

FIXATION OF DERIVATIVE WORKS IN A TANGIBLE MEDIUM: TECHNOLOGY FORCES A REEXAMINATION

KELLY M. SLAVITT*

I. INTRODUCTION

In the United States, protection for copyrights is found in the Constitution, which grants Congress the power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”¹ The “goal of the Statute of Anne [in 1710, from where the Copyright Clause finds its roots in England,] was to encourage creativity and ensure that the public would have free access to information by putting an end to ‘the continued use of copyright as a device of censorship.’”² The U.S. Supreme Court has held that “[t]he 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.”³ These policies underlying copyright law become even more important when considering technology’s impact.

Technology has changed the way we access, copy, and distribute works, each of which were once separate and distinct actions. At one time not all that

* B.A., Pennsylvania State University; M.P.A. New York University; J.D., Brooklyn Law School; LL.M. in Intellectual Property, Cardozo School of Law. Kelly Slavitt is Associate Counsel at The American Society for the Prevention of Cruelty to Animals (ASPCA) and before moving in-house was associated with Skadden, Arps, Slate, Meagher & Flom and Thelen Reid & Priest in New York City and with Allens Arthur Robinson in Melbourne, Australia. The author would like to thank Professor Justin Hughes.

¹ U.S. Const., art. I § 8, cl. 8.

² *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1260 (11th Cir. 2001) (quoting L. Ray Patterson, *Understanding the Copyright Clause*, 47 J. Copy. Socy. 365, 379 (2000)).

³ *Twentieth Cent. Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975); see Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* vol. 1, § 1.03[A] (Matthew Bender & Co. 2005) (stating that “[t]he primary purpose of copyright is not to reward the author, but is rather to secure the general benefits derived by the public from the labors of authors” (citations and quotations omitted)).

long ago, works were only tangible and accessed primarily by visiting a library or bookstore. Works are now intangible as well as easily accessed via the Internet, where particularly in the United States, network-ready computers and digital equipment have reduced the barriers for accessing information.

Whereas at one time a copy could only be made by transcribing the original by hand, technology advanced so that copies could be made on a copy machine.⁴ Now, technology has advanced such that the original work can be transformed, by copying a hard copy with a scanner, into a digitized version, or simply using a computer to copy one intangible copy to another intangible copy. Making copies of works from the intangible “computer world” to tangible items, like diskettes and CDs via burning or streaming, are clear cases of copies being made and potential areas of infringement. Technology has merely expanded the ease with which these copies can be made.

Distribution of copies is facilitated by technology, which peer-to-peer file sharing of music has highlighted. Technology has advanced to the stage where the compression of data allows copies to be sent more easily. In addition, technology allows distribution of this compressed data at “lightning-quick” speed over phone and cable lines and/or by posting it to a website on the Internet.

More interestingly, technology is allowing people to *transform* works as never before. DJs, which were once only able to transform music by “scratching” an album while it was playing, can now use synthesizers and other technology to transform a song to the more danceable house music version. Technology allows video game enthusiasts to create “patches” which alter the games, such as patches that remove the clothes of women like Lara Croft, from the Tomb Raider games, or unlock sexual graphic images, hidden in video games by software developers, and to distribute these patches widely over the Internet – something makers of video games have been struggling to stop.⁵ Graphic arts

⁴ *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 430 (1984).

From its beginning, the law of copyright has developed in response to significant changes in technology [such as player pianos and perforated rolls of music, which preceded the enactment of the Copyright Act of 1909; innovations in copying techniques that gave rise to the statutory exemption for library copying in the Copyright Act of 1976; and the revisions since then following the development of technology that made it possible to retransmit television programs by cable or by microwave systems in 1968 and 1974, respectively]. Indeed, it was the invention of a new form of copying equipment – the printing press – that gave rise to the original need for copyright protection. *Id.*

⁵ BBC News, *Nude Volleyball Angers Game Makers*, <http://news.bbc.co.uk/go/pr/fr/-/2/hi/technology/2904877.stm> (last updated Apr. 1, 2003, 05:05 UK); Steve Lohr, *In Video Game, a Download Unlocks Hidden Sex Scenes*, N.Y. Times C3 (July 11, 2005).

software and greater memory capacity on computers allows photographs to be altered such that the newly-created work appears real, for example an image of a shark leaping out of the water to eat a person being rescued by a helicopter, which made its way across the Internet during the summer of 2002.⁶

Not all transformations of an original work violate copyright law, however. “[I]n truth, in literature, in science and in art, there are, and can be, few, if any, things, which in an abstract sense, are strictly new and original throughout. Every book in literature, science and art, borrows, and must necessarily borrow, and use much which was well known and used before.”⁷ A transformation from one medium to another, e.g. from radio to television, creates a derivative work and is thus unlawful,⁸ but transformations which may not be derivative works include where the work is not substantially similar to the original, where no more than a trivial amount is added to the original or where the use was fair.

When are transformed works derivative works which are protected by the copyright the owner has in the original work? With new technology, such as computers and the Internet, does the requirement that works be “fixed in a tangible medium” still make sense? How does fair use fit in? What about moral rights? And most importantly, are the policies behind copyright protection being reflected effectively in light of new technologies? How are these issues being treated internationally?

These are new questions, not previously asked and answered in depth within the legal community. This article will examine whether technology has, or should, change the view that derivative works must be fixed in a tangible medium to be protected under U.S. copyright law, using the timely technological example of “clean videos.” This article will also argue that the Family Movie Act of 2005, signed into law by President George W. Bush on April 27, 2005, is bad law.

The first and second parts of this article provide a background both on the requirements for a work to be copyrightable and on derivative works. The third part highlights the conflict between legislative history and caselaw as to whether a derivative work is subject to the requirement that it be fixed in a tangible medium. The fourth part presents a case study of a recent technology which challenges copyright’s fixation requirement. The fifth part analyzes the Family Movie Act of 2005 and proves why it is bad law. The sixth part exam-

⁶ See Stentor Danielson & David Braun, *Shark “Photo of the Year” is E-Mail Hoax*, http://news.nationalgeographic.com/news/2002/08/0815_020815_photooftheyear.html (accessed Oct. 17, 2005).

⁷ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 575 (1994) (citation omitted).

⁸ *Lone Ranger TV v. Program Radio Corp.*, 740 F.2d 718, 721 (9th Cir. 1984).

ines the purpose of fair use and discusses its application to technological advances which allow transformative uses. The seventh part looks at the similarities and differences in how international law addresses these same issues, focusing on treaties and moral rights. Finally, the conclusion argues that the fixation threshold must be interpreted as “the functional equivalent of fixation,” and not an absolute fixation, in order to further copyright law’s ultimate aim of stimulating artistic creativity for the general public good by giving authors the incentive of securing a fair return for their creative labor through the granting of a limited monopoly.

II. COPYRIGHTABLE IF FIXED IN A TANGIBLE MEDIUM

The Framers of the U.S. Constitution realized the importance of protecting copyrights when they granted Congress the power “to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”⁹ These “writings” are called “works” under copyright law.

The 1976 Copyright Act grants copyright protection to:

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

literary works;

musical works, including any accompanying words;

dramatic works, including any accompanying music;

pantomimes and choreographic works;

pictorial, graphic, and sculptural works;

motion pictures and other audiovisual works;

sound recordings; and

architectural works.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.¹⁰

⁹ U.S. Const. art. I, § 8, cl. 8.

¹⁰ 17 U.S.C. § 102 (2000).

A copyright owner has the right to do themselves and to authorize someone else to reproduce their work, prepare similar works, distribute copies, and to perform or display the work publicly.¹¹ A copyright holder's rights are infringed when any of his "bundle of rights" are violated.¹² Violation can be by direct infringement (where lack of intent to infringe is not a defense) or indirect infringement.¹³ Indirect infringers are held liable only if they knew or should have known of the infringement.¹⁴ A contributory infringer is one who, with knowledge of the infringing activity, induces, causes, or materially contributes to the infringing conduct of another,¹⁵ whereas vicarious liability holds anyone who has the authority and ability to control another person who infringes any of the exclusive rights, and who derives a financial benefit therefrom to be vicariously liable for the infringement of another person.¹⁶

Copyright attaches only to original works. A work is "created" when it is fixed in a copy for the first time.¹⁷ A work is "fixed" when

[I]n a tangible medium of expression . . . its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration. A work consisting of sounds, images, or both, that are being transmitted, is "fixed" for purposes of this title if a fixation of the work is being made simultaneously with its transmission.¹⁸

Spoken words are not copyrightable, because the spoken word is not fixed in a tangible medium.¹⁹ Similarly, a live parade and its telecast are not sufficiently fixed.²⁰ Whether video games, made possible by what was once new technology, were copyrightable also confronted the fixation issue, but only after courts first examined whether they were copyrightable. This required proving they were fixed in a tangible medium and original.

While it may seem obvious to us now in this technological age, twenty years ago courts were addressing whether video game programs were copy-

¹¹ *Id.* at § 106 (commonly referred to as The Copyright Act of 1976).

¹² Sen. Rpt. 94-473 at 57 (Nov. 20, 1975); H.R. Rpt. 94-1476 at 61 (Sept. 3, 1976).

¹³ *Gershwin Publ. Corp., v. Columbia Artists Mgt., Inc.*, 443 F.2d 1159, 1162 (1971).

¹⁴ *Id.*

¹⁵ *Id.*

¹⁶ *Shapiro, Bernstein, & Co. v. H.L. Green Co.*, 316 F.2d 304 (1963).

¹⁷ 17 U.S.C. § 101.

¹⁸ *Id.*

¹⁹ See *Falwell v. Penthouse Intl.*, 521 F. Supp. 1204, 1207 (W.D. Va. 1981); *Est. of Hemingway v. Random House, Inc.*, 23 N.Y.2d 341, 348-49 (1968).

²⁰ *Prod. Contractors v. WGN Cont'l. Broad.*, 622 F. Supp. 1500, 1504 (N.D. Ill. 1985).

rightable as “audiovisual works” under Section 102(a) or were to be denied copyrightability under Section 102(b) as a “procedure,” “process,” or “system.”²¹ “Audiovisual works” were defined as

works that consist of a series of related images which are intrinsically intended to be shown by the use of machines or devices such as projectors, viewers, or electronic equipment, together with accompanying sounds, if any, regardless of the nature of the material objects, such as films or tapes, in which the works are embodied.²²

In *Stern Electronics, Inc. v. Kaufman*, copyright protection as an “audiovisual work” was given to video games; coin-operated video machines where visual images were electronically displayed on a television screen and included memory storage devices called PROMs (programmable read only memory), which are ROMs (read only memory) into which information could be programmed after manufacture.²³ It was argued that the video game was not copyrightable as an audiovisual work because it was neither “fixed in any tangible medium of expression” nor “original.”²⁴ The Copyright Act did not provide clear guidance because, although “fixation” is defined, “original” is not.

The *Stern* court struck down the fixation argument because the video game was permanently embodied in a material object, namely, the memory devices from which it could be perceived with the aid of the other components of the game.²⁵ Further, the player’s participation did not render the audiovisual work uncopyrightable because the images remained fixed, capable of being seen and heard each time a player succeeded in keeping his spaceship aloft long enough to permit the appearances of all the images and sounds of a complete play of the game.²⁶

Stern next struck down the originality argument.²⁷ First, the argument that each play of the game was an original work because of the player’s participation (and the analogy to a videotape of a particular play of the game only being given protection for that one “original” display) was struck down because of

²¹ 17 U.S.C. § 102(a); *Id.* at § 102(b) (providing that “[i]n no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work”); see e.g., *Apple Computer v. Franklin Computer Co.*, 714 F.2d 1240, 1252 (3d Cir. 1983).

²² 17 U.S.C. App. § 101 (1976).

²³ *Stern Elec., Inc., v. Kaufman*, 669 F.2d 852, 853-54 (2d Cir. 1982).

²⁴ *Id.* at 855.

²⁵ *Id.* at 856.

²⁶ *Id.*

²⁷ *Id.*

the repeated appearance of the same sequence of numerous sights and sounds in each play of the game.²⁸ Second, the argument that the audiovisual display contains no originality because all of its reappearing features are determined by the previously created computer program was struck down.²⁹ The court held, “[t]he visual and aural features of the audiovisual display are plainly original variations sufficient to render the display copyrightable even though the underlying written program has an independent existence and is itself eligible for copyright.”³⁰ Thus, the entire game, as it appeared and sounded, was held copyrightable as an audiovisual work.³¹

A variation on this originality argument was made in *Williams v. Artic International* against copyrightability, when it was argued that the video game player’s interaction caused him to become a co-author of what appeared on the screen; the unfixed audiovisual presentation.³² The court held that, although the player interaction caused the audiovisual presentation to change from game-to-game, there was always a repetitive sequence of a substantial portion of the sights and sounds of the game and thus many aspects of the display remain constant from game-to-game, regardless of how the player operates the controls.³³

In *Midway Manufacturing Co. v. Dirkschneider*, a variation on the fixation argument was made – video games were not copyrightable because the visual display of the games was merely ephemeral projections on a cathode ray tube.³⁴ The court rejected this argument because the audiovisual works were fixed in the printed circuit boards, which were tangible objects from which the audiovisual works may be perceived for a period of time more than transitory.³⁵

In resolving the issue that video games are copyrightable, courts held that it is not the video game itself that is copyrightable but rather “the shape and characteristics of the cards and the ‘shapes, sizes, colors, sequences, arrangements and sounds [that] provides something ‘new or additional over the idea.’”³⁶

Courts next addressed when a “copy” was made on a computer. “Copies” are:

²⁸ *Id.*

²⁹ *Id.*

³⁰ *Id.*; see also *Williams Elec., Inc. v. Artic Intl., Inc.*, 685 F.2d 870, 874 (3d Cir. 1982).

³¹ *Stern Elec., Inc.*, 669 F.2d at 856.

³² *Williams*, 685 F.2s at 874.

³³ *Id.*

³⁴ 543 F. Supp. 466, 479 (D. Neb. 1981).

³⁵ *Id.* at 480.

³⁶ *M. Kramer Mfg. v. Andrews*, 783 F.2d 421, 435 (4th Cir. 1986) (citing *Atari v. N.A. Phillips Consumer Elec.*, 672 F.2d 607, 617 (7th Cir. 1982)).

material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term “copies” includes the material object, other than a phonorecord, in which the work is first fixed.³⁷

In *M. Kramer Manufacturing v. Andrews*, the Fourth Circuit Court of Appeals held that the memory device, or computer program, qualifies as a copy of an audiovisual work, and as such is protected under the original copyright.³⁸ The copyright in the audiovisual display created by a computer program protects not only the audiovisual work from copying, but also the underlying computer program to the extent the program embodies the game’s expression.³⁹ “When an infringer copies the computer program and reproduces the expression embodied in the audiovisuals, he has infringed the copyright holder’s exclusive right” to reproduce copies or create derivative works of the copyrighted work.⁴⁰

Courts also addressed whether software programs were copyrightable. It was argued that programs imprinted on silicon chips, which were permanently wired into a computer (ROM) were not “copies” of the original computer program.⁴¹ The court dismissed this argument and held that computer programs are “works of authorship” and a chip or ROM is a “tangible means of expression” of the work of authorship.⁴² Further, a program imprinted on ROM is “fixed in a tangible medium,”⁴³ and the expression of a program in source code or object code is protected as a “copy.”⁴⁴

In the context of a claim for copyright infringement, computer copying was addressed for the first time in *MAI Systems v. Peak Computer*.⁴⁵ The plaintiff claimed the licensee exceeded the scope of its license when it copied the plaintiff’s software program.⁴⁶ To prevail, the plaintiff had to prove ownership

³⁷ 17 U.S.C. § 101.

³⁸ *M. Kramer Mfg.*, 783 F.2d at 441-42.

³⁹ *Id.*

⁴⁰ *Id.* at 442; see *Stern Elec. Inc.*, 669 F.2d at 857; *Atari*, 672 F.2d at 617; *Midway Mfg. v. Artic Intl., Inc.*, 547 F. Supp. 999, 1006-07 (N.D. Ill. 1982); *Atari v. Amuse. World*, 547 F. Supp. 222, 227 (D. Md. 1981); *Midway Mfg.*, 543 F. Supp. at 480; *Midway Mfg. v. Bandai-Am.*, 546 F. Supp. 125, 148 (D.N.J. 1982).

⁴¹ *Tandy Corp. v. Personal Micro Computers, Inc.*, 524 F. Supp. 171, 173 (N.D. Cal. 1981).

⁴² *Id.*

⁴³ *Stern Elec., Inc.*, 669 F.2d at 855.

⁴⁴ *Williams Elec.*, 685 F.2d at 876-7.

⁴⁵ *MAI Sys. Corp. v. Peak Computer, Inc.*, 991 F.2d 511, 519 (9th Cir. 1993).

⁴⁶ *Id.* at 517.

of the software copyright and “a ‘copying of protectable expression’ beyond the scope of a license.”⁴⁷

MAI copyrighted its operating system and computer diagnostic software, which were licensed to MAI customers for their own internal information processing.⁴⁸ This use included the loading of the software into the computer’s RAM (random access memory) by customers’ employees, MAI representatives, or others authorized by MAI in writing.⁴⁹ When the computer was turned on, the operating system was loaded into the computer’s RAM, and in diagnosing a computer problem at the customer site, the Peak technician ran the computer’s operating system software which allowed the technician to view the systems error log (a part of the operating system) to diagnose the problem.⁵⁰

The *MAI Systems* court held that for the purposes of copyrights law, “copying” occurs when a computer program is transferred from a permanent storage device to a computer’s RAM: “Copyright infringement occurs upon the loading of copyrighted computer software from the storage medium (hard disk, floppy disk, or read only memory) into the memory of a central processing unit (CPU) causing a copy to be made in the absence of ownership of the copyright or express permission by license.”⁵¹ Peak’s loading of copyrighted software into RAM created a “copy” of that software, because RAM is a computer component in which data and computer programs can be temporarily recorded until the computer is shut off.

This was held to be sufficient fixation although it was “only a temporary fixation” because the copy of the program recorded into RAM is lost when the computer is turned off.⁵² It was enough that “the copy created in the RAM can be ‘perceived, reproduced, or otherwise communicated’ as required under the fixation definition, and therefore the loading of software into the RAM creates a copy under the Copyright Act.

