



6-1-1989

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Recommended Citation

Michael B. Landau, *The Colorization of Black-and-White Motion Pictures: A Grey Area in the Law*, 22 Loy. L.A. L. Rev. 1161 (1989).

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THE COLORIZATION OF BLACK-AND-WHITE MOTION PICTURES: A GREY AREA IN THE LAW

*Michael B. Landau**

[I]f [works] command the interest of the public, they have a commercial value [I]t would be bold to say they have not an aesthetic and educational value . . . the taste of any public is not to be treated with contempt.

Mr. Justice Holmes¹

I. INTRODUCTION

In an attempt to exploit new markets, and to resurrect and allegedly revitalize many old black-and-white films, several firms, through a process known as "colorization"² or "color conversion,"³ are adding color to hundreds of old black-and-white films.⁴ Highly computerized, the process is expensive, arduous and, according to those who do it, artistically creative.⁵ Some of the films that have been colorized, the firms admit,

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The Author would like to thank Leslie Kyman for her patience and expertise at the word processor.

1. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 252 (1903).

2. See *Philadelphia Inquirer*, Mar. 29, 1987, (Sunday Magazine), at 14. "Colorization" is the term and trademark used by Colorization, Inc., a subsidiary of Hal Roach Studios. As its subsidiary, Colorization, Inc. has access to the studio's entire library of black-and-white films. *Id.*

3. *Id.* "Color conversion" is the term used by Color Systems Technologies, Colorization, Inc.'s main competitor. Color Systems Technologies does the colorization work for Ted Turner. *Id.* The term "colorization" will be used in this Article to refer to the process of adding color to films.

4. *Id.*

5. Representatives of Color Systems Technologies describe the conversion process as follows:

It is not the computer that colors unassisted, but rather, a large staff of operators, including artists and researchers, who make numerous subjective choices. . . . The coloring process begins with a transfer of the film to video tape on a shot-by-shot basis. Each shot is broken down with respect to such elements as costumes and sets, and the art department researches the film for factors of historical significance, as well as for tone and color. Representative 'story boards' are colored by the art department to guide the actual color conversion, which also takes place under the su-

are classics,⁶ while others are not.⁷ In either case, major commercial interests view colorization as a monumental profit-making opportunity.⁸

The United States Copyright Office has recently chosen to grant separate copyright protection to colorized versions of black-and-white motion pictures as derivative works.⁹ There has been much criticism of this decision, as well as a plethora of criticism of the colorized versions of the films in general.¹⁰ In the autumn of 1986, the Copyright Office requested

pervision of the art department. The final product must meet the approval of the highly credentialed artists on the color conversion staff, as well as the client.

23 Pat. Trademark & Copyright J. (BNA) 493 (Aug. 28, 1980).

Wilson Markle of Colorization, Inc. describes Colorization's process as follows:

It all begins with a client's delivering a "broadcast quality" black-and-white videotape of the best available copy of a given film. Certain imperfections caused by wear and tear of film stock can be cleaned from the videotape, but others will find their way into the colorized version.

Research and continuity people then break the film down into scenes. Studio stills, production notes, old movie magazines and other sources are consulted to glean available information on costumes, sets, hair and eye color. Some things can be found out, and some things can't. . . . Next an art director and a "strategy colorist" decide what shades go where.

They have hints from the black-and-white tape. . . . They know that if two tones in two parts of the frame are equally dark, those two colors are equally dark. But there's no way they can look at those shades of gray and know what colors they really are. So they use their artistic sense. And when they have made their decisions, the thing gets turned over to the animation colorists.

Philadelphia Inquirer, Mar. 29, 1987, (Sunday Magazine), at 16.

Since "true artistic merit" has been listed as a criterion for originality by the Second Circuit in *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 491 (2d Cir. 1976), the parties involved would characterize their processes as artistic, original and creative. See *supra* notes 36-105 and accompanying text.

6. *It's a Wonderful Life* (RKO Radio Pictures, Inc. 1947), *Casablanca* (Metro-Goldwyn-Mayer 1942), and *The Maltese Falcon* (MGM/UA 1941) have all been colorized. *Id.* at 16.

7. Ted Turner has purchased 3,650 old black-and-white films. *Id.* It is hard to imagine that most of them could be considered classics.

8. See *id.* Ted Turner paid \$1.2 billion to MGM for its library of 3,650 movies, including many films made by Warner Brothers and RKO. *Id.* Turner has hired Color Systems Technologies to put color on more than one hundred of these films, to be broadcast over Turner's satellite "super station," offered in syndication and available on videotape. *Id.*

9. The colorized version of Frank Capra's *It's a Wonderful Life* was the first motion picture to receive a separate copyright. *Id.* at 14.

10. *Id.* at 16. The criticism often comes from the creative forces behind the original black-and-white versions of the films. *Id.*

Frank Capra, then 87, wrote a letter to the Library of Congress urging that the copyright request be denied. "I chose to shoot [the movie] in black-and-white film," the director said in his letter. "The lighting, the makeup for the actors and actresses, the camera and laboratory work, all were geared for black-and-white film, not color. I beseech you with all my heart and mind not to tamper with a classic in any form of the arts. Leave them alone. They are classics because they are superior. Do not help the quick-moneymakers who have delusions about taking possession of classics by smearing them with paint."

Id.; see also N.Y. Times, Nov. 14, 1986, § 3, at 36 (John Houston expressed his negative reaction to the colorized version of *The Maltese Falcon*).

that interested parties send comments to assist it in developing practices regarding the registration of colorized black-and-white motion pictures.¹¹ The Office requested information regarding the technical processes involved, the nature of artistic decisions made, and the commercial intent of the "authors."¹² Ultimately, on June 22, 1987, the Copyright Office decided to grant separate protection to colorized films, provided they possess "sufficient originality."¹³

The Copyright Office was justifiably in a quandary. The colorization of motion pictures involves fundamental and pivotal questions of copyright law: is there sufficient originality in a colorized motion picture to qualify it for copyright protection as a derivative work;¹⁴ a great deal of the colorizing process is done by computer—is it thus an unprotected process¹⁵ or a protected expression of an idea;¹⁶ are there policy reasons for not granting the colorized version separate protection? Because of inconsistent holdings in the courts and the nebulosity of certain copyright standards, these questions are difficult to answer.

The present copyright law apparently would tend to favor the copyrightability of colorized versions of classic motion pictures. This Article addresses fundamental principles of copyright law as they relate to colorization of motion pictures, and attempts to arrive at sensible answers.

II. COLORIZED MOTION PICTURES AS DERIVATIVE WORKS: BASIC PRINCIPLES

Section 102(a)(6) of Title 17 of the United State Code authorizes copyright protection for motion pictures and other audiovisual works.¹⁷ In particular, section 101 of Title 17 defines the categories of audiovisual works that are capable of protection under the Copyright Act:

"Audiovisual works" are works that consist of a series of re-

11. Copyright L. Rep. (CCH) No. 100, at 1 (Sept. 30, 1986).

12. *Id.*

13. 52 Fed. Reg. 23,442-3 (Feb. 4, 1987); see also 34 Pat. Trademark & Copyright J. (BNA) 214, 222 (1988). See *infra* notes 36-105 and accompanying text for a discussion of the "originality" requirement.

14. See, e.g., *L. Batlin & Son*, 536 F.2d at 491.

15. See 17 U.S.C. § 102(b) (1982).

16. See, e.g., *M. Kramer Mfg. v. Andrews*, 783 F.2d 421 (4th Cir. 1986); *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240 (3d Cir. 1983).

17. 17 U.S.C. § 102(a)(6) (1982). Section 102(a) of the Copyright Act sets forth the allowable subject matter of copyrights:

[C]opyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated,

lated images which are intrinsically intended to be shown by the use of machines, or devices such as projectors, viewers, or electronic equipment, together with accompanying sounds, if any, regardless of the nature of the material objects, such as films or tapes, in which the works are embodied.¹⁸

Motion pictures are a subcategory of audiovisual works and are defined in section 101 of the Copyright Act as "audiovisual works consisting of a series of related images which, when shown in succession, impart an impression of motion, together with accompanying sounds, if any."¹⁹ Clearly, colorized versions of motion pictures are themselves audiovisual works falling under the definition set forth in section 101.

