A FILM OF A DIFFERENT COLOR: COPYRIGHT AND THE COLORIZATION OF BLACK AND WHITE FILMS*

I. INTRODUCTION

Progress in the field of computer technology has led to the development of patented processes which add color to films and television programs originally produced in black and white.[1] The companies producing color versions of black and white films (the "colorists"),[2] as well as motion picture studios and other owners of copyrights in black and white films (the "copyright proprie-

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1 Harris, *No Black and White Answers to Colorization Copyright Debate*, Variety, Sept. 11, 1985, at 2, col. 1. The two companies in the forefront of this technology are Colorization, Inc. and Color Systems Technology, Inc. Bennetts, *'Colorizing' Film Classics: A Boon or a Bane?*, N.Y. Times, Aug. 5, 1986, at A1, col. 5.

2 Colorization, Inc.'s first major project was the colorization of the 1937 film *Topper*. Colorization, Inc. began selling this film on the home video market in 1985. Huntington, *Black and White in Color*, SATURDAY REV., Nov./Dec. 1985, at 10. Colorization, Inc. is owned by International HRS and Hal Roach Studios, Inc. Telephone interview with Victor White, Former Senior Vice President of Hal Roach Studios, Inc. (Jan. 6, 1986). Hal Roach Studios owns an extensive library of film classics (including most of the Laurel and Hardy films) and intends to use the facilities of Colorization, Inc. primarily to colorize these films. White, *supra*; *see also* Onosko, *Hollywood Alchemy: Black & White Classics are Being Colorized. Is This Progress?*, VIDEO, May 1986, at 57. Colorization, Inc. has also contracted to colorize some of the films owned by Otto Preminger Films, Linfield, *The Color of Money*, AM. FILM, Jan./Feb. 1987, at 29, 30; Bennetts, *supra* note 1, at C14, col. 3, and it colorized the public domain film, *It's A Wonderful Life*. *E.g.*, Onosko, *supra*, at 57. The colorization of *It's A Wonderful Life* has been accompanied by protests from Frank Capra, the film's director. *See infra* note 209.

Color Systems Technology, Inc. converted the classic *Miracle on 34th Street* to color and it was first broadcast during the 1985 Thanksgiving and Christmas holiday season. *A "Miracle" of Technology*, N.Y. Times, Nov. 27, 1985, at C22, col. 5. Color Systems has also completed work on *The Absent Minded Professor* for Walt Disney Studios and *Yankee Doodle Dandy*. Wallace, *Giving New Life to Old Movie Classics*, PUBLISHERS WEEKLY, June 6, 1986, at 32, 34. The broadcast of Color Systems' version of *The Maltese Falcon*, created under contract with the Turner Entertainment Company, was accompanied by protests and calls for boycotts by the film's director, John Huston. Robb, *Huston Blasts Colorizing*, Variety, Nov. 19, 1986, at 4, col. 5; Harmetz, *Huston Protests Coloring of 'Falcon'*, N.Y. Times, Nov. 14, 1986, at C36, col. 1. Color Systems Technology, Inc. has contracted to convert to color one hundred films from the MGM library for the Turner Entertainment Company, and sixteen Shirley Temple movies for Disney studios. Galbraith, *Color Process Revives Vintage B&W Films Like 'Yankee Doodle;' MGM, Disney Sell Off TV Rights*, Variety, Mar. 12, 1986, at 2, col. 1. Color Systems was responsible also for coloring the original Alfred Hitchcock introductory and closing vignettes for the updated series *Alfred Hitchcock Presents* that was aired by the NBC network during the 1985-86 season. Telephone

tors"), foresee that "colorization"[3] will revive interest in films of the past.[4] The colorists and the copyright proprietors expect to generate large revenues from sales of color enhanced films in the television syndication and home video markets.[5] They are interested in protecting their investments, as well as the potential for large economic gains, from dilution by infringers.[6] Therefore, they claim that under the laws of copyright,[7] the colorists' additions of color to black and white films are original works of authorship,[8] creating derivative works,[9] to be accorded the exclusive rights[10] and remedies[11] provided by copyright.

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interview with Charles Powell, Executive Vice President of Color Systems Technology, Inc. (Feb. 24, 1986).

[3] "Colorization" is a trademark of Colorization, Inc. This term will be used generically throughout this Note as a noun, and in verb form, as it has become a part of film industry jargon.

[4] Black and white films have been rejected by average movie audiences which prefer the "realism" of color. *High-tech facelift for film classics*, U.S. NEWS & WORLD REP., Mar. 31, 1986, at 68; *see also* Armstrong, *Now they're using computers to color black-and-white movies*, Christian Science Monitor, Oct. 16, 1984, at 25, col. 3. Colorization, Inc. claims that a marketing survey shows that eighty-five percent of viewers prefer to view movies in color. Linfield, *supra* note 2, at 30; Wallace, *supra* note 2, at 32.

Color film was invented toward the beginning of this century, Onosko, *supra* note 2, at 56, but was first introduced on a widescale basis in the 1940's. L. GIANNETTI, UNDERSTANDING MOVIES 26 (2d ed. 1976). Since then, the popularity of color motion pictures has grown so that virtually all films are now produced in color. L. GIANNETTI, *supra*, at 26 (black and white film is used occasionally in modern films to evoke the "milieux" of early motion pictures); *see also* Huntington, *supra* note 2, at 10. Additionally, most homes are equipped with color televisions, *see* Kindel, *Good-bye, TV Hello, video*, FORBES, July 1, 1985, at 100, with television being the preferred medium for viewing films, especially old films. Linfield, *supra* note 2, at 32; Sanburn, *The Race to Save America's Film Heritage*, LIFE, July 1985, at 68, 80. Since black and white films were considered to have little economic value, most were shelved, or, if considered "classics," relegated to late night movie broadcasts and film retrospectives. Lilienthal, *Old Movies Grow Up: The Changing Role of Public Domain Video*, PUBLISHERS WEEKLY, Dec. 6, 1985, at 51. Owners often ignored these films and failed to renew the copyrights, thereby allowing the films to enter the public domain, Lilienthal, *supra*, therefore making it possible for colorists to capitalize on this free market of films.

[5] Bennetts, *supra* note 1, at A1, col. 5, & C14, col. 3. The broadcasts of the color version of *Miracle on 34th Street* have generated at least $1,000,000, Schmuckler, *Play it again, Sam . . . in color*, FORBES, Feb. 10, 1986, at 117-18, and earned for its copyright proprietor, Twentieth Century-Fox, approximately $600,000. FORTUNE, Mar. 3, 1986, at 45. The broadcasts have also garnered ratings equivalent to the most widely viewed television events. Onosko, *supra* note 2, at 54.

[6] *See infra* text accompanying notes 79-80.

[7] The Constitution of the United States grants Congress the ability to promulgate laws "[t]o promote the Progress of Science and the useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8, cl. 8. Such laws, pertaining to authors, are now embodied in the Copyright Act of 1976, 17 U.S.C. §§ 101-914 (1982 & Supp. III 1985) [hereinafter 1976 Copyright Act].

[8] *See* 17 U.S.C. § 102(a).

[9] *Id.* § 103. The 1976 Copyright Act defines a derivative work as "a work based upon one or more preexisting works . . . . A work consisting of . . . modifications which, as a whole, represent an original work of authorship . . . ." *Id.* § 101.

[10] *Id.* § 106.

[11] *Id.* §§ 501-505.

Colorization has also led to renewed vigor in the call for moral rights legislation to prevent the alteration of the original black and white creations.[12] Members of the film community[13] believe that colorization will destroy the original filmmakers' visions as captured in black and white, and that new audiences will be deprived of viewing the artistry of black and white filmmaking.[14] At least one director has sought the authority of the Copyright Office for the protection of his work;[15] however, the United States does not recognize moral rights in its copyright statute.[16] Under the present law, original filmmakers can protect the integrity of their creations only if they are the copyright owners.[17] Once original filmmakers transfer their proprietary interests in the copyrights, they lose the ability to protect the integrity of their films, or to control future disposition of the films.[18] Courts, at times, have granted artists protections, similar to moral rights, under the guise of other laws.[19] Therefore, original filmmakers may be able to protect their films from colorization by using the limited claims available under these judicial precedents.[20]

Copyright protection for colorized films and moral rights protection for original black and white films encompass two distinct, yet overlapping, issues concerning valuable rights. This Note will begin by addressing the issue of whether colorists can expect to receive copyright protection for their endeavors,[21] and

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12 Bennetts, *supra* note 1, at A1, col. 3.

13 The major artist guilds, and many other entertainment oriented organizations, have released official protests against colorization. *Actors Guild Comes Out Against Film Colorizing*, Variety, Nov. 19, 1986, at 6, col. 5 (Screen Actors Guild); *Natl. Arts Council Raps Colorization*, Variety, Nov. 5, 1986, at 3, col. 5 (National Council on the Arts); *Directors Guild Takes Official Stand Against Film Colorization*, Variety, Oct. 22, 1986, at 6, col. 1 (Directors Guild of America); *Cinematographers Register Opposition to Pic Colorization*, Variety, Oct. 15, 1986, at 5, col. 2 (American Society of Cinematographers); *AFI Squares Off Against Colorization: Calls for Pros to Get Together*, Variety, Oct. 8, 1986, at 5, col. 3 (American Film Institute); *Writers, 2 Locals Join Directors in Colorization War*, Variety, Oct. 8, 1986, at 5, col. 4 (Writers Guild of America West, Hollywood locals of the Int'l Alliance of Theatrical Stage Employees, Camera Local 659, and Costume Designers Local 892). Many film critics also have expressed their objections. *See, e.g.*, Corliss, *Raiders of the Lost Art*, TIME, Oct. 20, 1986, at 98; Canby, *Through a Tinted Glass, Darkly*, N.Y. Times, Nov. 30, 1986, § 2, at 19, col. 1; Canby, *'Colorization' Is Defacing Black and White Film Classics*, N.Y. Times, Nov. 2, 1986, § 2, at 1, col. 1 [hereinafter *'Colorization'*].

14 *See infra* notes 209-14 and accompanying text.

15 Letter from Frank Capra to Dorothy Schrader, General Counsel to the Copyright Office of the Library of Congress (Dec. 13, 1984) [hereinafter Capra Letter]; *see also infra* note 210.

16 *See infra* notes 214, 219-27, 232 and accompanying text.

17 *See infra* note 76.

18 *See infra* note 215 and accompanying text.

19 *See infra* notes 216-17, 255-324 and accompanying text.

20 *See infra* notes 216-17 and accompanying text.

21 The Copyright Office of the Library of Congress has been considering the question of the registrability of colorized films. Telephone interview with Dorothy Schrader,

will argue that the results of colorization are copyrightable as derivative works. However, the copyrights to be accorded to colorized films must be limited solely to the arrangements of color that are the products of the colorists' original intellectual endeavors.

This Note will then focus on moral rights and how original filmmakers may protect their black and white creations from colorization. This section will explain why it is unlikely that specific legislation will be enacted to protect films from the colorization process. It will conclude that only those filmmakers who have retained the right to approve alterations, or those who can prove a violation of section 43(a) of the Lanham Act,[22] will be able to protect the integrity of their films from the addition of color.

II. COPYRIGHT PROTECTION FOR THE RESULTS OF COLORIZATION

Motion pictures[23] are considered works of authorship and are enumerated in the list of subjects protected by the 1976 Copyright Act.[24] Whether the contributions of color to films are also copyrightable works of authorship[25] is a question pertinent to the public's interest of promoting progress in intellectual endeavors.[26] Copyright confers a property right upon its proprie-

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General Counsel to the Copyright Office of the Library of Congress (Nov. 22, 1985). In a Notice of Inquiry, dated August 20, 1986, the Copyright Office issued a request for "public comment, views, and information which will assist the Copyright Office in developing its practices regarding colorization and may lead to proposals to amend the regulations." Registration of Claims To Copyright Notice of Inquiry; Colorization of Motion Pictures, 51 Fed. Reg. 32,665 (1986) [hereinafter Notice of Inquiry]. *See infra* text accompanying notes 190-200.

22 15 U.S.C. § 1125(a) (1982).

23 Hereinafter the term "films" is used throughout this Note to denote motion pictures and other audiovisual works that may be the subjects of colorization.

24 17 U.S.C. § 102(a)(6) (1982).

25 The Copyright Office Rules and Regulations state that "[t]he following are examples of works not subject to copyright and applications for registration of such works cannot be entertained: . . . mere variations of . . . coloring . . . ." 37 C.F.R. § 202.1(a) (1985).

26 The purpose of copyright is to give the author an economic reward as an incentive for furthering literary and artistic endeavors. Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 429 (1984); *cf.* Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975) ("The immediate effect of our copyright law is to secure a fair return for an 'author's' creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good."); Mazer v. Stein, 347 U.S. 201, 219 (1954); Fox Film Corp. v. Doyal, 286 U.S. 123, 127-28 (1932); 1 M. NIMMER, NIMMER ON COPYRIGHT § 1.03[A], at 1-31 to -32 (1986) [hereinafter NIMMER]. The public purpose and the economic reward are closely related, because "[m]any authors could not devote themselves to creative work without the prospect of remuneration." Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law 6 (1961), *reprinted in* 2 STUDIES ON COPYRIGHT LAW 1206 (A. Fisher mem. ed. 1963).

tor.[27] This property right takes the form of a limited monopoly[28] over an original intellectual creation that is fixed in a tangible form.[29] If colorists are to receive the economic benefits of copyright, their contributions must display a sufficient amount of original expression, which is the result of intellectual labor,[30] that signifies a change from the prior works on which they are based.[31] Only then can the colorists' contributions be labeled works of authorship that are copyrightable as derivative works.

A. *The Impact of Color and the Colorization Process on Black and White films*

1. Color

Color is part of nature or "reality"; therefore, black and white films are considered to be stylized depictions of nature.[32] Although many filmmakers believe that color can be distracting to audiences, and that black and white photography affords actors and directors a better medium for artistic expression,[33] lack of color prevents the achievement of total reality, a goal towards which the American cinema often strives.[34] In the early days of

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[27] 1 NIMMER, *supra* note 26, § 1.03[A], at 1-32.1.

[28] *Sony Corp.*, 464 U.S. at 429. A monopoly over a work is created by the exclusive rights accorded in 17 U.S.C. § 106 (1982):

> [T]he owner of copyright . . . has the exclusive rights to do and to authorize any of the following:
> (1) to reproduce the copyrighted work in copies or phonorecords;
> (2) to prepare derivative works based upon the copyrighted work;
> (3) to distribute copies or phonorecords of the copyrighted work to the public . . . ;
> (4) . . . to perform the copyrighted work publicly; and
> (5) . . . to display the copyrighted work publicly.

The monopoly is limited by 17 U.S.C. §§ 107-118, which: detail the way copyrighted works may be used without infringement occurring; impose compulsory licenses for certain uses; and define the scope of the copyright in certain copyrightable works. Olson, *Copyright Originality*, 48 MO. L. REV. 29, 33 (1983). The monopoly is further encumbered by the durational limitations of copyright. 17 U.S.C. §§ 302-305.

[29] 17 U.S.C. § 102(a). Though "[m]otion pictures and other audiovisual works are most often embodied in film[,]" 1 NIMMER, *supra* note 26, § 2.09[D][1], at 2-130, these cinematographic works may be set down in other tangible forms including videotape. 17 U.S.C. § 101 (definition of audiovisual works); H.R. REP. NO. 1476, 94th Cong., 2d Sess. 56, *reprinted in* 1976 U.S. CODE CONG. & ADMIN. NEWS 5659, 5669 [hereinafter H.R. 1476]. Colorized films are fixed in the audiovisual medium of videotape. *See, e.g.*, Armstrong, *supra* note 4, at 25, col. 3.

[30] Trade-Mark Cases, 100 U.S. 32, 94 (1879); 1 NIMMER, *supra* note 26, § 1.06[A], at 1-37.

[31] *See* 17 U.S.C. § 101 (definition of derivative works).

[32] K. ROBERTS & W. SHARPLES, JR., A PRIMER FOR FILM-MAKING 110 (1st ed. 5th printing 1976). Prior to widespread availability of color, many early filmmakers depicted reality as best they could with the limited resources available to them.

[33] Winston, *A Whole Technology of Dyeing: A Note on Ideology and the Apparatus of the Chromatic Moving Image*, 114 DAEDALUS: J. AM. ACAD. ARTS & SCI. 105, 119 (Fall 1985).

[34] *Id.* at 109 (quoting Natalie Kalmus, the wife of the "inventor" of Technicolor,

the film industry, some filmmakers used the laborious process of hand-tinting to create the sense of reality which they felt was missing from black and white films.[35]

Filmmakers also use color for expressionistic purposes. By manipulating colors, various moods and emotions can be subliminally suggested, adding drama or symbolism to films.[36] Consequently, debate often arises as to whether color adds realism or expression to the filmed image.[37] If a colorist were to use expressionistic techniques when creating a colorized version of a black and white film, the result would be a distinctive change from the expression which the original film conveyed. In such a case, the use of color would be a substantial contribution to the film, as evidenced by the colorist's intentional change in meaning, and there would be little question as to the copyrightability of this new work.[38]

However, colorists employ colorization to add aesthetic realism to films, while retaining the original filmmakers' expressions.[39] Therefore, when colorists use colors that are facts derived directly from the film itself,[40] or from other sources which identify the colors missing from the screen images,[41] the copyrightability of the contributions are less clear.

