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Emphasizing the Copy in Copyright: Why Noncopying Alterations Do Not Prepare Infringing Derivative Works

I. INTRODUCTION

Utilizing new digital editing technologies, an infant industry began supplying home-video consumers with the option of viewing edited versions of popular movies. These “sanitized” versions removed content deemed objectionable by some consumers, including profanity, sexual content, and violence. Many within the motion picture industry, however, found such unauthorized editing to be objectionable. Fearing that the motion picture industry would bring a lawsuit to end their business operation, a franchisee of the popular video-editing company CleanFlicks sued sixteen Hollywood directors for declaratory relief.¹ Before long, many major motion picture studios came to the defense of the directors, countersuing the entire home-video-editing industry for, *inter alia*, copyright infringement. Some home-video editors, however, never *copied* the original motion pictures in order to provide edited versions—instead they produced filters that altered copies of the original movies during real-time playback—making claims of *copyright* infringement unintuitive. Displeased with the edited affect, regardless of the noncopying method employed, the motion picture studios alleged that video filterers infringed their copyrights by preparing *derivative works*² of their protected movies. Conflicting precedent regarding other *noncopying alterations* made resolution of the case unpredictable. Before the district court reached a ruling on motions for summary judgment, the

1. See Second Amended Complaint at 5–6, *Huntsman v. Soderbergh* (D. Colo. filed Oct. 28, 2002) (No. 02-M-1662), available at <http://news.findlaw.com/hdocs/docs/copyright/cflicstud102802cmp.pdf>.

2. Derivative works are works based upon one or more preexisting works. See 17 U.S.C. § 101 (2000). For instance, a motion picture based upon a book is a derivative work of that book. The 1976 Copyright Act granted copyright owners the exclusive right to prepare derivative works based upon their copyrighted works. See 17 U.S.C. § 106(2).

issue became moot when Congress enacted the Family Movie Act of 2005,³ which expressly authorizes video-filtering technologies.⁴

Litigation over video filtering is the most recent addition to a growing list of unpredictable controversies arising from noncopying alterations of copyrighted works. Prior to the 1976 Copyright Act (hereinafter “Act” or “1976 Act”), courts consistently rejected attempts to prohibit mere unauthorized alterations of protected works unless there was evidence that those works were copied⁵ in one form or another. Since the 1976 Act, however, some courts have prohibited unauthorized alterations even absent any evidence of copying, finding that these noncopying alterations infringed the exclusive right of copyright owners to prepare derivative works. Although rudimentary forms of the derivative right date back to the 1870 Copyright Act, the 1976 Act redefined the right very broadly, granting copyright owners the right to prohibit the creation of any work based upon the owners’ preexisting works. Relying on this broad definition of the Act, plaintiffs have alleged that respective defendants created derivative works merely by altering lawfully purchased copies of a work or by manufacturing component devices that alter the appearance of a work in real time. Defendants in these cases have included commercial art stores, video-game and other toy producers, clothing manufacturers, software engineers, webpage advertisers, and, most recently, home-video filterers.

Although evidence of copying is elementary to copyright infringement in general, no court deciding a noncopying-alteration case has specifically addressed whether evidence of copying is necessary to prove infringement of the derivative right. Courts have addressed, instead, various other issues, which has resulted in confusing and contradictory federal case law. Supreme Court review is ripe in order to resolve conflicting decisions among the circuit courts and to avoid special congressional intervention, such as the Family Movie Act of 2005. To remedy the current dilemma, courts must directly address

3. Pub. L. No. 109-9, §§ 201–202, 119 Stat. 218, 223–24 (to be codified at 17 U.S.C. § 110, 15 U.S.C. § 1114).

4. For more on the home-video editing/filtering controversy, see *infra* notes 258–272 and accompanying text.

5. The term “copied,” as used here and throughout this Comment, does not necessarily mean “reproduced.” A work may be copied without producing a copy of it. For instance, a motion picture might *copy* the characters, plots, and dialogues from a novel without ever reproducing a *copy* of the book.

whether unauthorized, noncopying alterations prepare infringing derivative works. This Comment concludes that there is no infringement of a copyright owner's exclusive right to prepare derivative works unless the defendant copied the owner's copyrighted work or its elements.

Part II describes the gradual expansion of copyright, which has led to the current controversy over whether noncopying alterations prepare infringing derivative works. Part III examines the judicial treatment of noncopying alterations both before and after the 1976 Act, focusing on the increasingly divergent decisions following the Act. Part IV advocates *emphasizing the copy in copyright* by concluding that noncopying alterations are not infringing derivative works because the Act's "based upon" requirement implies evidence of copying. In addition, Part IV explains that holding noncopying alterations not to infringe the derivative right would provide a consistent framework for disavowing two circumspect federal appellate court decisions, and would substantially eliminate the need for resorting to narrow legislative exemptions for noncopying alterations. Part V summarizes these conclusions.

Before continuing, it will be helpful to define the nouns "work," "copy," and "embodiment," as well as the verbs "reproduce," "copy," and "alter," as these terms are used in this Comment. Understanding the distinctions between these terms will help clearly define the concept of a "noncopying alteration." Additionally, subtle distinctions between these terms will help form the basis for the conclusions this Comment reaches.

A "work," as used herein, means a copyrightable work, as defined by the Copyright Act—that is, an "original work[] of authorship fixed in any tangible medium of expression . . . from which [it] can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device."⁶ For example, a printed script of a drama intended for live performance is a work because it is fixed in the tangible mediums of ink and paper. An impromptu theatrical performance, however, is not a work because it is not fixed in any tangible medium of expression. Alternatively, if the same impromptu theatrical performance were recorded, it would then be a work because the recording is fixed in a tangible medium of expression.

6. 17 U.S.C. § 102(a) (defining general subject matter of copyright).

A “copy” of a work, as defined in this Comment,⁷ is a substantially similar representation of the original work, or its copyrightable elements, in a similar form of object as the original—that is, an object consisting of a medium similar to the medium of the object in which the original work was fixed. For example, books published from a handwritten manuscript are copies of the manuscript. Each book is a substantially similar representation of the original manuscript and is fixed into an object (the printed pages of the book) that is similar to the original object in which the work was fixed (the handwritten pages of the manuscript). Thus, the published books are “copies” of the handwritten manuscript.

As used herein, to “reproduce” a work means to intentionally multiply copies of a work. It is possible, however, to *copy (verb)* a work without reproducing a *copy (noun)* of it. In other words, although reproducing a work is one way of copying a work, there are also other ways.⁸ For example, a movie based upon a book copies the book, even though the movie is not a copy of the book. Although the movie is a substantially similar representation of the book, the film recording (either digital or analog) is not a similar medium to the printed pages of the book. Thus, even though the process of deriving one work from another necessarily requires copying, the resultant derivative work is not properly called a copy of the work from which it is derived. Similarly, a live performance of a dramatic script copies the script—when, for instance, the performers repeat the dialogue from the script—even though the performance is not a copy of the script. Defining the concept of copying to include activities other than just reproducing a work—such as preparing derivative works or performing works—comports with the common, everyday use of the verb “copy.” For instance, children might complain that siblings copy their favorite basketball moves or copy their styles of dress and grooming, even though the allegedly infringing

7. The Copyright Act defines “copies” as “material objects . . . 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.” 17 U.S.C. § 101. The definition of “copy” provided in this Comment, in essence, embellishes this definition in two ways. First, it clarifies that a copy is substantially similar to the original work. Second, it clarifies that the material object, in which the copy is fixed, consists of a medium similar to the medium in which the original work was fixed. This second element helps distinguish a “copy” of a work from an “embodiment” of a work.

8. For more on the distinction between reproducing and copying, see, for example, 2 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 8.02[A] (1963).

siblings would not have reproduced anything by their allegedly copying behavior.⁹

Because the common, everyday use of the verb “copy” may include more activities than just reproduction, it is necessary to distinguish between the noun and verb forms of the term “copy,” and, in so doing, to distinguish between “reproducing” a work—that is, intentionally multiplying *copies* of a work—and “copying” a work. In this Comment, the term “copy,” as a verb, means to intentionally multiply *embodiments* of a work or its elements. An “embodiment” of a work, as defined here,¹⁰ is a substantially similar representation of the original work, or its copyrightable elements, in any form. In contrast to a copy, an embodiment of a work need not be fixed in a similar object, or even be fixed in any object at all. Thus, the elements of a literary work previously published in a book, for example, may be embodied in an object similar to the original (for example, a photocopy), embodied in an object different from the original (for example, a motion picture), or embodied in no object at all (for example, a live performance).

In summary, this Comment distinguishes the concept of copying a work from the concept of reproducing a copy of a work. The definition of the term “copy” depends on whether it is being used as a noun or as a verb. Although the noun form of “copy” generally refers only to a reproduction of a work, the verb form of “copy” generally refers to other activities in addition to reproduction, including the preparation of derivative works and the performance of works. Now that the “copying” element of “noncopying alteration” has been described, it will be helpful to define the “alteration” element.

The term “alter” is easy to define, but difficult to apply. Succinctly, the term “alter” merely means to modify. Copyrighted works may be altered in a number of ways. For example, movies based upon books, in most cases, alter certain elements of the respective books in order to adapt them to cinematic storytelling. In this example, the movie producer copies and alters the original copyrighted text. It is possible, however, to alter a copyrighted work without copying it. For example, a book retailer might decide to excise vulgar words from copies of particular novels by marking through the words with a thick, black marker. In this example,

9. In this sense, it may be helpful to think of copying as “mimicking.”

10. The term “embodiment” is not common to copyright law. There is no intention here to draw any parallels to the use of the term in patent law.

the book retailer has altered copies of original works without copying the respective works. Accordingly, this Comment refers to these kinds of alterations as *noncopying* alterations. Whether copyright law *should prohibit* unauthorized, noncopying alterations is an important policy discussion that this Comment does not directly address. Instead, this Comment focuses on whether the 1976 Copyright Act *did prohibit* unauthorized, noncopying alterations.

With these definitions in mind, it is possible to make a subtle, but important, point: altering a copy of an original work may create a new work without copying the original work. This point is best understood by way of example. Consider an artist who paints a landscape picture of a treeless prairie and sells the picture to another artist. If the second artist paints a tree in the middle of the prairie, the original work of art was *modified* (or altered), but it was not *multiplied*. Although the alteration created a new work—assuming the tree contained sufficiently original expression—it was not another embodiment of the original work and, therefore, did not multiply embodiments of the original work. Thus, mere alterations to a copy of a work—even those that create separate, additional works—do not necessarily multiply the original work; instead these noncopying alterations embody other, additional works.

It is possible, however, to alter a work in such a way that the alteration copies—that is, intentionally multiplies the embodiments of—the original work. For example, consider an artist who paints a landscape picture of a prairie with a single tree and sells the picture to another artist. If the second artist paints onto the original picture a second tree that is substantially similar to the first tree, then the original work—or, more specifically, an element of it (the tree)—has been multiplied. There are now two embodiments of an original work: the first tree embodied in the paint of the original painting and the second tree embodied in the paint of the alteration. In this example, a copying alteration multiplied the number of embodiments of an original work. Thus, although an alteration to a copy does not necessarily copy the original work, it may. The analysis in Parts III and IV depends on this distinction between copying and noncopying alterations.

Finally, it will be helpful to make another subtle, but important, point: a work may be created from another work without creating a multiple embodiment of the original work. Consider again the first example of an artist who paints a landscape picture of a treeless prairie and sells the picture to another artist. As mentioned above, if the second artist paints a tree in the middle of the prairie, a multiple embodiment of

the original work is not created because the added expression, the tree, is completely original. This is true even though the resulting work comprises the original work. As another example, consider an automobile, which is comprised of its parts, but does not embody its parts. An automobile embodies a design, which may have originated on a drafting board or a computer screen. Thus, an automobile is comprised of its parts, but it embodies a design. Assembling an automobile does not create a multiple embodiment of its parts, though it does create an embodiment of the automobile design.

At times it is difficult to identify a noncopying alteration because the altered work is comprised of copies of an original work. The key to distinguishing a noncopying alteration from a copying alteration is to ask whether the alteration copied—that is, to ask whether an original work was copied in the process of alteration. Thus, the addition of a tree to a painting of a treeless prairie does not necessarily copy, unless the added tree is copied from another work. Even though the resulting work—a painting of a prairie with a single tree—comprises a copy of the original work, the alteration did not copy any expression from the original work, making the alteration a noncopying alteration. Similarly, an assembled automobile does not copy its parts, though it does copy its design, making the assembly a noncopying alteration. While reading about the noncopying alterations discussed in Parts III and IV, it will be helpful to keep this distinction in mind.

II. BACKGROUND: THE GRADUAL EXPANSION OF COPYRIGHT

Originally, copyright protected authors only from the unauthorized reproduction of their original works. Over the years, the derivative right gradually grew out of this original reproduction right.¹¹ In 1790, the first copyright statute conferred to the authors of “any map, chart, book or books” only the rights of “printing, reprinting, publishing and

11. For more on the history of the gradual development of the derivative right, see Paul Goldstein, *Derivative Rights and Derivative Works in Copyright*, 30 J. COPYRIGHT SOC'Y U.S.A. 209, 211–15 (1983). In addition, although not specifically addressing derivative rights, Professor L. Ray Patterson's insightful history of copyright provides helpful background for drawing the distinction between derivative works that copy preexisting works and derivative works that merely alter copies of preexisting works. See L. Ray Patterson, *Free Speech, Copyright, and Fair Use*, 40 VAND. L. REV. 1 (1987).

vending.”¹² Owing to this narrow reach of copyright, Harriet Beecher Stowe was unable to exclude unauthorized translations of her novel *Uncle Tom’s Cabin* into German.¹³ Although the translation was, in essence, “the same book,”¹⁴ the deciding court held that the copyright statute extended only to the “particular combination of characters” in the author’s original book.¹⁵ Significantly, the court observed that copying had occurred, but it refused to recognize such copying as prohibited by statute: “A translation may, in loose phraseology, be called a transcript or *copy* of her thoughts or conceptions, but in no correct sense can it be called a *copy* of her book.”¹⁶ Thus, copyright did not originally prohibit all forms of copying; rather, copyright prohibited only reproduction.

Slowly, Congress began to expand the scope of copyright to include many forms of copying other than just page-by-page duplication. In 1856, Congress prohibited theater performers from copying (that is, performing without permission) an author’s protected, dramatic works.¹⁷ Then, in the Copyright Acts of 1870 and 1909, Congress prohibited several forms of derivative copying. Taken together, the 1870 and 1909 Copyright Acts expressly prohibited, without the author’s permission, the

12. Act of May 31, 1790, ch. 15, § 1, 1 Stat. 124 (repealed 1831). Although, the 1831 Act expanded the list of protected works to include musical compositions, the exclusive rights of authors remained only those of printing, reprinting, publishing, and vending. *See* Act of Feb. 3, 1831, ch. 16, § 1, 4 Stat. 436 (repealed 1870).

13. *See* *Stowe v. Thomas*, 23 F. Cas. 201 (C.C.E.D. Pa. 1853) (No. 13,514).

14. *Id.* at 202.

15. *Id.* at 206. The court reasoned,

The claim of literary property, therefore, after publication, cannot be in the ideas, sentiments, or the creations of the imagination of the poet or novelist as dissevered from the language, idiom, style, or the outward semblance and exhibition of them. His exclusive property in the creation of his mind, cannot be vested in the author as abstractions, but only in the concrete form which he has given them, and the language in which he has clothed them. When he has sold his book, the only property which he reserves to himself, or which the law gives to him, is the *exclusive right to multiply the copies* of that particular combination of characters which exhibits to the eyes of another the ideas intended to be conveyed. This is what the law terms copy, or copyright.

Id. at 206–07 (emphasis added).

16. *Id.* at 208 (emphasis added).

17. Specifically, Congress included dramatic compositions among the list of protected works and granted the author of such a work the “sole right to act, perform, or represent the same, or cause it to be acted, performed, or represented, on any stage or public place.” Act of Aug. 18, 1856, ch. 169, 11 Stat. 138 (repealed 1870). This was the first manifestation of the present-day performance right codified at 17 U.S.C. § 106(4) (2000).

translation of literary works into other languages,¹⁸ the conversion of dramatic compositions into novels¹⁹ (and vice versa²⁰), the arrangement or adaptation of musical works for use with different voices or instruments,²¹ and the creation of three-dimensional works of art from two-dimensional models or designs.²² Thus, copyright gradually began to prohibit the copying of themes, styles, characters, forms, structures, stories, plots, designs, arrangements, organizations, etc., in addition to prohibiting exact print duplication. For instance, the Supreme Court in *Kalem Co. v. Harper Bros.*²³ held that an unauthorized motion picture infringed the dramatization right of the copyright owner of the novel *Ben Hur* because the silent film acted out certain “portions [of the book] giving enough of the story [so as] to be identified with ease.”²⁴

Although the 1870 and 1909 Acts expanded the scope of copy protection, courts did not interpret copyright to prohibit all methods of copying. For instance, the Supreme Court in *White-Smith Music Publishing Co. v. Apollo Co.*²⁵ held that perforated rolls used to operate

18. The exclusive right to translate a work originated in the 1870 Copyright Act. Act of July 8, 1870, ch. 230, § 86, 16 Stat. 212 (repealed 1909) (granting authors the exclusive “right to . . . translate their . . . works”). The 1909 Copyright Act preserved this right. Act of Mar. 4, 1909, ch. 320, § 1(b), 35 Stat. 1175 (repealed 1976) (preserving the author’s exclusive right to translate literary works “into other languages or dialects, or make any other version thereof”).

19. The exclusive right to dramatize a work originated in the 1870 Copyright Act. Act of July 8, 1870, ch. 230, § 86, 16 Stat. 212 (repealed 1909) (granting authors the exclusive “right to dramatize . . . their . . . works”). The 1909 Copyright Act preserved this right. Act of Mar. 4, 1909, ch. 320, § 1(b), 35 Stat. 1175 (repealed 1976) (preserving the author’s exclusive right “to dramatize [a copyrighted work] if it be a non-dramatic work”).

20. Act of Mar. 4, 1909, ch. 320, § 1(b), 35 Stat. 1175 (repealed 1976) (granting authors the exclusive right “to convert [the copyrighted work] into a novel or other non-dramatic work if it be a drama”).

21. *Id.* (granting authors the exclusive right “to arrange or adapt [the copyrighted work] if it be a musical work”).

22. *Id.* (granting authors the exclusive right “to complete, execute, and finish [the copyrighted work] if it be a model or design for a work of art”).

23. 222 U.S. 55 (1911).

24. *Id.* at 60. The Court stated,

We are of the opinion that *Ben Hur* was dramatized by what was done. Whether we consider the purpose of this clause of the statute [the 1891 Act], or the etymological history and present usages of language, drama may be achieved by action as well as by speech. Action can tell a story, display all the most vivid relations between men, and depict every kind of human emotion, without aid of a word.

Id. at 61. Although the case was decided in 1911, the Court applied the provisions of the 1891 Act (which had amended the 1870 Act), presumably, because the motion picture was released in 1907, which was prior to the enactment of the 1909 Act. *See id.*

25. 209 U.S. 1 (1908).

player pianos were not “copies or publications of the [original] copyrighted music.”²⁶ Additionally, in *Kalem* Justice Holmes acknowledged—without deciding, however, the merits of—the lower court’s conclusion that “pictures of scenes in a novel may be made and exhibited without infringing the copyright.”²⁷ Thus, the Supreme Court had refused to recognize that player-piano music rolls or pictorial representations of novels were the result of prohibited copying, even though both had been based upon original works.

