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The Derivative Right, or Why Copyright Law Protects Foxes Better than Hedgehogs

Daniel Gervais, Ph.D.*

ABSTRACT

The derivative right is at the very core of copyright theory. What can and cannot be reused to create a new work impacts freedom of expression but also impacts the value of the markets for works and their various “derivatives.” The derivative right includes forms of derivation and adaptation, such as making a movie from a novel or translating a book. It also covers what this Article refers to as penumbral derivatives, which the US Copyright Act captures using the phrase “based upon” with respect to preexisting works. This leads to indeterminacy about the scope of the derivative right, which may have chilling effects on nonprofessional Internet users who may not have the time, desire, or resources to consider or negotiate copyright rights. This Article acknowledges that derivation often includes reproduction of all or part of a preexisting work. How is the derivative right different from the right of reproduction? That is the main question tackled in this Article. Using the Berne Convention negotiating history, as well as US, British, French, and German jurisprudence, this Article suggests that the derivative right has a different normative target than the right of reproduction, in spite of their considerable overlap. The Article enunciates six mobilizing principles, which it then proceeds to

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demonstrate. The Article also argues and demonstrates in particular that there is a hard line that divides fundamental changes that are noninfringing under a proper derivative right analysis (in most cases because the idea, not the expression, is appropriated), and those that are noninfringing as transformative fair uses. Finally, the Article strikes a note of caution specific to appropriation art.

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The lumpish and rather capacious notion of “derivative work,” added to the US Copyright Act in 1976, is at the very heart of copyright theory and practice.¹ Yet thirty-five years after its injection

1. See 17 U.S.C. § 101 (2006) (defining “derivative work”); § 103 (making “derivative works” copyrightable subject matter); § 106(2) (giving copyright owners the right “to prepare derivative works”). The Author will say more on the importance of the notion in the text preceding Part I.

in the statute, serious doubts remain about its scope and purpose.² If our understanding of this notion is nebulous, it is not because the derivative right does not matter—quite the opposite: The scope of the derivative right directly impacts the range of lawful reuses of a work or, viewed from across the fence, reuses that a copyright owner can prohibit.³ This includes several types of online uses and, most notably, user-generated content (UGC).⁴ As such, this Article builds on work previously published in the *Vanderbilt Journal of Entertainment and Technology Law*.⁵

Not surprising given the importance of the derivative right, a substantive debate on its purpose and scope has been ongoing in both courts and scholarly literature since at least the early 1980s.⁶ This debate has reached a new level of acuteness with remixes, mash-ups, and more generally the transition from a professional one-to-many entertainment infrastructure to a many-to-many—and in large measure amateur—environment in which financial incentives are often not a significant motivation for creation.⁷ Indeterminacy about the scope of the derivative right may have more perceptible chilling effects on nonprofessional Internet users because they may not have the time, desire, or resources to consider or negotiate copyright

2. After years of tergiversations, we are no closer to a workable understanding. As William Patry noted, “regrettably the understanding of derivative works is fast approaching incomprehensibility.” WILLIAM F. PATRY, PATRY ON COPYRIGHT § 3.46 (2012). Incomprehensible, perhaps, yet it is also fascinating both intellectually and as a matter of policy for user-generated content (UGC), appropriation art, and other new forms of cultural expression.

3. Under 17 U.S.C. § 106(2), a copyright owner can prohibit the making of derivative works, which the statute defines in part as works “based upon” the author’s work. 17 U.S.C. § 101.

4. See Daniel Gervais, *The Tangled Web of UGC: Making Copyright Sense of User-Generated Content*, 11 VAND. J. ENT. & TECH. L. 841, 842–43 (2009).

5. See *id.*

6. See, e.g., *Zomba Enters., Inc. v. Panorama Records, Inc.*, 491 F.3d 574 (6th Cir. 2007) (holding unauthorized sound recordings of music for karaoke infringed); *Mulcahy v. Cheetah Learning LLC*, 386 F.3d 849 (8th Cir. 2004) (reversing summary judgment and remanding for analysis of derivative-work claim in case involving condensation of test materials); *Castle Rock Entm’t, Inc. v. Carol Publ’g Grp., Inc.*, 150 F.3d 132 (2d Cir. 1998); *Radji v. Khakbaz*, 607 F. Supp. 1296 (D.D.C. 1985) (holding unauthorized translation of substantial excerpts from plaintiff’s book infringed the derivative right); see also PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 7.3 (3d ed. 2012); Naomi Abe Voegtli, *Rethinking Derivative Rights*, 63 BROOK. L. REV. 1213, 1267 (1997) (proposing inter alia a narrow formulation of the derivative right, in addition to broader fair use and a possible compulsory license). Professor Wu’s article on complementary works is also thought provoking. See Tim Wu, *Tolerated Use*, 31 COLUM. J.L. & ARTS 617, 631 (2008) (arguing that complementary works should not be deemed infringing).

7. See Niva Elkin-Koren, *Tailoring Copyright to Social Production*, 12 THEORETICAL INQUIRIES L. 309, 342–43 (2011). Elkin-Koren suggests that a world in which both true amateur creators (who do not want to get paid and are not merely thinking there is no practical way to do so) and professional creators produce content maximizes general welfare. *Id.* In other words, it is a world in which our greatest novelists and songwriters do not need a day job. *Id.*

rights.⁸ Hence, what may have been a mostly theoretical debate about what is protectable (and hence may not be reused without authorization) when it was a matter for professionals who translated books, adapted plays or novels for the cinema, and prepared abridged versions, now affects anyone making and uploading UGC.⁹

Courts and scholars need to work harder to foster clarity with respect to the derivative right, in part to compensate for the US Copyright Act's unhelpfulness in setting limits. The derivative right in the statute is open ended in that it includes *named derivatives* (which correspond to major, traditionally licensed reuses of preexisting works such as translations), but also an unbounded number of other derivations that also require authorization.¹⁰ The Copyright Act defines that part of the right very broadly as a right *to prevent the making of any work "based upon" a preexisting work*.¹¹ The growth of a vibrant culture, one making full use of the potential of digital tools to create and disseminate new works (in particular the potential of the Internet) within a copyright-compatible framework, is at stake.¹²

Beyond the risks that exercising a vague right entails for users, a more theoretical reason why clarity is crucial is that the derivative right lies at the core of copyright theory. It is situated at the essential border between infringement and inspiration. Drawing its limits is thus an inevitable step of any effort to develop an understanding of what uses and reuses are allowed. The task is to explicate, define, and properly cabin the derivative right.¹³ This is not a debate about semantics; it is about the ability of a copyright owner to prevent others from creating by reusing nonliteral parts of her work. More specifically, the doctrinal and normative challenge is two-fold: first, to define the derivative right properly, which would seem to presuppose a good understanding of its foundations and purpose; and second, to develop an adequate test to implement the right thus delineated.

To achieve these dual objectives, and in light of the relative paucity of statutory guidance, this Article looks for answers in

8. See *id.* at 344–46.

9. See Daniel Gervais, *User-Generated Content and Music File-Sharing: A Look at Some of the More Interesting Aspects of Bill C-32*, in FROM "RADICAL EXTREMISM" TO "BALANCED COPYRIGHT": CANADIAN COPYRIGHT AND THE DIGITAL AGENDA 447, 467–72 (Michael Geist ed., 2010).

10. See Voegtli, *supra* note 6, at 1267.

11. 17 U.S.C. § 101 (2006) (defining "derivative work"); see also *infra* note 95 and accompanying text.

12. Another important area of culture directly impacted by the definition of the derivative right is appropriation art. See *infra* Part V.

13. See 17 U.S.C. § 106(2).

international and other comparative sources that have been grappling with a notion of adaptation or derivation for much longer than the US statute.¹⁴ The current US approach, as Part I.A explains, is essentially to subsume reuses of copyrighted material under the reproduction right, thus creating a complete overlap with the idea-expression dichotomy and leaving very little work for the derivative right, in spite of the broad statutory language. Yet Congress specifically carved out forms of reuse and identified them as derivative uses—some of which fall outside the scope of the reproduction right. That must mean something. This Article suggests that we should apply different analyses to reuses that *transform* the content used, in ways Part II defines, versus other cases of reproduction. Otherwise, the statute's definition of "derivative work," and the inclusion of a derivative right in 17 U.S.C. § 106(2), is meaningless.¹⁵

Another view in the literature is that, in functional terms, the role of the derivative right is a tool to catch unfixed derivatives, for instance performances.¹⁶ This jars with the importance of many of the named derivatives in the statute (e.g., translations). It perhaps follows from the confusion that one can infringe the derivative right without fixation of the infringing derivative use, but one cannot get a copyright in a derivative work without both fixation and an absence of infringement.¹⁷ This confusion has made it very difficult to find the normative foundations of the right. One needs a better understanding

14. As the Author compares international law, including French and German approaches to derivation, to the US approach, differences will emerge that illuminate the notion of derivative right. The Berne Convention, to which the United States adhered in 1988, only mentions "derivative works" in the title of Article 2(3), which reads: "Translations, adaptations, arrangements of music *and other alterations* of a literary or artistic work shall be protected as original works without prejudice to the copyright in the original work." Berne Convention for the Protection of Artistic and Literary Works art. 2(3), Sept. 9, 1886, *revised by* Paris Act on July 24, 1971 (amended July 24, 1979), 25 U.S.T. 1341, 828 U.N.T.S. 221 [hereinafter Berne Convention] (emphasis added), *available at* www.wipo.int/treaties/en/ip/berne/pdf/trtdocs_wo001.pdf. This is examined in Part III.B, but one can already see that the Berne notion is, compared to the US statute, open by including the notion of "other alterations."

15. See 17 U.S.C. §§ 101, 103, 106(2).

16. To be protected as a work in its own right, a derivative work must be "fixed in a tangible medium of expression." *Id.* § 102(a). However, § 106(2) does not require that the work be fixed *in order to infringe*. *Id.* § 106(2). As noted in the House Report, "reproduction requires fixation in copies or phonorecords, whereas the preparation of a derivative work, such as a ballet, pantomime, or improvised performance, may be an infringement even though nothing is ever fixed in tangible form." H.R. REP. NO. 94-1476, at 62 (1976) (Conf. Rep.), *reprinted in* 1976 U.S.C.C.A.N. 5675.

17. See 17 U.S.C. § 102(a) (fixation); *see also infra* note 351 and accompanying text (stating an author need not infringe to get a separate copyright in the derivative work).

of the purpose of the right—whether as a subset of the reproduction right or otherwise.¹⁸

The very language of the statute describing the derivative right (any work “based upon” a preexisting work) points to a broad notion and seems textually at odds with the minuscule purpose of the right—that is, mostly as a safety net to catch unfixed performances.¹⁹ More importantly, and this further explains the analytical approach in this Article, US law is different from many other national laws, which do not require fixation as a condition of protection and where using the derivative right to catch unfixed reuses thus makes little sense.²⁰ In most industrialized countries other than the United States, seeing the derivative right as a corrective measure designed to prohibit performances or protect them as derivative works is plainly wrong because musical performances are protected not as copyrighted works but rather by a neighboring right specific to performers.²¹

Against this backdrop, this Article argues that the derivative right is, and should be, more than a safety net to catch unfixed performances and a few other mostly marginal uses. Using both a comparative and international perspective, this Article attempts to demonstrate that the evolution of the derivative right both in the United States and in other jurisdictions teaches that, while the rights of reproduction and derivation self-evidently overlap, they have *distinct targets* and normative foundations and, perhaps more importantly for our purposes, respond to different tests. This Article contends that one should be able to identify those tests now, because the level of difficulty will increase as cases concerning UGC (and new forms of appropriation art) emerge in greater numbers.

In addition to the Berne Convention,²² the main international copyright instrument, this Article uses comparative sources from three major jurisdictions—France, Germany, and the United Kingdom—to illustrate the role that a properly conceived derivative right can play, and how different it is from its reproduction-right cousin.²³

18. See *infra* notes 311–315 and accompanying text.

19. See Yoav Mazeh, *Modifying Fixation: Why Fixed Works Need to be Archived to Justify the Fixation Requirement*, 8 LOY. L. & TECH. ANN. 109, 113–17 (2009).

20. See *id.*

21. This is true in both international law and a majority of national copyright laws. See Michael Gruenberger, *A Duty to Protect the Rights of Performers? Constitutional Foundations of an Intellectual Property Right*, 24 CARDOZO ARTS & ENT. L.J. 617, 627–28 (2006).

22. See *infra* note 104 and accompanying text.

23. See, e.g., Jane C. Ginsburg, *A Tale of Two Copyrights: Literary Property in Revolutionary France and America*, 64 TUL. L. REV. 991 (1990). Ginsburg explained:

The French and U.S. copyright systems are well known as opposites. The product of the French Revolution, French copyright law is said to enshrine the author: exclusive

In French, a derivative work is known as “*une œuvre dérivée*.”²⁴ The verb *dériver* can mean “to derive” but also “to drift.” This double-entendre is applicable here, for when copyright drifts too far from its normative moorings, it risks encountering the shoals of free expression and creating obstacles to cultural and economic progress. At the risk of pushing the metaphor a bridge too far, the notion of derivative work is at dangerous cross-currents as we define the space available for Internet users to reuse, remix, modify, and make available audiovisual and audio content such as mash-ups, sampling-based sound recordings, and fan sites, to name just three examples.²⁵ This debate may well be a battle royal in shaping tomorrow’s culture.

rights flow from one’s (preferred) status as a creator. For example, a leading French copyright scholar states that one of the “fundamental ideas” of the revolutionary copyright laws is the principle that “an exclusive right is conferred on authors because their property is the most justified since it flows from their intellectual creation.” By contrast, the U.S. Constitution’s copyright clause, echoing the English Statute of Anne, makes the public’s interest equal, if not superior, to the author’s. This clause authorizes the establishment of exclusive rights of authors as a means to maximize production of and access to intellectual creations.

Pursuing this comparison, one might observe that post-revolutionary French laws and theorists portray the existence of an intimate and almost sacred bond between authors and their works as the source of a strong literary and artistic property right. Thus, France’s leading modern exponent of copyright theory, the late Henri Desbois, grandly proclaimed: “The author is protected as an author, in his status as a creator, because a bond unites him to the object of his creation. In the French tradition, Parliament has repudiated the utilitarian concept of protecting works of authorship in order to stimulate literary and artistic activity.”

By contrast, Anglo-American exponents of copyright law and policy often have viewed the author’s right grudgingly.

Id. at 991–92.

24. *Œuvre* is usually translated as “work.”

25. The issue is not new, though new tools allow Internet users to create ever more creative derivatives. See Lydia Pallas Loren, *The Changing Nature of Derivative Works in the Face of New Technologies*, 4 J. SMALL & EMERGING BUS. L. 57, 58–59 (2000). Loren described technology’s effect on the derivative right:

Digital technology creates ample opportunity for individuals to create new works based on old works. The ease of copying and manipulating digital works, whether they are text, images, or sounds, raises a complex and somewhat metaphysical issue concerning the point at which those works move from being infringing derivative works to being non-infringing new works of authorship.

Id. at 58. The Author discussed the emergence of self-expressive content on the Internet in an earlier Article published in this Journal:

[I]t is now widely accepted that there is such a thing as the “participative web,” or Web 2.0 (soon to be 3.0). These terms refer to an Internet-based network of content and services that use increasingly intelligent software capable of empowering Internet users to develop, rate, collaborate on, and distribute content, as well as to customize Internet applications. As the Internet becomes more embedded in peoples’ lives, they draw on new Internet applications to express themselves through content that they upload or make available. Life stories are written on Facebook as they happen.

Gervais, *supra* note 4, at 843.

This Article proceeds as follows: Part I enunciates the context for the subsequent analysis, first by explaining the emergence and expansion of the derivative right in the US statute and then by contextualizing the right within the framework of copyright policy. This includes an inventory of “known quantities” in the debate. Part II proposes principles that inform the rest of the analysis and demonstrates why this analysis is correct. Part III considers how major international instruments treat derivative works. Part IV looks at French and German doctrine and cases to see whether there are lessons one can import in understanding the right. Finally, Part V brings the various threads of analysis together, suggests the ways in which the notion of derivative work should be interpreted in the United States, and hopefully convinces the reader that the principles enunciated below are correct.

I. THE DERIVATIVE RIGHT IN CONTEXT

A. Emergence of the Derivative Right in the US Copyright Act

The derivative right is the result of an evolution that started in the 1870 Copyright Act, with the realization that copyright could be infringed by making something other than exact, “piratical” copies.²⁶ Indeed, introducing a right against unauthorized translations and dramatizations implied that *something protectable lay beneath a work’s literal surface*.²⁷ What now may seem obvious was in fact a major shift. It opened up a new path for copyright under which substantial as well as literal copies could infringe.²⁸ It also created a

26. See Act of July 8, 1870, ch. 230, § 86, 16 Stat. 198; Paul Goldstein, *Derivative Rights and Derivative Works in Copyright*, 30 J. COPYRIGHT SOC’Y U.S.A. 209, 214 (1983). As a commentator explained:

Congress responded to a Supreme Court decision that had upheld the right of a German author to translate Harriet Beecher Stowe’s *Uncle Tom’s Cabin* by explicitly adding the right of translation to the bundle of exclusive rights guaranteed to a copyright owner. While the 1870 Act provided that “authors may reserve the right to dramatize or to translate their own works,” Congress went even further in 1909, adding novelization and musicalization to the expanding list of derivative rights for copyright holders.

Frank Houston, *The Transformation Test: Artistic Expression, Fair Use, and the Derivative Right*, 6 FIU L. REV. 123, 133–34 (2010). In *Folsom v. Marsh*, Justice Story opened the door by considering whether an adaptation infringed copyright. See *Folsom v. Marsh*, 9 F. Cas. 342 (C.C.D. Mass. 1841) (No. 4,901); R. Anthony Reese, *The Story of Folsom v. Marsh: Distinguishing Between Infringing and Legitimate Uses*, in *INTELLECTUAL PROPERTY STORIES* 259 (Jane C. Ginsburg & Rochelle Cooper Dreyfuss eds., 2006). On the use of “piracy” to signify copyright infringement, see WILLIAM F. PATRY, *MORAL PANICS AND THE COPYRIGHT WARS* 90–94 (2009).

27. See BENJAMIN KAPLAN, *AN UNHURRIED VIEW OF COPYRIGHT* 32–33 (1967).

28. Actually, the normative foundation for the extension beyond literal copying may be traced back to *Folsom*, which provided the intellectual wedge for considering the impact of

climate hospitable to a significant expansion of copyright, which a growing international trade in translated books then accelerated.²⁹ That trade facilitated the expansion of the translation right of course, but also of the right to adapt books and other works for the theater.³⁰

Four decades later, the 1909 Copyright Act³¹ reflected this continuing expansion of copyright (beyond literal copying), though it did not contain the notion of “derivative work” as such.³² Instead, consistent with British and Commonwealth practice,³³ it contained a

less-than-literal copies on the reproduction right. *Folsom*, 9 F. Cas. at 349. As explicated by the Supreme Court in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994), “[t]he central purpose of this investigation is to see, in Justice Story’s words, whether the new work merely ‘supersede[s] the objects’ of the original creation.” *Id.* at 579. By focusing on harm to the “object” of the work, an intellectual path was laid to harm well beyond literal copying. See GOLDSTEIN, *supra* note 6, § 7.3.

29. That climate led to an amendment introduced in both the House and Senate in the 58th Congress in 1903 providing that if an author of a foreign-published book obtained copyright for a translation within twelve months of its first publication, then the author would enjoy “the sole liberty of printing, reprinting, publishing, vending, translating, and dramatizing the said book, and, in the case of a dramatic composition, of publicly performing the same, or of causing it to be performed or represented by others.” THORVALD SOLBERG, COPYRIGHT IN CONGRESS 1789–1904, at 8 (1905). On the issue of foreign books, a much more limited Act was eventually passed and signed by the President on January 7, 1904. See Act of Jan. 7, 1904, ch. 2, 33 Stat. 4. There was a lively debate in Congress and apparent opposition to protecting foreign works. Representative Payne inquired whether people could “bring in books and works of art, photographs, etc. that could not now be copyrighted under the law under pretense of exhibition.” SOLBERG, *supra*, at 371–72. The bill passed unanimously, however. *Id.* at 370. The Author offers many thanks to Paul Goldstein for this insight.

30. Paul Geller, asking whether Hiroshige could have sued Vincent Van Gogh for using some of his paintings as “background” for his *Japonaiseries*, noted the following in that regard:

In the eighteenth century, copyright was instituted to deal only with easy cases, the pirate reprinting of books or restaging of plays. At the start of the nineteenth century, courts typically found no infringement in what leading French commentary called “[t]he transmutation of form that the translator causes the original to undergo.” But in the course of that century, as trade in books became increasingly globalized, authors and publishers started to claim rights to stop translations in foreign markets. Ultimately, the right of translation was subsumed under the more general right to control the making and exploitation of derivative works. The scope of copyright was effectively expanded beyond protecting prior works against substitution by later works in the markets that the prior works targeted. Copyright reached new markets in new media, for example, as literary works were adapted to the stage or film.

Paul Edward Geller, *Hiroshige vs. Van Gogh: Resolving the Dilemma of Copyright Scope in Remediating Infringement*, 46 J. COPYRIGHT SOC’Y U.S.A. 39, 46–47 (1998).

31. Act of 1909, ch. 320, 35 Stat. 1075, 1080 (1909) (repealed 1976).

32. See Goldstein, *supra* note 26, at 214–15. While the 1909 Act did not use the words “derivative work,” the reference to “other versions” is often considered to be a precursor of the derivative right in the 1976 Act. See *id.*

33. See, e.g., Copyright, Designs and Patents Act, 1988, c. 48, § 16 (U.K.) (“The owner of the copyright in a work has, in accordance with the following provisions of this Chapter, the exclusive right to do the following acts in the United Kingdom- . . . (e) to make an adaptation of the work or do any of the above in relation to an adaptation.”). Section 21(3) defines “adaptation” as follows:

- (a) in relation to a literary or dramatic work, means-
 - (i) a translation of the work;

finite list of types of "adaptations" requiring an authorization.³⁴ This included the right to make abridgements and translations; to dramatize a nondramatic work; to arrange or adapt a musical work; and to complete, execute, and finish a model or a design for a work of art.³⁵

This expansion of the scope of protected uses is visible in case law as well: courts increasingly protected nonliteral uses by relying on an expanded notion of reproduction, though occasionally filtering out noninfringing adaptations.³⁶ *C.M. Paula Co. v. Logan* provides a good

(ii) a version of a dramatic work in which it is converted into a non-dramatic work or, as the case may be, of a non-dramatic work in which it is converted into a dramatic work;

(iii) a version of the work in which the story or action is conveyed wholly or mainly by means of pictures in a form suitable for reproduction in a book, or in a newspaper, magazine or similar periodical;

(b) in relation to a musical work, means an arrangement or transcription of the work.

Id. § 21(3); *see also* Canadian Copyright Act, R.S.C. 1985, c. C-42, § 3(1) (Can.) (using a similar approach, though with some differences); *Copyright Act 1968* §§ 10(1), 31(1)(vi) (Austl.) (defining "adaptation").

34. The 1909 Act granted a translation right in § 1(b):

[A]ny person entitled thereto, upon complying with the provisions of this Act, shall have the exclusive right: . . .

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

Act of 1909, ch. 320, § 1(b), 35 Stat. 1075, 1075 (repealed 1976). The term "adaptation" is preferred internationally, but it covers essentially the same scope as derivation in the US statute. *See infra* Parts III-IV.

35. Act of 1909, ch. 320, § 1(b), 35 Stat. 1075, 1075 (repealed 1976); *see also* Goldstein, *supra* note 26, at 214-16. "The 1909 Act not only identified *specific types* of derivatives that authors were entitled to control; it also tied each type of derivative to the type of work being adapted." Pamela Samuelson, *The Quest for a Sound Conception of Copyright's Derivative Work Right* 6 (UC Berkeley Pub. Law Research Paper No. 2138479, 2012) (emphasis added), available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2138479.