In determining whether a colorized version of a black-and-white motion picture is capable of receiving its own copyright protection, it is important to examine the definition of "derivative works" in the Copyright Act. Section 101 defines derivative works:

A "derivative work" is a work based upon one or more preexisting works, such as a translation, . . . motion picture, . . . or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole represent an original work of authorship, is a "derivative work."²⁰

It would thus appear, if the requisite quantum of originality is met, that a colorized version of a motion picture is a derivative work—the colorized version would certainly be a recasting, transformation or modification as defined by the statute.²¹ That the underlying motion picture movie upon which the derivative work is based has fallen into the public domain is of no consequence.²² A work may be copyrightable though it is based upon material already existing in the public domain, if the au-

either directly or with the aid of a machine or device. Works of authorship include the following categories:

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

Id. § 102(a).

18. *Id.* § 101.

19. *Id.*

20. *Id.*

21. *Id.*

22. *Id.* at § 103(b). Section 103(b) provides that the copyright in a derivative work is independent of any copyright protection in the preexisting material. *Id.*

thor, by virtue of his own skill and effort has contributed a *distinguishable variation* from the previous existing materials.²³

The area in dispute in the copyrightability of colorized motion pictures is whether the colorization represents an "original work of authorship" as required by the Copyright Act.²⁴ Under the "distinguishable variation" test, it would appear that the requisite originality is met, for an ordinary lay observer would clearly notice the difference between the colorized version and the black-and-white version. By colorizing the film, the colorizer has contributed a distinguishable variation from the previously existing black-and-white movie. If the colorizer is successful in satisfying the originality requirement, the colorized movie would be a derivative work eligible for protection under section 103(a) of the Copyright Act.²⁵

The protection that would attach to the derivative work is limited; it would "extend[] only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the [underlying] work."²⁶ The underlying work—the black-and-white film—would still be protected by its own separate copyright.²⁷ Therefore, if protection is granted, it would only extend to the specific colorization of the film. Additionally, even if copyright were granted to the colorized version, under section 103(b) the original black-and-white films would still enter the public domain upon the expiration of their copyrights.²⁸ The duration of the copyright in the colorized version would not affect

23. *Donald v. Zack Meyer's T.V. Sales & Service*, 426 F.2d 1027 (5th Cir. 1970), *cert. denied*, 400 U.S. 992 (1971) (emphasis added).

24. 17 U.S.C. § 102(a). For copyright protection to subsist, the material must be an original work of authorship. *Id.*

25. *Id.* § 103(a). "The subject matter of copyright . . . includes compilations and derivative works . . ." *Id.*

26. *Id.* § 103(b); see also *Knickerbocker Toy Corp. v. Winterbrook Corp.*, 554 F. Supp. 1309, 1317-18 (D.C.N.H. 1982); H.R. REP. NO. 1476, 94th Cong., 2d Sess. 57, reprinted in 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5660-61 ("The most important point here is one that is commonly misunderstood today: copyright in a 'new version' covers only the material added by the later author, and has no effect one way or the other on the copyright or public domain status of the preexisting material.").

27. 17 U.S.C. § 103(b). In *Russell v. Price*, 612 F.2d 1123, 1129 (9th Cir. 1979) a motion picture of George Bernard Shaw's protected work, *Pygmalion*, was found to be infringing, for most of its content was that of the underlying play.

28. Section 103(b) expressly states that the duration of the copyright in a derivative work is independent of the duration of the copyright in the underlying work. Derivative works created after January 1, 1978 will have a basic duration of the life of the creator and fifty years after the creator's death. 17 U.S.C. § 302(a). At the end of this period, the derivative work will enter the public domain.

the duration of the copyright in the underlying black-and-white film.²⁹ Thus, it would be possible for there to be a public domain black-and-white film—that anyone could use, display or from which to make a derivative work—and a protected colorized version, both existing simultaneously.

It is also clear that under present copyright law, a derivative work could not be made from a copyrighted black-and-white film without the copyright owner's permission.³⁰ According to Professor Nimmer, when the underlying work is copyrighted, the derivative work is "saved from being an infringing work only because the borrowed or copied material was taken with the consent of the copyright owner."³¹ Using the underlying black-and-white film *without* permission would clearly be an infringement of the copyright owner's exclusive rights.³² Thus, unless the black-and-white movie is in the public domain, the colorizer must obtain the film owner's permission before preparing a colorized version.

One federal district court has observed that "the mere fact that [a party] used a matter in the public domain does not in and of itself preclude a finding of originality, since [a party] may have added unique features to the matter so as to render it copyrightable . . ."³³ In the case of colorization of motion pictures, the "unique features" would be the colorization process. Note that the "unique aspects" of the derivative work must themselves be nontrivial or the originality requirement will not be satisfied.³⁴

At present, there are no reported cases of suits brought for infringement of copyright resulting from colorization. In most instances, those who are doing the colorizing either own the right to make derivative works based on black-and-white films or the underlying work has fallen into the public domain as in the case of Color Systems Technologies' colorization of *Miracle on 34th Street*.³⁵

In sum, under the 1976 Copyright Act, if the colorizers either own the copyright in the underlying work or if the underlying black-and-white film is in the public domain, the colorized version will be protect-

29. *Id.* § 103(b). See *infra* notes 176-91 and accompanying text for further discussion of copyright duration in colorized films.

30. 17 U.S.C. § 103(a).

31. 1 M. NIMMER, NIMMER ON COPYRIGHT § 3.01, at 3-3, 3-4 (1988).

32. 17 U.S.C. § 106(2). A copyright owner has the exclusive right to prepare derivative works.

33. *R. Dakin & Co. v. A & L Novelty Co.*, 444 F. Supp. 1080, 1083-84 (E.D.N.Y. 1978).

34. 17 U.S.C. § 103(b). See *infra* notes 36-105 and accompanying text for a discussion of the originality requirement.

35. Philadelphia Inquirer, Mar. 29, 1987, Sunday Magazine, at 14.

able as a derivative work provided the colorization process satisfies the originality requirement.

III. SUFFICIENT ORIGINALITY

A major issue in the copyrightability of colored films is the satisfaction of the sufficient originality requirement.³⁶ Section 102(a) of the 1976 Copyright Act provides that "copyright protection subsists, in accordance with this title, in *original* works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device."³⁷ Nowhere in copyright jurisprudence does there exist a more nebulous and potentially undefinable term than "originality." The statute does not define originality; nowhere in the statute are the requirements of originality set out. Originality is not dependent on the aesthetic merit of a work.³⁸

Case law lends only confused meaning to the term "originality." In *Bleistein v. Donaldson Lithographing Co.*,³⁹ the Supreme Court of the United States reversed the denial of a copyright to a circus advertising poster.⁴⁰ The court of appeals⁴¹ and the dissent in the Supreme Court did not deem an advertisement to be artistic enough to warrant copyright protection.⁴² Writing for the majority, Justice Holmes focused not on the skill of the artist or the aesthetics of the work, but on originality.⁴³ The Court declared that courts should not be the arbiters of aesthetics, or determiners of "what is art."⁴⁴ Justice Holmes stated: "It is not for the court to substitute its taste for that of the public No matter how poor artistically the 'author's' addition, it is enough if it is his own."⁴⁵

Since artistic merit or aesthetics is not the determining factor of originality for copyright protection, what does "originality" mean? Different cases have set different standards, but all are vague and difficult to follow.⁴⁶ As a result, there are no reliable guidelines for the courts to

36. 17 U.S.C. § 102(a) (1982).

37. *Id.* (emphasis added).

38. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 51, reprinted in 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5660-61.

39. 188 U.S. 239 (1903).

40. *Id.* at 250.

41. *Courier Lithography Co. v. Donaldson Lithography Co.*, 104 F. 993 (6th Cir. 1900).

42. *Bleistein*, 188 U.S. at 252-53 (Harlan, J., dissenting).

43. *Id.* at 249-50.

44. *Id.* at 250.