When Congress enacted the 1976 Copyright Act, however, it granted copyright owners, in very broad terms, the exclusive right, *inter alia*,²⁸ “to prepare *derivative works* based upon the copyrighted work.”²⁹ Significantly, the definition of “derivative work” encompassed not only familiar examples such as translations and dramatizations, which had been protected previously, but also included “any other form in which a work may be *recast, transformed, or adapted*.”³⁰ Because the derivative right was defined so broadly, plaintiff copyright owners began to allege infringement for mere alterations to copies of their works—as, arguably, any alteration to a copyrighted work might recast, transform, or adapt that work—even though the defendants had never *copied* the plaintiffs’ works.³¹ In some cases, plaintiffs sought to enforce otherwise unenforceable “moral rights”³² disguised as infringement claims.³³ This

26. *Id.* at 18. Concurring specially, Justice Holmes appeared to concede to the majority’s holding only out of respect for the “opinions in this country and abroad.” *Id.* (Holmes, J., concurring). He subsequently opined, “On principle anything that mechanically reproduces [the] collocation of sounds [of the original musical composition] ought to be held a copy” *Id.* at 20 (Holmes, J., concurring).

27. *Kalem*, 222 U.S. at 62.

28. The 1976 Copyright Act also grants owners the right to reproduce, distribute, perform, and display their copyrighted works. *See* 17 U.S.C. § 106(1), (3)–(6) (2000).

29. 17 U.S.C. § 106(2) (emphasis added).

30. *Id.* § 101 (emphasis added).

31. *See infra* Part III.B.

32. The term “moral rights” originates from the French *le droit moral*, the doctrine that an author possesses, in addition to economic interests, certain personal rights in their original works of art, such as rights of integrity and attribution. For more on moral rights, see, for example, 3 NIMMER & NIMMER, *supra* note 8, § 8D. Commentators and courts disagree on the extent to which American copyright law recognizes moral rights. *See, e.g.*, 3 NIMMER & NIMMER, *supra* note 8, § 8D.02[A], at 8D-10 to -11.

33. *See infra* note 215 and accompanying text. Because it appears that other plaintiffs have alleged infringement of the derivative right for economic reasons, it is only accurate to write that some plaintiffs have attempted to enforce otherwise unenforceable moral rights through the backdoor of alleging infringement of the derivative right.

Comment concludes that Congress did not intend this result. As demonstrated in Part IV.A, neither the context nor the text of the Act supports finding copyright infringement without evidence of copying. Before addressing the proper interpretation of the modern-day derivative right, however, it will be helpful to examine how courts have treated noncopying alterations both before and after the Act.

III. CASE LAW ADDRESSING NONCOPYING ALTERATIONS: BEFORE AND AFTER THE 1976 COPYRIGHT ACT

This Part attempts to collect federal case law addressing noncopying alterations. Because courts and commentators have not directly addressed whether noncopying alterations prepare infringing derivative works, this collection is unique. Although other authors have identified groups of cases within this field,³⁴ these cases have not been identified for their noncopying characteristic. In other words, the following cases have never been characterized as a distinct category of derivative works cases—that is, as noncopying-alteration cases.

Because the 1976 Copyright Act changed how courts decided controversies arising from noncopying alterations, this Part first collects all pre-1976 cases addressing noncopying alterations—when courts generally did not find infringement absent proof of copying—and then collects all post-1976 cases—when courts began to divide over whether certain noncopying alterations infringed the derivative right. Again, neither courts nor commentators have categorized these cases according to their noncopying characteristic, so it should be remembered that courts have not expressly, or perhaps even consciously, divided over whether noncopying alterations prepare infringing derivative works. As of yet, no court has squarely addressed the issue. In a sense, courts have divided unwittingly, some holding certain noncopying alterations to be infringing and some finding other noncopying alterations not to be infringing. All

34. See, e.g., 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 COMM. & ENT. L.J. 615 (1993) (addressing computer add-ons); Lydia Pallas Loren, *The Changing Nature of Derivative Works in the Face of New Technologies*, 4 J. SMALL & EMERGING BUS. L. 57 (2000) (addressing “integrated works,” those works that reference but do not copy other works); Pamela Samuelson, *Modifying Copyrighted Software: Adjusting Copyright To Accommodate a Technology*, 28 JURIMETRICS J. 179 (1988) (addressing modifications to software).

of these cases ignore the question of whether noncopying alterations prepare infringing derivative works.

*A. Before the 1976 Copyright Act: No Infringement
Absent Proof of Copying*

Prior to the 1976 Act, courts generally found no copyright infringement without proof of copying, even when defendants altered original works without authorization. By far the most often litigated controversy was the rebinding of books.

In the rebound-book cases, courts consistently held that the mere restoration of copyrighted books did not infringe copyright. For example, in *Harrison v. Maynard, Merrill & Co.*,³⁵ a secondhand book dealer did not infringe the copyright of the plaintiff when the defendant rebound, for the purpose of resale, damaged copies of the plaintiff's books.³⁶ In a similar case, *Doan v. American Book Co.*,³⁷ the plaintiff argued that copyright prohibited unauthorized repair or renewal of the plaintiff's copyrighted work by those who purchased copies of it. Relying on *Harrison*, the court of appeals concluded, "A right of ownership in the book carries with it and includes the right to maintain the book as nearly as possible in its original condition, so far, at least, as the cover and the binding of the book is concerned."³⁸ Thus, courts consistently rejected

35. 61 F. 689 (2d Cir. 1894).

36. The court reasoned: "The new purchaser cannot reprint the copy. He cannot print or publish a new edition of the book; but, the copy having been absolutely sold to him, the ordinary incidents of ownership in personal property, among which is the right of alienation, attach to it." *Id.* at 691. (Interestingly, although the defendant had altered copies of the plaintiff's work without permission, the plaintiff did not object to the unauthorized *alteration* of the books per se, but rather to their unauthorized *resale*.) Although the plaintiff had sold the copies (to merchants who later sold them to the defendant) with the express condition that the books be used for paper stock and not otherwise be placed on the market, the court held that the plaintiff could not enforce, by virtue of copyright, the contractual agreements between the plaintiff and an original purchaser against a subsequent purchaser. *Id.* According to the court, the plaintiff's sole remedy was for breach of contract against the original purchaser. *Id.*

Harrison's holding has been followed by subsequent courts. See, e.g., *Indep. News Co. v. Williams*, 293 F.2d 510 (3d Cir. 1961) (refusing to hold defendant liable for copyright infringement for purchasing cover-removed comics from waste paper dealers); *Burke & Van Heusen, Inc. v. Arrow Drug, Inc.*, 233 F. Supp. 881 (E.D. Pa. 1964) (finding no copyright infringement when the defendant sold separately plaintiff's copyrighted phonorecords and bottles of shampoo, which were originally sold to a third party who agreed to a restrictive license with the plaintiff to sell the records and shampoo together).

37. 105 F. 772 (7th Cir. 1901).

38. *Id.* at 777 (citing *Harrison*, 61 F. 689).

claims of copyright infringement for unauthorized, noncopying alterations of books, at least for restorative purposes.³⁹

Courts were less consistent deciding cases addressing book alterations for nonrestorative purposes. One appellate court, in *Kipling v. G.P. Putnam's Sons*,⁴⁰ affirmed *Harrison* and *Doan* and held that binding previously unbound manuscripts did not infringe the copyright in the manuscripts.⁴¹ Two district courts, however, split over whether unauthorized, noncopying compilations infringed. *National Geographic Society v. Classified Geographic*⁴² held that the defendant infringed the plaintiff's copyrights when the defendant purchased secondhand copies of the plaintiff's magazine, disassembled the magazines into separate articles, and organized and bound like-category articles into book form.⁴³ In contrast, *Fawcett Publications v. Elliot Publishing Co.*⁴⁴ held that the defendant did not infringe the plaintiff's copyright when the defendant purchased secondhand copies of the plaintiff's comic book and subsequently bound them together with other comic publications (not owned by the plaintiff).⁴⁵ These cases are, perhaps, distinguishable because the defendant in *National Geographic* recompiled only the

39. *But see* *Ginn & Co. v. Appollo Publ'g Co.*, 215 F. 772 (E.D. Pa. 1914) (holding defendant book restorer liable for copyright infringement for appending recopied maps and reprinted text to replace the missing parts in the used books). In *Ginn & Co.*, however, there was evidence of copying, even though it was only for restorative purposes. *Id.* at 775. It is unclear whether the court would have found the appendage of non-copied maps and text to be infringing.

Doan v. American Book Co., 105 F. 772 (7th Cir. 1901), however, also involved copying. Interestingly, the court permitted the "exact imitation"—that is, the copying—of the original binding design in order to restore the book to its original condition. *See id.* at 774. Arguably, the copying required for restoration does not multiply the copies of the original work, but rather maintains copies of the original work. *Doan* may have relied on this assumption; otherwise, it is difficult to understand why the court permitted the defendant's copying of the plaintiff's (presumably copyrightable) bindings, though it may be the case that the plaintiff never copyrighted the bindings or that the bindings were not sufficiently original to be copyrightable, leaving them unprotected. *Ginn & Co.*, though referencing *Doan*, did not justify the distinction between copying the binding (permitted in *Doan*) and copying the text, which it prohibited. *See Ginn & Co.*, 215 F.2d at 778. The issue of restorative copying highlights the subtle problem of nonmultiplicative copying.

40. 120 F. 631 (2d Cir. 1903).

41. *Id.* at 634. *Kipling* also permitted a purchaser to compile an index reference for the copyrighted works, even though this required the copying of words and phrases. *Id.* at 635. This permissible copying is best understood as a fair use of the copyrighted work, or perhaps more precisely, a fair copy.

42. 27 F. Supp. 655 (D. Mass. 1939).

43. *Id.* at 657.

44. 46 F. Supp. 717 (S.D.N.Y. 1942).

45. *Id.* at 717–18.

plaintiff's works, albeit in a different order, whereas the defendant in *Fawcett Publications* recompiled the plaintiff's work with other works the plaintiff did not own. This distinction, however, is without significance. In both cases, the defendant altered (when the defendant compiled) lawfully purchased copies of the plaintiff's works without copying them, yet the deciding courts reached opposite conclusions. On this basis, these cases are irreconcilable.

In addition to the bookbinding cases, pre-1976 courts also addressed other controversies arising from unauthorized, noncopying alterations. As in the bookbinding cases, these courts generally did not find copyright infringement absent copying—that is, absent some multiplication of embodiments of the work. In *Scarves by Vera, Inc. v. American Handbags, Inc.*,⁴⁶ the defendant made women's handbags from copies of the plaintiff's copyrighted towels, but the plaintiff did not challenge this unauthorized alteration, presumably because there was little, if any, precedent for noncopying infringement.⁴⁷ In another case, *Blazon, Inc. v. Deluxe Game Corp.*,⁴⁸ the defendant repainted a copy (lawfully purchased) of the plaintiff's copyrighted hobbyhorse for display in defendant's showroom. Here the plaintiff alleged infringement, but the district court ruled for the defendant, observing, "It is clear that before there can be infringement there must be . . . some proof of copying, and as a matter of logic there can be no copying in the case at bar where the horse seized and alleged to copy [the plaintiff's horse] . . . is in fact [the same horse] . . ." ⁴⁹ Finally, in *C.M. Paula Co. v. Logan*,⁵⁰ the defendant used a "transfer medium" to remove copyrighted designs from greeting cards and notepads and affixed the removed images to ceramic plaques.⁵¹ The federal district court

46. 188 F. Supp. 255 (S.D.N.Y. 1960).

47. *Id.* at 258. Instead, the plaintiff objected to the defendant's removal of the copyright notice from the towels, alleging that consumers would be confused as to the source of the copyrighted design. *Id.* Accordingly, the district court enjoined the defendant from selling the handbags without notice that the design was the copyrighted design of the plaintiff. *Id.* The parties did not raise, and the court did not consider, whether an unauthorized alteration violates copyright because, presumably, prior to the 1976 Act infringement required proof of copying, and there was no evidence of copying in this case.

48. 268 F. Supp. 416 (S.D.N.Y. 1965).

49. *Id.* at 420 (emphasis omitted) (citing *Affiliated Enters., Inc. v. Gruber* 86 F.2d 958 (1st Cir. 1936)).

50. 355 F. Supp. 189 (N.D. Tex. 1973).

51. *Id.* at 190.

concluded, “the process . . . does not constitute copying.”⁵²

It will be helpful to examine the reasoning from *C.M. Paula* more closely, as the opinion explains very carefully why the process of *altering* a work is not the same as *copying* a work. The district court reasoned:

The Court notes at the outset that without copying there can be no infringement of copyright. . . . The process utilized by defendant that is now in question results in the use of the original image on a ceramic plaque; such process is not a “reproduction or duplication.”

. . . Each ceramic plaque sold by defendant with a Paula print affixed thereto requires the purchase and use of an individual piece of artwork marketed by the plaintiff. For example, should defendant desire to make one hundred ceramic plaques using the identical Paula print, defendant would be required to purchase one hundred separate Paula prints. The Court finds that the process here in question does not constitute copying.⁵³

If, in the alternative, the defendant had created one-hundred ceramic plaques by purchasing a single copy of the copyrighted work, reproducing that copy ninety-nine times, and affixing the total one-hundred copies onto ceramic plaques, then the defendant would have been liable for infringement—for multiplying ninety-nine additional copies of the work. Because the multiplying element was absent, the district court concluded that no copying had occurred.

In contrast, in the many pre-1976 cases where unauthorized alterations did involve copying, courts consistently found copyright infringement. One example is *Addison-Wesley Publishing Co. v. Brown*,⁵⁴ in which the defendants published solutions to the plaintiffs’ physics textbook without permission, altering how students used the textbook.⁵⁵ Although the defendants’ solutions, in general, “substitut[ed]

52. *Id.* at 191 (citing *Blazon*, 268 F. Supp. at 434).

53. *Id.* (footnotes omitted) (citing *Blazon*, 268 F. Supp. at 434).

54. 223 F. Supp. 219 (E.D.N.Y. 1963).

55. Characterizing *Addison-Wesley* as an alteration case requires some consideration. If students have access to the solutions in the textbook, the students will use the textbook in a different manner, utilizing the published solutions to help them answer the textbook problems. This altered use constitutes the unauthorized alteration, though it is not a permanent alteration and occurs only during the real-time use or operation of the work.

paraphrase for direct quotation” of the original problems,⁵⁶ the court appeared to rest its holding of infringement on the finding that the defendant had nevertheless copied from the plaintiff, even though the copy was not a literal reproduction.⁵⁷ The court did not address whether publishing the solutions, without copying any of the original problems, would infringe.

*Gilliam v. ABC, Inc.*⁵⁸ is another case involving unauthorized alterations with evidence of copying. In *Gilliam*, the BBC licensed to ABC certain recorded performances of the British group of writers and performers known as “Monty Python,” and ABC subsequently broadcast unauthorized, edited versions of these recordings to which Monty Python objected.⁵⁹ Because the BBC agreement with Monty Python had reserved to the group the right to make any significant editorial changes, *Gilliam* held that ABC had exceeded the scope of the license that the BBC had the authority to give, thereby infringing the copyright by releasing an unauthorized copy.⁶⁰ Thus, this holding is consistent with the general trend of the courts during the pre-1976 Act era to find copyright infringement only when a defendant had copied the plaintiff’s works. In *Gilliam*, the infringement occurred as a result of having exceeded the scope of the license—that is, as a result of having impermissibly copied the work by broadcasting an unauthorized copy. It was not the alteration per se—but rather the broadcast of the alteration—that infringed the copyright.

Thus, prior to the 1976 Copyright Act, several controversies over noncopying alterations reached the courts. Those courts consistently

56. *Id.* at 223. The court did note, however, that “[o]ccasionally . . . momentary forgetfulness of their plan of camouflage or difficulty in accommodating it to their objective led them to incorporate in their manual a literal or indefensibly close approximation of what might be found in plaintiffs’ texts.” *Id.*

57. The court cited to several authorities for the proposition that copying need not be restricted to literal repetition, indicating, perhaps, that the court found the evidence of copying to be dispositive. *See id.* at 227. Rather than rest its decision expressly on copying, however, the court instead concluded, “It is clear that defendants’ parasitical excrescence upon plaintiffs’ distinguished and useful works profits defendants alone. In this symbiosis defendants thrive, while their manual kills the host it feeds upon. The Court sees nothing here warranting the exercise by it of an exigent astuteness to ferret out some legal justification for defendants’ overuse of plaintiffs’ copyrighted material.” *Id.* at 228.

58. 538 F.2d 14 (2d Cir. 1976).

59. *Id.* at 17–18.

60. *Id.* at 19–23.

rejected copyright infringement claims for unauthorized alterations absent some proof of copying.⁶¹

B. After the 1976 Copyright Act: Courts Inconsistently Decide Whether Noncopying Alterations Prepare Infringing Derivative Works

Since enactment of the 1976 Copyright Act, courts have inconsistently decided cases addressing noncopying alterations. Much of this confusion originates from the broadly defined derivative right, first enacted in the 1976 Act. As discussed previously in Part II, although copyright owners previously enjoyed the exclusive right to prepare certain kinds of derivative works, such as translations and dramatizations,⁶² the 1976 Act recognized for the first time a broad, umbrella derivative right, granting copyright owners the exclusive right “to prepare derivative works based upon the copyrighted work.”⁶³

What precisely is a “derivative work”? The Act defines a “derivative work” as “a work based upon one or more preexisting works” and includes a nonexhaustive list of examples.⁶⁴ In addition to listing familiar examples, such as translations and dramatizations, the Act also includes a broad, catchall phrase: “or any other form in which a work may be recast, transformed, or adapted.”⁶⁵ Thus, a derivative work appears to be any work that recasts, transforms, or adapts a preexisting work.

Courts and commentators have characterized this definition as “hopelessly overbroad”⁶⁶ and “expansive.”⁶⁷ On the one hand, the broad definition may be representative of the steadily increasing scope of copyright, described as follows by one prominent commentator: “Copyright, which once protected only against the production of substantially similar copies in the same medium as the copyrighted work, today protects against uses and media that often lie far afield from the

61. The lone exception, *National Geographic Society v. Classified Geographic*, was in direct contrast with the contemporaneous case of *Fawcett Publications v. Elliot Publishing Co.* See *supra* notes 42–45 and accompanying text.

62. See *supra* notes 18–22 and accompanying text. Previous acts did not refer to these works as “derivative works”; rather, it is a modern term, adopted in the 1976 Act.

63. 17 U.S.C. § 106(2) (2000).

64. For the full text of the definition, see text accompanying *infra* note 225.

65. *Id.*

66. *E.g.*, *Micro Star v. Formgen Inc.*, 154 F.3d 1107, 1110 (9th Cir. 1998).

67. *E.g.*, 2 PAUL GOLDSTEIN, COPYRIGHT § 5.3, at 5:81 (2d ed. Supp. 2002) (describing the Act’s definition of derivative works as being “in the most expansive terms”).

original.”⁶⁸ As shown below, however, courts and commentators have struggled to define the outer boundaries of the broadly defined derivative right. One unresolved question is whether mere alterations to copyrighted works infringe the derivative right, even absent any evidence of copying by the defendants. Arguably, an alteration may recast, transform, or adapt a preexisting work without copying that work. As discussed previously in Part III.A, however, prior to the 1976 Act courts generally did not find that copyright prohibited noncopying alterations. Since the 1976 Act, courts have inconsistently decided cases addressing noncopying alterations. In general, courts have not directly addressed whether the definition of derivative works includes noncopying alterations, which undoubtedly has contributed to the confusion.