36. Hence, they found binding and rebinding of books noninfringing because a binding or similar operation does not lead to a reproduction, at least not if reproduction is defined by its result, namely an increase in the number of copies in existence. *See* Doan v. Am. Book Co., 105 F. 772 (7th Cir. 1901); *Harrison v. Maynard, Merrill & Co.*, 61 F. 689 (2d Cir. 1894). The right did not extend to copying missing pages, however. *See* Ginn & Co. v. Apollo Publ'g Co., 215 F. 772 (E.D. Pa. 1914). The courts' findings derived in part from the competing ownership rights in the copy, which implies a right to maintain or restore the copy's condition. *See Harrison*, 61 F. at 777. Although binding was allowed, even if a work was combined with others in the process, it was not allowed when it amounted to a recompilation of works previously compiled in a different way, such as the separation of articles in magazines to publish a book. *See* Fawcett Publ'ns, Inc. v. Elliot Publ'g Co., 46 F. Supp. 717 (S.D.N.Y. 1942); *Nat'l Geographic Soc'y v. Classified Geographic, Inc.*, 27 F. Supp. 655 (D. Mass. 1939). In British law, reproduction and "multiplication" were different concepts. *See* Fine Arts Copyright Act, 1862, 25 & 26 Vict., c. 68, § 1 (Eng.) (granting authors "the sole and exclusive right of copying, engraving, *reproducing*, and *multiplying*") (emphasis added); *see also* *Bradbury, Agnew & Co. v. Day*, (1916) 32 T.L.R. 349 (Eng.).

example of a pre-1978 case (the 1976 Act entered into force on January 1, 1978³⁷).³⁸ The owner of pictures imprinted on stationery and greeting cards brought the case against the manufacturer of wall plaques that incorporated the stationery and greeting cards.³⁹ The district court held that the transfer to ceramic plaques did not constitute “copying,” adding, “without copying there can be no infringement of copyright.”⁴⁰ A closer reading of the cases, however, shows that the court conflated copying with the need to identify a parasitical use or misappropriation, and specifically with whether the reuse of the work would “kill the host.”⁴¹ This is reminiscent of the

37. See Act of Oct. 19, 1976, Pub. L. No. 94-553, 90 Stat. 2541 (“This Act becomes effective on January 1, 1978, except as otherwise expressly provided by this Act . . .”).

38. *C.M. Paula Co. v. Logan*, 355 F. Supp. 189 (N.D. Tex. 1973); see also *Affiliated Enters., Inc. v. Gruber*, 86 F.2d 958 (1st Cir. 1936); *Blazon, Inc. v. DeLuxe Game Corp.*, 268 F. Supp. 416, 420 (S.D.N.Y. 1965). Conversely, adaptations that copied a preexisting work, even if material was added or deleted, were generally considered infringing. See *Addison-Wesley Publ'g Co. v. Brown*, 223 F. Supp. 219 (E.D.N.Y. 1963) (finding book containing solutions to physics textbook problems infringing). A number of commentators consider *Addison-Wesley* problematic in that the book held to be infringing published solutions *without reproducing the problems*. See Case Comment, *Solutions to Questions in a Copyrighted Physics Textbook Held an Infringement*, 112 U. PA. L. REV. 1070, 1070–71 (1964) (discussing how finding copying is a “difficulty” because the “manual of solutions contained little actual lifting of plaintiffs’ language” but ultimately concluding that the facts should be enough to support a claim of unfair competition, if not unfair use); see also JANE C. GINSBURG & ROBERT A. GORMAN, COPYRIGHT LAW 148 (2012). Some scholars seem to reconcile *Addison-Wesley*’s holding. See Goldstein, *supra* note 26, at 209 (“[C]opyright has historically prohibited utilitarian uses, from the copying of telephone and business directories to the publication of a book providing solutions to physics problems appearing in plaintiff’s copyrighted text.”); see also *Gilliam v. Am. Broad. Cos.*, 538 F.2d 14 (2d Cir. 1976) (involving edited versions of Monty Python sketches).

39. See *C.M. Paula Co.*, 355 F. Supp. at 190.

40. *Id.* at 191. The Supreme Court of Canada heard a very similar case. See *Théberge v. Galerie d’Art du Petit Champlain Inc.*, [2002] 2 S.C.R. 336 (Can.). The ink from paper posters of copyrighted works had been transferred to canvas. See *id.* A split court held that no reproduction had taken place because there had been no net increase in the number of copies in existence. See *id.* For a comment, see Daniel J. Gervais, *The Purpose of Copyright Law in Canada*, 2 U. OTTAWA L. & TECH. J. 315, 319–21 (2005), available at <http://uoltj.ca/articles/vol2.2/2005.2.2.uoltj.Gervais.315-356.pdf>.

41. In *C.M. Paula Co.*, the court, finding no infringement, suggests the use comes close to the limit of unacceptable appropriation and “is of the opinion that some action should be taken to insure that no confusion exists in the marketplace as to the source of defendant’s product.” 355 F. Supp. at 192–93 (citing *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368 (1924)); see also, *Nat’l Geographic Soc’y*, 27 F. Supp. at 655. In addition, the district court in *Addison-Wesley* noted:

Of preponderant importance to the Court in evaluating the merits in doubtful cases so that it may arrive at its decision with a minimum of “ad hoc” and a maximum of legal justification is the recognition by it of “the economic philosophy behind the (constitutional) clause empowering Congress to grant patents and copyrights.” That philosophy persuades “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.’ Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.”

It is clear that *defendants’ parasitical excrescence upon plaintiffs’ distinguished and useful works profits defendants alone. In this symbiosis defendants thrive, while their*

Folsom inquiry, well known at the time, which focuses on the economic outcomes rather than on ethical or behavioral aspects of copyright infringement, namely appropriations that affect or supersede the market for the primary work.⁴²

The process of expansion of the derivative right continued. When the long march to the 1976 reforms began, the Register of Copyrights suggested a definition of the reproduction right as inclusive of certain kinds of derivatives, a significant overlap that was also apparent in the congressional record.⁴³ Overlap did not mean identity, however. Indeed, by the mid-1960s, the “derivative right” had been named as a separate right.⁴⁴ In 1976, it finally made its grand entrance in the statute.⁴⁵

manual kills the host it feeds upon. The Court sees nothing here warranting the exercise by it of an exigent astuteness to ferret out some legal justification for defendants’ overuse of plaintiffs’ copyrighted material. If the issue is at all doubtful—and in the Court’s view it does not appear to be—such doubt should, in good conscience and in fulfillment of the constitutional mandate, be resolved in plaintiffs’ favor.

Addison-Wesley, 223 F. Supp. at 228 (emphasis added).

42. This notion of “killing the host” indeed seems a logical kin of the notion of supersession espoused by Judge Story in *Folsom v. Marsh*:

[W]e must often, in deciding questions of this sort, look to the nature and objects of the selections made, the quantity and value of the materials used, and the degree in which the use may prejudice the sale, or diminish the profits, or *supersede the objects*, of the original work.

9 F. Cas. 342, 348 (C.C.D. Mass. 1841) (No. 4,901) (emphasis added); *see also supra* note 28 and accompanying text.

43. Samuelson, *supra* note 35, at 20 n.62. The process to draft and pass the new Act lasted approximately thirty years. *Id.* at 5–13.

44. *Id.* at 2 n.10.

45. The statute refers to derivative works as works “*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.” 17 U.S.C. § 101 (2006) (emphasis added). Essentially, the statute (a) enumerates named derivatives, and (b) opens up a broader, undefined category of works “*based upon*” previous works. *See id.* Although both are anchored in the opening “*based upon*” language, they do explicate it. The list provided in the statute is useful on at least two levels: normatively and perhaps more mechanically also under the *ejusdem generis* canon of construction, according to which, “[w]here general words follow specific words in a statutory enumeration, the general words are construed to embrace only objects similar in nature to those objects enumerated by the preceding specific words.” *Circuit City Stores, Inc. v. Adams*, 532 U.S. 105, 114–15 (2001). It is normatively useful because the difficulty mainly resides in the “*based upon*” language combined with the open-ended phrase “or any other form in which a work may be recast, transformed, or adapted.” 17 U.S.C. § 101. As Paul Goldstein has noted, “the derivative author’s transformation of the primary work need not be extensive.” *See Goldstein, supra* note 26, at 210.

B. Contextualizing the Derivative Right in Copyright Policy

The necessity of serving the purpose of copyright has generated a number of doctrines to limit the scope of what copyright protects. These are best viewed as a group of safeguards to allow the optimal “Progress of Science and useful Arts” that the Constitution establishes as the purpose of copyright (and patent) law.⁴⁶ For example, copyright doctrine, both in the United States and internationally, teaches that the *expression* of a work is protected, but not the underlying *ideas*—the so-called idea-expression dichotomy.⁴⁷ This doctrine, often elevated to the level of principle, goes back to the origins of copyright in the common-law world. For example, in an 1847 case, an English court noted the following:

The right to multiply copies of what is written or printed, and to take therefor whatever other possessions mankind is willing to give in exchange, constitutes the whole claim of literary property. This claim leaves wholly undisturbed the opportunity of every reader to make an intellectual appropriation of the ideas suggested to him by the characters which he purchases.⁴⁸

A number of infringement-related doctrines further limit the “copy-right,”⁴⁹ including the need to show substantial similarity between the plaintiff’s and defendant’s works and the exclusion of de minimis copying.⁵⁰

46. U.S. CONST. art. I, § 8, cl. 8.

47. The idea-expression dichotomy separates two seemingly mutually exclusive and watertight notional universes, which is reflected both in 17 U.S.C. § 102(b) and the Agreement on Trade-Related Aspects of Intellectual Property Rights art. 9(2), Apr. 15, 1994, 1869 U.N.T.S. 299, 33 I.L.M. 1125, 1197 (1994) [hereinafter TRIPS Agreement]. As Paul Geller explained:

In hard cases, plaintiffs allege that defendants have derived works from their own. In such cases, courts often resort to complementary doctrines to limit copyright scope. These doctrines operate on theoretically distinct levels of analysis that tend to come together in practice. On the level of determining what is protectible, there is the principle that courts may not protect “ideas” or “facts,” but rather only “expression” or “forms.” On the level of finding infringement, courts ask whether plaintiff’s work is copied in defendant’s “substantially” similar work or whether “essential” or “characteristic traits” of one work are taken in the other. But such notions as “ideas” defy ready definition, and equally metaphysical notions of “substance” suggest that works of the mind are things like tables and chairs, consistently perceived by all audiences, but none of these doctrines by itself guides courts to consistent decisions.

Geller, *supra* note 30, at 47.

48. GEORGE T. CURTIS, TREATISE ON THE LAW OF COPYRIGHT 11 (1847).

49. In most other languages, especially in legal systems inspired by Civil (Roman) law, the corresponding term is “author’s rights” and connotes a different historical background and set of underlying principles, though one which may have been overstated. See Ginsburg, *supra* note 23, at 991–92 (noting that the difference of underlying principles was overstated, at least as a matter of eighteenth- to early nineteenth-century copyright).

50. Of course fair use is directly relevant in allowing reuse that constitutes *prima facie* infringement, which is a greater social purpose served by the transformative nature of the use. See *infra* Part V.

Considering those copyright-limiting doctrines together as forming a variegated policy collage—a counterweight to the rights contained in 17 U.S.C. § 106, as it were—one can posit that there must be an optimal point of protection. That is, a point must exist where *enough* protection is granted to create the level of ex post reward (or to create an ex ante incentive) to generate new works, but not *excessive* protection, which would prevent other authors from generating their own works.⁵¹ Theoretically at least, equilibrium must be possible. As a normative matter, one must seek to establish it.⁵²

The introduction of the open-ended derivative right did not make achieving this balance any simpler. Indeed, the statute's prohibition of the reuse of protected works beyond literal copying (by giving the owner of copyright in a work an exclusive right to prohibit the making of any work "based upon" her work) seems a major expansion of copyright's reach over the speech of others.⁵³ At first glance, this right (as formulated in the 1976 Act) makes little sense

51. The US Copyright Act contains the basic copyright rights, namely the right of reproduction, distribution, public performance (and the related right in digital transmissions of sound recordings), public display, and of course the right to prepare derivative works. See 17 U.S.C. § 106 (2006). A more complete utilitarian perspective that directly impacts the analysis of derivative works would include the development of potential secondary markets for the protected work and the facilitation of optimal means of development and dissemination. See *id.*; Neil Weinstock Netanel, *Copyright and a Democratic Civil Society*, 106 YALE L.J. 283, 308 (1996).

52. In *Nash v. CBS*, Judge Easterbrook noted:

Intellectual (and artistic) progress is possible only if each author builds on the work of others. No one invents even a tiny fraction of the ideas that make up our cultural heritage. Once a work has been written and published, any rule requiring people to compensate the author slows progress in literature and art, making useful expressions "too expensive," forcing authors to re-invent the wheel, and so on. Every work uses scraps of thought from thousands of predecessors, far too many to compensate even if the legal system were frictionless, which it isn't. Because any new work depends on others even if unconsciously, broad protection of intellectual property also creates a distinct possibility that the cost of litigation—old authors trying to get a "piece of the action" from current successes—will prevent or penalize the production of new works, even though the claims be rebuffed.

Nash v. CBS, Inc., 899 F.2d 1537, 1540 (7th Cir. 1990).

53. See 17 U.S.C. §§ 101, 106(2); *Nash*, 899 F.2d at 1540. Christina Bohannon explained how this is germane to the issue at hand:

Given that a derivative work must only be "based on" an existing work and that it gives the copyright holder the exclusive right of "fictionalization," the derivative works right would seem to prohibit taking facts from a non-fiction historical work and making a fictional work out of them. Under this interpretation, Dan Brown's *The Da Vinci Code* would infringe the historical work *Holy Blood, Holy Grail*, even if it took no copyrighted expression. Yet, under the idea/expression dichotomy, codified at § 102(b), ideas and facts are not copyrightable; only the author's expression may be copyrighted. Some judicial decisions have attempted to resolve this ambiguity by applying a narrowing interpretation that limits the derivative works right to uses that actually incorporate copyrighted expression.

Christina Bohannon, *Taming the Derivative Works Right: A Modest Proposal for Reducing Overbreadth and Vagueness in Copyright*, 12 VAND. J. ENT. & TECH. L. 669, 677–78 (2010).

because most if not all new works are based upon preexisting ones in one way or another.⁵⁴ Most authors do not take from “nature” (though perhaps an artist does when painting or photographing a natural scene); authors take from each other and all those who created before them and made their work available for others to enjoy.⁵⁵ Humanity, as Blaise Pascal once said, “is but one person who continually grows.”⁵⁶

While the right to prohibit the making of derivative works must mean *something*, however, a hugely expansive reading of a right to prevent any work “based upon” a preexisting work (as found in 17 U.S.C. § 101) seems both exaggerated and unwarranted. For one thing, it could be read to deny many new expressions of human creativity. That, this Article contends, is not the target of the right. When copyright moved doctrinally beyond literal copying,⁵⁷ the underlying concern was the (correct) realization that other appropriations, including translation, dramatizations, and substantial (if not literal) copying, could cause an unjustified harm to a copyright holder.⁵⁸

Does that mean that the derivative right is the same as or entirely subsumed under reproduction? The simple answer is no—unless one is prepared to violate a basic canon of statutory construction.⁵⁹ Yet a number of commentators have argued that the right to prohibit the making of derivatives is essentially useless and subsumed under the reproduction right (and in some cases the right of public performance as well). This position leaves only a few marginal cases for the derivative right, such as when a license allows copying but reserves the making of certain derivatives.⁶⁰ Professor Nimmer,

54. See Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965, 966 (1990) (“[T]he very act of authorship in any medium is more akin to translation and recombination than it is to creating Aphrodite from the foam of the sea.”). Phillip Page explained:

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.

Phillip Edward Page, *The Works: Distinguishing Derivative Creations Under Copyright*, 5 CARDOZO ARTS & ENT. L.J. 415, 418 (1986).

55. See ROBERT K. MERTON, ON THE SHOULDERS OF GIANTS 6–12 (1993).

56. Gervais, *supra* note 4, at 845.

57. See *supra* notes 26–27 and accompanying text.

58. See *supra* note 28 and accompanying text.

59. Basic canons of statutory interpretation counsel against courts “reading out” statutory language. See, e.g., GEORGE COSTELLO, CONG. RESEARCH SERV., STATUTORY INTERPRETATION: GENERAL PRINCIPLES AND RECENT TRENDS 12 (2006) (“[S]tatutes should be construed ‘so as to avoid rendering superfluous’ any statutory language.”).

60. 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 8.09[A] (2010).

whose copyright treatise is widely cited by US courts, specifically argued that the derivative right is superfluous because an infringement of the right infringes either the right of reproduction or the right of public performance.⁶¹ This Article disagrees, but does concede that a number of US courts have applied the "substantial similarity" test to allegedly infringing derivative works in the same way they have applied it to alleged infringements of the reproduction right.⁶² Perhaps superfluity was part of the congressional intent at the time of the 1976 reform.⁶³ The statute makes plain, however, that the derivative right targets specific reuses of protected works. This will become clear in light of the purpose of the derivative right in international conventions and national laws examined below.⁶⁴ To argue that some of them are also reproductions does not add normative clarity—quite the opposite. Courts should consider reuses that Congress identified as within the derivative right under that right. Part V explains in more detail how to parse the distinction.

This Article thus acknowledges the overlap but endeavors to separate the two rights. This means that there are forms of derivation that copy and some that do not. Conversely, there are forms of copying that derive, and others that "merely" copy. As alluded to above, the derivative right, properly applied and understood, is situated in a zone between (and occasionally beyond) reproduction, on

61. See *id.* This view was cited, apparently with approval, in *Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366, 1373 n.6 (2d Cir. 1993); see also J.A.L. STERLING, *WORLD COPYRIGHT LAW* § 9.04 (2d ed. 1989) ("It could be said that all adaptations involve reproduction, where the essential features of the adapted work are used. However, in many laws (and under the Berne Convention) the right of adaptation is viewed separately from that of reproduction.").

62. See GINSBURG & GORMAN, *supra* note 38, at 146–47.

63. See *id.*

64. The Author also concedes that the House Report accompanying the changes to the statute in 1976 did little to allay the concerns expressed by those who saw much overlap between the two rights:

To be an infringement the "derivative work" must be "based upon the copyrighted work," and the definition in section 101 refers to "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." Thus, *to constitute a violation of section 106 (2), the infringing work must incorporate a portion of the copyrighted work in some form*; for example, a detailed commentary on a work or a programmatic musical composition inspired by a novel would not normally constitute infringements under this clause.

H.R. REP. NO. 94–1476, at 62 (1976) (Conf. Rep.), *reprinted in* 1976 U.S.C.C.A.N. 5675 (emphasis added). As Page noted, the possibly infelicitous drafting of the new derivative right and its "approximate" relation to the right of reproduction was criticized early on:

It is, however, the Act's introduction of new copyright concepts which presents the greatest potential source of difficulty for the derivative artist and his transferees. These provisions, even where their salutary effect is generally conceded, have made changes in the enjoyment of rights which may not have been fully anticipated by the drafters.

Page, *supra* note 54, at 417.

the one hand, and uses that are inspired by, but not infringing (because they are not “based upon”), an earlier work, on the other hand.⁶⁵

C. Known Quantities

At least two building blocks seem indisputable as our analytical journey enters its next phase. First, many national copyright laws including the US statute identify *specific types of derivatives*.⁶⁶ The US Copyright Act identifies “translation[s], musical arrangement[s], dramatization[s], fictionalization[s], motion picture version[s], sound recording[s], art reproduction[s], abridgment[s], and condensation[s]” as well as “work[s] consisting of editorial revisions, annotations, elaborations, or other modifications.”⁶⁷ This Article refers to these as *named derivatives*. They help us understand the notion but do not fully define it.

A second initial contextual element—but one that is particularly important—is that a derivative work *transforms or recasts something protectable* in the primary work (something other than the unprotected ideas) by adding or transforming it.⁶⁸ This

65. See Timothy Everett Nielander, *The Mighty Morphin Ninja Mallard: The Standard for Analysis of Derivative Work Infringement in the Digital Age*, 4 TEX. WESLEYAN L. REV. 1 (1997). Nielander described that zone as follows:

On the continuum between an exact reproduction of protected property, and the creation of an original work, lies a gray zone. This zone is a mixture of protected works—printed art, art on digital media, digital and analog music, and other works recognized as deserving intellectual property protection—that can be mixed and matched with other works to create new works. American law recognizes protection of this form of copying as derivative rights.

Id. at 2.

66. Section 101 of the US Copyright Act mentions “translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation.” 17 U.S.C. § 101 (2006).

67. *Id.*

68. A derivative work, if it is created, must self-evidently be a “work,” since the Copyright Act only protects “original works of authorship.” See *id.* § 102(a). This is further confirmed by the last words of the definition of “derivative work.” See *infra* text accompanying note 72. This does not fully answer the question of course because there is uncertainty about what exactly can be a work and in particular how small a creative unit can be to qualify. See Justin Hughes, *Size Matters (or Should) in Copyright Law*, 74 FORDHAM L. REV. 575, 578 (2005) (arguing for a “minimum size principle” in copyright law). As such, it must be original in its own right. See *Kamar Int’l, Inc. v. Russ Berrie & Co.*, 657 F.2d 1059, 1061 (9th Cir. 1981). The Author posits that the source of the originality for both works is different, at least in part, typically because the works have different authors. Even the same author arranging her own work would make different creative, originality-generating choices for the first (preexisting) and second (derivative) works. An author could infringe copyright in her own creation if she had transferred the right to make derivatives thereof to a third party. In the Author’s experience, the right to reuse one’s own works is seldom reserved by authors when they transfer copyright. For an actual example, see *Gross v. Seligman*, 212 F. 930 (2d Cir. 1914) (“If the copyrighted picture were

means (a) that to constitute a (preexisting) work in which copyright subsists, the *primary* work must be original;⁶⁹ and (b) that derivation (whether or not a new, derivative work results) implies *some additional work by the derivative user*.⁷⁰ In fact, it is that additional

produced with colors on canvas, and were then copyrighted and sold by the artist, he would infringe the purchaser's rights if thereafter the same artist, using the same model, repainted the same picture with only trivial variations of detail and offered it for sale."). The harder question is whether the originality of the derivative work must come entirely from the changes and additions made by the author of the derivative work. The Author will leave that question for a future paper.

69. As the Ninth Circuit noted in *Entertainment Research Group, Inc. v. Creative Group, Inc.*, a derivative work must exhibit its own originality. 122 F.3d 1211, 1220 (9th Cir. 1997). The Ninth Circuit also discussed the applicable test in that case. It was asked to pick either the *Doran* test, named after *Doran v. Sunset House Distributing Corp.*, 197 F. Supp. 940 (S.D.Cal. 1961), *aff'd*, 304 F.2d 251 (9th Cir.1962), or the *Durham* test, named after *Durham Industries, Inc. v. Tomy Corp.*, 630 F.2d 905 (2d Cir. 1980). *See Entm't Research Grp.*, 122 F.3d at 1219–21 (explaining that in the Ninth Circuit also the *Durham* test governs). It picked the *Durham* test because the *Doran* test "completely fails to take into account the rights of the holder of the copyright for the underlying work." *Entm't Research Grp.*, 122 F.3d at 1219.

In *Durham*, the Second Circuit explained the test as follows: "First, to support a copyright the original aspects of a derivative work must be *more than trivial*. Second, the original aspects of 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." *Durham*, 630 F.2d at 909. This debate, however, is essentially on the scope of the rights of the owner of primary [or underlying] work, rather than on the need for the author of a derivative work to make an original contribution, a point on which the cases seem to agree. For a discussion, see Steven S. Boyd, *Deriving Originality in Derivative Works: Considering the Quantum of Originality Needed to Attain Copyright Protection in a Derivative Work*, 40 SANTA CLARA L. REV. 325, 357–58 (2000).