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from Kalmus, *Colour Consciousness*, J. SEMPE 139 (Aug. 1935)); *see also* K. ROBERTS & W. SHARPLES, JR., *supra* note 32, at 111. *But cf.* Winston, *supra* note 33, at 119 (some films tend to use color to signify spectacle or fantasy, as illustrated by the film *The Wizard of Oz*, which used black and white for the scenes in Kansas and color for the scenes in Oz). Even using color motion photography the filmmaker cannot achieve a perfect rendition of nature because color film can only approximate the actual colors which it photographs. L. GIANNETTI, *supra* note 4, at 26; *see generally* Winston, *supra* note 33.

35 Onosko, *supra* note 2, at 56; *see also* K. ROBERTS & W. SHARPLES, JR., *supra* note 32, at 111; L. GIANNETTI, *supra* note 4, at 26; Chittock, *How to Put Colour Into Old Movies*, Fin. Times, Aug. 21, 1984, at 20, col. 5 (description of the hand-tinting process). Although color film was invented early in this century, *see supra* note 4, its use was originally limited because it was technically cumbersome and expensive to use. For a detailed description of the history of color motion picture film, see Winston, *supra* note 33.

36 K. ROBERTS & W. SHARPLES, JR., *supra* note 32, at 111-12; L. GIANNETTI, *supra* note 4, at 26-28.

37 S. NEALE, CINEMA AND TECHNOLOGY: IMAGE, SOUND, COLOUR 145-51 (1985).

38 The colorist's contribution of expression is easily viewable when comparing the original film with the colorized version. However, when deciding the copyrightability of a work, the test for originality does not depend on an immediately recognizable difference between two works. Such standard is part of the ordinary observer test of substantial similarity used to determine copying in infringement cases. *E.g.*, Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487 (2d Cir. 1960).

39 The colorists intent is to preserve "the spirit of the old works 'in their original form.'" Cox, *Film-Tinting Fight Raises Questions of Copyright Law: Hollywood Sees Red Over Computer-Aided Versions of Classics, the Money of Color*, L.A. Daily J., Nov. 10, 1986, at 1, col. 6 (quoting Rob Ward, Vice President for Creative Affairs for Hal Roach Studios, Inc.); *see also infra* notes 53-58 and accompanying text.

40 *See infra* text accompanying notes 47 & 56.

41 *See infra* note 57 and accompanying text.

Colorization may be considered a novel process; however, copyright encompasses originality which is distinct from novelty.[42] Whether the colorists' additions deserve copyright protection can be decided only upon finding that the colorists have made contributions of expression when culling information from the public domain, and by exercising discretion while superimposing the colors on the original film images to create a product distinct from the original film.[43]

2. The Colorization Process

The two major companies involved in the colorization process[44] use similar techniques when colorizing films.[45] The first step requires the transfer of the black and white film to videotape. Next, a computer electronically scans the first frame of a scene and separates the frame into 525,000 "pixels",[46] each pixel representing a portion of the picture. A sensing device is sometimes used to read the values of the blacks, whites, and grays to determine what colors were originally photographed.[47] However, often the colors of sets, make-up, and clothes were chosen to give the best rendition in black and white, and would not have been used had the film been photographed in color.[48] In such cases, new colors must be assigned by the colorists.[49] Once the correct colors are determined by the colorist, the pixels are colorized by using signals representing colors from an electronic palette.[50] The computer will continue to color the rest of the

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42 Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 102. Novel processes are covered by the Patent Act of 1952, 35 U.S.C. § 102 (1982).

> The novelty of the art or thing described or explained has nothing to do with the validity of the copyright. . . . The claim to an invention or discovery of an art or manufacture must be subjected to the examination of the Patent Office before an exclusive right therein can be obtained; and it can only be secured by a patent from the government.

Baker v. Selden, 101 U.S. 99, 102 (1879).

43 *See infra* note 66-75 and accompanying text.

44 *See supra* note 1.

45 Linfield, *supra* note 2, at 30; Elmer-DeWitt, *Play It Again, This Time in Color*, TIME, Oct. 8, 1984, at 83. The two companies claim to have different approaches to colorization. Color Systems Technology looks for complete authenticity, while Colorization, Inc. tries to achieve a "modern look." Linfield, *supra* note 2, at 30. For a detailed explanation of the colorization process, see Onosko, *supra* note 2, at 56-57.

46 Rebello, *Black and White in Color*, AM. FILM, Apr. 1984, at 13. The American television screen is divided into 525,000 pixels, or micro-dots of information. Each is smaller than a pinpoint. White, *supra* note 2.

47 "All colors photograph as different magnitudes of black." White, *supra* note 2.

48 Colorization, Inc. claims that certain films were photographed using green make-up and sets. Onosko, *supra* note 2, at 57.

49 White, *supra* note 2; *see also* Armstrong, *supra* note 4, at 25, col. 4.

50 White, *supra* note 2.

scene, making changes which follow movement. The colorist then reviews the scene and assigns new colors where major changes in the scene occur.[51]

According to the colorists, there is "considerable freedom" of choice when colorizing films;[52] however, colorization was designed primarily to achieve aesthetic accuracy. The colorists' aim is to create a convincing color rendition of a black and white film[53] which will appeal to audiences who prefer their films in color. This seems to indicate that colorists are limited in their color options.[54]

One company employs a staff of researchers which evaluates each scene of a film for color cues.[55] The dialogue of the film, as well as the costumes and other familiar objects within a scene may give clues as to the correct colors.[56] To maintain the historical accuracy of colors, these researchers must scrutinize the contents of archives, and other sources, to find the correct colors for a film.[57] The process of color correction is facilitated when the colorists receive direction from the original filmmakers,[58] but such assistance is not always available when filmmakers are no longer alive or refuse to give assistance.[59]

The extensive use of computers, and information derived from public domain sources, gives rise to the debate concerning whether copyrights should be extended to the color arrangements produced by colorization.

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51 *Id.*; *see also* Chittock, *supra* note 35, at 20, col. 5.

52 Elmer-DeWitt, *supra* note 45, at 83. The inventor of the process patented by Colorization, Inc. claims that "color selection for a scene is essentially arbitrary . . . ." Onosko, *supra* note 2, at 57.

53 *See* Wallace, *supra* note 2, at 34.

54 " '[S]ometimes our options *are* limited by the original.' " Cox, *supra* note 39, at 1, col. 6 (quoting Joseph A. Adelman, Senior Vice President of Color Systems Technology, Inc.) (emphasis in original). Within these limitations the colorists have discretion as to shading, basing their choices on realism, audience appeal, or tone of the period. *See* Wallace, *supra* note 2, at 34; Cox, *supra* note 39, at 20, col. 2.

55 Onosko, *supra* note 2, at 56.

56 *Id.*

57 For example, during the coloring of *Miracle on 34th Street*, Color Systems Technology's researchers checked the archives of Macy's Department Store for color photographs that would help in depicting the original colors of the store back in the 1940's. *See, e.g.*, *A "Miracle" of Technology*, *supra* note 2, at C22, col. 5.

58 Joan Leslie, the actress who played James Cagney's wife in *Yankee Doodle Dandy*, was an advisor on that film's conversion to color. Powell, *supra* note 2. Color Systems Technology has also hired Gene Allen, an Academy Award winning art director, as a consultant. Onosko, *supra* note 2, at 57.

59 The original filmmaker may be dissatisfied with the contract arrangements which the colorist offers, or may believe that the colorization will result in a distortion of the work. This is the controversy surrounding the colorization of Frank Capra's film *It's A Wonderful Life*. *See infra* notes 208-12 and accompanying text.

3. The Scope of Copyright Protection in a Color Arrangement

Color is the result of human response to natural phenomena.[60] Because color *per se* is a fact of nature it cannot be copyrighted.[61] It is, therefore, an element belonging to the public domain.[62] However, an original expression embodied in a color arrangement is copyrightable.[63] The distinction between fact and expression limits the copyrightable aspects of an author's work to the contributions of expression and not the facts contained therein.[64] An author can copyright an original expression of an idea or fact, but cannot sue for infringement when another author uses an independent expression of the same idea—no matter how similar the two expressions may be.[65] The products of colorization are largely created from factual sources and by mechanical processes. "Mere mechanical or industrial processes

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60 Color has been defined as the:

> effect produced on the eye and its associated nerves by light waves of different wavelength or frequency. Light transmitted from an object to the eye stimulates the different color cones of the retina, thus making possible perception of various colors in the object.

NEW COLUMBIA ENCYCLOPEDIA 602 (4th ed. 1975).

61 *See* Harper & Row, Publishers, Inc. v. Nation Enters., 105 S. Ct. 2218, 2224 (1985) ("[N]o author may copyright facts or ideas.").

62 Sargent v. American Greetings Corp., 588 F. Supp. 912, 918 (N.D. Ohio 1984). For examples of items in the public domain, see Harper & Row, Publishers, Inc. v. Nation Enters., 105 S. Ct. 2218 (1985) (historical facts and public documents); Mazer v. Stein, 347 U.S. 201 (1954) (utilitarian objects); Baker v. Selden, 101 U.S. 99 (1879) (blank forms or systems); Mattel, Inc. v. Azrak-Hamway Int'l, Inc., 724 F.2d 357 (2d Cir. 1983) (fighting pose that has been around since Neanderthal days); Eltra Corp. v. Ringer, 579 F.2d 294 (4th Cir. 1978) (typeface); Trebonik v. Grossman Music Corp., 305 F. Supp. 339 (N.D. Ohio 1969) (musical chords); Note, *Arrangements and Editions of Public Domain Music: Originality in a Finite System*, 34 CASE W. RES. 104 (1983) (sound).

63 Pantone, Inc. v. A.I. Friedman, Inc., 294 F. Supp. 545, 548 (S.D.N.Y. 1968); 1 NIMMER, *supra* note 26, § 2.14, at 2-178.3; *cf.* H.R. REP. No. 2237, 89th Cong., 2d Sess. 44 n.1 (1966) (This report of an early version for revision of the Copyright Act of 1909, stated, in a footnote, that "color schemes" were among ten items not copyrightable. This footnote was removed from H.R. 1476, *supra* note 29, in which the 1976 Copyright Act was reported.).

64 The dichotomy between original expression and ideas or facts is found in 17 U.S.C. § 102(b) (1982). *See* H.R. 1476, *supra* note 29, at 57.

Often it is difficult to distinguish the ideas from the expressions used within a work, and a court must therefore decide the scope of copyright protection for that work. *See* Kunstadt, *Can Copyright Law Effectively Promote Progress in the Visual Arts?*, 25 COPYRIGHT L. SYMP. (ASCAP) 159, 163 (1975).

65 1 NIMMER, *supra* note 26, § 2.01[A], at 2-8. Judge Learned Hand stated in Sheldon v. Metro-Goldwyn Pictures, Corp., 81 F.2d 49, 54 (2d Cir.), *cert. denied*, 298 U.S. 669 (1936):

> Borrowed the work must indeed not be, for a plagiarist is not himself pro tanto an "author"; but if by some magic a man who had never known it were to compose anew Keats's Ode on a Grecian Urn, he would be an "author," and, if he copyrighted it, others might not copy that poem, though they might of course copy Keats's.

See also Olson, *supra* note 28, at 32 & n.16.

. . . have never served as the basis for original or derivative authorship."[66] Thus, if copyrights are to be granted to color enhanced films, the extent to which protection will be allowed depends upon the amount of expression contributed by the colorists to the color arrangements.

Colorists expend much time and effort to research and compile the facts necessary to create authentic color renditions of black and white films.[67] While the colorists' special efforts and skills in producing the color do not support in themselves the copyrightability of the final products,[68] the colorists may claim that their *use* of factual information, discovered through extensive independent research, exhibits original authorship.[69] Therefore, even if their color arrangements are compilations of pure fact, the creation of these products would entail some degree of original expression,[70] constituting copyrightable subject matter that would be protected against literal copying or paraphrasing.[71] However, if the expressions within the color arrangements are inseparable from the colors employed, public policy would decree that copyright protection should be denied.[72] Granting copyrights to works in which fact and expression are closely related would deny future authors access to items in the public domain, ultimately impeding the constitutional premise of progress in the arts and sciences.[73] It is unlikely that copyright protection could be denied to colorized films on this basis. The copyrights would extend to the entire color arrangement, rather than to each individual use of color.[74] Therefore, under the idea-expres-

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66 Notice of Inquiry, *supra* note 21, at 32,666.

67 *See infra* note 131.

68 *See* 1 NIMMER, *supra* note 26, § 2.01[A], at 2-9 to -10. *But cf.* Alva Studios, Inc. v. Winninger, 177 F. Supp. 265, 267 (S.D.N.Y. 1959) (the court found plaintiff's work copyrightable due to the skill involved in creating a miniature reproduction of a sculpture).

69 1 NIMMER, *supra* note 26, § 2.01[A], at 2-9; *see also* Amsterdam v. Triangle Publications, Inc., 93 F. Supp. 79, 82 (E.D. Pa. 1950), *aff'd in pertinent part*, 189 F.2d 104 (3d Cir. 1951) ("[T]he presentation of information available to everybody . . . is protected only when the publisher . . . obtains originally some of that information by the sweat of his own brow." The Third Circuit recited this conclusion. 189 F.2d at 106.).

70 Harper & Row, Publishers, Inc. v. Nation Enters., 105 S. Ct. 2218, 2224 (1985).

71 1 NIMMER, *supra* note 26, § 2.03[D], at 2-33 & n.56.

72 [I]f . . . one form of expression . . . could exhaust all possibilities of future use of the substance. . . . it is necessary to say that the subject matter would be appropriated by permitting the copyrighting of its expression. We cannot recognize copyright as a game of chess in which the public can be checkmated.

Morrissey v. Proctor & Gamble Co., 379 F.2d 675, 678-79 (1st Cir. 1967).

73 Simensky, *Ideas, the Lifeblood of the Entertainment Industry, Are Not Covered Under Copyright Law*, N.Y.L.J., Mar. 21, 1986, at 5, col. 1; *see also* 3 NIMMER, *supra* note 26, § 13.03[A], at 13-20.2.

74 Harris, *supra* note 1, at 92, col. 1; *see* N. BOORSTYN, COPYRIGHT LAW 59 (1981) ("A

sion dichotomy, the colorists' contributions contain copyrightable subject matter. However, the color arrangement created by the colorist would not exist without the original film. Consequently, to be deemed derivative works deserving of copyright protection, the colorists' contributions must withstand the "distinguishable variation" test—a judicial test of originality which will determine whether the expression is more than a trivial contribution to the original film.[75]

B. *The Implications of Copyright for Colorized Works*

Whether contributions resulting from colorization are copyrightable as derivative works is questionable. The copyright status of the original film and the potential economic rewards must be considered. Copyright proprietors of original black and white films may protect their properties from unauthorized colorization.[76] Moreover, they may protect authorized color versions of their films from unauthorized use, regardless of whether the colorized film is considered a copy or a derivative work.[77] The

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compilation copyright protects the selection, organization, and arrangement of preexisting materials and not the materials themselves.").

[75] L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486 (2d Cir.), *cert. denied*, 429 U.S. 857 (1976); Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 102-03 (2d Cir. 1951); *see infra* notes 104-76 and accompanying text.

[76] By properly invoking the exclusive rights and remedies available through copyright, the original filmmaker could prevent any unauthorized uses, including alteration through colorization of the work. *See* 17 U.S.C. §§ 106, 502-505 (1982). An example of this is the action for copyright infringement recently instituted by RKO Pictures, Inc., in the Central District of California, against Color Systems Technology, Inc. RKO sought to enjoin Color Systems from colorizing ten RKO films and requested relief for damages that may have been incurred. *See generally* Complaint of RKO Pictures, Inc. (C.D. Cal. 1986) (No. 86 Civ. 6816 FFF (Gx)). RKO states in its motion papers that Color Systems Technology plans to colorize several RKO films for the Turner Entertainment Company. Notice and Motion for Preliminary Injunction; Memorandum of Points and Authorities at 8, (C.D. Cal. 1986) (No. 86-6816 FFF (Gx)) [hereinafter Plaintiff's Notice and Motion]. RKO claims it owns the copyrights in these films, Plaintiff's Notice and Motion, *supra*, at 10, and that colorization is conduct not authorized by a license of television rights to a company for which the Turner Entertainment Company is now a successor. *See* Plaintiff's Notice and Motion, *supra*, at 11-24.

However, Color Systems Technology claims that RKO's suit is frivolous because the RKO films in question have not been colorized, nor does Color Systems Technology have the ability to colorize these films without RKO's assistance. *See* Memorandum of Points and authorities of defendant Color Systems Technology, Inc. in Opposition to Plaintiff's Motion for Preliminary Injunction; Request for Sanctions at 2, 8-10, (C.D. Cal. 1986) (No. 86-6816 FFF (Gx)) [hereinafter Defendant's Memorandum]. Color Systems Technology explains it is "an innocent 'stakeholder' in a contract dispute between Turner Entertainment Company and RKO." Letter from Joseph A. Adelman, Senior Vice President of Color Systems Technology Inc., to Elise K. Bader (Dec. 16, 1986). It also states that RKO's suit, in the California federal court, is a "strategic ploy in its battle with Turner . . . ." Defendant's Memorandum, *supra*, at 3. RKO's action has been stayed pending litigation and results of a suit for breach of contract, in the Southern District of New York, by Turner Entertainment Company against RKO. Adelman, *supra*.