After the 1976 Act, noncopying alterations have generally surfaced in one of two distinct, though related, scenarios. In the first scenario, defendants purchase copies of the plaintiffs’ copyrighted work, physically alter or modify the copies (without copying), and subsequently resell the very same copies they purchased. This Comment refers to these alterations as static (one-time) alterations because the alterations generally occur at one fixed point in time. For instance, a clothing company might alter copyrighted fabric by sewing it into garments.⁶⁹ In the second scenario, defendants sell add-on products that function in a complementary manner with the plaintiffs’ works to alter or modify (without copying) the respective work’s real-time playback or display. This Comment refers to these alterations as dynamic (real-time) alterations because the alterations are made on the fly, reoccurring during each playback or display of the copyrighted work. For instance, a video-editing company might alter copyrighted movies by selling filters that omit certain scenes and mute certain dialogue only during real-time playback of the home video.⁷⁰

As shown below, numerous plaintiffs have objected to any unauthorized alterations of their copyrighted works, whether in the form

68. Goldstein, *supra* note 11, at 209.

69. All static alterations to a given work, however, do not necessarily occur at the same time. Thus, a secondhand clothing dealer might further alter the same garments.

70. In a sense, a video filter is an unauthorized *use* of a copyrighted work, rather than an unauthorized *alteration*. Although it may be meaningful to describe “alterations” as unauthorized uses, this Comment employs the term “alter” to also include uses that result in alterations. This is primarily to avoid the misunderstood description of the doctrine of fair use, which is understood best as fair copying because the doctrine has no origin in noncopying uses. *See, e.g.*, Patterson, *supra* note 11, at 13–53.

of static or dynamic modification, regardless of whether the defendants actually copied their works. Significantly, the pace of litigation appears to be increasing, making the resolution of this issue timely and important. In the first ten years following enactment of the 1976 Act, there was only one case, *Midway Manufacturing Co. v. Artic International, Inc.*,⁷¹ in which a plaintiff alleged that a noncopying alteration infringed the derivative right. As demonstrated below, the number of cases addressing noncopying alterations has increased almost exponentially in the succeeding decades.

1. Static (one-time) alterations

As discussed previously in Part III.A, controversies over noncopying alterations prior to the enactment of the 1976 Act included the following static alterations: rebinding copyrighted print (for both restorative and nonrestorative purposes), manufacturing handbags from copyrighted fabrics, repainting hobbyhorses, and affixing designs removed from greeting cards and notepads to ceramic plaques. In each controversy, the defendants purchased copies of the respective plaintiff's works, altered the purchased copies, and then resold, or otherwise reused commercially, the altered copies. Following the 1976 Act, additional controversies arose over affixing copyrighted artworks to ceramic tiles, manufacturing baby bedding from copyrighted fabrics, and editing home video cassettes. Similar to their pre-1976 counterparts, the defendants in these more recent controversies purchased copies of the respective plaintiff's works, altered the purchased copies, and then resold the altered copies. In contrast to their pre-1976 counterparts, however, courts decided inconsistently whether these noncopying alterations infringed the respective plaintiff's copyrights.

In the post-1976 era, the most litigated example of static alteration arose from affixing prints of copyrighted artworks to ceramic tiles. A circuit split developed in the Seventh and Ninth Circuits over whether the creation of these ceramic tiles amounted to the preparation of infringing derivative works. In *Mirage Editions, Inc. v. Albuquerque A.R.T. Co.*,⁷² the defendant, without permission, purchased compilations of the plaintiff's copyrighted works, removed selected pages from the

71. 704 F.2d 1009 (7th Cir. 1983) (defendant manufactured replacement circuit boards to speed up plaintiff's arcade video game).

72. 856 F.2d 1341 (1988). For more regarding the issue of decompilation, see *infra* note 77.

books, mounted the removed pages onto ceramic tiles, and then offered the tiles for sale.⁷³ The Ninth Circuit concluded that the defendant art company made “another version” of the plaintiff’s works, and held that this other version was an infringing derivative work.⁷⁴ To arrive at its conclusion, the court explained, “The protection of derivative rights extends *beyond mere protection against unauthorized copying* to include the right to make other versions of, perform, or exhibit the work.”⁷⁵ From the context, it appears that the Ninth Circuit equated copying with reproduction, but the court never explained why making another version of, performing, or exhibiting a work are not forms of “unauthorized copying.” Two district courts in the Ninth Circuit have since followed the holding of *Mirage*; one district court found (and the Ninth Circuit affirmed) that affixing individual note cards to ceramic tiles created derivative works,⁷⁶ and another found that disassembling a copyrighted

73. *Id.* at 1342. The court explained the process in detail:

Since 1984, the primary business of appellant has consisted of: 1) purchasing artwork prints or books including good quality artwork page prints therein; 2) gluing each individual print or page print onto a rectangular sheet of black plastic material exposing a narrow black margin around the print; 3) gluing the black sheet with print onto a major surface of a rectangular white ceramic tile; 4) applying a transparent plastic film over the print, black sheet and ceramic tile surface; and 5) offering the tile with artwork mounted thereon for sale in the retail market.

Id.

74. *Id.* at 1343.

75. *Id.* (emphasis added) (citing *Lone Ranger Television v. Program Radio Corp.*, 740 F.2d 718, 722 (9th Cir. 1984); *Russell v. Price*, 612 F.2d 1123, 1128 n.16 (9th Cir. 1979)).

76. *Muñoz v. Albuquerque A.R.T. Co.*, 829 F. Supp. 309 (D. Alaska 1993), *aff’d*, 38 F.3d 1218 (9th Cir. 1994) (unpublished opinion). As in *Mirage*, the defendant art company in *Muñoz* (which was the same defendant in *Mirage*) had affixed plaintiff’s copyrighted works onto ceramic tile. See *id.* at 310–11. Unlike *Mirage*, however, the defendant did not disassemble plaintiff’s artwork; instead of mounting the separate pages from books, the defendant mounted individual copyrighted notecards. *Id.* Thus, *Muñoz* isolated for examination the process of mounting copyrighted artwork onto ceramic tile. For more regarding the issue of decompilation, see *infra* note 77.

In defense of its tile art business, the defendant argued that mounting notecards onto ceramic tiles is indistinguishable from framing a print or painting—both practices “amount[] to nothing more than a display of the artwork.” *Muñoz*, 829 F. Supp. at 314. The district court did not agree. Observing that the defendant “permanently affix[ed]” the notecards, the court concluded that the original artwork was indeed recast, transformed, or adapted. *Id.* The court distinguished framing because “[i]t is commonly understood that this [framing] amounts to only a method of display,” and that “it is a relatively simple matter to remove the print or painting and display it differently if the owner chooses to do so.” *Id.* In making one final distinction, the court noted that “tiles lend themselves to other uses such as trivets (individually) or wall coverings (collectively).” *Id.* The Ninth Circuit affirmed the decision of the district court in an unpublished opinion. *Muñoz*, 38 F.3d 1218.

work and separately framing the individual pages likewise created derivative works.⁷⁷

A split in the circuits developed when A.R.T. Co. (formerly Albuquerque A.R.T. Co. in *Mirage*) successfully defended the same practice of mounting note cards onto ceramic tiles that the Ninth Circuit previously rejected. In *Lee v. A.R.T. Co.*,⁷⁸ the Seventh Circuit expressly rejected the Ninth Circuit's distinction between tile-art mounting and traditional methods of framing.⁷⁹ Instead, it found that the copyrighted note cards were not transformed⁸⁰ by the tile art process because each

77. *Greenwich Workshop, Inc. v. Timber Creations, Inc.*, 932 F. Supp. 1210 (C.D. Cal. 1996). As in *Mirage*, the defendant art company (a different defendant from that in *Mirage*) disassembled plaintiff's books and resold the separate pages. *See id.* at 1211. Unlike *Mirage*, however, the defendant did not mount plaintiff's artwork onto ceramic tile; instead, the defendant matted and framed the individual bookplates. Thus, *Greenwich* isolated for examination the process of disassembling and reselling individual pages of a copyrighted work.

In defense of its business model, the defendant in *Greenwich* relied on the *Muñoz* opinion, which endorsed the practice of framing as a simple method of display that did not amount to preparing a derivative work. *Id.* at 1213. Although ruling that the defendant infringed "the plaintiff's copyrights in both the artwork and the book," the court appears to have based its finding exclusively on the defendant's removal of pages from the plaintiff's books. *Id.* at 1214–15. For a thoughtful discussion of the decompilation of collected works at issue in *Mirage* and *Greenwich*, which this Comment does not address, see Steve Lauff, Note, *Decompilation of Collective Works: When the First Sale Doctrine Is a Mirage*, 76 TEX. L. REV. 869, 889 (1998).

78. 125 F.3d 580 (7th Cir. 1997). *Lee* endorses the exact mounting process that the Ninth Circuit found infringing in *Muñoz v. Albuquerque A.R.T. Co.*, 38 F.3d 1218 (9th Cir. 1994) (unpublished opinion), *aff'g*, 829 F. Supp. 309 (D. Alaska 1993). For more on *Muñoz*, see *supra* note 76. *Lee* directly addresses the process of mounting copyrighted works onto ceramic tile, avoiding the decompilation issue present in *Mirage*.

79. *Lee*, 125 F.3d at 581 (agreeing with the district court that this is "a distinction without a difference").

If changing the way in which a work of art will be displayed creates a derivative work . . . then the derivative work is "prepared" when the art is mounted; what happens later [that is, permanent affixation] is not relevant, because the violation of the § 106(2) right has already occurred. If the framing process does not create a derivative work, then mounting art on a tile, which serves as a flush frame, does not create a derivative work. What is more, the ninth circuit erred in assuming that normal means of mounting and displaying are easily reversible. A painting is placed in a wooden "stretcher" as part of the framing process; this leads to some punctures (commonly tacks or staples), may entail trimming the edges of the canvas, and may affect the surface of the painting as well. . . . As a prelude to framing, photographs, prints, and posters may be mounted on stiff boards using wax sheets, but sometimes glue or another more durable substance is employed to create the bond.

Id.

80. *Id.* at 582. The Seventh Circuit concluded that tile art did not fit any of the enumerated categories of derivative works defined in § 101, and proceeded to examine whether the mounting process recast, transformed, or adapted the copyrighted notecards. Concluding, without elaboration,

piece of artwork “depict[ed] exactly what it depicted when it left [the] studio.”⁸¹ The court opined that if the plaintiff’s interpretation of the derivative right were followed, then “any alteration of a work, however slight, [would] require[] the author’s permission.”⁸²

In addition to the tile-art cases, courts have also addressed static alterations to copyrighted fabrics and videocassette tapes. Addressing alterations to copyrighted fabrics, a district court, in *Precious Moments, Inc. v. La Infantil, Inc.*,⁸³ held that baby bedding manufactured with the plaintiff’s copyrighted fabrics were not derivative works. In a similar fashion to the Seventh Circuit in *Lee*, the court opined that *Mirage* and its progeny erroneously “open the door for the most trivial of modifications to generate an infringing derivative work.”⁸⁴ In *Paramount Pictures Corp. v. Video Broadcast Systems, Inc.*,⁸⁵ a district court found that the defendant’s appendage of commercial advertisements to the plaintiff’s videocassettes did not create derivative works of its copyrighted motion pictures. Finding *Mirage* inapplicable (without disagreeing with the merits), the district court concluded simply, “The court does not recognize the addition of [defendants’ advertisement] to a videocassette in any way recasting, transforming or adapting the motion picture.”⁸⁶ Perhaps in reference to the holding in *Mirage*, the court added, “The result is not a new version of the motion picture.”⁸⁷

that mounting artwork onto tile does not recast or adapt the notecards, the court acknowledged that the process might come closer to transforming the works, but ultimately concluded the question in the negative: “The art was bonded to a slab of ceramic, but it was not changed in the process. It still depicts exactly what it depicted when it left [the] studio.” *Id.*

81. *Id.*

82. *Id.*

83. 971 F. Supp. 66 (D.P.R. 1997).

84. *Id.* at 69. Although the Seventh Circuit had not yet decided *Lee*, the district court in *Precious Moments* contrasted the district court opinion in *Lee*, see *supra* notes 78–82, with the decisions in both *Mirage*, see *supra* note 72, and *Muñoz*, see *supra* note 76, and agreed with the district court opinion in *Lee*. *Id.* at 68–69.

85. 724 F. Supp. 808 (D. Kan. 1989).

86. *Id.* at 821. The court also found inapplicable *Midway Manufacturing Co. v. Artic International, Inc.*, 704 F.2d 1009 (7th Cir. 1983). In prior reference to *Mirage* and *Artic*, the court noted, “In both cases, the derivative work transformed, adapted or recast the original work into a new and different one.” *Paramount*, 724 F. Supp. at 821. For more on *Artic*, see *infra* notes 90–95.

87. *Paramount*, 724 F. Supp. at 821.

2. *Dynamic (real-time) alterations*

During the pre-1976 era, most controversies over noncopying alterations arose from static (one-time) alterations to copies of protected works. Dynamic (real-time) alterations arose during the post-1976 era.⁸⁸ Most of these controversies surfaced in digital media, such as video games, website advertising, and digital home videos. In each of these controversies, defendants, without the permission of the plaintiff, made products that added onto, plugged into, or otherwise complemented the respective plaintiff's copyrighted works. These products altered the real-time appearance of the plaintiff's work for a temporary period. Similar to their counterparts deciding static alterations, courts deciding controversies addressing dynamic alterations have inconsistently decided whether these noncopying alterations infringe the respective plaintiff's copyrights. Again, courts have disagreed over the relative breadth of the derivative right. Because some of the cases presented below refer to the cases decided before them, they are presented chronologically.

Among the dynamic-alteration cases, video-game components have provided the most prevalent source for litigation. A video-arcade enhancement kit was the first instance of a noncopying alteration to be found an infringing derivative work under the 1976 Act. After several courts had decided instances of video-arcade-game copying,⁸⁹ *Midway Manufacturing Co. v. Artic International, Inc.*⁹⁰ addressed enhancement kits that merely altered, rather than copied, the plaintiff's arcade games. *Midway* held the defendant manufacturers liable under a theory of

88. *But see* Addison-Wesley Publishing Co. v. Brown, 223 F. Supp. 219 (E.D.N.Y. 1963). In a sense, the unauthorized solution book was a temporary, real-time alteration to the plaintiffs' physics textbook. Much like the video-game cases discussed below, the solution book complemented, plugged into, and added onto the original textbook. Moreover, the solution book altered the manner in which consumers used the textbook—consumers used the solutions to help answer (reverse engineer) the otherwise unaided problem sets in the textbook—and it was precisely this unauthorized change in use to which the copyright owner objected, fearing that it would make the textbook less marketable to professors. For more on *Addison-Wesley*, see *supra* notes 54–57.

89. *See, e.g.*, Stern Electronics, Inc. v. Kaufman, 669 F.2d 852, 855 (2d Cir. 1982) (finding infringement because the defendant's video game was "virtually identical in both sight and sound" to the plaintiff's game); Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp., 672 F.2d 607, 619–20 (7th Cir. 1982) (finding infringement because the defendant's "K. C. Munchkin" video game copied the "total concept and feel" of the plaintiff's "PAC-MAN" video game); Midway Mfg. Co. v. Strohon, 564 F. Supp. 741 (N.D. Ill. 1983) (finding infringement because of evidence that the replacement circuit boards in the defendant's enhancement kit were copies of the original circuit boards for plaintiff's "PAC-MAN" video game).

90. 704 F.2d 1009 (7th Cir. 1983).

contributory infringement.⁹¹ Because some of the replacement kits only interacted with the plaintiff's arcade game⁹²—temporarily altering the real-time game speed⁹³—*Artic* found that a derivative work was created by a noncopying, add-on component that altered an audiovisual work only during real-time.⁹⁴ *Artic*'s novel holding⁹⁵ has been unwieldy, as the following discussion demonstrates.

Artic even influenced courts confronted squarely with evidence of copying, persuading some to rest their holdings on broad alteration grounds, rather than evidence of copying. In 1986, two federal district courts relied on the Seventh Circuit's decision in *Artic* to hold that the defendants infringed the respective plaintiffs' copyrights by

91. The arcade owners who installed the enhancement kits were the direct infringers. *Id.* at 1013 (“If, as we hold, the speeded-up ‘Galaxian’ game that a licensee creates with a circuit board supplied by the defendant is a derivative work based upon ‘Galaxian,’ a licensee who lacks the plaintiff’s authorization to create a derivative work is a direct infringer and the defendant is a contributory infringer through its sale of the speeded-up circuit board.”).

92. The enhancement kit included replacement circuit boards that operated in the plaintiff’s arcade game. There were actually two different circuit boards, however, at issue in *Artic*. In addition to the circuit board that speeded-up plaintiff’s “Galaxian” game, the defendant also manufactured and sold circuit boards that stored “a set of images and sounds almost identical to that stored in the circuit boards of plaintiff’s ‘PAC-MAN’ video game machine.” *Id.* at 1010–11. In contrast, the “Galaxian” replacement boards did not copy any of the elements of the plaintiff’s game—neither the underlying program code nor the audiovisual displays of “Galaxian” were stored in the defendant’s circuit boards. The “Galaxian” circuit boards merely *interacted* with the copyrighted work. *Id.* at 1010, 1013–14. Subsequent courts interpreting *Artic* have mistakenly concluded that all of the defendant’s circuit boards copied from the plaintiff’s boards. *See infra* notes 113–114.

93. Although the replacement boards are physically attached to the arcade game—suggesting that the alteration may be a static alteration, rather than a dynamic one—the configuration of game components is not the copyrighted work, but rather the audiovisual display. Because the audiovisual display of the game has not been permanently altered, the replacement boards are properly considered as dynamic alterations.

94. Although acknowledging that “[a] speeded-up phonograph record is probably not” an infringing derivative work, *Artic*, 704 F.2d at 1014 (citing, as cross-reference, *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 73 F. Supp. 165, 167 (S.D.N.Y. 1947) (“The change in time of the added chorus, and the slight variation in the base of the accompaniment, there being no change in tune lyrics, would not be ‘new work.’”)), the court searched for a reason to hold speeded-up video games to be infringing derivative works, resting its decision on the observation that there is no market for speeded-up records in contrast to the market for speeded-up video games. *Id.* at 1013–14.

95. Although the copied “PAC-MAN” circuit boards in *Artic*, *see supra* note 92, could have been decided on previous precedent, *see supra* note 89, the “Galaxian” circuit boards presented a case of first impression—addressing whether third-party components that alter, without copying, a plaintiff’s audiovisual displays create derivative works of those displays. *Artic* was a case of first impression even though *Strohon*, 564 F. Supp. 741, also addressed an enhancement kit to speed up game play. In *Strohon*, the replacement components were substantially similar to the original “PAC-MAN” circuit boards, supporting the inference that the defendant copied the plaintiff’s work. *Id.* at 752–53.

manufacturing alternative cassette tapes that animated the then-popular Teddy Ruxpin talking-bear toy.⁹⁶ Although neither case addressed a strictly noncopying alteration,⁹⁷ the courts decided them as if they did. Citing *Artic*, the courts ruled on infringement claims in such a way that made the defendants' copying practically irrelevant. In *Worlds of Wonder, Inc. v. Veritel Learning Systems, Inc.*,⁹⁸ the district court found the case "analogous" to *Artic*.⁹⁹

In this case, the Veritel cassette inserted into Teddy Ruxpin creates a substantially similar audiovisual work which is *altered* in much the same as a Galaxian game is *altered* by a speed up kit. Thus, the *modification* of the copyrighted Teddy Ruxpin toy also falls within the definition of derivative works.¹⁰⁰

Thus, although *Veritel* might have rested its decision on evidence that the defendant had *copied* the plaintiff's works in order to make its own tapes,¹⁰¹ it instead relied on the fact that the defendant's tapes had *altered* the plaintiff's works. Significantly, *Veritel* did not consider whether independently created tapes—that is, tapes that operated in the Teddy Ruxpin toy but that did not mimic the stories, voice, or set of movements from the plaintiff's tapes—would have infringed the derivative right. *Worlds of Wonder, Inc. v. Vector Intercontinental, Inc.*,¹⁰² a companion case in another district, however, did. *Vector*

96. *Worlds of Wonder, Inc. v. Veritel Learning Sys., Inc.*, 658 F. Supp. 351 (N.D. Tex. 1986); *Worlds of Wonder, Inc. v. Vector Intercontinental, Inc.*, 653 F. Supp. 135 (N.D. Ohio 1986). The tapes at issue consist of two tracks: "The first track, the audio track, contains songs and stories; the second track, the command track, contains digital information that activates the eyes, nose and mouth." *Vector*, 653 F. Supp. at 137; *see also Veritel*, 658 F. Supp. at 352. Together, these two tracks animate the Teddy Ruxpin bear "in a life-like fashion as it plays songs and stories." *Vector*, 653 F. Supp. at 137.