⁴⁷ *Id.* (quotations omitted).

⁴⁸ *Id.*

⁴⁹ *Id.*

⁵⁰ *Id.* at 518.

⁵¹ *Id.*

⁵² *Id.* at 519.

III. DERIVATIVE WORKS

Since the 1870 Copyright Act,⁵³ copyrights have been issued for derivative works.⁵⁴ The Copyright Act of 1976 defines “derivative work” as:

a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revision, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a “derivative work.”⁵⁵

Further, the exclusive rights granted to copyright owners—the “bundle of rights”—includes “to prepare derivative works based upon the copyrighted work.”⁵⁶

An example of a derivative work is to create a gift wrap design based on copyrighted sketches which the derivative work creator has a license to use.⁵⁷ It is not a derivative work to create a new magazine by ripping out articles from National Geographic (a copyrighted magazine) where the derivative work crea-

⁵³ Paul Goldstein, “Derivative Rights and Derivative Works in Copyright,” 30 J. Copy. Socy., 209 (1983).

⁵⁴ § 103. Subject matter of copyright:

Compilations and derivative works
 (a) The subject matter of copyright as specified by section 102 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.
 (b) The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

⁵⁵ 17 U.S.C. § 101.

⁵⁶ *Id.* at § 106(2). The other exclusive rights in § 106 are: (2) “to reproduce the copyrighted work in copies or phonorecords”; “to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending”; “in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly”; “in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly”; and “in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.”

⁵⁷ See *Eden Toys v. Florelee Undergarment*, 697 F.2d 27 (2d Cir. 1982).

tor does not have a license or right to use, or to duplicate, remix, and distribute tapes of Lone Ranger television episodes onto broadcast cartridges for radio play where the creation of this derivative work is not based on ownership or a license to the underlying copyrighted work.⁵⁸

The protection of derivative works is based on an underlying valid copyright of the original work and the derivative work creator's valid use of such underlying work by ownership or license.⁵⁹ Five primary justifications are typically cited for granting copyright owners the exclusive right to create derivative works:

The resulting greater economic benefits available to copyright owners will encourage greater production of new works of authorship;

Derivative works harm the market for the underlying copyrighted works by acting as substitutes;

Protecting derivative works will encourage prompt dissemination of new works;

Protecting derivative works is appropriate under a natural rights theory of copyright, which provides that an individual who has created a product should be entitled to full property rights in that product; and

Protecting derivative works provides protection for rights of integrity, also known as moral rights.⁶⁰

To prove infringement, a plaintiff must show ownership of a valid copyright and copying by the defendant. The test for infringement is "of necessity vague."⁶¹ Since direct evidence of copying is rarely available, a plaintiff may prove copying by showing access and "substantial similarity" of the two works.⁶²

⁵⁸ See *Lone Ranger TV v. Program Radio*, 740 F.2d 718, 721 (9th Cir. 1984); *Nat'l Geographic Soc. v. Classified Geographic*, 27 F. Supp. 655 (D. Mass. 1939).

⁵⁹ *Russell v. Price*, 612 F.2d 1123, 1127-28 (9th Cir. 1979); see e.g. *Gracen v. The Bradford Exch.*, 698 F.2d 300, 305 (7th Cir. 1983); cf. *Theotokatos v. Sara Lee Personal Prods.*, 971 F.Supp. 332, 340 (N.D. Ill. 1997); *Ets-Hokin v. Skyy Spirits*, 225 F.3d 1068, 1078 (9th Cir. 2000).

⁶⁰ Lydia Pallas Loren, *The Changing Nature of Derivative Works in the Face of New Technologies*, 4 J. Small & Emerging Bus. L. 57, 76 (Spring 2000); see Justin Hughes, *The Philosophy of Intellectual Property*, 77 Geo. L.J. 287, 296, 303 (Dec. 1988) (discussing Locke's theory on labor that rewards must be provided in order to get labor, or alternatively that labor should be rewarded).

⁶¹ *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).

⁶² *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 911 (2d Cir. 1980); cf. *Novelty Textile Mills, Inc. v. Joan Fabrics Corp.*, 558 F.2d 1090, 1092 (2d Cir. 1977); *Knickerbocker Toy v. Winterbrook*, 554 F. Supp. 1309, 1320 (D.N.H. 1982).

Substantial similarity is determined by the “ordinary observer” test: “the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same,”⁶³ refined as, “whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.”⁶⁴ A “general impression of similarity is not sufficient to make out a case of infringement.”⁶⁵ For example, still photographs of a copyrighted ballet are derivative works, substantially similar to the underlying copyright.⁶⁶

Another important limitation on the scope of copyright protection, in the context of substantial similarity, is that copyright protection extends only to the artistic aspects of expression, but not to the mechanical or utilitarian features of a protected work.⁶⁷

Derivative works, however, are subject to two limitations. First, they are only copyrightable if original features of the derivative work are more than trivial.⁶⁸ Second, the scope of protection must reflect the degree to which the derivative work relies on preexisting material and cannot affect the scope of any copyright protection in the preexisting material.⁶⁹

The amount of originality required for copyrighting a derivative work has been addressed by the courts many times. As Judge Learned Hand said in 1927: “[W]hile a copy of something in the public domain will not, if it be merely a copy, support a copyright, a distinguishable variation will. . . .”⁷⁰

Originality was met, and copyright infringement found, when a defendant produced and sold color lithographs of the same mezzotint engravings⁷¹ of

⁶³ *Peter Pan Fabrics*, 274 F.2d at 489.

⁶⁴ *Ideal Toy Corp. v. Fab-Lu, Ltd.*, 360 F.2d 1021, 1022 (2d Cir. 1966)

⁶⁵ *Durham Indus.*, 630 F.2d at 912.

⁶⁶ *Horgan v. Macmillan, Inc.*, 789 F.2d 157, 163 (2d Cir. 1986).

⁶⁷ *Mazer v. Stein*, 347 U.S. 201, 218 (1954, *superseded*, 37 C.F.R. § 202.10(a)) (holding that although a lamp is a non-copyrightable utilitarian article, the sculptural aspect of the lamp, apart from the base, was a sculptural work of art with independent existence and was thus copyrightable).

⁶⁸ *Durham Indus.*, 630 F.2d at 909; *see Sherry Mfg. Co., Inc. v. Towel King of Florida, Inc.*, 753 F.2d 1565, 1568 (11th Cir. 1985); *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 489 (2d Cir. 1976).

⁶⁹ *Durham Indus.*, 630 F.2d at 909.

⁷⁰ *Gerlach-Barklow Co. v. Morris & Bendien*, 23 F.2d 159, 161 (2d Cir. 1927); *see also* Justin Hughes, *The Personality Interests of Artists and Inventors in Intellectual Property*, 16 *Cardozo Arts & Ent. L.J.* 81, 89, 100 (1998) (stating that “originality” as used in copyright law should be defined in part by the means of creativity).

⁷¹ A laborious process wherein a copper plate is engraved and then outlines of the engraving are traced over to produce a proof which is then colorized. The depth and shape of the depres-

old masters as the plaintiff.⁷² The court in *Alfred Bell* found that the requirement of some originality was met because no two engravers could produce identical interpretations of the same old master painting, and because the specimens filed were similar.⁷³ The argument that plaintiff's mezzotints could not be validly copyrighted because they were reproductions of works in the public domain was rejected because the Copyright Act allows copyrighting of "versions" of works in the public domain and the mezzotints were such versions.⁷⁴ Prior works in the public domain do not require a different test for "substantial similarity," nor do they reduce the amount of protection from copying afforded to the copyrighted design.⁷⁵

Originality was also raised in a case regarding Uncle Sam mechanical banks where the court addressed derivative works based on works in the public domain. The court upheld a preliminary injunction against defendants' infringing plastic banks, which were "extremely similar" to plaintiff's metal banks with only minor differences.⁷⁶ The court stated "there were no elements of difference that amounted to significant alteration or that had any purpose other than the functional one of making a more suitable (and probably less expensive) figure in the plastic medium."⁷⁷ Even though the underlying work was in the public domain, the court held that to claim the more limited protection given to a reproduction of a work of art, the reproduction had to be more than just a copy

sions in the plate depends on the engraver's concept of the effect of the oil painting. *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 74 F. Supp. 973, 975 (S.D.N.Y. 1947).

⁷² *Id.* at 104-05 (2d Cir. 1951); *cf. Millworth Converting Corp. v. Slijka*, 276 F.2d 443, 445 (2d Cir. 1960) (Judge Friendly holding that where plaintiffs copyrighted their expression of a public domain fabric design, defendants did not copy such expression and therefore did not infringe); *Mirage Editions, Inc. v. Albuquerque A.R.T. Co.*, 856 F.2d 1341, 1344 (9th Cir. 1988) (finding copyright infringement of a derivative work where defendant cut out art images from a book and mounted these copyrighted art images on tiles without the consent of the copyright owners); *Futuredontics, Inc. v. Applied Anagramics*, 1997 U.S. Dist. LEXIS 22249 (C.D. Cal. 1997). A leading expert on copyrights disagrees with the decision in *Mirage* that a derivative work was created by "choosing ceramic rather than cardboard as the backing material" which could "scarcely be construed as a 'meaningful' variation in the eyes of the Copyright Act." Nimmer and Nimmer, *supra* n. 3, vol. 1-3 § 3.03[B][1]; *see e.g. Lee v. A.R.T. Co.*, 125 F.3d 580, 583 (7th Cir. 1997) (holding that mounting of small notecards and lithographs on ceramic tiles and covering the art with a transparent epoxy resin in the process was not derivative work).

⁷³ 74 F. Supp. at 975.

⁷⁴ *Id.*

⁷⁵ *Novelty Textile Mills, Inc.* 558 F.2d at 1093.

⁷⁶ *L. Batlin & Son, Inc.*, 536 F.2d at 489.

⁷⁷ *Id.*

and contain originality, which was not present in the underlying work of art.⁷⁸ The defendant's skill and special training which allowed him to produce the plastic molds for the plastic banks were not enough originality, because "a considerably *higher* degree of skill was required, true artistic skill, to make the reproduction copyrightable."⁷⁹ Novelty, uniqueness and ingenuity are not required for copyright protection, but independent creation is.⁸⁰ The change from one medium to another, as with metal banks recast in plastic, is insufficiently original to qualify for copyright protection.⁸¹

Originality in fully-jointed teddy bears was not found because the copyrighted bear had no component or feature that could be attributed to authorship by plaintiffs, and the bear, in ensemble and in its component parts, was drawn from the public domain – "[n]o touch of fresh authorship enlivens the bear of the copyright."⁸² Further, even though differences between the bears could be pointed out, the court held this was beside the point because plaintiffs could only recover on a taking of their authorship.⁸³

Similarly, plaintiff's derivative work was not copyrightable where she improved on a previous copyrighted beach towel design because "[w]hen compared to the public domain design it simply lacks sufficient originality to justify copyright protection."⁸⁴

The difficulty with derivative works is finding the point at which the right to reproduce the copyrighted work in copies ends and the right to prepare derivative works based on the copyrighted work begins, because this is the point at which contribution of independent expression to an existing work effectively creates a new work for a different market.⁸⁵

This concept was nicely illustrated recently in *Williams v. Broadus* where the hip-hop artist Marley Marl copied a portion of Otis Redding's "Hard to Handle" into his song "The Symphony" and then the rapper Snoop Dog copied a portion of the lyrics and music of "The Symphony" into his song "Ghetto Symphony."⁸⁶ Defendants attacked the validity of plaintiff's copyright on "The

⁷⁸ *Id.* at 491.

⁷⁹ *Id.*

⁸⁰ *Id.*

⁸¹ *Id.*; see also *Durham Indus.*, 630 F.2d 905.

⁸² *Kuddle Toy v. Pussycat-Toy*, 1974 U.S. Dist. LEXIS 6440, *90 (E.D.N.Y. 1974).

⁸³ *Id.*

⁸⁴ *Sherry Mfg. Co.*, 753 F.2d at 1565.

⁸⁵ Goldstein, *supra* n. 53 (arguing that rather than relying on copyright law to protect derivative works, more reliance should be placed on unfair competition and trademark laws).

⁸⁶ *Williams v. Broadus*, 2001 U.S. Dist. LEXIS 12894, **2-3 (S.D.N.Y. 2001).

Symphony” as an infringement on the copyright in “Hard to Handle.”⁸⁷ The court noted that “a work is not derivative simply because it borrows from a pre-existing work”⁸⁸ and that for defendants to establish a derivative work they had to prove both that plaintiffs copied “Hard to Handle” and that the copying was an improper or unlawful appropriation because the second work bore a “substantial similarity” to the earlier work’s protected expression.⁸⁹

While only two of the 54 measures (ten notes) of “Hard to Handle” were copied by plaintiffs, they were the opening two measures in “Hard to Handle” and were repeated throughout “The Symphony” in a comparable style. The court considered this and denied defendant’s Motion for Summary Judgment because it found a genuine issue of material fact as to whether the copying was of a substantial portion of the work.⁹⁰

Supreme Court Justice Oliver Wendell Holmes called those who created derivative works “second takers.”⁹¹ But when it comes right down to it, aren’t all creative works derivatives of previous works to greater and lesser extents? Those of us fortunate enough to be in New York City in the Spring of 2003 had the opportunity to see the benefits to society of derivative works protection *not* being enforced: the Matisse/Picasso exhibit at the Museum of Modern Art, and the Manet/Velasquez exhibit at the Metropolitan Museum of Art. When the works of each artist are placed side-by-side, one can certainly see the similarities – which in many cases are substantial and would perhaps qualify as derivative works in today’s society. But society has benefited from having both of these similar works to enjoy.

IV. FIXATION OF DERIVATIVE WORKS IN A TANGIBLE MEDIUM

When the Copyright Act was overhauled in 1976, the requirement that a work be “fixed in a tangible medium of expression” was clarified to mean one “now known or later developed.”⁹² It was further clarified that the fixation is

⁸⁷ *Id.* at *3.

⁸⁸ *Id.* at *5.

⁸⁹ *Id.* at **10-13; see *Castle Rock Ent. v. Carol Publ. Group*, 150 F.3d 132 (2d Cir. 1998).

⁹⁰ *Williams*, 2001 U.S. Dist. LEXIS 12894 at **13-14 (citing *Sandoval v. New Line Cinema Corp.*, 147 F.3d 215, 218 (2d Cir. 1998) (stating that although a small portion was copied, from a quantitative standpoint, the court must examine from a qualitative standpoint also)).

⁹¹ Siva Vaidhyathan, *Copyrights and Copywrongs: The Rise of Intellectual Property and How it Threatens Creativity* 95 (N.Y. U. Press, 2001).

⁹² H.R. Rpt. 94-1476 at 52 (Sep. 3, 1976).

sufficient if the work “can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”⁹³

The legislative history states that one purpose of the new definition was to resolve the status of live broadcasts reaching the public in unfixed form but being simultaneously recorded, which legislators determined would be fixed if the underlying work was copyrightable, as a motion picture or sound recording.⁹⁴ However, “fixed” would not include “purely evanescent or transient reproductions such as those projected briefly on a screen, shown electronically on a television or other cathode ray tube, or captured momentarily in the ‘memory’ of a computer.”⁹⁵ The legislative history also determined that it makes no difference what the form, manner or medium of fixation is, only that the embodiment “is sufficiently permanent or stable to permit the work to be perceived, reproduced or otherwise communicated for a period of more than transitory duration.”⁹⁶

This gains new significance in the age of computers. On the one hand, computers allow a work to be perceived as does a television. But on the other hand, data can be stored on a computer, in its memory, unlike a television. But is the duration of this perception “purely evanescent or transient,” being “captured momentarily” and “for a period of more than transitory duration[?]”

The issue becomes further muddled when one considers derivative works, which are also subject to the “bundle of rights” the original copyright is: reproduction, adaptation, publication, performance, and display. Reproduction of a work is subject to the “fixed in a tangible medium” requirement, whereas display is not – such that showing images on a screen would not be in violation of the reproduction right but might be in violation of the display right. And the definition of “copies” includes the material object “in which the work is first fixed,” so the right of public display applies to the original works of art and to their reproductions.

The right to prepare derivative works is a broader right than the right of reproduction, although a certain amount of overlap exists in that “reproduction requires fixation in copies or phonorecords, whereas the preparation of a derivative work, such as a ballet, pantomime, or improvised performance, may be an infringement *even though nothing is ever fixed in tangible form.*”⁹⁷ This bears

⁹³ *Id.*

⁹⁴ *Id.*

⁹⁵ *Id.* at 53.

⁹⁶ *Id.*

⁹⁷ *Id.* at 62 (emphasis added).

repeating: the legislative history explicitly states that a derivative work does not have to be fixed in a tangible form to be copyrightable.

The Ninth Circuit Court of Appeals came to the opposite conclusion in *Lewis Galoob Toys, Inc., v. Nintendo of Am., Inc.* in 1992.⁹⁸ Galoob manufactured a device called the Game Genie which allowed a video game player to alter up to three features of a Nintendo home video game, such as increasing the number of lives of the player's character, increasing the speed at which the character moved, and allowing the character to float above obstacles. The player controlled these changes by entering codes provided by Galoob, which replaced the value for a single data byte sent by the Nintendo game cartridge to the central processing unit in the Nintendo Entertainment System hardware. The Game Genie was inserted between a game cartridge and the Nintendo Entertainment System, and its temporary effects did not alter the data stored in the game cartridge.

The court looked to the Copyright Act's definition of "derivative work" and its lack of any reference to "fixation" and found that a derivative work had to be fixed to be *protected* under Section 102(a) of the Copyright Act, but not to *infringe*.⁹⁹ The legislative history explicitly states that "reproduction requires fixation in copies or phonorecords, whereas the preparation of a derivative work, such as a ballet, pantomime, or improvised performance, may be an infringement *even though nothing is ever fixed in tangible form*."¹⁰⁰ The court dismissed the argument that a derivative work must be fixed; as a work under Section 101, which is "created" when fixed in a copy or phonorecord for the first time, fixation would be a misapplication of the Copyright Act definition of "created." A work is "created" when:

it is fixed in a copy or phonorecord for the first time; where a work is prepared over a period of time, the portion of it that has been fixed at any particular

⁹⁸ 964 F.2d 965 (9th Cir. 1992).