[77] *See* 17 U.S.C. § 106.

terms of a contract between the copyright proprietor and the colorist would determine the economic benefits to be received by each party from the new version.[78]

If the results of colorization are deemed copies of the prior works, an additional copyright period would not be extended. Protection for these colorized films would endure only until the expiration of the black and white films' copyrights. The colorists of films in the public domain[79] would receive virtually no protection for their efforts. Under these circumstances, color versions of films in the public domain could be copied and distributed without recourse on the part of their creators.[80] For the colorists, this lack of control over the quantity and quality of the copies in distribution could lead to excessive losses in economic value and reputation.

If colorization is deemed a contribution worthy of derivative work status, colorized versions of films would receive separate copyrights. These copyrights would endure, at least as to their color arrangements, beyond the copyrights of the black and white versions,[81] and the colorists of public domain films would be entitled to copyright protection for their endeavors.[82] This protection would enable the colorists to prevent unauthorized exploitation of their colorized versions of public domain films,[83] and most of the economic benefits would belong solely to these

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[78] The colorization of films under copyright is usually done on a work for hire basis. *See id.* § 201(b). The copyright proprietor employing the colorist would keep all rights to the copyright, in the original film and the color version. Without specific royalty terms in the contract, the colorist's economic benefit would be solely the charge for colorization. Color Systems Technology, Inc. contracted to receive, in addition to the fee for colorization, a percentage of the net profits after distribution of the films it colorizes from the MGM library. Powell, *supra* note 2.

[79] A film enters the public domain when: 1) the initial copyright expired without renewal for a second term, or both terms have expired; or 2) the copyright notice was defective or missing from the work and no efforts were made to cure the omission. 17 U.S.C. § 405(a). Under the Copyright Act of 1909, ch. 320, 35 Stat. 1075, *superseded by* the Copyright Act of 1976, Pub. L. 94-553, 90 Stat. 2541 (codified as amended at 17 U.S.C. §§ 101-914 (1982 & Supp. III 1985)), the first term of copyright lasts for 28 years with a renewal period of 28 years. The 1976 Act extended the renewal period so that copyrights still in existence under the 1909 Act would last for 75 years. 17 U.S.C. § 304(b). For thorough discussions concerning public domain films, see generally Lilienthal, *supra* note 4, at 51; Pierce, *Copyright Lost*, AM. FILM, Oct. 1985, at 68.

[80] Harris, *supra* note 1, at 2, col. 1.

[81] The duration of the copyright for colorized films would be governed by the 1976 Copyright Act, 17 U.S.C. § 302.

[82] In certain cases, the colorization of public domain films may be done on a work for hire basis and the copyright would vest in the colorist's employer, the owner of the physical print of the film.

[83] Another colorist could take the same black and white public domain film and make its own color version as long as it did not copy the first colorist's original expressions. *See supra* text accompanying note 65. However, there would be potential for confusion of the two colorized films, creating loss in value and raising issues under § 43(a) of the

colorists.[84]

Recognizing the copyrightability of colorization would increase the rewards that colorists, and copyright proprietors of original films, could expect from their efforts. Therefore, if the results of colorization are contributions that are so substantial that, in effect, new films are created, these parties should be entitled to receive protection for their endeavors. However, if the contributions are minor, in that no expression is added and the film remains identical in substance to the original, there should be no reason to grant economic rewards under the guise of copyright.[85] Protecting efforts which exhibit no original creative value does not stimulate artistic or literary progress; rather, creativity may be inhibited by removing from the public domain that which is available for public use.[86]

It is foreseeable that colorized versions of films will be more popular than their black and white counterparts with average movie audiences.[87] If colorized films are granted separate copyrights, the copyright proprietors of these new versions may choose to keep the original films out of circulation, and thus out of competition.[88] As a result, the public would be subject to the whims of the copyright proprietors of the colorized films for pricing and availability of both the black and white and the color ver-

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Lanham Act, 15 U.S.C. § 1125(a) (1982). Exploration of such issues is beyond the scope of this Note.

84 The colorists would have to share some of the economic benefits derived from the colorized version. Retailers, distributors, manufacturers, employees, and creditors would all be enriched from the profits made by the new work. The only people who would not gain from the colorization would be the creators of the original black and white productions. However, the original filmmakers might receive an indirect benefit from the colorization process by way of increased exposure and renewed interest in their work.

85 This is the argument made by opponents of colorization. *See* Cox, *supra* note 39, at 1, col. 6. However, many judicial opinions construing the copyright statute take a more liberal view and grant copyright for the efforts that are involved in creating derivative works. *See infra* notes 125-29 and accompanying text.

86 The Second Circuit, in L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486, 492 (2d Cir.), *cert. denied*, 429 U.S. 857 (1976), stated:

> Absent a genuine difference between the underlying work of art and the copy of it for which protection is sought, the public interest in promoting progress in the arts—indeed, the constitutional demand . . . could hardly be served. To extend copyrightability to minuscule variations would simply put a weapon for harassment in the hands of mischievous copiers intent on appropriating and monopolizing public domain work.

See also Brown, *The Widening Gyre: Are Derivative Works Getting Out of Hand?*, 3 CARDOZO ARTS & ENT. L.J. 1, 3 (1984); Kunstadt, *supra* note 64, at 170.

87 *See supra* notes 4-5.

88 *But cf.* Bennetts, *supra* note 1, at C14, cols. 5-6 (one company marketing colorized films for home video explains that colorization is being made available solely as an alternative).

sions.[89] This scenario is possible even for films in the public domain when only one quality copy of the black and white version exists.[90] " 'Classic films are going to be principally accessible over television and in video cassette. People can't go to the archive and see the original print. They'll see the film the way it's marketed, so therefore the films will be essentially inaccessible in black and white.' "[91] Opponents of colorization fear that future generations will be unable to view the classic masterpieces of film in the form that their creators intended.[92] However, the elements which are not original to the new versions would still be available for use in copying[93] and in creating other derivative works, including other authorized colorized versions. If the black and white versions have previously experienced widespread distribution and remain in circulation, the problems concerning availability of these public domain films will be nonexistent. The ramifications of copyright protection magnify the importance of deciding whether the colorists' contributions are deserving of copyright as derivative works.

C. *The Originality Requirement and the Distinguishable Variation Test*

The requirement of originality is the keystone of the 1976 Copyright Act.[94] The congressional intent in establishing the concept of originality within the statute was "to incorporate with-

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[89] *See* Universal City Studios, Inc. v. Sony Corp. of Am., 659 F.2d 963, 965 (9th Cir. 1981) (The court stated that copyright is based on the premise that the exclusive rights granted " 'will not impose unacceptable costs to society in terms of limiting access to published works or pricing them too high.' "), *rev'd on other grounds*, 464 U.S. 417 (1984); *see also* Olson, *supra* note 28, at 35.

[90] Many old films were originally shot on nitrate film stock which deteriorates over time, or have been stored improperly or otherwise mishandled. *See generally* Sanburn, *supra* note 4. In such cases, it is difficult to find a quality print that may be used in the colorization process. Often the only usable prints are in the guarded possession of a film archive or collector. Jaszi, *When Works Collide: Derivative Motion Pictures, Underlying Rights, and the Public Interest*, 28 UCLA L. REV. 715, 741 & nn. 68-69 (1981).

[91] Bennetts, *supra* note 1, at C14, col. 6 (quoting George Stevens, Jr. of the American Film Institute).

[92] *Id.* at C14, cols. 4-6; *see also infra* notes 208-12 and accompanying text.

[93] A reversal of the colorization process is possible by someone who has access to the colorized work. *See* Onosko, *supra* note 2, at 136. However, the black and white version obtained in this manner may not be exactly equivalent to the original black and white film. The transformation to color does necessitate some change from the colors originally photographed and the quality of the new black and white reversal would be different from the original black and white version. *See id.* Therefore widespread distribution of the black and white reversal would be skirting along the edges of copyright infringement of the colorized version from which it was made. This would hold true especially in situations where the colorist has obtained the motion picture rights to the underlying story that is still protected by copyright, although the original film has entered the public domain.

[94] "Copyright protection subsists . . . in original works of authorship . . . ." 17 U.S.C. § 102(a) (1982).

out change the standard of originality established by the courts under [the Copyright Act of 1909]."[95] Although originality is left undefined in the 1976 Copyright Act,[96] "the originality necessary to support a copyright merely calls for independent creation, not novelty."[97] Originality is considered "the essence of authorship"[98] and the statutory requirement is attributed to the United States Constitution's specification that copyright may be granted to an "author".[99] The Supreme Court has defined the term "author" as " 'he to whom anything owes its origin; originator; maker . . . .' "[100]

The standard for originality is embodied in the "distinguishable variation" test,[101] a judicial determination of the amount of originality involved in authorship.[102] The test requires that originality of expression must be more than a trivial contribution to support a copyright.[103]

Originality is also a requirement for receiving copyright status as a derivative work.[104] However, copyrights in derivative works only extend to the material expressions added by the contributors.[105] Therefore, a derivative work must be more than a copy;[106] the author must have contributed some form of original expression that distinguishes his work from the prior work.[107]

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95 H.R. 1476, *supra* note 29, at 51.

96 *Id.*

97 1 NIMMER, *supra* note 26, § 2.01[A], at 2-6 to -7 (footnote omitted); *see also* Olson, *supra* note 28, at 31.

98 1 NIMMER, *supra* note 26, § 1.06[A], at 1-37.

99 *Id.*

100 Burrows-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 58 (1884).

101 Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 102-03 (2d Cir. 1951); Gerlach-Barklow Co. v. Morris & Bendien, Inc., 23 F.2d 159 (2d Cir. 1927).

102 *See* 1 NIMMER, *supra* note 26, § 2.01[B], at 2-11.

103 L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486, 491 (2d Cir.), *cert. denied*, 429 U.S. 857 (1976); *Alfred Bell*, 191 F.2d at 102-03. Sufficient originality is to be determined on an objective basis. A court's decision is not to be based on a judgment of the merits of the "art" or the expression itself. Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 251-52 (1903); *Alfred Bell*, 191 F.2d at 103; 1 NIMMER, *supra* note 26, § 2.01[B], at 2-12 to -13. Therefore, many courts have found that a modest degree of originality can suffice. *See, e.g.*, *Bleistein*, 188 U.S. at 250; Dan Kasoff, Inc. v. Novelty Jewelry Co., 309 F.2d 745, 746 (2d Cir. 1962) (requirement is a "faint trace of 'originality' ").

104 17 U.S.C. § 103(a) (1982).

105 *Id.* § 103(b).

106 To be considered derivative, the new work must have substantially copied the expressions from the underlying work, so that if unauthorized, the copyright proprietor would have a claim for infringement. "It is saved from being an infringing work . . . because the . . . material was taken with the consent of the copyright owner . . . or because the prior work has entered the public domain." 1 NIMMER, *supra* note 26, § 3.01, at 3-3 to -4 (footnote omitted). However, while copying, Congress "requires a process of recasting, transforming, or adapting 'one or more preexisting works' . . . ." H.R. 1476, *supra* note 29, at 57.

107 This original expression must constitute more than a minimal contribution. "Any variation will not suffice, but one which is sufficient to render the derivative work distin-

1. The Liberal Applications of the Distinguishable Variation Test

The distinguishable variation test for originality was endorsed in *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*[108] That case involved a suit for copyright infringement of the plaintiff's mezzotint engravings.[109] The plaintiff had copyrighted eight mezzotints which were copies of the subject matter of famous artworks in the public domain, including Gainsborough's *Blue Boy*.[110] The defendant had photographed plaintiff's mezzotints for use in its lithographing process.[111] The issue of originality was raised by the defendant's counterclaim that the plaintiff's mezzotints were not copyrightable because they were "reproductions of works in the public domain."[112]

Judge Frank, writing for the Second Circuit, determined that under the Copyright Act of 1909[113] the plaintiff's mezzotints were copyrightable, and held, therefore, that the defendant's works were infringements.[114] The court applied the "distinguishable variation" test,[115] and established a liberal standard for originality. "All that is needed to satisfy both the Constitution and the statute is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own' . . . . No matter how poor artistically the 'author's' addition, it is enough if it be his own."[116] The plaintiff's works were found copyrightable, based on the distinguishable variation test, due to the "quantity and quality of original effort"[117] involved in pre-

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guishable from its prior work in any meaningful manner will be sufficient." 1 NIMMER, *supra* note 26, § 3.03, at 3-12 to -12.1. However, courts and commentators cannot agree as to what standard of originality is sufficient. *See infra* notes 174-80 and accompanying text.

108 191 F.2d 99 (2d Cir. 1951).

109 "Mezzotint" is a term for the method and the print made from "engraving a copper or steel plate by scraping and burnishing areas to produce effects of light and shadow." THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 828 (New College ed. 1976).

110 Alfred Bell & Co. v. Catalda Fine Arts, Inc., 74 F. Supp. 973, 975-76 (S.D.N.Y. 1947), *modified*, 191 F.2d 99 (2d Cir. 1951).

111 74 F. Supp. at 977. A lithograph is a photoengraving using a combination of printing plates for each color or shade in the work. *See id.*

112 191 F.2d at 104.

113 Copyright Act of 1909, ch. 320, 35 Stat. 1075, *superseded by* Copyright Act of 1976, Pub. L. 94-553, 90 Stat. 2541 (codified as amended at 17 U.S.C. §§ 101-914 (1982 & Supp. III 1985)).

114 191 F.2d at 104-06.

115 *Id.* at 102. The "distinguishable variation" test was first contemplated in Gerlach-Barklow Co. v. Morris & Bendien, Inc., 23 F.2d 159 (2d Cir. 1927).

116 191 F.2d at 102-03 (footnotes omitted).

117 Olson, *supra* note 28, at 50.

paring a mezzotint.[118]

> The work of the engraver upon the plate requires the individual conception, judgment and execution by the engraver on the depth and shape of the depressions in the plate to be made by the scraping process in order to produce in this other medium the engraver's concept of the effect of the oil painting. No two engravers can produce identical interpretations of the same oil painting.[119]

However, Judge Frank stated that even inadvertent variations could make a reproduction copyrightable.[120]

In *Alva Studios, Inc. v. Winninger*,[121] the definition of originality under the distinguishable variation test was stretched to its limits.[122] In that case, the court held that a reproduction in miniature of Rodin's *Hand of God* sculpture was copyrightable.

> Its copyrighted work embodies and resulted from its skill and originality in producing an accurate scale reproduction of the original. In a work of sculpture, this reduction requires far more than an abridgement of a written classic; great skill and originality is called for when one seeks to produce a scale reduction of a great work with exactitude.[123]

The decisions in *Alfred Bell* and *Alva Studios* indicate that almost any work involving reproduction of art in the public domain would qualify for copyright protection under the category of derivative works.[124] Furthermore, these cases suggest that any new work that exhibits a modest difference from the prior work on which it is based, though not necessarily a variation in expression, would be copyrightable due to the skill and judgment employed while preparing the new work.[125] Although the artists exhibited great skill and expertise when preparing their reproductions in both of these cases,

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118 The court in Kuddle Toy, Inc. v. Pussycat-Toy, Co., 183 U.S.P.Q. (BNA) 642, 658 (E.D.N.Y. 1974), found:

> What the Court considered that it had to decide in Bell v. Catalda was really whether such difficult and elevated copying was itself sufficiently an exercise of authorship—an originality in copying—to be independently the subject of copyright. . . . The more nearly the mezzotints approached perfection of copying, the more brilliantly "original" within their own special art of copying they were . . . .

119 74 F. Supp. at 975.

120 191 F.2d at 105.

121 177 F. Supp. 265 (S.D.N.Y. 1959).

122 Oppenheimer, *Originality in Art Reproductions: "Variations" in Search of a Theme*, 26 BULL. COPYRIGHT SOC'Y 1, 17 (1978-79).

123 177 F. Supp. at 267.

124 *See* Kunstadt, *supra* note 64, at 169-72. *But see* Jaszi, *supra* note 90, at 735-36.

125 *See Alfred Bell*, 191 F.2d at 104-05 n.22; *Alva Studios*, 177 F. Supp. at 267; Oppenheimer, *supra* note 122, at 16-17.

the laws of copyright protect the expression that results, not the proficiency of the artists involved.[126] In *Alfred Bell*, the plaintiff's mezzotints created different impressions of the subject matter copied from the original paintings.[127] Therefore, the use of skill aided the process of original expression. In this light, it is difficult to reconcile the decision in *Alva Studios*. It is dubious whether originality of expression is exhibited in the smaller version of Rodin's work.[128] It appears that the *Alva Studios* court actually protected the skill of the copyist.[129]

By applying the distinguishable variation test as contemplated in these two cases, the additions of color to black and white films create sufficient variations from the original films and are thereby deserving of copyrights as derivative works. Skill and expert judgment are employed in the operation of computers and in the application of colors. Colorists contribute certain independent decisions[130] to determine the colors that will best express the reality of the original films, and the process involves a complex, tedious, and expensive undertaking.[131]

Other courts, following the *Alfred Bell* and *Alva Studios* interpretations of the distinguishable variation test, have found that specific arrangements of ideas in the public domain are copyrightable.[132]

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126 *See supra* note 68 and accompanying text.