45. *Id.*

46. See, e.g., *Durham Indus. v. Tomy Corp.*, 630 F.2d 905, 911 (2d Cir. 1980) ("even a modest degree of originality" is enough); *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490-

follow. The required quantum of originality has been variously defined as a "substantial, but not merely trivial" originality,⁴⁷ a "distinguishable variation,"⁴⁸ a "minimal element of creativity over and above the requirement of independent effort,"⁴⁹ a "very modest grade of originality,"⁵⁰ and as "sufficiently dissimilar" from another work.⁵¹ With standards such as these, it seems as though "originality" is as difficult to define as "love" or "beauty." The cases appear to be fact-specific and sometimes result oriented. In fact, Judge Learned Hand stated that in the area of copyright, "[d]ecisions must . . . inevitably be *ad hoc*."⁵²

In *Durham Industries*,⁵³ three-dimensional wind-up toy replicas of two-dimensional Walt Disney characters were denied copyright protection as derivative works on the grounds that the figures lacked "even a modest degree of originality."⁵⁴ Yet, in *W. Goebel Porzellanfabrik v. Action Industries*,⁵⁵ a New York federal court held that "artists . . . who [have] translated . . . sketches [and drawings] into three-dimensional art works have added sufficient creative effort to make the . . . figures protectible under the copyright laws" as derivative works.⁵⁶

Adding to the confusion, the Second Circuit, in *Alfred Bell*,⁵⁷ granted a separate copyright to an exact reproduction, albeit in a different medium, of a public domain old master painting.⁵⁸ In granting a copyright to the mezzotint engravings, the court defined original as something that "owes its origin to the author," and continued that "no large measure of novelty is necessary."⁵⁹ The court stressed "that noth-

91 (2d Cir. 1976) (originality requires "true artistic skill" and a recognizable contribution of the author); *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102 (2d Cir. 1951) ("original" means owing its origin to the author; no novelty is required).

47. *Chamberlin v. Uris Sales Corp.*, 150 F.2d 512, 513 (2d Cir. 1945).

48. *Gerlach-Barklow Co. v. Morris & Bendien, Inc.*, 23 F.2d 159, 161 (2d Cir. 1927).

49. 1 M. NIMMER, *supra* note 31, § 102, at 36.

50. *Peter Pan Fabrics, Inc. v. Dan River Mills, Inc.*, 295 F. Supp. 1366, 1368 (S.D.N.Y. 1969).

51. *Blazon, Inc. v. DeLuxe Game Corp.*, 268 F. Supp. 416, 422 (S.D.N.Y. 1965).

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

53. 630 F.2d 905 (2d Cir. 1980).

54. *Id.* at 911.

55. 589 F. Supp. 763 (S.D.N.Y. 1984).

56. *Id.* at 767. *But see L. Batlin & Son*, 536 F.2d at 492 (translation to another medium is not protectable originality).

57. 191 F.2d 99 (2d Cir. 1951).

58. *Id.* at 102.

59. *Id.* The *Alfred Bell* court explained in depth the constitutional background of the copyright statute, and the difference between the requirement for patents, novelty and uniqueness, and copyright originality. *Id.* at 100-03. The court held that the standard for copyright is less stringent than that for patents. *Id.* at 102-04; *see also Alva Studios, Inc. v. Winninger*, 177 F. Supp. 265 (S.D.N.Y. 1959).

ing in the Constitution commands that copyrighted matter be strikingly unique or novel.”⁶⁰ *Alfred Bell* also reinforces the idea that a copyright may be granted to works derived from public domain works.⁶¹ The court stated that:

[W]e were not ignoring the Constitution when we stated that a “copy of something in the public domain” will support a copyright if it is a “distinguishable variation” All that is needed to satisfy both the Constitution and the statute is that the “author” contributed something more than a “merely trivial” variation.⁶²

The colorization of a motion picture would certainly seem to satisfy the merely trivial variation requirement. In *Alfred Bell*, just as with film color, the new work was essentially the same as the old master, but in a different medium and copied with exacting certitude.⁶³

The *Alfred Bell* court also expressed concern over blocking of future works by future artists⁶⁴ by stating that “[t]he ‘author’ is entitled to a copyright if he independently contrived a work completely identical with what went before; similarly, although he obtains a valid copyright, he has no right to prevent another from publishing a work identical with his, if not copied from his.”⁶⁵ If this were not so, a copyright owner could monopolize a work to the same extent that a patent owner could without having to go through the rigorous requirements of patent registration.

Later cases also suggest the notion that the standards of originality or “original contribution of the author” are relatively low.⁶⁶ In *Eden Toys*, a modest and minor variation of an illustration of a Paddington Bear was given copyright protection.⁶⁷ The bear with “changed proportions of the hat, elimination of individualized fingers and toes, [and] the overall smoothing of lines” created a “different [and] ‘cleaner’ look.”⁶⁸ It was therefore a distinguishable variation from the underlying work.⁶⁹ In *Blazon*, the court assumed a hobby horse could be copyrightable since the plaintiff could have added “unique features to the horse, enlarged it

60. *Alfred Bell*, 191 F.2d at 102.

61. *Id.* at 102-03.

62. *Id.*

63. *Id.* at 105.

64. *Id.* at 103. See *supra* notes 176-91 and accompanying text for discussion of the impact on later works by future artists.

65. *Alfred Bell*, 191 F.2d at 103.

66. See, e.g., *Eden Toys, Inc. v. Florelee Undergarment Co.*, 697 F.2d 27 (2d Cir. 1982); *Blazon, Inc. v. DeLuxe Game Corp.*, 268 F. Supp. 416 (S.D.N.Y. 1965).

67. *Eden Toys*, 697 F.2d at 34-35.

68. *Id.* at 35.

69. *Id.*

and made it sufficiently dissimilar from defendant's horse as to render it copyrightable"⁷⁰

Minimal differences in fabric design,⁷¹ toy snowmen,⁷² theatrical and musical works,⁷³ and video games⁷⁴ have all been granted separate copyright protection. The courts in these cases have accepted any distinguishable variation resulting from an author's independent creative endeavor as constituting sufficient originality to confer copyright protection.⁷⁵ Under this standard, the deliberate creative addition⁷⁶ of color to a black-and-white film would probably be eligible for protection as a copyrightable derivative work.

Although the lack of an objective definition of originality in the 1976 Copyright Act has caused problems that were clearly foreseeable when it was enacted, Congress purposely omitted a definition because it desired to continue the standard established by the 1909 Act.⁷⁷ The House Report stated that the originality "standard did not include requirements of novelty, ingenuity, or [a]esthetic merit . . . [and] there [is] no intention to enlarge the standard of copyright protection to require them."⁷⁸ Congress sought to endow authors with protection for even minimal additions to a preexisting work. Thus, the addition of color to motion pictures should be considered to be a sufficient addition to satisfy the Act's originality requirement.

The courts in the previously described cases have required the "author" to meet a rather minimal standard of "originality."⁷⁹ However, reflecting the lack of a concrete statutory definition of the term, other courts have applied a much stricter standard and have denied copyright protection for original, but slightly different, derivative works. For ex-

70. *Blazon*, 268 F. Supp. at 422.

71. *See, e.g.*, *Covington Fabrics Corp. v. Artel Prods. Inc.*, 328 F. Supp. 202 (S.D.N.Y. 1971); *Peter Pan Fabrics, Inc. v. Dan River Mills*, 295 F. Supp. 1366 (S.D.N.Y.), *aff'd*, 415 F.2d 1007 (2d Cir. 1969).

72. *Eden Toys, Inc. v. Marshall Field & Co.*, 675 F.2d 498 (2d Cir. 1982).

73. *Leeds Music Ltd. v. Robin*, 358 F. Supp. 650 (S.D. Ohio 1973); *Brecht v. Bentley*, 185 F. Supp. 890 (S.D.N.Y. 1960). *Brecht* dealt with the separate copyrightability of a translation of a theatrical work. Section 103(b) of the Copyright Act allows a copyright for a derivative work in a translation. 17 U.S.C. § 103(b) (1982).

74. *M. Kramer Mfg. Co. v. Andrews*, 783 F.2d 421, 434-35 (4th Cir. 1986).

75. *M. Kramer Mfg.*, 783 F.2d at 438; *Eden Toys*, 675 F.2d at 500-01; *Leeds Music Ltd.*, 358 F. Supp. at 659-60; *Covington Fabrics Corp.*, 328 F. Supp. at 204; *Peter Pan Fabrics*, 295 F. Supp. at 1368; *Brecht*, 185 F. Supp. at 894.

76. *See supra* note 5.

77. H.R. REP. No. 1476, 94th Cong., 2d Sess. 51, *reprinted in* 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5664.