70. In this Article, the Author will use "primary" to refer to a work from which a derivative is made. Other authors have used "original," which the Author will avoid because it may be a source of confusion. "Original" is also the term used to describe the necessary originality that a work must possess to be protected by copyright. *See, e.g., infra* notes 177, 225 and accompanying text. In *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), the Supreme Court explained that "originality requires independent creation plus a modicum of creativity." 499 U.S. at 346. "Because the requirement was distilled from the Constitution's use of the word 'authors' in the Copyright Clause, the requirement was said to be constitutionally mandated." Elizabeth F. Judge & Daniel Gervais, *Of Silos and Constellations: Comparing Notions of Originality in Copyright Law*, 27 CARDOZO ARTS & ENT. L.J. 375, 389–91 (2009). That modicum of creativity, the generator of originality, stems from creative choices made by the author, which one might define as:

[T]hose made by a human author which are not dictated by the function of the work, the method or technique used, or by applicable standards or relevant "good practice." Literary and artistic works are the result of one or more of three types of choices: technical choices, those that are essentially dictated by the technique used (e.g., in painting or photography, or certain forms of poetry); functional choices, those dictated by the function that a utilitarian work will serve (e.g., a chair must not collapse when someone is sitting on it); and finally creative choices, those that truly stem from the author and where, if someone else has produced the work, there would most likely have been a different result. Intellectual property does not reward the first category (unless a new technique is invented perhaps); copyright does not reward the second but other forms of intellectual property (e.g., patent) might. Copyright's focus is on the latter category.

Id. at 377.

work that will be protected if other conditions (in particular no infringement of primary work) are met.⁷¹ A translation, for example, is clearly the result of much intellectual work, though of a different nature than the composition of the primary work.⁷² New expression is required to find that a translation constitutes a (new) original work.⁷³ There is thus a distinction to be made between the targets of the rights of reproduction and derivation in that the latter necessarily implies a *transformation* of, or addition of new expression to, the expression contained in a primary work.

What else can one say with certainty about the derivative right? Not much. Indeed, beyond the two known elements just identified, and which this Article uses as premises for the analysis that follows, one must proceed with extreme caution. Yet, the problems that indeterminacy will pose for artists, amateur authors, and other users justify the quest for better and more complete answers. Those problems will become more insistent because the combined use of digital tools and the Internet allow for many new forms of transformation of copyrighted material, many of which may seem like prime candidates for the derivative right.⁷⁴

One can ask the question this way: As new forms of use of copyrighted works emerge, should we assume that the reach and scope of the derivative right should grow in parallel fashion?⁷⁵ It seems safe

71. See *Silverman v. CBS Inc.*, 870 F.2d 40,49 (2d Cir.1989) (“[C]opyrights in derivative works secure protection only for the incremental additions of originality contributed by the authors of the derivative works.”).

72. See CURTIS, *supra* note 48, at 187 (“[T]he translator impresses upon [the original subject] matter so much of a new character by his own labor, that the law treats his translation as a new product.”). However, Curtis then flips the coin:

The property of the original author embraces something more than the words in which his sentiments are conveyed. It includes the ideas and sentiments themselves, the plan of the work and the mode of treating and exhibiting the subject. In such cases his right may be invaded in whatever form his own property may be reproduced. The new language in which his composition is clothed by translation *affords only a different medium of communicating that in which he has an exclusive property*; and to attribute to such a new medium *the effect of entire originality*, is to declare that a change of dress alone annihilates the most important subject of his right of property. It reduces his right to the *narrow limits of an exclusive privilege of publishing* in that idiom alone in which he first publishes.

Id. at 292–93 (emphasis added).

73. See *id.* at 187. The Author is indebted to Professor Tyler Ochoa for this insight.

74. See *id.*

75. A number of proposals consider not the scope of the right but changes to infringement doctrines, which in effect would broaden the possibilities of users to reuse content, in some cases after a period of higher exclusivity. See, e.g., Orit Fischman Afori, *Flexible Remedies as a Means to Counteract Failures in Copyright Law*, 29 CARDOZO ARTS & ENT. L.J. 1, 5–8 (2011). Afori, for example, argued the following:

[C]lasses addressing derivative works are a good example of the binary decision-making approach. Such cases occasionally raise some of copyright law’s most basic dilemmas: how much can a work borrow from a copyrighted work without infringing its

to assume that not all the normative, doctrinal, and remedial work need be performed by the definitional effort surrounding the notion of derivative right offered in this Article. Fair use and First Amendment free-expression scrutiny, two matters this Article does not address in full, will still perform a significant part of the work.⁷⁶ But the same is true with all copyright rights.⁷⁷ For example, a specific proposal based on First Amendment concerns noted that “[i]f it is not a reproduction but a derivative work, neither an injunction nor damages should be available. In such cases, however, the copyright holder would not be left wholly without remedy. Instead, he would have an action for profit allocation.”⁷⁸ This type of limitation is necessary but does not

copyright? Must the use of the underlying copyrighted work be accomplished through reproduction in order to infringe? Are there other ways of reliance on copyrighted works, in addition to reproduction, which are prohibited too? How should a court treat a derivative work, which adds a significant contribution, but is based on a minimal taking from the underlying copyrighted work? Do such cases support a fair use finding? Since courts can only find that there either was or was not an infringement of copyright, legal distortions may occur.

Id. at 7. Other commentators have taken the opposite view, and at least in one case suggested a statutory expansion of the right to cover, for example, programs that modify or “filter” movies. See Patrick W. Ogilvy, Note, *Frozen in Time? New Technologies, Fixation, and the Derivative Work Right*, 8 VAND. J. ENT. & TECH. L. 687, 706–10 (2006).

[T]he purposes and policy of copyright law and the derivative work right support a broader definition of what constitutes infringement. Therefore, the Copyright Act should be amended to expand the derivative work right, clarifying that movie filters and other similar types of works that rely on but do not incorporate elements of an underlying work constitute infringing works.

Id. at 706.

76. See Bohannon, *supra* note 53 (discussing fair use in the context of derivative works). The Author returns to First Amendment concerns below. See *infra* Part V.C. Another possibility the Author will not dwell upon here is the potential limiting role of a fixation requirement. But see Tyler T. Ochoa, Copyright, Derivative Works and Fixation: Is Galoob a Mirage, or Does the Form (Gen) of the Alleged Derivative Work Matter?, 20 SANTA CLARA COMPUTER & HIGH TECH. L.J. 991 (2004) (critiquing the Ninth Circuit’s opinion in *Lewis Galoob Toys, Inc. v. Nintendo of America, Inc.*, 964 F.2d 965 (9th Cir. 1992), which held that derivative works need not be fixed but must nonetheless be in “concrete or permanent form”). Professor Ochoa concludes:

This contradiction stems from the fact that although the statutory language does not appear to require fixation, reading the statutory language literally would render illegal merely imagining a modified version of a copyrighted work. This contradiction can be eliminated by recognizing that what Congress intended was to prohibit the public performance of an unfixed derivative work, as well as the reproduction, public distribution, public performance or public display of a fixed derivative work. Congress’ intent can be fully implemented by holding that the exclusive right to prepare derivative works is dependent upon, rather than independent of, the other four exclusive rights.

Id. at 1044.

77. Fair use, to take just that exception, applied to all exclusive rights in 17 U.S.C. § 106 (2006).

78. Jed Rubenfeld, *The Freedom of Imagination: Copyright’s Constitutionality*, 112 YALE L.J. 1, 55 (2002). Rubenfeld continues the discussion by taking the specific example from *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994), namely 2 Live Crew’s “version” of Roy Orbison’s “Oh, Pretty Woman”:

lie within the scope of the right itself. The same may be said of other limiting doctrines.⁷⁹

II. PROPOSED PRINCIPLES

This Article suggests six mobilizing principles that inform a proper analysis of the derivative right. The first three principles are definitional in nature; the last three are best seen as notes of caution. While some of these principles follow from the preceding contextual discussion, the following sections further demonstrate them.

A. Definitional Principles

(1) *The derivative right is not coextensive with the right of reproduction.* The two rights undoubtedly overlap, but to make any sense of the derivative right, it must be considered from its own perspective, normatively but also operationally. Properly anchored, the derivative right has its own normative footing and is, or should be, more than an infringement doctrine designed to catch certain unfixed derivative uses.⁸⁰ Indeed, internationally this is beyond cavil. This principle, as this Article shows, may impact the application and scope of a properly understood right of reproduction.

The fair use determination functions here as an on-off determinant of liability. If 2 Live Crew's *Pretty Woman* was a fair use of the preexisting *Oh Pretty Woman*—a determination said to turn largely on whether the new song was “transformative” of the old, both creatively and for purposes of the market-substitution analysis—then the new song was totally outside the prohibitions of copyright law, leaving the copyright holder with no claim at all. Conversely, if *Pretty Woman* was not fair use, then the copyright holder could receive not only damages, but in principle injunctive relief as well.

From a First Amendment perspective, this is a doubly wrong result. *Pretty Woman* was not the same song as *Oh Pretty Woman*. It was plainly “transformative,” having not only new lyrics but a completely different sound and feel. Hip-hop ‘sampling’ generates new music; that is its virtue. It also steals; that is its vice. Because it was new music, 2 Live Crew's *Pretty Woman* should have been categorically protected from an injunction, regardless of whether it “criticized” the original. But there is no reason why 2 Live Crew was entitled to reap all the profits from its transformative use of *Oh Pretty Woman*, when some of those profits were unquestionably attributable to Roy Orbison's immensely popular tune.

Id. at 55–56.

79. The Supreme Court noted in *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006), that a court could and perhaps should examine whether “the public interest would not be disserved by” the issuance of a preliminary injunction. *Id.* at 391. That case involved a patent, but the principle was extended to copyright in *Salinger v. Colting*, 607 F.3d 68, 78 n.7 (2d Cir. 2010). It is also relevant to note that it was then extended to trademark cases in *N.Y.C. Triathlon, LLC v. NYC Triathlon Club, Inc.*, 704 F. Supp. 2d 305, 328 (S.D.N.Y. 2010). The principle, which seems well anchored in the equitable nature of the remedy, is thus now well established across all major intellectual property rights.

80. Under US law, the fixation requirement does not apply to derivative works; they must still be in “concrete” form. See Ochoa, *supra* note 76, at 1044.

(2) *A derivative work implies a transformation of or addition to the (protected) expression of a primary work.* If a derivative intellectual production is fixed and original (that is, if it meets the constitutionally entrenched test of a modicum of creativity in the United States), it can be a work in its own right.⁸¹

(3) *There must be sufficient proximity between the primary work and the derivative use or work.* This may be the most important principle, and one Parts III and IV explicate. Specifically, this Article suggests that proximity follows from the *reuse of the elements that gave the primary work its originality*. This proximity is required to trigger the application of the derivative right. The distinction between reproduction and derivation is thus that, rather than being merely copied, parts of the protected expression of the primary work are transferred to, and transformed in, the product of the derivative use. This may, but does not have to, imply a reproduction.

This principle reconciles the notion of derivative work with guidance from Congress and several historical sources. These sources indicate that one should look for an *unlawful taking or the appropriation of something in the underlying work that made it a protected work in the first place*.⁸² The principle is also consonant with traditional copyright doctrine, for it is well established that protection by copyright is rooted in *originality*, and courts often use the scope of the original expression in a protected work to decide whether a

81. Originality is the worldwide standard, though not always defined in *Feistian* terms. See Daniel J. Gervais, *Feist Goes Global: A Comparative Analysis of the Notion of Originality in Copyright Law*, 49 J. COPYRIGHT SOC'Y U.S.A. 949 (2002). The existence of originality in borderline cases may be shown by demonstrating that two authors in similar situations (tools, instructions, function of the work, knowledge of applicable standards and practices) would produce substantially different results. See *id.* at 965 n.98. The sources of the originality of the primary and derivative work are different, usually because different authors are involved, but even if the same author prepares the derivative work, the sources differ due to the temporal difference between the two works. See *supra* note 68. The originality may stem from changes to the composition or the inherent structure of the primary work, as when a novel is repurposed for the big screen, to the expression (a translation), or both. See Ochoa, *supra* note 76, at 1006–07 (discussing the *Galoob* case: “The Game Genie does not contain or produce a separate copy (a material object) of the copyrighted work, which could then be transferred; but whether the altered screen displays are a separate work (an intangible intellectual creation) is the question to be decided.”).

82. See, e.g., 17 U.S.C. § 103(b). The Copyright Act states:

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.; see also *infra* note 83 and accompanying text.

particular use is infringing.⁸³ The distinction between derivation and (other forms of) reproduction is that a nonderivative form of copying takes the expression of the primary work, while a derivation may take *but it must also transfer and transform* what makes the primary work original.⁸⁴

The distinction matters.⁸⁵ It matters more than might appear at first glance because derivation is *not* reproduction plus transformation. In a number of cases, what is taken to create the derivative work must be considered differently than under a generic reproduction analysis. Put differently, operationally the two inquiries are often distinct; normatively, they almost always are.⁸⁶ The qualitative part of the reproduction inquiry focuses chiefly on the *form* of what was taken while the derivation inquiry looks at a deeper level of appropriation, namely at whether the *creative choices* that made the primary work worthy of copyright protection were taken.⁸⁷ This is the key to understanding the difference. It explains why the *form* (e.g., two- versus three-dimensional and novel versus film) and mode of expression (e.g., language) of a derivative work (see the list of named derivatives in § 101) are almost always different. Yet, while the form is different and separates a derivative use from a correctly cabined

83. Hence, by contrast, if one copies unoriginal elements, no infringement has taken place. See *Alexander v. Haley*, 460 F. Supp. 40, 41–46 (S.D.N.Y. 1978). The court had to decide whether *Roots*, the famous novel written by Alex Haley, copied the novel *Jubilee*, written by the plaintiff. *Id.* at 42. The court noted that the similarity was essentially that both works were “amalgams of fact and fiction derived from the sombre history of black slavery in the United States. Each purports to be at least loosely based on the lives of the author’s own forbears.” *Id.* This was (rightly) found insufficient to constitute copyright infringement. *Id.* at 46.

84. Naturally, the author of a derivative work is able to exercise her rights only in respect of her additions or changes to the primary work. See, e.g., *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994). Also, under US law, infringement occurs when the expression of another work is taken (that is, not the ideas), which means that expression would have to be taken here as well. See *supra* note 47 and accompanying text. However, as noted above, this large overlap between the reproduction and expression may stem precisely from a lack of precision in the definition of derivation in US law. See *supra* notes 6, 65 and accompanying text.

85. See *STERLING*, *supra* note 61, § 9.04 (“It could be said that all adaptations involve reproduction, where the essential features of the adapted work are used. However, in many laws (and under the Berne Convention) the right of adaptation is viewed separately from that of reproduction.”).

86. As commentators have noted in a discussion of modern French law, but in a remark that can be generalized, “[d]ifficulties arise when courts have to determine at what point sufficient originality in changing the underlying work warrants protection of any resulting derivative work.” Andre Lucas et al., *France*, in 1 *INTERNATIONAL COPYRIGHT LAW & PRACTICE*, at FRA-29 (Paul E. Geller ed., 2011).

87. The creative choices are those that one can isolate by asking whether two authors in similar situations (tools, direction, budget, etc.) would likely have created the same product. See Gervais, *supra* note 81, at 965 n.98; see also Judge & Gervais, *supra* note 70, at 376–77. The Author posits that what might be called the “quantitative part” of the analysis is the determination of the substantiality of the taking.

reproduction inquiry, the main point is that the derivative user takes the *creative choices* that made the primary work original.⁸⁸ For example, when a computer program is transferred to another programming language, not a single word is copied. Hence, is the matter not better understood as a form of derivation?⁸⁹ This Article shows that other major systems that have tried to distinguish those uses for many decades have reached similar conclusions, which are also compatible with major international copyright treaties.⁹⁰

As a corollary to the third principle, the *purpose* of the use is a strong indication of whether a use derives or copies without derivation. Derivation is a use *designed to create and express something new or in a different format*. In this sense, derivation and nonderivative copying both *use* the primary work. Derivation, however, typically uses the work at a higher level of abstraction in order to blend new choices and embed them in the primary work.⁹¹

B. Cautionary Principles

(4) *Because derivative works are often named forms of transformation, any extension of the right beyond those must be done carefully.* Named derivatives (internationally and in most national copyright statutes) usually pose little analytical difficulty.⁹² The problems arise in the category of “penumbral derivatives,” which includes unnamed transformations of a primary work. Courts should take care not to expand that category to new forms of reuse without a clear reason to do so. Otherwise, the category might expand beyond reasonable measure and catch reuses vaguely “based upon” a previous (primary) work in a colloquial sense, but without a solid normative

88. See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348 (1991) (“These choices as to selection and arrangement, so long as they are made independently by the compiler and entail a minimal degree of creativity, are sufficiently original that Congress may protect such compilations through the copyright laws.”); Gervais, *supra* note 81, at 975–81 (suggesting a definition of “creative choice” that would meet copyright law principles).

89. More specifically, the matter is better understood as a form of derivation because the structure of the two languages is likely to be very different. The Author suggests this is the case when any language is translated into a language with a completely different structure (English to, say, Mandarin Chinese).

90. See *infra* Parts III–IV.

91. Consumptive use or use for another purpose (information, education, or entertainment) is typically a copy, not a derivation, and its infringing nature will depend on the presence of a defense (such as fair use) or license. Purpose, like market impact discussed below, is best seen as indicia, not a tool that directly delineates the derivative right.

92. Including, according to the US statute, “translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other . . . [W]ork consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship.” 17 U.S.C. § 101 (2006).

grounding. Think of digital technology and the Internet, which allow for both creation and distribution of works, including mash-ups, sampling-based recordings, and fan sites.⁹³ All of these are based upon preexisting content in a colloquial sense, but are they—or more precisely should they be—considered to infringe rights in such preexisting content from a normative perspective? If so, what are the metes and bounds of the exclusive right? This principle urges caution in the extension of the right to prohibit those new uses.

(5) *Key limiting doctrines apply differently to derivative uses because those uses are also creative.* A better understanding of the derivative right would lead to a better understanding of its inherent limits and of external doctrines such as fair use. Internationally, the idea-expression dichotomy and its US cousin, the *scènes à faire* doctrine, are other good candidates for a differential application to derivative uses (as opposed to pure copies), bearing in mind that many derivative uses are themselves creative.⁹⁴

Beyond the strict confines of the *scènes à faire* doctrine, courts may need to consider certain factors. For instance, courts might consider whether the derivative user had access to a limited stock of building blocks, as is the case for pop music, for example; whether the tools used, including standard UGC software, imposed constraints or maybe even suggested certain choices; and whether the laws of the genre might have dictated a course of action.⁹⁵ Otherwise, copyright “morphs into a terribly crude test of first-in-time, first-in-right.”⁹⁶

Limiting doctrines will likely evolve as they are called upon to accomplish much work in the context of new forms of derivation, especially in providing the necessary modulation to protect free

93. Under US law, this normative guidance must be reconciled with the statutory language, which covers tangible media of expression “now known or later developed.” *Id.* § 102(a). The Author’s point is not to exclude any medium but to suggest caution when expanding rights to new uses of technologies from which new cultural forms and practices may emerge.

94. See Leslie A. Kurtz, *Copyright: The Scènes à Faire Doctrine*, 41 FLA. L. REV. 79, 112–14 (1989).

95. See Wellett Potter & Heather A Forrest, *Musicological and Legal Perspectives on Music Borrowing: Past, Present and Future*, 22 AUSTRALIAN INTELL. PROP. J. 137, 143–44 (2011).

96. *Id.* at 155. The notion of originality as requiring creative (intellectual) choices seems to preclude predicated copyright on mere uniqueness or “novelty.” As the eminent German scholar Eugen Ulmer notes:

[S]tatistical uniqueness, is rapidly achieved. It can result from the mere fact that a pen has squirted abundant quantities of ink, thus producing arbitrarily distributed blots, or that footprints have been left in some way on a support capable of preserving the marks, even though not the slightest requirements have been fulfilled as far as intellectual effort is concerned.

Eugen Ulmer, *The Copyright Concept of Intellectual Works in Modern Art*, 5 COPYRIGHT 80, 81 (1969).

expression. But limits may also come from a proper application of infringement doctrines, particularly in refusing injunctions when the public interest commands otherwise. That said, the issue of potentially excessive statutory damages remains relevant.⁹⁷

(6) *Courts should tread with caution when considering new forms of creation*, from UGC to contemporary art forms based on appropriation, both for First Amendment and cultural reasons.⁹⁸ Part V devotes specific attention to appropriation art to explicate those difficulties. The analysis can be ported to more modern forms of creation such as UGC.⁹⁹

This Article will now attempt to demonstrate the correctness of these six principles, and propose a test to implement them.

III. THE RIGHT TO MAKE DERIVATIVE WORKS FROM AN INTERNATIONAL PERSPECTIVE

This Part begins with the 1886 Berne Convention for the Protection of Literary and Artistic Works (Berne Convention).¹⁰⁰ The Berne Convention is the most comprehensive copyright treaty both in scope and geographic coverage.¹⁰¹ In 1994, it was largely incorporated into the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement).¹⁰²

A look at the evolution of the derivative right in pre-Berne Europe, the cradle of the Berne Convention, yields useful and

97. See Pamela Samuelson & Tara Wheatland, *Statutory Damages in Copyright Law: A Remedy in Need of Reform*, 51 WM. & MARY L. REV. 439, 441 (2009) ("Awards of statutory damages are frequently arbitrary, inconsistent, unprincipled, and sometimes grossly excessive.").

98. See *infra* Part V.C.

99. See *infra* Part V.C.

100. Berne Convention, *supra* note 14. The Berne Convention was originally signed in 1886, following three diplomatic conferences held in Berne, Switzerland, in 1884, 1885, and 1886. A Protocol was added to the Convention at the time of its adoption in 1886, and the Convention itself was later revised six times, in 1896, 1908, 1928, 1948, 1967, and 1971. See generally WIPO, *BERNE CONVENTION CENTENARY 1886–1986* (1986) [hereinafter *BERNE CONVENTION CENTENARY*] (discussing the history of the Convention and providing a summary of the discussions as well as the role of each participating country).

101. As of February 9, 2013, the World Intellectual Property Organization (WIPO) had 166 member states. See WIPO, *Contracting Parties*, <http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treatyid=15> (last visited Feb. 9, 2013). By comparison, the World Trade Organization, which administers the TRIPS Agreement, had 158 Members. See WTO, *Members and Observers*, www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm (last visited Feb. 9, 2013). And the Universal Copyright Convention had 65 member states party to it. See Universal Copyright Convention, July 24, 1971, 25 U.S.T. 1341, 943 U.N.T.S. 194.

102. TRIPS Agreement, *supra* note 47, art. 9(1); *Marrakesh Agreement Establishing the World Trade Organization*, in *THE LEGAL TEXTS: THE RESULTS OF THE URUGUAY ROUND OF MULTILATERAL TRADE NEGOTIATIONS* 320 (Cambridge Univ. Press, 1999).

interesting clues.¹⁰³ Early copyright literature emphasized two types of derivation, namely adaptations and translations, both of which are mentioned in the definition of derivative work in the current US statute.¹⁰⁴ Other adaptations pose greater analytical difficulties.¹⁰⁵

A. *The Emergence of the Derivative Right Internationally*

This Part explores the laws of the nineteenth-century Western European nations that negotiated the Berne Convention to discover clues concerning the beginnings of the derivative right. This first section wishes to paint the broad normative outline of the emergence of the derivative right. Part III.B explains exactly how it emerged and evolved in the text of the Berne Convention.

Early in the twentieth century, European nations did not generally recognize a derivative right.¹⁰⁶ In fact, many key countries failed to recognize even a basic right of translation.¹⁰⁷ For example, as of 1903, Russia had limited the translation right to “scientific works,” and that right was valid for only two years.¹⁰⁸ Denmark only prohibited translation in a Nordic language.¹⁰⁹ More importantly, in

103. Countries attending the 1886 conference where the Convention was signed were Belgium, France, Germany, Great Britain, Haiti, Italy, Japan, Liberia, Spain, Switzerland, Tunisia, and the United States (which only sent a diplomat from the Embassy in Berne to observe, as the United States did not sign the text). See *BERNE CONVENTION CENTENARY*, *supra* note 100, at 28, 130. Another strong indicator is the location of the successive revision conferences, that is, after the original conference held in Berne, Switzerland: Paris (1896), Berlin (1908), Rome (1928), Brussels (1948), Stockholm (1967), and Paris (1971), all cities in Western Europe. See *id.* at 19–24.