97. *See infra* notes 101–102.

98. 658 F. Supp. 351 (N.D. Tex. 1986).

99. *Id.* at 355.

100. *Id.* at 356 (emphasis added).

101. There was ample evidence of copying. Although the court noticed "some differences in the voices on the tapes" and "some difference in the story line," it nonetheless concluded that "[t]he voice and animation of the tapes are similar," and that "[t]he total concept and feel of the works is substantially similar." *Id.* at 355. Furthermore, the court observed that the person responsible for programming the defendant's tapes used the plaintiff's work and that the actor who provided the voice for the defendant's tapes listened to the plaintiff's tapes. *Id.* at 356.

102. 653 F. Supp. 135 (N.D. Ohio 1986). In *Vector*, there was also evidence of copying. Although the tapes in *Vector* only related public-domain fairy tales, rather than stories set in the World of Teddy Ruxpin, *id.* at 137, the court noted substantial evidence that the defendant had nonetheless copied the voice of the narrator, the method and sound for signaling the end of a page,

suggested that even noncopied tapes would infringe the derivative right because the copyright of the animated bear extends to *every* configuration of the toy.¹⁰³ Thus, although both cases addressed copying alterations, the courts rested their holdings on noncopying grounds. In so doing, they impliedly endorsed *Artic*'s holding that noncopying alterations are infringing derivative works, even if the facts did not properly present such a case.

Some courts, however, declined to extend *Artic* beyond its holding. Two years following the *Worlds of Wonder* cases, the Fifth Circuit, in *Vault Corp. v. Quaid Software Ltd.*,¹⁰⁴ declined to extend *Artic*, holding that the defendant's digital key was not a derivative work of the plaintiff's disk-protection device, even though the key effectively circumvented the protection of the plaintiff's device.¹⁰⁵ The plaintiff cited *Artic*, in the words of the court, "for the proposition that a product

and the visual impression of the eyes, nose, and mouth movement of the bear, *id.* at 139–40. Furthermore, the court observed that the defendant had the plaintiff's tape analyzed "to determine how it could be duplicated." *Id.* at 138. In conclusion, the court observed that "the general feel and concept" of the defendant's tapes were the same, and held the tapes were "[a]t least" derivative works, even "if not an exact copy." *Id.* at 140.

103. *Id.* The court observed,

[The plaintiffs] further argue that the copyright of Teddy Ruxpin as an audiovisual work is limited to a specific series of images. They reason that their tapes create a series of images different from those created by the [defendant's] tapes. Therefore, they conclude that they do not infringe.

Their position is neither practical nor credible as it would require a separate copyright for each possible series of images. The language of the copyright is certainly broad enough to include *all movements* which may be created by the animated bear.

Id. (discussing *Midway Mfg. Co. v. Artic Int'l, Inc.*, 704 F.2d 1009 (7th Cir. 1983)).

104. 847 F.2d 255 (5th Cir. 1988).

105. *Id.* As in *Artic*, *see supra* note 92, both copying and noncopying products were accused of being derivative works in *Vault*. *See Vault*, 847 F.2d at 257–58. In *Vault*, the plaintiff produced protective diskettes designed to prevent unauthorized duplication of programs distributed by software companies. *Id.* at 256–57. The protective diskettes consisted of a "fingerprint" and a verification program that prevented execution of the diskette contents unless the program identified the diskette by the "fingerprint." *Id.* The defendant produced diskettes that circumvented the plaintiff's protective mechanism. *Id.* at 257–58. The defendant's diskettes operated even with software copied from the plaintiff's protected diskettes. *Id.* The defendant's diskettes contained a digital key that interacted with the plaintiff's verification program—copied onto the defendant's diskettes along with the target software—to make it appear that the defendant's diskette contained the "fingerprint." *Id.* One of the early versions of the defendant's digital keys contained copied characters found in the plaintiff's verification program. *Id.* A later version, however, contained no copied characters. *Id.* at 258. Thus, *Vault* addressed both copying and noncopying alterations. With regard to the key containing copied elements, the Fifth Circuit held that the copied characters were insufficient to create a derivative work, finding that the digital key with the copied characters was not substantially similar to the plaintiff's verification program. *Id.* at 268.

can be a derivative work where it *alters*, rather than *copies*, the copyrighted work.”¹⁰⁶ The Fifth Circuit, however, declined to opine on the merits of that proposition, deciding instead to distinguish *Artic* on the basis that it did not hold the replacement circuit boards to be derivative works, but rather the altered audiovisual displays caused by the replacement boards. Because the plaintiff in *Vault* alleged that the digital key itself was a derivative work, the court concluded that *Artic* was inapplicable.¹⁰⁷

Several years later, *Lewis Galoob Toys, Inc. v. Nintendo of America, Inc.*¹⁰⁸ substantially limited the holding of *Artic* by holding that a different video-game component did not prepare derivative works. In *Lewis Galoob Toys*, the Ninth Circuit rejected Nintendo’s claim that an enhancement component (the “Game Genie”) created derivative works of its copyrighted video games. Similar to the “Galaxian” circuit boards at issue in *Artic*, the Game Genie in *Lewis Galoob Toys* altered the play of the plaintiff’s copyrighted game.¹⁰⁹ But unlike the “Galaxian” circuit boards, the Game Genie was not a replacement part—it attached independently to Nintendo’s game system.¹¹⁰ The Ninth Circuit found this fact dispositive in distinguishing *Artic*,¹¹¹ even though both

106. *Vault*, 847 F.2d at 268 (emphasis added).

107. *Id.* *Vault*’s reading of *Artic* is problematic. First, *Vault* concluded that *Artic* did not hold the replacement boards to be derivative works because *Artic* held that the sale of the replacement boards constituted contributory infringement, presuming apparently that only the altered audiovisual displays, not the altered component system, were derivative works. *Artic*, however, held that the *arcade owners* who installed the kits directly infringed, implying perhaps that the installation might have created the derivative work. See *supra* note 91 and accompanying text. It is unclear whether *Artic* held infringing the installation or the execution of the enhancement kits. Second, if *Vault* is correct that *Artic* did not hold the altered component system to be infringing, then *Artic* must hold that any alteration to an audiovisual display creates a derivative work.

108. 964 F.2d 965 (9th Cir. 1992).

109. *Id.* at 967 (“The Game Genie is a device . . . that allows the player to alter up to three features of a Nintendo game. For example, the Game Genie can increase the number of lives of the player’s character, increase the speed at which the character moves, and allow the character to float above obstacles.”).

110. Compare *id.* (“The Game Genie is *inserted between* a game cartridge and the Nintendo Entertainment System. The Game Genie does not alter the data that is stored in the game cartridge. Its effects are temporary.” (emphasis added)), with *Midway Mfg. Co. v. Artic Int’l, Inc.*, 704 F.2d 1009, 1010 (7th Cir. 1983) (“Defendant sells printed circuit boards for use inside video game machines. One of the circuit boards defendant sells speeds up the rate of play—how fast the sounds and images change—of ‘Galaxian,’ one of plaintiff’s video games, when *inserted in place* of one of the ‘Galaxian’ machine’s circuit boards.” (emphasis added)).

111. *Lewis Galoob Toys*, 964 F.2d at 969. Interestingly, the court paid no special attention to the fact that the “Galaxian” circuit boards and the Game Genie had the same practical effect—they

enhancement kits had the same effect—speeding up game play.¹¹² The court also appears to have distinguished *Artic* on the basis that the replacement “Galaxian” boards *copied* the plaintiff’s original boards.¹¹³ It is unclear, however, how the Ninth Circuit concluded that the defendant’s “Galaxian” replacement boards copied the plaintiff’s original boards, when *Artic* suggests the exact opposite.¹¹⁴ The court also distinguished *Mirage*, concluding that, although the ceramic tiles physically incorporated the copyrighted works, the Game Genie did not.¹¹⁵

In *Micro Star v. Formgen Inc.*,¹¹⁶ the Ninth Circuit addressed yet another video-game component and found, in this case, that the component infringed the derivative right. Like previous cases, the plaintiff, Formgen Inc., alleged infringement for the unauthorized distribution of add-on components that modified the plaintiff’s video games; unlike previous video-game cases, however, the plaintiff actually supplied the users with the means to create the allegedly infringing components. Formgen’s video game, “Duke Nukem 3D,” included a “Build Editor,” which allowed game users to develop their own player levels. Formgen also encouraged users to post their game levels on the

both speeded up the play of their respective host machines. The court did not indicate whether the fact that the “Galaxian” circuit boards could only be used to speed up a single game, whereas the Game Genie could speed up any Nintendo game played on the system, was relevant. (It likely was not because both components worked with only one machine—it seems likely that the same or similar circuit board might work in an arcade machine capable of playing multiple games.)

112. In addition, the Game Genie made other alterations. *See supra* note 109.

113. *Lewis Galoob Toys*, 964 F.2d at 969 (“The defendant in *Midway*, Artic International, marketed a computer chip that could be inserted in Galaxian video games to speed up the rate of play. The Seventh Circuit held that the speeded-up version of Galaxian was a derivative work. Artic’s chip substantially copied . . . the chip that was originally distributed by Midway.” (citation omitted)).

114. In fact, it appears that the “Galaxian” boards did not copy. *See supra* note 92. It is unclear from the opinion in *Lewis Galoob Toys* whether the court confused the two sets of circuit boards in *Artic* or whether the court inferred copying of the “Galaxian” boards based on the admitted copying of the “PAC-MAN” boards.

115. The court observed,

The Game Genie merely enhances the audiovisual displays (or underlying data bytes) that originate in Nintendo game cartridges. The altered displays do not incorporate a portion of a copyrighted work in some concrete or permanent *form*. . . . [In contrast, t]he ceramic tiles [in *Mirage*] physically incorporated the copyrighted works in a form that could be sold.

Lewis Galoob Toys, 964 F.2d at 968.

116. 154 F.3d 1107 (9th Cir. 1998) (defendant distributed user-generated game levels for plaintiff’s video game).

Internet for shared use by other users. When the defendant, Micro Star, downloaded 300 user-created levels and sold them on a CD, Formgen alleged infringement of the derivative right.¹¹⁷ Although Micro Star arguably only copied the efforts of the game's users, the court analogized the game levels to motion picture sequels and held them to be derivative works of the "Duke Nukem 3D" story itself.¹¹⁸

Although other noncopying-alteration controversies have divided courts, there appears to be a general consensus, at least among several federal district courts, that website-advertising technologies do not prepare derivative works. Litigation over website advertising has surfaced in two different contexts—framing (inline linking) and pop-up dialogue boxes. In the late 1990s, several plaintiffs alleged infringement after the respective defendant's website "framed" the respective plaintiff's site.¹¹⁹ Websites that frame other sites contain inline links in their own (host) sites that direct the user's browser to display content from the target (or framed) site within the *frame* of the host (or framing) site.¹²⁰ Frames might include a name or logo,¹²¹ links to other websites (or other selectable options related either to the host's or the target's business),¹²² and advertisements.¹²³ Some frames mask or otherwise partially obscure the target site, potentially modifying the appearance of the content or advertising of the target site.¹²⁴ The frame may even replace the target site's content or advertising with its own¹²⁵—

117. *Id.* at 1109.

118. *Id.* at 1112.

119. *N.Y. Soc'y of Certified Pub. Accountants v. Eric Louis Assocs.*, 79 F. Supp. 2d 331 (S.D.N.Y. 1999) (defendant's website framed plaintiff's website); *Futuredontics Inc. v. Applied Anagramics Inc.*, No. CV 97-6991, 1998 WL 132922, 45 U.S.P.Q. 2d 2005 (C.D. Cal. Jan. 30, 1998) (same); *Complaint, Washington Post Co. v. TotalNews, Inc.*, No. 97 Civ. 1190, 1997 WL 33733041 (S.D.N.Y. filed Feb. 20, 1997) (same).

120. For further descriptions of framing, see, for example, Maureen A. O'Rourke, *Fencing Cyberspace: Drawing Borders in a Virtual World*, 82 MINN. L. REV. 609, 637–39 (1998); Aaron Rubin, Comment, *Are You Experienced? The Copyright Implications of Web Site Modification Technology*, 89 CAL. L. REV. 817, 821 (2001).

121. *E.g.*, *N.Y. Soc'y*, 79 F. Supp. 2d at 339; *Futuredontics*, 45 U.S.P.Q. 2d at 2008; *TotalNews*, No. 97 Civ. 1190, para. 30.

122. *E.g.*, *N.Y. Soc'y*, 79 F. Supp. 2d at 339; *Futuredontics*, 45 U.S.P.Q. 2d at 2008.

123. *E.g.*, *N.Y. Soc'y*, 79 F. Supp. 2d at 339; *TotalNews*, No. 97 Civ. 1190, para. 30.

124. *E.g.*, *TotalNews*, No. 97 Civ. 1190, paras. 33, 36 ("Plaintiff Washington Post's own content, which is designed to occupy the entire screen, is partially obscured in order to fit inside Defendants' frame.")

125. *E.g.*, *id.* para. 36 ("Defendants also distort, and divert from, the content of Plaintiffs' sites that otherwise would be the only substantive material appearing on a user's screen. Among other

prompting some to refer to these as “parasitic website[s]”¹²⁶ (or “parasites”¹²⁷ for short).

Unfortunately, none of the courts that have entertained these complaints have reached a decision on the merits of the copyright claims,¹²⁸ so whether framing prepares infringing derivative works is an unanswered question before the courts. Legal commentators, however, have not hesitated to offer their opinions.¹²⁹ Although some parties and commentators appear to characterize the host (or framing) sites as *reproducing* the target (or framed) site,¹³⁰ careful analysis of the inline

things, by juxtaposing advertising sold by Defendants against advertising sold by Plaintiffs on their own sites, and by obscuring the advertising on Plaintiffs’ sites, Defendants directly compete against Plaintiffs and interfere with Plaintiffs’ contractual relationships with advertisers.”).

126. *E.g.*, *id.* paras. 1, 8.

127. *E.g.*, Rubin, *supra* note 120, at 821.

128. *N.Y. Soc’y*, 79 F. Supp. 2d at 343 (court declined to decide issue of copyright); *Futuredontics*, 45 U.S.P.Q. 2d 2005 (parties settled after court denied defendants’ motion to dismiss); *TotalNews, Inc.*, No. 97 Civ. 1190 (parties settled). Only in *Futuredontics* did the court consider the arguments for alleged infringement of the derivative right. In ruling on the defendants’ motion to dismiss, the court decided only “that the cases cited by the parties do not conclusively determine whether Defendants’ frame page constitutes a derivative work,” and subsequently denied the defendants’ motion. *Futuredontics*, 45 U.S.P.Q. 2d at 2010. The court considered both *Mirage* and *Lewis Galoob Toys*, but concluded that both cases were distinguishable from framing. *Id.*

129. Commentators have compared framing to both the tile art at issue in *Mirage* and *Lee*, as well as to the Game Genie at issue in *Lewis Galoob Toys*. Given the differences in both the facts and the legal conclusions reached in these cases, it is not surprising that the commentators disagree over whether or not framing sites recast, transform, or adapt the framed sites. Compare *e.g.*, O’Rourke, *supra* note 120, at 666 (1998) (“[Framing] is more a method of display than a *transformation* of the framed work.” (emphasis added)), with Gregory C. Lisby, *Web Site Framing: Copyright Infringement Through the Creation of an Unauthorized Derivative Work*, 6 COMM. L. & POL’Y. 541, 555 (“[Framing] alters the framed Web sites, modifies it, re-packages it in a way its author did not intend, and *transforms* it into something else entirely, altering the author’s copyrighted work by integrating it into something else the author did not create nor authorize.” (emphasis added)).

Internet framing, and linking in general, implicates a host of intellectual property issues beyond just the derivative right, including trademark infringement and dilution, passing off, false advertising, copyright infringement (of the reproduction and display rights, as well as the derivative right), misappropriation, and unfair competition. For a comprehensive analysis of the various issues, see, for example, O’Rourke, *supra*; Mark Sableman, *Link Law Revisited: Internet Linking at Five Years*, 16 BERKELEY TECH. L.J. 1273 (2001).

130. See, *e.g.*, *Futuredontics*, 45 U.S.P.Q. 2d at 2010 (“Plaintiff’s complaint, however, alleges that defendants *reproduce* its copyrighted web page by combining AAI [defendant] material and Plaintiff’s web site.” (emphasis added)); *TotalNews*, No. 97 Civ. 1190, para. 8 (“Defendants have designed a parasitic website that *republishes* the news and editorial content of others’ websites in order to attract both advertisers and users.” (emphasis added)); Raymond Chan, *Internet Framing: Complement or Hijack?*, 5 MICH. TELECOMM. & TECH. L. REV. 143, 170 (1999) (“TotalNews’ framing resulted in a *literal copying* of Time’s [plaintiff’s] copyrighted work.” (emphasis added)); Sableman, *supra* note 129, at 1297 (2001) (“[Framing] is a little bit like painting a picture of a

linking at issue demonstrates that host sites merely direct the user's browser to display the target site within the host site; thus, the frames *alter* or *modify* the real-time appearance of the framed sites, but they do not *reproduce* them.¹³¹ Whether framing will be determined to infringe the derivative right is an important question because of the scope of Internet technologies that may utilize it in one way or another.¹³²

gallery at the Louvre, by simply importing onto your canvas the Louvre's own digital *reproductions* of those drawings." (emphasis added)). It is difficult to determine whether Chan intends to suggest that host sites *reproduce* the target site. "Time's [the plaintiff's] copyrighted material was mounted within an electronic visual frame designed by TotalNews. However, TotalNews did *not directly republish* Time's copyrighted material. . . . Thus, the issue is whether TotalNews' *on-line republication* of Time's copyrighted material constituted direct derivative work infringement." Chan, *supra*, at 167 (emphasis added). It is likewise unclear whether Sableman suggests that framing *reproduces* the target sites. Sableman, *supra* note 129, at 1297–1301. Notwithstanding the parties and commentators that appear to suggest that framing sites *literally copy* or otherwise *reproduce* the framed site, commentators careful to examine the precise technical details of framing, conclude otherwise. *See infra* note 131.

131. Rubin's student comment provides an excellent technical description of framing. "[N]one of the [website modification] technologies under consideration reproduce the HTML code of the underlying Web pages." Rubin, *supra* note 120, at 830. Instead framing websites point the user's browser to the targeted location and cause the target website to be displayed in the user's browser surrounded, and potentially visually modified, by the framing site. *Id.* at 830–31. Thus, "[f]or framing and in-line links in general, then, the copying into RAM of a Web page's HTML code and the displaying of its images occurs only on the end user's computer and not on the framing site's server." *Id.* at 831. Significantly, "the copying and displaying that take place on an end user's computer is exactly the same kind of copying and displaying that take place any time a user accesses a Web page." *Id.* Properly understood, the controversy surrounding framing does not involve the reproduction of the target website, but rather the real-time modification to the target site that the framing page causes to appear in the user's browser. Thus, there is no multiplying or copying of the framed pages.