127 *See supra* text accompanying note 119; *see also* Olson, *supra* note 28, at 50. *But see Kuddle Toy*, 183 U.S.P.Q. (BNA) at 658:

> When Bell v. Catalda is subdued to its facts, it is seen that it has nothing to do with limited "originality" . . . . It had to do only with whether an honest copy made in a new medium by a laborious process could be protected against color reprinting. The Court held that it was protected.

See also Brown, *supra* note 86, at 6.

128 *See* Oppenheimer, *supra* note 122, at 27.

129 *Cf.* L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486 (2d Cir.), *cert. denied*, 429 U.S. 857 (1976). The court stated that *Alva Studios* appears to be the only case that is an "exception to [the originality] rule . . . ." 536 F.2d at 490 n.3. Later in the opinion, the court distinguished the case at hand by stating that the court in *Alva Studios* awarded copyright status to the "complexity and exactitude" involved in preparing the miniature of Rodin's statute. 536 F.2d at 491-92; *see also* 1 NIMMER, *supra* note 26, § 2.08[C][2], at 2-98.

130 *See supra* notes 48-52 and accompanying text.

131 Colorization, Inc. estimates that it takes six weeks and $2,000 per minute, or $180,000, to color an average length film which does not have too many intricacies of detail. White, *supra* note 2. Color Systems Technology, Inc. estimates the same cost for the average film, but states that it takes one month to colorize, and is hoping to cut this time to ten days. Powell, *supra* note 2; *see also* Elmer-DeWitt, *supra* note 45, at 83; Harris, *supra* note 1, at 92, col. 1. However, the time from the start of research on the project to a completed colorized film may take as long as five months. Armstrong, *supra* note 4, at 25, col. 4.

132 Primcot Fabrics v. Kleinfab Corp., 368 F. Supp. 482 (S.D.N.Y. 1974) (Designs in public domain arranged in a "pleasing" patchwork pattern with a "particular juxtaposition of colors." *Id.* at 484); Trebonik v. Grossman Music Corp., 305 F. Supp. 339 (N.D. Ohio 1969) (guitar chords in the public domain but arranged on a set of three paper wheels affixed together in such a way as to show correct fingering); Pantone, Inc. v. A.I.

These courts concurred with the finding by Judge Frank, in *Alfred Bell*, that originality need be just slightly more than a trivial variation.[133] However, these later cases did not apply the distinguishable variation test to derivative works; rather, the decisions applied the test to compilations of matters from the public domain. Colorization of black and white films may be likened to compilations, as the results comprise arrangements of facts concerning color.[134] Nevertheless, due to the substantial copying of the prior works, the colorized films would be copyrighted as derivative works.

Colorization may be considered among a new class of derivative works. Rather than creating an art reproduction[135] which strives to attain exactness in its replication of the original work, colorization creates a true copy containing an additional element. Recently, the Fourth Circuit, in *M. Kramer Manufacturing Co. v. Andrews*,[136] covered this type of derivative work. That case involved an infringement action which led to a dispute over the copyrightability of a video arcade poker game.[137] The district court, in an unpublished decision, had found that plaintiff's video game was not copyrightable because the audiovisual elements already existed in defendant's game, with the exception of an additional element of a flashing card.[138] The lower court decided that the flashing card was not copyrightable "because it amounted to only 'an idea, concept or system of flashing cards . . . .' "[139] The Fourth Circuit reversed, holding that the additional elements of the flashing card and split screen

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Friedman, Inc., 294 F. Supp. 545 (S.D.N.Y. 1968) (color matching system that arranged colors into a planned design in booklet form).

133 *See supra* text accompanying note 116.

134 For a discussion on color and colorization, see *supra* notes 32-59 and accompanying text.

135 Colorization may conceivably be viewed as a color reproduction of the original film in a new medium. The original film is electronically transferred to the new medium of videotape for purposes of colorizing the film, creating slight variations in the image during the transfer. Often a change from one medium to another is enough to find sufficient variation in expression. Oppenheimer, *supra* note 122, at 22-24. For instance, a three-dimensional sculpture exhibits images that are different from those of an oil painting of the same subject. *But cf.* 1 NIMMER, *supra* note 26, § 2.08[C][2], at 2-98 to -100.

However, the Copyright Office does not consider the results of copying film to videotape a copyrightable derivative work. *See* Notice of Inquiry, *supra* note 21, at 32,666. The process is considered a simple transfer of content from one audiovisual medium to another. *See* 1 NIMMER, *supra* note 26, § 2.03[C], at 2-31 to -32 ("[A] given 'motion picture' is a work of authorship, while its copies may take different forms, such as motion picture film, video tape, video discs, etc. There is but a single work of authorship, no matter how numerous and diverse the copies."); *see also* Rohauer v. Killiam Shows, Inc., 551 F.2d 484, 492 n.12 (2d Cir.), *cert. denied*, 431 U.S. 949 (1977).

136 783 F.2d 421 (4th Cir. 1986).

137 *Id.* at 431-32.

138 *Id.* at 430.

139 *Id.*

images exhibited sufficient originality of expression[140] under the *Alfred Bell* distinguishable variation test[141] and, therefore, that plaintiff's version of the game was copyrightable.[142] Following this decision, it is likely that a color addition to a film would be considered a sufficient variation.[143] Colorization, like the additions to the video game, superimposes an element which enhances the original work.

Arguments may be raised against according the colorists' products derivative works status, even under the liberal construction of distinguishable variation. Such opposition would contend that the colorists' use of factual information, which is inherent in the creation of the colorized work, provides nothing more than a minor change from the original work.[144] The colorists' reliance upon computers may provide other grounds for denying copyright. Use of this mechanical means to create the colorized work would prevent indelible mistakes caused by a "slip of the hand" which is sufficient for a finding of originality under *Alfred Bell*.[145] If a mistake is made, the colorist can return to that frame of the work and make the necessary corrections.

However, under the liberal standards for originality, any change from the prior work would suffice as long as it involves skill and judgment. Therefore, copyrights for colorized films, under the *Alfred Bell* distinguishable variation test, would only be limited by determining how much of the additional color is an expression of colorists' intellectual labors.[146]

2. The Strict Applications of the Distinguishable Variation Test

Since 1976, some courts have turned away from the expansive view of derivative works under the distinguishable variation test applied in *Alfred Bell* and *Alva Studios*, and have applied, instead, a more stringent rule of "substantial variation" in their decisions concerning originality. The most prominent case is *L.*

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140 *Id.* at 440.

141 *See id.* at 437-40.

142 *Id.* at 443.

143 *See also* International Film Exch. v. Corinth Films, Inc., 621 F. Supp. 631 (S.D.N.Y. 1985). The court found that dubbed and subtitled versions of a public domain film were individually copyrightable as derivative works. *Id.* at 636. However, the copyrights only extended to the elements that were added as part of the translations. *Id.*

144 *See* Cox, *supra* note 39, at 1, col. 6.

145 "A copyist's bad eyesight or defective musculature, or a shock caused by a clap of thunder, may yield sufficiently distinguishable variations." 191 F.2d at 105.

146 *See supra* notes 61-74 and accompanying text.

Batlin & Son, Inc. v. Snyder.[147] The defendant, Snyder, decided to capitalize on the bicentennial celebration by arranging for the design and manufacture of a plastic version of an an antique mechanical bank featuring the figure of Uncle Sam.[148] The design of the original metal version had long been in the public domain.[149] The plaintiff, Batlin, also decided to market plastic Uncle Sam banks, but his products were refused entry into the United States by the customs service based upon the defendant's copyright registration.[150] Batlin sought to have the defendant's copyright declared void.[151] The Second Circuit affirmed the district court's ruling that Batlin was entitled to a preliminary injunction, which would compel Synder to cancel a recordation with the customs service of the copyright in the plastic banks and would prevent him from enforcing that copyright.[152]

The court determined that the differences which occurred when transferring the public domain version not the plastic version were trivial[153] and, therefore, not copyrightable.[154] One commentator stated that *Batlin* did not follow the true distinguishable variation test and that the case is an abberation because the court rejected Snyder's ability to copyright his work solely on a finding that the bank was "inartistic."[155] The *Batlin* requirement of "true artistic skill"[156] abandons the *Alfred Bell* assertion that inadvertent variations are sufficiently original, and allows courts to make decisions on what constitutes art. Yet, *Batlin*'s requirement of substantial variation has been cited affirmatively by a number of subsequent cases.[157] Although *Batlin*

147 536 F.2d 486 (2d Cir.), *cert. denied*, 429 U.S. 857 (1976).
148 536 F.2d at 488.
149 *Id.*
150 *Id.*
151 *Id.*
152 *Id.* at 487-88.
153 "[T]here were no elements of difference that amounted to significant alteration or that had any purpose other than the functional . . . ." *Id.* at 489. The changes included a difference in size of the "sculpture" and variations in the presentation of certain shapes and textures. *Id.*
154 *Id.* at 492.
155 *See* Olson, *supra* note 28, at 52-55; *see also* M. Kramer Mfg. Co. v. Andrews, 783 F.2d 421, 439 (4th Cir. 1986) (The Fourth Circuit reversed the district court's judgment on copyrightability, stating that the lower court's holding, based on *Batlin*, was erroneous. The lower court had found that the elements added to a video game were not artistic contributions and, therefore, not copyrightable); Brown, *supra* note 86, at 7 (approving the *Batlin* decision because he likened the banks to utilitarian objects which do not receive copyright protection).
156 536 F.2d at 491.
157 *See, e.g.*, Sherry Mfg. Co. v. Towel King of Fla., Inc., 753 F.2d 1565, 1568 (11th Cir. 1985) (changes in design of beach towel were too trivial and insubstantial to support a copyright); Eden Toys, Inc. v. Florelee Undergarment Co., 697 F.2d 27 (2d Cir. 1982) (plaintiff's derivative sketches of Paddington Bear were "original and substantial

relied upon the "teachings" of *Alfred Bell*,[158] it resulted in a stricter standard predicated upon the distinguishable variation test.[159]

In *Gracen v. Bradford Exchange*,[160] the Seventh Circuit followed the strict application of the distinguishable variation test, and raised the standard of originality to an even higher degree.[161] The plaintiff, Gracen, created a painting of Judy Garland portraying the character of Dorothy in the motion picture *The Wizard of Oz*. The painting was chosen, through a competition, to be reproduced on the defendant's collectors' plates. A disagreement concerning contract terms arose, and the defendant hired another artist to prepare similar paintings.[162] Gracen copyrighted her work and brought an action for infringement of her exclusive right to make copies of her work.[163] The defendant counterclaimed that Gracen had infringed the copyright in the motion picture.[164]

The court determined that Gracen's painting was not copyrightable, although it represented her artistic impression of the subject after viewing the movie and the publicity stills.[165] Had the plaintiff painted Judy Garland from life the portrait would have been copyrightable as a work of art.[166] However, as the painting was based upon the film, the court decided, in an alternative holding, that this composition lacked substantial variation of expression and was not copyrightable as a derivative work.[167] Judge Posner, writing for the court, reasoned that the painting

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enough" to obtain a copyright); Durham Indus. v. Tomy Corp., 630 F.2d 905 (2d Cir. 1980) (Plaintiff's three dimensional figures of Disney characters were not substantial variations from the original characters, and therefore not deserving of copyright protection. The court determined that had these figures been copyrightable, any other licensee of Disney would have had to make changes in the characters to prevent infringement of plaintiff's figures, leaving their figures without a marketable value. 630 F.2d at 911.).

158 *See Batlin*, 536 F.2d at 490; *see also* 1 NIMMER, *supra* note 26, § 3.03, at 3-13 n.21; Olson, *supra* note 28, at 54.

159 *See* Gracen v. Bradford Exch., 698 F.2d 300, 305 (7th Cir. 1983); *see also* Brown, *supra* note 86, at 4 (the *Batlin* requirement of substantial variation raises the requirement of originality "a notch or two").

160 698 F.2d 300 (7th Cir. 1983).

161 *See* Brown, *supra* note 86, at 5.

162 698 F.2d at 301.

163 *Id.* (the plaintiff's counsel called the second painting a "piratical copy").

164 *Id.* at 302.

165 *Id.* at 301, 305.

166 *Id.* at 305.

167 *Id.* The court actually held that the plaintiff could not copyright her painting because she had no authority from the owner of the copyright in the film. However, she had been given authority to create the painting by the licensee of the copyright holder. *Id.* at 303. Therefore, her work was not an infringement; she was only prevented from obtaining a copyright in her name for a derivative work based on the film, *The Wizard of Oz*. *See* Brown, *supra* note 86, at 5.

was substantially similar to anyone's impression of the film, despite the fact that the artist's rendition was not an exact likeness of Judy Garland.[168] The judge distinguished artistic originality, which he concluded was demonstrated in the plaintiff's painting, from the "legal concept of originality in the Copyright Act."[169] This legal definition is designed to prevent overlapping claims in copyright.[170] In its explanation of the difference, the court adopted a very strict interpretation of substantial variation. "[T]he purpose of the term [original] in copyright law is not to guide aesthetic judgments but to assure a sufficiently gross difference between the underlying and the derivative work to avoid entangling subsequent artists depicting the underlying work in copyright problems."[171]

Once again, commentators have called this an aberrant decision that goes "beyond the precedents, and the statute; that it put too much power in the judges."[172] Commentators object to the *Gracen* court's decision because it permits judges to make aesthetic judgments when defining originality, despite the Supreme Court's long-standing prohibition against such subjective opinions.[173]

Determining the appropriate standard of originality for derivative works continues to be an area of debate. Commentators are divided on the issue of whether the standard should be minimal variation or substantial variation.[174] One commentator argues that the decisions concerning originality are confused and impermissibly based upon subject matter.[175] He views the *Alfred Bell* approach as uncomplicated and as preventing the courts from making subjective judgments.[176] Another commentator contends that the category of derivative works is an expanding umbrella for copyright protection, and that protection is being given to products which may be better protected by other laws.[177] Therefore, this commentator would require a substantial varia-

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168 698 F.2d at 305.

169 *Id.* at 304.

170 *Id.*

171 *Id.* at 305.

172 Brown, *supra* note 86, at 6; *see also* 1 NIMMER, *supra* note 26, § 3.03, at 3-12.

173 *See supra* note 103.

174 Mandel, *Copyrighting Art Restorations*, 28 BULL. COPYRIGHT SOC'Y 273, 293 (1980-81).

175 Olson, *supra* note 28, at 31-32.

176 *Id.* at 51.

177 Brown, *supra* note 86, at 2-3.

tion standard, but he would look at subject matter,[178] and, unlike the *Gracen* court, would be more liberal toward works of fine and applied art.[179]

Despite the commentators' assertions, some courts are presently applying a stricter standard in their decisions concerning the copyrightability of derivative works.[180] Therefore, if a colorist were to obtain a copyright registration for a colorized film, and then appeared in a suit to defend that copyright, a court, relying on the *Batlin* and *Gracen* interpretations of the distinguishable variation test, might decide that the colorized version is not a copyrightable derivative work because it does not exhibit the requisite substantial originality. Such a result would be grounded on the determination that the colorized print is merely a color enhanced copy which exhibits no new measure of expression because it fulfills the audiences' expectations of what the colors should be. Thus, a court could then order the cancellation of the copyright.

3. Color as a Distinguishable Variation

In the 1984 case of *Sargent v. American Greetings Corp.*,[181] the court considered whether color constitutes a distinguishable variation. The plaintiff, Sargent, contracted with the defendant corporation to create detailed paintings of a character from copyrighted black and white sketches provided by the defendant.[182] Sargent copyrighted her paintings.[183] She then claimed that the defendant's merchandising and licensing of the character, Strawberry Shortcake, infringed her copyright.[184] American Greetings asserted, in a motion for summary judgment, that "the plaintiff's alleged contributions, which were essentially color, are not copyrightable subject matter as a matter of law."[185]

The court did not decide whether the plaintiff's artwork was properly copyrightable. Instead, in denying the defendant's mo-

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178 *Id.* at 10 (this commentator would exclude items that are "mass-produced and mass-merchandised" from copyright as derivative works).

179 *See id.* at 6-10.

180 *See* W. STRONG, THE COPYRIGHT BOOK: A PRACTICAL GUIDE 6-8 (2d ed. 1984) (author states that only the Ninth Circuit still holds to the liberal standard). *But see* M. Kramer Mfg. Co. v. Andrews, 783 F.2d 421, 437-40 (4th Cir. 1986) (Fourth Circuit followed the liberal standard).

181 588 F. Supp. 912 (N.D. Ohio 1984).

182 *Id.* at 913-16.

183 *Id.* at 913.