⁹⁹ *Id.* at 967-68; see Nimmer & Nimmer, *supra* n. 3, at § 8.09 (calling this differentiation "dictum" and finding it difficult to reconcile the two different definitions of a derivative work (infringement and protection) when Congress used identical language both to define the reach of copyright protection in Section 103(a) and the scope of infringement in 106(2), with the plain language of the Copyright Act); Edward G. Black & Michael H. Page, *Add-On Infringements: When Computer Add-Ons and Peripherals Should (and Should Not) be Considered Infringing Derivative Works Under Lewis Galoob Toys, Inc. v. Nintendo of America, Inc., and Other Recent Decisions*, 15 *Hastings Commun. & Ent. L.J.* 615, 626 (1993) (arguing that the assumption that the concept of derivative works should have these two definitions may be faulty).

¹⁰⁰ H.R. Rpt. 94-1476 at 62 (emphasis added).

time constitutes the work as of that time, and where the work has been prepared in different versions, each version constitutes a separate work.¹⁰¹

Because this definition clarifies the *time* at which a work is created and not a definition of “work,”¹⁰² the definition of “derivative work” does not require fixation. Thus, the court agreed with the Copyright Act’s legislative history.

Nevertheless, the court did not find infringement by Galoob. The court held that no independent work had been created by the Game Genie, and as such no derivative work had been created. The Game Genie was found to merely enhance the audiovisual displays that originated in the Nintendo video game cartridges. The court dismissed Nintendo’s argument that the Game Genie’s displays were as fixed in the hardware and software used to create them as Nintendo’s original displays because the Game Genie could not produce an audiovisual display; the underlying display was produced by a Nintendo Entertainment System and video game cartridge. Because the altered displays produced by the Game Genie did not incorporate a portion of a copyrighted work in some *form*, because the Game Genie’s display had no form, the resulting display was not “embodied” in the Game Genie, as required under Section 101. Thus, no derivative work was created by the Game Genie.¹⁰³

The deciding factor for the *Galoob* court was that the Game Genie was useless by itself and could only enhance (not duplicate) a Nintendo video game’s output. The court analogized to spell-checkers for computers that operated within existing word processors by signaling the writer when a word was misspelled, and how these applications could not be produced and marketed if courts were to conclude that the audiovisual display of a word processor and spell-checker combination was a derivative work based on the display of the word processor alone. Finally, the court noted that “such innovations rarely will constitute derivative works under the Copyright Act.”¹⁰⁴

Interestingly, the *Galoob* court was able to distinguish the Seventh Circuit Court of Appeals decision in *Midway Manufacturing v. Artic Interna-*

¹⁰¹ 17 U.S.C. § 101.

¹⁰² Whereas the defined terms “audiovisual works,” “literary works,” and “pictorial, graphic and sculptural works” are included. *Id.*

¹⁰³ See Carol S. Curme, *Derivative Works of Video Game Displays*, 61 U. Cin. L. Rev. 999, 1013, 1023-1024 (1993) (arguing that *Galoob* was based on “faulty reasoning” because it confused copyrights in audiovisual displays with copyrights in computer programs that produce these displays; also noted that the *Galoob* court required a derivative work be independent, or capable of producing an audiovisual display on its own, yet this requirement is unsupported by precedent and makes contributory infringement analysis superfluous).

¹⁰⁴ *Galoob*, 964 F.2d. at 969.

tional.¹⁰⁵ Midway manufactured video game machines that had printed circuit boards inside them that caused images to appear on a television screen and sounds to emanate from a speaker when an electric current was passed through them. How the circuits were arranged and connected determined the set of sounds and images the machine was capable of making. Players could use a lever or button on the outside of each machine to alter the images or sounds which would send a signal to the circuit boards inside the machine. Artic sold a computer chip that could be inserted in Midway's Galaxian and Pac-Man video games which would speed up the rate of play.

The *Midway* court held that the speeded-up games created by a licensee with a circuit board supplied by Artic was a derivative work based upon the original Galaxian and Pac-Man games, and a licensee who did not have Midway's authorization to create a derivative work was directly infringing while Artic was contributorily infringing through its sale of the speeded-up circuit board.¹⁰⁶

The *Midway* court noted that it was "not obvious" from the definition of "derivative work" whether a speeded-up video game was a derivative work.¹⁰⁷ It analogized to a speeded-up phonograph record, such as playing a phonograph record recorded at 33 RPMs at 45 or 78 RPMs, which it noted would probably not be a derivative work.¹⁰⁸ Nonetheless, the court found that a speeded-up video game was a substantially different product from the original game because it is more exciting to play and requires some creative effort to produce; therefore, the owner of the copyright on the game should be entitled to monopolize it on the same theory that he is entitled to monopolize the derivative works specifically listed in Section 101 ("translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation").¹⁰⁹

The *Galoob* court was able to distinguish itself because it found the *Midway* court had "stretched" the Copyright Act's definition of "derivative work," so accordingly the *Galoob* court held that stretching the definition further would "chill innovation" and fail to protect "society's competing interest in the free flow of ideas, information and commerce."¹¹⁰

¹⁰⁵ *Midway Mfg. v. Artic Intl.*, 704 F.2d 1009 (7th Cir. 1983).

¹⁰⁶ *Id.* at 1014.

¹⁰⁷ *Id.*

¹⁰⁸ *Id.*

¹⁰⁹ *Id.*

¹¹⁰ 964 F.2d. at 969 (citing *Sony*, 464 U.S. at 429).

In 1998 the Ninth Circuit revisited its *Galoob* decision in *Micro Star v. Formgen*.¹¹¹ Formgen, manufacturer of the computer game Duke Nukem 3D, included a feature where players could create their own game levels and encouraged players to frequently post new levels of play they created on the Internet so that other players could download them.¹¹² When Micro Star, a software distributor, downloaded 300 user-created levels and burned them onto a CD which it sold to the public as Nuke It, Formgen sued for copyright infringement.¹¹³

Duke Nukem consists of three separate components: a game engine, a source art library, and MAP files.¹¹⁴ The game engine is the computer program that tells the computer when to read data, save and load games, play sounds, and project images onto the screen.¹¹⁵ “The game engine invokes the MAP file that corresponds” to the level where it needs to create the audiovisual display for that level.¹¹⁶ “Each MAP file contains a series of instructions that tell the game engine” what to put where, such as to put the scuba gear at the bottom of the screen which the game engine will do after finding the image of scuba gear in the source art library.¹¹⁷

In response to FormGen’s argument that as a copyright holder it had exclusive rights to create derivative works based on Duke Nukem, the *Micro Star* court opined that because the statutory language defining a derivative work is “hopelessly overbroad”¹¹⁸ courts such as the *Galoob* court have required the derivative work to exist in a “concrete or permanent form”¹¹⁹ and substantially incorporate protected material from the preexisting work.¹²⁰ *Micro Star*’s defense was that a derivative work was not created because the audiovisual displays generated when Duke Nukem was run with Nuke It’s MAP files were not “fixed” in a concrete or permanent form, and that the MAP files did not copy any of Duke Nukem’s protected expression.¹²¹

¹¹¹ 154 F.3d 1107 (9th Cir. 1998).

¹¹² *Id.* at 1114.

¹¹³ *Id.* at 1109.

¹¹⁴ *Id.* at 1110.

¹¹⁵ *Id.*

¹¹⁶ *Id.*

¹¹⁷ *Id.*

¹¹⁸ A leading copyright expert agrees that the definition of derivative works is overbroad. David Nimmer, (Master Class at Cardozo School of Law, February 19, 2003).

¹¹⁹ *Galoob*, 964 F.2d. at 967.

¹²⁰ *Micro Star*, 154 F.3d at 1110.

¹²¹ *Id.* at 1111.

The *Micro Star* court distinguished the *Galoob* court's Game Genie from Nuke It because Game Genie consisted of audiovisual displays generated by combining the Nintendo System with the Game Genie which were not incorporated in any permanent form, such that when the game was over, the displays were gone.¹²² In contrast, the audiovisual displays generated by Duke Nukem from the Nuke It MAP files were recorded in a permanent form: the MAP files themselves.¹²³ The court asked the following question: "whether an exact, down to the last detail, description of an audiovisual display (and by definition we know that MAP files do describe audiovisual displays down to the last detail) counts as a permanent or concrete form for purposes of *Galoob*" and said yes.¹²⁴

The *Micro Star* court also dismissed *Micro Star*'s argument that the MAP files were not derivative works because they did not incorporate any of Duke Nukem's protected expression.¹²⁵ The court held that the work infringed by *Micro Star* was the Duke Nukem story itself, which was a form of sequel and owned by the copyright holder.¹²⁶

Unlike the *Galoob* court, the *Micro Star* court merely noted in passing that the MAP files could only be used with Duke Nukem but refused to acknowledge the significance of this.¹²⁷ This is in contrast with *Galoob*, where the court found it vital to their holding that the Game Genie merely enhanced the audiovisual displays that originated in Nintendo game cartridges, did not alter the data stored in Nintendo's game, and could not produce an audiovisual display on its own, but rather the underlying display had to be produced by a Nintendo Entertainment System and game cartridge.¹²⁸ Thus, the *Galoob* court found that no derivative work had been created because no independent work had been created by the Game Genie, but the *Micro Star* court barely addressed the fact that no independent work was created by the MAP files either.¹²⁹

Further, a derivative work was not produced by the Game Genie because the Game Genie, plus the Nintendo system, was not a permanent form in that the Game Genie's display had no form, but the derivative works *were* produced in *Midway* and in *Micro Star*. In *Midway*, it was because the speeded-up games created by Artic's chip were substantially different from the original

¹²² *Id.* at 1110-11.

¹²³ *Id.* at 1111.

¹²⁴ *Id.* at 1111-12.

¹²⁵ *Id.* at 1111.

¹²⁶ *Id.* at 1112.

¹²⁷ *Id.*

¹²⁸ 964 F.2d. at 968.

¹²⁹ 154 F.3d at 1111.

game in that they were “more exciting to play” and the product required “some creative effort to produce.”¹³⁰ In *Micro Star*, the derivative work was found because the displays generated by the game were in a permanent form (the MAP files) when the Duke Nukem displays were created from the Nuke It MAP files.¹³¹

V. EXAMPLE WHERE TECHNOLOGY IS CHALLENGING THE “FIXATION” REQUIREMENT

Technology forces a reconsideration as to what constitutes a derivative work. The Copyright Act and its legislative history do not say that a derivative work must be “fixed in a tangible medium” although *Galoob* has interpreted it that way (for copyright protection, not for infringement) and no other court has challenged such an interpretation. While this interpretation still works for new technology such as streaming from the Internet because the underlying work remains in tact, this interpretation is put to the test in light technology which allows changes to be made to the underlying copyrighted work—transformations of the underlying work. Unlike technology that allows streaming from the Internet, some technology allows the user to view the work in an altered format such that the original work has been transformed.

Whereas isolated incidents of jokesters circulating morphed photographs of Hollywood stars or sharks attacking, or rogue game enthusiasts circulating patches to denude Lara Croft or unlock hidden sexual video graphics in *Grand Theft Auto: San Andreas*, an entire industry is being created for “clean videos.” This technology allows users to edit out scenes of movies which the user does not want to see, or does not want their children to see.

These transformed movies present an opportunity to apply the conflict between the legislative history and the Ninth Circuit Court of Appeals in the United States as to whether a derivative work must be fixed in a tangible medium.

A. *Clean Videos*

In August 2002 the Directors Guild of America (DGA) announced it was going to seek a permanent injunction against numerous video companies¹³²

¹³⁰ 704 F.2d at 1014.

¹³¹ 154 F.3d at 1111.

¹³² Robert Huntsman; Clean Flicks of Colo., LLC; Video II; Glen Dickman; J.W.D Mgt. Corp.; Trilogy Studios, Inc., which is the producer and distributor of MovieMask software; Clean-

to prevent them from “cleaning videos” in numerous ways such that the original movie was changed in some way, such as to put clothing on a nude actress or to remove profanity.¹³³ In response, numerous clean video companies filed for a declaratory judgment that their video editing was lawful.¹³⁴ The DGA did file suit against numerous other video editing companies,¹³⁵ joining numerous movie directors and studios as defendants.¹³⁶

CleanFlicks makes a master copy of the movie from a VHS cassette or DVD, edits out the desired scenes – ones with sex, nudity, profanity and extreme violence – and then duplicates the revised version for rental or purchase by subscribers.¹³⁷ CleanFlicks uses three methods of cleaning: (1) distributing the original and edited versions together to the viewer and allowing the viewer to choose to watch either or both versions, (2) replacing the edited version with the original and, although it is preserved, rendering the original inoperable, and (3) creating an edited version for the personal home viewing of a consortium of viewers who purchase the movie.¹³⁸ Subscribers can order one of the 500 movies through the CleanFlicks website, or through one of its 61 locations across the United States.¹³⁹ Subscribers can also send their copy to CleanFlicks to be edited and returned. CleanFlicks claims that no copies of the original work are

Flicks; ClearPlay, Inc.; MyCleanFlicks; Family Shield Tech., LLC, which is the manufacturer of a product called MovieShield; Clean Cut Cinemas; Family Safe Media; EditMyMovies; Family Flix, U.S.A. L.L.C.; and Play It Clean Video.

¹³³ See Compl. and Jury Demand in *Huntsman v. Soderbergh*, CA 02-M01662, (D. Colo.), <http://viewerfreedom.info>, (accessed Oct. 17, 2005); 2d Amend. Compl. and Jury Demand, Oct. 28, 2002, <http://www.findlaw.com>, (accessed Oct. 17, 2005); Mot. Picture Studio Defs.’ Ans. and Counterclaims, Dec. 13, 2002, <http://www.findlaw.com>, (accessed Oct. 17, 2005).

¹³⁴ See Compl. and Jury Demand in *Huntsman v. Soderbergh*, CA 02-M01662, (D. Colo.), <http://viewerfreedom.info>, (accessed Oct. 17, 2005); 2d Amend. Compl. and Jury Demand, Oct. 28, 2002, <http://www.findlaw.com>, (accessed Oct. 17, 2005).

¹³⁵ The video editing companies were Video II, Glen Dickman, J.W.D. Mgt. Corp., Family Shield Technologies, LLC, Clean Cut Cinemas, Family Safe Media, EditMyMovies, Family Flix, USA LLC, and Play It Clean Video. DGA, *DGA, Press Release, Archives*, http://www.dga.org/news/pr_expand.php3?281 (accessed Oct. 17, 2005).

¹³⁶ The directors included Steven Soderbergh, Robert Altman, John Landis, Martin Scorsese, Steven Spielberg, and Robert Redford. *Id.* The movie studios included MGM, Disney, and Dreamworks.

¹³⁷ See CleanFlicks, *CleanFlicks - Edited DVD's - It's About Choice!*, <http://www.cleanflicks.com/learnMore.php> (accessed Oct. 17, 2005).

¹³⁸ See *Huntsman* Compl., *supra* n. 133, at ¶ 8.

¹³⁹ Of the 61 locations, 33 are located in Utah.

made,¹⁴⁰ yet claims fair use because they only make a single edited copy for each original video or DVD they purchase.

Trilogy Studio's software edits the movie in real time to the rating level chosen by the viewer. That is, rather than just blocking nudity, violence, bad language or other elements, the software actually replaces them.¹⁴¹ For example, the nude Kate Winslet in *Titanic* may be clothed with a picture of her wearing a corset and the swords in *Braveheart* could be replaced with Star Wars-type light sabers. Also, instead of just "bleeping" over a swear word such that the viewer can still read the speaker's lips, Trilogy manipulates the lips to match the voice-over. The software is available in a version for professional applications and for home users.

ClearPlay allows subscribers, who own a copy of the movie, to download its filtering software to their computers, and then skip or mute portions of certain movies.¹⁴² The underlying technology of ClearPlay uses the "special disc identifier" located on each DVD, and ClearPlay encourages its subscribers to submit "special disk identifiers" for movies not already on its availability list via email to its Customer Support center. ClearPlay provides subscribers with the MPAA Rating of the movie, and then classifies each of its 320 movie titles¹⁴³ into four categories: Blood and Gore, Profanity, Sex and Nudity, and Violence. Each classification is then ranked as Extreme, Heavy, Moderate, Minor, Mild, or None – both before the ClearPlay software filter is run, and after. In a press release of September 21, 2002, the company claims "ClearPlay filters do not touch, alter or change the DVD in any way."

B. Issues This Raises

Each of these methods of cleaning videos runs afoul of copyright law in different ways. They will be addressed in terms of each of the bundle of rights: reproduction, derivative works, distribution, public performance, and public display. "Reproduction" is not defined in the statute. However, "copy" is defined in the statute as "a material object in which original work is fixed in a tangible medium."¹⁴⁴

¹⁴⁰ Huntsman Compl., *supra* n. 133, at ¶ 12.

¹⁴¹ See *id.* <http://www.trilogystudios.com> and <http://www.moviemask.com> (accessed Sept. 17, 2005).

¹⁴² See ClearPlay, *ClearPlay, How It Works*, <http://www.clearplay.com/About.aspx> (accessed Oct. 17, 2005).

¹⁴³ ClearPlay, *ClearPlay, Movie Titles*, <http://www.clearplay.com/filtercart.aspx> (accessed Oct. 17, 2005).

¹⁴⁴ 17 U.S.C. § 101.

CleanFlicks and Trilogy violate the reproduction right because each copies the original movie onto another video or DVD, a material object which is fixed in a tangible medium. Depending on how much of the original movie is edited out, the resulting video may be substantially similar to the original video and also in violation of the derivative work right. ClearPlay may also violate the reproduction right. The original movie is the material object and it can be “perceived” with the “aid of a machine or device,” i.e., the computer.