Similarly, other commentators conclude that framing sites do not reproduce the framed sites. Another student comment concludes: "Web page designers, therefore, do not actually have to *reproduce* any of the 'outside' web site to create a web page that utilizes frames. They must simply create a hyperlink to the other web site." Michael A. Stoker, Comment, *Framed Web Pages: Framing the Derivative Works Doctrine on the World Wide Web*, 67 U. CIN. L. REV. 1301, 1307 (1999) (emphasis added). Stoker analyzed the differences between static and nonstatic frames and even provided some example HTML code to explain his conclusion. *Id.* at 1306–07. Although at one point O'Rourke's article might suggest reproduction, O'Rourke, *supra* note 120, at 633 ("A site that utilizes framing has the ability to *bring up* the entire contents or portions of one of more other sites that are 'framed' within the linking site." (emphasis added)), the article later makes clear that it is the user's browser, not the framing website, that reproduces the framed webpage, *id.* ("The user's machine sends a request for the document to be linked to the document owner's server, which makes a copy and sends it back to the user's machine."). The significant question, then, is whether modifying the user's authorized reproduction of the framed site prepares a derivative work.

132. For an insightful study of Internet technologies that modify or alter target websites (through either framing or other means), including comparison-shopping, commentary, ad-stripping, and customization applications, see Rubin, *supra* note 120, at 819 (concluding that "employing

More recently, litigation over website advertising has focused on the use of pop-up windows, which have been consistently found not to infringe the derivative right. District courts across the country have entertained complaints (alleging, *inter alia*, infringement of the derivative right) against two advertising network operators, WhenU.com (“WhenU”) and the Gator Corporation¹³³ (“Gator”).¹³⁴ WhenU and Gator “bundle” ad-ware programs with certain applications freely available for downloading (such as a weather forecasting desktop display).¹³⁵ Once installed, the ad-ware program causes site-specific,¹³⁶ third-party¹³⁷ advertisements to appear whenever the user browses a targeted website.¹³⁸ The owners of these sites might object to these pop-up advertisements for many reasons. For instance, pop-up ads may interfere with the visitors’ use of the targeted site,¹³⁹ may confuse

technologies that modify how a user experiences a Web page does not typically infringe a Web site owner’s exclusive rights under copyright law”). Rubin explains, in detail, each implicated technology. *Id.* at 820–26.

133. The Gator Corporation has apparently changed its name to Claria Corporation. *See* <http://www.gator.com>.

134. *E.g.*, *1-800 Contacts, Inc. v. WhenU.com*, 309 F. Supp. 2d 467 (S.D.N.Y. 2003) (defendant’s software triggered pop-up advertisements to appear when users browsed plaintiff’s website), *rev’d on other grounds*, 414 F.3d 400 (2d Cir. 2005); *Wells Fargo & Co. v. WhenU.com, Inc.*, 293 F. Supp. 2d 734 (E.D. Mich. 2003) (same); *U-Haul Int’l, Inc. v. WhenU.com, Inc.*, 279 F. Supp. 2d 723 (E.D. Va. 2003) (same); *Washingtonpost.Newsweek Interactive Co. v. Gator Corp.*, 2002 WL 31356645 (E.D. Va. July 16, 2002) (same).

For a detailed account of the factual background in these cases, see Jill E.C. Yung, Comment, *Virtual Spaces Formed by Literary Works: Should Copyright or Property Rights (or Neither) Protect the Functional Integrity and Display of a Web Site?*, 99 NW. U. L. REV. 495 (2004).

135. Yung, *supra* note 134, at 499.

136. *See, e.g.*, *Wells Fargo*, 293 F. Supp. 2d at 738 (“WhenU’s participating consumers receive contextually relevant advertisements, delivered to their computer screens These advertisements are selected by SaveNow [ad-ware program], based on a proprietary analysis of the consumer’s immediate interests, as reflected by the consumer’s Internet browsing activity.”).

137. *See, e.g.*, *U-Haul*, 279 F. Supp. 2d at 726 (“To maintain its business, WhenU sells advertising space and opportunities to merchants that want to take advantage of the SaveNow [ad-ware].”).

138. *See, e.g.*, *1-800 Contacts*, 309 F. Supp. 2d at 499–500. Gator apparently warns users that, in exchange for the free application, the bundled ad-ware will cause “‘occasional’ pop-up advertisements based on their online browsing behavior.” *Id.* at 500. In contrast, WhenU “buries the consequences of downloading products bundled” with its ad-ware. *Id.* at 501.

139. *See, e.g.*, *id.* at 479 (“Plaintiff argues the ‘pop-up advertisements also interfere with and disrupt the carefully designed display of content’ on Plaintiff’s copyrighted website.”).

visitors as to the true source of the advertisements,¹⁴⁰ and/or may discourage visitors of the targeted sites from returning.¹⁴¹ Plaintiffs have alleged, *inter alia*, that the ad-ware programs prepare derivative works because the pop-up advertisements modify the appearance and presentation of the plaintiffs' websites (on the screen of the ad-ware user).¹⁴²

To date, no district court has held that these ad-ware programs prepare derivative works.¹⁴³ These courts have relied on either *Lee* or *Lewis Galoob Toys* to reach essentially the same conclusion that pop-up ads do not recast, transform, or adapt the target websites because the ads do not *change* the sites.¹⁴⁴ The two courts that relied on *Lee* reasoned

140. *See, e.g., id.* at 479–80 nn.26–30 (detailing the results of a survey “conducted . . . to determine whether Defendants’ pop-up advertising scheme was likely to cause confusion as to the source of the pop-up advertisements”).

141. Although it appears from current cases that plaintiffs have not alleged that pop-up ads discourage visitors from returning to their own websites, legal commentators and computer industry analysts have questioned whether Internet users would consider not returning to a particular site because of the presence of pop-up ads. *See Yung, supra* note 134.

142. *E.g., 1-800 Contacts*, 309 F. Supp. 2d at 486 (“Plaintiff argues that to infringe their derivative work right, Defendants need not have made a copy of the original work in order to create a derivative work, and that to violate its protected right to prepare derivative works, Defendants need only transform or recast the copyrighted work in some way, as by adding to or deleting from Plaintiff’s copyrighted website.” (footnote and internal quotation marks omitted)). It is noteworthy that the plaintiff cited *Aymes v. Bonelli*, 47 F.3d 23, 25 (2d Cir. 1995), for the proposition that an original work need not be copied in order to prepare a derivative of that work. *1-800 Contacts*, 309 F. Supp. 2d at 486 n.39. The court, however, distinguished *Aymes* on the ground that that case dealt with an alteration to the underlying computer code. *Id.* Without expressly saying so, the court rested this distinction on the fact that the plaintiff never alleged that the pop-up ads modified or altered the underlying code of the plaintiff’s website. *Id.* The court declined to comment on whether a work must copy a preexisting work (or multiply elements of it) in order to constitute a derivative work. *Id.* The Second Circuit appears to hold in *Aymes* that mere modification of a preexisting copy is sufficient to prepare a derivative work; however, *Aymes* does not elaborate on this point (merely assuming that a software adaptation is a derivative work) and immediately proceeds to analyze the case under § 117.

143. *E.g., 1-800 Contacts*, 309 F. Supp. 2d at 488 (denying motion for preliminary injunction only on copyright claims); *Wells Fargo & Co. v. WhenU.com, Inc.*, 293 F. Supp. 2d 734, 773 (S.D.N.Y. 2003) (denying motion for preliminary injunction on all claims, including copyright); *U-Haul Int’l, Inc. v. WhenU.com*, 279 F. Supp. 2d 723, 731 (E.D. Va. 2003) (granting summary judgment to defendants, based in part on finding no infringement of the derivative right). *But see* *Washingtonpost.Newsweek Interactive Co. v. Gator Corp.*, 2002 WL 31356645 (E.D. Va. July 16, 2002) (granting motion for preliminary injunction without opining on the merits of the claims, including copyright infringement).

144. *1-800 Contacts*, 309 F. Supp. 2d at 487 (“Defendants’ pop-up ads may ‘obscure’ or ‘cover’ a portion of Plaintiff’s website—but they do not ‘change’ the website, and accordingly do not ‘recast, transform or adapt’ the website” (citing *Lee v. A.R.T. Co.*, 125 F.3d 580, 582 (7th Cir. 1997))); *Wells Fargo*, 293 F. Supp. 2d at 770 (“If one were able to look at the HTML code of

that pop-up ads could not be derivative works because it would mean that a user creates a derivative work upon opening *any* window while another is already open.¹⁴⁵ Notwithstanding the defendants' success with regards to the copyright claims, some of the plaintiffs have enjoined the distribution of the respective defendant's programs, at least temporarily, on other grounds (such as trademark infringement);¹⁴⁶ moreover, other actions are still pending.¹⁴⁷

Of all the controversies arising from noncopying alterations, the most publicized controversy surrounds home-video filtering (and editing). Home-video filtering companies produce data filters that instruct digital video disc players to skip images and mute sounds marked as objectionable by prescreening employees of the filter companies. As explained in Part I, home-video filtering became the subject of litigation after a franchisee of the popular video-editing company CleanFlicks initiated a lawsuit against the Directors Guild of

plaintiffs' sites, one would not see any changes as a result of WhenU's advertisements. In this respect, the effect of WhenU's advertisements on plaintiffs' sites is more akin to the affect of a video game accessory in *Lewis Galoob Toys.*"); *U-Haul*, 279 F. Supp. 2d at 731 ("WhenU's ad is merely another window on the user's computer desktop. The pop-up ad may modify the user's computer display; however, this modification does not consist [sic] copyright infringement." (citing *Lee*, 125 F.3d at 582)). The *U-Haul* decision makes this point by implication. The court noted that a pop-up modifies the *user's* computer display, and then concluded without explanation that such a modification does not prepare a derivative work. *U-Haul*, 279 F. Supp. 2d at 731. The court noted previously that, in relation to the trademark claim, "the SaveNow [ad-ware] program does not change the underlying appearance of the U-Haul website." *Id.* at 729. Thus, when the court later concluded that a modification to the *user's* screen would not be sufficient to prepare a derivative work, it may have meant to imply that a derivative work may not be prepared unless there is some modification to the underlying appearance of the *target* website—or in other words, a derivative work is not prepared unless the underlying work is *changed*. *Id.* at 731.

145. *1-800 Contacts*, 309 F. Supp. 2d at 487–88 ("[I]f obscuring a browser window containing a copyrighted website with another computer window produces a 'derivative work,' then *any* action by a computer user that produced a computer window or visual graphic that altered the screen appearance of Plaintiff's website, however slight, would require Plaintiff's permission."); *U-Haul*, 279 F. Supp. 2d at 731 ("To conclude otherwise [that pop-ups infringe copyright] is untenable in light of the fact that the user is the one who controls how items are displayed on the computer [ostensibly by installing the ad-ware], and computer users would infringe copyrighted works any time they opened a window in front of a copyrighted Web page . . .").

146. *E.g.*, *1-800 Contacts*, 309 F. Supp. 2d 467 (granting motion for preliminary injunction on trademark and cybersquatting claims, which was reversed on appeal), *rev'd*, 414 F.3d 400 (2d Cir. 2005); *Washingtonpost.Newsweek*, 2002 WL 31356645 (granting motion for preliminary injunction without explanation of the grounds for decision).

147. *See, e.g.*, *In re The Gator Corp. Software Trademark & Copyright Litig.*, 259 F. Supp. 2d 1378 (consolidating similar actions in multiple districts). For more regarding this consolidated action, as well as other potentially pending actions, see Yung, *supra* note 134, at 521–22.

America. Because Congress intervened—expressly exempting video filtering from copyright infringement with the Family Movie Act of 2005¹⁴⁸—before a substantive decision was reached in the case, the controversy is mentioned here only briefly. Although the video-filtering companies were recently dismissed as parties to the case—in light of the Family Movie Act of 2005—litigation is still pending with respect to several video-editing companies.¹⁴⁹ Video filtering (and editing) will be discussed in more detail below in Part IV.B.3.

In summary, courts have inconsistently decided cases addressing noncopying alterations under the 1976 Copyright Act. As the previous discussion observed, some courts have found that unauthorized, noncopying alterations infringe the derivative right, while other courts have not. Even courts that reach similar outcomes do not arrive at their conclusions for the same reasons. Owing, at least in part, to the unpredictable case law surrounding noncopying alterations, Congress has already intervened in one recent controversy, expressly authorizing video-filtering technologies.

IV. EMPHASIZING THE COPY IN COPYRIGHT

To avoid continued uncertainty in litigation and to remedy the future need for additional congressional intervention, this Comment proposes a simple solution: requiring evidence of copying—that is, evidence of the intentional multiplication of embodiments of the allegedly infringed work—before finding infringement of the derivative right. This solution does not require new legislation¹⁵⁰ or new judicial doctrine.¹⁵¹ It simply requires courts to reemphasize a basic principle of copyright law—there is no copyright infringement, even of the derivative right, without

148. Pub. L. No. 109-9, §§ 201–202, 119 Stat. 218, 223–24 (to be codified at 17 U.S.C. § 110, 15 U.S.C. § 1114).

149. *See, e.g.,* John Accola, *A Win for Movie Sanitizers: Judge Drops Two Companies from Copyright Lawsuit*, ROCKY MOUNTAIN NEWS, Aug. 19, 2005, at 2B, available at 2005 WLNR 13068749.

150. Other authors have suggested legislative amendments. *See, e.g.,* Naomi Abe Veogthi, *Rethinking Derivative Rights*, 63 BROOK. L. REV. 1213 (1997) (advocating legislation of a less expansive definition of the derivative right).

151. Other authors have suggested crafting new judicial doctrines. *See, e.g.,* Tyler T. Ochoa, *Copyright, Derivative Works and Fixation: Is Galoob a Mirage, or Does the Form(Gen) of the Alleged Derivative Work Matter?*, 20 SANTA CLARA COMPUTER & HIGH TECH. L.J. 991 (2004) (advocating the adoption of the rule that the derivative right is dependent upon the other exclusive rights).

evidence of copying. In short, this Comment urges courts to *emphasize the copy in copyright*. Although holding noncopying alterations not to infringe the derivative right is contrary to at least two federal appellate court precedents, those decisions are either much maligned, generally misunderstood, and/or directly in conflict with the holdings of other circuits. Thus, requiring evidence of copying does not require a significant course change in federal case law. Even more importantly, this requirement would result in more consistent and predictable outcomes for present and future litigation over noncopying alterations, avoiding the need for narrow legislative exemptions, such as the Family Movie Act of 2005.¹⁵² This Part first argues why noncopying alterations do not prepare infringing derivative works, and then analyzes how past and present controversies would be resolved by requiring evidence of copying before finding infringement of the derivative right.

*A. Why Noncopying Alterations Do Not Prepare
Infringing Derivative Works*

Simply stated, noncopying alterations do not prepare infringing derivative works because they do not copy. Traditionally, copying has been a necessary element to prove infringement, and the 1976 Copyright Act did not change this fundamental requirement. In addition, as demonstrated below, the text of the 1976 Copyright Act implies that noncopying alterations do not prepare infringing derivative works because a work may not be *based upon* another work unless the derivative *copied*, in some degree or other, the original. Thus, this Section first argues that the general requirement for evidence of copying to prove infringement applies to the modern derivative right, and then argues that the “based upon” text of the 1976 Act specifically implies requiring evidence of copying to prove infringement of the derivative right.

*1. The general requirement for evidence of copying to prove
infringement applies to the modern derivative right*

Evidence of copying has long been a bedrock requirement for any claim of copyright infringement. One prominent commentator went as

¹⁵² Pub. L. No. 109-9, §§ 201–202, 119 Stat. 218, 223–24 (to be codified at 17 U.S.C. § 110, 15 U.S.C. § 1114).

far as to call it a principle of “copyright gospel” that copyright “infringement will be found only if defendant’s work *copies* from plaintiff’s [work].”¹⁵³ As shown below, this conclusion, as applied to the present-day *reproduction* right, is safely rooted in the Supreme Court’s consistent interpretation of copyright as conferring the right to multiply copies—or, by negative implication, as conferring the right to exclude others from multiplying copies. Its broad implication—that infringement of the *derivative* right requires evidence of copying—is, admittedly, more difficult to confirm.

a. Traditionally, copyright infringement required proof of copying. During the years that the derivative right developed, the Supreme Court repeatedly affirmed that copyright protected only against copying. Interpreting the original Copyright Act of 1790, the Court observed, in *Stephens v. Cady*,¹⁵⁴ “The copy-right is an exclusive right to the multiplication of copies.”¹⁵⁵ At the time, copyright only granted authors the exclusive rights of “printing, reprinting, publishing or vending”;¹⁵⁶ subsequent cases, however, continued to define copyright as the right to multiply copies, even though Congress had expanded copyright to include additional derivative rights. For instance, *Bobbs-Merrill Co. v. Straus*¹⁵⁷ defined the “main purpose of the copyright statutes” to be “the right to multiply copies,”¹⁵⁸ even though the 1870 Act had already expanded copyright protection to include the rights to translate and to dramatize works. Arguably, these additional derivative rights were not the “main purpose” of copyright, but were merely incidental protections. *Mazer v. Stein*¹⁵⁹ concluded unequivocally, however, “The copyright protects originality rather than novelty or invention—conferring only

153. Goldstein, *supra* note 11, at 218 (emphasis added).

154. 55 U.S. 528 (1852).

155. *Id.* at 530 (holding that the defendant’s purchase of a copperplate engraving of the plaintiff’s copyrighted map did not confer the right to multiply copies of the map).

156. *See supra* note 12 and accompanying text.

157. 210 U.S. 339 (1908) (holding that a copyright owner could not, by virtue of the copyright, enforce a minimum retail price against subsequent wholesale purchasers who sold the works at retail below the minimum price).

158. *Id.* at 347 (citing *Stephens*, 55 U.S. at 530).

159. 347 U.S. 201 (1954) (holding that the intended use of porcelain figures as bases for table lamps did not disqualify the figures from copyright protection).

‘the sole right of multiplying copies.’”¹⁶⁰ Significantly, *Mazer* interpreted the 1909 Act, which granted the most expansive protection for derivative rights prior to the 1976 Act.¹⁶¹ How then could *Mazer* conclude that copyright conferred *only* the sole right to multiply copies when the statute presently enumerated derivative rights in addition to the traditional reproduction rights¹⁶² of printing, reprinting, and publishing?

One reasonable explanation is that the Court considered derivative works, such as translations and dramatizations, to be copies of original works in the same manner that a reproduction was considered to be a copy. Under this interpretation of *Mazer*, the addition of derivative rights to the statute did not change the fundamental purpose of copyright, which was to prohibit the unauthorized multiplication of copies—that is, unauthorized copying—because derivative works were, by implication, considered to be copies as well. Accordingly, *Mazer*’s subsequent observation—“Absent copying there can be no infringement of copyright”¹⁶³—was, by implication, equally applicable to infringement of the *derivative* copyrights. As such, there could have been no infringement of these derivative rights absent evidence of copying—that is, absent some proof that the defendant had multiplied copies of the plaintiff’s work by, for instance, creating a translation or dramatization based upon that work.

Significantly, the Supreme Court never found copyright infringement absent at least some evidence of copying, which supports the inference that copying was a requirement for all infringement cases, including alleged infringement of the then-recognized derivative rights. Admittedly, the Supreme Court never directly addressed whether evidence of copying was required for alleged infringement of the then-recognized derivative rights.

Prior to the 1976 Copyright Act, however, lower courts consistently rejected attempts to expand copyright to prohibit noncopying activities, such as noncopying alterations, as demonstrated in Part III.A. For

160. *Id.* at 218 (quoting *Jewelers Circular Publ’g Co. v. Keystone Publ’g Co.*, 281 F. 83 (2d Cir. 1922)).

161. *See supra* notes 18–22 and accompanying text.

162. The “reproduction” right, as such, was not introduced until the 1976 Act, *see* 17 U.S.C. § 106(1), but it is used here to describe its predecessor rights.

