying hybrid standards affected by the public domain status of the underlying work, the other remaining true to the more traditional approaches. However, in the clash between the two, it sometimes takes an ally to best the foe. In swaying the tally in favor of retaining the traditional approaches to originality standards, Precious Moments, Inc. v. La Infantil, Inc. departed from the reasoning of Mirage Editions.

Precious Moments sued La Infantil for using authentic, lawfully acquired Precious Moments fabric to manufacture and sell baby bedding. When considering whether La Infantil created a derivative work, District Court Judge Perez-Gimenez criticized the reasoning of the Ninth Circuit when dealing with the originality requirement for derivative works. He explained that "[t]he Ninth Circuit requires one seeking a copyright in a derivative work to meet all the requirements of copyrightability but does not require a work to be independently copyrightable in order for it to be considered a derivative work infringing on the underlying work."

343. Precious Moments is a company engaged in the business of licensing the "Precious Moments" trademark and artwork to licensees who manufacture and distribute numerous products, including greeting cards, figurines, stationery, jewelry, dolls, fabrics, baby bedding, and baby accessories. See Precious Moments, 971 F. Supp. at 66-67.
344. La Infantil is "[a] retail store that sells baby products, including furniture, bedding, clothes, and accessories. Some of the bedding it sells is manufactured by Teresita Martin Sewing Service from authentic, lawfully-acquired Precious Moments fabrics." Id. at 67. Precious Moments, Inc. sued La Infantil, Inc. for "copyright and trademark infringement, unfair competition, and dilution under federal and Puerto Rico law." Id.
345. See id. at 66. Precious Moments additionally alleged that La Infantil was "selling counterfeit Precious Moments products, [but] the evidence presented with the motion for a preliminary injunction did not support that allegation and the issue dropped out of the case at the preliminary injunction hearing." Id. at 67 n.1.
346. See id. at 68.
347. Id. (citing Lewis Galoob Toys, Inc. v. Nintendo of Am., Inc., 964 F.2d 965, 967-69 (9th Cir. 1992) (holding that fixation in a tangible medium of expression is unnecessary for derivative work to infringe)).
Judge Perez-Gimenez approved of the reasoning in *Lee* that denounced the Ninth Circuit's double standard. In *Lee*, the court found that *Mirage Editions*'s "(1) 'risks that courts will naively apply this broad definition to find activities infringing that are more properly viewed as altogether beyond the scope of copyright,' and (2) ignores the definition of a 'derivative work' found in § 101, in which Congress specifically included an originality requirement." In unison with Judge Perez-Gimenez's criticisms of the dangerous holding in *Mirage Editions*, commentators also express their concern at the "unwarranted extension of the Copyright Act.

The court in *Precious Moments*, in direct contravention of the Ninth Circuit's holding in *Mirage Editions*, found that the necessary element of originality was absent from the items manufactured for La Infantil from the Precious Moments fabric. Because the works in question did not evidence the requisite originality, they "do not constitute 'derivative works' infringing on Precious Moments's copyright."

In conclusion, while the courts in *Lee* and *Precious Moments* desperately try to stem an unimaginable flood of derivative works, the Ninth Circuit has opened the copyright regime to incomprehensible abuse. At minimum, *Mirage Edi-

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348. See id. at 69.


Reading Galoob in conjunction with *Mirage Editions*, however, it appears that the Ninth Circuit also relaxes the originality requirement when considering whether a work is a derivative work for purposes of infringement. Even if Galoob was correct with regard to fixation, *Mirage Editions* reads the originality requirement out of the definition of "derivative work."

*Id.* at 67 n.4.


351. See *Precious Moments*, 971 F. Supp. at 69.

352. *Id.*
IV. CONCLUSION

As the foregoing case law evidences, the perpetual vacillation in the "more than merely trivial" standard has prompted an urgent need for judges to adopt a consistent test to adjudicate the quantum of originality necessary to receive copyright protection in a derivative work. Courts can forge the various standards enunciated in the survey of cases presented in this article to structure a unified standard that greatly simplifies the copyright law analysis of originality.

In short, copyright law must continue to grow and change, but do so responsibly. Judges must remember to exercise caution when venturing too far from the "more than merely trivial" "distinguishable variation" standard. Requiring too much originality or recognizing too little of a variation unjustifiably burdens an already unwieldy area of the law. Without employing the heightened Gracen standard and by rejecting the lowered Mirage Editions standard, judges should follow the two-part test of Durham Industries with confidence that the derivative works created will enrich our society without burdening the rights enjoyed in the underlying works.

The legislature expected the courts to define this originality requirement. Though occasionally deviating "trivially" from the path, the majority of the decisions form a cohesive, consistent understanding that a derivative work should demonstrate "more than merely trivial" "distinguishable variations" from the underlying work that are attributable to the author. Finally, because copyright protection does not extend to the unoriginal elements of a derivative work, discrimination against derivative works that are based on protected, underlying works is inappropriate.

Decisions such as Mirage Editions and Gracen should not be inferred to alter the quantum necessary to attain protec-

353. Compare Mirage Editions, Inc. v. Albuquerque A.R.T. Co., 856 F.2d 1341, 1343 (9th Cir. 1988) (finding a derivative work based on a tiling method), with Gracen, v. Bradford Exch., 698 F.2d 300, 305 (7th Cir. 1983) (refusing to find a derivative work to sustain a suspicion that permission was not properly given by the author of the underlying work).
tion. Circuit Judge Frank's expectation of "more than merely trivial" "distinguishable variations" in Alfred Bell & Co.\textsuperscript{354} remains a tenable and useful standard to judge whether a derivative work, irrespective of the public domain or copyright protected status of the underlying work, can demonstrate sufficient originality to enjoy copyright protection.

\textsuperscript{354} Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 105 (2d Cir. 1951).