78. *Id.*

79. *See supra* note 75 and accompanying text.

ample, in *Gracen v. Bradford Exchange*,⁸⁰ an authorized painting based on frames from the movie *The Wizard of Oz* was denied copyright protection for lack of sufficient originality.⁸¹

In *L. Batlin & Son*,⁸² the court removed copyright protection from a plastic version of a public domain metal "Uncle Sam Bank."⁸³ Although the court quoted the originality standards of *Alfred Bell*, it added the standard of "true artistic skill"⁸⁴ to the recognizable contribution of the author.⁸⁵ The addition of "true artistic skill" seems to contradict the Supreme Court's reasoning in *Bleistein* that the courts should not be concerned with artistic merit. In *Bleistein*, Justice Holmes asserted:

It would be a dangerous undertaking for persons trained only in the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At one extreme some works of genius would be sure to miss appreciation. . . . At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge.⁸⁶

Has not a court acted as an arbiter of aesthetics if it determines "true artistic skill" in its decision? With a standard of true artistic skill, a conservative judge in the 1950's might have ordered copyright protection removed from the works of Jackson Pollack, Ellsworth Kelly, or Franz Kline for lack of sufficient originality.⁸⁷ In *Past Pluto Productions Corp. v. Dana*,⁸⁸ a case similar to *Batlin*, the court refused to allow green foam-rubber Statue of Liberty hats to be copyrighted because of a lack of origi-

80. 698 F.2d 300 (7th Cir. 1983).

81. *Gracen*, 698 F.2d at 305. The decision to deny copyright protection reflected the court's concern over future artists copying from subsequent copies rather than the original. *Id.* The court envisioned great difficulty in discerning the various artist's rights in multiple copy situations. *Id.* To avoid confusion, the court chose to deny copyright protection to the copies. *Id.*

82. 536 F.2d 486 (2d Cir. 1986).

83. *Id.* at 492.

84. *Id.* at 491.

85. *Alfred Bell*, 191 F.2d at 102-03 ("All that is needed is . . . that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.'").

86. *Bleistein*, 188 U.S. at 251-52.

87. For those unfamiliar, Pollack, Kelly, and Kline are/were painters from the New York School of Abstract Expressionism. Pollack was famous for his "splatter paintings" in which paint would drip on a canvas in a planned but random fashion. Kelly painted a number of totally monochrome canvasses. Kline painted broad black strokes on white backgrounds with housepaint. It could also be argued that the abstract expressionist copyrights should not have been granted protection under the doctrine of idea-expression merger. For a discussion of the doctrine of idea-expression merger, see *infra* notes 124-38 and accompanying text.

88. 627 F. Supp. 1435 (S.D.N.Y. 1986).

nality.⁸⁹ The court declined to find any "non-trivial originality deserving of protection under the federal copyright laws."⁹⁰

Holding that a green foam seven-inch crown is not sufficiently different from the enormous actual oxidized copper crown in New York Harbor is an absurdity. What the courts are really saying in cases like *Batlin* and *Past Pluto* is that they will not allow public domain American icons such as Uncle Sam and the Statue of Liberty to be monopolized by profit hungry manufacturers. The courts should have expressed their policy motives instead of expanding or misinterpreting previous copyright standards, thereby causing doctrinal confusion.⁹¹

In *M. Kramer Manufacturing, Inc. v. Andrews*,⁹² a video game case, the court distinguished *Batlin* by relying on the language of the Copyright Act.⁹³ The *M. Kramer* court then focused on use of the "true artistic skill" standard and limited it specifically to "works of art."⁹⁴ The court stated that:

It is true that *Batlin* does use the phrase "true artistic skill," but it was using it in connection with a copyright issued for a "work of art." No doubt the language was appropriate in that connection but it is not relevant where the work is copyrighted as "audiovisual works."⁹⁵

The definition of "audiovisual works" in section 101 and its interpretation in the decisions plainly differs from that of a "work of art" in the act.⁹⁶ Motion pictures are a subclassification of audiovisual works.⁹⁷ The *M. Kramer* court moved to a more relaxed standard of originality with respect to subject matter other than "works of art" as expressed in previous cases.⁹⁸

89. *Id.* at 1441-42.

90. *Id.* at 1442.

91. The court in *Past Pluto* was also concerned with the problem of the first derivative work "author" or "creator" preventing others from using the same public domain work. *Id.*; see also the "Mona Lisa" discussion in *Gracen*, 698 F.2d at 304, *infra* note 189 and accompanying text. The author of the first derivative work would argue that the author of the second derivative work copied the first derivative work and not the underlying work. Thus, the author of the first derivative work would attempt to sue the author of the second derivative work for copyright infringement.

92. 783 F.2d 421 (4th Cir. 1986).

93. *Id.* at 439 (citing 17 U.S.C. § 101).

94. *Id.* at 439 (citing *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486 (2d Cir. 1976)). The "Uncle Sam" bank in *Batlin* was registered with the Copyright Office as a "work of art." *Batlin*, 536 F.2d at 488.

95. *M. Kramer Mfg.*, 783 F.2d at 439.

96. For the definition of audiovisual works, see *supra* note 18 and accompanying text.

97. 17 U.S.C. § 101 (1982).

98. *M. Kramer Mfg.*, 783 F.2d at 440; see also *supra* notes 57-70 and accompanying text.

In one of the few recent cases involving the copyrightability of a motion picture derivative work of an underlying motion picture, *International Film Exchange, Ltd. v. Corinth Films Inc.*,⁹⁹ the court held that there was a separate copyrightable derivative work in an English language dubbed or subtitled version of a foreign film, even though the underlying Italian version of the film was in the public domain.¹⁰⁰ In another case, *Brecht v. Bentley*,¹⁰¹ a translation of a play was granted separate protection.¹⁰² Under the 1976 Act, a translation of a preexisting work can be copyrightable as a derivative work.¹⁰³

Clearly, translating any work requires a significant creative effort. Translations are not literal; they must be idiomatic. To convey the correct mood, word choice is crucial. In the case of a dubbed (as opposed to a subtitled) motion picture, even more creativity is necessary. The creative team must choose the dubbing actors so that their voices match the images and personalities of the characters on screen. The words then must be matched, as closely as possible, to the movements of the screen actors' lips. It is easy to see how originality is owed to the author in a dubbed film, and how the translated version would be a distinguishable variation.

By analogy, the same holds true for the colorized version of a motion picture. According to those involved in colorizing, the process is quite creative.¹⁰⁴ Hundreds of choices regarding color, tone and hue are made. It is a painstaking process involving many decisions and numerous people. Colorization is thus probably no less creative than translation. If translations are protected then "recasting" or "modifying" by colorizing should also be protected. In a colorization, the colorized version would owe its origin to the author and to the lay observer would be a distinguishable variation from the original work. Under most case law, that is sufficient to qualify for separate protection.¹⁰⁵

99. 621 F. Supp. 631 (S.D.N.Y. 1985). In *International Film*, a question arose over whether an English version of Vittorio de Sica's *Ladri di Biciclette* (*The Bicycle Thief*) (Produzioni de Sica 1948) had a separate copyright. *Id.* at 632-33.

100. *Id.* at 636; see also 17 U.S.C. §§ 101, 103 (regarding translations).

101. 185 F. Supp. 890 (S.D.N.Y. 1960).

102. *Id.* at 894.

103. 17 U.S.C. §§ 101, 103 (derivative works); see also *International Film*, 621 F. Supp. at 636.

104. See *supra* note 5.

105. See, e.g., *Gerlach-Barklow Co. v. Morris & Bendien, Inc.*, 23 F.2d 159, 161 (2d Cir. 1927) (distinguishable variation); *Alfred Bell*, 191 F.2d at 102-03 (more than a merely trivial variation).

IV. COPYRIGHT AND COLOR

There may be Copyright Office regulations that prevent a copyright from attaching to a colorized version of a work.¹⁰⁶ However, these regulations have generally been overlooked in case law. The Copyright Office regulations regarding registration are contained in two separate sections, 202.1 and 202.21.¹⁰⁷ Section 202.1 lists material that is not subject to copyright:

The following are examples of works not subject to copyright and applications for registration of such works cannot be entertained:

(a) Words and short phrases such as names, titles, and slogans; familiar symbols or designs; *mere variations* of typographic ornamentation, lettering, or *coloring*; mere listing of ingredients or contents.¹⁰⁸

Section 202.21 provides in pertinent part:

(a) [I]n any case where the deposit of identifying material is permitted or required under § 202.19 or § 202.20 of these regulations for published or unpublished works, the material shall consist of photographic prints, transparencies, photostats, drawings, or similar two-dimensional reproductions or renderings of the work, in a form visually perceivable without the aid of machine or device. *In the case of pictorial or graphic works, such material should reproduce the actual colors employed in the work. In all other cases, such material may be in black and white or may consist of a reproduction of the actual colors.*¹⁰⁹

The language in section 202.1(a) and in the last sentence of section 202.21(a) regarding "black and white . . . or a reproduction of the actual colors" could be construed to mean that copyright in black-and-white versions and copyright in color versions are mutually exclusive.¹¹⁰ The copyright applicant can have one or the other. It is interesting to consider whether a photographer, equipped with two cameras, one loaded with black-and-white film, the other with color film, who simultaneously

106. 37 C.F.R. §§ 202.1, 202.21 (1988).