104. See 17 U.S.C. § 101 (2006) (mentioning translations and works that are “recast, transformed, or adapted”).

105. Translation (from one language to another) seems mostly self-explanatory, other than for computer programs for which a debate still exists on the “translation” of human-readable source code to executable object code:

While copyright protection is well established for both the source and object code forms of a computer program, the theoretical basis upon which copyright is extended to the object code form of a computer program and the relationship between the source and the object code forms of a computer program have not been clearly articulated. At first glance, the object code version of a computer program appears to be a derivative work of the corresponding source code version of that computer program since compilation appears to translate human comprehensible source code into machine executable object code. The definition of “derivative work” in 17 U.S.C. § 101 reinforces this impression since it includes translations as one of the listed examples of derivative works. Therefore, intuitively, the characterizing object code programs as derivative works of source code programs has great appeal.

Michael F. Morgan. *The Cathedral and the Bazaar: An Examination of the “Viral” Aspects of the GPL*, 27 J. MARSHALL J. COMPUTER & INFO. L. 349, 408–09 (2010).

106. See *infra* notes 107–119 and accompanying text.

107. See GUSTAVE HUARD, 1 *TRAITÉ DE LA PROPRIÉTÉ INTELLECTUELLE* 74 (1903).

108. See *id.*

109. See *id.*

several countries the existence of the right depended on the author making a translation available within a specified timeframe—often only two to three years from the publication of the original version.¹¹⁰ The underlying concerns were clear: access to foreign language works was primordial and trumped copyright.¹¹¹ Those concerns would be reflected in the 1896 text of the Berne Convention, which included a translation right—provided, however, that an authorized translation was made available within ten years.¹¹² This amendment to the original (1886) text of the Berne Convention was adopted as a compromise.¹¹³

France, a major world power and exporter of books at the time, was one of the few countries to insist on a full translation right.¹¹⁴ France had been one of the first European countries to introduce a full translation right in its domestic copyright legislation.¹¹⁵ This domestic example served as the basis for bilateral treaties entered into by the French.¹¹⁶ Interestingly, under French law, infringement depended on the existence of monetary damage to the author.¹¹⁷

110. *See id.*

111. *See id.*

112. *See infra* note 152 and accompanying text.

113. HUARD, *supra* note 107, at 275.

114. ÉTIENNE BRICON, DES DROITS D'AUTEUR DANS LES RAPPORTS INTERNATIONAUX 87 (1888).

115. An 1852 decree by Louis-Napoléon protected the translation right “at the same level as the right of reproduction.” Decree-Law of Mar. 28, 1852, Literary and Artistic Property Rights in Foreign Published Works, *reprinted in* CH. LYON-CAEN & PAUL DELALAIN, I LOIS FRANÇAISES ET ÉTRANGÈRES SUR LA PROPRIÉTÉ LITTÉRAIRE ET ARTISTIQUE 35 (1889). Prince Louis-Napoléon made a statement that might rejoice Lockean theorists: “Intellectual works are property like land and houses.” Letter from Louis-Napoléon to Mr. Jobard (1844), *in* BRICON, *supra* note 114, at 48–49 (Author’s translation). As it happens, Jobard was an advocate for strong authors’ rights and “lobbied” for perpetual rights, a thesis which the Berne Conferences rejected. *See* ÉDOUARD ROMBERG, COMPTE-RENDU DES TRAVAUX DU CONGRES DE LA PROPRIÉTÉ LITTÉRAIRE ET ARTISTIQUE 275 (1859). This was also the interpretation by French courts. *See id.*

116. This is not unlike current US practice in bilateral trade treaties:

Since the early 2000s, the European Union and the United States have pushed aggressively for the development of bilateral and regional trade agreements. Termed economic partnership agreements (“EPAs”) by the European Union and free trade agreements (“FTAs”) by the United States, these instruments seek to transplant laws from the more powerful signatories to the less powerful ones.

Peter K. Yu, *Sinic Trade Agreements*, 44 U.C. DAVIS L. REV. 953, 955 (2011).

117. *See* HUARD, *supra* note 107, at 175. How far the United States has moved from this state of affairs! This is so, especially under the Digital Millennium Copyright Act, 17 U.S.C. § 512 (2006), which made circumvention of technical protection measures illegal even if there is no underlying infringement of the copyright in the work protected by such measure. *See, e.g.*, MDY Indus., LLC v. Blizzard Entm’t, Inc., 629 F.3d 928, 945 (9th Cir. 2010) (noting that traditional copyright infringement was not required but reading the statute broadly to extend protection to “the right to prevent circumvention of access controls”), *amended and superseded on denial of reh’g*, No. 09–15932, 2011 WL 538748 (9th Cir. Feb. 17, 2011). *Contra* Chamberlain Grp. v. Skylink Techs., Inc., 381 F.3d 1178, 1197 (2004).

French courts considered that differences between a new, allegedly infringing work and a preexisting one were irrelevant; they focused instead on how much and what parts of the preexisting work had been appropriated.¹¹⁸ The inquiry proceeded as follows: first, were elements that gave the primary work its “originality” taken, and second, did this appropriation cause a (financial) prejudice to the author?¹¹⁹ Under this two-prong test, abridgements, musical arrangements, and translations were generally prohibited because, first, the author would lose the benefit of being able to license such uses, and second, those uses took the “pith and marrow” of the primary work.¹²⁰

Access to foreign-language works was a clear concern for several of the other Berne countries.¹²¹ Arguing in favor of subordinating the existence of the right of translation to the publication of an authorized translation (access, in modern parlance) within a certain period of time, the organizers of the 1859 Congress of the Association Littéraire et Artistique Internationale (ALAI) wrote:

The starting point of the literary property right is the publication of a work. Society guarantees authors certain advantages in exchange for those he himself provides. Yet the translation privilege, when the author fails to use it, is an effect without a cause. It is not fair that society shall be forever deprived, by his negligence or omission, an enjoyment on which it could count, and that people other than the author are prepared to provide.¹²²

A broader right of adaptation (beyond translation) did not get the same level of even partial support because it clashed with the practice

118. See *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 56 (2d Cir. 1936) (“[N]o plagiarist can excuse the wrong by showing how much of his work he did not pirate.”). For French law on this point, see HUARD, *supra* note 107, at 175.

119. See HUARD, *supra* note 107, at 175–76.

120. *Id.* at 176–79.

121. The “Acts” of Congresses of the Association Littéraire et Artistique Internationale (ALAI) that took place before 1884 shed additional light on the matter. The first Diplomatic Conference to negotiate the Berne Convention was held in 1884. ALAI had submitted a draft, which the Swiss government modified and submitted as a draft treaty. ALAI was a key player on several levels, having produced the initial draft of the Berne Convention. See STEPHEN P. LADAS, 1 THE INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY 71–88 (1938); 6 REV. INT’L DU DROIT D’AUTEUR 144, 144–45 (1955). ALAI continued to take part (as what in modern parlance would be called a nongovernmental organization) in the discussions, however. ALAI was founded in 1878 by French playwright and public intellectual Victor Hugo, its first President. ALAI Congresses were held (during the relevant period) in 1879 (London); 1880 (Lisbon); 1881 (Vienna); 1882 (Rome); 1883 (Amsterdam), and 1884 (Brussels). See ACTES DU CONGRÈS DE DRESDE 11 (1895). ALAI had argued in favor of a full reproduction right and an adaptation right (at least the production of a dramatic version of a nondramatic work, starting in 1887 (Madrid) and essentially at every ALAI Congress after that. See *id.* at 7–8.

122. ÉDOUARD ROMBERG, COMPTE-RENDU DES TRAVAUX DU CONGRÈS DE LA PROPRIÉTÉ LITTÉRAIRE ET ARTISTIQUE 11 (1859). The Author’s translation retained the gendered references in the original text.

of many Berne members.¹²³ The adaptation of three-dimensional works of art in two-dimensional formats or vice versa (industrial design) was a major concern for Austria, Finland, Germany, Japan, and Mexico.¹²⁴

Matters were not wholly different in the United Kingdom. The British International Copyright Act protected translations.¹²⁵ But Britain allowed other adaptations of non-British works.¹²⁶ For example, in *Wood v. Chart*, the court found that the translation of the French play *Frou-Frou* was in fact a permissible "imitation or adaptation" to the English stage and not a translation, quoting the language of the statute at the time.¹²⁷ The apparent distinction was that a translation would afford "the English people . . . the opportunity of knowing the French work as accurately as possible."¹²⁸ By contrast, the defendant's version transferred some scenes from France to England, made the characters English and introduced English manners, which the court was prompt to note "differ from French manners."¹²⁹

In discussing musical arrangements, Copinger makes a similar point, in a way that seems to prefigure the "lay hearer" test of more recent US cases. Copinger states:

Now, the most unlettered in music can distinguish one song from another, and the mere adaptation of the air, either by changing it to a dance or by transferring it from one instrument to another, does not, even to common apprehensions, alter the original subject. The ear tells you that it is the same. The original air requires the aid of genius for its construction, but a mere mechanic in music can make the adaptation or accompaniment.¹³⁰

123. See HUARD, *supra* note 107, at 74.

124. See *id.*

125. See International Copyright Act, 1852, 15 & 16 Vict., c. 12 (Eng.).

126. *Id.* A number of European playwrights chose not to publish their plays and only allowed their public performance to avoid having their plays adapted without their authorization in the United States. See BRICON, *supra* note 114, at 34-36. This concern about access is still reflected today in the Appendix to the Convention, which allows developing countries to grant compulsory translation licenses for works not made available in a national language.

127. See WALTER ARTHUR COPINGER, *THE LAW OF COPYRIGHT IN WORKS OF LITERATURE AND ART* 481 (1893).

128. *Id.*

129. *Id.* Interestingly, in the index to the book, under the entry "Adaptation," it says "see Imitations." *Id.* at cxix.

130. *Id.* at 160. Copinger may be referring to *D'Almaine v. Boosey*, (1835) 160 Eng. Rep. 117 (H.L.), a House of Lords decision holding the defendant's musical arrangement an infringement of the underlying musical work because the arrangement lacked original authorship. The court implied that an adaptation could not be original *and* infringing. See *id.* The Author is grateful to Jane Ginsburg for this insight. On the lay hearer test, see Michael Der Manuelian, Note, *The Role of the Expert Witness in Music Copyright Infringement Cases*, 57 *FORDHAM L. REV.* 127, 144-45 (1988).

Commentators emphasized the nature of the adaptor's work to support the freedom to adapt foreign works.¹³¹ They referred to the "great talents, ingenuity, and judgment" of authors of notes or additions to existing works not just as permissible but worthy of their own copyright.¹³² This is part of the key distinction between copying and derivation.

European countries worked hard to try to define the exact scope of uses protected by copyright. Switzerland, as the host of the three conferences that led to the adoption of the Berne Convention, had a key role to play in the negotiations. In the course of the early discussions leading up to the Berne negotiations, the (future) Swiss delegate at the Berne Convention preparatory conferences, Louis Ulbach, provided a definition of the term "adaptation": "[An adaptation] is the *transformation*¹³³ by striking off, changes to the text, or by developments that the original author had not foreseen, *with the sole purpose of appropriating the work* without giving the impression of translating or infringing it."¹³⁴ As discussed below, the 1886 Berne Conference would in fact assimilate adaptations to "disguised" reproductions.¹³⁵ Those early texts distinguished a specific form of derivation (translation) and hesitated to grant a right beyond translation with respect to other forms of transformations or adaptations.¹³⁶

The following years would see other derivatives emerge, leading to an early international notion of derivative work that included translations and *specific conversions or transformations* of a primary work, which encompassed transformations from one format or genre to another (e.g., novel to film or play; film to novel or play, etc.) and musical arrangements.¹³⁷ Beyond that, the penumbral category (unnamed derivatives) was present (other "appropriations by alteration") but remained very diffuse. It rested on a concept of "disguised reproduction."¹³⁸ The notion of derivative work then continued to evolve, most notably in the 1948 text of the Berne

131. RICHARD GODSON, A PRACTICAL TREATISE ON THE LAW OF PATENTS FOR INVENTIONS AND OF COPYRIGHT 242 (1832). Godson, a member of the British Parliament, cites a case where a new edition of Milton's *Paradise Lost* (which was in the public domain) could not be reprinted without authorization because it contained additional notes still protected by copyright. *See id.* at 244; *see also* *Tonson v. Walker*, (1739) 96 Eng. Rep. 184.

132. *See* GODSON, *supra* note 131, at 242.

133. The French term is "travestissement," which has a clear pejorative connotation. Literally, it means the "cross-dressing" of a work.

134. *See* BRICON, *supra* note 114, at 86–87 (emphasis added).

135. *Id.* at 88.

136. *See id.*

137. *See id.*

138. *See id.*

Convention, to include *noncopying* “alterations,” that is, infringement by derivations not involving (only) a reproduction.¹³⁹

One can see that, at the international level, the right against the making of unauthorized derivatives was conceptually distinct from the right of reproduction.¹⁴⁰ The cradle of the early notion of derivation was the suggestion that what constitutes an infringing *appropriation*¹⁴¹ is the *taking of those elements that gave the infringed work its originality* and transforming or recasting them.¹⁴² The approach was consistent: a work was protected under that proposal if it was original, if it was infringed, and if what the defendant took was what made it original in the first place.¹⁴³ In more modern parlance, this analysis aligns the test to grant protection (originality) and the infringement analysis (how much or what elements of the plaintiff’s work were taken).¹⁴⁴ This is also precisely what courts tend to do, and it demonstrates the correctness of filtering out elements that cannot be protected.¹⁴⁵ The approach allows one to make appropriate distinctions about the “copyright value” of what was taken, on the one hand, and what was produced, on the other.

B. The Derivative Right in the Berne Convention

The original (1886) text of the Berne Convention established a distinction between translations and other forms of adaptation. It stated, first, that “lawful translations shall be protected as original works,” adding that “in the case of a work for which the translating

139. See BERNE CONVENTION CENTENARY, *supra* note 100, at 231.

140. See *id.*

141. The Author hesitates to use “misappropriation” because that term has its own significance, although the overlap between the illicit appropriation in the Berne *travaux* and the common-law notion of misappropriation is significant. For a discussion on the issue in the United States, where it tends to revolve around federal preemption, see Lauren M. Gregory, Note, *Hot Off the Presses: How Traditional Newspaper Journalism Can Help Reinvent the “Hot News” Misappropriation Tort in the Internet Age*, 13 VAND. J. ENT. & TECH. L. 577 (2011). Gregory, discussing *NBA v. Motorola, Inc.*, 105 F.3d 841 (2d Cir. 1997), noted:

[T]he “extra element” test [from *NBA*] it produced is useful in defining the boundaries of hot news misappropriation [T]he court was trying to demonstrate that misappropriation is distinct enough from copyright infringement to stand on its own legal footing. In other words, misappropriation—stealing from a competitor to get ahead in business—is distinct from the generalized bad-faith taking that copyright law prohibits, and is not, therefore, preempted by copyright law.

Id. at 596. The approach chosen here is reminiscent of the improper-appropriation test applied in *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946).

142. And similar to the approach taken by a number of US courts. See *infra* Part III.B.

143. See BERNE CONVENTION CENTENARY, *supra* note 100, at 231.

144. See Gervais, *supra* note 81, at 978–81.

145. See, e.g., *Computer Assocs. Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 707 (2d Cir. 1992); see also 4 NIMMER & NIMMER, *supra* note 60, § 13.03[A].

right has fallen into the public domain, the translator cannot oppose the translation of the same work by other writers.”¹⁴⁶ Then, Article 10 included “among the unlawful reproductions to which this Convention applies,” the following: “unauthorized indirect appropriations of a literary or artistic work, of various kinds, such as adaptations, musical arrangements, etc.”¹⁴⁷ As suggested in the *New Guide*, the notion of derivative work was subsumed under that of reproduction in the 1886 text.¹⁴⁸ This seems to have been based on the perception that both reproductions and adaptation were comparable misappropriations of the preexisting work by the author of the copy and of the derivative work.¹⁴⁹

The 1896 Additional Act and Interpretative Protocol to the Convention¹⁵⁰ added an exclusive right of translation for authors “throughout the term of their right in the original work.”¹⁵¹ It had an important caveat, however: that right ceased to exist if the author had not “availed himself of it during a term of ten years from the date of first publication of the primary work, by publishing or causing to be published, in one of the countries of the Union, a translation in the language for which protection is claimed.”¹⁵²

Twelve years later at the 1908 Berlin Revision Conference, the Berne Convention maintained the prohibition against “unauthorized indirect appropriations”¹⁵³ but made clear that it intended to cover only adaptations or translations *by reproduction*.¹⁵⁴ There was thus no distinct derivative right in the Berne Convention at the time. While the 1908 Berlin Act made it clear that a *translation* had to be authorized, it also deleted the 1886 mention that only lawful translations were themselves protected works.¹⁵⁵ Beyond that, there was simply no agreement on the normative limits of the right. While some countries pushed for a broad right, a commentator noted that

146. Berne Convention, *supra* note 14, art. 6; see BERNE CONVENTION CENTENARY, *supra* note 100, at 228. For dramatic works, the right extended to public performances of the translated work. See Berne Convention, *supra* note 14, art. 9(2).

147. BERNE CONVENTION CENTENARY, *supra* note 100, at 228.

148. See MIHÁLY FICSOR, GUIDE TO THE COPYRIGHT AND RELATED RIGHTS TREATIES ADMINISTERED BY WIPO AND GLOSSARY OF COPYRIGHT AND RELATED RIGHTS TERMS 81 (2003) [hereinafter NEW GUIDE].

149. See *id.*

150. *Id.* at 228.

151. *Id.*

152. *Id.* The ten-year rule is still available under the most recent (1971) Act of the Convention but is subject to a declaration. See Berne Convention, *supra* note 14, art. 30(2)(b).

153. ANDRÉ PETIT, ÉTUDE SUR LA CONVENTION DE BERLIN DE 1908 POUR LA PROTECTION DES ŒUVRES LITTÉRAIRES ET ARTISTIQUES 28–29 (ŒUVRES LITTÉRAIRES ET ARTISTIQUES 1911).

154. See CLAUDE MASOUYÉ, GUIDE TO THE BERNE CONVENTION 76 (1978) [hereinafter GUIDE] (emphasis added).

155. BERNE CONVENTION CENTENARY, *supra* note 100, at 150–52.

letting a translator enforce her rights on an unauthorized translation “pushed a little too far” the notion of authors’ rights.¹⁵⁶ A clear concern, as international trade in books was growing, was access to foreign works.¹⁵⁷

Reading Articles 2 and 12 of the Berlin Act (1908) in tandem, it becomes clear that the notion of derivation in the Berne Convention was understood at the time as follows: First, adaptations could constitute original works.¹⁵⁸ Indeed, in later revisions of the Berne Convention it was said that adaptations *must* be original in their own right to be considered derivative works at all.¹⁵⁹ Second, the adaptation right was still viewed as a subset of the right of reproduction.¹⁶⁰ Article 12 defined an *infringing* adaptation as a *reproduction* in the same form with nonessential changes, additions, or deletions, *which was not in itself an original work*.¹⁶¹ This implied that using a preexisting work to create a new, original one would not infringe, a view that some courts, notably in Germany, had endorsed.¹⁶² Interestingly, this formulation may be viewed as a precursor of the US notion of transformativeness in fair use jurisprudence and of the equivalent French notion.¹⁶³ Indeed, there is an explicit reference in the Berlin (1908) text to “transformed” reproductions.¹⁶⁴ A French commentator mentions as examples of acceptable adaptations parodies and transformations of a serious work

156. PETIT, *supra* note 153, at 27.

157. See NEW GUIDE, *supra* note 148, at 53 (“The right of translation was the first right to be recognized under the Convention, which is quite understandable since the use of works of other countries in translations was the most obvious issue in international relations.”). A basic ten-year right was present in the original 1886 text. See GUIDE, *supra* note 154. It was expanded significantly in 1896. See NEW GUIDE, *supra* note 148, at 53.

158. There were a number of anomalies in the drafting, however. The meaning is clearer now, but only in hindsight. See 1 SAM RICKETSON & JANE C. GINSBURG, INTERNATIONAL COPYRIGHT AND NEIGHBOURING RIGHTS 480–81 (2d ed. 2006).

159. See *id.* at 483 (“‘Alteration’ for the purposes of article 2(3) must imply something further, a change, modification, or transformation of the original; work resulting in something which can fairly be regarded as a distinct intellectual creation.”).

160. *Id.* at 481–82.

161. *Id.* at 650 (emphasis added).

162. See NEIL WEINSTOCK NETANEL, COPYRIGHT’S PARADOX 59 (2008).

163. The French Intellectual Property Code states that “The authors of *translations, adaptations, transformations or arrangements of works* of the mind shall enjoy the protection afforded by this Code, without prejudice to the rights of the author of the original work. The same shall apply to the authors of anthologies or collections of miscellaneous works or data, such as databases, which, by reason of the selection or the arrangement of their contents, constitute intellectual creations.” CODE DE LA PROPRIÉTÉ INTELLECTUELLE, Art. L.112–13 (Fr.) (emphasis added). The French Civil Supreme Court (*Cour de cassation*) found that the proper limit of the right of the adapted or transformed work was reached when the transformation of the intrinsic form of that work is so deep that the original form was no longer present. See *Cour de cassation* [Cass.] [supreme court for judicial matters] 1re civ., D. 1992, 182, note Gautier (Fr.).

164. See BERNE CONVENTION CENTENARY, *supra* note 100, at 229.

in the form of comedies such as operettas and *opéras-bouffe*, provided that the adaptation resulted from a personal contribution that had given a “new spirit” to the work.¹⁶⁵

But matters evolved beyond this initial approach. The changes made to the Berne Convention at the Brussels Revision Conference in 1948¹⁶⁶ reflected the belief that limiting infringement adaptation to reproductions (or subsuming the former under the latter) was incorrect or too narrow an approach: “[T]here are other ways of exploiting works. It *became common ground* that, in general, the author enjoyed the Convention’s right not only for his work in its original form but also for all *transformations* of it.”¹⁶⁷

The new provision refrained “from laying down what constitutes adaptation, but *it is agreed* that this includes *any new form of the substance of the work*, marginal cases being left to the courts.”¹⁶⁸ By 1948, the Berne Convention was thus drawing closer to infringement *beyond reproduction* by the taking of the “originality” (substance) of the work.¹⁶⁹ In fact, the 1948 Brussels Act of the Berne Convention formally divorced derivative works from the existence of a reproduction.¹⁷⁰ The Berne drafters envisaged a *broad commercial exploitation right* for protected works.¹⁷¹ The Brussels Act reflected a determined attempt to broaden the scope of protection but *not* by viewing all derivative works as reproductions of protected works.¹⁷²

This notion of protected commercial exploitation also meshes well with the main exception test contained both in the Berne Convention and the TRIPS Agreement.¹⁷³ This is known as the three-step test, the second step of which prohibits exceptions that

165. The Author points to Wikipedia, which got it right on this point. An *opéra-bouffe* is a “genre of late 19th century French operetta, closely associated with Jacques Offenbach, who produced many of them at the *Théâtre des Bouffes-Parisiens* that gave its name to the form.” *Opéra Bouffe*, WIKIPEDIA, <http://en.wikipedia.org> (search “Opéra bouffe”) (last visited Dec. 15, 2011). The long-standing conceptual confusion underlying the conclusion that if the adaptation displays original authorship it *could not* also be infringing was surmounted by the 1948 Berne text. See PETIT, *supra* note 153, at 29.

166. See BERNE CONVENTION CENTENARY, *supra* note 100, at 231–32.

167. GUIDE, *supra* note 154, at 76 (emphasis added).

168. *Id.* at 77 (emphasis added).

169. See *infra* note 171 and accompanying text.

170. See BERNE CONVENTION CENTENARY, *supra* note 100, at 180–81, 231.

171. See SILKE VON LEWINSKI, INTERNATIONAL COPYRIGHT LAW AND POLICY 142–43 (2008) (“[A]daptation was conceived in the early versions of the Berne Convention as a specific kind of reproduction It was only at the 1948 Brussels Conference that the adaptation right was formulated as a self-standing, independent exclusive right . . .”).