184 *Id.*

185 *Id.* at 916.

tion for summary judgment,[186] the court determined that the question of originality under the distinguishable variation test is a question of fact to be decided by a jury.[187] The court stated that, "[defendant's] assertion that color is . . . *per se* eliminated from consideration when evaluating originality is incorrect."[188] Professor Nimmer referred to this decision when he stated that "adding colors to a previous black and white picture *may* constitute an original copyrightable contribution."[189]

The use of color in Sargent's paintings, however, can be distinguished from the use made by colorists of black and white films. The plaintiff in *Sargent* applied her imagination when deciding what colors would complete the characterization of a fantsy-related product. In contrast, the colorists use factual color information gained from public domain sources when adding to films which heretofore were considered complete. Therefore, it is possible that had the court decided that Sargent's paintings were copyrightable as derivative works, such a holding would be translatable only to those colorized versions of black and white films for which the colorists had plied their imagination when choosing the colors. However, the effort involved in discovering the factual elements with which to colorize films also requires intellectual labor. This, and the decisions involving discretion, should be sufficient to find that colorized versions of black and white films are copyrightable as derivative works.

D. *The Copyrightability of Colorized Films*

This Note has discussed the copyrightability of colorized films under the judicial interpretations of the copyright statute. However, the Copyright Office has decided that copyrights for the results of colorization technology may have special consequences, and has chosen to solicit comments on this issue, through a Notice of Inquiry.[190] The Copyright Office will take these comments into advisement and decide whether to amend the Copyright Office Regulations to specifically address coloriza-

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186 *Id.* at 924.

187 *Id.* at 919.

188 *Id.* at 918. This statement was based partially on a finding by the court that the colors used by the plaintiff were not inherent to the medium in which she worked. *Id.* at 919.

189 1 NIMMER, *supra* note 26, § 2.14, at 2-178.3 (emphasis added). Professor Nimmer was involved in the *Sargent* case, as an advisor to American Greetings on the question whether Sargent's painting was a derivative work. Telephone interview with Howard Weinshenker, Trademark and Licensing Counsel for American Greetings Corp. (Dec. 2, 1986).

190 *See supra* note 21.

tion.[191] As of the writing of this Note, no copyright registrations have been granted for colorized films, although the Copyright Office has received a number of applications.[192] The Copyright Office will hold these applications until the Register of Copyrights makes a decision concerning the copyrightability of these works.[193] If the Register deems colorized films to be copyrightable as derivative works, then copyright protection will be determined to have begun the day the color work was created, or fixed on tape.[194] However, registration of the work with the Copyright Office is not conclusive evidence that a work is copyrightable; it is only *prima facie* evidence.[195] A court could order cancellation of a copyright registration, but this would most likely occur in an infringement case involving the question as to which of two colorized versions of the same film is correctly copyrightable, rather than an outright decision that copyrights for colorization are erroneous.

The decision of the Register of Copyrights will depend upon a number of factors. As the Copyright Office is obligated to follow the legislative intent[196] embodied in the Copyright Act, the primary factor in the Register's decision will concern the originality of the colorists' contributions to films.[197] The Register must consider the precedents using the distinguishable variation test[198] when deciding what constitutes the original expression that makes the new works distinguishable from the prior films. The Register is also concerned whether colorized films being copyrightable as derivative works will lead to marketing practices of the film industry which will effectively extend the duration of copyright, or recapture from the public domain preexisting works.[199] This question accounts for the policy concerns of availability to the public of the original black and white versions of films.[200]

Public policy issues aside, colorized films will more than likely be considered copyrightable as derivative works. It would

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191 Notice of Inquiry, *supra* note 21, at 32,665-67.

192 Telephone interview with Dorothy Schrader, General Counsel to the Copyright Office of the Library of Congress (May 27, 1986).

193 *Id.*

194 *See* 17 U.S.C. § 302(a) (1982).

195 *Id.* § 410(c); 2 NIMMER, *supra* note 26, § 7.16[D], at 7-124.1.

196 Schrader, *supra* note 21.

197 *See* Notice of Inquiry, *supra* note 21, at 32,666.

198 *See supra* notes 101-80 and accompanying text; *see also supra* text accompanying note 95.

199 Notice of Inquiry, *supra* note 21, at 32,666.

200 *See supra* notes 88-93 and accompanying text.

be difficult to argue that the colorists have not made any original contributions to the prior works. Colors do not make an appearance by magic; the colorists are responsible for every aspect of the additions of color. The colorists must choose the correct colors and continue to monitor the computer as it colors the films.[201] Before the more mechanical portion of the process begins, colorists expend much time in the intellectual endeavor of compiling facts about the colors to be added.[202] Although much information about color is in the public domain, the colorists use personal judgment when choosing the correct shades and when making changes because the factually correct colors may not aesthetically suit the color arrangements.[203]

The strongest argument against the copyrightability of colorized films is that the substance of the original films survives intact. The actors, the dialogue, the scenery, and the dramatics all remain, they are merely enhanced by color. However, contributions of color may be considered expressions independent from those originally conveyed in the black and white films. This is true even though the color arrangements are meant to be realistic portrayals of nature as captured on the screen.[204]

Copyright is meant to encourage progress in the fields of literature and art.[205] As authors' endeavors take many forms, the standards for copyright are fairly expansive and the protections are limited.[206] Copyright for the result of colorization would fulfill the public interest of rewarding creative endeavors to stimulate further creativity,[207] as well as provide the colorists with protections against unauthorized appropriations of their works. The copyrights in the colorized films would only encompass the additional element of color. The colorists would not receive copyrights for the wholesale use of the original filmmakers' expressions. Rather, colorists would receive copyright protection only for their original intellectual endeavors in interpreting the color arrangements of the original films.

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201 *See supra* text accompanying note 51.
202 *See supra* notes 55-57 & 131 and accompanying text.
203 *See supra* notes 48-49 and accompanying text.
204 *See supra* note 39 and accompanying text.
205 *See supra* note 26 and accompanying text.
206 *See supra* note 28 and accompanying text.
207 *See supra* note 26 and accompanying text.

III. THE DOCTRINE OF MORAL RIGHTS FOR THE PROTECTION OF THE INTEGRITY OF ORIGINAL BLACK AND WHITE FILMS

Arising concurrently with the issue of copyrightability of colorized films, is a more fervent debate concerning the effect that colorization may have on the integrity of the original films. Directors, film archivists, and other members of the film industry[208] are disturbed that colorists are tampering with black and white films.[209] They believe that films were meant to be seen only as they were originally photographed,[210] and fear that changes in imagery will occur due to the addition of color.[211]

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208 John Huston, Warren Beatty, Woody Allen, and Elia Kazan are among the American directors who have joined George Stevens, Jr. and the American Film Institute to campaign against colorization. This group is followed the efforts of a coalition of British directors, formed under the aegis of the Directors Guild of Great Britain, who have called "for legislation to forbid the 'deformation' of an important part of their cultural heritage." Bennetts, *supra* note 1, at C14, col. 4. For other members of the film industry against colorization, see *supra* note 13.

209 Most notably, Frank Capra, whose film, *It's A Wonderful Life*, has been colorized by Colorization, Inc., was the first director to speak out against colorization. This classic film was produced and directed by Frank Capra for his company, Liberty Films, Inc. Letter from Page A. Miller, Copyright Office of the Library of Congress, to Elise K. Bader (Apr. 3, 1986); *see generally* F. CAPRA, THE NAME ABOVE THE TITLE: AN AUTOBIOGRAPHY 379-86 (1985). When Liberty Films was sold to Paramount Pictures, F. CAPRA, *supra*, at 400, so passed the copyright on *It's A Wonderful Life*. The film was virtually ignored from thereon, and upon the failure to renew the copyright the film entered the public domain. McDonough, *A Christmas Movie's Wonderful Life*, Wall St. J., Dec. 19, 1984, at 36, col. 1. The popularity of *It's A Wonderful Life* regained momentum, however, when it began playing on television every year during the Christmas holiday. McDonough, *supra*. Colorization, Inc. contracted for the motion picture rights with the copyright proprietor of the underlying story, and thereafter colorized the original film. Telephone interview with Andrew Kaplan, Vice President of Administration for Hal Roach Studios, Inc. (Mar. 7, 1986). Frank Capra, the director and producer of *It's A Wonderful Life*, claims that the colorization of his film distorts the integrity of the original. *See* Capra Letter, *supra* note 15; *see also* Lindsey, *Frank Capra's Films Lead Fresh Lives*, N.Y. Times, May 19, 1985, § 2, at 1, col. 1.

210 Gross, *Will 'Camille' Still Appeal in Color? Firms Paint New Versions of Old Films*, Wash. Post, Jan. 7, 1985, § 14 (Business), col. 5, at 15, col. 1; *see also* Capra Letter, *supra* note 15, at 1-2. The major fear is that " '[a] generation from now, no young person would ever see the work in the way it was seen by John Ford, William Wyler, Alfred Hitchcock, Orson Welles or Charlie Chaplin.' " Bennetts, *supra* note 1, at C14, col. 5 (quoting George Stevens, Jr. of the American Film Institute). However, now that the technology is available, the colorists urge that colorization is " 'an alternative for people who are interested in color.' " Bennetts, *supra* note 1, at C14, col. 6 (quoting Jim Fifield, Chief Exec. Officer of CBS-Fox Video). The colorists claim that those wishing to view a film in black and white, when it is shown in color, only need turn down the color control on the television set. *E.g.*, Bennetts, *supra* note 1, at C14, col. 5. *But see* Onosko, *supra* note 2, at 136 (turning down the color knob will not give an exact rendition of the original black and white shading). Whether to allow audience preferences to take precedence over artists' integrity encompasses a first amendment issue, *see* Linfield, *supra* note 2, at 35, which is beyond the scope of this Note.

211 [T]he act of painting would destroy the characterization. One of the factors that makes a film a classic is its ability to make audiences laugh and cry at the antics of flesh and blood real people. Coloring the actors and their surroundings would tend to diminish this illusion, creditability [sic] is weakened and so is the story.

Such changes are deemed to distort or destroy the visions rendered by the original filmmakers. " 'These pictures were conceived in black and white, and by adding color one betrays the intentions of the maker, which should not be done, because it damages or destroys the style of the films.' "[212]

Although colorization may cause distress to original filmmakers, there exists no statute in the United States which specifically addresses the moral rights of filmmakers to the integrity of their creations.[213] The problem for original filmmakers is particularly acute when they have transferred all of their interest to the copyrights in their films, or when the films have entered the public domain. Upon such occurrences, original filmmakers lose the ability to control the disposition and exploitation of their films.[214] Filmmakers who do not own the copyrights to their cre-

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Capra Letter, *supra* note 15, at 1-2.

On October 7, 1985, WPIX-TV, in New York City, aired a *Honeymooners'* special which featured sketches from the series that have not been seen since the 1950's. *See* Holden, *'Honeymooners' Anniversary Show*, N.Y. Times, Oct. 7, 1985, at C18, col. 1. One segment of that series was colorized for the special. The following is the reaction of the television critic for the *New York Times*: "Though technologically impressive, the change from harsh black-and-white to cotton-candy color undercuts the series' surreal kitchen-sink ambiance." Holden, *supra*, at C18, col. 1.

212 Bennetts, *supra* note 1, at C14, col. 4 (quoting Fred Zinnemann, the spokesman for the British directors, *see supra* note 208).

Although color film was available early in the century, *see supra* note 4, filmmakers from the period before the late 1960's often chose to work within the constraints of black and white film technology. *See* Linfield, *supra* note 2, at 32; *'Colorization'*, *supra* note 13, at 21, col. 1. These filmmakers believed that color would be a distraction, S. NEALE, *supra* note 37, at 145-46, 149, and geared all the production elements toward the black and white film. *See* Capra Letter, *supra* note 15, at 1. Some directors developed the technique of manipulating the values of black and white to such extent that they and their works have achieved the respect accorded to the masters of fine art. For example, Orson Welles' film *Citizen Kane* is most often cited for its artistry in all aspects of filmmaking. *See* Robertson, *A Retrospective of Welles Films at the Regency*, N.Y. Times, May 23, 1986, at C28, col. 1. The film *Casablanca* is also an American classic. These are the two films commentators fear would be most injured by the addition of color. *See, e.g.*, Gross, *supra* note 210, at 15; Armstrong, *supra* note 4, at 25; Rebello, *supra* note 46, at 13.

Contemporary directors, such as: Peter Bogdanovich in *The Last Picture Show*; Woody Allen in *Broadway Danny Rose*, and *Zelig*; and Martin Scorsese in *Raging Bull*, use black and white film to evoke certain feelings or achieve certain effects. *See* L. GIANNETTI, *supra* note 4, at 26; Huntington, *supra* note 2, at 10; *'Colorization'*, *supra* note 13, at 21, col. 1. These modern directors also resent the alteration of films by colorization. *See* Linfield, *supra* note 2, at 31-32; Huntington, *supra* note 2, at 10-11.

213 2 NIMMER, *supra* note 26, § 8.21[B], at 8-248; *see infra* notes 218-226, 231 and accompanying text. *But cf.* MASS. GEN. LAWS ANN. ch. 23, § 85S (West Supp. 1986).

214 Copyright is an " 'owner's statute and not an author's statute.' " Comment, *Toward Artistic Integrity: Implementing Moral Right Through Extension of Existing American Legal Doctrines*, 60 GEO. L.J. 1539, 1542 (1972) [hereinafter *Artistic Integrity*] (quoting Barbara Ringer, former Register of Copyrights). Therefore "where there [is] neither copyright protection nor a contract between the parties, creative works [are] held available for anyone to use as he might wish." Goldberg, *Commentary: The Illusion of "Moral Right" in American Law*, 43 BROOKLYN L. REV. 1043, 1046-47 (1977); *see* Wheaton v. Peters, 33 U.S. (8 Pet.) 591 (1834).

ations can only rely upon theories of law, which have been used indirectly to protect the moral rights of artists.[215] Most commentators, however, have found that the American analogues to the civil law doctrine of moral rights provide only limited protections for authors and artists.[216] These commentators are unanimous in supporting the addition of a moral rights provision to the United States copyright statute.[217]

Congress has been urged at various times to amend the copyright statute to include the doctrine of moral rights,[218] so that the United States could join the Berne Convention,[219] an international copyright union, and thereby enjoy greater protection worldwide for the creations of its authors and artists.[220] Bills have been proposed but have never passed the committee stage.[221] Originally, the exploiters of artistic works, such as film

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215 "[T]he doctrine of moral right is not part of the law in the United States . . . except insofar as parts of that doctrine exist in our law as specific rights—such as copyright, libel, privacy and unfair competition." Geisel v. Poynter Prods., Inc., 295 F. Supp. 331, 339-40 n.5 (S.D.N.Y. 1968) (citations omitted); *see, e.g.*, 2 NIMMER, *supra* note 26, § 8.21[B], at 8-248; FINAL REPORT OF THE AD HOC WORKING GROUP ON U.S. ADHERENCE TO THE BERNE CONVENTION ch. VI, at 35, 36, *reprinted in* 10 COLUM.-VLA J.L. & ARTS 547, 548 (1986) [hereinafter FINAL REPORT] (This report was prepared by a group of copyright practitioners who joined together to analyze the compatibility of the United States copyright law with the Berne Convention. *See* FINAL REPORT, *supra*, at 2-3); *see also infra* notes 256-324 and accompanying text.

216 *See, e.g.*, Krigsman, *Section 43(a) of the Lanham Act as a Defender of Artists' "Moral Rights"*, 73 TRADEMARK REP. 251, 270-72 (1983); Goldberg, *supra* note 214, at 1057-58.

217 Krigsman, *supra* note 216, at 255.

218 Gabay, *The United States Copyright System and the Berne Convention*, 26 BULL. COPYRIGHT SOC'Y 202, 204 (1979).

219 Berne Convention For the Protection of Literary and Artistic Works (Paris Text—July 24, 1971) [hereinafter Berne Convention], *reprinted in* 4 NIMMER, *supra* note 26, at app. 27.

220 Actually, adherence to the Berne Convention would necessitate change in other provisions of the United States copyright statute as well, most importantly the areas concerning copyright formalities. *See generally* Gabay, *supra* note 218. On October 1, 1986, Senator Charles McC. Mathias, Jr. introduced a bill, S. 2904, for the purpose of amending the 1976 Copyright Act to be more consistent with the Berne Convention. However a moral rights provision was not included in this bill. *Bill to Implement Berne Convention Would Eliminate 'Copyright Formalities'*, 32 Pat. Trademark & Copyright J. (BNA) 626 (1986).

221 Gantz, *Protecting Artists' Moral Rights: A Critique of the California Art Preservation Act as a Model for Statutory Reform*, 49 GEO. WASH. L. REV. 873, 876-77 n.20 (1981). The following language has been proposed as part of the "Visual Artists Moral Rights Amendment" to be added to 17 U.S.C. § 113:

> (d) Independently of the author's copyright in a pictorial, graphic, or sculptural work, the author or the author's legal representative shall have the right, during the life of the author and fifty years after the author's death, to claim authorship of such work and to object to any distortion, mutilation, or other alteration thereof, and to enforce any other limitation recorded in the Copyright Office that would prevent prejudice to the author's honor or reputation.