163. *Mazer*, 347 U.S. at 218 (citing, *inter alia*, *White-Smith Music Publ’g Co. v. Apollo Co.* 209 U.S. 1 (1908); *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 249 (1903)).

instance, courts found no infringement for rebinding books,¹⁶⁴ for binding comic magazines together,¹⁶⁵ for manufacturing handbags from designed fabric,¹⁶⁶ for repainting a hobbyhorse,¹⁶⁷ or for affixing designs removed from greeting cards and notepads to ceramic plaques.¹⁶⁸ In each case, the defendant never copied—that is, never intentionally multiplied embodiments of—the respective plaintiff’s works. One of these courts, in reaching its conclusion, relied expressly on the Supreme Court’s characterization of copyright as the exclusive right to multiply copies. In *Fawcett Publications v. Elliot Publishing Co.*,¹⁶⁹ the defendant purchased secondhand copies of plaintiff’s comic book and subsequently bound them together with other comic publications (not owned by the plaintiff).¹⁷⁰ *Fawcett*, citing *Bobbs-Merrill*, noted: “The decisions appear to be uniform that the purpose and effect of the copyright statute is to secure to the owner thereof the exclusive right to multiply copies.”¹⁷¹ Accordingly, *Fawcett* held that there was no copyright infringement because “the defendant ha[d] not multiplied copies but merely resold the plaintiff’s under a different cover.”¹⁷² Many other courts similarly found the absence of copying to be the dispositive issue.¹⁷³

In summary, prior to the 1976 Copyright Act, the Supreme Court held expressly that copyright infringement, in general, requires evidence of copying. Moreover, the Supreme Court never found copyright infringement absent proof of copying. Finally, almost all of the lower courts deciding noncopying-alteration cases rejected infringement claims on the basis that copyright infringement requires evidence of copying.

But do the same principles of copyright infringement, formed during the years when copyright primarily prohibited only unauthorized

164. See *supra* notes 37–39 and accompanying text.

165. See *supra* notes 44–45 and accompanying text.

166. See *supra* notes 46–47 and accompanying text.

167. See *supra* notes 48–49 and accompanying text.

168. See *supra* notes 50–53 and accompanying text.

169. 46 F. Supp. 717 (S.D.N.Y. 1942).

170. For more on *Fawcett*, see *supra* notes 44–45 and accompanying text.

171. 46 F. Supp. at 718 (citing *Bobbs-Merrill Co. v. Straus*, 210 U.S. 339 (1908)).

172. *Id.*

173. See, e.g., *C.M. Paula Co. v. Logan*, 355 F. Supp. 189, 191 (N.D. Tex. 1973) (finding no infringement because there was no proof of copying); *Blazon, Inc. v. Deluxe Game Corp.*, 268 F. Supp. 416, 420 (S.D.N.Y. 1965) (same). For more on *C.M. Paula*, see *supra* notes 50–53 and accompanying text. For more on *Blazon*, see *supra* notes 48–49 and accompanying text.

reproductions,¹⁷⁴ apply to the modern-day derivative right? Specifically, does the traditional infringement requirement for proof of copying apply to claims against noncopying alterations alleged to be derivative works under the 1976 Copyright Act?

b. Feist preserved the traditional infringement requirement for proof of copying even after the 1976 Act. When the Court decided *Feist Publications, Inc. v. Rural Telephone Service Co.*,¹⁷⁵ interpreting the 1976 Act, it stated emphatically, “The *sine qua non* of copyright is originality.”¹⁷⁶ In other words, without originality there is no copyright. Originality, according to *Feist*, means that “the work was independently created by the author, as opposed to [being] copied from other works, and that it possesses at least some minimal degree of creativity.”¹⁷⁷ By implication, complete originality precludes a finding of copyright infringement.¹⁷⁸ Even more directly, *Feist* held, “To establish infringement, two elements must be proven: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.”¹⁷⁹ Thus, even after the inclusion of the broadly defined, modern-day derivative right in the 1976 Copyright Act, the Supreme Court restated the traditional rule that copyright infringement requires proof of copying. Although the facts at issue only implicated the reproduction right, not the derivative right,¹⁸⁰ *Feist*, nevertheless, did not

174. See *supra* Part II; see also Goldstein, *supra* note 11, at 219 (“The rules on copyright infringement were shaped in the years before derivative rights were added to the statute, when the only question was whether defendant’s work constituted a copy of plaintiff’s.”). Ironically, what used to be the “only question” in infringement cases is rarely discussed thoroughly in derivative rights cases addressing noncopying alterations.

175. 499 U.S. 340 (1991).

176. *Id.* at 345.

177. *Id.* (emphasis added).

178. A work, of course, may be copyrightable and still be an infringing work. If, for instance, a work contained both copied and original elements (and a minimum degree of creativity), then it would be copyrightable (for the original elements) but nonetheless an infringing work (for the copied elements). In some cases, it may be possible to separate the copyrightable original elements from the copied elements, but in other cases, it is likely that the mixed elements are inseparable. The implication of *Feist*, however, is that a completely original work is completely copyrightable, and therefore not capable (in whole or in part) of being an infringing work.

179. *Id.* at 361 (emphasis added) (citing *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 548 (1985)).

180. *Feist* speaks of infringement in general terms, never specifically referencing the reproduction right in 17 U.S.C. § 106(1), though it appears uncontroversial that the reproduction right, not the derivative right, was implicated.

make its infringement formula contingent on the reproduction right, making it presumptively applicable to the derivative right.

Whether the infringement formula stated in *Feist* applies beyond the reproduction right should be the threshold question for any court deciding an infringement claim regarding the derivative right. Surprisingly, no lower courts addressing derivative-works cases have asked this question. Although most, if not all, courts addressing allegedly copying derivative works—that is, derivative works that have allegedly copied original works—determine whether, in fact, there is evidence of copying,¹⁸¹ courts addressing noncopying alterations have not directly addressed the question. Some have cited the infringement formula in *Feist*,¹⁸² and others have cited similar formulations,¹⁸³ but many courts have ignored any infringement formula requiring proof of copying.¹⁸⁴ Even more problematic, courts that have required proof of copying have found infringement absent any such proof.¹⁸⁵ Furthermore, those courts

181. See, e.g., *Anderson v. Stallone*, No. 87-0592 WDKGX, 1989 WL 206431 (C.D. Cal. April 25, 1989).

182. See, e.g., *1-800 Contacts, Inc. v. WhenU.com*, 309 F. Supp. 2d 467, 484 (S.D.N.Y. 2003) (citing *Feist*), *rev'd on other grounds*, 414 F.3d 400 (2d Cir. 2005); *U-Haul Int'l, Inc. v. WhenU.com, Inc.*, 279 F. Supp. 2d 723, 729 (E.D. Va. 2003) (same); *Lee v. Deck the Walls, Inc.*, 925 F. Supp. 576, 578 (N.D. Ill. 1996) (citing a Seventh Circuit decision citing *Feist*), *aff'd*, *Lee v. A.R.T. Co.*, 125 F.3d 580 (7th Cir. 1997).

183. See, e.g., *Micro Star v. Formgen Inc.*, 154 F.3d 1107, 1109 (9th Cir. 1998) (“To succeed on the merits of its [infringement] claim . . . [the plaintiff] must show . . . copying of protected expression.”); *Futuredantics Inc. v. Applied Anagramics Inc.*, No. CV 97-6991, 1998 WL 132922, 45 U.S.P.Q. 2d 2005, 2009 (C.D. Cal. Jan. 30, 1998) (“To establish copyright infringement, Plaintiff must prove . . . that Defendants copied Plaintiff’s copyrighted work.” (citing *Smith v. Jackson*, 84 F.3d 1213, 1218 (9th Cir. 1996))); *Greenwich Workshop, Inc. v. Timber Creations, Inc.*, 932 F. Supp. 1210, 1212 (C.D. Cal. 1996) (“Copyright infringement is demonstrated by proof of . . . ‘copying’ by the defendants.” (citing *Hustler Magazine, Inc. v. Moral Majority, Inc.*, 796 F.2d 1148, 1151 (9th Cir. 1986))); *Paramount Pictures Corp. v. Video Broad. Sys., Inc.*, 724 F. Supp. 808, 819 (D. Kan. 1989) (“There are two basic elements to a claim for copyright infringement: (1) plaintiff’s ownership of the copyright; and (2) defendant’s ‘copying’ of the work protected by copyright.” (citing *Nelson v. PRN Prods., Inc.*, 873 F.2d 1141, 1142 (8th Cir. 1989))); *Worlds of Wonder, Inc. v. Vector Intercontinental, Inc.*, 653 F. Supp. 135, 138 (N.D. Ohio 1986) (“To establish infringement of copyright [the plaintiff] must show . . . copying by the defendants.” (citing *Eckes v. Card Prices Update*, 736 F.2d 859 (2d Cir. 1984))).

184. See, e.g., *Lee v. A.R.T. Co.*, 125 F.3d 580, 580–81 (7th Cir. 1997); *Lewis Galoob Toys, Inc. v. Nintendo of America, Inc.*, 964 F.2d 965, 969 (9th Cir. 1992); *Mirage Editions, Inc. v. Albuquerque A.R.T. Co.*, 856 F.2d 1341 (9th Cir. 1988).

185. See, e.g., *Micro Star*, 154 F.3d 1107; *Greenwich*, 932 F. Supp. 1210; *Vector*, 653 F. Supp. 135. There was evidence in *Micro Star* of copying—the defendants admittedly copied the MAP files that game users had posted on the Internet. The appellate court, however, never expressly explained what the defendant copied from the plaintiff. Alleging that the altered video-game levels

that have not found infringement have based their decisions on reasons other than absence of copying.¹⁸⁶ Only a very small minority of courts appear to have concluded that noncopying alterations do not infringe because they do not copy.¹⁸⁷ The apparent inattention to *Feist*'s formula in cases addressing noncopying alterations, as well as the corresponding confusion over evidence of copying, may be attributable, primarily, to two factors: (1) many noncopying alterations appear to copy; and (2) copying has been redefined by some to mean infringement of any exclusive copyright, including the derivative right.

(1) *Many noncopying alterations appear to copy.* Many noncopying alterations appear to meet all of the standard elements for establishing circumstantial proof of copying—that is, the elements articulated by the seminal Second Circuit opinion in *Arnstein v. Porter*¹⁸⁸—including: (1) access to the copyrighted work, and (2) substantial similarity between the copyrighted work and the allegedly infringing work. In every noncopying-alteration case, the defendant had access to the copyrighted work. In fact, it was the acknowledged business practice of each defendant to alter copies of the respective plaintiff's works; proof of access, therefore, was obvious. Furthermore, altered copies appear substantially similar to the original copies. Speeded-up video-game play appears substantially similar to unaltered game play;¹⁸⁹ prints affixed to ceramic tiles appear substantially similar to those same prints before affixation;¹⁹⁰ and filtered home-video

are sequels is as close as the court came. Similarly, there was also evidence of copying in *Vector*. The district court, however, appears to have rested its decision on noncopying grounds.

186. For example, the website framing case *1-800 Contacts*, 309 F. Supp. 2d 467, cited *Feist*, see *supra* note 182, but did not decide the case on the absence of copying, but rather on the basis that the frames did not change the plaintiff's work. *1-800 Contacts*, 390 F. Supp. 2d at 487 ("Defendants' pop-up ads may 'obscure' or 'cover' a portion of Plaintiff's website—but they do not 'change' the website, and accordingly do not 'recast, transform or adapt' the website." (citing *Lee*, 125 F.3d at 582)).

187. See, e.g., *Deck the Walls*, 925 F. Supp. at 580 ("Both framing and tiling utilize the same works purchased from the copyright holder and do not involve 'copying' as defined by the Copyright Act."), *aff'd on other grounds*, *Lee*, 125 F.3d 580; *Vault Corp. v. Quaid Ltd.*, 847 F.2d 255, 268 (5th Cir. 1988) ("Under these circumstances, we agree with the district court that the . . . copying was not significant and that this version . . . was not a substantially similar copy . . .").

188. 154 F.2d 464 (2d Cir. 1946).

189. For more on speeded-up video games, see, for example, *supra* notes 90–95.

190. For more on prints affixed to ceramic tiles, see *supra* notes 72–82.

playback appears substantially similar to unfiltered playback.¹⁹¹ Thus, some courts have summarily concluded that altered copies were substantially similar to the original copies.¹⁹² What these courts have neglected is the most fundamental, but most understated, element of copying—*multiplication* of embodiments of the work. The defendants in the above-mentioned alteration cases—speeded-up video games, tile art, and filtered home videos—did not create *additional* copies (or embodiments); instead they altered *existing* copies. Courts have improperly analyzed the elements for circumstantial proof of copying without ever asking, in the first place, whether there was actual copying—that is, intentional multiplication of embodiments of the work.

In most infringement cases, implicating either the reproduction or the derivative right, the “multiplying element” of copying is obvious, and courts do not even bother proving the point, answering instead whether the defendant had access to the plaintiff’s work and whether the work created by the defendant sufficiently resembles the plaintiff’s work such that the court may reasonably infer that the defendant copied the plaintiff’s work. Courts rarely must answer whether the defendant created something additional in the first place. For instance, in deciding whether one musical composition reproduced another composition,¹⁹³ there was no need for the court to prove that the allegedly copying composition was an additional creation; the only question was whether that additional creation embodied the original composition. The same was true with regards to an allegedly copied theatrical play¹⁹⁴ and an allegedly copied illustration.¹⁹⁵

Similarly, courts often assume the “multiplying element” for infringement claims in derivative-works cases. Thus, courts did not address whether a motion picture based on a book¹⁹⁶ or a sequel based on a previous movie¹⁹⁷ multiplied embodiments of these respective works. Again, such multiplication was obvious because the defendants created embodiments of their works *in addition* to the existing

191. For more on filtered home videos, see *supra* note 271 and accompanying text.

192. See, e.g., *Micro Star v. Formgen Inc.*, 154 F.3d 1107, 1112 (9th Cir. 1998).

193. See *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946).

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

195. See *Steinberg v. Columbia Pictures Indus., Inc.*, 663 F. Supp. 706 (S.D.N.Y. 1987).

196. See *Kalem Co. v. Harper Bros.*, 222 U.S. 55, 63 (1911).

197. See *Anderson v. Stallone*, No. 87-0592 WDKGX, 1989 WL 206431 (C.D. Cal. April 25, 1989).

embodiments of the respective plaintiff's works. Accordingly, the question before the courts, in most infringement cases, is whether the defendant had access to the plaintiff's works and whether the defendant's creations sufficiently resemble the plaintiff's works—that is, whether the defendant copied the plaintiff's works.

This problem is easily correctible. Courts simply must be advised that noncopying alterations do not necessarily copy the original works they alter; some alterations *modify existing* copies, without *multiplying additional* copies (or embodiments), of works. Emphasizing the “multiplying element” of copying preserves the underlying motivation for copyright, as articulated by the Supreme Court—protecting the right to multiply copies (or embodiments).

(2) *Copying has been redefined by some to mean infringement of any exclusive copyright, including the derivative right.* The apparent inattentiveness to *Feist's* infringement formula may also be attributable to the sentiment that “copying” is “shorthand” for infringing any of the exclusive rights in Section 106 of the Copyright Act.¹⁹⁸ If “copying” just means infringing one of the exclusive rights, then any infringement of the derivative right would necessarily be copying, making *Feist's* requirement for evidence of copying tautological. Although only a few courts have expressly held that “copying” means infringement of any exclusive copyright,¹⁹⁹ many more courts appear to agree tacitly, either leaping immediately into the question of whether a work is derivative without ever addressing whether the defendant copied the plaintiff,²⁰⁰ or deciding cases for reasons other than evidence of copying.²⁰¹ The

198. See, e.g., 2 NIMMER & NIMMER, *supra* note 8, § 8.02[A], at 8-28 (“Accordingly, ‘copying’ is ‘shorthand for the infringing of any of the copyright owner’s five exclusive rights’ set forth in Section 106 of the Copyright Act.” (footnote omitted)) (noting that the subsequent expansion in 1995 of Section 106 to encompass six rights did not change the proposition).

199. See, e.g., *Deck the Walls*, 925 F. Supp. at 578 (“‘Copying’ means infringing upon a copyright owner’s exclusive rights.”); *Paramount Pictures Corp. v. Video Broad. Sys., Inc.*, 724 F. Supp. 808, 819 (D. Kan. 1989) (“‘Copying’ is the shorthand reference to the act of infringing any of the copyright owner’s five exclusive rights set forth at 17 U.S.C. § 106.” (citing *S.O.S., Inc. v. Payday, Inc.*, 886 F.2d 1081 (9th Cir. 1989))).

200. See, e.g., *Lewis Galoob Toys, Inc. v. Nintendo of America, Inc.*, 964 F.2d 965, 967 (9th Cir. 1992) (leaping directly into the definition of a derivative work without ever addressing the requirement for copying to prove infringement).

201. See, e.g., *Worlds of Wonder, Inc. v. Vector Intercontinental, Inc.*, 653 F. Supp. 135, 140 (N.D. Ohio 1986). *Vector* went through the standard steps for analyzing evidence of copying—access to the copyrighted work and substantial similarity between the works. *Id.* at 138. *Vector*,

unfortunate consequence of this tautology is that it removes the most fundamental element of copyright—evidence of copying—and thus opens the door for infringement suits against noncopying defendants.

Requiring evidence of copying for every case of copyright infringement, however, is potentially problematic because, arguably, some of the exclusive rights may be infringed without copying. The 1976 Act granted copyright owners the exclusive rights to reproduce copies of,²⁰² to prepare derivative works based upon,²⁰³ to distribute copies of,²⁰⁴ to perform publicly,²⁰⁵ and to display publicly their copyrighted works.²⁰⁶ Arguably, defendants who distribute or display unauthorized copies have not themselves copied. Thus, copyright infringement—at least of the distribution and display rights—does not require proof of the *defendant's* copying. If the distribution and the display rights appear to deal with unauthorized *uses*, not unauthorized *copying*, of protected works, does the derivative right, therefore, also address unauthorized *uses*, not just unauthorized *copying*?

Interpreting the derivative right to prohibit unauthorized uses is not reasonable given the historical development of the derivative right. In a sense, the derivative right and the performance right grew out of the early reproduction right as part of a gradually expanding view of what constituted unauthorized *copying*. Understood as such, the reproduction right excludes literal copying;²⁰⁷ the derivative right excludes copying into alternative mediums or markets;²⁰⁸ and the performance right excludes copying in live productions.²⁰⁹ Describing the reproduction, derivative, and performance rights as “copying” rights is consistent with

however, did not limit the scope of the infringement to only the copied expression, concluding instead, “The language of the copyright is certainly broad enough to include all movements which may be created by the animated bear.” *Id.* at 140. Thus, even if the defendant’s tapes had animated the toy bear in a completely different manner than the plaintiff’s tapes, the court would have found infringement by the defendant for having configured the plaintiff’s toy.

202. 17 U.S.C. § 106(1) (2000).

203. *Id.* § 106(2).

204. *Id.* § 106(3).

205. *Id.* § 106(4). Later amendment expanded the performance right to include digital audio transmissions of sound recordings. *See id.* § 106(6).

206. *Id.* § 106(5).

207. *Id.* § 106(1). The reproduction right has extended beyond literal copying, but for purposes here it is sufficient to describe it as literal copying.

208. *Id.* § 106(2). For more on this market-oriented conception of the derivative right, see Goldstein, *supra* note 11.