“Derivative works” are defined in the statute as a work based on a pre-existing work.¹⁴⁵ CleanFlicks and Trilogy violate this right because the cleaned video they produce is based upon the preexisting movie, the copyright of which is not held by CleanFlicks or Trilogy. Again, whether a copy is made or a derivative work is made will depend on how much of the original movie is edited out. ClearPlay does not violate the copyright owner’s right to create derivative works because it merely provides the software which the user then uses to create the derivative work. At best, ClearPlay may be guilty of contributory copyright infringement or vicariously liable for facilitating the infringing acts of its subscribers in creating a copy or a derivative work.

“Distribution” of copies is not defined in the statute. CleanFlicks violates the distribution right because after it makes a copy and edits the video, it sends the cleaned video to subscribers or allows them to rent the cleaned video. ClearPlay never makes a copy of the original video, and so is not in violation of distributing a copy. The rights of public performance and public display are not violated by any of the clean videos companies because the cleaned videos are for private home use only.

As demonstrated above, each of the clean videos companies have violated some part of the copyright owner’s bundle of rights. Infringement requires the additional element that derivative works be fixed in a tangible medium.

The Copyright Act does not specify that a derivative work must be fixed in a tangible medium. Many courts,¹⁴⁶ as well as practitioners, consult legislative histories to clarify the meaning of statutory language.¹⁴⁷ Where the plain meaning of a statute is clear, “it would be inappropriate for the Court to consider the legislative history in an effort to determine the ‘true’ congressional in-

¹⁴⁵ *Id.*

¹⁴⁶ See *M. Kramer Mfg. Co.*, 783 F.2d at 433-34; *NFL v. McBee & Bruno’s Inc.*, 792 F.2d 726, 732 (8th Cir. 1986); *Donald Frederick Evans & Assn. v. Contl. Homes, Inc.*, 785 F.2d 897, 905 (11th Cir. 1986).

¹⁴⁷ See e.g. Gerald C. MacCallum, Jr., *Legislative Intent*, 75 Yale L. J. 754, 754 (1966).

tent.”¹⁴⁸ Even where there are “contrary indications in the statute’s legislative history...we do not resort to legislative history to cloud a statutory text that is clear.”¹⁴⁹

It has been argued that “the legislative history of a statute is helpful if, and to the extent that, it yields useful information about what the drafters intended the statutory language to mean and why the legislature enacted it.”¹⁵⁰ Legislative silence is misplaced where the text and structure of the statute counsel otherwise.¹⁵¹

Examining the legislative history of the Copyright Act of 1976 to determine legislative intent requires reviewing more than “30 studies, three reports issued by the Register of Copyrights, four panel discussions issued as committee prints, six series of subcommittee hearings, 18 committee reports, and the introduction of at least 19 general revision bills over a period of more than 20 years.”¹⁵²

A leading copyright expert believes the plain language of the statute must control because the legislative history of the “fixed in a tangible medium” requirement for derivative works is ambiguous.¹⁵³ But the plain language of the statute is, well, not very plain to see.

The lack of statutory definitions for words and phrases used throughout the statute only adds to the ambiguity. The word “work” is not defined although the definition of a “derivative work” includes the word “work.” Moreover, other definitions which include the undefined word are “architectural work,” “audiovisual work,” “collective work,” “joint work,” “literary works,” “pseudonymous work,” a “United States work,” “work of visual art,” “work of the United States Government,” and “work made for hire.” In addition, of all the verbs in the bundle of rights of Section 106, are not defined. While “perform” and “display” are defined, “reproduce,” “prepare,” and “distribute” are not.

The Copyright Act is unambiguous as to what qualifies for copyright protection: “[1] original works of authorship[, 2)] fixed in a tangible medium now known or later developed[, 3)] from which they can be perceived, repro-

¹⁴⁸ *Lexmark Intl., Inc. v. Static Control Components, Inc.*, 253 F. Supp. 2d 943, 967 (E.D. Ky. 2003).

¹⁴⁹ *Ratzlaf v. U.S.*, 510 U.S. 135, 147-48 (1994) (footnote omitted) (referencing criminal laws).

¹⁵⁰ Jessica Litman, *Copyright, Compromise, and Legislative History*, 72 Cornell L. Rev. 857, 881 (1987).

¹⁵¹ *CCNV v. Reid*, 490 U.S. 730, 748 (1989).

¹⁵² Litman, *supra* n. 150, at 865 (citing *The Kaminstein Legislative History Project: A Compendium and Analytical Index of Materials Leading to the Copyright Act of 1976* xxxi-xliii (Alan Latman & James F. Lightstone eds., Fred B. Rothman & Co. 1981)).

¹⁵³ Nimmer & Nimmer, *supra* n. 3, at § 8.09[A].

duced, or otherwise communicated, either directly or with the aid of a machine or device.”¹⁵⁴ Each of these components needs separate analysis.

“Original” is undefined in the Copyright Act, but courts have defined it to mean a minimal amount of creativity.¹⁵⁵ Derivative works are defined as works based on preexisting works, which can be copyrighted as to the new material contributed, as long as the resulting derivative work is not substantially similar to the preexisting work(s).¹⁵⁶ A work is “created” when fixed.¹⁵⁷ Fixation occurs where tangible and sufficiently stable.

If a “copy” must be able to be perceived *or* reproduced, then why is there a necessity for it to be fixed in a tangible medium also? Reproduction requires fixation, while perception does not necessarily, as will be discussed in further detail in this section. The requirement that works be fixed in a tangible medium was designed to “resolve the status of live broadcasts – sports, news coverage, live performances of music, etc. – that are reaching the public in un-fixed form but that are simultaneously being recorded.”¹⁵⁸ This makes sense for the original to be fixed, but does not make sense for the copy or derivative work

¹⁵⁴ 17 U.S.C. § 102.

¹⁵⁵ *Feist Publications, Inc. v. Rural Tel. Serv., Co.*, 499 U.S. 340, 345-46 (1991).

¹⁵⁶ Many proposals as to what constitutes, or should constitute, a derivative work have been made. See e.g. Loren, *supra* n. 60, at 58-60 (arguing that while digital technology has made possible new types of works, which she calls “integrated works,” that digitally reference pre-existing copyrighted digital works, without making a reproduction of any portion of the pre-existing material, copyright owners should not be able to control the creation of integrated works as they can for derivative works); Christian H. Nadan, Student Author, *A Proposal to Recognize Component Works: How a Teddy Bears on the Competing Ends of Copyright Law*, 78 Cal. L. Rev. 1633, 1660-67 (1990) (arguing for an explicit judicial recognition exception under copyright law against infringement for a new type of work, a “component work,” which would depend on the original work, add value to the original but not replace it, and not cause substantial economic harm to the original author, as measured by the market test for infringement, such as a computer chip that makes a particular personal computer more powerful); see also Black & Page, *supra* n. 99, at 635 (“Computer add-ons that add new features or enhancements do not supplant demand for existing elements of expression protected by the copyright in the primary work, and copyright holders should not be allowed to assert a protectable interest in all improvements to an existing copyrighted computer program”); Adam Eric Jaffe, Student Author, *Red Alert! Add-On Games Are Coming!*, 8 Fordham Intell. Prop. Media & Ent. L.J. 655, 657-58 (1998) (arguing that software manufacturers should be free to market add-on game products such as those at issue in Galoob “because the benefits to the public outweigh any harm to the original manufacturers of computer games”).

¹⁵⁷ “[A] work is ‘created’ when it is fixed in a copy or phonorecord for the first time.” 17 U.S.C. § 101. This does not mean that all created works are copyrightable, because Section 102 states that copyright protection subsists in original works of authorship fixed in any tangible medium of expression. *Id.* at § 102.

¹⁵⁸ H.R. Rpt. 94-1476 at 52 (reprinted in 1976 U.S.C.C.A.N. 5659, 5665).

to also be fixed, where the owner of the copyright in the original work is unable to enjoy his exclusive bundle of rights. The definition of “copy” requires the work be a “material object”¹⁵⁹ and for a work to be “created” requires fixation, but the definition of “derivative work” neither requires a material object nor fixation. Allowing clean videos to escape violation of copyright law thus depends on whether they are “fixed” or not, which depends on whether the time viewed on the screen is “sufficiently permanent or stable . . . for a period of more than transitory duration.”

Clean videos appear on a tangible medium of expression, a computer screen. They are sufficiently permanent or stable to permit them to be perceived, but is this a period of more than transitory duration? As a leading copyright expert notes: “[t]he concepts of tangibility (‘material object’) and some level of permanence are separable because writing in the sand is tangible although only permanent until the next wave erases it forever, and an image appearing on a television or movie screen is embodied in a material object but is evanescent.”¹⁶⁰

Under this theory, how long would a sand writing have to exist for it to be more than transitory? This same copyright expert suggests that the world’s tallest snowman in Maine, built out of 9 million pounds of snow on February 19, 2001 “presumably qualified as ‘fixed’ by virtue of surviving until mid-March.”¹⁶¹ This would give fixation a finite period of one month to qualify as “transitory duration.”

The *Micro Star* court analogized the Game Genie to a fictitious product called a Pink Screener (pink cellophane stretched over a frame and put in front of a television), which does not create a derivative work because the modified image is not in a “permanent or concrete form.”¹⁶² The *MicroStar* court was correct that it’s “Pink Screener” is not a derivative work but for the wrong reason: not because its modified image was not in “permanent or concrete form” but because it was not “more than transitory duration” when the television program passed through the pink screen and was viewed. In contrast, the clean video exists for a period of more than transitory duration when one considers the

¹⁵⁹ The Copyright Act also requires fixation be done “by or under the authority of the author.” 17 U.S.C. § 101. Therefore, unauthorized fixation is not a copy under copyright law and the clean video producer would *seem* to be in the clear. He is not, however, because in 1994, following the *Sony* decision, section 1101 was enacted, which prevents such unauthorized fixations. 17 U.S.C. § 1101. Therefore, when clean video producers reproduce or allow reproductions of an unauthorized fixation, they are violating section 1101.

¹⁶⁰ Nimmer & Nimmer, *supra* n. 3, at § 8.09.

¹⁶¹ *Id.* at § 8.02[B][2] n. 14.1.

¹⁶² *Micro Star*, 154 F.3d at 1111 n. 4.

fact that it can be replayed exactly the same way, an infinite number of times. The clean video software allows the new version of the video (whether or not it qualifies as a “derivative work”) to be viewed on the screen over and over again, in exactly the same format, effortlessly, as opposed to the Game Genie, which requires numerous codes to be entered exactly the same way by each player to produce the same result.

Moreover, the *Micro Star* court did not use the proper analysis. The *Micro Star* court seemed to be requiring “fixation” but the definition of fixation does not require “a permanent or concrete form.” It requires a work to be “in a tangible medium of expression . . . sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.”¹⁶³ *Micro Star* thus raised the bar as to what qualifies as fixation.

As the court noted in *Micro Star* when distinguishing itself from *Galoob*, “[t]he audiovisual displays generated by combining the Nintendo System with the Game Genie were not incorporated in any permanent form; when the game was over, they were gone. Of course, they could be reconstructed, but only if the next player chose to reenter the same codes.”¹⁶⁴ Does this suggest that repeated reconstruction by entering the same codes might be an infringement? The *Micro Star* court asked “whether an exact, down to the last detail, description of an audiovisual display . . . counts as a permanent or concrete form for purposes of *Galoob*,” and said yes.¹⁶⁵ Clean videos do not erase forever this permanence because the software facilitates permanence by creating the same result over and over an infinite number of times.

Even if copyright infringement is found, the law nevertheless will allow a copyright infringer to escape liability in certain circumstances. Fair use and moral rights are the most appropriate defenses for clean videos, and for circumstances where creation of a derivative work is not fixed in a tangible medium.

VI. FAMILY MOVIE ACT OF 2005

The Family Entertainment and Copyright Act of 2005 was signed into law by President George W. Bush as part of the Family Entertainment and Copyright of 2005 on April 27, 2005, privately and without any public comment. Section 201 is The Family Movie Act of 2005 (“FMA”), which after a

¹⁶³ 17 U.S.C. § 101.

¹⁶⁴ *Micro Star*, 154 F.3d at 1111.

¹⁶⁵ *Id.* at 1111-1112.

previous version failed to pass the previous Congress, became codified in the Copyright Act as Section 110(11).¹⁶⁶ The FMA permits for the first time:

the making imperceptible, by or at the direction of a member of a private household, of *limited portions* of audio or video content of a motion picture, during a performance in or transmitted to that household for *private home viewing*, from an authorized copy of the motion picture, or the creation or provision of a computer program or other technology that enables such making imperceptible and that is designed and marketed to be used, at the direction of a member of a private household, for such making imperceptible, if *no fixed copy* of the altered version of the motion picture is created by such computer program or other technology.¹⁶⁷

This grants a new right to two different groups of people: those of a private household, and those who manufacture the technology.¹⁶⁸ Both groups, however, are not permitted to make a fixed copy of the altered version.

The goal of the FMA was “to give the viewer the ability to *make imperceptible limited portions* of work that he or she chooses not to see for themselves or their family, whether or not the skipped content is viewed as objectionable by most, many, few or even one viewer (Emphasis added).”¹⁶⁹ Section 202(a) explicitly states that “the term ‘making imperceptible’ does not include the addition of audio or video content that is performed or displayed over or in place of existing content in a motion picture.” What constitutes a “limited portion” is not quantified in terms of a percentage of the work or quantity of time, but rather the intent is for judges to determine its meaning by looking at the work as a whole.¹⁷⁰

¹⁶⁶ The minority view and numerous legal scholars have criticized the violation of the separation of powers created by the passage of the FMA while the courts have not issued an opinion yet in *Huntsman v. Soderbergh*. The legislative history shows that Congress got tired of waiting for a settlement or an opinion in the *Huntsman v. Soderbergh* civil suit and criticized the parties for not acting in good faith to resolve their differences, thus requiring Congress to step in and create a lasting solution. See H. Rpt. at 6.

¹⁶⁷ 17 U.S.C. § 110(11) (emphasis added).

¹⁶⁸ Section 202(b) requires such manufacturer, licensee, or licensor of technology to “ensure that the technology provides a clear and conspicuous notice at the beginning of each performance that the performance of the motion picture is altered from the performance intended by the director or copyright holder of the motion picture.”

¹⁶⁹ H. Rpt. 109-33 at 5, <http://thomas.loc.gov/cgi-bin/cpquery/T?&report=hr033p1&dbname=cp109&> (accessed Oct. 17, 2005). Note that no distinction was made for non-profit or for-profit entities, and no limitation was placed on content.

¹⁷⁰ *Id.*

But “making imperceptible limited portions” creates a derivative work in violation of the author’s exclusive rights. It does not appear that Congress understands derivative works because the legislative history incorrectly analogizes to “editing movies for screen size, content, and time purposes with or without the director’s consent” as if such editing creates a derivative work (which it does not).¹⁷¹

Congress does not appear to understand moral rights either. The legislative history notes that such editing does not impact on the moral rights of directors any more than “someone wanting to prevent certain content from being displayed on their television.”¹⁷²

The legislative history glosses over whether the work has been fixed in a tangible medium in one short paragraph that concludes by saying the Judiciary Committee “is aware of services and companies that create fixed derivative copies of motion pictures and believes that such practices are illegal under the Copyright Act.”¹⁷³ The entire purpose of the FMA is to allow derivative copies to be made (without calling it that), and yet Congress fails to explain why what it has just passed into law is or is not fixation. Whether the fixation issue was even identified as a critical consideration is not noted in the legislative history.

The FMA is bad law not just because it violated the separation of powers by deciding an issue already before the courts, and not just because parents and children already have options to avoid watching movies with certain content,¹⁷⁴ but because it takes away the author’s right to determine who does or does not have the right to create derivative works from its copyrighted work. An exception to such exclusive rights is fair use.

¹⁷¹ *Id.*

¹⁷² *Id.*

¹⁷³ *Id.* at 6.

¹⁷⁴ As the Register of Copyrights, Marybeth Peters, noted at a hearing on this issue: “I cannot accept the proposition that not to permit parents to use such [video cleaning software] products means that they are somehow forced to expose their children (or themselves) to unwanted depictions of violence, sex, and profanity. There is an obvious choice – one which any parent can and should make: don’t let your children watch a movie unless you approve of the content of the entire movie.” Family Movie Act of 2004: Hearing on H.R. 4586 Before the Subcomm. on Courts, the Internet, and Intellectual Property of the House Comm. on the Judiciary, 108th Cong., 2d Sess. 67-70 (June 17, 2004) reported in H. Rpt. at page 37. Further, “the industry annually releases dozens of films geared towards audiences who do not wish to see sexual, violent, or profane content. In 1999, filmmakers released 14 G-rated and 24 PG-rated major motion pictures. In 2000, there were 16 G-rated and 27 PG-rated films. In 2001, 8 G-rated and 27 PG-rated movies were released. In 2002 1 G-rated and 50 PG-rated pictures were distributed. Finally, in 2003, 11 G-rated and 34 PG-rated motion pictures were released.” H. Rpt. at page 37.

VII. FAIR USE

Fair use allows works, including derivative works,¹⁷⁵ to be used irrespective of the copyright owner's rights. "Copyright protection subsists in original works of authorship fixed in any tangible medium of expression [but t]his protection has never accorded the copyright owner complete control over all possible uses of his work. Rather, the Copyright Act grants the copyright holder 'exclusive' rights to use and to authorize the use of his work in five qualified ways, including reproduction of the copyrighted work in copies. All reproductions of the work, however, are not within the exclusive domain of the copyright owner; some are in the public domain. Any individual may reproduce a copyrighted work for a 'fair use' the copyright owner does not possess the exclusive right to such a use."¹⁷⁶ In essence, fair use by the public trumps copyright protection granted to the owner.

Fair use is an affirmative defense which places limits on the copyright owner's exclusive "bundle of rights" in that it allows others to use their works under certain circumstances.¹⁷⁷ The fair use doctrine was first codified in the 1976 Copyright Act,¹⁷⁸ but lawmakers recognized that the world was in a time of rapid technological change and did not want the statute to be carved in stone.¹⁷⁹ Instead, courts were given a framework of factors to consider including, but not limited to,¹⁸⁰ those listed in Section 107 of the Copyright Act:

¹⁷⁵ Mark A. Lemley, *The Economics of Improvement in Intellectual Property Law*, 75 Tex. L. Rev. 989, 1024 (1997) ("To be sure, copyright's fair use doctrine does offer some protection to improvers in certain circumstances. The fair use doctrine provides a defense to some charges of infringement on a case-by-case basis, generally where there is a public interest served by the copying or where the copying is unlikely to have a significant market impact. While the fair use doctrine may serve to protect radical improvers in some cases, it is not expressly designed to do so. Fair use may be invoked to protect pure copiers - those who do not improve at all - as well as to prefer radical improvers.").