172. *Id.*

173. TRIPS Agreement, *supra* note 47.

interfere with normal commercial exploitation of the work.¹⁷⁴ If one were to reconcile the right and the exception, the question could be framed as follows: when is (enough of) the substance of a work taken that it affects the market for the primary work?¹⁷⁵ In the case of a translation and presumably of true musical arrangements the answer may not be too hard to find, but the line may be harder to draw with respect to mash-ups and other forms of remix and reuse.¹⁷⁶

C. Derivative Works in the Current Text of the Berne Convention

The current text (1971) of the Berne Convention, to which the United States became party in 1989, contains a number of provisions that are relevant to the analysis. The first worth mentioning is Article 2(3), which reads as follows: “*Translations, adaptations, arrangements of music and other alterations* of a literary or artistic work shall be protected as original works without prejudice to the copyright in the original work.”¹⁷⁷ The original *World Intellectual Property Organization (WIPO) Guide to the Berne Convention* noted in connection with this provision that “[t]his paragraph deals with *what are often called derivative works*, i.e., those based on another, pre-existing, work.”¹⁷⁸ The *Guide* explained that there are four types of derivative works.¹⁷⁹ First, *translations* “express another’s thoughts in a different language.”¹⁸⁰ Second, *adaptations* are generally works in their own right and consist of adapting a work in a different format, for example a novel finding its way onto a stage or screen.¹⁸¹ An adaptation may, of course, also be a translation.¹⁸² The third type is musical arrangements; the fourth, “generally all other alterations of literary and artistic works.”¹⁸³ The first three are the named derivatives previously identified. The last covers penumbral

174. See Daniel J. Gervais, *Towards a New Core International Copyright Norm: The Reverse Three-Step Test*, 9 MARQ. INTELL. PROP. L. REV. 1, 16–19 (2005).

175. This goes back to the ratio issue and the quotation right. An interesting remark was made by the *Rapporteur* of the Brussels Revision Conference: “The question of borrowings from known works has always been a source of abuses; moreover it is very difficult to bridle the right of quotation which, without actually affording evidence of culture, remains a habit of writers.” BERNE CONVENTION CENTENARY, *supra* note 100, at 180.

176. See *infra* Part V.B.

177. Berne Convention, *supra* note 14, art. 2(3) (emphasis added).

178. GUIDE, *supra* note 154, at 19 (emphasis added).

179. *Id.*

180. *Id.*

181. *Id.*

182. *Id.*

183. *Id.*

derivatives.¹⁸⁴ No express criteria are provided in the Berne Convention to determine where the line should be drawn between the creation of a derivative work and simple “inspiration” that would not require an authorization. But commentators have argued that the normative footing for the entire category is identical because the “skills necessary for adaptation and arrangement could be compared to those necessary for translation.”¹⁸⁵

Other substantive provisions worth mentioning in this context—compilations, translations, and adaptations—are structured along the same lines.¹⁸⁶ The Berne Convention contains, first, a right of translation and a number of rights related thereto.¹⁸⁷ Second, the Berne Convention provides for a right of adaptation defined as the right of authorizing “adaptations, arrangements and other alterations of [authors’] works.”¹⁸⁸ This suggests that the notion of derivative works in the Berne Convention is an *umbrella notion* that encompasses translations, adaptations (including changes of “format”), musical arrangements, and other alterations, but is also distinct from reproduction.¹⁸⁹

The new *WIPO Guide to the Berne Convention*, published in 2003, explains that the right of adaptation “may find *its origin* in the right of reproduction.”¹⁹⁰ This is because an adaptation means “the combination of the pre-existing elements of the works concerned—the use of which in the adaptation, etc., may well be regarded as reproduction of those elements—with some new ones, as a result of which normally a new work emerges.”¹⁹¹ The *New Guide* suggests, however, that Article 12, the main provision on the right of adaptation in the Berne Convention added in 1948, was meant to limit confusion “in respect of those cases where adaptations, etc., amounted to the creation of new derivative works.”¹⁹²

From this analysis, one can posit that there is a difference between derivation as defined in Berne and reproduction. While both

184. *Id.*

185. See 1 RICKETSON & GINSBURG, *supra* note 158, at 476.

186. See Berne Convention, *supra* note 14, arts. 2(3), 2(5), 8, 12.

187. *Id.* arts. 8, 11*bis*(2), 11*ter*(2). The former provides authors of dramatic and dramatic-musical works “the same rights with respect to translations thereof.” As the Guide to the Berne Convention explains, Article 8 applies if a libretto is translated, but if that translated libretto is publicly performed, then Article 11*bis*(2) applies. See GUIDE, *supra* note 154, at 65. Article 11*ter*(2) provides for a right to “recite” translations of literary works. Public recitation would be considered a public performance under US law. *Id.*

188. See Berne Convention, *supra* note 14, art. 12.

189. See NEW GUIDE, *supra* note 148, at 81.

190. *Id.*

191. *Id.*

192. *Id.* at 81–82.

rights are normatively motivated by a desire to protect legitimate market expectations, derivation is not a subset or de minimis adjunct of reproduction, unlike, say, trademark dilution.¹⁹³ It has its own domain, which will become clearer as Part IV considers doctrines of France and Germany, two countries that played a major role in the evolution of the Berne Convention.

IV. THE DERIVATIVE RIGHT IN MAJOR EUROPEAN LEGAL SYSTEMS

Part IV now turns the analytical spotlight to three sovereign states, France, Germany, and the United Kingdom, all of which have a long tradition and rich copyright doctrine, to look for useful insights on what makes a new work a derivative of another.

A. France

French law dealing with the scope of the derivative right is illuminating. There are, as seen below, many parallels with US law, but also a number of differences.¹⁹⁴ One obvious parallel is that derivation comes under one of the two major rights umbrellas: reproduction.¹⁹⁵ Two important differences are that (a) fixation is not required to obtain copyright protection, and (b) performances are protected under a neighboring right.¹⁹⁶

Another reason to consider French law is that French courts and scholars have struggled with the notion of derivative works for

193. In *Ty Inc. v. Perryman*, 306 F.3d 509 (7th Cir. 2002), Judge Posner seems to consider free-riding a form of dilution:

[T]here is a possible concern with situations in which, though there is neither blurring nor tarnishment, someone is still taking a free ride on the investment of the trademark owner in the trademark. . . . This rationale for antidilution law has not yet been articulated in or even implied by the case law, although a few cases suggest that the concept of dilution is not exhausted by blurring and tarnishment. . . . The validity of the rationale may be doubted, however.

Ty Inc., 306 F.3d at 512. Free-riding is also one of the asserted foundations of the right. See Greg Lastowka, *Trademark's Daemons*, 48 HOUS. L. REV. 779, 813–14 (2011). The Author sees it more as a normative driver than a tool to define the scope of the right.

194. See PAUL GOLDSTEIN & P. BERNT HUGENHOLTZ, *INTERNATIONAL COPYRIGHT* 316 (2d ed. 2010).

195. Apart from the moral right, there are two umbrellas for economic copyright rights in French law, a *summa division* between the right of reproduction, which includes adaptation, translation, and similar alterations, and the right of “representation,” which includes public performance in front of a live audience or at a distance (known as communication to the public) and other ways in which the work made available without copies being made. See ANDRÉ LUCAS ET AL., *TRAITÉ DE LA PROPRIÉTÉ LITTÉRAIRE ET ARTISTIQUE* 247–48 (4th ed. 2012). In spite of this, however, French scholars cabin reproduction qua reproduction and derivation. See *infra* notes 197–214 and accompanying text.

196. On the former point, see *supra* notes 17–19 and accompanying text. On the latter, see Gruenberger, *supra* note 21, at 627–28.

decades and have suggested a number of useful distinctions.¹⁹⁷ Trying to properly cabin reuses requiring an authorization from the owner of the primary work, French commentators tried to distinguish works of “absolute originality” from those that result from only “relative originality.”¹⁹⁸ But they had to acknowledge that originality is rarely “absolute” in the sense that works are always *based upon* the author’s experience and previous contacts with other works.¹⁹⁹ It is difficult to justify the granting of a right to prohibit the making of *any* work “based upon” one or more preexisting works. The right must be properly anchored both normatively and historically.²⁰⁰

Henri Desbois—probably still today the most cited copyright scholar in France—offered several interesting hypotheses. First, he suggested that authors of original works who borrow “protected elements” from preexisting works were entitled to copyright protection, though not if they infringe a primary work, a solution not surprising to US readers.²⁰¹ He then suggested a list of named derivative works based on the French statute in existence at the time (namely the 1957 Copyright Act): translations and literary adaptations, transformations (which typically imply a transposition from one genre to another, e.g., painting to sculpture), and musical arrangements, including variations.²⁰²

In trying to define derivative works, Desbois suggested that their originality stemmed *from their composition, their literal expression, or both*. Derivation by adaptation usually incorporates some of both, because even if the adaptor was following someone else, he followed his imagination in adding elements of his own.²⁰³ By contrast, a translator is enslaved to the primary work and is not expected to add compositional elements. The originality is then strictly based in the expression of the translator, not the

197. As already noted, the text of the French statute is similar in some respects to the US Copyright Act, particularly in forcing courts to decide what is an infringing transformation. Article L. 112–13 of the French Intellectual Property Code provides in part that:

The authors of translations, adaptations, *transformations* or arrangements of works of the mind shall enjoy the protection afforded by this Code, without prejudice to the rights of the author of the original work. The same shall apply to the authors of anthologies or collections of miscellaneous works or data, such as databases, which, by reason of the selection or the arrangement of their contents, constitute intellectual creations.

CODE DE LA PROPRIÉTÉ INTELLECTUELLE, Art. L.112–13 (Fr.) (emphasis added) (WIPOLex translation).

198. HENRI DESBOIS, *LE DROIT D'AUTEUR EN FRANCE* 9 (1978).

199. *See id.*

200. *See id.*

201. *See id.*

202. *See id.*

203. *See id.* at 33.

composition.²⁰⁴ The translator also makes creative choices, however, in adapting the work to her own language and in selecting "more or less adequate wording."²⁰⁵ Desbois saw the existence of originality in the fact that two translators usually come up with very different results if asked to translate the same text (unless it is very short or highly technical).²⁰⁶ By contrast, the best example of a derivative work that is original only by reason of its composition but not of its expression would be an anthology, which may be original due to the selection and arrangement of the contents.²⁰⁷ In both cases, however, the *message embedded in the primary work is not fundamentally altered*.

According to Desbois and the authors he relied on, including Professors de Sanctis and Saporta, a visual artist who "disfigured" a character described in a preexisting novel could be liable for a moral right violation, but not for infringing the derivative right, because he did not see that right as crossing from the figurative arts to the literary ones.²⁰⁸ The explanation he gives is interesting. Desbois quoted Saporta, among others, who justified his view by stating that the economic exploitation of one genre had no impact on the exploitation of other genres.²⁰⁹ Desbois agreed but only partially, noting that a painting made from a novel might be analogized to a

204. See *id.*

205. See *id.*

206. See *id.* Surprisingly, Desbois was willing to give a copyright to someone copying a work of art because of the skill involved by comparing the copyist effort to a translation, although the two types of work seem wholly different. See *id.* at 75-76. Desbois seems to imply that choosing to copy is a manifestation of personality. See *id.* This might inform an analysis of some appropriation or forms of similar contemporary art. See *infra* Part V.

207. This notion closely mirrors Article 2(5) of the Berne Convention, which provides that "[c]ollections of literary or artistic works such as encyclopaedias and anthologies which, by reason of the selection and arrangement of their contents, constitute intellectual creations shall be protected as such, without prejudice to the copyright in each of the works forming part of such collections." Berne Convention, *supra* note 14, art. 2(5). Article 10.2 of the TRIPS Agreement provides, along similar lines, that "[c]ompilations of data or other material, whether in machine readable or other form, which by reason of the selection or arrangement of their contents constitute intellectual creations shall be protected as such. Such protection, which shall not extend to the data or material itself, shall be without prejudice to any copyright subsisting in the data or material itself." TRIPS Agreement, *supra* note 47, art. 10(2). This is also similar to § 101 of the Copyright Act, which defines a "compilation" in part 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." 17 U.S.C. § 101 (2006). In US law, a work such as an anthology would be a collective work. See *id.*

208. See DESBOIS, *supra* note 198, at 106.

209. See *id.*; Marcel Saporta, *A Few Notes on the Creation of "Personages"*, 11 REVUE INT. DROIT D'AUTEUR 63 (1956). Saporta authored a book on the limits of copyright protection in which he suggests that impact on economic exploitation should guide the policy-maker in deciding whether an exclusive economic right applies. See Marcel Saporta, LES FRONTIÈRES DU DROIT D'AUTEUR (1951).

movie made from the same novel.²¹⁰ Since the latter was a recognized form of adaptation, there was no good normative reason to consider the former any differently.²¹¹ The lesson from this is that there may be a common normative intuition to what constitutes a derivative work among the various categories of literary and artistic works, more than in simply seeing a derivation as crossing the genre barrier.

Professor André Lucas, a very senior scholar in France and the coauthor of the leading current treatise on French copyright law, has suggested that what makes a work a derivative of another (as a copyright matter) is the fact that *it borrows the elements that generated copyright protection in the primary work*, which typically would be by copying parts of it or its “general composition.”²¹² Lucas discusses Desbois’s approach, which he describes as the composition test.²¹³ The test teaches that to decide whether an appropriation crosses the derivative-right line, one must remember that copyright does not protect the ideas or main incidents, but rather *the particular way the author develops the idea*.²¹⁴ He compares this test with German jurist Jozef Kohler’s distinction between the internal and external form of a work.²¹⁵ The latter seems to fall more properly within the realm of reproduction and the former is better viewed under derivation, especially if the purpose of copying the internal form was to add to or transform it. This approach has theoretical appeal but is admittedly easier to see in the case of, for example, a compilation, than for other forms of artistic creation.²¹⁶ The next section returns to the German approach.

210. See DESBOIS, *supra* note 198, at 106–07.

211. See *id.* at 107.

212. See LUCAS ET AL., *supra* note 195, at 226–27.

213. See *id.* at 304–05.

214. See *id.* at 306–07. Lucas is careful about separating plagiarism from copyright infringement, the former being a more general deontological analysis, the latter based on copyright principles. See *id.* at 304–05. Copyright law focuses on the taking of what makes a work original, while plagiarism focuses on unattributed takings, whether or not the work taken from is protected by copyright:

Material whose copyright has expired, that has been created by the federal government, that is not by nature copyrightable (such as an idea or fact), or that is otherwise in the public domain, cannot be the subject of a copyright infringement lawsuit, but its use without attribution could still ground an accusation of plagiarism.

Walter A. Effross, *Owning Enlightenment: Proprietary Spirituality in the “New Age” Marketplace*, 51 BUFF. L. REV. 483, 551–52 (2003); see also Stuart P. Green, *Plagiarism, Norms, and the Limits of Theft Law: Some Observations on the Use of Criminal Sanctions in Enforcing Intellectual Property Rights*, 54 HASTINGS L.J. 167, 200 (2002) (“Under the Federal Copyright Act, there is no infringement when copying involves work that has an expired copyright [or] is in the public domain The rule against plagiarism has no such limitations.”).

215. See *infra* note 233 and accompanying text.

216. For a fuller discussion of Kohler’s thesis, see *infra* text accompanying notes 229,

234. See also Philippe Gaudrat, *Réflexions sur la Forme des Oeuvres de L’Esprit*, in MÉLANGES

The matter is not only theoretical. The French supreme civil court (*Cour de cassation*) has firmly adopted the “Desbois test” and looks in harder infringement cases for whether the defendant has taken what makes the plaintiff’s work protectable in the first place. Equating this with what can be *misappropriated*, the test is counterbalanced by a broad application of the idea-expression dichotomy.²¹⁷ “Originality,” Lucas tells us, “is the touchstone, the essential condition for protection of a work; it is also the proper measure of the scope of protection.”²¹⁸ He cites a number of key cases including one in which the court found that the “appropriation (*reprise*) without authorization of the original characteristic features of the [primary] work” triggered the derivative right (more specifically the right of adaptation).²¹⁹

In providing examples of whether a work is a derivative subject to the rights of the primary work, Desbois suggested that musical arrangements should be compared to translations because the arranger is trying to preserve the primary work’s character.²²⁰ This supports the principle of proximity (principle (3)) and the inverse principle, namely that a fundamental change of character may well be beyond the reach of the derivative right. As Part V discusses, however, there is a hard line that divides fundamental changes that are noninfringing under a proper derivative-right analysis (in most cases because the idea, not the expression is appropriated), and those that are noninfringing as transformative fair uses.²²¹

Desbois makes interesting suggestions when trying to define which musical arrangements are derivative works and which are mere copies.²²² He places in the latter category changes from one key to

EN L'HONNEUR DE ANDRÉ FRANÇON 195, 201–03 (1995). This distinction may have been intended to make the work of courts easier. See Brad Sherman, *What Is a Copyright Work*, 12 THEORETICAL INQUIRIES L. 99, 114 (2011) (“Given the inherent difficulties in deciding what the identifying traits of a work are, it is not surprising that the courts have fastened onto external markers to help them decide whether something is a work.”).

217. See LUCAS ET AL., *supra* note 195, at 305–06.

218. *Id.* at 308 (Author’s abbreviated translation). Because this passage is difficult to translate, the Author quotes the original text as well: “C’est la notion d’originalité qui, là encore, constitue la pierre de touche. L’originalité est la condition essentielle mise à la naissance du droit de l’auteur. C’est elle qui donnera la mesure de la protection.” *Id.* This analysis also seems solidly anchored in French case law. See *Cour d’appel* [CA] [regional court of appeal] Paris, June 27, 2001 (Fr.). The case may also be found at 2 REV. INT. DROIT D’AUTEUR 426 (2002).

219. See LUCAS ET AL., *supra* note 195, at 308; Tribunal de grande instance [TGI] [ordinary court of original jurisdiction] Nanterre, 1re civ., March 10, 1993 (Fr.).

220. See DESBOIS, *supra* note 198, at 143. Desbois notes that a number of authors referred to arrangements as “musical translations” and quotes Chartier that in an arrangement the “original musical thought is reproduced fully and concretely in its melodic, harmonic and rhythmic development.” *Id.* (Author’s translation).

221. See *infra* Part V.

222. See DESBOIS, *supra* note 198, at 143.

another and other similar arrangements in which the arranger is “more technician than composer.”²²³ This is similar to the previously enunciated test, which considers whether two authors with similar knowledge of music would arrive at substantially the same result in arranging a preexisting work.²²⁴ A positive answer suggests that there was little, if any, room for the creative choices identified in *Feist* and hence for originality to be present.²²⁵ It is also reminiscent of Judge Posner’s denial of copyright protection to the author of a superimposition of two photographic works as not sufficiently original.²²⁶ That was a departure, as Professor Jaszi rightly noted, from more liberal copyright doctrine on this point.²²⁷

Music is a good illustration of Desbois’s proposed test. While some musical arrangements are too trivial or technical to qualify for protection, others are self-evidently original. Was Maurice Ravel’s arrangement of Moussorgski’s *Les tableaux d’une exposition* for orchestra the work of a mere technician?²²⁸ Of course not. Most “variations” must also be allowed to find a home under the umbrella of

223. *Id.* at 144. As Learned Hand explained in *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49 (2d Cir. 1936), if an author produced Keats’s “Ode on a Grecian Urn” again independently, it would be original. *Id.* at 54. That is, however, unlikely, and the test here is one of likelihood: how likely is it in a given fact pattern that two authors would produce substantially the same result. See 2 NIMMER & NIMMER, *supra* note 60, § 8.09[A]. How likely is it that an author unaware of Keats’s work asked to write an Ode on a Grecian urn would write “Heard melodies are sweet, but those unheard; Are sweeter; therefore, ye soft pipes, play on; Not to the sensual ear, but, more endear’d; Pipe to the spirit ditties of no tone”? See John Keats, *Ode on a Grecian Urn*, in THE OXFORD BOOK OF ENGLISH VERSE: 1250–1900, at 729 (A.T. Quiller-Couch ed., 1919).

224. See *supra* note 206 and accompanying text.

225. In *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), the Supreme Court found that certain choices not dictated by the function of the work, applicable standards, etc., were those that generated originality for the purposes of copyright law: “These choices as to selection and arrangement, so long as they are made independently by the compiler and entail a minimal degree of creativity, are sufficiently original that Congress may protect such compilations through the copyright laws.” *Id.* at 348. The Author terms those choices “creative” because the Court also found that originality required at least a modicum of creativity. *Id.* at 362; Gervais, *supra* note 81, at 975.

226. See *Gracen v. Bradford Exch.*, 698 F.2d 300, 305 (7th Cir. 1983). Arguably, the author-artist did more than merely superimpose two photographic works. For a different view, see *Schrock v. Learning Curve Int’l, Inc.*, 586 F.3d 513, 519–21 (7th Cir. 2009), which found that photographs classified as derivative works are not subject to a heightened standard of originality. The Author posits it is likely that other courts or judges might have found the work original.

227. See Peter Jaszi, *Toward a Theory of Copyright: The Metamorphoses of “Authorship”*, 1991 DUKE L. J. 455, 461.

228. This arrangement was the subject of considerable litigation in France. See Cour d’appel [CA][regional court of appeal] Paris, 1e ch., Mar. 10, 1970, D. 1971, 114, note P.L., obs. Desbois (Fr.). For an excerpt of the arrangement, see MichelMusik123, *Tableaux d’une Exposition Moussorgsky Ravel Harmonie de Lens*, YOUTUBE (May 11, 2012), <http://www.youtube.com/watch?v=DbBkVwbVTs8>.

originality.²²⁹ This categorization would also include many works that are rearranged using modern technologies that allow digital manipulation of the sound.²³⁰

Desbois was also correct when he noted that most transcriptions and mere transpositions, which often require a significant amount of technical work but little personal addition by the arranger, lack the required degree of originality to constitute works in their own right.²³¹ As a rule of thumb, again ask whether two arrangers working within similar parameters would achieve a substantially similar outcome. A negative answer is a strong indicator that there is room for an original contribution, whereas a positive answer is a strong indicator that there is no originality.²³²

B. Germany

Germany's authors-rights doctrine is rich and also very helpful in understanding the derivative right. Josef Kohler explained that an author produces a work by expressing what is taken from a common font. He named the common font *Weltschöpfungsidee* and suggested that a work was an abstract representation (*imaginäres Bild*) the author derived.²³³ From this representation the author would give a work its skeleton or "inner form" (*innere Form*) and then its outer form (*äussere Form*), which adds layers of details to the copyrighted work.²³⁴

This is comparable to the creative-choices approach under US law.²³⁵ The question becomes whether preexisting ideas were appropriated, or if protected expression was appropriated, which might then trigger the derivative right. This idea that authors create by progressively increasing the precision of their creation from a general (and unprotected) idea to a protected expression is also found

229. Referring to the suggested originality test, see *supra* note 223 and accompanying text. Leopold Stokowski also did an orchestral arrangement of *Les Tableaux d'une Exposition* ("Pictures at an Exhibition"), and it is quite different. For an excerpt of the arrangement, see Addiobelpassato, *Mussorgsky "Pictures at an Exhibition" arr: Stokowski*, YOUTUBE (Aug. 29, 2012), <http://www.youtube.com/watch?v=UBjpzkaD8JI>.

230. However, the Author would exclude CGM because a human author is needed. See Daniel Gervais, *The Protection Under International Copyright Law of Works Created with or by Computers*, in 22 IIC INT'L REV. INTELL. PROP. & COPYRIGHT L. 628, 641–54 (1991); see also GINSBURG & GORMAN, *supra* note 38, at 21.