209. 17 U.S.C. § 106(4), (6).

the historical expansion of copyright, as discussed in Part II, in which Congress gradually extended copyright to include protection against unauthorized theater performances²¹⁰ and against unauthorized derivative works, such as translations²¹¹ and dramatizations.²¹² If the derivative right enumerated in the 1976 Act “merely restat[ed] preexisting law in a more simple and concise way,”²¹³ then infringement of the modern-day derivative right requires proof of copying consistent with the pre-1976 case law described in Part III.A. Interpreting the derivative right, in contrast, as prohibiting unauthorized *uses*, such as alterations, would be a drastic expansion of copyright, effectively providing copyright owners with full claim to “moral rights” in their works. Arguably, the Visual Rights Act of 1990²¹⁴ introduced limited protection for “moral rights.” At least one appellate court, however, has expressed reluctance to provide through the “back door”—that is, through an expansive definition of the derivative right—that which Congress deliberately omitted from the Visual Rights Act.²¹⁵

If, however, copyright infringement requires proof of copying how are the distribution and the display rights to be understood? Although there is no need for evidence of copying by the *defendants* in order to prove infringement of either the distribution or display rights, neither right may be infringed without proof of unauthorized copying by *another party*. These rights simply help copyright owners to enforce their copyrights against parties who profit from others’ unauthorized copying. In the case of the distribution right, copyright owners may enforce their rights against distributors of unauthorized copies who did not themselves make the copies. Similarly, the display right enables copyright holders to

210. *See supra* note 17.

211. *See supra* note 18.

212. *See supra* note 19.

213. Pamela Samuelson, *Allocating Ownership Rights in Computer-Generated Works*, 47 PITT. L. REV. 1185, 1214 (1986).

214. Pub. L. No. 101-650, §§ 601–610, 104 Stat. 5089, 5128–33 (codified primarily at 17 U.S.C. § 106A).

215. *See, e.g.*, *Lee v. A.R.T. Co.*, 125 F.3d 580, 582 (7th Cir. 1997). The court noted,

If Lee (and the ninth circuit) are right about what counts as a derivative work, then the United States has established through the back door an extraordinarily broad version of authors’ moral rights, under which artists may block any modification of their works of which they disapprove. . . . It would not be sound to use § 106(2) to provide artists with exclusive rights deliberately omitted from the Visual Artists Rights Act.

Id. (citations omitted).

prohibit the subsequent display of unauthorized copies.²¹⁶ In effect, the distribution and display rights do not prohibit *unauthorized uses*, but rather *uses of unauthorized copies*. Thus, infringement of every exclusive right requires some proof that either the defendant or a third party copied.

In summary, evidence of copying has always been an element of copyright infringement. Significantly, this conclusion was reaffirmed by the Supreme Court, in *Feist Publications, Inc. v. Rural Telephone Service Co.*,²¹⁷ which was decided after enactment of the 1976 Copyright Act. Although *Feist*, arguably, only applied to the reproduction right, *Feist*'s unequivocal requirement should make evidence of copying presumptively necessary in derivative-rights cases as well. Few courts deciding controversies over noncopying alterations, however, have required plaintiffs alleging infringement of the derivative right to prove evidence of copying. Some courts have likely ignored the requirement for copying because many noncopying alterations appear to copy. Future courts should recognize the difference between *modifying* a copy and *multiplying* a copy. Other courts have likely ignored the requirement for copying because "copying" has been redefined by some to mean infringement of any exclusive copyright, including the derivative right. Future courts should reject this tautology because it obscures the most fundamental element of any claim for *copyright* infringement—evidence of copying! Furthermore, courts should reject attempts to define the derivative right as prohibiting unauthorized *uses* of copyrighted works, thereby granting copyright owners broad claims to "moral rights," which Congress deliberately omitted from the Visual Artists Rights Act.

2. "Based upon" implies evidence of copying

In addition to the long-established precedent that copyright infringement requires evidence of unauthorized copying, the text of the 1976 Copyright Act specifically implies that evidence of copying is required to prove infringement of the derivative right. There are two

216. In practice, the display right also prohibits copying by the defendants. Section 109(c) of the Copyright Act limits the scope of the display right by permitting the owners of a particular copy of a work to display it "to viewers present at the place where the copy is located," 17 U.S.C. § 109(c), such as an art gallery. The only way to infringe the display right, therefore, is to broadcast the copy to viewers who are not present where the copy is located. Such a broadcast, in effect, *copies* the work in much the same way that a live performance would copy the work.

217. 499 U.S. 340 (1991).

relevant sections of the Act: Section 106(2), which defines the exclusive rights granted to copyright owners, and Section 101, which defines certain terms used in the Act.

a. Section 106(2) implies evidence of copying. Section 106(2) of the 1976 Copyright Act grants copyright owners “the exclusive right to . . . prepare derivative works *based upon* the [owner’s] copyrighted work.”²¹⁸ By negative implication, a work is an infringing derivative work if it is *based upon* the allegedly infringed copyrighted work. What does it mean for a derivative work to be “based upon” a copyrighted work? As demonstrated below, a work is based upon another work only if it copied that work. Thus, the statutory language, requiring an infringing derivative work to be based upon the allegedly infringed work, requires evidence of copying.

At first glance, the “based upon” requirement may appear to broaden, not limit, the definition of infringing derivative work. After all, every creative work in one form or another is based upon preexisting works, as illustrated by Justice Joseph Story’s oft-quoted observation regarding copyright: “In 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.”²¹⁹ Closer scrutiny, however, reveals several significant limiting factors. For example, because it is axiomatic that a work may not be based upon itself, the preparation of an infringing derivative work necessarily requires the creation of another work in addition to the original work. Next, because an additional work

218. 17 U.S.C. § 106(2) (2000) (emphasis added).

219. *Emerson v. Davies*, 8 F. Cas. 615, 619 (C.C.D. Mass. 1845) (No. 4,436), *quoted in* 1 NIMMER & NIMMER, *supra* note 8, § 3.01, at 3-3 to 3-4. Although Justice Story made his observation several decades before any legal recognition of an author’s derivative rights, his insights are nonetheless appreciable. Justice Story continued,

Every book in literature, science and art, borrows, and must necessarily borrow, and use much which was well known and used before. No man creates a new language for himself, at least if he be a wise man, in writing a book. He contents himself with the use of language already known and used and understood by others. No man writes exclusively from his own thoughts, unaided and uninstructed by the thoughts of others. The thoughts of every man are, more or less, a combination of what other men have thought and expressed, although they may be modified, exalted, or improved by his own genius or reflection. If no book could be the subject of copy-right which was not new and original in the elements of which it is composed, there could be no ground for any copy-right in modern times, and we should be obliged to ascend very high, even in antiquity, to find a work entitled to such eminence.

Id.

is not necessarily based upon the original work, the preparation of an infringing derivative work requires that the additional work embody the original work, or its elements. Finally, because an independently created work, even if it embodies the same or similar elements, is not based upon another work, the preparation of an infringing derivative work requires evidence that the alleged derivative embodiment was created as a result of having copied the original work.

There are, therefore, three “based upon” elements: (1) creation of another work in addition to the original work; (2) embodiment of the original work in the new work; and (3) evidence of copying.²²⁰ It will be helpful to remember that “copying” is defined as the *intentional* multiplication of embodiments of a work.²²¹ Furthermore, it will be helpful here to recognize that “based upon” is not coterminous with the concept of copying. Although a work that is based upon another preexisting work must have copied the preexisting work, copying a preexisting work does not always lead to a work that is based upon the preexisting work. A reproduction is not based upon the original work, even though a reproduction meets the latter “based upon” element—evidence of copying. A reproduction is not based upon the original work from which it is copied because a reproduction does not create another work in addition to the original work—that is, it does not meet the first “based upon” element; rather the reproduction creates an additional copy of the original work. Accordingly, a reproduction does not embody the original work in a new work because there is no new work. Thus, the second “based upon” element is also not satisfied.

An example illustrates that the three above-mentioned elements are identifiable in a work that—in common, everyday usage—is based upon another work. Consider a motion picture version of a novel. Commonly, the character scripts are based upon the novel’s dialogues; actors’ costumes and film sets are based upon the novel’s descriptions; and action sequences are based upon the novel’s plots. Often, these motion

220. In a sense, there is only one “based upon” factor—evidence of copying. To copy a work, there must be another work apart from the original work—that is, the original work cannot copy itself no matter how much it is altered. Furthermore, to copy a work the second work must embody the original work in some form. Thus, the “based upon” factors boil down to evidence of copying. The factors are separated in order to demonstrate the different elements of copying. Here “evidence of copying” means proof that the second work was created intentionally to appear as the original. In other words, it means that the creator of the second work had the original work in mind, and intentionally multiplied its elements, when creating the second work.

221. *See supra* Part I.

pictures are preceded by an announcement, such as, “Based upon the novel by . . .” or “Based upon a true story.” Because a motion picture version of a novel is based upon that novel, the motion picture version should meet the three above-identified “based upon” elements. First, a separate motion picture is another work in addition to the original work, the novel. Second, a motion picture version of a novel by definition embodies the elements of the original novel; otherwise it would not be called a *version* of the novel. Third, a motion picture version of a novel cannot be created but for the copying of the elements of the novel into the movie; an independently created motion picture that coincidentally embodied elements of the novel would not be called a *version* of the novel.

By definition, noncopying alterations do not meet the third “based upon” element—evidence of copying. Is it possible, however, for a work to be based upon another work without having copied it? In other words, is evidence of copying a necessary element for one work to be based upon another work? The discussion below answers this question by way of example. In the following discussion, examples of three types of noncopying alterations—alternative displays, alternative configurations, and compound works—will be discussed. In each example, common, everyday use of the phrase “based upon” suggests that these noncopying alterations are not *based upon* the respective preexisting works; instead, they *are* the respective preexisting works, albeit altered copies of them. Because all of the noncopying alterations identified in Part III fall into one of these three categories (or combinations of them), there is a reasonable inference that there are no noncopying alterations that are based upon preexisting works. Accordingly, as it is reasonably inferred that noncopying alterations cannot be based upon preexisting works, it is further inferred that evidence of copying is a necessary element for one work to be based upon another work.

(1) Alternative displays and alternative configurations are not based upon preexisting works. Several examples demonstrate that neither alternative displays nor alternative configurations of a work, two types of noncopying alterations, are based upon that work.

Consider the example of an alternative display of a motion picture viewed on a home video. Most, if not all, entertainment systems include functions that allow consumers to alter the display of home-video versions of motion pictures during real-time playback. For instance, the volume of a video soundtrack may be increased or decreased, or muted

altogether. Similarly, segments of a video may be viewed in fast forward or reverse. Additionally, segments may be skipped entirely by stopping play and skipping ahead or behind. These alternative playbacks, however, are not based upon the original motion picture. A motion picture viewed without the soundtrack is not *based upon* that motion picture—it *is* that motion picture, albeit a silent showing of it. A motion picture viewed with certain scenes played in fast forward is not *based upon* that motion picture—it *is* that motion picture, albeit a fast-forwarded showing of it. Everyday, commonplace usage of the phrase “based upon” resists application to these alternative means of displaying the work, suggesting that these noncopying alterations are not *based upon* the motion picture.

Accordingly, these alternative displays should fail to meet at least one of the three “based upon” factors. Indeed, they fail to meet all three requirements. Because there is only one work, the motion picture, it goes without saying that there are not multiple works. In other words, an alternative display of a work does not create another work in addition to the original work. Because there is no new work in addition to the preexisting work, the two remaining “based upon” elements also are not satisfied. With regards to the second element, a new work cannot embody an original work if there is no new work. Although the creation of a new work is not necessary to meet the third requirement of copying, there must at least be a new copy of the original work, which is also absent here. Thus, alternative displays of a work do not meet any of the three identified “based upon” elements.

What is the difference between a motion picture version of a novel, which is based upon a preexisting work, and a muted or fast-forwarded display of a motion picture? More specifically, is not a motion picture version of a novel similarly just an alternative version for displaying the original expression embodied by the novel? In an abstract sense, a motion picture version might be described as an alternative display of the novel, but it is also much more. A motion picture version of a novel is a new work (the motion picture) that “recasts, transforms, and adapts”²²² a preexisting work (the novel). In contrast, the alternative versions for motion picture playback described above—muting sound or fast forwarding scenes—are not new *works*, but rather alternative *displays* of

222. The phrase “recasts, transforms, and adapts” is a reference to the definition of derivative work provided in 17 U.S.C. § 101, which is discussed in detail below.

copies of the original work. An alternative display of a work is not *based upon* that work—it *is* that work, albeit displayed differently.

Another example demonstrates that an alternative configuration of a work, another type of noncopying alteration, is also not based upon that work. Consider many popular toys and games that are configurable—that is, their parts may be rearranged during play. For example, some toys consist of basic building blocks and other shapes that may be configured to build models of complex machines, buildings, etc. Similarly, many dolls have detachable parts, clothes, and accessories that may be arranged differently. More complex toys, such as video games, have a database of sounds and images that may be rearranged during game play according to the decisions of the game player. Many of these toys and their elements are copyrightable. An alternative configuration of a toy, however, is not *based upon* that toy—it *is* that toy, albeit configured differently. Everyday, commonplace usage of the phrase “based upon” resists being applied to describe alternative configurations of toys, suggesting that these noncopying alterations are not *based upon* the toys. Accordingly, these alternative displays should fail to meet at least one of the three “based upon” factors. Indeed, they fail to meet all three. Alternative configurations, similar to alternative displays, do not create another work in addition to the original work, which eliminates the possibility of meeting either of the first two “based upon” elements. Additionally, there is no evidence of copying, the third “based upon” element.

Arguably, some alternative displays and some alternative configurations may add sufficient original expression to create a new work, thereby meeting the first “based upon” factor, and most likely the second factor. In these kinds of noncopying alterations—defined below as compound works—however, there is not necessarily any evidence of copying, even though the works are created with copies of other works. Unauthorized compound works, therefore, are not necessarily infringing derivative works. As demonstrated below, an unauthorized compound work is not an infringing derivative work unless there is evidence of copying.

(2) *Compound works are also not based upon preexisting works.* Some noncopying alterations add sufficient expression such that the resultant alteration is a new work. In other words, copies of preexisting works may become the building blocks, or raw materials, for the creation of new works. For purposes of this Comment, a work that is created by

assembling altered copies of other works is called a compound work—that is, a work created *with copies* of other works. Here it is important to distinguish between two ways in which one work may be created from another work. In the first instance, an author may create another work from an original work by copying recognizable elements of an original work into an embodiment separate from the original work. In the second instance, an author may create another work *with copies* of an original work. In other words, a work may be created by using copies of preexisting works as the building blocks, or raw materials, of the new work. These compound works are not based upon the works from which they were created because they do not meet the “based upon” requirement for evidence of copying. Accordingly, unauthorized compound works are not based upon their component works and, therefore, are not infringing derivative works.

An example is illustrative. A few years ago, digital computer technology made it possible to easily arrange a collage of pictures, which, taken as a whole, created an independent image.²²³ Consider an artist who purchases a collection of digital images—perhaps a collection of images from the movie *Star Wars* marketed for use as computer screensavers or for computer-desktop backgrounds—and who is granted rights only to a single digital copy of each image. Consider further that this artist uses a software collage program to arrange this collection of purchased images such that, taken as a whole, the resultant collage creates the image of one of the artist’s own copyrighted works. This is an example of a compound work—a work created with copies of other original works. In essence, the artist used copies of copyrighted images as the building blocks, or raw materials, for a new work—the collage. Rather than creating a painting using watercolors or oils, this artist created an original work of art using copies of other artists’ works. Has this artist prepared a work based upon other artists’ works? No. Even though the resultant collage is created with copies of other original works, it is not *based upon* those works—it *is* those works, albeit a compound work made with copies of those works. In an analogous manner, an automobile is not *based upon* its parts—it *is* its parts, or rather it is comprised of its parts. Everyday, commonplace usage of the

223. To create the independent image, many collage software programs use one picture as a template and arrange the images in the collage such that the predominant color tone of each image placed in the collage matches the same color tone of the relative portion of the template image.

phrase “based upon” resists application to describe compound works, as it resists application to describe an automobile composition of parts.

Accordingly, a compound work, the collage in this example, should fail to meet at least one of the three “based upon” elements. Because the collage contains its own original expression—the arrangement of preexisting images such that an independent image is formed by their arrangement—in addition to the expression embodied in the preexisting images, the collage is a new work. The collage, therefore, meets the first “based upon” requirement—creation of another work in addition to the original work. It also meets the second “based upon” requirement—embodiment of the original work in the new work. Because the new work, the collage, comprises copies of the original works, it necessarily embodies those works. Those works are not embodied in the new work, however, as a result of copying, so the collage fails to meet the third “based upon” requirement—evidence of copying. This point is subtle. The new work embodies the original works because it was created with copies of those works, not because it copied those works. The collage, therefore, is not a derivative work of its component images.²²⁴ The collage is not based upon its component images any more than an automobile is based upon its parts; instead, the collage, similar to the automobile, is based upon its design—that is, the image forming the basis for the arrangement of the component parts.

A compound work, however, may be an infringing derivative work if it copied, without authorization, from another work. Consider another example of an artist who purchases a collection of *Star Wars* movie images. In the example above, the artist arranged the images in order to create an independent embodiment of one of the artist’s own copyrighted works. Had the artist, instead, intentionally arranged the images in order to resemble a copyrighted work, such as an image of a popular character from *Star Wars*, then the resulting collage would be a derivative work of the copied *Star Wars* image. In this case, the resultant collage would meet the third “based upon” requirement—evidence of copying.

b. Section 101 also implies evidence of copying. Until this point, only Section 106(2)—which defines an infringing derivative work, by

224. Although this collage is not a derivative work of the component images, it is a derivative work of the artist’s own copyrighted image. Of course, if the artist reproduced the individual images by printing the collage, the artist would have infringed the copyrights of the owners of the component images.

negative implication, as an unauthorized work based upon a copyrighted work—has been addressed. The Copyright Act, however, expressly defines a “derivative work” in Section 101, as follows:

A “derivative work” is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a “derivative work.”²²⁵

Similar to Section 106(2), this definition repeats the “based upon” requirement. In addition, the Section 101 definition adds two lists of nonexhaustive examples, as well as a catchall phrase, in order to further clarify what it means for one work to be based upon another work. If the phrase “based upon” indeed implies evidence of copying, as advocated in Part IV.A.2.a, then the listed examples of works that are “based upon” other works, as well as the catchall phrase, must all be capable of being created as the result of some form of copying—that is, the intentional multiplication of embodiments of an original work.

Beginning with the first list, little explanation is required to demonstrate that translations, musical arrangements, dramatizations, fictionalizations, motion picture versions, sound recordings, and art reproductions intentionally multiply embodiments of original expression—that is, copy. For instance, a translation is, by definition, an intentional multiplication of an embodiment of the original text into a new language. Similarly, a sound recording is an intentional multiplication of an embodiment of a live musical performance into a reproducible medium. In each case, the resultant derivative work is based upon the preexisting work from which it was copied. It is difficult to hypothesize creating any of the above examples without some form of copying.

The inclusion of abridgments and condensations, however, requires a more searching explanation. Arguably, abridgments and condensations may be created without any copying. For instance, a secondhand bookseller might excise with a thick, black marker certain lengthy portions of popular novels, marketing these excised copies as “abridged”

225. 17 U.S.C. § 101 (2000).

or “condensed” versions. Thus, the may statute include abridgments and condensations that are the result of alteration, rather than of copying.

Several observations suggest, however, that the statute refers to copy-based, rather than alteration-based, abridgments and condensations. First, most commercially produced abridgments and condensations are distributed as stand-alone copies of the abbreviated versions, not as excised copies of the original. The statutory definition, therefore, likely refers to these kinds of abridgments and condensations. In response, it might be argued that it would be unnecessary to include these stand-alone abridgments and condensations in the list of example derivative works because the reproduction right would protect authors against the reproduction of those portions of an original text that were included in abbreviated versions. By implication, it might further be argued that the statutory definition, therefore, specifically contemplated noncopying abridgments and condensations—created by means of direct alteration—in order to extend protection beyond the limits of the reproduction right.