¹⁷⁶ *Sony*, 464 U.S. at 432-433.

¹⁷⁷ 17 U.S.C. § 107. Limitations on exclusive rights: Fair use. Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.

¹⁷⁸ *Suntrust Bank v. Houghton Mifflin*, 268 F.3d 1257, 1264 (11th Cir. 2001).

¹⁷⁹ Joseph P. Liu, "Copyright and Time: A Proposal," 101 Mich. L. Rev. 409, 453 (2002).

¹⁸⁰ Two recent proposals suggest that fair use analysis includes consideration of time such that fair use would be more broadly applied to older copyrighted works. Justin Hughes, *Fair Use Across Time*, 50 UCLA L. Rev. 798 (2003) (arguing that time should be considered as part of the fourth factor, impact of the use on the potential market); Liu, *supra* n. 179, at 453 (argu-

the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;

the nature of the copyrighted work;

the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and

the effect of the use upon the potential market for or value of the copyrighted work.¹⁸¹

These factors have been interpreted and weighed by the courts.

A. *Caselaw*

The first major Supreme Court decision to consider the impact of modern technology on fair use was *Sony v. Universal City Studios*.¹⁸² The owners of copyrights on television programs broadcast on public airwaves brought suit against a manufacturer of home video tape recorders (VTRs) for copyright infringement.¹⁸³ The copyright owner's argued that VTRs allowed consumers to record television programs thereby infringing their copyrights.¹⁸⁴

The Court did not find vicarious liability because Sony did not sell equipment with the constructive knowledge that its customers may use the equipment to make unauthorized copies of copyrighted material.¹⁸⁵ Likewise, the Court did not find contributory infringement because the sale of the equipment was widely for legitimate substantial noninfringing uses.¹⁸⁶

The Court found that the average member of the public used a VTR principally to record a program he could not view at the time it was being televised so he could watch the program at a later time ("time-shifting").¹⁸⁷ This practice enlarged the television viewing audience and the television program owners did not show that time-shifting impaired the commercial value of their copyrights (or created a likelihood of future harm).¹⁸⁸ Therefore, the Court did

ing that time should be considered either in the second factor, nature of the copyrighted work, or as a separate and distinct factor).

¹⁸¹ 17 U.S.C. at § 107.

¹⁸² *Sony Corp. of Am.*, 464 U.S. at 430-31.

¹⁸³ *Id.* at 419-20.

¹⁸⁴ *Id.* at 420.

¹⁸⁵ *Id.* at 439.

¹⁸⁶ *Id.* at 442.

¹⁸⁷ *Id.* at 421.

¹⁸⁸ *Id.*

not find infringement because the copying was a fair use of the underlying copyrighted works.¹⁸⁹

The Court considered the first three factors together. These factors included the purpose and character of use, the nature of the copyrighted work, and the amount and substantiality of the portion used in relation to the copyrighted work as a whole.¹⁹⁰ The Court held that these factors weighed in favor of Sony because the copying of an entire television program which was freely available for the purpose of viewing later (“time-shifting”) in the private home was a non-commercial, nonprofit activity.¹⁹¹

The fourth factor, effect of the use on the potential market, also weighed in favor of Sony. The “use ha[d] no demonstrable effect on the potential market for, or the value of, the copyrighted work” and to prohibit such copying to protect the author’s incentive to create would “merely inhibit access to ideas without any countervailing benefit.”¹⁹² As long as the copying remained merely for time-shifting purposes where the tapes were recorded over and a private library of television programs was not created, fair use was present.¹⁹³ Further, the Court found that time-shifting expanded public access to freely broadcast television programs and as such yielded societal benefits.¹⁹⁴ Thus, private use at home was fair use.

Unlike private use in *Sony* being fair use, the court found private use was not fair use in *Sega Enterprises LTD v. Maphia*.¹⁹⁵ Sega, a major manufacturer and distributor of computer video games and systems, raised the issue of fair use in a copyright infringement action against an electronic bulletin board operator whose electronic bulletin board (“BBS”) contained and distributed pirated versions of Sega’s video games.¹⁹⁶ The defendant, system operator for the MAPHIA BBS, claimed the copying done by the users of the BBS was fair use because there was no evidence that the users did more than play a single copy in their homes.¹⁹⁷ The court held that all four factors weighed against the defendant and rejected his fair use defense.¹⁹⁸

¹⁸⁹ *Id.* at 456.

¹⁹⁰ *Id.* at 454.

¹⁹¹ *Id.* at 450-51.

¹⁹² *Id.*

¹⁹³ *Id.* at 451.

¹⁹⁴ *Id.* at 454.

¹⁹⁵ 948 F. Supp. 923, 934 (N.D. Cal. 1996).

¹⁹⁶ *Id.* at 927.

¹⁹⁷ *Id.*

¹⁹⁸ *Id.* at 936.

First, the *Sega* court held that the purpose of the use was commercial and the defendant encouraged uploading and downloading of Sega's games because it induced sale of software copiers which the defendant sold.¹⁹⁹ The court distinguished the home use of *Galoob's* Game Genie where users did not have to purchase an authorized game cartridge because here users were able to avoid purchasing Sega's cartridges by downloading a pirated version.²⁰⁰

The second factor also weighed against fair use because the Sega video games were for entertainment uses, which were more creative than informational uses, thus, the nature of the copyrighted work was not in the core of the intended copyright protection.²⁰¹ Similarly, the third factor weighed against fair use because the whole work was copied without showing any public benefit or explanation as to why the entire work needed to be copied.²⁰²

The fourth factor solidified the court's holding against fair use. The unauthorized copying facilitated by the defendant decreased Sega's sales of video games because the copiers sold by the defendant in conjunction with the games provided on the BBS supplanted users' need to purchase Sega video games. The court rejected the defendant's argument that the use was *de minimis* because only a limited number of users had copiers which they only played in their own homes, thus Sega's sales were not diluted.²⁰³ The court held that "unrestricted and widespread conduct of this sort would result in a substantial adverse impact on the market for the Sega games."²⁰⁴ Clearly, the court took into the consideration the ease at which technology allowed copies to be not only made, but widely distributed.

The Supreme Court rejected a fair use defense in *Harper & Row Publishers v. Nation Enterprises*.²⁰⁵ In *Harper & Row Publishers*, portions of former President Gerald R. Ford's unpublished memoirs were published by a political magazine without authorization several weeks prior to its scheduled release by Harper & Row.²⁰⁶ The defendant claimed fair use.²⁰⁷

The first factor, purpose of the use, was news reporting and therefore a productive use. The purpose of use was also commercial use and the character

¹⁹⁹ *Id.* at 933.

²⁰⁰ *Id.* at 934.

²⁰¹ *Id.*

²⁰² *Id.*

²⁰³ *Id.* at 935-36.

²⁰⁴ *Id.* at 935.

²⁰⁵ 471 U.S. 539, 549 (1985).

²⁰⁶ *Id.* at 542.

²⁰⁷ *Id.*

of the use was to intentionally and in bad faith infringe the right of first publication held by the copyright owner. The second factor, nature of the copyrighted work, also worked against the defendant. The manuscript was an unpublished historical narrative or autobiography, and there is a greater need to disseminate factual works than works of fiction.²⁰⁸ The fact that the manuscript was unpublished was a “critical element of its nature” because the scope of fair use is narrower for unpublished works.²⁰⁹ Moreover, the use by the defendant clearly infringed the copyright holders’ interests in confidentiality and creative control.²¹⁰

The third factor, amount and substantiality of the portion used, weighed against the defendant because although the quantity of words quoted were an insubstantial portion of the manuscript, they were among the most powerful passages in those chapters. The court recognized, it was the quality of the work taken, and not the quantity.²¹¹ The fourth factor, effect of the use upon the potential the market, also weighed against the defendant. Not only did the book publisher cancel its projected serialization and refuse to pay the final payment, but by copying the key passages the article in *The Nation* “directly competed for a share of the market for prepublication excerpts.”²¹²

The recent Supreme Court decision addressing fair use, *Campbell v. Acuff-Rose Music*,²¹³ clarified the test under each factor in holding that the rap group 2 Live Crew’s version of Roy Orbison’s “Oh, Pretty Woman” was a parody and a fair use of a copyrighted work.

Under the first factor, the purpose and character of the use, a court is to determine whether the new work merely supersedes the original creation or adds something new such that the first work has been transformed. Such transformation furthers the goal of promoting science and the arts.²¹⁴ “The more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use.”²¹⁵ Whether the

²⁰⁸ *Id.* at 555.

²⁰⁹ *Id.* at 556.

²¹⁰ *Id.*

²¹¹ See Broadus discussion in *supra* Section II regarding derivative works where this same quality/quantity argument was raised.

²¹² *Harper & Row, Publishers, Inc.*, 471 U.S. at 568.

²¹³ 510 U.S. 569 (1994).

²¹⁴ *Id.* at 579.

²¹⁵ *Suntrust Bank*, 268 F.3d at 1269 (citing *Campbell*, 510 U.S. at 579).

use of the original work is commercial or nonprofit is only one element of the first factor enquiry.²¹⁶

The second factor, the nature of the copyrighted work, “calls for recognition that some works are closer to the core of intended copyright protection than others, with the consequence that fair use is more difficult to establish when the former works are copied.”²¹⁷ The third factor, the amount and substantiality of the portion used in relation to the copyrighted work as a whole, tends to overlap with the facts addressing the fourth factor in examining the degree to which the derivative work is a market substitute for the original or potentially licensed derivatives.²¹⁸ Consideration of not only the quantity of the materials used, but also their quality and importance, is essential.²¹⁹

The fourth factor, the effect of the use upon the potential market for, or value of, the copyrighted work “requires courts to consider not only the extent of market harm caused by the particular actions of the alleged infringer, but also ‘whether unrestricted and widespread conduct of the sort engaged in by the defendant . . . would result in a substantially adverse impact on the potential market’ for the original.”²²⁰ Consideration of “not only the harm to the original but also of harm to the market for derivative works” is essential.²²¹ “The market for potential derivative uses includes only those that creators of the original works would in general develop or license others to develop.”²²² “The only harm to derivatives that need concern us . . . is the harm of market substitution.”²²³ When the second use is transformative, “market substitution is at least less certain, and market harm may not be so readily inferred.”²²⁴ “Market harm is a matter of degree, and the importance of this factor will vary, not only with the amount of harm, but also with the relative strength of the showing on other factors.”²²⁵

²¹⁶ *Campbell*, 510 U.S. at 584.

²¹⁷ *Id.* at 586.

²¹⁸ *Id.* at 586-87.

²¹⁹ *Id.* at 587.

²²⁰ *Id.* at 590 (quoting *Nimmer & Nimmer*, *supra* n. 3, at § 13.05[A][4]).

²²¹ *Id.* (citing *Harper & Row, Publishers, Inc.*, 471 U.S. at 568).

²²² *Id.* at 592.

²²³ *Id.* at 593.

²²⁴ *Id.* at 591.

²²⁵ *Id.* at 591, n. 21.

In *Harper & Row, Publishers*, the Supreme Court held that the fourth factor was the most important factor,²²⁶ although the Court noted that its strength will vary with the amount of harm and the relative strength of proof on the other factors.²²⁷ In the Supreme Court's recent fair use decision, *Campbell*, the court seemed to back away from this by stating: "the four statutory factors . . . are [all] to be explored, and the results weighed together, in light of the purposes of copyright."²²⁸ In fact, in *Campbell*, the Court reversed the circuit court for "giving virtually dispositive weight to the commercial nature of the parody" examined under the first factor.²²⁹

Courts have since been weighing all the factors as instructed, but relying on the first and fourth factors as to whether the use was transformative and the effect of the use on the market for the original work—economic bases.

Creation of the allegedly parodic Seinfeld Aptitude Test based on the television comedy Seinfeld was not fair use. The court examined all four factors, but it was the first and fourth factors (lack of transformation and effect on the market) which were most important. The use was not transformative because it did not "educate, criticize, parody, comment, report upon, or research Seinfeld" and the fact that it "so minimally altered Seinfeld's original expression is further evidence of The SAT's lack of transformative purpose."²³⁰ In addition, the SAT acted as a market substitute for a derivative market that the court found was an area of typical development for television programs.²³¹

In *Suntrust Bank*, the court vacated an injunction against publication of a fictional work based on Margaret Mitchell's *Gone With the Wind* after examining if fair use was present despite "substantial use" of *Gone With the Wind*.²³² The court applied all four fair use factors, with the decision hinging, as with The Seinfeld Aptitude Test, on the first and fourth factors, the work was transformative and did not act as a market substitute for *Gone With the Wind*.²³³

²²⁶ *Harper & Row, Publishers, Inc.*, 471 U.S. at 566 (stating that the fourth factor is "undoubtedly the single most important element of fair use"); *Sega Enters. Ltd.*, 948 F. Supp. at 934 (stating "the fourth factor is the most important consideration").

²²⁷ *Harper & Row, Publishers, Inc.* 471 U.S. at 590-91.

²²⁸ *Campbell*, 510 U.S. at 578.

²²⁹ *Id.* at 584.

²³⁰ *Castle Rock Ent., Inc. v. Carol Publ. Group, Inc.*, 150 F.3d 132, 142-43 (2d Cir. 1998).

²³¹ *Id.* at 145.

²³² *Suntrust Bank*, 268 F.3d at 1267, 1277.

²³³ *Id.*

B. Policy Reasons for Fair Use

Fair use gets to the heart of the policy reasons behind copyright law because in creating exceptions to the rule, one must understand not only the rule but the basis on which the rule was created. The role of fair use in copyright law has traditionally been explained under the public benefit theory, which has the goal of promoting the dissemination of knowledge in society, and the market failure theory, which has the goal of permitting discreet small-scale use of copyrighted works where the cost of securing a license exceeds the value of that use.²³⁴ “[Promotion of] science and the arts is generally furthered by the creation of transformative works.”²³⁵ The ultimate test of fair use is whether copyright law’s “goal of encouraging creative and original work by ‘promoting the Progress of Science and useful Arts’ would be better served by allowing the use than by preventing it.”²³⁶

The United States Supreme Court has stated:

the [limited monopoly that Congress may authorize] is a means by which an important public purpose may be achieved. It is intended to motivate the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius after the limited period of exclusive control has expired.²³⁷

Further, “the sole interest of the United States and the primary object in conferring the monopoly lie in the general benefits derived by the public from the labors of authors. It is said that reward to the author or artist serves to induce release to the public of the products of his creative genius”²³⁸ and that “[t]he copyright law makes reward to the owner a secondary consideration.”²³⁹ Called a “wobbly balancing test,”²⁴⁰ fair use was meant to be a balance between

²³⁴ Liu, *supra* n. 179, at 457-58.

²³⁵ *Castle Rock Ent., Inc.*, 150 F.3d at 142 (citing *Campbell*, 510 U.S. at 579).

²³⁶ *Id.* at 141 (citing *Arca Inst. v. Palmer*, 970 F.2d 1067, 1077 (2d Cir. 1992)).

²³⁷ *Sony Corp. of Am.*, 464 U.S. at 429.

²³⁸ *Id.* (citing *U.S. v. Paramount Pictures, Inc.*, 334 U.S. 131, 158 (1948)).

²³⁹ *Id.*; These statements were challenged during the debate in the United States over extension of the copyright term generally by twenty years via The Copyright Term Extension Act and its subsequent litigation in *Eldred v. Ashcroft*, 534 U.S. 1126, 1160 (2002), *Eldred v. Reno*, 239 F.3d 372 (D.C. Cir. 2001), *reh'g denied*, 255 F.3d 849; see also Kelly M. Slavitt, *The Copyright Term Extension Act: We May Know the Words, But Can We Find the Harmony?*, 11 MSU-DCL J. Int'l. L. 457 (2002).

²⁴⁰ Hughes, *supra* n. 180, at 798.

the rights of copyright owners and the rights of society. Fair use has been referred to as an “equitable rule of reason” in legislative history.²⁴¹

As the test of the Constitution makes plain, it is Congress that has been assigned the task of defining the scope of the limited monopoly that should be granted to authors or to inventors in order to give the public appropriate access to their work product. This task involves a difficult balance between the interests of authors and inventors in the control and exploitation of their writings and discoveries on the one hand, and society’s competing interest in the free flow of ideas, information, and commerce on the other hand. Thus, our patent and copyright statutes have been amended repeatedly.²⁴²

Fair use was designed to be “inherently flexible and fact-specific” although lawmakers found it difficult to agree on language defining fair use which would adequately represent the interests of all parties.²⁴³ “The fair use doctrine ‘permits [and requires] courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which the law is designed to foster.’”²⁴⁴ In the end, fair use became the 1976 Copyright Act’s “central source of flexibility” because it “offered the sole means of tempering the expansive scope of the copyright owner’s exclusive rights” and was “the sole safe harbor for interests that lacked the bargaining power to negotiate a specific exemption.”²⁴⁵

Fair use was traditionally defined as “a privilege in others than the owner of the copyright to use the copyrighted material in a reasonable manner without his consent.”²⁴⁶ Moreover, “[the] author’s consent to a reasonable use of his copyrighted works [had] always been implied by the courts as a necessary incident of the constitutional policy of promoting the progress of science and the useful arts, since a prohibition of such use would inhibit subsequent writers from attempting to improve upon prior works and thus . . . frustrate the very ends sought to be attained.”²⁴⁷

Nevertheless, the fair use provision has been criticized as to its impact on technology because “[b]y limiting future technology’s exemptions to those

²⁴¹ Litman, *supra* n. 150, at 898.

²⁴² *Sony Corp. of Am.*, 464 U.S. at 429.

²⁴³ Litman, *supra* n. 150, at 886-87 (providing an excellent discussion of the legislative history of the Copyright Act, and of § 107 in particular).