231. DESBOIS, *supra* note 198, at 143–44.

232. See Gervais, *supra* note 81, at 978.

233. See IVAN CHERPILLOD, *L'OBJET DU DROIT D'AUTEUR* 26–27 (1985).

234. See *id.*

235. See *supra* note 225 and accompanying text.

in Desbois's writings, as in a number of others.²³⁶ Indeed, this is not that different from the abstraction test in US cases such as *Altai*.²³⁷ One could object to the subjectivity of Kohler's test (peering into an author's mind) because the process may imply that a protected expression exists before its full, objectively perceptible expression is available. But the difficulty may be avoided by considering only the objectified form (in most cases, its first fixation) as protected and, consequently, appropriable.²³⁸

Like France, Germany requires that the derivative work be original in the sense that it must be a *personal intellectual creation* and, specifically in the case of musical works, the result of more than insubstantial work.²³⁹ Germany also has an interesting doctrine of "free utilization" (*freie Benutzung*) aimed at accentuating the distinction between derivation and inspiration.²⁴⁰ The test is one of

236. See CHERPILLOD, *supra* note 233, at 32. Andrzej Kopff speaks of building a work in "layers" or "strata" (*Schichtenaufbau des Werkes*). See *id.* at 38. De Boor, building on insights from Goethe, posits that another "layer" is added when the work is perceived because the reader, viewer, or listener adds her own layer. See *id.* at 42–43. A communication theorist might add that the work is therefore only "complete," once perceived, because that is when the form of the work actually communicates its content, but then each perception is different so that there would be as many works as there are readers, viewers, and listeners. See Cheryl Boudreau et al., *What Statutes Mean: Interpretive Lessons from Positive Theories of Communication and Legislation*, 44 SAN DIEGO L. REV. 957, 959 (2007) (applying this reasoning in the field of statutory interpretation). The perception of the form and content of the work reflects the hermeneutic approach of the reader, listener, or viewer to the "information" and in determining the semantic content of the work and its relevance. To appropriate beyond superficial or pure form copying, surely one must "understand" the work being appropriated on some level, but which work is it? See also Tyler T. Ochoa, *Dr. Seuss, the Juice and Fair Use: How the Grinch Silenced a Parody*, 45 J. COPYRIGHT SOC'Y U.S.A. 546, 557 n.54 (1998).

237. Computer Assoc. Int'l Inc. v. Altai Inc., 982 F.2d 693 (2d Cir. 1992). As the court explained:

At the lowest level of abstraction, a computer program may be thought of in its entirety as a set of individual instructions organized into a hierarchy of modules. At a higher level of abstraction, the instructions in the lowest-level modules may be replaced conceptually by the functions of those modules. At progressively higher levels of abstraction, the functions of higher level modules conceptually replace the implantation of those modules . . . until finally one is left with nothing but the ultimate function of the program.

Id. at 707 (quoting Steven R. Englund, Note, *Idea, Progress, or Protected Expression?: Determining the Scope of Copyright Protection of the Structure of Computer Programs*, 88 MICH. L. REV. 866, 897–98 (1990)).

238. See CHERPILLOD, *supra* note 233, at 35–41. Italian doctrine, and in particular the work of Mario Are, suggests a distinction not between idea and protected expression, but between the form and content of a work. See *id.* at 46–49. The form is protected. *Id.* But so are some parts of the content (not ideas, theories, or knowledge, but any content produced by the author's "imaginary"). See *id.* The Author points out that a difficulty, at least of an evidentiary nature, may be posed by the fact that fixation is not required under German law for copyright to subsist.

239. See Adolf Dietz, *Germany*, in 2 INTERNATIONAL COPYRIGHT LAW & PRACTICE, at GER-33 (Paul E. Geller ed., 2011).

240. See *id.*

"significant dependence."²⁴¹ German law distinguishes adaptations or "reworking" (*Bearbeitungen*) from transformations that modify the inner structure of a work (*Umgestaltungen*).²⁴² This is key to establishing the proper scope of the derivative right because changes to the form or structure (*Gestalt*) of the primary work is perhaps the key distinction between reproduction and derivation.²⁴³ A derivation changes the form or structure but not the fundamental character of the primary work. Like in France, German law draws a doctrinal difference between copying expression and derivation, the latter of which the law sees as taking "something else" that cannot be appropriated without infringing.²⁴⁴ This avoids the overreach of the reproduction right and is more likely to allow reuses that truly transform the primary work as beyond the reach of the derivative right. Put differently, German courts use the "free utilization" doctrine essentially to limit copyright infringement.²⁴⁵

This analysis can be taken to a granular level, one that goes beyond the de minimis limit applied to (mere) reproductions.²⁴⁶ It considers what and how much was taken, how much was added, and the level of transformation. Professor Ivan Cherpillod, who is well acquainted with both French and German doctrine, explained that when the originality of what was taken from the primary work is dubious (*discutable*), infringement is less likely.²⁴⁷ When the primary work's message is fundamentally altered and much is added, a similar argument can be made because in both cases the proximity between the two works is less apparent. Cherpillod cites an opinion from the Court of Appeal of Paris to explain this view.²⁴⁸ The court noted that the elements common to the plaintiff's and the defendant's works, two well-known novelists, were "purely superficial and without originality."²⁴⁹ The appropriation was lawful because the elements taken from the plaintiff's work were of "uncertain originality" and used mostly as background for the new work.²⁵⁰ The approach is complex because it is infused with normative considerations, such as

241. See *id.*

242. See *id.* at GER-108.

243. See CHERPILLOD, *supra* note 233, at 145-46. The free-utilization doctrine also applies under Swiss law. See *id.*

244. See *id.*

245. See Geller, *supra* note 30, at 45.

246. See *supra* note 50 and accompanying text.

247. See Geller, *supra* note 30, at 46.

248. See CHERPILLOD, *supra* note 233, at 146-47.

249. See *id.* The case, opposing Jean Hougron and Françoise Sagan, may be found at 111 REV. INT. DROIT D'AUTEUR 188 (1982).

250. See CHERPILLOD, *supra* note 233, at 147.

the need to allow certain transformations (e.g., parody) not as a fair use (defense) but as outside the scope of the derivative right.²⁵¹ He also suggests that the impact of the derivative work on the market for the original work is only an indicium and not the definition of the proper scope of the derivative right; it applies only to certain types of derivative works such as parody but not, for example, two scientific articles on the same subject.²⁵²

C. United Kingdom

Under UK law, it is an infringement of copyright to reproduce any substantial part of a literary work.²⁵³ As explained in the well-known treatise by Copinger and Skone James, however, the inquiry focuses on whether the originality was appropriated by the derivative user:

As already stated, the overriding question is whether, in creating the defendant's work, substantial use has been made of *the skill and labour which went into the creation of the claimant's work and thus those features which made it an original work* The issue thus depends therefore not just on the physical amount taken but on its substantial significance or importance to the copyright work.²⁵⁴

Copinger and Skone James explain that the question may depend on whether what has been taken is novel or striking, or is merely a commonplace arrangement of words or well-known material, an application of a limiting doctrine not unlike *scènes à faire*.²⁵⁵ They also note that,

As a corollary of the last point, the more simple or lacking in substantial originality the copyright work, the greater the degree of taking will be needed before the substantial part test is satisfied. In the case of works of little originality, almost exact copying will normally be required to amount to infringement.²⁵⁶

They note in the same breath that “the more abstract and simple a copied idea, the less likely it is to constitute a substantial part. Originality, in the sense of the contribution of the authors’ skill and labour, tends to lie in the detail with which the basic idea is presented.”²⁵⁷

251. See *id.* at 147–49 (“[A court] may authorize the appropriation of protected elements if the reproduction is justified by a particular interest.”) (Author’s translation). German courts also limit the derivative right “when constitutional considerations come into play.” See Dietz, *supra* note 239, at GER-103.

252. See CHERPILLOD, *supra* note 233, at 151.

253. See Copyright, Designs and Patents Act, 1988, c. 48, §§ 16(3), 17(2) (U.K.).

254. COPINGER & SKONE JAMES, ON COPYRIGHT § 7-27 (15th ed. 2005) (emphasis added).

255. See *supra* note 96.

256. COPINGER & SKONE JAMES, *supra* note 254, § 7-27.

257. *Id.*

In light of two recent UK cases,²⁵⁸ to target the normative distinction that delineates the domain of the derivative right, a taking of the originality of the primary work is what generates an infringement. A line is drawn, however, at a level of abstraction where the idea-expression line is crossed. Explaining the applicable distinction, Lord Hoffman, in *Designers Guild Ltd.*,²⁵⁹ noted the following:

[C]opyright subsists not in ideas but in the form in which the ideas are expressed. The distinction between expression and ideas finds a place in the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) . . . to which the United Kingdom is a party. . . . What does it mean? . . . It represents [the author's] *choice* to paint stripes rather than polka dots, flowers rather than tadpoles, use one colour and brush technique rather than another, and so on.²⁶⁰

The Court then turned to the notion of “substantial part,” the minimum part of a protected work that must be copied to trigger the application of the reproduction right:

The expression of these ideas is protected, both as a cumulative whole and also to the extent to which they form a “substantial part” of the work. Although the term “substantial part” might suggest a quantitative test, or at least the ability to identify some discrete part which, on quantitative or qualitative grounds, can be regarded as substantial, it is clear upon the authorities that neither is the correct test. . . . [T]here are numerous authorities which show that the “part” which is regarded as substantial can be a feature or combination of features of the work, abstracted from it rather than forming a discrete part. . . . Or to take another example, the original elements in the plot of a play or novel may be a substantial part, so that copyright may be infringed by a work which does not reproduce a single sentence of the original. If one asks what is being protected in such a case, it is difficult to give any answer except that it is an idea expressed in the copyright work.²⁶¹

Providing the subtitle for this Article, Lord Hoffman quipped in the same opinion that “Copyright law protects foxes better than hedgehogs.”²⁶² Arden LJ explained this rather cryptic formulation of the derivative right in *L. Woolley Jewellers Ltd v. A & A Jewellery Ltd.*,²⁶³ as follows:

Lord Hoffmann did not elaborate on his reference to hedgehogs and foxes. However, it appears that it is a reference to a fragment of Greek poetry of the seventh century BC, with which the late Sir Isaiah Berlin begins his famous essay on Tolstoy:

“There is a line among the fragments of a Greek poet Archilochus which says “The fox knows many things, but the hedgehog knows one big thing.” (*The Hedgehog and*

258. *Designers Guild Ltd. v. Russell Williams (Textiles) Ltd.*, [2000] UKHL 58, [2001] 1 W.L.R. 2416 (appeal taken from Eng.); *Ladbroke (Football) Ltd. v. William Hill (Football) Ltd.*, [1964] 1 W.L.R. 273 (H.L.) (appeal taken from Eng.).

259. *Designers Guild Ltd.*, [2000] UKHL 58, [2001] 1 W.L.R. 2416.

260. *Id.* at [24].

261. *Id.* at [24]–[25].

262. *Id.* at [26].

263. [2002] EWCA Civ 1119, [9], [2003] F.S.R. 15 (Eng. & Wales).

the Fox: An Essay on Tolstoy's View of History by Isaiah Berlin. (1953, as revised in 1978) (Phoenix) (1999) p.3).

Sir Isaiah points out that scholars have differed about the correct interpretation of these "dark" words. They may, on the one hand, mean no more than that the fox, for all his cunning, is defeated by the hedgehog's one defence. But the fragment may also be taken figuratively as contrasting those with a single central vision and organising principle as against those who pursue many ends, often unrelated or contradictory. It was, the Author thinks, in the figurative sense that Lord Hoffmann was using his metaphor.²⁶⁴

The exposition of UK law presented in the previous paragraphs is consonant with the more recent case *Baigent v. Random House Group*,²⁶⁵ in which Mummery LJ said:

[I]t is not necessary for the actual language of the copyright work to be copied or even for similar words to be used tracking, like a translation, the language of the copyright work. It is sufficient to establish that there has *been substantial copying of the original collection, selection, arrangement, and structure of literary material*, even of material that is not in itself the subject of copyright.²⁶⁶

The line of cases was also cited with approval recently in *SAS Institute Inc. v. World Programming Ltd.*²⁶⁷ The case also opens a broader window on European law on the matter because, in that opinion, Judge Arnold referred a number of questions to the European Court of Justice to see how European directives might impact the analysis.²⁶⁸ That court, in an opinion released on May 2, 2012, reiterated the view that *creative choices* are what give a work originality.²⁶⁹ Those are choices made by an author that are not primarily dictated by the function of the work, the method or tools used, or applicable standards.²⁷⁰ As a rule of thumb, creative choices are those that one can isolate by asking whether two authors in similar situations (tools, direction, budget, etc.) would likely have produced essentially the same thing.²⁷¹ In doing so, the Court of Justice's opinion explicitly follows in the wake of previous opinions,²⁷² namely *Infopaq*,²⁷³

264. *Id.*

265. [2007] EWCA Civ 247, [145], [2007] F.S.R. 24 (Eng. & Wales).

266. *Id.* (emphasis added).

267. [2010] EWHC 1829 (Ch.) (Eng. & Wales).

268. Council Directive 1991/250, 1991 O.J. (L 122) 42 (EC), *codified at* Directive 2009/24/EC, of the European Parliament and of the Council of 23 April 2009 on the Legal Protection of Computer Programs.

269. Case C-406/10, *SAS Inst. Inc. v. World Programming Ltd.*, May 2, 2012, *available at* http://curia.europa.eu/jcms/jcms/_6 (search case no "406/10"); Daniel Gervais & Estelle Derclaye, *The Scope of Computer Program Protection after SAS: Are We Closer to Answers?*, 34 EUR. INTELL. PROP. REV. 565, 567-68 (2012).

270. See Gervais, *supra* note 81, at 965.

271. See *supra* note 87.

272. For a full comment, see Gervais & Derclaye, *supra* note 269.

273. Case C-5/08, *Infopaq Int'l A/S v. Danske Dagblades Forening*, [2009] ECR I-6569 (Den.).

Murphy, *FAPL*,²⁷⁴ *Painer*,²⁷⁵ and *Football Dataco*.²⁷⁶ UK law thus points to a distinct role for the derivative right, even though it is not named or identified under that rubric in the statute. Its target is the appropriation of originality embodied in the author's expression.

D. European Lessons

As shown in this Part, European jurisprudence can be used to illuminate the distinction between reproduction and derivation. The two key suggestions are that (a) the difference lies in the transfer of *elements of original expression from the primary work to the derivative one for the purpose of adding or transforming it, but not to the point of a fundamental transformation of the primary work*;²⁷⁷ and (b) market impacts of the derivative are indicia used in appropriate cases to determine whether the derivative right is infringed; they do not delineate the right.²⁷⁸

Whether one considers derivation as a subset of a broader right of reproduction, the analysis of European jurisdictions suggests that, teleologically, normatively, and doctrinally, real distinctions exist between the two rights. A reproduction *copies the expression* of the primary work, while a derivation *transfers what makes the primary work original* with the purpose of adding to, or transforming, those elements.²⁷⁹ The two inquiries are thus distinct because the reproduction inquiry focuses primarily on the form of what was taken, while the derivation inquiry looks at a deeper level at what was taken, in the creative choices that made the primary work worthy of copyright protection and the nature of what was added or transformed.²⁸⁰ Additionally, *it is in the nature of derivation that something is added or transformed*.²⁸¹

274. Joined Cases Case C-403/08, *Football Ass'n Premier League v. QC Leisure and Case C-429/08, Murphy v. Media Protection Servs. Ltd.*, [2012] F.S.R. 1 (appeal taken from U.K.).

275. Case C-145/10, *Painer v. Standard VerlagsGmbH*, Dec. 1, 2011, available at http://curia.europa.eu/jcms/jcms/j_6 (search case no "145/10").

276. Case C-604/10, *Football Dataco v Yahoo! UK Ltd.*, Dec. 15, 2011, available at http://curia.europa.eu/jcms/jcms/j_6 (search case no "604/10").

277. *Designers Guild Ltd. v. Russell Williams (Textiles) Ltd.*, [2000] UKHL 58, [2001] 1 W.L.R. 2416 (appeal taken from Eng.).

278. See cases cited *supra* note 274 and accompanying text.

279. As the US statute makes clear, a derivative need not add to the primary work. "Abridgement" and "condensation" are examples that show that an infringing derivative work may take the form of deletion and abbreviation. See 17 U.S.C. § 101 (2006).

280. See *supra* note 86 and accompanying text.

281. The limit of the right may be reached when the message of the primary work is fundamentally transformed. See *infra* Part V. Indeed, Professor Cherpillod uses the verb "to fade" when describing this situation in which "the individuality of the copied features (*traits*)

V. PULLING IT ALL TOGETHER

While forms of human creation have changed greatly from the Lascaux caves to Aqua's "I'm a Barbie Girl," the way that authors create (from a copyright viewpoint) is *by exercising choices not wholly dictated by the tools used nor by the possible functionality of their work or standards*. They create by something else, a *je ne sais quoi* that makes it almost a certainty that two authors in an identical situation with similar tools would produce substantially different results.²⁸² That is the essence of what copyright aims to incentivize (ex ante) and protect (ex post); it is the taking and transformation of those same elements that triggers the application of the derivative right.

Foundational to our understanding of copyright is: (a) that an author "generates discourse," (b) our societal relationship with this discourse, (c) the recognition of an individual (as opposed to, e.g., a community) as the discourse's unique source, and (d) the "legal and institutional systems that circumscribe, determine and articulate the realm of discourses."²⁸³ The protection of authors' rights may have changed dramatically over time, but the discourse-generating function itself has not.²⁸⁴ We want and need authors to perform this function. It is similarly true that, while the function of the author as discourse generator may have been stable, the corresponding notion of authorship is anything but, having strong spatio-temporal ties to its

fades before the originality of the second work." See CHERPILLOD, *supra* note 233, at 147. As a matter of US law, the Author suggests that, in harder cases that fit within the latter situation, the limit of the derivative right is likely to meet its fair use limits. That does not mean that the doctrinal work on the nature and scope of the derivative right can simply be ignored.

282. This may relate to what Michel Foucault termed a "transhistorical constant" in the status of authorship. See MICHEL FOUCAULT, WHAT IS AN AUTHOR 237 (1995). However, this notion of authorship linked to the "individuality" of each author is solidly anchored in post-Renaissance notions. See *id.* Foucault adds: "The author is thus a definite historical figure in which a series of events converge." *Id.* at 238. The author is seen here as a source of coherent and "finished" expression. See *id.*

283. See *id.* at 235–36.

284. See *id.* at 239. In discussing the nature of copyright over time, Pierre Recht noted that "literary property existed in Rome, but it was 'unperceived and unguaranteed' because the need to protect authors had not yet been felt." Pierre Recht, *Copyright: A New Form of Property*, 5 COPYRIGHT 94, 97 (1969). Recht sees the property-creation function of copyright as grounded in the function of the author as expressing (or objectifying) a fundamentally subjective creative process. He explained: "The subject of the legal status [of writers and artists] is thus a right which, before being recognized by law, was a subjective right in the limited field of freedom, the inexpugnable stronghold of individualism." *Id.* at 95. Recht suggested that copyright be split between an eminent domain of authors (basically the right to transfer the copyright itself and a rough equivalent of the Roman *abusus*) and a right in respect of use and enjoyment (getting paid for some uses), an equivalent of the *usus* and *fructus* elements of property under Roman law. See *id.* at 96–98. This might be useful *inter alia* in designing exceptions and limitations, but the Author shall leave that for a future article.

Romantic origins.²⁸⁵ Again, one must bear this in mind along with the objectives of copyright when trying to define the derivative right. This Article will now try to pull the threads of the analysis in the previous Parts together. Given the link between authors and discourse, this Article first considers the way its conclusions may impact speech.

A. Speech Considerations

In the principles this Article suggests, a reuse that *improves but does not fundamentally alter* the message (this might include a sequel) infringes the derivative right. Fair use may well save the reuse, but this is a separate inquiry. Is this speech restrictive? This Article's analysis leads to the conclusion that having fewer restrictions fits the First Amendment maxim "that everything worth saying shall be said,"²⁸⁶ *but it does not define the right* per se. Let us probe a bit more.

Professor Netanel discusses the significant free-speech impacts of an overbroad derivative right as follows:

Today, copyright law's governing premise, far from being solicitous to secondary, transformative authorship, is that "no plagiarist can excuse the wrong by showing how much of his work he did not pirate" [citing *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 56 (2d Cir.), *cert. denied*, 298 U.S. 669 (1936).] That unitary focus on what the defendant appropriated is broadly applied even to highly creative secondary authors who engage in little or no verbatim copying of the copyrighted work. . . . Because of these developments, speech that copies from an existing work at a high level of abstraction, containing no identity or even close similarity or words or specific elements of design, but only a resemblance of style, mood, and overall aesthetic appeal, may well run afoul of the copyright holder's rights.²⁸⁷

It is important to bear in mind, however, that in *Sheldon v. Metro-Goldwyn Pictures Corp.*, Learned Hand made a determination that Metro-Goldwyn was in fact a plagiarist.²⁸⁸ There is a sense that

285. See Jaszi, *supra* note 227, at 456 ("'Authorship,' as deployed in texts and in cultural understandings, has been anything but a stable, inert foundation for the structure of copyright doctrine. Rather, the ideologically charged concept has been an active shaping and destabilizing force in the erection of that structure.").

286. ALEXANDER MEIKLEJOHN, *POLITICAL FREEDOM: THE CONSTITUTIONAL POWERS OF THE PEOPLE* 26 (2d ed. 1960). A broader debate about alienation is explicated in WILLIAM W. FISHER III, *PROMISES TO KEEP: TECHNOLOGY, LAW, AND THE FUTURE OF ENTERTAINMENT* 30–37 (2004). Although no short summary can be fair, the Author suggests a freer derivative right would allow individuals to be more engaged in (and less alienated by) dominant expression, allowing them to shape or subvert it.

287. NETANEL, *supra* note 162, at 59–60.

288. Learned Hand stated:

The play is the sequence of the confluent of all these means, bound together in an inseparable unity; it may often be most effectively pirated by leaving out the speech, for which a substitute can be found, which keeps the whole dramatic meaning. That as it appears to us is exactly what the defendants have done here; the dramatic significance of the scenes we have recited is the same, almost to the letter. True, much

the plagiarism instinct is triggered when much is taken, with little original transformation. That is a use that the derivative right would cover or, if indeed very little is transformed or added, is best seen as a mere reproduction. To create his work *Letty Lynton*, the defendant had copied much, both from a play (*Dishonored Lady*) and from the eponymous novel on which it was based.²⁸⁹ Moreover, the court seemed to believe that *not much originality had been added*.²⁹⁰ The case does *not* stand for the proposition that the differences between plaintiff's and defendant's works are irrelevant to establishing infringement *ab initio*, quite the opposite in fact.²⁹¹ It shows that we should consider *both the creative choices that made the primary work original and were appropriated and those made by the derivative user* (and possibly author of a derivative work in his own right).²⁹²

While the case might be used to demonstrate the risk of an overboard right, it also suggests a test that comports with the principles enunciated in Part II: the application of the derivative right *is an equation that reflects the amount of originality of the primary work, the quality and quantity of the originality transferred from the primary work to the derivative work, and the amount of originality added by the author of the derivative work*.²⁹³ This Article will return to this test several times in the following pages to explicate its role and limits.

The question of the *level of abstraction* of the taking from a primary work is particularly germane to this analysis because setting the bar *at how high the abstraction must be* not to infringe (and beyond which one takes only unprotected ideas) is the hard balancing act of scoping the derivative right.²⁹⁴ However, the idea that copyright

of the picture owes nothing to the play; some of it is plainly drawn from the novel; but that is entirely immaterial; it is enough that substantial parts were lifted; *no plagiarist can excuse the wrong by showing how much of his work he did not pirate*. We cannot avoid the conviction that, if the picture was not an infringement of the play, there can be none short of taking the dialogue.

Sheldon v. Metro-Goldwyn Pictures Corp., 81 F.2d 49, 55 (2d Cir. 1936) (emphasis added).

289. *Id.* at 49–53.

290. Certainly enough originality to make it a derivative work, if done lawfully. *See supra* note 81 and accompanying text.

291. *Sheldon*, 81 F.2d at 53–56.

292. *Id.* at 49–53.

293. If the first two are satisfied, that is a *prima facie* case of infringement; the third is relevant to fair use. *See supra* note 277 and accompanying text.

294. In *Nichols v. Universal Pictures*, Learned Hand noted:

[W]hen the plagiarist does not take out a block in suit, but an abstract of the whole, decision is more troublesome. Upon any work, and especially upon a play, a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the play is about, and at times might consist only of its title; but there is a point in this series of abstractions where they are no longer protected, since

must navigate up and down a vertical axis going from the exact expression at the bottom to the “pure idea” at the top is not new. It emerged *inter alia* in a number of computer program related cases where something other than the exact code was copied.²⁹⁵

In isolation this analysis is particularly difficult. In context, however, one can get there by focusing as much on the nature of the *transformation* of the message embedded in the primary work as on what is appropriated—hence the above equation. The difficulty in reaching equilibrium lies in reconciling the two underlying policy objectives (generating a sufficient incentive for creation under copyright law and protecting free expression).