H.R. 1521, 98th Cong., 1st Sess. (1983), *reprinted in* 25 Pat. Trademark & Copyright J. (BNA) 374 (1983); H.R. 2908, 97th Cong., 1st Sess. (1981). On September 9, 1986, Senator Edward Kennedy introduced S. 2796, a much expanded version of the above

producers, opposed adherence to the Berne Convention due to the moral rights requirement.[222] However, with the growth in technology that is easily infringed or pirated, these users are now in favor of the United States joining the Berne Convention.[223] Presently, hearings before Congress continue,[224] and President Reagan has recommended that membership in the Berne Convention be adopted.[225] Also, extensive changes to the 1976 Copyright Act may not be necessary for the United States to become a signatory to the Berne Convention.[226]

Member nations of the Berne Convention have varying degrees of moral rights within their statutes, and some countries rely upon common law protections, rather than a specific statute, for their adherence.[227] Therefore, even if the United States were to join the Berne Convention, there is no guarantee that this action would provide original black and white filmmakers protection for their creations[228] beyond the measures currently available to them through contract law[229] or section 43(a) of the Lanham Act.[230]

A. *The Doctrine of Droit Moral*

"American copyright law, as presently written, does not recognize moral rights or provide a cause of action for their violation, since the law seeks to vindicate the economic, rather than the personal, rights of authors."[231] Personal rights of authors and artists are protected under the doctrine of *droit moral* or

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bill. *Bill Would Prohibit Distortion of Art Works and Allow Resale Royalties*, 32 Pat. Trademark & Copyright J. (BNA) 607 (1986). However, the proposed amendment, in the original form and Senator Kennedy's version, does not include moral rights for motion pictures and other audiovisual works which are accorded copyright protection under 17 U.S.C. § 102(a) (1982).

222 Nimmer, *Implications of the Prospective Revisions of the Berne Convention and the United States Copyright Law*, 19 STAN. L. REV. 499, 524 (1967); Roeder, *The Doctrine of Moral Right: A Study in the Law of Artists, Authors and Creators*, 53 HARV. L. REV. 554, 558, 577 (1940).

223 *Press U.S. to Join Berne C'right Convention, 100 Yrs. Old in '86*, Variety, Apr. 23, 1986, at 4, col. 1, at 266, col. 1.

224 Telephone interview with Dorothy Schrader, General Counsel to the Copyright Office of the Library of Congress (Aug. 5, 1986).

225 President's Message to the Senate Transmitting the [Berne] Convention, 22 WEEKLY COMP. PRES. DOC. 827 (June 18, 1986) (also reprinted in 98 Copyright L. Rep. (CCH) ¶ 20,378 (1986)).

226 *See* DuBoff, Winter, Flacks, & Keplinger, *Out of UNESCO and into Berne: Has United States Participation in the Berne Convention for International Copyright Protection Become Essential?*, 4 CARDOZO ARTS & ENT. L.J. 203, 231 (1985) (adjustments, rather than fundamental changes, are all that is necessary).

227 *Id.*; *see also* FINAL REPORT, *supra* note 215, at 36-37 & 43-44.

228 *See infra* text accompanying notes 249-53; *see also supra* note 221.

229 *See infra* notes 256-83 and accompanying text.

230 15 U.S.C. § 1125(a) (1982); *see infra* notes 295-324 and accompanying text.

231 Gilliam v. American Broadcasting Cos., 538 F.2d 14, 24 (2d Cir. 1976).

moral rights.[232] *Droit moral* is a concept developed by countries with civil law systems,[233] and is subscribed to by the nations which are signatories to the Berne Convention.[234] These countries recognize that artwork is an expression of personality,[235] and that an artist's relationship with a work does not end at completion of the work,[236] or at the termination of the artists' property right in the work.[237] In contrast, the United States considers art an economic commodity, and only affords protections to the owner of the artistic property.[238]

Droit moral is a "bundle of rights",[239] consisting of two main elements: the right of paternity and the right of integrity.[240] These are enumerated within the Berne Convention provision on *droit moral*:

> Independently of the author's economic rights, and even after

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232 For thorough discussions of *droit moral*, see Sarraute, *Current Theory on the Moral Right of Authors and Artists Under French Law*, 16 AM. J. COMP. L. 465 (1968); Roeder, *supra* note 222.

233 *See* Rosen, *Artists' Moral Rights: A European Evolution, An American Revolution*, 2 CARDOZO ARTS & ENT. L.J. 155 (1983) (discussion of the development of moral rights in Europe); Sarraute, *supra* note 232 (discussion of the French *droit moral* laws, the first of such laws to be codified); *see also* DaSilva, Droit Moral *and the Amoral Copyright: A Comparison of Artists' Rights in France and the United States*, 28 BULL. COPYRIGHT SOC'Y 1 (1981).

234 For a listing of the nations that are members of the Berne Convention, see 4 NIMMER, *supra* note 26, at app. 22.

235 *E.g.*, DaSilva, *supra* note 233, at 12; Roeder, *supra* note 222, at 557.

236 Rosen, *supra* note 233, at 156; Davis, *State Moral Rights Law and the Federal Copyright System*, 4 CARDOZO ARTS & ENT. L.J. 233, 234 & n.11, (1985).

237 *See* DaSilva, *supra* note 233, at 12 (under the French system, even a work made for hire creates rights which attach to the artist); *Rosen, supra* note 233, at 176-77.

238 *See* Rosen, *supra* note 233, at 169; Roeder, *supra* note 222, at 576. Moral rights and property rights are two very distinct concepts with moral rights having evolved from the "natural law theory of aesthetics." Rosen, *supra* note 233, at 177.

As of the 1940's, the United States had not yet experienced the cultural development that had occurred in Europe; therefore, the importance of artistic expression had been largely ignored. Reverence was reserved for the products of industry, rather than for artistic creativity. Rosen, *supra* note 233, at 179, 181. The idea that artists retain natural rights in their works was "foreign" to this country, which had been raised on the importance of "[w]estward expansion and economic development." Rosen, *supra* note 233, at 181; Roeder, *supra* note 222, at 557. "The enactment of copyright legislation by Congress under the terms of the Constitution is not based upon any natural right that the author has in his writings, for the Supreme Court has held that such rights as he has are purely statutory rights . . . ." H.R. REP. No. 2222, 60th Cong., 2d Sess. 7 (1909), *reprinted in* 6 E. BRYLAWSKI & A. GOLDMAN, LEGISLATIVE HISTORY OF THE 1909 COPYRIGHT ACT S7 (1976).

The United States copyright laws were designed to protect pecuniary interests in a creation, and only on a temporary basis. *See supra* notes 26-28 and accompanying text. However, the interest of the United States in preserving and protecting its artwork has grown in recent years, a time when art has become an industry unto itself. *See* Rosen, *supra* note 233, at 186-87.

239 Granz v. Harris, 198 F.2d 585, 590 (2d Cir. 1952) (Frank, J., concurring) (footnote omitted).

240 The other elements are: the right of disclosure to the public of one's work; and, the right to withdraw that work from the public. Sarraute, *supra* note 232, at 467.

> the transfer of the said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation, or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation.[241]

The right of paternity is "the right to have one's name and authorship recognized."[242] This definition allows creators to present themselves as the authors of their work, to require others to so present them (thereby preventing others from receiving such credit), and to prevent false attribution of the work of others as their works.[243] The right of integrity "arises only after the work has been completed, published, performed, or transferred."[244] The purpose of the right of integrity is to allow artists to have their creations preserved and displayed in the form originally intended.[245] However, the right of integrity is often protected through the right of paternity, by enjoining alterations of works which are attributed to the creator and misrepresent the creator's intent.[246]

Under a system that recognizes *droit moral*, it is possible for filmmakers to enjoin the colorization of their films if changes from black and white are considered alterations of the spirit of the works.[247] In contrast, under United States law, filmmakers are accorded a lesser degree of control over their work. Once a film is completed and transferred, filmmakers lose the property rights to their works.

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241 Berne Convention, art. 6*bis*, para. 1, *supra* note 219, at app. 27-5 to -6.

242 Sarraute, *supra* note 232, at 467.

243 Roeder, *supra* note 222, at 561-62.

244 DaSilva, *supra* note 233, at 30; *see also* Sarraute, *supra* note 232, at 480.

245 *Granz*, 198 F.2d at 589 (Frank, J., concurring) (An artist is "entitled to prevention of the publication, as his, of a garbled version of his uncopyrighted product."); DaSilva, *supra* note 233, at 31 (" '[R]ight of integrity' means that the artist has a right to preserve his work from any alterations or mutilation whatsoever.").

246 *See* Krigsman, *supra* note 216, at 257; *see also infra* notes 295-324 and accompanying text.

247 As the right of integrity prevents alterations without the artist's consent, the existence of the right to make derivative works would appear to be a nullity, since all transfers to other media would necessitate "certain organic changes." DaSilva, *supra* note 233, at 34. *But see supra* note 135 (A transfer from film to videotape should not be considered an adaptation in a new medium. Although, experts in the broadcasting and film industries would say that there is a difference in the quality of such a transfer, it is still considered a copy.).

However, countries recognizing *droit moral* have dealt with the problem. Rather than preventing adaptation to other media and the creation of other derivative works, the adaptor is expected to "transpose, with honesty, the spirit, character and substance of the work." Giocanti, *Moral Rights: Authors' Protection and Business Needs*, 10 J. INT'L L. & ECON. 627, 642 (1975) (quoting Schmidt, *L'Application Jurisprudentielle de la Loi du 11 Mars 1957*, 84 REVUE INTERNATIONALE DU DROIT D'AUTEUR 92 (1975)). The freedom to alter a work is spelled out in the contract between the adaptor and the artist, but the courts must decide whether a violation of integrity has occurred. DaSilva, *supra* note 233, at 35-37; *see also* Sarraute, *supra* note 232, at 480-83.

Such a loss is significant because it is only through these rights that filmmakers may protect the integrity of their work.[248]

The complexities attendant with recognition of moral rights may explain the United States' reluctance to add such a provision to its copyright law.[249] The United States prefers that creators bargain for provisions that will protect the integrity of their artworks.[250] Moral rights are usually considered inalienable; thus, if moral rights are enacted in the United States, courts would be forced to give preference to such rights over any contractual rights or waivers.[251] However, the United States favors the enforcement of rights obtained by contractual provisions due to the belief that these expose the clear expression of the parties' intent.[252] This prevents courts from making judgments based upon subjective attitudes toward the merits of the claim.[253] Some courts have recognized, however, that protection of integrity exists by analogy to certain statutory or common law protections,[254] and some states have added their own equivalents to moral rights within their statutes.[255]

B. *The Right of Integrity in the United States*

1. Contract Law

The United States considers intellectual property a commodity and treats its transfer as it would any other type of property.[256] Therefore, courts most frequently use contract theories to determine the rights of creators as against the rights of owners

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248 *See supra* note 214.

249 *See supra* note 247. *But see supra* note 238.

250 *See infra* notes 256-77 and accompanying text; *see generally Artistic Integrity*, *supra* note 214.

251 Krigsman, *supra* note 216, at 253 & n.13.

252 *See* Vargas v. Esquire, Inc., 164 F.2d 522, 526 (7th Cir. 1947) (quoting Domeyer v. O'Connell, 364 Ill. 467, 470, 4 N.E.2d 830, 832 (1936)).

253 However, "[c]ourts have interfered with the freedom to contract in . . . cases where one party enjoys a disproportionate bargaining advantage and uses it to the unreasonable detriment of both the weaker party and the general public welfare." Note, *Authors' and Artists' Rights in the United States: A Legal Fiction*, 10 HOFSTRA L. REV. 557, 587 & n.210 (1982) [hereinafter *Authors' and Artists' Rights*]; *see also* E. FARNSWORTH, CONTRACTS § 7.11, at 499-500 (1982).

254 *See supra* note 215; *see also* Seroff v. Simon & Schuster, Inc., 6 Misc. 2d 383, 387-88, 162 N.Y.S.2d 770, 774-75 (Sup. Ct. 1957), *aff'd*, 12 A.D.2d 475, 210 N.Y.S.2d 479 (1st Dep't 1960). For a discussion of laws that are purported to give some protection to moral rights, see *Authors' and Artists' Rights*, *supra* note 253.

255 *See infra* notes 325-42 and accompanying text.

256 Parton v. Prang, 18 F. Cas. 1273, 1278 (D. Mass. 1872) (No. 10,784); Goldberg, *supra* note 214, at 1044-45; Note, *Giving the Devil Its Due: Actors' and Performers' Right to Receive Attribution for Cinematic Roles*, 4 CARDOZO ARTS & ENT. L.J. 299, 312 (1985) [hereinafter *Right to Receive Attribution*].

of artworks.[257] Assuming there are no earlier contractual ties, during the time a film is under copyright the original filmmaker-copyright proprietor has full power over the disposition of rights in that film. Once the rights of ownership are transferred by the original filmmaker, the copyright statute will not protect the integrity of the original film, unless the filmmaker provides for protections in the contract.[258] The owner of a film's copyright, or license of rights, may contract on an extremely broad or narrow basis for the commercial exploitation of the work, disregarding the integrity of the film,[259] except as to how disposal of the individual rights might affect the rights retained by the original filmmaker and public policy.[260]

If a filmmaker retains a pecuniary interest in the copyright of the creation, its integrity may be protected for the duration of the film's copyright, by activating the ownership rights and remedies provided by copyright law.[261] However, if a filmmaker has prepared a film on a "works made for hire" basis,[262] or has made an assignment of the copyright, it is left to the courts to interpret the contracts involved and to uncover what rights the creator has reserved.[263]

Film productions are usually prepared on works made for hire terms and the copyrights are owned by the studios or producing entities.[264] In most cases, the studios owning the copyrights have total control over the licensing of alterations to the

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257 *See* Krigsman, *supra* note 216, at 272; Goldberg, *supra* note 214, at 1044-46; *Authors' and Artists' Rights*, *supra* note 253, at 558, 563-65.

258 *See supra* note 214; *see also* Treece, *America Law Analogues of the Author's "Moral Right"*, 16 AM. J. COMP. L. 487, 501 (1968). Film artists are now asking for "absolute creative right" clauses in their guild contracts. *See* Linfield, *supra* note 2, at 35. However, once the copyright expires in a film the rights and protections accorded an artist in a contract will expire.

259 "Copyright in America, as limited by statute, was designed to protect only the exploitive value of creation; its protection is not granted to the *creator* as such, but to the *owner*, the person having the power to exploit the creation." Roeder, *supra* note 222, at 576 (emphasis in original). 17 U.S.C. § 115(a)(2) (1982) provides the one exception, by allowing compulsory licensees of phonorecords the ability to make musical arrangements, but only with the express consent of the copyright owners.

260 *See infra* note 274 and accompanying text.

261 17 U.S.C. §§ 106, 502-505 (if a colorized work was made without authorization the copyright proprietor could then bring an action for copyright infringement).

262 *Id.* § 201(b).

263 "Where . . . parties have entered into a contract . . . plaintiff's so-called 'moral right' is controlled by the law of contract . . . ." Edison v. Viva Int'l, Ltd., 70 A.D.2d 379, 384, 421 N.Y.S.2d 203, 206 (1st Dep't 1979); *see also* Seroff v. Simon & Schuster, Inc., 6 Misc. 2d 383, 388-90, 162 N.Y.S.2d 770, 775-76 (Sup. Ct. 1957), *aff'd*, 12 A.D.2d 475, 210 N.Y.S.2d 499 (1st Dep't 1960). For a history of various contract interpretations, see Goldberg, *supra* note 214.

264 Studios raise revenue for the production, often developing the project, providing equipment and facilities, and taking charge of distribution.

original films.[265] Unless it is stipulated in employment contracts that the filmmakers have the right to approve any alterations,[266] these creators cannot prevent colorization. With the exception of those eminent directors who retained economic investments in their films, it is unlikely that clauses containing the right to consent to alterations were obtained.[267] It is also unlikely that any directors during the early years of the film industry had the foresight to add such terms to their employment contracts with a studio. In fact, it is common for film contracts to require a broad grant of rights and a waiver of any claims of *droit moral*.[268]

Courts have followed freedom of contract principles when interpreting the rights assigned or retained by artists.[269] Contract law assumes that the parties had equal bargaining power;[270] therefore, the predominant view is that rights must be expressly reserved by the artist or the right claimed is presumed to have been waived.[271] Courts have stated that a reservation of rights

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265 Compare with French law, where moral rights have been extended to five of the creators of films: the storywriter, the adaptor, the scriptwriter, the composer of music, and the director. Sarraute, *supra* note 232, at 474-75 (quoting Loi du 11 mars 1957 Sur La Propriété Littéraire Artistique, art. 14); *see also* DaSilva, *supra* note 233, at 13-14. To prevent paralyzing the production of a film, the moral rights of these artists may be invoked only at the completion of a film, completion being a joint agreement among the collaborators and the producer. Sarraute, *supra* note 232, at 475 (quoting Loi du 11 mars 1957 Sur La Propriété Littéraire Artistique, art. 16).

266 The filmmaker with a contractual right to agree to alterations must pursue the right of action against mutilation through the copyright proprietor. A duty of care is implied to the assignee of the copyright, to see that the terms of the contract are carried out. *See* 2 NIMMER, *supra* note 26, § 8.21[C], at 8-254 & n.29.

267 A developing artist is in an inferior bargaining position *vis-à-vis* a reservation of rights in a contract. Krigsman, *supra* note 216, at 259 ("For the unknown, commercially-untested artist having little or no bargaining power, insistence on contractual integrity rights may result in the loss of the contract and a prolonged stay in obscurity."); *see also Authors' and Artists' Rights*, *supra* note 253, at 564. *But see supra* note 258.