²⁴⁴ *Campbell*, 510 U.S. at 577 (citing *Stewart v. Abend*, 495 U.S. 207, 236 (1990)).

²⁴⁵ Litman, *supra* n. 150, at 886.

²⁴⁶ *Harper & Row, Publishers, Inc.*, 471 U.S. at 549 (citing Horace G. Ball, *The Law of Copyright and Literary Property* 260 (1944)).

²⁴⁷ *Id.*

available under the fair use provision, the [Copyright Act of 1976] restricted the impact of judicial creativity on the copyright owner's bundle of rights."²⁴⁸

C. *Application to Clean Videos and Future Technologies*

The first factor, purpose and character of the use, includes whether such use is of a commercial nature or is for nonprofit educational purposes. The clean videos producers claim their purpose in creating the clean videos is to help parents protect children from violence and offensive language. The character of the use is noncommercial in that the videos are viewed privately at home, but commercial in that the clean video producers make money in transforming the original videos to cleaned videos. Whereas the *Sony* Court held that "the copying of the respondents' [television] programs represents a small portion of the total use of [video tape recorders],"²⁴⁹ clean videos software has as its only purpose the copying and/or creation of derivative works.

The second factor is the nature of the copyrighted work. The nature of the copyrighted work is entertainment. As the *Sega* court held, because entertainment uses are more creative than informational, the nature of the copyrighted work is not in the core of intended copyright protection.²⁵⁰

The third factor is the amount and substantiality of the portion used in relation to the copyrighted work as a whole. This factor varies from movie to movie. Some movies have more violence and offensive language than others, and thus would require more editing to make them "clean." The amount of the original movie remaining would be less than a less violent movie with less offensive language. In general, a substantial portion of the original movie will be used to create the cleaned video and thus this factor weighs against the clean video producers.

The fourth factor is the effect of the use upon the potential market for or value of the copyrighted work. This factor varies in its application to each of the clean video producers. CleanFlicks' rental market has an impact on the potential market because the original will not be purchased if it can be rented for less money instead. In cases where the clean video producer replaces the original video with a cleaned version of the original video, the market will not be diminished because the sale of the original movie is preserved. The potential market for sales of the original video could be negatively impacted if a potential

²⁴⁸ Litman, *supra* n. 150, at 887.

²⁴⁹ *Sony Corp. of Am.*, 464 U.S. at 434.

²⁵⁰ *Sega Enters. Ltd.*, 948 F. Supp. at 934.

purchaser viewed the cleaned version and did not like it, because they would not buy the original movie.

Complete copies made by technology have been held by the Ninth Circuit Court of Appeals to be fair use because the copies were only momentary and did not effect the potential market.²⁵¹ In *Sony Computer Entertainment v. Connectix* the court held that noncopyrightable elements of a software program which were copied by a competitor were fair use because it was only “intermediate copying,”²⁵² and “the Copyright Act protects expression only, not ideas or the functional aspects of a software program.”²⁵³

The second recent challenge to complete copies occurred in *Ticketmaster Corp. v. Tickets.com, Inc.*²⁵⁴ In *Ticketmaster*, a copy of noncopyrightable data was made.²⁵⁵ The court held this was fair use because the copying was “transitory and temporary and not used directly in competition” with the defendant.²⁵⁶ Additionally, the copy was destroyed after its limited function was over. Thus, making a copy to protect data temporarily to access uncopyrightable data is fair use.²⁵⁷

The economics of the Game Genie were considered by the *Galoob* court, which held that the Game Genie was noninfringing because it was useless by itself.²⁵⁸ The value was thus not in the Game Genie alone, but only in combination with the technology which ran the Game Genie (i.e., the computer). Similarly, the ClearPlay software is useless by itself. Without both the computer and the movie, the software cannot “clean” the video.

The Family Movie Act (“FMA”) does not address fair use, but surely the courts will in interpreting and applying the FMA. While the FMA claimed that the non-profit or for-profit status was unimportant, the first fair use factor examines the purpose and character of the use and includes consideration of the entity’s status. In addition, the “limited portions” language of the FMA will surely be considered when deciding the amount and substantiality of the portion of the copyrighted work used in relation to the copyrighted work as a whole. The only factor that may weigh in favor of the FMA is the fourth factor. This is

²⁵¹ *Sony Computer Ent., Inc. v. Connectix Corp.*, 203 F.3d 596 (9th Cir. 2000).

²⁵² *Id.* at 602.

²⁵³ *Id.* at 603.

²⁵⁴ *Ticketmaster Corp. v. Tickets.com, Inc.*, 2000 U.S. Dist. LEXIS 12987 (C.D. Cal. 2000), *aff’d* 248 F.3d 1173 (9th Cir. 2001).

²⁵⁵ *Id.*

²⁵⁶ *Id.* at *11.

²⁵⁷ *Id.*

²⁵⁸ *Galloob*, 964 F.2d at 969.

due to the fact that the use may be considered transformative in creating a positive effect on the potential market because arguably more people would buy the movies if they could bypass scenes they did not want to see.

Technology has changed the economics of copyright. The value is not necessarily in the tangible object because the copyrighted work can be used in the intangible computer world. Clean videos present a new problem created by technology. The new technology highlights a problem stemming from revisions to the 1976 Copyright Act: whether derivative rights must be fixed in a tangible medium.

Whereas a RAM or cache copy violates the copyright owner's reproduction right because storage is a reproduction right, which applies to a copy of the entire work. Streaming and clean videos do not transfer an entire copy of the work to the RAM of the user's computer, but rather only a portion at a time: the portion being viewed by the user. Thus, no copy of the copyrighted work is made, merely a small portion of the copyrighted work is copied and then another small portion of the copyrighted work replaces it, and so on. Therefore, copyright law is not violated because a substantial amount of the original is never made at once, and each of the small portions copied would qualify as fair use.

In the end, the entire copyrighted work has been copied and used, though not all at once. Surely, law makers never intended to provide this loophole in copyright law, which affects the protection of copyright owners' rights. This loophole is merely an unanticipated byproduct resulting from advances in technology. Copyright owners exploit their rights in the intangible world, and if the end result is that they cannot reap the rewards for their labors, then the purpose of copyright law has been frustrated. In the absence of true moral rights protection in the United States, and with only VARA which excludes protection for motion pictures, artists and movie studios may be better able to protect themselves using contractual provisions.

VIII. INTERNATIONAL PERSPECTIVE

The copyright concepts of the United States are not unique. The concept of fair use exists in other countries,²⁵⁹ as does protection for derivative works and the requirement that copyrightable works be fixed in a tangible me-

²⁵⁹ In Canada, England, New Zealand, and Australia fair use is called "fair dealing," but the concept is similar to the U.S.-version of fair use. See Brian F. Fitzgerald, *Digital Property: The Ultimate Boundary?*, 7 Roger Williams U. L. Rev. 47 (2001); see also Neil Weinstock Netanel, *Asserting Copyright's Democratic Principles in the Global Arena*, 51 Vand. L. Rev. 217 (1998).

dium. If the underlying policies of copyright law are universal, then treatment of the technology underlying clean videos should be the same under international laws as under those under United States laws.

A. *Major International Treaties and Directives*

1. **Berne Convention for the Protection of Literary and Artistic Works**

The Berne Convention for the Protection of Literary and Artistic Works has 150 states from around the globe as members including Australia, Belgium, Brazil, Canada, China, France, Germany, Mexico, the Russian Federation, South Africa, the United Kingdom, and the United States.²⁶⁰ The Berne Convention defines “literary and artistic works” to include “every production in the literary, scientific and artistic domain, *whatever may be the mode or form of its expression*,”²⁶¹ thus incorporating expressions made digitally on a computer. Like the United States, The Berne Convention requires that works be “fixed in some material form”²⁶² although derivative works are protected without specifying that they too need to be fixed.²⁶³ The Berne Convention gives authors the exclusive right of authorizing the reproduction of literary and artistic works “in any manner or form.”²⁶⁴

2. **Agreement on Trade-Related Aspects of International Property**

The Agreement on Trade-Related Aspects of Intellectual Property (“TRIPS”) is an agreement between members of the World Trade Organization which includes all European countries.²⁶⁵ TRIPS is one of the major trade

²⁶⁰ See WIPO, *Treaties and Contracting Parties: Berne Convention*, <http://www.wipo.int/treaties/ip/berne/index.html> (accessed October 17, 2005).

²⁶¹ *Berne Convention for the Protection of Literary and Artistic Works* art. 2(1) (Sept. 28, 1979) [hereinafter *Berne Convention*] (emphasis added).

²⁶² *Id.* at art. 2(2).

²⁶³ *Id.* at art. 12 (“Authors of literary or artistic works shall enjoy the exclusive right of authorizing adaptations, arrangements and other alterations of their works.”). *Id.* at art. 14(1)(i) (which is specific to cinematographic rights: “(1) Authors of literary or artistic works shall have the exclusive right of authorizing: (i) the cinematographic adaptation and reproduction of these works, and the distribution of the works thus adapted or reproduced.”).

²⁶⁴ *Id.* at art. 9(1).

²⁶⁵ Guy Tritton, *Intellectual Property in Europe* para. 2-003 (2nd ed., Sweet & Maxwell 2002).

agreements of the GATT Uruguay Round and requires GATT members to give equivalent intellectual property protection as found in the Berne Convention, the Paris Convention for the Protection of Industrial Property, the Rome Convention, and the Treaty on Intellectual Property in Respect of Integrated Circuits.²⁶⁶ This equivalent protection excepts The Berne Convention's Article 6*bis* regarding moral rights and instead incorporates the exact language proposed by the U.S.²⁶⁷

3. The World Intellectual Property Organization's 1996 Copyright Treaty

The World Intellectual Property Organization's (WIPO) 1996 Copyright Treaty has 41 states from around the world as members, including Argentina, Mexico, the Philippines, and the United States.²⁶⁸ The WIPO Copyright Treaty follows The Berne Convention language as to literary and artistic works, and protects computer specifically.²⁶⁹ Fixation is also required but only "fixed copies that can be put into circulation as tangible objects."²⁷⁰

²⁶⁶ Jeffrey M. Dine, *Author's Moral Rights in the Non-European Nations: International Agreements, Economics, Mannu Bhandari, and the Dead Sea Scrolls*, 16 Mich. J. Int'l L. 545, 556-57 (1995).

²⁶⁷ *Berne Convention*, *supra* n. 261, at art. 9; *see* Dine, *supra* n. 266, at 557 (citing Terence P. Stewart, *The GATT Uruguay Round: A Negotiating History (1986-1992)* vol. 2, 2288-89 (1993)).

²⁶⁸ *See* WIPO, *Treaties and Contracting Parties: WIPO Copyright Treaty (WCT)*, <http://www.wipo.int/treaties/ip/wct/index.html> [hereinafter *WIPO Copyright Treaty*] (accessed Oct. 17, 2005).

²⁶⁹ *Id.* at art. 4 ("Computer programs are protected as literary works within the meaning of Article 2 of the Berne Convention. Such protection applies to computer programs, *whatever may be the mode or form of their expression.*" (emphasis added). The scope of protection for computer programs is consistent with Article 2 of Berne and on par with the relevant provisions of TRIPS); *id.* at art. 6(1) ("Authors of literary and artistic works shall enjoy the exclusive right of authorizing the making available to the public of the original and copies of their works through sale or other transfer of ownership"); *id.* at art. 7(1) ("Authors of . . . cinematographic works . . . shall enjoy the exclusive right of authorizing commercial rental to the public of the originals or copies of their works); *id.* at art. 7(2) ("[Article 7(1)] shall not apply . . . in the case of cinematographic works, unless such commercial rental has led to widespread copying of such works materially impairing the exclusive right of reproduction.").

²⁷⁰ *WIPO Copyright Treaty*, *supra* n. 268, at n. 6 ("Agreed statement concerning Articles 6 and 7: As used in these Articles, the expressions 'copies' and 'original and copies,' being subject to the right of distribution and the right of rental under the said Articles, refer exclusively to *fixed copies that can be put into circulation as tangible objects.*") (emphasis added).

The Treaty specifically states that the reproduction right set out in The Berne Convention²⁷¹ applies in the digital environment, in particular to the use of works in digital form, and that “[i]t is understood that the storage of a protected work in digital form in an electronic medium constitutes a reproduction within the meaning of Article 9 of The Berne Convention.”²⁷²

4. European Union Copyright Directive

The language quoted above is similar to the European Union Copyright Directive²⁷³ language which gives authors the right to prohibit temporary reproductions as well as permanent reproduction “by any means in any form, in whole or in part.”²⁷⁴ However, temporary acts of reproduction

which are transient or incidental [and] an integral and essential part of a technological process and whose sole purpose is to enable: (a) a transmission in a network between third parties by an intermediary, or (b) a lawful use of a work or other subject-matter to be made, and which have no independent economic significance [are exempted].²⁷⁵

Member States are given the option of providing an exception or limitation to the reproduction right²⁷⁶ and to the distribution right.²⁷⁷ Such exception or limitation is limited to several circumstances, including “in respect of reproductions on any medium made by a natural person for private use and for ends that are neither directly nor indirectly commercial, on condition that the rightholders receive fair compensation which takes account of the application or

²⁷¹ *Berne Convention*, *supra* n. 261, at art. 9.

²⁷² *WIPO Copyright Treaty*, *supra* n. 268, at n. 2.

²⁷³ *EU Copyright Directive 2001/29/EC* art. 11 (May 22, 2001), http://europa.eu.int/eur-lex/pri/en/oj/dat/2001/l_167/l_16720010622en00100019.pdf#search='EU%20Copyright%20Directive' [hereinafter *EU Copyright Directive*] (accessed Oct. 17, 2005) (allowing contracting parties to provide for limitations of or exceptions to the rights granted under the treaty via national legislation “in certain special cases that do not conflict with a normal exploitation of the subject-matter and do not unreasonably prejudice the legitimate interests of the rightholder.”); *see WIPO Copyright Treaty*, *supra* n. 268, at art. 10(1) (tracking this language almost exactly (Any exception or limitation shall only be applied “in certain special cases that do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the author.”)).

²⁷⁴ *EU Copyright Directive*, *supra* n. 273, at art. 2 (giving authors the exclusive right to “prohibit direct or indirect, temporary or permanent reproduction by any means and in any form, in whole or in part.”) (emphasis added).

²⁷⁵ *Id.* at art. 5(1).

²⁷⁶ *Id.* at art. 2 (reproduction right). *Id.* at art. 5(2) (exception).

²⁷⁷ *Id.* at art. 4 (distribution right). *Id.* at art. 5(4) (exception).

non-application of [adequate legal protection against the circumvention of any effective technological measures] or subject-matter concerned.”²⁷⁸ Any exception or limitation “shall only be applied in certain special cases which do not conflict with a normal exploitation of the work or other subject-matter and do not unreasonably prejudice the legitimate interests of the rightholder.”²⁷⁹

B. Moral Rights

While in the United States the rights of artists have historically been protected by granting the artist traditional property rights over his work—a limited monopoly over the exploitation of his work—other countries have created a personal right called “moral rights.”²⁸⁰ In contrast to property rights, which are justified by the benefits they bring to individuals in society, non-economic benefits of intellectual property are justified by the protection of the personality interest or “personhood” of individuals.²⁸¹ While “personhood” interests are

²⁷⁸ *Id.* at art. 5(2).

²⁷⁹ *Id.* at art. 5(5).

²⁸⁰ These include not only the signatories to the Berne Convention, but also Canada, Mexico, England, the European Union, France, Germany, the Republic of Singapore, India, and Israel. Brian T. McCartney, “Creepings” and “Glimmers” of the Moral Rights of Artists in American Copyright Law, 6 UCLA Ent. L. Rev. 35, 71 (1998) (citing Canada’s moral rights law at Canadian Copyright Act, R.S.C. ch. C-42, amended by R.S.C. ch. 10 (1st Supp. 1985), ch. 1 (3d Supp. 1985), ch. 41 (3d Supp. 1985), ch 10 14.1(3) (4th Supp. 1985); Mexico’s moral rights law at Ley Federal de Derechos de Autor, D.O., Dec. 21, 1963, art. 3, translated in UNESCO, Copyright Laws and Treaties of the World (1993); England’s moral rights law in caselaw at *Clark v. Associated Newspapers Ltd.*, 1 All E.R. 959 (Chancery Div. 1998); *Morrison Leahy Music v. Lightfoot*, Chancery Div., Transcript: Marten Walsh Cherer (Hearing Date March 21, 1991); *Joseph v. National Magazine*, 3 WLR 366, 369 (Chancery Div. 1958); *Frisby v. British Broadcasting Corp.*, 2 WLR 1204, 1218 (Chancery Div. 1967); European Community moral rights law in caselaw at *Radio Telefis Eireann v. European Commission*, 1995 FSR 530, para. 73 (E.C.J.); *Collins v. Imtrat Handelsgesellschaft*, 1994 FSR 166, 171 (E.C.J.); *Independent Television Publications v. EC Commission*, 1991 FSR 678, 679 (Ct. First Instance); and Singapore’s moral rights law in *Creative Technologies v. Aztech Systems*, 1997 FSR 491, para. 83 (Singapore Ct. App.); Craig A. Wagner, Student Author, *Motion Picture Colorization, Authenticity, and the Elusive Moral Right*, 64 N.Y.U. L. Rev. 628, 688, n. 359 (1989) (citing the German moral rights law at Gesetz uber Urheberrecht und verwandte Schutzrechte (Sept. 9, 1965), BGB1.I 1273 (Sept. 16, 1965) (as amended June 24, 1985), reprinted in UNESCO, 2 Copyright Laws and Treaties of the World (BNA) (1984) and the Italian moral rights law at Protezione del diritto d’autore e di altri diritti connessi al suo esercizio, reprinted in UNESCO, 2 Copyright Laws and Treaties of the World (BNA) (1984)); For a thorough discussion of protections in India and Israel, see Dine, *supra* n. 266, at 577.