107. *Id.* The Copyright Office on August 9, 1988 added the requirement that those parties submitting a colorized version of a work must also deposit a copy of the original black-and-white version. This requirement is to assist the Copyright Office in determining whether there is sufficient originality in the colorized version to support an independent copyright. 36 Pat. Trademark & Copyright J. (BNA) 370 (Aug. 11, 1988).

108. 37 C.F.R. § 202.1 (emphasis added).

109. *Id.* at § 202.21 (emphasis added).

110. *Id.* §§ 202.1, 202.21(a).

photographed the same scene in two versions would be granted separate copyright protection in both versions under section 202.21.

Although not directly referred to by regulation number, these regulations were probably relied on in *Uneeda Doll Co. v. Regent Baby Products*.¹¹¹ In *Uneeda Doll*, the plaintiff attempted to register two similar, but slightly differently colored dolls for separate copyrights.¹¹² The Copyright Office held that the two dolls were "devoid of copyrightable difference (since colors are, assertedly, not copyrightable . . .)."¹¹³ As a result, the Copyright Office would only register one of the dolls.¹¹⁴

Similarly, the court in *Storm v. Kennington, Ltd.*¹¹⁵ held that black-and-white illustrations produced from public domain color illustrations were unprotectable.¹¹⁶ However, the process in *Storm* is distinguishable from the process of colorization, for it can be argued that it is a less creative process to delete all color¹¹⁷ than it is to engage in all of the choices involved in coloring movies.

Most courts addressing the color issue seem to neglect or disregard the regulations entirely. Although the regulations appear to expressly indicate that colors are uncopyrightable, in *Sargent v. American Greetings Corp.*,¹¹⁸ in which the plaintiff had added colors to pencil line drawings, the court rejected defendant's argument that additions of "color *per se* does not constitute copyrightable subject matter."¹¹⁹ Similarly, in *Pantone, Inc. v. A. I. Friedman, Inc.*,¹²⁰ the court held that Pantone's mode of expression and arrangement of colors in its booklet of color gradient charts appeared to possess sufficient originality and uniqueness in its embodiment of its mode of expression to qualify for copyrightability.¹²¹

Professor Nimmer stated in his treatise that "an original combination or arrangement of colors should be regarded as an artistic creation capable of copyright protection."¹²² Nimmer concludes: "[t]hus, adding colors to a previously black and white picture may constitute an original

111. 355 F. Supp. 438 (E.D.N.Y. 1972).

112. *Id.* at 441.

113. *Id.*

114. *Id.*

115. 223 U.S.P.Q. (BNA) 790 (June 25, 1984).

116. *Id.* at 791-92.

117. Deleting all the color involves but a single choice and a single filtering process.

118. 588 F. Supp. 912 (N.D. Ohio 1984) (coloring children's character "Strawberry Shortcake").

119. *Id.* at 918.

120. 294 F. Supp. 545 (S.D.N.Y. 1968).

121. *Id.* at 548.

122. 1 M. NIMMER, *supra* note 31, § 2.14.

copyrightable contribution."¹²³

In the area of copyrightability and sufficiency of originality of colorization, the cases and the copyright statute lead to confusing results. There is no clear precedent, and the standard of originality often changes from case to case. Although it appears that colorized motion pictures are sufficiently different from the originals and therefore possess the requisite quantum of originality for separate protection, there is no certainty of result in this area. More certainty, either in the case law or the copyright statute, is necessary.

V. PROCESS OR EXPRESSION?

The colorization of black-and-white motion pictures is performed partly by creative human effort and partly by computer.¹²⁴ Each frame of a movie is not hand colored by an artist with a paintbrush. Section 102(a) of the Copyright Act grants protection to "original works of authorship fixed in any tangible medium of expression."¹²⁵ However, section 102(b) denies copyright protection to a "process."¹²⁶ The question then arises, is the colorization of motion pictures an expression or a process?

Apple Computer, Inc. v. Franklin Computer Corp.,¹²⁷ is illustrative of a number of recent cases in which courts have held that computer programs¹²⁸ are not to be denied copyrightability as a "process" or "system" precluded from registration under section 102(b).¹²⁹ Also, another court in *Apple Computer, Inc. v. Formula International, Inc.*,¹³⁰ stated that:

[A]ll computer programs . . . are designed to operate a machine in such a way as to ultimately produce some useful image to the user—that is their purpose (i.e., *to express*). Because of this, the fact that the works of the program are used ultimately in the implementation of a process should in no way affect copyrightability.¹³¹

123. *Id.*

124. *See supra* note 5.

125. 17 U.S.C. § 102(a) (1982).

126. *Id.* § 102(b).

127. 714 F.2d 1240 (3d Cir. 1983), *cert. denied*, 464 U.S. 1033 (1984).

128. Computer programs are classified as "audiovisual works." *See Stern Elecs., Inc. v. Kaufman*, 669 F.2d 852, 855 (2d Cir. 1982).

129. *See, e.g., Apple Computer*, 714 F.2d at 1250-51; *Atari, Inc. v. North American Phillips Consumer Elecs. Corp.*, 672 F.2d 607 (7th Cir. 1982).

130. 562 F. Supp. 775 (C.D. Cal. 1983), *aff'd*, 725 F.2d 521 (9th Cir. 1984).

131. *Id.* at 780 (emphasis in original).

A 1976 House Report reinforces this idea by explaining that the copyrightable element in a computer program is the *expression* and that the underlying method or process is not within the scope of copyright protection.¹³²

The holding in *M. Kramer Manufacturing, Inc. v. Snyder*¹³³ refers to the language of the 1976 Copyright Act, which expressly brings within the standards of copyrightability, communications made "with the aid of a machine."¹³⁴ As a result, the court found that the expression of a computer program was not precluded from copyright protection under the provisions of section 102(b).¹³⁵ Professor Nimmer has also concluded that written computer programs are copyrightable.¹³⁶

Since the computer program utilized to colorize the black-and-white film is protectable, it can be argued that the colorized version of the film is also protectable. The colorized film, which results from the commands of the programmer, the artist, and the computer, is the final expression of the computer program. If moving "blips" on a video game television screen, the expression of the computer program, are granted protection,¹³⁷ so should colorized video tapes of black-and-white motion pictures.

The question then arises, "what about the programmer's participation?" In the video game context, the *Stern* court held that the player's participation does not withdraw the audiovisual work from copyright eligibility.¹³⁸ By analogy, if copyright protection is given to the patterns on a video screen generated by the interaction of the player with the computer program, copyright protection probably should be given to the colors expressed on a video screen from the interaction of the video artist and his computer. That the colors are essentially computer generated should not preclude them from protection; nor should they be precluded because they are not purely computer generated.

VI. IDEA-EXPRESSION MERGER

The protection afforded by a copyright extends only to the particular expression of an idea, not to the idea itself.¹³⁹ In some cases, how-

132. H.R. REP. NO. 1476, 94th Cong., 2d Sess. 51, reprinted in 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5660-61.

133. 783 F.2d 421 (4th Cir. 1986).

134. 17 U.S.C. § 102(a).

135. *M. Kramer Mfg.*, 783 F.2d at 435.

136. 1 M. NIMMER, *supra* note 31, § 2.04[c].

137. *M. Kramer Mfg.*, 783 F.2d at 435.

138. *Stern*, 669 F.2d at 856; see also *M. Kramer Mfg.*, 783 F.2d at 437.