Perhaps not surprisingly since this Article’s analysis reflects a number of European doctrinal lessons, the Commission of the European Communities (now European Union) used an approach compatible with the above equation in its policy analysis:

The obligation to clear rights before any transformative content can be made available can be perceived as a barrier to innovation in that it blocks new, potentially valuable works from being disseminated. However, before any exception for transformative works can be introduced, one would need to carefully determine the conditions under which a transformative use would be allowed, so as not to conflict with the economic interests of the rightsholders of the original work.²⁹⁶

And this is the case not just in Europe. In Canada, based on similar normative foundations, certain forms of UGC are now allowed under a recent amendment to the Copyright Act.²⁹⁷ The amended legislation was said to remove an “irritant” for millions of Canadians who neither understood nor accepted restrictions that they considered obsolete, unjustified, or both.²⁹⁸

Clearly, the shift from a one-to-many entertainment infrastructure to a many-to-many information infrastructure has deep consequences on several levels, and one of them relates to the scope of

otherwise the playwright could prevent the use of his “ideas,” to which, apart from their expression, his property is never extended. Nobody has ever been able to fix that boundary, and nobody ever can.

Nichols v. Universal Pictures Corp., 45 F.2d 119, 121 (2d Cir. 1930) (citation omitted). A similar point was made in recent British cases. See *supra* note 258 and accompanying text.

295. See *supra* note 237.

296. Commission Green Paper on Copyright in the Knowledge Economy, at 19, COM (2008) 466 final (July 16, 2008).

297. See Gervais, *supra* note 9, at 465–66. The Act was amended by the Copyright Modernization Act, S.C. 2012, c. 20 (Can.), which received Royal Assent on June 29, 2012. The exception is not a license to freely copy anything or to upload it to any social website. It is best seen as a limited right to reuse existing works in a noncommercial context to create new works in cases where there is no demonstrable impact on the market for such existing works. See *id.*

298. See Archon Fung, *Democratizing the Policy Process*, in THE OXFORD HANDBOOK OF PUBLIC POLICY 669, 676–78 (Michael Moran, Martin Rein & Robert E. Goodin eds., 2006).

reuses requiring an authorization (license).²⁹⁹ Digital technology has made possible mass fan fiction, mash-ups, music remixes, cloud computing, collages, and so forth, and blogs have transformed access to, and arguably the nature of, information.³⁰⁰ Reusing existing works without fundamentally transforming the message (which a recontextualization might do) *prima facie* infringes the derivative right (and possibly the reproduction right). Courts examine market impacts (including established licensing practices) and the need to maintain an incentive to create certain derivatives as a test to determine whether the transformation might be beyond the scope of the derivative right.³⁰¹ In hard cases, a US court might understandably find fair use, a matter to which this Article returns below.³⁰²

B. Reproduction versus Derivation

A pillar of the analysis in this Article is that, while the rights of reproduction and derivation are joined at the hip, they differ normatively. In many cases, this is true operationally as well because some cases of derivation also amount to copying, but others do not. Conversely, most cases of reproduction do not trigger the derivative right. For example, a quotation (that goes beyond fair use) infringes reproduction but not derivation. A work that quotes generates a message that does not transform the primary work. Instead, it uses the primary work as support or illustration. By contrast, mounting or gluing a picture on a wall tile may infringe the derivative right (the hard question here is whether the recontextualization is still proximate enough to constitute derivation) but not the reproduction right if no copy is made (that is, if the original image is used). Unfixed performances, as already noted, can infringe the derivative right but

299. See Daniel J. Gervais & Daniel J. Hyndman, *Cloud Control: Copyright, Global Memes and Privacy*, 10 J. TELECOMM. & HIGH TECH. L. 53, 63–64 (2011).

300. See Andrea Slane, *Democracy, Social Space, and the Internet*, 57 U. TORONTO L.J. 81, 99–100 (2007).

301. See Brett M. Frischmann & Mark A. Lemley, *Spillovers*, 107 COLUM. L. REV. 257, 290 (2007) (“To the extent that substitution is likely, there is likely a greater impact on incentives, and this is a social cost to deeming the use fair. If market substitution is unlikely, however, the risk to incentives is smaller.”). The Author will leave aside for those purposes the *ex ante* versus *ex post* debate. For a discussion, see Mark A. Lemley, *Ex Ante Versus Ex Post Justifications for Intellectual Property*, 71 U. CHI. L. REV. 129 (2004).

302. In other jurisdictions where fair use is unavailable as a defense, however, the analysis of the scope of the derivative right must be fully developed. Very few countries have fair use in their copyright legislation. See, e.g., Copyright Act, 5768–2007, 2199 LSI 34, ¶19 (2007) (Isr.).

not generate a protectable work in its own right, precisely because they are unfixed.³⁰³

Congress saw the derivative right as an almost complete overlap with the notion of reproduction when it adopted the 1976 Act, but it is high time to revisit the nature and scope of the overlap. Normatively, this seems essential as the derivative right is called upon to draw acceptable lines for mass reuse of online content.³⁰⁴ Operationally, it is much easier to draw those boundaries if the purpose of the right is better understood.

The notion of derivative work was described as targeting not types of uses as much as types of *markets* and a related desire by Congress to reserve derivative or peripheral markets to copyright

303. See H.R. REP. NO. 94-1476, at 62 (1976) (Conf. Rep.), *reprinted in* 1976 U.S.C.A.N. 5675. The Conference Report states:

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

Id. A typical unfixed use would then be by way of public performance. See Ochoa, *supra* note 76, at 999. This opens up a fascinating possibility, namely that a performer's performance is a separate work. Internationally, the matter was resolved by granting performers a "neighboring right" which does not recognize them as authors. At the Rome revision Conference of the Berne Convention in 1928, a proposal was made to include performers in the realm of authors. See INTERNATIONAL LABOUR OFFICE, RIGHTS OF PERFORMERS IN BROADCASTING TELEVISION AND MECHANICAL REPRODUCTION OF SOUNDS 122 (1939) ("[The Austrian delegation], however, expressed the view that performers' rights should be protected on the same basis as had been adopted in the case of derivative works (translations, adaptations, etc.)."). Whether Yehudi Menuhin was creating a work when performing Bach's *Suites* is an open question in the Author's mind. The Author believes that some performances are "worthy" of being considered copyrighted works. This is beyond the scope of this Article, however. The Author realizes that merely acknowledging the possibility would create significant practical difficulties. Moreover, US law was modified to protect performers against bootlegging, which would suggest they do not have a right under copyright proper. This in turn raised a constitutional issue, namely whether Congress could adopt noncopyright protection of performers. See Dotan Oliar, *Resolving Conflicts Among Congress's Powers Regarding Statutes' Constitutionality: The Case of Anti-Bootlegging Statutes*, 30 COLUM. J.L. & ARTS 467 (2007). A separate inquiry is what gives sound recordings, which are considered "works" under US copyright law, their originality, if not the performer's contribution. The US Copyright Act defines a sound recording as the fixation of the sounds, that is, the performers' contribution; and the 1976 Act House Report recognizes that the performance can be original. This intellectual mess deserves further work though it has been the subject of good commentary already. See, e.g., CRAIG JOYCE, COPYRIGHT LAW 203 (8th ed. 2010); 1 NIMMER & NIMMER, *supra* note 60, § 2.10[A][2][b] (discussing record producers' originality requirement for copyright in the sound recording); 1 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 3:161 (2007); Jon M. Garon, *Entertainment Law*, 76 TUL. L. REV. 559, 619 (2002) ("The interests in protecting against record piracy far outweighed the niceties of minimal creative necessity. Like photography, the choices made (or overlooked) in fixing the sound recording is [sic] sufficiently creative to meet the originality requirement under Feist.").

304. See *supra* notes 4–8 and accompanying text.

holders.³⁰⁵ Indeed, as Professor Goldstein noted, the direction of investment in copyrighted works can often be used as indicia to determine (in part) the scope of the right.³⁰⁶ This concern is valid when considering copyright as an incentive and support for markets. While market impacts *do not define the right itself*, they can be a useful guide.³⁰⁷ There are many cases (such as Internet-based uses), however, in which the “market” is highly dynamic. Trying to define potential impacts is an unstable target.³⁰⁸

Other examples might help illuminate the distinction between reproduction and derivation according to the approach suggested in this Article. A prequel or sequel or an encyclopedia based on an existing book, film, or series (such as the *Harry Potter* lexicon) infringes the derivative right, but in many cases not a properly construed reproduction right.³⁰⁹ Again, whether it is defensible as fair use is a different inquiry.³¹⁰

US courts have not done well when trying to apply derivation as a distinct right, but there is room for that distinction to do much more work as new cases emerge. One could start with *Arnstein v. Porter*, in which the court identified two separate elements essential to a plaintiff's suit for infringement: copying and unlawful

305. See Robert J. Morrison, *Deriver's Licenses: An Argument for Establishing a Statutory License for Derivative Works*, 6 CHI.-KENT J. INTELL. PROP. 87, 88 (2006) (“The right to prepare derivative works is a clear statement that Congress wants to provide copyright holders the sole right to exploit the peripheral markets for a work. The clearest value of a derivative work to the copyright holder is the ability to reach new markets.”).

306. See Goldstein, *supra* note 26, at 227.

307. To quote Learned Hand:

If the defendant took so much from the plaintiff, it may well have been because her amazing success seemed to prove that this was a subject of enduring popularity. Even so, granting that the plaintiff's play was wholly original, and assuming that novelty is not essential to a copyright, there is no monopoly in such a background.

Nichols v. Universal Pictures Corp., 45 F.2d 119, 122 (2d Cir. 1930).

308. Additionally, a definitional effort grounded on expected online markets presents a risk of circularity. See R. Anthony Reese, *Transformativeness and the Derivative Work Right*, 31 COLUM. J.L. & ARTS 467, 495 (2008). Reese observed:

And just as courts have recognized in the fourth factor that it would be circular to identify market harm merely from the fact that the particular defendant being sued did not pay the copyright owner for the particular use she made, courts may need to find ways to avoid a similar circularity in judging transformativeness. Courts should probably not conclude that a defendant's use is not transformative simply because the copyright owner herself might at some point use (or intend to use) the work for the same purpose, but should probably also not conclude that a defendant's use must be transformative if the copyright owner has not yet exploited her work for the same purpose.

Id.

309. See Dennis S. Karjala, *Harry Potter, Tanya Grotter, and the Copyright Derivative Work*, 38 ARIZ. ST. L.J. 17, 32–34 (2006).

310. See *id.* at 34–36.

appropriation.³¹¹ Then one might consider *Sid & Marty Krofft Television Products, Inc. v. McDonald's Corp.* and its intrinsic-extrinsic test, which separates substantial similarity in ideas (extrinsic) and substantial similarity in expressions (intrinsic).³¹² From *Krofft*, one might then move to *Cavalier v. Random House, Inc.*, which proposes a different two-part analysis, namely an extrinsic test (objective comparison of specific expressive elements) and an intrinsic test (subjective comparison that focuses on "whether the ordinary, reasonable audience" would find the works substantially similar in the "total concept and feel of the works").³¹³ Finally, one might go back to the Second Circuit in *Boisson v. Banian, Ltd.*, which employed an ordinary-observer test to determine copying but a "more refined" version of the test when the work alleged to have been infringed incorporates public domain elements.³¹⁴ Courts often used the tests to decide whether expert testimony was admissible or probative in deciding infringement.³¹⁵ It seems fair to conclude that a number of courts have increasingly tried to separate reproduction from derivation qua derivation (that is, whether or not a reproduction may also be occurring) but without fully getting there.

It is time to consider a more nuanced and transparent approach. Even a quick *tour d'horizon* suffices to illustrate the role that drawing proper distinction between the reproduction right and the derivative right might play. This Article's proposed equation above is comparable to *Krofft* and *Boisson*, that is, considering *intrinsic similarity* and asking whether what "intrinsically" makes the primary work original was taken, and then whether those elements were transformed.³¹⁶

Conversely, the perils of a misunderstood distinction between the two rights are visible in the opinions that have avoided trying to make the distinction altogether, preferring instead to limit themselves to a "market impact" analysis.³¹⁷ That approach tends to conflate

311. 154 F.2d 464, 468–69 (2d Cir. 1946).

312. 562 F.2d 1157, 1163–64 (9th Cir. 1977).

313. 297 F.3d 815, 822 (9th Cir. 2002).

314. 273 F.3d 262, 272–73 (2d Cir. 2001).

315. For a discussion of the slightly different tests (or versions) applied by the various circuits and the role of expert testimony, see Michael D. Murray, *Copyright, Originality, and the End of the Scènes À Faire and Merger Doctrines for Visual Works*, 58 BAYLOR L. REV. 779 (2006).

316. A court might also ask an expert to demonstrate the creative process pertinent to the type of creation at play in a given case in determining infringement. See Nielander, *supra* note 65, at 17 ("The focus in this context would be on the qualitative aspects of a work rather than the quantitative tally of expressive elements in search of substantial similarity.").

317. See *infra* note 326 and accompanying text.

derivation and fair use.³¹⁸ This is because while market impact is used to define the right in those cases, it is also the fourth fair use criterion (market impact) that has been the heart of the fair use doctrine since the supersession test developed in *Folsom v. Marsh*.³¹⁹ It is indeed a paradox of contemporary US copyright jurisprudence that fair use, which affects all of the exclusive rights, including the derivative right, should be formulated in terms that virtually read on the accepted definition of one of those exclusive rights (namely the derivative right).³²⁰ This is not exactly surprising in light of the Supreme Court's direction:

Although such transformative use is not absolutely necessary for a finding of fair use, the goal of copyright, to promote science and the arts, is generally furthered by the creation of transformative works. Such works thus lie at the heart of the fair use doctrine's guarantee of breathing space within the confines of copyright.³²¹

But while this (rightly) pertains to fair use, it does not define the derivative right. Deciding *whether the derivative right applies* as a matter contingent on market impacts is both unstable and normatively undesirable for the same reason as using the market to define the right itself.³²²

The first step under the derivation inquiry boils down to asking *whether the creative choices that make the primary work original were taken without fundamental alteration*. Hence, market impact is a mere guide in appropriate cases, as, for example, market success is a guide that an invention is nonobvious for purposes of patent law.³²³ The second step is considering the nature of what was added or

318. The three A.R.T. cases were already mentioned in terms of market impact. See *infra* note 326 and accompanying text.

319. 9 F. Cas. 342, 348 (C.C.D. Mass. 1841) (No. 4,901). *Folsom* was not a fair use case of course, nor does it use that term. The supersession test was meant to ensure that copyright covered additional markets. That said, Barton Beebe's empirical analysis suggests that the fourth factor was the most important until at least 2005. See Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978–2005*, 156 U. PA. L. REV. 549, 616–17 (2008) (noting that in *Campbell* the Supreme Court attempted to change the dictum in *Harper & Row* that the fourth factor was the “most important” by stating that all of the factors are to be “weighed together”; still, 26.5 percent of lower courts post-*Campbell* have stated that the fourth factor is the most important). The Author suggests it may be changing as a result of *Campbell*.

320. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994); see Michael J. Madison, *A Pattern-Oriented Approach to Fair Use*, 45 WM. & MARY L. REV. 1525, 1670 (2004) (“As a beacon of fair use, the transformative use standard has become all things to all people.”); see also Pamela Samuelson, *Unbundling Fair Uses*, 77 FORDHAM L. REV. 2537, 2548–68 (2009) (discussing the numerous ways in which “transformative” is applied in a variety of cases).

321. *Campbell*, 510 U.S. at 579.

322. See *supra* note 308 and accompanying text.

323. Commercial success is one of the secondary considerations used to determine nonobviousness under *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). It is only that, however—not a hard test. See *Tokai Corp. v. Easton Enters., Inc.*, 632 F.3d 1358, 1369 (Fed. Cir. 2011).

transformed, including by recontextualization. Various limiting doctrines, in particular fair use and the idea-expression dichotomy, will then limit the reach of the right but as a separate inquiry.³²⁴

This approach is not only normatively preferable, it is also consistent with statutory and historical developments (in the United States, in France, in Germany, and elsewhere internationally) that have put the spotlight on the derivation *qua* derivation—in named forms or as penumbral right—instead of market impacts *per se*.³²⁵ The protection of markets allows a clearer separation of fair use and derivation in the analytical sequence.

In sum, there are two avenues by which to test for an infringement of the derivative right as distinct from copying. The first focuses on reuses that impact the market(s) for an existing work, in which case questions emerge as to which markets are reasonably expected to be developed for a given type of work, a central issue in the three *A.R.T.* cases.³²⁶ A second avenue is the equation suggested above, namely, considering the nature of what was taken (whether measured quantitatively, qualitatively, or both), and what transformation was done by the derivative user or author, in particular whether the message contained in those elements was fundamentally altered by recontextualization or otherwise. Either avenue will raise an interface issue with fair use because market impact and amount and substantiality of the use are, respectively, the third and fourth fair use criteria.³²⁷ The second avenue, which separates the two inquiries, seems closer to the history and purpose of the derivative right.

Visually, this could be shown as follows:

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

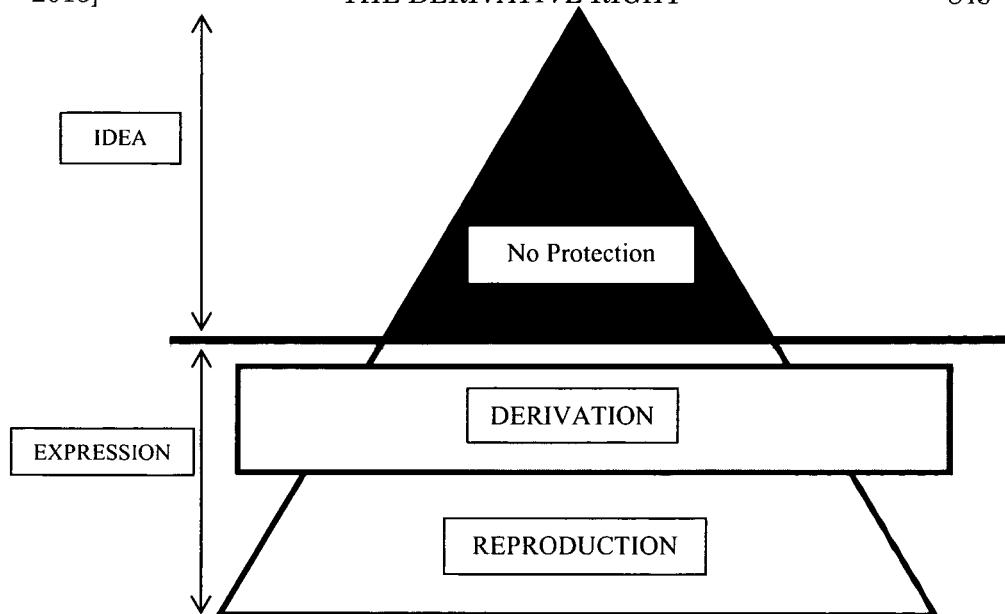
325. As Von Lewinski explained:

[A]ll such transformations are covered under the general term “alteration,” which includes any change of a work where the original work can still be recognized in the alteration but, at the same time, is not simply reproduced, be it in the same or different size or format. Accordingly, if the original work has only served as inspiration . . . then the second one is not an alteration.

VON LEWINSKI, *supra* note 171, at 143; see also RICKETSON & GINSBURG, *supra* note 185, at 479 (“Although little was said at the time of the Berlin Conference as to the precise scope of the term ‘adaptations,’ it seems clear from the later conference that a wide interpretation was intended.”).

326. Lee v. A.R.T. Co., 125 F.3d 580 (7th Cir. 1997); Mirage Editions, Inc. v. Albuquerque A.R.T. Co., 856 F.2d 1341 (9th Cir. 1988); Muñoz v. Albuquerque A.R.T. Co., 829 F. Supp. 309 (D. Ala. 1993), *aff’d* 38 F.3d 1218 (9th Cir. 1994).

327. See 17 U.S.C. § 107 (2006).



This diagram shows that some cases of derivation are also reproductions, but others are not. Additionally, derivations tend to appropriate elements higher in the abstraction continuum.³²⁸ Obviously, to be protected the appropriation must be below the level of unprotected ideas.³²⁹ As this Article has suggested throughout, even if one sees derivation as a form of reproduction in many cases, or as somehow subsumed under reproduction in a categorical taxonomy of copyright right, derivation stands on its own normative footing and must be considered (at least as a first step) as a fully distinct right to be understood. Then the derivation and reproduction analyses can be combined (in a specific case).

To determine whether a derivation *qua* derivation has taken place, it may be useful to recall that, according to the view that informs the principles enunciated in Part II and the international and comparative analyses above, it is the originality that is appropriated in a derivative work. Originality—rooted in *creative choices* made by the author of a primary work—is appropriated (and thus presumably worth taking) by a derivative user or author *for the purpose of reworking those creative choices* (often to create a new work). It is that originality (resulting from creative choices) that a court should aim to protect, absent an applicable defense or other exception.³³⁰ This

328. See *supra* note 292 and accompanying text.

329. The Author left a bit of space below the idea-expression line but above the derivation “box” for possible reproductions at a higher level of abstraction.

330. This occurs in a number of cases. See, e.g., *Tufenkian Import/Export Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 133 (2d Cir. 2003) (“Jurists have long been vexed by the

should not depend on a showing of the existence of a real or expected market nor on copying of the form of the expression, which is the proper realm of the reproduction right.³³¹ Derivation is best seen as *taking what makes a preexisting work (or more than one) original for the purpose of transforming it*, but not to the point of a *fundamental alteration* of the message. Market impact provides a useful clue, but it remains a secondary consideration. A translation or sequel in the same vein as the primary work is a good example of a derivative work, as would be a change in the genre or form. By contrast, a reuse that alters the fundamental message of the primary work typically does not appropriate the protected elements of that work.³³² It is important to recall that the derivative right is subject to a number of limiting doctrines, including fair use, which factor into market impact.³³³ Another limit on the right is the application of the *eBay-Salinger* test—if the public interest so dictates.³³⁴

Applying the test to the three-dimensional versions of objects, would a three-dimensional “copy” of, say, “Mattie the Clown,” be considered a reproduction for copyright purposes?³³⁵ It is clearly a case of taking the creative choices, but something is added. The question is, what? The added physical dimension (from two to three)

task of precisely identifying that which separates inexact copies that infringe from those that do not.”).

331. Other considerations, such as whether the author of the second work had sought a license (for the work at issue or previously) may also impact a finding of fair use:

Courts, unfortunately, have repeatedly made the mistake. It is no coincidence that the principal cases establishing broad rights against infringement by derivative works characteristically involve situations in which the alleged infringer had at some earlier point sought a license. The tendency in these cases, always unarticulated because legally irrelevant, is to take the earlier quest for a copyright license as evidence that one was needed, and to bar defendants from asserting that the rights they once tried to acquire do not now exist. For the reasons given, the emphasis is clearly misplaced.

Goldstein, *supra* note 38, at 221. However, trying to identify a lost licensing transaction may be inappropriate. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 592 (1994).

332. See 4 NIMMER & NIMMER, *supra* note 60, § 13.03 [A].

333. The Author is comforted in that regard by Professor Reese’s analysis of all published circuit court opinions dealing with the derivative right through 2007. See Reese, *supra* note 308, at 484–85. Professor Reese distinguishes derivation by transformation of purpose and transformation of content. See *id.*

334. In *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006), the US Supreme Court applied a four-factor test based on traditional equitable principles to the issuance of injunctions in patent cases. In *Salinger v. Colting*, 607 F.3d 68 (2d Cir. 2010), the Second Circuit applied the test to copyright, holding that “although the District Court applied our Circuit’s longstanding standard for preliminary injunctions in copyright cases, our Circuit’s standard is inconsistent with the ‘test historically employed by courts of equity’ and has, therefore, been abrogated by *eBay, Inc. v. MercExchange*.” *Id.* at 74–75.