²⁸¹ See Margaret Jane Radin, *Property and Personhood*, 34 Stan. L. Rev. 957, 958 (1982); see also Hughes, *supra* n. 70, at 81-82; Nimmer, *supra* n. 3, at 8D.01[A] (“Certain countries of

commonly linked to sentimental attachment or the opportunity for personal growth,²⁸² intellectual creations are “public goods” in the economic sense²⁸³ and moral rights serve to protect the cultural heritage of a civilization.²⁸⁴ As a former World Intellectual Property Organization Director noted: “Intellectual Property’s prime aim is the recognition of the *moral* and economic value of intellectual creation in the cultural, social and economic development of nations.”²⁸⁵

1. Generally

Moral rights protect the artist’s creative process by giving the artist control over that process, from conception to destruction. The idea behind “moral rights” is “that the creator, as the sole judge of when a work is ready for public dissemination, is the only one who can possess any rights in an uncompleted work.”²⁸⁶ Even after the artist transfers ownership of the work to another he retains his moral rights.²⁸⁷ Further, moral rights can not be sold, given away, or bequeathed.²⁸⁸

Giving moral rights to artists is society’s way of protecting artists from reputational harm and preserving “cultural property.”²⁸⁹ Moral rights are also an

the world have long recognized rights personal to authors, and as such viable separate and apart from the economic aspect of copyright”); see e.g. *Lugosi v. Universal Pictures*, 603 P.2d 425, 431 (Cal. 1979) (holding that the right of the artist to exploit his name and likeness was personal).

²⁸² Hughes, *supra* n. 70, at 87.

²⁸³ *Id.* at 86 (citing Harold Demsetz, *The Private Production of Public Goods*, 13 J.L. & Econ. 293, 295 (1970) (a public good is a good for which “it is possible at no cost for additional persons to enjoy the same unit.”); Lemley, *supra* n. 175, at 994-95 (“Information has the characteristics of what economists call a ‘public good’ - it may be ‘consumed’ by many people without depletion, and it is difficult to identify those who will not pay and prevent them from using the information.”).

²⁸⁴ Martin A. Roeder, *The Doctrine of Moral Right: A Study in the Law of Artists, Authors and Creators*, 53 Harv. L. Rev. 554, 578 (1940).

²⁸⁵ World Intellectual Property Organization Director Arpad Bogsch at June 3, 1994 Conference in Paris, quoted in Tritton, *supra* n. 265, para. 1-001 (emphasis added).

²⁸⁶ Roberta Rosenthal Kwall, *Copyright and the Moral Right: Is an American Marriage Possible?*, 38 Vand. L. Rev. 1, 5 (1985).

²⁸⁷ Susan P. Liemer, *Understanding Artists’ Moral Rights: A Primer*, 7 B.U. Pub. Int. L.J. 41, 50 (1998).

²⁸⁸ *Id.* at 44 (citing 17 U.S.C. § 106A(e)(1) (2000) in the United States and Law No. 57-298 Art. 6 of Mar. 22, 1957, J.O., Mar. 14, 1957, 1723 B.L.D. 197 in France).

²⁸⁹ Eric M. Brooks, Student Author, “Tilted” Justice, 77 Cal. L. Rev. 1431, 1434 (1989) (citing John Henry Merryman, *The Public Interest in Cultural Property*, 77 Cal. L. Rev. 339, 341

indicator of the values of a culture, such as “the roles of truth, beauty, and contemplation in human life; the distribution of wealth and cultural influence; the flexibility of social convention and the tolerance for political dissent . . . [and] the balance between preservation of the past and development of the future.”²⁹⁰ This is reflected in whether artists are held in high regard and encouraged to pursue their creativity, or devalued with little or no recognition.²⁹¹ “A system that does not recognize moral rights imposes the cost [of copyright] by default on the author, who takes the risk that an unscrupulous user will damage her reputation by misattribution or by distortion of her work.”²⁹²

Most countries that recognize moral rights also protect artists’ economic rights under separate laws, such as copyright law.²⁹³ In France, where rights of artists and authors are most fully developed, *droit d’auteur* encompasses both property rights (*droits patrimoniaux*) and personal rights which inure only to creators (*droit moral*).²⁹⁴ The modern *droit moral*, which translates as moral rights, developed from French courts in the mid-19th century and was codified in 1957.²⁹⁵ In its broadest sense, moral rights encompass the creator’s rights of attribution, integrity, disclosure, withdrawal, and resale royalties.²⁹⁶

(1989)) [(“Cultural property” are “objects that embody the culture—principally archeological, ethnographical, and historical objects, works of art, and architecture . . .”).]

²⁹⁰ Lawrence Adam Beyer, *Intentionalism, Art, and the Suppression of Innovation: Film Colorization and the Philosophy of Moral Rights*, 82 Nw. U. L. Rev. 1011, 1012 (1988).

²⁹¹ Liemer, *supra* n. 287, at 57 n. 2 (Japan designates artists preserving traditional art forms as Living National Treasures, Bunkazai Hogo Ho [Law for the Protection of Cultural Assets], Law No. 214 of 1950, amended 1954 and 1970.); *see also Gilliam v. ABC*, 538 F.2d 14, 23-24 (2d Cir. 1976) (stating that their decision, which represents the U.S. version of moral rights, “reinforce[s] our initial inclination that the copyright law should be used to recognize the important role of the artist in our society and the need to encourage production and dissemination of artistic works by providing adequate legal protection for one who submits his work to the public.”).

²⁹² Dine, *supra* n. 266, at 579.

²⁹³ Liemer, *supra* n. 287, at 44.

²⁹⁴ *See* Roeder, *supra* n. 284 at 556.

²⁹⁵ Wagner, *supra* n. 280, at 688 (citing Roeder, *supra* n. 284 at 555-56); *see also* John Henry Merryman, *The Refrigerator of Bernard Buffet*, 27 Hastings L.J. 1023, 1026 (1976) (“It is interesting to note that the moral right of the artist in French law is entirely judicial in origin. This is in itself remarkable, since one of the most treasured tenets of the conventional wisdom about the civil law is that law is made by legislators and executives, not by judges.”).

²⁹⁶ Liemer, *supra* n. 287, at 46. Moral rights also include the right not to create: “[d]uring the construction of Westminster Abbey, artists and artisans were impressed by royal decree; it is reported that Fra Filippo Lippi was imprisoned by Cosimo de Medici until a desired tableau had been painted.” Roeder, *supra* n. 284, at 558 (citing MacNeil, *Some Pictures Come to Court*, Harvard Legal Essays, 247, 249 (1934)).

The rights of paternity and integrity protect the personality of an artist in that because a work of art expresses the artist's personality. Any distortion, mutilation, or misrepresentation of the work would injure that expression and impair the artist's personality, identity, dignity, and honor. The right of paternity (or attribution) provides that the artist's name and authorship is to be respected, that his name is attached to his own work and not to anyone else's, and that he has the right to remain anonymous.²⁹⁷ The right of integrity protects the integrity of the work itself and prevents anyone from modifying the art without the artist's permission, which indirectly also protects the creative process and the artist's reputation.²⁹⁸ Traditionally, this right did not protect another from totally destroying the artwork, because the artist's creative efforts and personal expressions could not be misrepresented by artwork which did not exist.²⁹⁹

The right of disclosure (or divulgation) provides that the artist is the master of the work during its creation and can decide when his work is completed,³⁰⁰ which may be never.³⁰¹ The right of withdrawal provides that the artist can take back or modify his work after he has sold or assigned it.³⁰² This is justified by the artist's right to decide that the work no longer expresses what he wants to express, be it the artwork itself or the reputation of the artist which may have evolved.

The right to resale royalties is provided in the Berne Convention for the Protection of Literary and Artistic Works.³⁰³ It allows the artist to benefit financially by earning a percentage of the profits when others benefit from his work.

The Berne Convention defines "moral rights" as:

Independently of the author's economic rights, and even after 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.³⁰⁴

²⁹⁷ Anna S. White, Student Author, *The Colorization Dispute*, 38 Emory L. J. 237, 245 (1989); Liemer, *supra* n. 287, at 47-49.

²⁹⁸ Liemer, *supra* n. 287, at 50.

²⁹⁹ *Id.* at 51.

³⁰⁰ White, *supra* n. 297, at 245.

³⁰¹ Liemer, *supra* n. 287, at 53.

³⁰² White, *supra* n. 297, at 245 (citing Rosen, *Artist's Moral Rights: A European Evolution, An American Revolution*, 2 Cardozo Arts & Ent. L.J. 155, 160 (1983).

³⁰³ *Berne Convention*, *supra* n. 261, at art. 14*ter*.

³⁰⁴ *Id.*

The rights granted to the author in accordance with the preceding paragraph shall, after his death, be maintained, at least until the expiry of the economic rights, and shall be exercisable by the persons or institutions authorized by the legislation of the country where protection is claimed. However, those countries whose legislation, at the moment of their ratification of or accession to this Act, does not provide for the protection after the death of the author of all the rights set out in the preceding paragraph may provide that some of these rights may, after his death, cease to be maintained. The means of redress for safeguarding the rights granted by this Article shall be governed by the legislation of the country where protection is claimed.³⁰⁵

The Berne Convention limits the term of protection to the life of the artist plus 50 years,³⁰⁶ although rights may continue in perpetuity in France, justified as necessary to protect the artist's reputation and society's interest in preserving the integrity of its cultural heritage.³⁰⁷

2. U.S. "Moral Rights" Protection

a. Before Becoming a Signatory to the Berne Convention

United States courts repeatedly rejected moral rights³⁰⁸ until the landmark 1976 case of *Gilliam v. ABC*.³⁰⁹ The British comedy troupe Monty Python granted the BBC the right to use their scripts on television, to make minor changes without their permission, and to license these television shows over-

³⁰⁵ *Id.* at art. 6bis.

³⁰⁶ *Id.* at art. 7.

³⁰⁷ Wagner, *supra* n. 280, at 693; Brooks, *supra* n. 289, at 1439 (citing Kwall, *supra* n. 286, at 15).

³⁰⁸ See *Vargas v. Esquire*, 164 F.2d 522, 526 (7th Cir. 1947); *Crimi v. Rutgers Presbyterian Church*, 89 N.Y.S.2d 813, 818-19 (N.Y. App. Div. 1st Dept. 1949); *Geisel v. Poynter Products*, 295 F. Supp. 331, 339 (S.D.N.Y. 1968); *Shostakovich v. Twentieth Century-Fox Films*, 80 N.Y.S.2d 575, 579 (N.Y. App. Div. 1st Dept. 1949); see also Merryman, *supra* n. 295 at 1039 (citing Fox Europe et Fox Americaine Twentieth Century, 1954 D. Jur. 16, 80 (Cour d'appel, Paris)) (noting that in *Shostakovich* the court found no violation of a composer's claimed moral right, "while on identical facts a French court found a violation."); see also Brooks, *supra* n. 289, at 1438 (citing 1954 D. Jur. 16, 80) (Cour d'appel, Paris)) (noting that the Shostakovich case "illustrates the difference between French and American protection of artist's rights: [because] [t]he American court explicitly denied the moral rights claim, while on identical facts, a French court hearing the case found a violation.).

³⁰⁹ 538 F.2d 14, 24-25 (2d Cir. 1976).

seas.³¹⁰ When Time-Life Films acquired the right to distribute the television programs in the United States, they were given the right to edit the programs only to allow for the governmentally mandated television commercials and time segment requirements.³¹¹ Time-Life then came to an agreement with ABC to broadcast two ninety-minute specials, each comprising three thirty-minute programs never before shown in the United States.³¹²

After Monty Python viewed the broadcast of the first special, it entered into negotiations concerning the editing of this broadcast and also of the editing of the second special which had not yet been broadcast.³¹³ When negotiations broke down, Monty Python sued for a preliminary injunction to enjoin broadcast of the second special.³¹⁴

Monty Python objected to the editing of its program, whereby 24 minutes of the original 90 minutes of recording were edited out: some to make time for commercials, and some because ABC found the matter offensive or obscene.³¹⁵ Monty Python argued that the “discontinuity and mutilation” of the program impaired the integrity of their artistic work.³¹⁶

The court agreed, noting that there was a likelihood of infringement because this was the first broadcast of Monty Python’s work to a nationwide audience in the United States, and because 27 percent of the original program was omitted such that the scope of the editing license given to the BBC was violated.³¹⁷ The court found it likely that the editing constituted an “actionable mutilation” of Monty Python’s works based on the concept of moral rights “which may generally be summarized as including the right of the artist to have his work attributed to him in the form in which he created it.”³¹⁸ The court could not reconcile American law’s lack of moral rights with “the inability of artists to obtain relief for mutilation or misrepresentation of their work to the public on which the artists are financially dependent”³¹⁹ presented in this case because the artist is the one who suffers the consequences of the mutilation in

³¹⁰ *Id.* at 17.

³¹¹ *Id.* at 18.

³¹² *Id.*

³¹³ *Id.*

³¹⁴ *Id.*

³¹⁵ *Id.*

³¹⁶ *Id.*

³¹⁷ *Id.* at 30.

³¹⁸ *Id.* at 24.

³¹⁹ *Id.*

that the public will have only the final product by which to evaluate their work and the network will not suffer the consequences of its mutilation.³²⁰

Moral rights were addressed and dismissed in two landmark decisions involving sculptures: *Serra v. U.S.*³²¹ and *Community for Creative Non-Violence v. Reid*.³²² In *Serra*, the artist sued to prevent removal of his sculpture “Tilted Arc” from Federal Plaza in New York City because it would infringe his moral rights in that the sculpture had been specifically designed to go in that particular space.³²³ The court denied Serra’s claims on the basis that he had no protected property interest in the continued display of his sculpture because he had contracted his rights away.³²⁴ Moreover, the court held that “though Serra might suffer injury to his reputation as a result of relocation of the sculpture, such an injury . . . would not constitute a constitutionally cognizable deprivation of property or liberty.”³²⁵

Tilted Arc is an example of the moral rights of paternity and integrity. “People now recognize that lip service to Berne is hypocritical. It’s a meaningless piece of paper,” Serra said just before workers completed removal of his sculpture “Tilted Arc” from Federal Plaza.³²⁶

In *Community for Creative Non-Violence*, the artist sued the organization that hired him to produce a sculpture after he learned of their plans to take the statue on a tour of several cities which he thought would ruin the sculpture due to the fragility of the sculpture’s material. The court refused to extend any type of moral rights protection, and instead determined the artist had produced the sculpture as a “work for hire” and thus did not own the work.³²⁷

b. Colorization of Films

When technology developed in the 1980s which allowed a computer to scan black and white films and apply color, moral rights were raised in response to this “colorization.”³²⁸ Opponents of colorization argued that colorization will

³²⁰ *Id.*

³²¹ 847 F.2d 1045 (2d Cir. 1988).

³²² 490 U.S. 730 (1989).

³²³ *Serra*, 847 F.2d at 1046.

³²⁴ *Id.* at 1051.

³²⁵ *Id.* at 1052.

³²⁶ Brooks, *supra* n. 289, at 1433 (citing David W. Dunlap, “Artist Abandons Fight to Bar Uprooting of Plaza Sculpture,” N.Y. Times B2 (Mar. 16, 1989)).

³²⁷ 847 F.2d at 1046.

³²⁸ While the word “colorization” is a trademark of Colorization, Inc., a Canadian company associated with Hal Roach Studios of Los Angeles, it arguably no longer has trademark pro-

ruin the original filmmaker's intent as captured on black-and-white film, and new audiences would be unable to view their "cultural heritage" embodied in the original black—and—white version of the film. Proponents argued that colorized films would encourage new audiences to view "old" films, thus justifying the investment of time and money in converting the films.³²⁹

Colorizers were accused of infringing on authors' rights by creating derivative works. The Copyright Office clarified the point to allow copyright protection for such derivative works only for "those color versions that reveal a certain minimum amount of individual creative human authorship."³³⁰ Two days after this decision, the Copyright Office proposed a rule, which was later adopted, requiring the registrant of a colorized work to deposit both a colorized copy and an original copy of that work with the Library of Congress.³³¹

The colorization issue brought the issue of who is the owner of a film to the forefront. While the owner of the copyright to a black-and-white film can prevent its colorization, filmmaking is a collaborative process which rarely has one creative "author."³³² Thus the artist is frequently not the copyright owner and corporations which have little or no concern for the reputation and integrity of the author can colorize at will.³³³

Artists also debated who was really the artist: the director or the actor. As Bette Davis said: "In films it's the director who's the supreme artist, who in

tection because the word has become generic by its use as a verb to describe all black-and-white movies converted to color.

³²⁹ See H.R. Subcomm. on Cts. Civ. Liberties & the Administration of Just. of the H. Jud. Comm., Hearing on H.R. 2400, *The Gephardt Film Integrity Act*, 100th Cong., 2d Sess. 1 (1988) (cited in Michael C. Penn, *Colorization of Films: Painting a Moustache on the "Mona Lisa"?*, 58 U. Cin. L. Rev. 1023 (1990)).

³³⁰ 37 C.F.R. § 202.1 (2005); 52 Fed. Reg. 23443, 23445 (June 22, 1987).

³³¹ See 53 Fed. Reg. 29887, 29887 (Aug. 9, 1988).

³³² Helen K. Geib, *Classic Films and Historic Landmarks: Protecting America's Film Heritage from Digital Alteration*, 33 John Marshall L. Rev. 185, 203 (1999) (noting that moral rights theory is inherently unsuited to film production because filmmaking is a collaborative process involving many artists and technicians including the principal artists of the screenwriter, director, and cinematographer; thus "films rarely have a single creative "author" in who would vest the moral right," and "recognizing the moral rights of more than one contributing artist carries the danger that the artists could take adverse positions in exercising their rights and "paralyze" the collaborative process.").

³³³ See Stephen Farber, *The Man Hollywood Loves to Hate; Film Buffs Don't Want the Classics Colorized, but Frankly, Ted Turner Doesn't Give a Damn*, L.A. Times Mag., 9 (Apr. 30, 1989) (quoting Ted Turner, president of Turner Broadcasting System Inc. and the force behind the colorization of the MGM film library on colorization, "I think the movies look better in color, pal, and they're my movies" and "Art is in the eye of the beholder. Just because some guy directed it doesn't mean his taste is better than mine.").

the final analysis is responsible for the success or failure of the picture, who shapes his material, inspires the performers, controls, juggles, and fits together all the pieces. We players are merely puppets a director dangles.³³⁴

In addition to colorization only being able to be prevented by the not—so—easily—determined author of the film, the author can only prevent colorization during the term of the copyright. Once the copyright has expired, the copyrighted work enters the public domain and black-and-white films may be colorized without obtaining permission from anyone.