268 The following is a typical provision for waiver of *droit moral*:

> You, having acknowledged your understanding of the needs of motion picture, television and other productions by granting us the unlimited right to change, vary, alter, add to, take from, substitute, combine and/or modify the Work as aforesaid, do hereby now waive the benefits of any provision of law known as the "droit moral" or any similar laws and agree not to institute, support, maintain or permit any action or lawsuit on the ground that any exercise of any of the rights granted us hereunder by us, our assignees or licensees by any means or through any media now known or hereafter devised, is in any way a defamation or multilation [sic] of said Work or any part thereof or contains unauthorized variations, alterations, modifications, changes or translations.

R. WINCOR, LITERARY RIGHTS CONTRACTS: A HANDBOOK FOR PROFESSIONALS 194 (1979).

269 *Authors' and Artists' Rights*, *supra* note 253, at 563; *see also* Goldberg, *supra* note 214, at 1044-45. *But see* Ettore v. Philco Television Broadcasting Corp., 229 F.2d 481 (3d Cir.), *cert. denied*, 351 U.S. 926 (1956).

270 E. FARNSWORTH, *supra* note 253, § 7.11, at 498; *Right to Receive Attributon*, *supra* note 256, at 313.

271 *E.g.*, Granz v. Harris, 198 F.2d 585, 588-89 (2d Cir. 1952); Vargas v. Esquire, Inc., 164 F.2d 522, 525-26 (7th Cir. 1947) (right to credit for artwork not available when

cannot be implied where the contract's language is in broad, general terms,[272] and some courts will look to the customs of the industry for guidance in contract interpretation.[273] Therefore, even if the use complained of was not a use contemplated at the time the contract was executed, the right of disposition over that use is deemed waived, absent unfairness or a breach of public policy.[274] Where the contract is silent concerning the disposition of certain rights, some courts have held that the artist retained those rights,[275] especially if the use complained of was not known at the time of contracting.[276] These courts will use contracts that have been narrowly drawn as evidence that the artists would have expressly reserved, or waived, their rights had the specific use been known.[277] A distinction is made, however, between experienced contractors and artists unacquainted with business practices.[278]

If the original filmmaker owns the copyright to his work, and grants an unconditional license to the colorist, theoretically, there could be no cause of action based upon copyright infringement.[279] Yet, courts have extended protection against "mutila-

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contract assigned all rights to the art without limitation); Seroff v. Simon & Schuster, Inc., 6 Misc. 2d 383, 388-91, 162 N.Y.S.2d 770, 775-78 (Sup. Ct. 1957), *aff'd*, 12 A.D.2d 475, 210 N.Y.S.2d 479 (1st Dep't 1960); *see* Royle v. Dillingham, 53 Misc. 383, 384, 104 N.Y.S. 783, 784 (Sup. Ct. 1907).

272 *See, e.g.*, Bartsch v. Metro-Goldwyn-Mayer, Inc. 391 F.2d 150, 155 (2d Cir.), *cert. denied*, 393 U.S. 826 (1968); Burnett v. Warner Bros. Pictures, Inc., 113 A.D.2d 710, 712-13, 493 N.Y.S.2d 326, 328 (1st Dep't 1985), *aff'd*, 67 N.Y.2d 912, 492 N.E.2d 1231, 501 N.Y.S.2d 815 (1986).

273 Krigsman, *supra* note 216, at 258-59; Comment, *The Monty Python Litigation—of Moral Right and the Lanham Act*, 125 U. PA. L. REV. 611, 632-33 (1977) [hereinafter *Monty Python Litigation*]; *see* Edison v. Viva Int'l, Ltd., 70 A.D.2d 379, 384, 421 N.Y.S.2d 203, 205 (1st Dep't 1979); Preminger v. Columbia Pictures Corp., 49 Misc. 2d 363, 366, 267 N.Y.S.2d 594, 598 (Sup. Ct.), *aff'd mem.*, 25 A.D.2d 830, 269 N.Y.S.2d 913 (1st Dep't), *aff'd mem.*, 18 N.Y.2d 659, 219 N.E.2d 431, 273 N.Y.S.2d 80 (1966).

274 Ettore v. Philco Television Broadcasting Corp., 229 F.2d 481, 491 & n.14 (3d Cir.) (Fighter was not expected to know of the advent of commercial television at time he contracted for sale of his motion picture rights to his fight with Joe Louis. "Fairness would seem to require that a court treat the absence of the new or unknown media . . . as about the equivalent of a reservation against the use of the work product . . . by a known medium . . . ."), *cert. denied*, 351 U.S. 926 (1956); Inge v. Twentieth Century-Fox Film Corp., 143 F. Supp. 294, 298 (S.D.N.Y. 1956). In cases where there is an extreme example of wrongful conduct, the court may treat the case as a "tortious breach of an implied covenant of good faith and fair dealing . . . ." *Right to Receive Attribution*, *supra* note 256, at 318-19.

275 *See, e.g.*, Manners v. Morosco, 252 U.S. 317 (1920); Warner Bros. Pictures, Inc. v. CBS, Inc., 216 F.2d 945 (9th Cir. 1954) (where contract is silent, a reservation is implied when the drafting of the contract is in the hands of the grantee).

276 *See Ettore*, 229 F.2d at 490-91.

277 *See, e.g.*, *Burnett*, 113 A.D.2d at 712-13.

278 *Bartsch*, 391 F.2d at 154 & n.2.

279 *See* Autry v. Republic Prods., 213 F.2d 667, 669 (9th Cir.), *cert. denied*, 348 U.S. 858 (1954); 2 NIMMER, *supra* note 26, § 8.21[C][1], at 8-249 & n.11.

tion" in certain cases where alterations of the work have been deemed to exceed what was intended by the license.[280] Alternatively, where the contract is silent in respect to alterations, the copyright proprietor is deemed to have reserved such rights except as to what may be necessary to complete the other contract terms.[281]

The copyright proprietor of a film has the right to license all uses of that work,[282] and, therefore, is entitled to contract for the colorization of the film. Many copyright proprietors, and filmmakers with continuing pecuniary interests in the film, may not necessarily object to colorization. The possibility of capitalizing further on the film through increased value would temper some doubts about the process. However, to retain some protection over the integrity of the film from the colorization process, the copyright holder must contractually reserve the following rights: 1) to oversee the process of colorization; 2) to give final approval to the finished product; 3) to approve distribution; and 4) to order destruction of the new version if it is deemed unsatisfactory.[283]

2. Unfair Competition and Section 43(a) of the Lanham Act

The law of unfair competition, under common law, protects a plaintiff from losses by a competitor's attempt at "palming off" or "passing off"—selling one's goods under the name of a more

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280 In Gilliam v. American Broadcasting Cos., 538 F.2d 14, 21-23 (2d Cir. 1976), the court found that the defendant's editing of the plaintiffs' television performance was extensive, and transcended any rights the plaintiffs granted to the original licensee. The defendant, ABC, received its license to broadcast plaintiffs', Monty Python, television programs by way of a series of intermediate conveyances from the original licensee, the British Broadcasting Corporation ("BBC"). *Id.* at 17-18. The court found that the original contract between Monty Python and the BBC did not contain a clause entitling "BBC to alter a program once it [had] been recorded." *Id.* at 17. Therefore, the court reasoned that the plaintiffs had retained, under the clause explicitly reserving all rights not granted, the right to consent to alteration of their work. *Id.* at 22. The court also concluded that plaintiffs would likely win a judgment at trial based on infringement of the common law copyright. *Id.* at 23; *see also* Preminger v. Columbia Pictures Corp., 49 Misc. 2d 363, 372, 267 N.Y.S.2d 594 (Sup. Ct.), *aff'd mem.*, 25 A.D.2d 830, 269 N.Y.S.2d 913 (1st Dep't), *aff'd mem.*, 18 N.Y.2d 659, 219 N.E.2d 431, 273 N.Y.S.2d 80 (1966); Stevens v. National Broadcasting Co. 148 U.S.P.Q. (BNA) 755 (Cal. Super. Ct. 1966); 2 NIMMER, *supra* note 26, § 8.21[C][1] n.11, at 8-249 to -250; Goldberg, *supra* note 214, at 1054 n.50.

281 2 NIMMER, *supra* note 26, § 8.21[C][1], at 8-250 to -251; *Monty Python Litigation*, *supra* note 273, at 631.

282 *See* 17 U.S.C. § 106 (1982).

283 This would satisfy the court's observation in Geisel v. Poynter Prods., Inc., 295 F. Supp. 331, 339-40 n.5 (S.D.N.Y. 1968), that a contract can provide for moral rights protection. *See* Maslow, *"Droit Moral" and Sections 43(a) and 44(i) of the Lanham Act—A Judicial Shell Game?*, 48 GEO. WASH. L. REV. 377, 380 n.31 (1980); Krigsman, *supra* note 216, at 257.

popular competitor.[284] Unfair competition was originally developed "to protect the good will of an enterprise,"[285] and was later expanded to protect against the tort of misappropriation[286] and the publication of a mutilated work.[287] The doctrine of unfair competition seems a likely theory to invoke to protect the integrity of films from colorization,[288] because the colorized films compete with their black and white predecessors in the marketplace. However, it is not clear that courts will accept an unfair competition claim by filmmakers who are without a pecuniary interest in the copyrights of their films, or when the motion pictures are in the public domain.[289] Also, there is no indication that an addition of color would create the economic injury, born of consumer confusion, that is necessary for unfair competition claims, especially when the creators of the original films are no longer entitled to compensation for their works.[290] In fact, color might revive interest in older films, giving their creators greater visibility in the marketplace. Unfair competition as a remedy for the torts of misrepresentation and mutilation has been found too unreliable a theory.[291] Therefore, artists and courts responding to the inadequate protections under this and other common law theories[292] have pursued section 43(a) of the Lanham Act[293] for

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284 *See* 1 J. McCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 1.7, at 19 (1984); Goldberg, *supra* note 214, at 1049; Maslow, *supra* note 283, at 382. "Unfair competition is a commercial tort." 1 J. McCARTHY, *supra*, § 1.3, at 12 (footnote omitted).

285 Maslow, *supra* note 283, at 382.

286 *Id.*; *Monty Python Litigation*, *supra* note 273, at 620.

287 2 NIMMER, *supra* note 26, § 8.21[C], at 8-254 & n.27.

288 *See* Prouty v. National Broadcasting Co., 26 F. Supp. 265 (D. Mass. 1939). The author of a well-known novel brought suit for misappropriation of the title character by a radio network, without the aid of a copyright infringement action. The plaintiff claimed broadcasts of radio plays degraded her work. The court dismissed defendant's summary judgment motion pending a hearing on the merits of the plaintiff's unfair competition claim. *Id.* at 265-66.

289 1A R. CALLMANN, UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES § 4.62 (4th ed. 1986). When there is a copyright infringement, unfair competition provides an "independent additional tort." *Id.* However, a claim of unfair competition by itself may be federally preempted under 17 U.S.C. § 301 (1982). *See* Harvey Cartoons v. Columbia Pictures Indus., 645 F. Supp. 1564, 1573 (S.D.N.Y. 1986); 1A R. CALLMANN, *supra*, at § 4.62. *Compare* Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225 (1964) *and* Compco Corp. v. Day-Brite Lighting Inc., 376 U.S. 234 (1964) *with* Goldstein v. California, 412 U.S. 546 (1973) *and* Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977).

290 "As long as there is no commercial injury, an aggrieved artistic creator remains without protection under a theory of unfair competition." *Authors' and Artists' Rights*, *supra* note 253, at 581. However, unfair competition is premised on preventing confusion of the public rather than remedying an injury to the private individual. Goldberg, *supra* note 214, at 1049; Roeder, *supra* note 222, at 568 ("The theory of unfair competition depends upon fortuitous fact that to present a deformed work to the public may economically injure the creator by depriving him of his market.").

291 Note, *The Lanham Trademark Act, Section 43(a)—A Hidden National Law of Unfair Competition*, 14 WASHBURN L.J. 330, 339 (1975).

292 *Authors' and Artists' Rights*, *supra* note 253, at 560.

federal statutory protection of the integrity of their creations.[294]

Section 43(a) of the Lanham Act is designed to regulate unfair trade practices, specifically false or misleading representation of goods or services in interstate commerce.[295] The statute was enacted as part of the federal trademark statute, but the protections afforded by this section can be had without a registered trademark.[296] There is some discrepancy among jurisdictions as to who has standing under section 43(a).[297] However, many courts broadly construe the statute, and accept claims by artists, who may be damaged by false representations in connection with the use of their works.[298] Section 43(a) of the Lanham Act is equivalent to a federal law of unfair competition[299] and has come to function as the American equivalent to *droit moral.*

In the seminal case, *Gilliam v. American Broadcasting Cos.*,[300] Judge Lumbard, writing for the Second Circuit, stated in an alternative holding,[301] that the plaintiffs would likely succeed in a sec-

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293 15 U.S.C. § 1125(a) (1982).

294 *See* 1 J. McCARTHY, *supra* note 284, § 1.9, at 24.

295 Any person who shall affix, apply, or annex, or use in connection with any goods or services . . . 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 such goods or services to enter into commerce . . . shall be liable to a civil action by any person . . . who believes that he is or is likely to be damaged by the use of any such false description or representation.

15 U.S.C. § 1125(a).

296 *E.g.*, Gilliam v. American Broadcasting Cos., 538 F.2d 14, 24 (2d Cir. 1976); Smith v. Montoro, 648 F.2d 602, 605 (9th Cir. 1981); Silverman v. CBS, Inc., 632 F. Supp. 1344, 1356 (S.D.N.Y. 1986); Maslow, *supra* note 283, at 386.

297 *Right to Receive Attribution, supra* note 256, at 320 n.150; *Authors' and Artists' Rights, supra* note 253, at 567 n.72. It is generally considered that consumers cannot raise a claim. Colligan v. Activities Club of N.Y., Ltd., 442 F.2d 686, 687 (2d Cir.), *cert. denied,* 404 U.S. 1004 (1971); Note, *Section 43(a) of the Lanham Act—A Federal Unfair Competition Remedy,* 25 DRAKE L. REV. 228, 231 (1975). Compare this with the *droit moral* laws under which a public entity or official is able to bring actions preventing the distortion of art works when the original artists are no longer alive. *See* Petrovich, *Artists' Statutory "Droit Moral" in California: A Critical Appraisal,* 15 LOY. L.A.L. REV. 29, 66-67 (1981); Merryman, *The Refrigerator of Bernard Buffet,* 27 HASTINGS L.J. 1023, 1042 (1976).

298 *See, e.g., Gilliam,* 538 F.2d at 24; Follett v. New Am. Library, Inc., 497 F. Supp. 304, 313 (S.D.N.Y. 1980); *see also* 1 R. CALLMANN, *supra* note 289, at § 2.07; Maslow, *supra* note 283, at 387; *Monty Python Litigation, supra* note 273, at 621; *Authors' and Artists' Rights, supra* note 253, at 568 (The commentator calls this an "unprecedented and unprincipled reading of the statute.").

299 *Gilliam,* 538 F.2d at 24; 1 J. McCARTHY, *supra* note 284, § 1.9, at 24; Maslow, *supra* note 283, at 383. However, unlike state unfair competition laws, § 43(a) of the Lanham Act is exempt from copyright preemption. *See* 17 U.S.C. § 301(d) (1982). Therefore, "[t]he fact that a copyrightable [element] has fallen into the public domain should not preclude protection under the trademark laws so long as it is shown to have acquired independent trademark significance . . . ." Frederick Warne & Co. v. Book Sales Inc., 481 F. Supp. 1191, 1196 (S.D.N.Y. 1979).

300 538 F.2d 14 (2d Cir. 1976).

301 *Gilliam*'s actual holding was based on contract and common law copyright. *See supra* note 280.

tion 43(a) action.[302] The defendant, ABC, had violated section 43(a) of the Lanham Act by creating a false impression that the plaintiffs, members of the Monty Python comedy group, were responsible for the origin of an edited program featuring their work.[303] In fact, the plaintiffs were not disposed to having their work edited without their consultation.[304] The court found that the version which ABC had broadcast "impaired the integrity of [the] work."[305] The broadcast, by presenting a "mere caricature of [plaintiffs'] talents,"[306] was an actionable distortion,[307] because it misrepresented the plaintiffs' work to the audience and was injurious to their reputation.[308]

Judge Gurfein, in his concurrence, stated that the judgment based upon contract and common law copyright was sufficient to protect the plaintiffs' rights.[309] Hence, there was no need to apply the Lanham Act as a protection for moral rights.[310] According to Judge Gurfein, a misrepresentation of the origin of the program would have been prevented by use of a disclaimer, thereby obviating any claim of a Lanham Act violation.[311] Some commentators have agreed with Judge Gurfein and have stated that a mutilation without an accompanying misrepresentation would not be actionable under the Lanham Act.[312] Thus, despite

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302 538 F.2d at 23-24.