139. See *Mazer v. Stein*, 347 U.S. 201, 217 (1954); 17 U.S.C. § 102(b) (1982).

ever, the idea and the expression coincide. This occurs when the expression provides nothing new over the idea.¹⁴⁰ In copyright law, this phenomenon is known as the doctrine of idea-expression merger.¹⁴¹ When there is merger of the idea and the expression in a work, no copyright will issue.¹⁴² Additionally, copyright protection will not be granted to the expression of an idea if the idea behind the expression is such that it can be expressed in only a very limited number of ways.¹⁴³ This is to prevent an author from monopolizing an idea merely by copyrighting one of the very limited number of ways of expressing the idea.

The doctrine of idea-expression merger was stated by the Ninth Circuit in *Herbert Rosenthal Jewelry Corp. v. Kalpakian*.¹⁴⁴ The court held that a jewel encrusted bumble bee pin was an idea that was free to be copied, and not a protectable expression.¹⁴⁵ In denying the copyright owner's infringement claim the court held that "when the 'idea' and its 'expression' are thus inseparable, copying the expression will not be barred since protecting the 'expression' in such circumstances would confer a monopoly of the 'idea' upon the copyright owner."¹⁴⁶

The concerns in denying protection where there is merger of the idea and expression are twofold. First, the court does not want to convey a monopoly to an idea on the first party who happens to copyright one of the expressions of the idea.¹⁴⁷ Copyright law is not a first in time receives the monopoly situation, as is patent law.¹⁴⁸ Second, the courts want to

140. *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1168 (9th Cir. 1977).

141. For a discussion of idea-expression merger, see Francione, *Facing the Nation: the Standards for Copyright, Infringement, and Fair Use of Factual Works*, 134 U. PA. L. REV. 519, 573 n.265 (1986).

142. *Id.* Courts will deny total protection because mere ideas are not to be protected. See *Baker v. Selden*, 101 U.S. 99, 103 (1897) (copyrightability of accounting forms); *Donald v. Zack Meyer T.V. Sales & Service*, 426 F.2d 1027 (5th Cir. 1970), *cert. denied*, 400 U.S. 97 (1971) (copyrightability of guarantee clauses); *Past Pluto Prods. Corp. v. Dana*, 627 F. Supp. 1435 (S.D.N.Y. 1986) (copyrightability of Statue of Liberty hats); see also *Mazer v. Stein*, 347 U.S. 201, 217 (1954); 17 U.S.C. § 102(b) (1982).

143. *Toro Co. v. Railroad Prods.*, 787 F.2d 1208 (8th Cir. 1986). In *Morrissey v. Proctor & Gamble Co.*, 379 F.2d 675 (1st Cir. 1967), copyright protection was denied to the wording of a sweepstakes entry form because of the limited number of ways to express such an idea. *Id.* at 678-80. The court stated that copyright protection will be denied when "by copyrighting a mere handful of forms, [a party] could exhaust all possibilities of future use of the substance [of an idea]." *Id.* at 678.

144. 446 F.2d 738 (9th Cir. 1971).

145. *Id.* at 742.

146. *Id.* (citing *Baker v. Selden*, 101 U.S. 99 (1879); *Morrissey v. Proctor & Gamble Co.*, 379 F.2d 675, 678-79 (1st Cir. 1967)).

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

148. *Id.*

prevent litigants from bringing infringement lawsuits merely to harass, and to prevent the potential impediment to the "promot[ion] of [the] useful Arts"¹⁴⁹ that would follow.

One could argue that the colorization of a previously existing black-and-white motion picture with realistic hair colors, eye colors and flesh tones, is an "idea" that can only be expressed in a limited number of ways. It could also be argued that the expression of the idea cannot be separated from the idea itself; there are only so many shades of blue skies, green grass, and brown eyes. Because of the limited ways that different parties could express the idea, the idea and expression could be said to merge, thereby preventing protection from attaching to the colorized work.¹⁵⁰

It is foreseeable that a second party might decide to do a slightly different, but still realistically colored version of an already colorized public domain black-and-white film. In that case, the original colorizer could bring a copyright infringement suit, claiming that the subsequent colorizer was copying the original colorizer's film and not making a creative derivative work, independently based on the underlying black-and-white public domain film. Harassing lawsuits of this type are not one of the results that the copyright law was enacted to achieve.¹⁵¹

On the other hand, if one makes a surreal film using noncorresponding colors such as green hair, red eyes, orange skin, and purple lips, the requisite amount of originality would be found and the idea-expression dichotomy will be clear. There are limitless ways to vary the colors if they do not have to correspond to those colors occurring in nature!

VII. AESTHETIC CRITICISM, MORAL RIGHTS, THE LANHAM ACT AND UNFAIR COMPETITION

Although the primary emphasis of this Article is copyright law and not trademark or unfair competition, the Lanham Act¹⁵² and the doctrine of "moral rights" are briefly discussed in this section.

Much of the criticism relating to the colorization of motion pictures is aesthetically based.¹⁵³ Some of the most vocal critics of colorized films

149. U.S. CONST. art. I, § 8, cl. 8.

150. 17 U.S.C. § 102(b).

151. See *infra* notes 176-91 and accompanying text for a discussion of duration and harassing lawsuits.

152. 15 U.S.C. § 1125 (1982).

153. 133 Cong. Rec. 77, 1923 (1987). In addressing the House of Representatives, Richard Gephardt stated that:

Film is a uniquely American art form: we brought it to life, we made it talk, we used it to address our deepest social concerns. Classic feature films are a vital part of

are directors and members of the film industry.¹⁵⁴ It must be recalled, however, that aesthetic quality is not a copyright issue.¹⁵⁵ Copyright law deals with "originality" and "expression," not aesthetics.¹⁵⁶ Thus, aesthetic criticism will not prevent a copyright from being issued. If anything, such criticism can be evidence supporting the granting of a copyright because it points to originality.

Film director Martin Scorsese has stated: "A lot of film directors use color as a statement. In using a certain color in a frame you create an emotional and intellectual response in an audience When you colorize [the film] you change these responses."¹⁵⁷ Paradoxically, Scorsese's statement cuts quite strongly in favor of granting colorized motion pictures separate copyright protection as derivative works. To paraphrase him, the ordinary audience member is able to perceive a distinguishable variation, a changed response, when viewing a colorized version of a film. Thus, the colorized version would have sufficient originality to afford it copyright protection.¹⁵⁸

Although disenchanted directors and writers cannot bring actions under the copyright laws if they do not own the copyright in the underlying film, they could bring actions under the Lanham Act for unfair designation of origin¹⁵⁹ or under general principles of unfair competition if they believe that their films have been so changed by colorization that

America's living heritage. They have become one of the most potent voices through which one generation speaks to the next.

But these voices are now in danger of being muffled and distorted because the best films in America's library are threatened with colorization. What would our lives be like without the images we all share from black and white films.

. . . .
The potential abuses of colorization are endless. How would it be if some business executive decided that the start of "The Wizard of Oz" should be colorized, and the second half "de-colorized"? It would be like giving a disco beat to Louis Armstrong's classic jazz recordings, or taking Ansel Adams' photographs of Yosemite, and coloring the sky blue and the grass green.

Id.

154. See *supra* note 10.

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

156. See, e.g., *id.* at 249-50.

157. *ABC News Nightline* (ABC television broadcast, Nov. 11, 1986, Show No. 1427, Transcript at 5). In fact, Martin Scorsese's film, *Raging Bull*, (United Artists 1980) was deliberately shot in black-and-white for the cinematic effect of that medium.

158. 17 U.S.C. § 102(a) (1982).

159. 15 U.S.C. § 1125 (1982). Section 1125 of the Lanham Act provides in pertinent part:

Any person who shall affix, apply, or annex or use in connection with any goods or services or any container or containers for goods, a false designation of origin, or any false description or representation, including words or other symbols tending falsely to describe or represent the same, and shall cause goods or services to enter into commerce . . . shall be liable in a civil action . . . by any person who believes that he is or is likely to be damaged by the use of such false description or representation.