In the now famous Huston case, brought by the heirs of John Huston, director of the film *The Asphalt Jungle*, France's highest court enjoined the broadcast of the colorized version of the originally black—and—white film. Although French law permitted such relief, American law did not recognize Huston's moral rights as he was not the owner of the copyright in the film because moral rights inure to the benefit of an author, but the French court held moral rights protected all authors—even a foreign one.³³⁵

c. After Becoming a Signatory to the Berne Convention

As a signatory to the Berne Convention, the U.S. passed the required implementing legislation³³⁶ but it did not recognize moral rights. The U.S. relied on the Copyright Act of 1976 (which expressly conferred “virtually no moral rights”³³⁷), and other U.S. substantive law it claimed gave adequate protection³³⁸ including the doctrines of unfair competition, breach of contract,

³³⁴ Wagner, *supra* n. 280, at 636-37 (quoting from R. Bare, *The Film Director: A Practical Guide To Motion Picture and Television Techniques* 16 (1971)).

³³⁵ *Huston v. Societe de l'Exploitation de la Cinquieme Chaîne*, 1991 Cass. civ. Ire, 149 R.I.D.A. 197 (Cour de cassation); see also Aljean Harmetz, *John Huston Protests Coloring of 'Maltese Falcon'*, N.Y. Times, C36 (Nov. 14, 1986) (protesting the colorization of *The Maltese Falcon*); Stephen Rebello, *Black and White in Color*, Am. Film 13, 13 (Apr. 1984); Rudolph Carmenaty, *Terry Gilliam's Brazil: A Film Director's Quest for Artistic Integrity in a Moral Rights Vacuum*, 14 Colum.-VLA J. L. & Arts 91 (discussing how Terry Gilliam, director of the film *Brazil*, battled publicly to prevent the film's producers from changing the ending of the film); Wagner, *supra* n. 280, at 701-02 (discussing network television's decision to change the ending of Terry Gilliam's film *Brazil* to suit audiences).

³³⁶ Samuel L. Fox, *Entertainment Industry Contracts: Negotiating and Drafting Guide*, vol. 4 § 172.04, 172-18.2 - 172-18.4 (Donald C. Farber ed.) (Matthew Bender & Co, Inc. 1995) (citing Pub. L. No. 100-568, 102 Stat. 2853 (1988)).

³³⁷ Nimmer, *supra* n. 3, at § 8D.02[C], 8D-12.

³³⁸ Fox, *supra* n. 336.

defamation, right of privacy,³³⁹ and palming-off.³⁴⁰ So against “true” moral rights applying in the U.S., legislators “made sure that TRIPs [the Agreement on Trade-Related Aspects of Intellectual Property Rights] excluded Berne’s article 6bis.”³⁴¹

The U.S. courts continued to refuse moral rights protection.³⁴² It did, however, note that contemporary American copyright law contained “glimmers”³⁴³ and “creepings”³⁴⁴ of moral rights doctrine. For instance, a licensor can insist on approval provisions contractually “to assure quality control and high standards in the exploitation of her creative work”³⁴⁵ and protect artistic reputation.³⁴⁶

Two years after declining to recognize moral rights under the Berne Convention, and post-Tilted Arc, Congress enacted what remains the closest application of moral rights in the United States--the Visual Artists Rights Act (“VARA”).³⁴⁷ It provides artists with the rights of attribution and integrity,

³³⁹ Kwall, *supra* n. 286, at 3; Wagner, *supra* n. 280, at 657-87; White *supra* n. 297, at 252 (discussing colorization).

³⁴⁰ Fox, *supra* n. 336.

³⁴¹ Jane C. Ginsburg, *Art and the Law: Suppression and Liberty Have Moral Rights Come of (Digital) Age in the United States?*, 19 *Cardozo Arts & Ent. L. J.* 9, 10 (2001) (citing *General Agreement on Tariffs and Trade: Multilateral Trade Negotiations Final Act Embodying the Results of the Uruguay Round of Trade Negotiation*, Annex 1C (Apr. 15, 1994), 33 I.L.M. 1125).

³⁴² See *Choe v. Fordham U. Sch. of L.*, 920 F. Supp. 44, 48-49 (S.D.N.Y. 1995) (distinguishing *Gillian*, where making typographic and grammatical errors to a student article was not a radical alteration of content).

³⁴³ *Seshadri v. Kasraian*, 130 F.3d 798, 803 (7th Cir. 1997).

³⁴⁴ *Ty, Inc. v. GMA Accessories, Inc.*, 132 F.3d 1167, 1173 (7th Cir. 1997).

³⁴⁵ *Rey v. Lafferty*, 990 F.2d 1379, 1393 (1st Cir. 1993).

³⁴⁶ See *Clifford Ross Co. v. Nelvana, Ltd.*, 710 F. Supp. 517, 520-21 (S.D.N.Y. 1989), *aff'd without opinion*, *Clifford Ross Co. v. Nelvana, Ltd.*, 883 F.2d 1022 (2d Cir. 1989) (discussing contract for rights to Babar the Elephant); see also *Geisel v. Poynter Prods., Inc.*, 283 F.Supp. 261, 266-68 (S.D.N.Y. 1968) (finding no written contract for Dr. Seuss products).

³⁴⁷ 17 U.S.C. § 106A (discussing rights whereas "the author of a work of visual art: (1) shall have the right (A) to claim authorship of that work, and (B) to prevent the use of his or her name as the author of any work of visual art which he or she did not create; (2) shall have the right to prevent the use of his or her name as the author of the work of visual art in the event of a distortion, mutilation, or other modification of the work which would be prejudicial to his or her honor or reputation; and (3) subject to the limitations set forth in section 113(d), shall have the right (A) to prevent any intentional distortion, mutilation, or other modification of that work which would be prejudicial to his or her honor or reputation, and any intentional distortion, mutilation, or modification of that work is a violation of that right, and (B) to prevent any destruction of a work of recognized stature, and any intentional or grossly negligent destruction of that work is a violation of that right.").

which are analogous to those protected under Article 6*bis* of the Berne Convention.³⁴⁸ VARA is less broad than true moral rights in several ways.

VARA only applies to certain defined works of visual art³⁴⁹ including paintings, drawings, prints, sculptures, and certain photographic images, but has been rejected for a law review comment³⁵⁰ and for notecards.³⁵¹ VARA is limited in scope by its definition of “work of visual art” which does not protect “works for hire.”³⁵² Further, the definition does not protect attribution because it excludes mass market multiples, and because attribution (as well as integrity) rights apply only to “works of visual art.”³⁵³ Finally, while VARA recognizes that any intentional distortion, mutilation, or modification of that work would be prejudicial to the artist’s honor or reputation and grants the artist the right to prevent such, this right is trumped. Works of visual art which have been incorporated in or made part of a building in such a way that removing the work from the building will cause the destruction, distortion, mutilation, or other modification of the work are excluded as are situations where the author consented to the installation of the work in the building either prior to VARA’s effective date or by contract. This is in contrast with “real moral rights” which also protect against distortion of representations of the art image.

³⁴⁸ *Carter v. Helmsley-Spear, Inc.*, 71 F.3d 77, 83 (2d Cir. 1995); *Martin v. City of Indianapolis*, 982 F. Supp. 625, 630 (S.D.N.Y. 1997).

³⁴⁹ 17 U.S.C. §101 (defining a “work of visual art” as “(1) a painting, drawing, print, or sculpture, existing in a single copy, in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author, or, in the case of a sculpture, in multiple cast, carved, or fabricated sculptures of 200 or fewer that are consecutively numbered by the author and bear the signature or other identifying mark of the author; or (2) a still photographic image produced for exhibition purposes only, existing in a single copy that is signed by the author, or in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author. A work of visual art does not include (A)(i) any poster, map, globe, chart, technical drawing, diagram, model, applied art, motion picture or other audiovisual work, book, magazine, newspaper, periodical, data base, electronic information service, electronic publication, or similar publication; (ii) any merchandising item or advertising, promotional, descriptive, covering, or packaging material or container; (iii) any portion or part of any item described in clause (i) or (ii); (B) any work made for hire; or (C) any work not subject to copyright protection under this title.”).

³⁵⁰ *Choe*, 920 F. Supp. at 49.

³⁵¹ *Lee*, 125 F.3d at 582.

³⁵² See *Carter*, 71 F.3d at 85.

³⁵³ Ginsburg, *supra* n. 341, at 11 (suggesting that the Digital Millennium Copyright Act may contain a more general attribution right and right of integrity in Section 1202 although it “falls short” of the protections under the Berne Convention).

d. Status of U.S. Protection for Moral Rights

Most commentators who have compared the U.S. system with the European Community system have concluded that the scope of protection in America for the personal rights of creators is insufficient.³⁵⁴ Further, American compliance with moral rights under Berne fall short of the standards generally accepted.³⁵⁵

In the absence of moral rights protections, U.S. courts have held that “speeding up the rate of play of a video game is a little like playing at 45 or 78 revolutions per minute (RPMs) a phonograph record recorded at 33 RPMs”³⁵⁶ and “a party who distributes a copyrighted work cannot dictate how that work is to be enjoyed...and enhancements [such as a Game Genie] to a copyrighted work [such as a Nintendo Game cartridge] merely make the experience more enjoyable.”³⁵⁷

For much of American history the United States has been a net copyright importer, while Europe has been a net copyright exporter, which is why European countries in general have given broader protection to authors and publishers. However, by the late twentieth century, the United States had become a net copyright exporter—particularly in software, CDs and films.³⁵⁸

At its core, the reason for the aversion of American law to adopt full moral rights protection may be due to the emphasis our culture places on the individual. It also may be due to the United States being a non-socialist government such that economic gain of the individual is emphasized more than a socialist government, which provides its citizens with numerous economic benefits such as housing, education, healthcare, and a liberal welfare system.

C. Clean Videos Under International Law

As discussed earlier, the requirement that copyrights be fixed in a tangible medium, providing protection for derivative works, and the concept of fair use, all exist in countries outside the United States as well. The underlying policies of copyright law are similar, which is why the challenge posed by clean

³⁵⁴ Kwall, *supra* n. 286, at 1.

³⁵⁵ J.H. Reichman, *An Evaluation of the Copyright Term Extension Act of 1995: The Duration of Copyright and the Limits of Cultural Policy*, 14 *Cardozo Arts & Ent. L. J.* 625, 630 (1996).

³⁵⁶ *Midway Mfg. Co.*, 704 F.2d at 1013; *see supra* Section III.

³⁵⁷ *Lewis Galoob Toys, Inc.*, 964 F.2d at 971.

³⁵⁸ Vaidhyanathan, *supra* n. 91, at 160-61.

videos would be approached similarly in other parts of the world. Therefore, only the interesting differences will be discussed in this section.

Authors under the Berne Convention have the exclusive right of authorizing the reproduction of literary and artistic works “in any manner or form.”³⁵⁹ Therefore, a copy made into RAM would likely be an infringement of the author’s reproduction right. Where a full movie is copied and then cleaned, a violation would be present; but ClearPlay, which cleans the video as it is playing, would likely escape liability because a whole copy is never made all at once. This is the same result as in the United States. Because the WIPO Copyright Treaty follows the definition of reproduction in the Berne Convention,³⁶⁰ this suggests that a copy made into RAM would be an infringement of the author’s reproduction right under the Treaty as well as under Berne.

Authors under the EU Copyright Directive have the right to prohibit temporary reproductions as well as permanent reproduction “by any means in any form, in whole or in part.”³⁶¹ This would encompass clean video software temporary reproductions if fixation were to be found. However, exempted are temporary acts of reproduction “which are transient or incidental [and] an integral and essential part of a technological process and whose sole purpose is to enable (a) a transmission in a network between third parties by an intermediary, or (b) a lawful use of a work or other subject-matter to be made, and which have no independent economic significance.”³⁶² Clean videos can be transient if ClearPlay software is used. The sole purpose may be fair and thus lawful, and the use is private and without any independent economic significance if the underlying videos continue to be purchased.

Fixation is required for WIPO Copyright Treaty countries for “fixed copies that can be put into circulation as tangible objects.”³⁶³ This seems to leave out clean videos which are not put into circulation as tangible objects.

Under the EU Copyright Directive, Member States can provide exceptions or limitations to the reproduction right and the distribution right for private use and noncommercial uses as long as the copyright owner receives fair compensation.³⁶⁴ Clean videos fit within this definition as they are viewed privately

³⁵⁹ *Berne Convention*, *supra* n. 261, at art. 9(1).

³⁶⁰ *WIPO Copyright Treaty*, *supra* n. 268, at art. 1 n. 1.

³⁶¹ *EU Copyright Directive*, *supra* n. 273, at art. 2.

³⁶² *Id.* at art. 5(1).

³⁶³ *WIPO Copyright Treaty*, *supra* n. 268, at art. 7 n. 6.

³⁶⁴ *EU Copyright Directive*, *supra* n. 273, at art. 5(4) (discussing reproduction right and distribution right exceptions).

for noncommercial purposes, but there is no compensation being given to the copyright owners.

Further, under the EU Copyright Directive, exceptions are only allowed if they do not conflict with the normal exploitation of the copyrighted work and do not unreasonably prejudice the legitimate interests of the copyright owner.³⁶⁵ Clean videos may be considered “normal exploitation” if moral rights or fair use are found because then the legitimate copyright interests of the rightholder would not be unreasonably prejudiced.

A fair dealing exception is available in some countries outside the United States.³⁶⁶ It provides similar protections to the fair use protections discussed at length above.³⁶⁷ Moral rights protection is more widely available to artists outside the United States.³⁶⁸ Under such protection, the clean videos producers will have violated the artists’ rights and the artists have a cause of action.³⁶⁹

IX. CONCLUSION

Clean videos have not benefited society as required under the copyright law, because artistic creativity has not been stimulated for the general public good by the creation of a new work. In contrast with public displays of paintings, which the public can enjoy and be inspired to create from (as Matisse/Picasso, and Manet/Velasquez did), the amount of creativity added by cleaned videos is substantially similar to the original (save for the “offending” material).

The appearance of clean videos on a computer screen after being filtered by software is the functional equivalent of fixation. Thus, clean videos can be copyrighted as a derivative work. In the alternative, if clean videos are not copyrightable as a derivative work it would be because they are substantially similar to the original—which would be a copy and thus an infringement.

Infringement is not defensible on fair use grounds for most types of clean videos, and arguably not with ClearPlay editing software either. Although viewed privately at home, the use is commercial because clean video producers make money in transforming the original movies to cleaned videos. As an entertainment use, clean videos are more creative than informational and not in the

³⁶⁵ *Id.* at art. 5(5).

³⁶⁶ Fitzgerald, *supra* n. 259, at 116.

³⁶⁷ *Supra* § VII(A) (discussing fair use protections).

³⁶⁸ *See generally supra* § VII (discussing moral rights).

³⁶⁹ *See supra* § VI(C) (discussing clean videos).

core of intended copyright protection. The amount and substantiality of the original movie varies from movie to movie, but a substantial portion of each original movie is used to create every cleaned video. The effect on the potential market for, or value of, the original movie also weighs against the clean video producer, because whereas the Game Genie did not supplant the market for the original works—the Nintendo video games—some types of cleaned videos currently on the market provide the subscriber with an alternative to buying the original movie, because subscribers can instead buy, or rent, the cleaned video.

Internationally, copyright protections are similar to those in the United States and clean video producers would also violate the copyright holders rights. In addition, authors in many countries, not including the United States, will also have moral rights protection because the author's right to protect his creative process has been violated by the distortion created by clean videos from their intended format.

When the *Sony* court addressed the impact of new technology on copyright law, it held that “[w]hen technological change has rendered its literal terms ambiguous, the Copyright Act must be construed in light of this basic purpose [to stimulate artistic creativity for the general public good].”³⁷⁰ Are “science and the useful arts” being promoted by requiring fixation in an tangible medium for derivative works?

As the U.S. Supreme Court has held, “[s]ound policy, as well as history, supports our consistent deference to Congress when major technological innovations alter the market for copyrighted materials.”³⁷¹ This may be true, but judge-made law also regularly occurs such as derivative works³⁷² and fair use³⁷³ in the United States and moral rights in France,³⁷⁴ which were judge-made law before being codified.

It has been noted that “[t]echnology often raises difficult questions concerning the proper role of intellectual property law,”³⁷⁵ which Congress and the

³⁷⁰ *Sony Corp. of Am.*, 464 U.S. at 432 (citing *Twentieth Cent. Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975)).

³⁷¹ *Id.* at 431.

³⁷² *Suntrust Bank*, 268 F.3d at 1261 (explaining that the 1909 Act codified the concept of a derivative work).

³⁷³ *Sony Corp. of Am.*, 464 U.S. at 447 n. 29.

³⁷⁴ See Tritton, *supra* n. 265.

³⁷⁵ See 132 Cong. Rec. H4385 (daily ed. June 26, 1986) (discussing the stress that technology places on the intellectual property system as a whole and on each of its parts, cited in Daniel McKendree Sessa, *Moral Right Protections in the Colorization of Black and White Motion Pictures: A Black and White Issue*, 16 Hofstra L. Rev. 503, 541 (Winter 1988)); Kelly M.

courts need to address—such as how to apply fixation in light of new technologies such as clean videos. Interpreting fixation as “the functional equivalent of fixation” in a tangible medium, and not a fixation of the absolute copyrighted work, will preserve the Copyright Act’s ultimate aim of stimulating artistic creativity for the general public good by giving authors the incentive of securing a fair return for their creative labor by the granting of a limited monopoly.³⁷⁶

The Family Movie Act of 2005 has addressed the issue raised by technology. And copyright law lost.

Slavitt, *Gabby in Wonderland—Through the Internet Looking Glass*, 80 J. Pat. & Trademark Off. Soc’y 611, 611 (1998).

³⁷⁶ *Sony Corp. of Am.*, 464 U.S. at 432.