335. “Mattie the Clown” is a painting by Mira Evans. See *Mattie the Clown*, FINE ART AMERICA fineartamerica.com/featured/mattie-the-clown-myra-evans.html (last visited Mar. 13, 2013).

might well be compared to a genre transition.³³⁶ Viewed as such, the application of the derivative right (for infringement purposes) to this type of transformation would seem to fit. A separate inquiry is whether a new derivative work is created. The simple answer is no if only trivial, mechanical, or “sweat of the brow” work is what modified the physical properties of the preexisting two-dimensional work to the three-dimensional realm.³³⁷ An emerging technology (as of this writing) of three-dimensional printers comes to mind. If that technology is used to produce a useful object from a set of instructions (blueprint), then the exclusion (in US law at least) of three-dimensional protection for useful articles would likely apply.³³⁸ However, I can easily see the day when such a printer will be able to produce a three-dimensional object based not on instructions but on a two-dimensional picture.³³⁹

Finally, there is a circular element in the enforcement discussion that we must eliminate. When courts in the United States decide that an infringing derivative cannot be a protected “work”

336. See *supra* notes 88 and 124 and accompanying text.

337. Naturally, if human choices are involved and demonstrably present in the three-dimensional object, that object might claim originality and the status of work in its own right. This would be a matter for evidence in an actual case. *Entertainment Research Group, Inc. v. Creative Group, Inc.*, 122 F.3d 1211 (9th Cir. 1997) is relevant in this context. The Ninth Circuit held that three-dimensional inflatable costumes based on copyrighted, two-dimensional cartoon designs were *insufficiently original* to constitute derivative works because the changes to make the three-dimensional version were dictated wholly by functional considerations, rather than creative judgments. For a discussion, see Michael J. Madison, *The End of the Work As We Know It*, 19 J. INTELL. PROP. L. 325 (2012).

There is little doubt that the reverse (a three-dimensional object “copied” in two dimensions) can also be an infringement. Indeed, in that direction (three to two dimensions), the use seems closer to a “straight copy” than the other way around because of the difference between the types of intellectual work involved. As the Eighth Circuit explained in *Warner Bros. Entertainment, Inc. v. X One X Productions*, 644 F.3d 584 (8th Cir. 2011), to make figurines and statuettes based on cartoon characters “a three-dimensional rendering must add new visual details regarding depth to the underlying two-dimensional image.” 644 F.3d 584, 603. Another example is provided in *Walco Products Inc. v. Kittay & Blitz Inc.*, 354 F. Supp. 121 (S.D.N.Y. 1972) (finding that Christmas tree ornamental kits substantially copied plaintiff’s copyrighted works of art even if the kits needed to be assembled by the consumer to recreate the work of art in three dimensions).

338. Under 17 U.S.C. § 113(b). For example, a two-dimensional sketch of a couture design is protected under copyright law, but the three-dimensional garment is not because it is considered a useful article. See Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687, 1745–46 (2006). For a British case on point, see *British Leyland Motor Corp. v. Armstrong Patents Co.*, [1986] A.C. 577 (U.K.) (finding that copyright protection in a two-dimensional drawing could be used to prohibit the creation of a three-dimensional version). For a discussion, see Orit Fischman Afori, *Reconceptualizing Property in Designs*, 25 CARDOZO ARTS & ENT. L.J. 1105, 1173 (2008).

339. In fact, the automated algorithmic nature of the process might be sufficient evidence of a lack of creative choices, the hallmark of originality. For an example, see *Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.*, 528 F.3d 1258, 1268 (10th Cir. 2008) (holding that only creativity in the finished product, not the process itself, is protectable under copyright). See also *supra* note 70.

because it is infringing, they do not necessarily decide that an infringement could not occur absent the creation of a new work.³⁴⁰ Instead, what they decide is that the new “work” is not protected under the statute.³⁴¹ Conceptually, the assertion is that no copyright right should be granted to an infringing author, but this does not preclude an analysis of whether a new (though infringing) work of authorship would have been created.³⁴²

C. Derivation as Art

This Article ends the analysis of the derivative right with a note of caution concerning art that copies art, a major form of which is known as “appropriation art.” In recent years, the related phenomenon of UGC in myriad forms (mash-ups, fan sites, etc.) has also come to the fore.³⁴³ The issue mentioned above of making “mechanical” three-dimensional representations of two-dimensional works is different to the extent that a machine does all the work with little or no human direction.³⁴⁴ This section discusses appropriation with changes made by a (human) author that may trigger the derivative right. This area will require courts to consider the derivative right with the utmost caution. It is also an area where understanding the derivative right—and its linkages with fair use—will become increasingly important.

It may be useful to distinguish fair use to create new works—even if derived (in colloquial terms) from preexisting material—and straight reuse. Transformativeness speaks more to the former than the latter and explains why allowing “derivation” as art, under fair use or because it does not fall under the exclusive right to begin with, normatively requires more leeway than copying to improve, say, online access to works that are not creatively transformed.³⁴⁵ In addition, copyright collectives can easily license

340. See *Anderson v. Stallone*, No. 87–0592 WDKGX, 1989 WL 206431 (C.D. Cal. Apr. 25, 1989).

341. As discussed above, the derivative right can be infringed without fixation but no new original work can be created under the US statute. See *supra* note 17 and accompanying text.

342. Nimmer suggested that under US law, if the work has been created lawfully, § 106(2)’s grant of the right to prepare derivative works “may be thought to be completely superfluous.” 2 NIMMER & NIMMER, *supra* note 60, § 8.09[A]. The Author tried in this Article to situate the difference.

343. See Daniel Gervais, *supra* note 4, at 842–43; see also Steven Hetcher, *The Kids Are Alright: Applying a Fault Liability Standard to Amateur Digital Remix*, 62 FLA. L. REV. 1275, 1326–27 (2010).

344. See *supra* note 333 and accompanying text.

345. See, e.g., *Perfect 10, Inc. v. Amazon.com, Inc.*, 487 F.3d 701 (9th Cir. 2007). In the Author’s view, this would be much better dealt with under a statutory safe harbour (as with

reuse of preexisting works “as is”; however, copyright collectives are much less nimble in licensing uses that imply a creative transformation.³⁴⁶ This is also relevant as part of a fair use analysis.³⁴⁷

Appropriation art, a major strand of postmodern art, has already generated a substantial amount of litigation involving not just the “appropriators,” but also museums debating their acquisition policies.³⁴⁸ It is the poster child for hard derivation cases under copyright law. Works by artists such as Andy Warhol, Robert Rauschenberg, and Jeff Koons have been the subject of intellectual property disputes.³⁴⁹ In a movement that was already well known by the Dadaists, appropriation art is the latest form of decontextualization.³⁵⁰ But art copying art is not new. Would we consider Delacroix or Cézanne infringers for “copying” Rubens’s “The

Internet Service Providers), allowing search engines to link to and present acceptable excerpts of publicly available material on the Internet. The Author suggests that it is not because one believes this function is normatively desirable that it should, ipso facto, be fair use.

346. The statute itself contains a compulsory license for “covers” of published musical works. 17 U.S.C. § 115 (2006). Collectives are at their best working with a repertory of works that are to be used according to standard terms. By contrast, the reuse of a specific work often requires a negotiation that must include input from the author or other rightsholder (for example, the use of music in a motion picture or advertisement).

347. See, e.g., *Am. Geophysical Union v. Texaco Inc.*, 60 F.3d 913 (2d Cir. 1994). The case stands for the proposition that a reasonably available license is a relevant consideration under the fourth factor:

It is indisputable that, as a general matter, a copyright holder is entitled to demand a royalty for licensing others to use its copyrighted work However, not every effect on potential licensing revenues enters the analysis under the fourth factor. Specifically, courts have recognized limits on the concept of “potential licensing revenues” by considering only traditional, reasonable, or likely to be developed markets when examining and assessing a secondary use’s “effect upon the potential market for or value of the copyrighted work.”

Id. at 929–30.

348. See John Henry Merryman, *Museum Ethics*, 2006 ALI-ABA COURSE OF STUDY: LEGAL ISSUES IN MUSEUM ADMIN. 3, 9 (2006).

349. See, e.g., *Dauman v. Andy Warhol Found. for Visual Arts, Inc.*, No. 96 Civ. 9219 (TPG), 1997 WL 337488, at *1–3 (S.D.N.Y. June 19, 1997) (denying the defendant’s motion to dismiss a claim of misappropriation of a copyright image by the late Andy Warhol, which formed the basis for his work “Sixteen Jackies”). Similarly, the publicity photo of Marilyn Monroe taken by Gene Korman used by Andy Warhol for his “Marilyn” series was the subject of a private settlement with the Warhol Foundation. See Molly Ann Torsen, *Beyond Oil on Canvas: New Media and Presentation Formats Challenge International Copyright Law’s Ability to Protect the Interests of the Contemporary Artist*, 3 SCRIPT-ED 45 (2006) (suggesting Warhol’s work was original enough to preclude liability); *Robert Rauschenberg and Pete Turner*, COPYRIGHT WEBSITE, <http://www.benedict.com/Visual/Rauschenberg/Rauschenberg.aspx> (last visited Mar. 3, 2013) (detailing how Rauschenberg was sued by Turner for using Turner’s photograph, which appeared in an issue of *Time* magazine, in his work); see also *Rogers v. Koons*, 960 F.2d 301, 305–06, 314 (2d Cir. 1992) (holding that Koons’s work, which incorporated Rogers’s photograph, infringed Rogers’s copyright in his photograph).

350. Jean-Pierre Cuzin, *Au Louvre, D’après les Maîtres*, in REUNION DES MUSEES NATIONAUX, *COPIER, C’EST CREER DE TURNER A PICASSO* 26, 28 (1993).

Landing of Marie de Médicis at Marseilles”?³⁵¹ Certainly they were adding their own personality, copying themselves as much as Rubens, in the words of Catherine Kintzler.³⁵² What of Dali “copying” Raphael?³⁵³ A derivative use may be amply original, but its originality does not always save it from also being an infringement. This Article does, however, suggest, as noted above, that it is an equation that reflects the amount of originality of the primary work, the quality and quantity of the originality transferred from the primary work to the derivative work, and the amount of originality and purpose added by the author of the derivative work.³⁵⁴

Modern artists, such as Sherri Levine, David Salle, Susan Pitt, Richard Prince, and, in the 2008 US presidential campaign, Shepard Fairey, have made the incorporation of previous works into their own works (without permission) a central element of their artistic statement.³⁵⁵ In the realm of copying as art, as noted above, there is an argument that copying or deriving is itself creative and, more broadly, that art is different.³⁵⁶ Art is art if it transforms or even destroys. Art incorporates and sometimes becomes a meme. It is copied as an element in a broader cultural construct, a vehicle for communal expression. Art may imitate, for example as homage when Man Ray created his “Violon d’Ingres”.³⁵⁷ Often, artists begin by

351. Assume that there is no expiration of the term of protection for the sake of discussion. A copy of Rubens’s masterpiece may be seen at Peter Paul Rubens, *The Landing of Marie de Médicis at Marseilles*, WEB GALLERY OF ART, http://www.wga.hu/html_m/r/rubens/40histor/01medici.html (last visited Feb. 26, 2013).

352. Catherine Kintzler, *La Copie et L’Original*, 2003 REVUE DÉMETER 1, 6.

353. See *id.*; Conrad H. Roth, *Dali on Raphael*, VARIETIES OF UNRELIGIOUS EXPERIENCE BLOG (Oct. 3, 2006), <http://vunex.blogspot.com/2006/10/dali-on-raphael.html>.

354. See *supra* note 293 and accompanying text.

355. The Author wishes to thank Walt Lehman for providing much useful background and insight on this point.

356. See Daniel J. Gifford, *Innovation and Creativity in the Fine Arts: The Relevance and Irrelevance of Copyright*, 18 CARDOZO ARTS & ENT. L.J. 569, 577–79 (2000). Gifford states:

Contrary to the way commercial development proceeds, work in the fine arts is not generally undertaken for profit. At the level of production, it is difficult to tie the supply of painting, sculpture, or composition of classical music directly to a system of economic rewards. . . . [A]rtistic production is most analogous to basic research because its guidance is left to the idiosyncrasies of the individual artist. By contrast, a complex system of museums, galleries, and critics guide its distribution. That system once shared a common view on artistic standards, which influenced both distribution and production accordingly. Largely as a result of the breakdown of the governing artistic paradigm, that system is in the process of becoming increasingly responsive to a broad array of tastes.

Id. at 578–79.

357. See Cuzin, *supra* note 350, at 29.

copying, as any art school instructor could attest.³⁵⁸ Copying is learning, homage, and a necessary step for art to grow. It is the method by which artists appropriate the past, an often-indispensable step to their own contribution.

What if the reuser seems to be exploiting the primary work and affecting its market? How does one fairly distinguish that “step” from a new contribution that the law should allow? That is precisely the question that properly scoping the derivative right (with its reproduction cousin in many cases) poses. It also shows that market impacts are likely a poor normative guide to deciding what art the law should allow.

By copying a master’s work, the “pupil” might at least get a glimpse of the great author’s mind, which would seem like a normatively desirable process.³⁵⁹ “*L’art naît d’un regard sur l’art*,” as the French would say: art is born from a view on existing art.³⁶⁰ As such, one may see it as categorically excised from the notion of derivation. In some cases, because of the equation mentioned above, the choices made by the reuser are such that normatively this may be the right outcome. In harder cases, especially if there is commercial exploitation of the derivative, a court might decide that the amateur (or professional) nature of the use is best considered a protected derivation, based on the principle of proximity. That, this Article suggests, is the proper approach. That principle is subject to the equation (or test) suggested previously. As a subsequent step, a fair use analysis may be used to limit the reach of the right.

UGC is subject to the same note of caution. Many forms of UGC are noncommercial but also nonprivate. An excellent example is *doujinshi*, comic-like magazines combining *anime*, *manga*, and video

358. See Johnson Okpaluba, *Appropriation Art: Fair Use or Foul?*, in DEAR IMAGES: ART, COPYRIGHT AND CULTURE 198–99 (Daniel McClean & Karsten Schubert eds., 2002). Okpaluba notes:

[A]ppropriation art is essentially an artistic technique not peculiar at all to the twentieth century, as it has always been used as an aid to teach drawing. There is a long tradition of artists who have appropriated elements of other artist’s work and recycled them into their own works, starting with Picasso’s cubist collages. In the early twentieth century, artists like Picasso, Braque, Gris, and Schwitters began to use “found” objects in their work; everyday items such as newspapers, litter, string, and photographs.

Id. As a matter of “art policy,” does it matter much whether the artist uses an actual article clipped from the *New York Times* or “copies” it with her brush? The Author posits that as a matter of copyright policy the difference is, of course, crucial, because the first use does not include a reproduction. It may, however, involve a transformation and hence application of the derivative right.

359. Cuzin, *supra* note 350, at 35.

360. See *id.* at 30–31.

games.³⁶¹ Major social events attended by thousands of fans are organized to share *doujinshi*.³⁶² Online fan sites also come to mind.³⁶³ These websites and forms of UGC cannot all be comfortably pigeonholed as noncommercial.³⁶⁴ This clashes with traditional accounts, which tend to present UGC as noncommercial or “amateur.”³⁶⁵ While this view may have been fully justified in the early days of UGC, a number of ways to monetize at least some forms of UGC are emerging, and litigation tends to follow as soon as a significant commercial line is crossed.³⁶⁶ Courts should make room for at least some forms of commercial (or at least nonamateur) UGC to balance the promotion of new forms of creativity and the need to maintain valid *ex ante* incentives and *ex post* rewards for creators of primary works used, even if the new forms strike the court as being of poor quality.³⁶⁷

The normative implications are clear: should one stop generations of younger creators who were “born digital” and see no good reason not to use those tools to create, even if it includes some measure of appropriation? When does that appropriation cross the line?³⁶⁸ When there is sufficient proximity between the works, especially where much of the primary work’s creative choices have been appropriated and little has been added. The analysis should be informed by the fact that copyright has always tried to avoid judgment on the quality or artistic merit of new forms of creation, and the fact that the appropriation of the past is a necessary ingredient of an

361. *Anime* is a form of animation, and *manga* is a form of Japanese comics. See Salil Mehra, *Copyright and Comics in Japan: Does Law Explain Why All the Cartoons My Kid Watches are Japanese Imports?*, 55 RUTGERS L. REV. 155, 164 (2002); Nathaniel T. Noda, *Copyrights Retold: How Interpretive Rights Foster Creativity and Justify Fan-Based Activities*, 20 SETON HALL J. SPORTS & ENT. L. 131, 132 (2010).

362. See Noda, *supra* note 361, at 132. This includes a three-day market in Tokyo known as “Comiket.” See COMIKET, http://www.comiket.co.jp/index_e.html (last visited Jan. 4, 2012).

363. See AARON SCHWABACH, *FAN FICTION AND COPYRIGHT* 18 (2011).

364. Commerciality is not a bar to a finding of fair use but it is a (major) strike against the defendant under the fourth factor. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 584–85 (1994).

365. See, e.g., LAWRENCE LESSIG, *REMIX: MAKING ART AND COMMERCE THRIVE IN THE HYBRID ECONOMY* 254 (2008).

366. See Casey Fiesler, Note, *Everything I Need to Know I Learned from Fandom: How Existing Social Norms Can Help Shape the Next Generation of User-Generated Content*, 10 VAND. J. ENT. & TECH. L. 729, 752–53 (2008).

367. This “trap” of judging the quality of a primary or allegedly infringing work is common, and may well be justified as a cultural matter, but not as a factor under copyright law (no judging of artistic merit). For a discussion of the former (cultural) aspects, see ANDREW KEEN, *THE CULT OF THE AMATEUR: HOW TODAY’S INTERNET IS KILLING OUR CULTURE* 3–4 (2007). On the latter (copyright) aspect, see James Grimmelman, *The Ethical Visions of Copyright Law*, 77 FORDHAM L. REV. 2005, 2006 (2009).

368. On that distinction, see Gervais, *supra* note 4, at 850–55.

intergenerational dialogue, which might take several new and possibly irreverent forms.³⁶⁹ At the very least, judges should be aware of any underlying “bias.”³⁷⁰ Originality is what is added by the artist both as a contribution to the work’s inherent structure (what one might call aesthetic originality) and, especially for new art forms, as a posture of the artist vis-à-vis her creative milieu.³⁷¹

If we mean it when we say that we want to foster the emergence of new expression, the law should encourage this form of evolution of art, whether seen as positive or not.³⁷² Again, this Article’s suggestion is that courts should tread with the utmost caution here. One may find some forms of contemporary art to be pure genius or garbage. One may, however, change one’s mind tomorrow. More importantly, one should not want to be the judge of what is or should be art today, and it certainly is not nor indeed has it ever been the historical role of courts to decide what should be allowed to exist as art today or for posterity. This means courts should be

369. The exclusion of artistic merit in copyright policy is well established, at least theoretically, in most legal systems. See, e.g., *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) (including Justice Holmes’s famous articulation on this point). Yet even courts that try often fail:

[I]t is no longer necessary or valuable or even possible to dissect a work of art to uncover the universal truths or ideas which must remain freely available to all future authors. If people value instead that creative process itself, rather than a particular end product, as conceptual artists do, then copyright’s focus on that end product seems misplaced. Every work of art, even if a copy of another’s work, could be seen as valuable in the sense that it was unique to the particular artist who engaged in that process. To the extent that copyright law rests on the view that the government should prohibit copying of expression in order to protect the original artist but allow the copying of ideas in order to encourage the creation of new works, it may be missing the point. There may be no way for the new artist to extract the “idea” without the “expression” of it, and moreover, there may be no point in making that artist attempt to do so because that artist’s creation of his or her work may be considered valuable as a reflection of that artist and that artist’s definition of what is art. For these reasons, the idea-expression dichotomy, conceptually grounded in classical and neoclassical views of art that are no longer widely accepted, is doomed to fail. Courts have no philosophical or objective basis on which to rely in trying to distinguish the ideas from the expression in works of art.

Amy B. Cohen, *Copyright Law and the Myth of Objectivity: The Idea-Expression Dichotomy and the Inevitability of Artistic Value Judgments*, 66 IND. L.J. 175, 231 (1990).

370. See Christine Haight Farley, *Judging Art*, 79 TUL. L. REV. 805, 845–46 (2005).

[C]ourts do adopt aesthetic theories in their resolution of these art cases, they are just unaware that they are doing so. Examples of almost every aesthetic theory can be found employed by a court that must decide whether an object is art. These theories are what enable courts to reach conclusions about the art objects. The problem is that these courts are not self-conscious or explicit about the theories of art they are employing.

Id. In the words of the famous German copyright scholar Eugen Ulmer: “It is certainly true that, if we are to do justice to modern art, we shall have to be as broad-minded and liberal as possible in deciding what constitutes a work for copyright purposes.” Ulmer, *supra* note 96, at 81.

371. Kintzler, *supra* note 352, at 8.

372. See *id.* The Author suggests that in some cases transgression might, in an ironic twist, become the norm.

liberal in finding originality in “derivative art,” thus tipping the infringement equation toward the reuser in appropriate cases.³⁷³ In cases where a court might find art subject to the derivative right, there should be a serious consideration of the application of a limiting doctrine.³⁷⁴

For appropriation art specifically, Okpaluba suggests a nomenclature that distinguishes three types of works: appropriation of a whole, unchanged image; montage or collage (incorporating multiple works or fragments to create a new one); and “simulationism” (appropriation of a genre to produce a work that does not resemble a new type of work).³⁷⁵ Presumably, the idea-expression dichotomy saves the third type if it involved any misappropriation (from a copyright standpoint), while the second is likely to be transformative fair use. The first is the harder case. It might involve transformativeness by recontextualization. A court might consider both inherent changes to the work and external changes (context) that make any negative impact on the market for the primary work unlikely.³⁷⁶ This consideration might include a parody (fair use) defense as a change of context bordering on social critique.³⁷⁷

In sum, the Author would structure the analysis of infringement in this particularly sensitive context—one in which eliminating cultural and temporal bias seems essential yet almost impossible to achieve—by scoping the derivative right using *proximity* as a filter before the court finds derivation. If the court finds derivation to be present, as suggested above, application of fair use may be required to permit “courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster.”³⁷⁸

VI. CONCLUSION

US doctrine has painted with a very broad brush to define the right of reproduction as the taking of any protected expression from a work. This superimposes the idea-expression dichotomy on the

373. See *supra* note 293 and accompanying text.

374. See Okpaluba, *supra* note 358, at 200.

375. See *id.*

376. See *Rogers v. Koons*, 960 F.2d 301, 310 (2d Cir. 1992). The case is interesting for its analysis of fair use and specifically parody, a defense the court ultimately rejected. *Id.* at 304–12.

377. That is one reading of *Campbell*, in which the 2 Live Crew version of Roy Orbison’s “Oh, Pretty Woman” was arguably as much a take on the naiveté of the original work as a comment on prostitution. See Ochoa, *supra* note 236, at 554.

378. *Stewart v. Abend*, 495 U.S. 207, 236 (1990) (quoting *Iowa State Univ. Research Found., Inc. v. Am. Broad. Cos.*, 621 F.2d 57, 60 (2d Cir. 1980)).

infringement analysis and has mostly limited the derivative right to marginal cases such as performances of unfixed derivative uses. Recent court opinions tend to emphasize the distinction between the two rights more clearly but more work remains to be done. It is time to understand the distinct normative foundations of the derivative right in US copyright law.

This Article's analysis started from known quantities. It then added to those known quantities an analysis of doctrinal and normative teachings from international copyright law as enshrined in the Berne Convention and in British, French, and German legal systems, to look for the pith and substance of derivation and what distinguishes it from reproduction. The polestar was a set of principles, which this Article both explicates and demonstrates, and which can and should be used to properly scope the derivative right. The Article argues and demonstrates that there is a hard line that divides fundamental changes that are noninfringing under a proper derivative right analysis (in most cases because the idea, not the expression, is appropriated), and those that are noninfringing as transformative fair uses. In the last Part, this Article suggests that one should be particularly careful in extending the derivative right to forms of creation that are based on appropriation of previous works and offers suggestions concerning the enforcement of the right.