Id.

they do not accurately represent their creations.¹⁶⁰ Unfair competition, like trademark infringement, is a commercial tort for which an aggrieved party is due compensation.¹⁶¹ Unfair competition law protects against various unfair commercial acts.¹⁶² Examples of unfair competition include false advertising, copying of a business' name and unfairly benefiting from another's efforts.¹⁶³ To prevail in the case of motion pictures, there must be a serious alteration of the film¹⁶⁴ or a serious misrepresentation to the audience.¹⁶⁵ It is doubtful that colorization would rise to this level of actionable mutilation or cause this kind of audience confusion. Nevertheless, it could easily be anticipated that vociferous colorization critic Woody Allen might bring an unfair competition claim against anyone who attempted to colorize either *Zelig* or *Manhattan*.¹⁶⁶

The 1976 Copyright Act provides authors with separate finite rights, often referred to as a bundle of rights.¹⁶⁷ However, there are other rights that relate to artistic creations not recognized by American copyright law. The United States, unlike many European civil-law countries, does not recognize the doctrine of "moral rights" in artistic works.¹⁶⁸ Califor-

160. Trademark law is a subclass of the broader law of unfair competition. Trademark infringement is one kind of unfair competition. S. KANE, TRADEMARK LAW: A PRACTITIONER'S GUIDE 5 (1987).

161. 1 J. MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 1:3 (2d ed. 1984).

162. *Id.*

163. *Id.*

164. See *Gilliam v. A.B.C.*, 538 F.2d 14 (2d Cir. 1976). In *Gilliam*, an actionable mutilation was found when an American broadcaster excised approximately twenty-seven percent of the plaintiff's film to make the broadcast suitable for American audiences. *Id.* at 23-24. But see *Preminger v. Columbia Pictures Corp.*, 49 Misc. 2d 363, 267 N.Y.S.2d 594 (1966) ("implicit in grant of television rights is the privilege to cut and edit").

165. See, e.g., *Benson v. Paul Winley Record Sales Corp.*, 452 F. Supp. 516 (S.D.N.Y. 1978). In *Benson*, the court granted an injunction to prevent the sale of redubbed versions of a record made by an early band of which George Benson was a member. The court found that the record company planned to mislead the public by selling the redubbed records as new George Benson albums. *Id.* at 518.

166. However, since these films are still under copyright protection, colorization without permission would clearly violate the copyright owner's exclusive rights to reproduce, distribute and make derivative works. 17 U.S.C. §§ 106(1)-(3). If the unauthorized colorized version is also shown to audiences, the copyright owner's exclusive right of public performance would also be violated. *Id.* § 106(4).

167. 17 U.S.C. § 106(1)(1982) (right to reproduce work); *id.* § 106(2) (right to prepare derivative work); *id.* § 106(3) (right to distribute copies of works); *id.* § 106(4) (right to public performance); *id.* § 106(5) (right to public display).

168. The doctrine of moral rights, often referred to as "droit moral," affords an author with the power to prevent "distortion, mutilation, or misrepresentation of [his] work, and the right to prevent the use or representation of the author or his work in such a way as to injure his reputation." N. BOORSTYN, *Copyright Law* § 4:8 (1981). The moral rights of authors include: the right to claim authorship of the work in the form created; the right to prevent distortion, mutilation or misrepresentation of the work; the right to prevent the use of a representation of

nia and New York have enacted specific moral rights legislation, but those statutes are worded to exclude motion pictures either explicitly, as in New York,¹⁶⁹ or as "works for hire" and commercial productions, as in California.¹⁷⁰

Because the copyright laws do not protect authors, artists and other creators who do not own copyrights, there is less incentive for them to create.¹⁷¹ Under the law, only copyright owners may bring infringement actions.¹⁷² Courts, however, have occasionally granted relief to creators who do not own copyrights under other legal theories such as breach of contract and unfair competition.¹⁷³ For example, in *Granz v. Harris*, a record manufacturer omitted eight minutes of a jazz performance from a twelve inch record so that the performance would fit onto a smaller record.¹⁷⁴ The *Granz* court held that distribution of the edited version constituted unfair competition because it falsely represented the shortened record as the work originally presented by the producer, N. Granz.¹⁷⁵

the author or his work in such a way as to injure his reputation; the right to withhold a work from publication or display; and the right to withdraw a work from the public. *Id.* §§ 4:7-4:8. Although the United States has amended the Copyright Act to make it compatible with the Berne Convention, Congress has specifically elected not to adopt any of the Convention's provisions relating to moral rights. 7 Pat. Trademark & Copyright J. (BNA) 3 (Nov. 3, 1988). For a detailed discussion of authors' and artists' moral rights and American equivalents, see Diamond, *Legal Protection for the "Moral Rights" of Authors and Creators*, 68 TRADEMARK REP., 244, 245-46; see also Merryman, *The Refrigerator of Bernard Buffet*, 27 HASTINGS L.J. 1023 (1976); Comment, *Protection of Artistic Integrity, Gilliam v. American Broadcasting Cos.*, 90 HARV. L. REV. 473 (1976); Comment, *The Doctrine of Moral Right: A Study in the Law of Artists, Authors and Creators*, 53 HARV. L. REV. 554 (1940); Comment, *The Monty Python Litigation—of Moral Rights and the Lanham Act*, 125 U. PA. L. REV. 611 (1977).

169. N.Y. ARTS & CULT. AFF. LAW § 14.03 (McKinney Supp. 1986).

170. CAL. CIV. CODE § 987 (West Supp. 1988) (The California Art Preservation Act). If the New York and California statutes included motion pictures, they might be faced with the threat of federal preemption. It could be argued that the right to make a derivative work, granted by 17 U.S.C. § 103, would preempt any statutory protection which artists may receive under state law. In a case of direct conflict such as this, the federal right to make a derivative work should prevail. See Francione, *The California Art Preservation Act and Federal Preemption by The 1976 Copyright Act—Equivalence and Actual Conflict*, 31 COPYRIGHT L. SYMP. (ASCAP) 105 (1984).

171. 17 U.S.C. § 501(b). In addition to the creative incentive, "the economic incentive for artistic and intellectual creations . . . would be . . . undermined if authors were unable to prevent mutilation, distortion or misrepresentation" of their works. N. BOORSTYN, *supra* note 168 § 4:8.

172. 17 U.S.C. § 501(b).

173. See, e.g., *Gilliam*, 538 F.2d 14 (2d Cir. 1976) (editing of television show found to exceed scope of broadcaster's license); *Granz v. Harris*, 198 F.2d 585 (2d Cir. 1952).

174. *Granz*, 198 F.2d at 588-89.

175. *Id.* Subsequent recording of jazz sessions involving producer N. Granz carry the legend "original sessions produced by N. Granz."

VIII. THE RELATIONSHIP BETWEEN DURATION OF COPYRIGHT PROTECTION AND HARASSING LAWSUITS

Another possible concern in granting protection to colorized motion pictures is the duration of the copyright protection. For works created before 1978, copyright protection has a duration of twenty-eight years with an additional twenty-eight year term if registration is renewed in a timely manner.¹⁷⁶ All existing statutory copyrights in their first twenty-eight-year term on January 1, 1978, must be renewed or they will expire on the thirty-first of December of the twenty-eighth year.¹⁷⁷ Upon expiration, all copyright protection will be permanently lost.¹⁷⁸ Under the 1976 Copyright Act, the term of protection for works in their twenty-eight-year renewal term prior to January 1, 1978 are automatically extended for an additional nineteen years.¹⁷⁹ Therefore, the renewal term now becomes forty-seven years giving a total protection of seventy-five years from the date of the original copyright.¹⁸⁰

Since most black-and-white films were made before 1976,¹⁸¹ and in most cases before 1945, they are generally either in the public domain or are in their second term of copyright protection. Many of the older classics of the 1930's and 1940's will soon enter the public domain, at which time anyone can have access to and use of the films. For example, if a black-and-white classic was first copyrighted in 1940 and then renewed, it will enter the public domain in the year 2015.¹⁸² If a separate copyright was granted to a colorized version as a derivative work in 1985, it will have protection until 2060, a time when the underlying film will no longer have protection.¹⁸³ Once the black-and-white classic enters the public domain, anyone would be free to make another colorized version. If a second party decides to produce a different colorized version using the actual colors as they correspond to nature, it might be difficult to determine whether the second derivative work was copied from the public domain classic or was copied from the first colorized derivative work.¹⁸⁴ Numerous lawsuits that allege infringement and attempt to

176. 17 U.S.C. § 304 (1982).

177. *Id.* §§ 304(a), 305.

178. *Id.*

179. *Id.*

180. *Id.* § 305(b).

181. Black-and-white films produced after 1976 were made in black-and-white not because of the limitations or unavailability of the color medium, but because of the director's creative decision to make a black-and-white film.

182. 17 U.S.C. § 304.

183. *Id.* § 302.