303 *Id.* at 24-25. ABC had edited three, thirty-minute programs from the *Monty Python's Flying Circus* series, combining them into one show. *Id.* at 17-18. In doing so, the network eliminated twenty-four minutes of program material. *Id.* at 18. The court found that this version "at times omitted the climax of the skits to which [Monty Python's] rare brand of humor was leading and at other times deleted essential elements in the schematic development of a story line." *Id.* at 25.

304 *Id.* at 17.

305 *Id.* at 25.

306 *Id.*

307 *Id.*

308 *Id.*

309 *Id.* at 26 (Gurfein, J. concurring).

310 *Id.* at 26-27 (Gurfein, J. concurring). "So far as the Lanham Act is concerned, it is not a substitute for *droit moral* which authors in Europe enjoy." *Id.* at 27. Commentators believe that Judge Gurfein's statement, as well as the contract and copyright holding, narrow the impact of *Gilliam* on use of § 43(a) of the Lanham Act as a moral rights substitute. Maslow, *supra* note 238, at 387; *Authors' and Artists' Rights*, *supra* note 253, at 573 ("[C]ontract remains the repository of all rights of integrity that the artistic creator seeks to preserve.") The commentators also state that § 43(a) does not survive a contractual waiver. Krigsman, *supra* note 216, at 269 & n.90.

311 *Gilliam*, 538 F.2d at 27 (Gurfein, J. concurring). *But cf. id.* at 25 n.13; *see also* Benson v. Paul Winley Record Sales Corp., 452 F. Supp. 516, 518 (S.D.N.Y. 1978) (explanatory label placed on albums would be inadequate to compensate for record jacket and record labels which prominently and falsely portray musician as a major performer on the album); *Authors' and Artists' Rights*, *supra* note 253, at 580 (Use of a disclaimer is little remedy for a mutilation of an artist's work. Although disclosure obviates misrepresentation, truth does not always prevent consumer confusion.).

312 Krigsman, *supra* note 216, at 268; *Monty Python Litigation*, *supra* note 273, at 623-24.

the court's broad construction of section 43(a) in *Gilliam*, the Lanham Act only affords limited protection of artists' moral rights.

In a more recent case, *Follett v. New American Library, Inc.*,[313] the court relied solely upon the Lanham Act to protect an author from misrepresentation.[314] Quoting *Gilliam*, the court held that one purpose of the Lanham Act was to "vindicate 'the author's personal right to prevent the presentation of his work to the public in a distorted form,' "[315] as well as to "protect the public and the artist from misrepresentations of the artist's contribution to a finished work."[316] However, the court stated that: "[w]here a description concerning goods is unambiguous, the court can grant relief based on its own findings of falsity without resort to evidence of the reaction of consumers of the goods."[317] One commentator has stated that *Follett* is an expansion of the moral rights doctrine within the Lanham Act as first set down by *Gilliam*.[318]

Under the *Gilliam* and *Follett* applications of section 43(a) of the Lanham Act, if a colorized version of a black and white film is presented as the work of the original filmmaker who disclaims any involvement with the colorization, a cause of action may arise which will indirectly protect the integrity of the film.[319] The original filmmaker would have to show that there is, or is likely to be, an injury to his reputation which results from a misrepresentation, to potential audiences, that the colorized work is attributable to his efforts.[320]

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313 497 F. Supp. 304 (S.D.N.Y. 1980). The author, Ken Follett, previous to publishing his best-selling books, had edited and refashioned an English translation of a non-fiction French work. *Id.* at 306. Upon Follett's achievement of popularity, the American licensee of the owners of the earlier book intended to publish a new edition and changed the attribution of the work, making it appear that Follett was the actual author. *Id.* at 305-09. Follett was successful in this action to enjoin the sales of the book with the above representation. *Id.* at 313.

314 *Id.* at 313.

315 *Id.* (quoting *Gilliam*, 538 F.2d at 24.).

316 *Follett*, 497 F. Supp. at 313.

317 *Id.* at 312.

318 *Authors' and Artists' Rights*, *supra* note 253, at 577.

319 The right of integrity is protected through application of the tort of misrepresentation, which is akin to the right of paternity. *Monty Python Litigation*, *supra* note 273, at 623.

320 To prevail on a § 43(a) claim, the plaintiff must be prepared to make a strong factual showing on the following:

1. that the defendant's advertisement is in fact false;
2. that it actually deceives or has the tendency to deceive a substantial segment of its audience;
3. that such deception is material, in the sense that it is likely to make a difference in the purchasing decision;
4. that the particular plaintiff has been or is likely to be injured as a result of

Hypothetically, if the colorized version of *It's A Wonderful Life* is expressly advertised across the nation as "The New Color Film by Frank Capra," or with any other slogan that would indicate that the director, Mr. Capra, was involved with the colorization of his film, Mr. Capra could bring an action under section 43(a) of the Lanham Act.[321] If Mr. Capra also could show that he has been, or is likely to be damaged by this representation, or that his services as a director are scorned as a result of the distortion and misrepresentation, he could win his suit.[322] Any failure on Mr. Capra's part to show that there is a misrepresentation which results, or is likely to result,[323] in audience confusion could prevent the Lanham Act from protecting his moral rights.[324] Compared with a true moral rights provision which would allow an artist to protect the integrity of his work without requiring evidence of

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> the foregoing, either by direct diversion of sales from himself to the falsely advertising competitor, or by lessening of the good will which his own product enjoys with the buying public.

Weil, *Protectability of Trademark Values Against False Competitive Advertising*, 44 CALIF. L. REV. 527, 536-37 (1956).

321 It is unlikely that the colorists will represent the colorized versions of films to be the works of the original filmmakers. The executives and attorneys of the companies involved in colorization are aware of the potential litigation that may arise from such false representations. Moreover, the companies are in competition with each other and, therefore, need to differentiate their work by indicating its origin. However, it is possible that advertising may confuse audiences into believing that the original filmmakers condoned colorization. Such implied representations also may be injurious to reputation and, therefore, actionable under § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) (1982). *See* Geisel v. Poynter Prods. Inc., 283 F. Supp. 261, 267 (S.D.N.Y. 1968). *But see infra* note 324. Actions under state right of privacy or publicity statutes may also exist. *See* Gieseking v. Urania Records, Inc., 17 Misc. 2d 1034, 1035, 155 N.Y.S.2d 171, 172 (Sup. Ct. 1956) ("[An author] has a property right in his [work] that it shall not be used for a purpose not intended, and particularly in a manner which does not fairly represent his service."); *see also* W. PROSSER & W. KEETON, PROSSER AND KEETON ON THE LAW OF TORTS, § 117, at 851-54 (5th ed. 1984); *Artistic Integrity*, *supra* note 214, at 1545-47.

322 Krigsman, *supra* note 216, at 272. Harm to an artist's reputation can mean loss of economic sustenance—the artist must be seen as a "businessman." *Id.*

323 *See supra* note 320; *see also* Follett v. New Am. Library, Inc., 497 F. Supp. 304, 312 (S.D.N.Y. 1980); Benson v. Paul Winley Record Sales Corp., 452 F. Supp. 516, 518 (S.D.N.Y. 1978).

324 Without an express misrepresentation, Mr. Capra might have trouble proving that an injury to his reputation resulted therefrom. However, a director whose name and reputation is synonymous with his black and white films could have a claim of a Lanham Act violation based on implied misrepresentation by virtue of the colorization of these films. In this situation, a director's reputation, such as that of Orson Welles, as well as his films, would have taken on a secondary meaning, becoming his trademark. *See* Silverman v. CBS, Inc., 632 F. Supp. 1344, 1356 (S.D.N.Y. 1986) ("A mark will be protected if it is inherently distinctive or has become distinctive through 'secondary meaning.' Secondary meaning is the association of a mark with its source."); *see also Authors' and Artists' Rights*, *supra* note 253, at 578-79. The addition of color to the black and white image would be a misrepresentation and injurious to this common law trademark. However, a Lanham Act violation could not be brought by the heirs of Mr. Welles', unlike a moral rights claim that is descendible. *See* Krigsman, *supra* note 216, at 267-68 (the concerns of § 43(a) of the Lanham Act and a *droit moral* statute, which grants perpetual protection, are different); *see also* Petrovich, *supra* note 297, at 66.

commercial injury through misrepresentation, it is apparent that section 43(a) of the Lanham Act provides a limited source of protection.

3. State Law

Five states have promulgated laws that provide protections of artists' moral rights,[325] and other states have had similar provisions under consideration.[326] California and New York, the states most closely associated with art and cultural activities, were the first to demonstrate their concern by initiating legislation[327] to protect art works and those who create them. However, both statutes are narrowly drawn and limited to works of "fine art."

The California Art Preservation Act[328] specifically declares that

> the physical alteration or destruction of fine art, which is an expression of the artist's personality, is detrimental to the artist's reputation, and artists therefore have an interest in protecting their works of fine art against such alteration or destruction; and that there is also a public interest in preserving the integrity of cultural and artistic creations.[329]

The statute defines fine art as "an original painting, sculpture, or drawing, or an original work of art in glass, of recognized quality, but shall not include work prepared under contract for commercial use by its purchaser."[330] Under the commercial use clause, the statute eliminates from protection any "work-for-hire arrangement for use in advertising, magazines, newspapers, or other print and electronic media."[331] The California statute is extremely narrow in its scope, and it excludes motion pictures and other audiovisual works from its protection.[332]

New York's Art and Cultural Affairs Law[333] provides artists with

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325 CAL. CIV. CODE §§ 987-989 (West Supp. 1987); ME. REV. STAT. ANN. tit. 27, § 303 (West Supp. 1986); MASS. GEN. LAWS ANN. ch. 231, § 85S (West Supp. 1986); N.Y. ARTS & CULT. AFF. LAW §§ 14.01-.03 (McKinney Supp. 1987). On December 11, 1986, Pa. House Bill No. 490 (known as the Fine Arts Preservation Act) was signed into law, to take effect in February 1987. Telephone interview with Paula A. Czajka, Pa. Council on the Arts Public Information Officer (Mar. 23, 1987).

326 *See* Gantz, *supra* note 221, at 876 n.19.

327 The California Art Preservation Act was promulgated in 1976, and New York's Art and Cultural Affairs Law was enacted in 1983. Davis, *supra* note 236, at 1.

328 CAL. CIV. CODE §§ 987-989 (West Supp. 1987).

329 *Id.* § 987(a).

330 *Id.* § 987(b)(2).

331 *Id.* § 987(b)(7).

332 *See* Gantz, *supra* note 221, at 883, 888 n.109; *Right to Receive Attribution*, *supra* note 256, at 311.

333 N.Y. ARTS & CULT. AFF. LAW §§ 14.01-.03 (McKinney Supp. 1987).

protections similar to those of section 43(a) of the Lanham Act.[334] New York's law protects an artist's integrity through prevention of misrepresentation. Absent the artist's consent, section 14.03 prohibits publishing, or public display, of artwork that has been "altered, defaced, mutilated or modified . . . if the work is displayed, published or reproduced as being the work of the artist, or under circumstances under which it would reasonably be regarded as being the work of the artist, and damage to the artist's reputation is reasonably likely to result therefrom . . . ."[335] The statute specifically excludes works of "sequential imagery such as that in motion pictures."[336]

Therefore, even with state recognition of some moral rights, filmmakers are still denied protection for their works. Were the statutes changed to include films,[337] the varying jurisdictional provisions may result in unequal protection from state to state.[338] Since films are goods in interstate commerce,[339] and are therefore subject to federal regulation,[340] it is possible that federal law[341] would pre-

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334 15 U.S.C. § 1125(a) (1982).

335 N.Y. ARTS & CULT. AFF. LAW § 14.03(1).

336 *Id.*

337 Massachusetts is the only state to recognize the moral right of the creator of a work of art in video tape or film. *See* MASS. GEN. LAWS ANN. ch. 231, § 85S(b) (West Supp. 1986). However, one Massachusetts practitioner has stated that "[b]y including film in the definition of fine art, the Massachusetts legislature may have bitten off more than the legal system can chew." Koven, *Observations on the Massachusetts Art Preservation Act*, 71 MASS. L. REV. 101, 106 (1986). The new Pennsylvania law, *see supra* note 325, may also protect films. Although limited to fine art, *see* Pa. House Bill No. 490, § 4a, [hereinafter House Bill], the definition of fine art is vague. "An original work of visual or graphic art of recognized quality created using *any* medium. The term shall include, but not be limited to, a painting, drawing or sculpture." House Bill § 2 (emphasis added). However, under § 7 of this bill, "[r]ights and duties . . . (3) shall not exist with respect to a work of fine art created under contract for advertising or other commercial use, unless the contract so provides." House Bill § 7. Until Pennsylvania courts interpret the language of this statute, it cannot be known whether films will be protected.

338 Commentators are unsure of the jurisdictional scope of the statutes. *See* Krigsman, *supra* note 216, at 254 n.15 (stating that the statutes are limited in jurisdiction); Gantz, *supra* note 221, at 882 (observing that the California statute has potentially great extraterritorial reach). Presumably, if the damage to integrity (*i.e.*, by way of the colorization itself, or the misrepresentation of the original filmmaker's contribution) occurs in the state, then the film may be protected under the state statute. *See* Koven, *supra* note 337, at 108; Gantz, *supra* note 221, at 882. However, if the damage is to an in-state plaintiff, but the breach occurs outside the state by an out-of-state defendant, it is likely that the laws of the other state will be applied. *See* Gantz, *supra* note 221, at 883.

339 Films may be regulated by the commerce clause, U.S. CONST. art. I, § 8, cl. 3, as well as the copyright clause, *id.* at cl. 8.

340 This Constitution, and the Laws of the United States which shall be made in Pursuance thereof; and all Treaties made, or which shall be made, under the Authority of the United States, shall be the supreme Law of the Land; and the Judges in every State shall be bound thereby, any Thing in the Constitution or Laws of any State to the Contrary notwithstanding.

U.S. CONST. art. VI, cl. 2.

341 17 U.S.C. § 301 (1982).

empt a state statute[342] that contained moral right protections for films.

IV. CONCLUSION

In the absence of a federal statute expressly protecting moral rights, the integrity of black and white films will not be protected from colorization unless the creators reserve, by contract, the right to approve alterations or state a cause of action under the Lanham Act. However, even if the United States were to promulgate a moral rights statute, it is unlikely that such a provision would provide the necessary protection of integrity that would enable original filmmakers to prevent colorization.

The commercial aspects of films, as well as the fact that films result from collaborative efforts, make it difficult for the legislature to draft a provision that encompasses and protects the rights of all interested parties without impeding the production and exploitation processes of filmmaking. It is more likely that the United States would adopt a narrow law protecting only the rights of fine artists.[343] Such a provision would not track the broad scope of the *droit moral* provisions of many countries or of the Berne Convention.[344] Also, unlike many *droit moral* statutes, the present and proposed laws do not make provisions for the public, which may be offended by colorization, to protect the integrity of films in the creators' stead.[345]

Due to the present lack of protection of moral rights, the judiciary is left to fashion relief for filmmakers whose films and reputations may be scarred by the addition of color. Commentators claim that creative use of various common law and statutory measures may protect moral rights,[346] but "[o]nly if the artist is fortuitously able to fit his case into certain fact patterns, based on laws designed for other purposes."[347]

While colorists and original filmmakers may agree that colorized films are not the same as the black and white originals, their respective interests necessarily conflict. The dilemma is that while colorization is a valuable advancement in film technology[348] and results in a copyrightable intellectual creation,[349] it

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342 *See* Davis, *supra* note 236, at 247-56; Gantz, *supra* note 221, at 893-900.
343 *See supra* note 221.
344 *See* Berne Convention, *supra* note 219, at art. 2, para. 1.
345 *See* Petrovich, *supra* note 297, at 66-67; *see also* Gantz, *supra* note 221, at 888-89.
346 *E.g.*, Davis, *supra* note 236, at 234; Maslow, *supra* note 283, at 381.
347 Davis, *supra* note 236, at 235; *see also supra* note 216 and accompanying text.
348 Colorization can be used to animate and correct flaws in films photographed in color. Cieply, *Movie Classics Transformed to Color Films*, Wall St. J., Sept. 11, 1984, at 37,

nevertheless may destroy the integrity of this century's most valuable monuments of popular art and culture. Therefore, until a statutory protection is enacted, the judiciary must be sensitive to the limited number of claims of original filmmakers that may arise.

> The statue of [Abraham] Lincoln [in the Lincoln Memorial] is all in one color—white. Would the statue be more credible or more forceful if paint was used on his face, beard and those wonderful hands? . . . [T]he statue of Mr. Lincoln belongs to the people just as a classic film in the public domain belongs to the people. Would the people stand still if someone were to paint the beard . . . or blacken his shoes?[350]

Films are no less an art form than any other works of art. Thus, films, and their creators, are deserving of protections which will preserve the integrity of the images from distortion.

Elise K. Bader

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col. 2. It can also be used as an aid in the preservation of color films which are fading. One critic states the irony that while many are trying to raise funds for preservation, colorists are making money from turning black and white films into color. *See 'Colorization', supra* note 13, at 21, col. 1. However, colorization does play a part in preservation, in that the process includes using the best prints and treating these to electronic cleansing techniques. *See* Onosko, *supra* note 2, at 57.

349 *See supra* text accompanying notes 190-207.

350 Capra Letter, *supra* note 15, at 2.