184. This would lead to the type of confusion that the court in *Gracen v. Bradford Exchange*, 698 F.2d 300 (7th Cir. 1983) was concerned with. *Id.* at 305. The *Gracen* court feared

harass and enjoin those who may be creating legitimate copyrightable works are foreseeable.¹⁸⁵ For example, the court in *Gracen v. Bradford Exchange*¹⁸⁶ hypothesized about an artist who makes minor changes in a reproduction of the Mona Lisa and then sues another artist for copyright infringement who also produced a changed Mona Lisa.¹⁸⁷ According to the *Gracen* court:

If the difference between the original and A's reproduction is slight, the difference between A's and B's reproductions will also be slight, so that if B had access to A's reproductions, the trier of fact will be hard-pressed to decide whether B was copying A or copying the Mona Lisa itself.¹⁸⁸

In cases such as that posited by the *Gracen* court, there is a danger that the innocent artist will be blocked from engaging in his or her creative efforts. This chilling effect would run counter to the promotion of the useful arts as provided for in the Constitution.¹⁸⁹ It could be argued that as a policy measure the prevention of harassing lawsuits might be reason enough for not granting copyright protection to colorized versions of motion pictures. As Judge Oaks expressed in *L. Batlin & Son, Inc. v. Snyder*,¹⁹⁰ "to extend copyrightability to miniscule variations would simply put a weapon for harassment in the hands of mischievous copiers intent on appropriating and monopolizing public domain work."¹⁹¹

IX. PROPOSAL

The colorization controversy continues. The process and, of course, its result, have both proponents and opponents.¹⁹² Although the Copyright Office presently grants protection to colorized films,¹⁹³ copyright protection in any given work, including colorized films, may be revoked by a court.¹⁹⁴

that such an "entangling" of the various artists' rights would make it difficult or impossible for a trier of fact to decide whether the subsequent derivative work was derived from the original or from the first derivative work. *Id.* The court solved this problem by denying copyright protection to the derivative work. *Id.*

185. See *Sheldon*, 81 F.2d at 53-54.

186. 698 F.2d 300 (7th Cir. 1983).

187. *Id.* at 304.

188. *Id.*

189. U.S. CONST. art. I, § 8, cl. 8.

190. 536 F.2d 486 (2d Cir. 1976).

191. *Id.* at 492 (copyright not granted plastic Uncle Sam bank because of lack of sufficient originality).

192. 133 Cong. Rec. 77, 1922 (1987).

193. See *supra* note 13 and accompanying text.

194. See, e.g., *Baker v. Selden*, 101 U.S. 99 (1879) (copyright revoked because of merger of

Colorization is a new and innovative process. It is also a process that probably was not contemplated by Congress when it enacted the Copyright Act of 1976. Congress should be called upon to "take a fresh look at this technology just as it so often has examined other innovations in the past."¹⁹⁵ Since the 1976 Copyright Act was enacted, Congress has made alterations and modifications to address special needs as they have arisen.¹⁹⁶ Specifically, section 117 was added to handle the problems associated with the sale of computer software,¹⁹⁷ and section 109(b) was added to deal with the rental of phonograph records.¹⁹⁸

Since it is unlikely that Congress foresaw the colorization of black-and-white films when it enacted the 1976 Act, it should make specific provision for it now. This would end the uncertainty and confusion, and would probably prevent countless future copyright litigation battles.¹⁹⁹

Additions to the copyright statute might read as follows:

In Favor of Copyright Protection:

Section 101. A "derivative work" is a work based upon one or more preexisting works, such as a *colorization of a black-and-white audiovisual or graphic work*, translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgement, condensation, or any other form in which a work may be recast, transferred or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which as a whole represent an original work of authorship, is a "derivative work."

Opposed to Copyright Protection:

Section 102(c). In no case does copyright protection for an original work of authorship extend to any change from a black-and-white pictorial, graphic or audiovisual work to its realistic representational colors, or to a change from the actual colors to a black-and-white version thereof.

idea and expression); *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905 (2d Cir. 1980) (copyright protection revoked for lack of originality).

195. *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 456 (1984). The *Sony* Court also stated, "[t]he direction of Art. I is that Congress shall have the power to promote the progress of science and the useful arts. When, as here, the Constitution is permissive, the sign of how far Congress has chosen to go can come only from Congress." *Id.* (citing *Deepsouth Packing Co. v. Laitram Corp.*, 406 U.S. 518, 530 (1972)).

196. *See, e.g.*, 17 U.S.C. §§ 109(b), 117 (1982).

197. 17 U.S.C. § 117 (1988).

198. *Id.* § 109(b).

199. However, there could still be litigation regarding the artistic changes and editing under the Lanham Act. *See supra* notes 152-75 and accompanying text.

As Professor Chafee has stated, "legal rules should be convenient to handle. . . . The rules should be certain, readily understood, not unduly complicated, and as easy as possible to apply."²⁰⁰ To this end, Congress should amend the present Copyright Act to provide a clear rule for the courts and the Copyright Office to follow.

X. CONCLUSION

Under present copyright law, it is not certain whether colorized motion pictures should be granted copyright protection—the applicable standards are unclear. Depending on the degree of originality required, there may or may not be protection.²⁰¹ However, under the majority of cases, the requisite quantum of originality appears to be met and copyright protection would be granted to colorized films.²⁰²

Under the idea-expression analysis, protection would probably not be granted.²⁰³ The expression would be found to be inseparable from the idea. After all, there are only so many ways that a black-and-white film can realistically be colored.

Under the computer program line of cases, protection probably would be granted.²⁰⁴ The colorized videotape would be found to be merely the expression of a computer program, and thus copyrightable.

Under a strict reading of the copyright registration regulations regarding color,²⁰⁵ it is not clear whether a copyright would be granted; however, *if* colorization is determined to be an arrangement of colors, copyright protection may adhere.²⁰⁶

There are also conflicting policy reasons for and against granting copyright protection to a colorized work. The copyright law and the Constitution seek to encourage artistic creativity—not hinder it.²⁰⁷ Pro-

200. Chafee, *Reflections on The Law of Copyright*, 45 COLUM. L. REV. 503, 514 (1945). The word "rules" here includes statutory and judge-made provisions as well as administrative regulations. *Id.*

201. See *supra* notes 36-105 and accompanying text for a discussion of the originality requirement.

202. See, e.g., *M. Kramer Mfg. Co. v. Andrews*, 783 F.2d 421 (4th Cir. 1986); *Eden Toys, Inc. v. Florelee Undergarment Co.*, 697 F.2d 27 (2d Cir. 1982); *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951).

203. See *supra* notes 124-38 and accompanying text for a discussion of the doctrine of idea-expression merger.

204. See *supra* notes 127-38 and accompanying text for a discussion of the copyrightability of expression generated by a computer program.

205. 37 C.F.R. §§ 202.1, 202.21 (1988).

206. See *supra* notes 106-10 and accompanying text for a discussion of copyright registration regulations relating to colors.

207. Artistic creation is encouraged by providing the author, for a limited time, with the exclusive rights to his work. U.S. CONST. art. I, § 8, cl. 8; 17 U.S.C. § 106 (1982).

tection is an incentive to authors and artists to create. If protection is granted, millions of people will see new artistic creations in the form of colorized versions of films. In competitive markets, such as television, the creative and original should be rewarded and encouraged. On the other hand, since the colorizers have copyright protection now, and probably for thirty years in the copyright of the underlying films, they can reap the economic rewards of their investments and efforts. It may be argued that to extend protection to these works for another seventy-five years because of a technological advancement might transcend the bounds of protecting the works "for limited [t]imes" as provided by the Constitution.²⁰⁸ Also, there is nothing to prevent the colorizers in 2059 from developing another technological innovation of "sufficient originality" to lock-up protection for another seventy-five years into the twenty-second century. By then, most, if not all, of the underlying works would be in the public domain. If protection is granted, as expressed in *L. Batlin & Son, Inc. v. Snyder*²⁰⁹ and *Gracen v. Bradford Exchange*,²¹⁰ the danger of harassing copyright infringement suits would loom ahead.²¹¹

The simplest solution for the disgruntled home viewer of colorized classic motion pictures is to turn off the color on the television set. The film community, however, must find its solace in clarified copyright laws.

208. U.S. CONST. art. I, § 8, cl. 8.

209. 536 F.2d 486 (2d Cir. 1976).

210. 698 F.2d 300 (7th Cir. 1983).

211. See *supra* notes 176-91 and accompanying text.