This argument, however, ignores the fact that many, if not most, abridgments and condensations require rewritten, and even additional, text in order to transition over the excised portions.²²⁶ Abridging or condensing works requires much more effort than merely reproducing those portions of the text that are chosen for abbreviated versions, including effort to rewrite the style, organization, and content of sentences, paragraphs, and chapters. If a certain event or character is excised in the process of abbreviation, then any reference to that event or character must be removed from all of the otherwise unmolested portions of the text. This may require extensive rewriting in order to make the omission unnoticeable. In each case that the abridgment or condensation rewrites original text, the abridgment or condensation must necessarily copy the style, organization, and content of the original text.

Having observed that abridgments and condensations require significant rewriting, it is reasonable to conclude that the reproduction right protects against the unauthorized copying of *intact portions* of a text, and that the derivative right protects against the unauthorized copying of *style, organization, and content* of a text. Accordingly, the inclusion of abridgments and condensations under the derivative right

226. Admittedly, no attempt is made here to prove this point by way of evidence, not even anecdotal; instead, the argument is based on hypothesizing the necessary steps in the process of abridgment or condensation.

does not infer that the definition of derivative right includes noncopying alterations. Consistent with common practice, the preparation of abridgments and condensations typically requires evidence of copying.

Similarly, the inclusion of the broad, catchall phrase—“any . . . form in which a work may be recast, transformed, or adapted”—does not infer that the derivative right includes noncopying alterations because works may be “recast,” “transformed,” or “adapted” as a result of copying. In fact, with regards to the term “recast,” it appears that only copying alterations would fit the description. Derived from the process of casting or molding, the term “recast,” in the copyright context, suggests creating a new work from the copied cast or mold of a preexisting work. Indeed, it is difficult to imagine how a work could be “recast” without some evidence of copying.

The terms “transformed” and “adapted,” however, may be interpreted to include both copying and noncopying alterations. Admittedly, these terms are commonly used without connoting any concept of copying. For instance, a child might adapt a bicycle helmet for use with a Halloween costume by attaching various decorative embellishments. Similarly, a family might transform their garage into a guestroom by painting and adding carpet. In both cases, the described alteration required no element of copying. The terms “adapt” and “transform,” however, may also be used to indicate copying alterations. For instance, a musician might adapt a piece of music by rewriting it for a different set of voices and/or instruments. Similarly, an artist might transform a watercolor painting by repainting it with oils. In both cases, the described activity required the intentional multiplication of embodiments of the original work—that is, copying.

Apparently, the potentially broad application of the terms “transformed” and “adapted” has formed the primary basis for interpreting the derivative right to include noncopying alterations.²²⁷ Interpreting “transformed” and “adapted” broadly, however, ignores the “based upon” requirement. The 1976 Copyright Act did not define derivative works to be any work that “recast, transformed, or adapted” a previous work; rather, the Act defined derivative works to be works that are *based upon* preexisting works in such a way that the resulting work “recast, transformed, or adapted” the preexisting work. Thus, although

227. For a detailed description of how some courts have arrived at the conclusion that noncopying alterations infringe the derivative right, see Part III.B.

the terms “transformed” and “adapted” might be interpreted to include certain noncopying alterations, such alterations are not based upon preexisting works. With reference to the above examples, a bicycle helmet adapted for use with a Halloween costume is not *based upon* the original, unaltered helmet—it *is* that helmet, albeit adapted for another use with decorative attachments. Similarly, a garage that is transformed into a guestroom is not *based upon* the original, unaltered garage—it *is* that garage, albeit transformed with the addition of paint and carpet.

Stated simply, the catchall phrase in the Section 101 definition is only as broad as the interpretation of the “based upon” requirement. In other words, the catchall phrase must be interpreted in light of the “based upon” requirement. The inclusion of the broad, catchall phrase, therefore, does not infer that derivative works include noncopying alterations. Interpreting the catchall phrase to be limited to instances of copying is internally consistent because each of the terms in the catchall phrase may refer to activities requiring copying. Thus, interpreting the phrase “based upon” to require evidence of copying—as advocated in Part IV.B.2.a—is not inconsistent with the first list of examples and the accompanying catchall phrase in the Section 101 definition of “derivative work.”

Interpreting “based upon” to require some form of copying is also consistent with the second list of examples in the Section 101 definition, though the point is more subtle. The second sentence of the definition lists editorial “revisions,” “annotations,” and “elaborations” as examples of derivative works, with the condition that these editorial modifications are sufficiently original when taken as a whole. At first glance, copying does not appear to be an element of any of these examples. Moreover, the definition continues, listing “other modifications, which as a whole, represent an original work of authorship” as examples of derivative works. Because originality is partly defined as the absence of copying,²²⁸ the second list appears to expressly contemplate noncopying modifications to be within the scope of the derivative right. From this initial perspective, the interpretation of “based upon” as requiring evidence of copying appears to be in jeopardy. Upon closer examination, however, editorial “revisions,” “annotations,” and “elaborations” likely require some form of copying, and the broad phrase “other

228. See *Feist Publ'ns, Inc. v. Rural Tel. Co.*, 499 U.S. 340, 345 (1991). The other element is a modicum of creativity. *Id.*

modifications” should be interpreted in light of these examples to include only copying modifications.

Editors do not edit from scratch. Editorial revisions, much like rewritten sentences from abridgments and condensations, likely copy the style, organization, and content of the original text. Similarly, editorial annotations and elaborations depend upon the original text for context. These annotations and elaborations likely copy portions of the original text in order to transition into the new material being added or to refer to the original. The physics solutions at issue in *Addison-Wesley Publishing Co. v. Brown*²²⁹ provide a helpful example. Editorial annotations and elaborations likely paraphrase the original texts that they complement in a similar fashion that the physics solutions in *Addison-Wesley* paraphrased the original problems.²³⁰ Admittedly, some annotations and elaborations may not paraphrase or otherwise copy the texts that they complement, resting instead as freestanding additions to the original texts. These annotations and elaborations, however, are not properly described as *editorial*.²³¹ Thus, each of the three enumerated examples of editorial modifications likely requires some form of copying. Because the context of “other modifications” suggests that the broad phrase refers to other *editorial* modifications, any elements common to the three enumerated examples are reasonably imputed to the interpretation of the otherwise open-ended phrase. Accordingly, the phrase “other modifications” should be interpreted to include only copying modifications, as the three enumerated examples all include an element of copying.

In summary, the definition of “derivative work,” found in Section 101 of the Copyright Act, is consistent with interpreting the phrase “based upon” to signify the existence of copying. In other words, the Section 101 definition of “derivative work” is consistent with requiring

229. 223 F. Supp. 219 (E.D.N.Y. 1963).

230. For more on *Addison-Wesley*, see notes 54–57.

231. If this distinction is judged to be too fine, there is another way to reconcile the second sentence of the “derivative work” definition with an interpretation of “based upon” that requires evidence of copying. It may be the case that the first sentence defines the “based upon” derivative works, and that the second sentence defines a very narrow category of editorial modifications that may include noncopying alterations, such as annotations and elaborations that are completely independent of the original text. This interpretation does not disturb the general conclusion of this Comment—that noncopying alterations do not prepare infringing derivative works—but rather crafts a very narrow exception for certain noncopying editorial modifications.

evidence of copying before finding infringement of the Section 106(2) derivative right.

B. Application to Controversies

Although holding noncopying alterations not to infringe the derivative right is contrary to at least two federal appellate court precedents,²³² those decisions are either much maligned, generally misunderstood, and/or directly in conflict with the holdings of other circuits. Thus, requiring evidence of copying does not require a significant course change in federal case law. Even more importantly, this requirement would result in more consistent and predictable outcomes for present and future litigation over noncopying alterations, avoiding the need for narrow legislative exemptions, such as the Family Movie Act of 2005.²³³ This Section first examines each of the two federal appellate court decisions that squarely hold examples of noncopying alterations to infringe the derivative right, demonstrating that neither holding merits continued deference. This Section then examines how the video-filtering controversy might have been resolved without congressional intervention, which appears to have been initiated as a direct result of the contradictory case law surrounding noncopying alterations.

I. Mirage Editions, Inc. v. Albuquerque A.R.T. Co.

If, as advocated in this Comment, evidence of copying is required to prove infringement of the derivative right, then *Mirage Editions, Inc. v.*

232. The Ninth Circuit holding in *Micro Star v. Formgen, Inc.*, 154 F.3d 1107 (9th Cir. 1998), may also be subject to review. Because the facts relevant to a determination of copying are difficult to discern from the opinion, a detailed discussion of the case is omitted here. Briefly, the question is whether the user-built MAP files—which contained instructions for building video-game levels comprising copyrighted images from the source art library—copied any of the plaintiff's distributed video-game level designs. From one perspective, the MAP files contain only reference and index information that does not copy any of the plaintiff's expression. From another perspective, however, the MAP files are sufficiently detailed—and the user-built levels sufficiently similar to the distributed, proprietary game levels—such that the user-built MAP files copy the style, structure, and organization of the original game levels. Because the Ninth Circuit did not specifically address the issue of copying to arrive at its decision, the description of the facts does not provide sufficient detail to determine whether any copying occurred—that is, whether the game users' personal game levels copied the game manufacturer's originally distributed game levels. For more on *Micro Star*, see *supra* notes 116–118 and accompanying text.

233. Pub. L. No. 109-9, §§ 201–202, 119 Stat. 218, 223–24 (to be codified at 17 U.S.C. § 110, 15 U.S.C. § 1114).

*Albuquerque A.R.T. Co.*²³⁴ and its progeny should be disavowed. As demonstrated by the following, many courts and commentators have already criticized *Mirage*; their reasons, however, are not consistent. If courts require evidence of copying before finding infringement of the derivative right, then *Mirage* and its progeny may be safely disavowed on a consistent basis.

Of all the noncopying, static alteration decisions, *Mirage* is the most heavily criticized by courts²³⁵ and commentators²³⁶ alike. Critics generally agree that the holding of *Mirage*—that is, that affixing lawfully purchased copies of a work onto ceramic tiles creates derivative works of that work—interprets the derivative right much too broadly, opening the door, as one court described, “for the most trivial of modifications to generate an infringing derivative work.”²³⁷ If, as *Mirage* held, permanent affixation to ceramic tile creates a “new version” of the original work, then any permanent alteration to a copy of a work would create a derivative work, including, for example, framing, cropping, or labeling.²³⁸ Although such alterations, arguably, “transform” the work, it

234. 856 F.2d 1341 (1988). For more on *Mirage*, see *supra* notes 72–77.

235. See, e.g., *Lee v. A.R.T. Co.*, 125 F.3d 580, 581–82 & n.1 (7th Cir. 1997) (disagreeing with *Mirage* and describing scholarly disapproval as “widespread”), *aff’g*, *Lee v. Deck the Walls, Inc.*, 925 F. Supp. 576, 578–79 & n.2 (N.D. Ill. 1996) (declining to follow *Mirage* and citing scholarly disapproval); *Precious Moments, Inc. v. La Infantil, Inc.*, 971 F. Supp. 66, 68–69 (D. Puerto Rico 1997) (declining to follow *Mirage* and citing judicial and scholarly disapproval); see also *Paramount Pictures Corp. v. Video Broad. Sys., Inc.*, 724 F. Supp. 808, 821 (D. Kan. 1989) (distinguishing *Mirage* and holding no infringement for noncopying affixation of advertisements to videocassette tape).

236. See, e.g., 2 GOLDSTEIN, *supra* note 67, § 5.3, at 5:84 to :84-1; 1 NIMMER & NIMMER, *supra* note 8, § 3.03[B][1], at 3-16 to -17; WILLIAM F. PATRY, *COPYRIGHT LAW AND PRACTICE* 823–24 (1994), cited in *Lee*, 125 F.3d at 582; Wendy J. Gordon, *On Owning Information: Intellectual Property and the Restitutionary Impulse*, 78 VA. L. REV. 149, 255 n.401 (1992).

237. *Precious Moments*, 971 F. Supp. at 69.

238. See, e.g., *Lee v. A.R.T. Co.*, 125 F.3d 580, 582 (7th Cir. 1997) (“We asked at oral argument what would happen if a purchaser jotted a note on one of the note cards, or used it as a coaster for a drink, or cut it in half, or if a collector applied his seal (as is common in Japan); Lee’s counsel replied that such changes prepare derivative works, but that as a practical matter artists would not file suit.”). The Seventh Circuit further observed, “A definition of derivative work that makes criminals out of art collectors and tourists is jarring despite Lee’s gracious offer not to commence civil litigation.” *Id.*

Whether tile art is akin to framing has been a topic of much debate. In *Muñoz v. Albuquerque A.R.T. Co.*, 829 F. Supp. 309 (D. Alaska 1993) (defendant art company mounted plaintiff’s copyrighted works onto ceramic tiles), *aff’d*, 38 F.3d 1218 (9th Cir. 1994) (unpublished opinion), the district court distinguished tile art from framing on the basis that framing is merely “a method of display,” which was easily reversible. *Id.* at 314. The Seventh Circuit found such reasoning to be “a distinction without a difference” and, moreover, refuted the conclusion that “normal means of

is doubtful that Congress intended, in the words of the Seventh Circuit, “[to] make[] criminals out of art collectors and tourists.”²³⁹

Although many courts and commentators agree that the derivative right should be interpreted to eliminate the kind of alteration at issue in *Mirage* from the scope of the derivative right, critics of *Mirage* have not agreed on the appropriate “limiting doctrine.”²⁴⁰ Some commentators conclude that the creation of tile art is not an infringing derivative work because the alteration is not sufficiently original.²⁴¹ Beginning from the assumption that a derivative work must be copyrightable in order to infringe, these commentators conclude that the affixation of art works to ceramic tiles constitutes insufficient original expression, one of the requirements for a work to be copyrightable, and, therefore, conclude that tile art is not an infringing derivative work.²⁴² Some commentators, however, disagree that a work must be copyrightable in order to infringe.²⁴³

Distinguishing infringing and noninfringing works on the basis of originality, however, leads to counterintuitive results. If only original

mounting and displaying art are easily reversible.” *Lee*, 125 F.3d at 581. Prominent commentators likewise find little difference between tile art and traditional picture framing. *See, e.g.*, 2 GOLDSTEIN, *supra* note 67, § 5.3, at 5:84 to :84-1; 1 NIMMER & NIMMER, *supra* note 8, § 3.03[B][1], at 3-16 to -17.

239. *Lee*, 125 F.3d at 582.

240. The term “limiting doctrine” is borrowed from Lydia Pallas Loren, *The Changing Nature of Derivative Works in the Face of New Technologies*, 4 J. SMALL & EMERGING BUS. L. 57, 62–63 (2000) (“Recognizing that almost all works are, in a broad sense, based upon preexisting works, courts have attempted to confine the application of the derivative work right through limiting doctrines, including requiring the work either to be substantially similar to the copyrighted work or to substantially incorporate protectable material from the underlying work.” (internal citation omitted)). Although Professor Loren’s article only addresses dynamic alterations, the description of courts’ attempts to reign in the definition of the derivative right applies generally to all derivative rights cases, including static alterations.

241. *See, e.g.*, 1 NIMMER & NIMMER, *supra* note 8, § 3.03[B][1], at 3-16 to -17.

242. *Id.*

243. The Seventh Circuit, in *Lee v. A.R.T. Co.*, 125 F.3d 580 (7th Cir. 1997), noted the apparently equally divided debate, and deliberately sidestepped it. *Id.* at 582. Finding the question unnecessary to the resolution of the case, the court rested its decision on the fact that the tile art process does not “transform” the original work because the resultant tile art “still depicts exactly what it depicted” before affixation. *Id.* *Lee*, however, is internally inconsistent. In discussing hypothetical examples raised during oral argument, *Lee* implied that writing on a work, cutting a work in half, or applying a seal to the face of work should all be permissible alterations. *Id.* Each of these alterations, however, arguably transforms that work, under the reasoning of *Lee*, because, in each case, the altered work no longer “depicts exactly what it depicted” before the alteration. *Lee*’s holding, therefore, is unworkable.

alterations are found infringing, there is no incentive for investing in original expression, the very purpose of copyright. This result is best observed by way of example. It is generally agreed that framing an artwork does not prepare an infringing derivative work. Advocates of limiting the derivative right on the basis of originality would argue that a simple frame does not add sufficient expression to amount to the preparation of a derivative work. Should a more creative and, therefore, original frame, however, be prohibited as an infringing derivative work? If, instead of using a simple framing technique, a subsequent artist framed and matted another artist's work in an elaborate and expressive manner, should the subsequent artist be prohibited from adding original expression? Public policy answers this question in the negative. In accordance with the fundamental purpose of copyright, the addition of original expression should not be discouraged unless preexisting expression is copied in the process.

Instead of attempting to limit the derivative right on the basis of lack of originality, courts and commentators should recognize the most fundamental purpose of copyright to be the prevention of unauthorized *copying*—that is, the unauthorized, intentional multiplication of embodiments of a protected work. Regardless of whether an alteration is sufficiently original, it should not be infringing unless it copied the original work. Although the Seventh Circuit, in *Lee v. A.R.T. Co.*,²⁴⁴ did not rest its holding on the requirement for evidence of copying, the court succinctly observed the underlying economic basis for such a requirement:

Because the artist could capture the value of her art's contribution to the finished product as part of the price for the original transaction, the economic rationale for protecting an adaptation as 'derivative' is absent. An alteration that includes (or consumes) a complete copy of the original lacks economic significance.²⁴⁵

Affixation to ceramic tile is, in essence, an alternative display or configuration of a work. As described in Part IV.A.2.a(1), alternative displays and configurations are not *based upon* preexisting works—they *are* those works. A work that has been altered, by affixing it to a ceramic backing, is not *based upon* that work—it *is* that work, albeit in a different

244. 125 F.3d 580 (7th Cir. 1997). For more on the precise holding of *Lee*, see *supra* note 243.

245. *Id.* at 581 (internal citation omitted) (citing William M. Landes & Richard A. Posner, *An Economic Analysis of Copyright Law*, 17 J. Legal Stud. 325, 353–57 (1989)).

format. Similarly, a picture in a frame is not *based upon* that picture—it *is* that picture, albeit surrounded by a frame. Requiring evidence of copying affords an everyday, commonsense meaning to the definition of an infringing derivative work as a work based upon preexisting works. Because tile art is not based upon the preexisting artwork that is affixed to the tile, tile art does not prepare infringing derivative works. *Mirage*, therefore, should be disavowed.

2. Midway Manufacturing Co. v. Artic International, Inc.

In contrast to the widespread criticism of *Mirage Editions, Inc. v. Albuquerque A.R.T. Co.*,²⁴⁶ courts and commentators have generally accepted the holding in *Midway Manufacturing Co. v. Artic International, Inc.*²⁴⁷ This result is odd because both *Mirage* and *Artic* adopt the same underlying holding that the derivative right prohibits even noncopying alterations. The disparity likely arises from a misunderstanding of the facts at issue in *Artic*. At least one decision, *Lewis Galoob Toys, Inc. v. Nintendo of America, Inc.*,²⁴⁸ has characterized *Artic* as addressing *copying* alterations. Similar to the “Galaxian” circuit boards at issue in *Artic*, the Game Genie in *Lewis Galoob Toys* speeded up the play of the plaintiff’s video game.²⁴⁹ *Lewis Galoob Toys*, however, distinguished the infringing “Galaxian” circuit boards in *Artic* from the noninfringing “Game Genie” because the “Galaxian” circuit boards: (1) copied the original boards, (2) replaced—and, therefore, supplanted demand for—the original boards, and (3) were offered for use by the general public.²⁵⁰ The first distinction is factually incorrect, and the latter two are without difference.

First, although *Artic* did not address in its discussion the differences between the defendant’s two sets of circuit boards, a careful reading of the facts indicates that the “Pac-Man” circuit boards copied an original work, while the “Galaxian” circuit boards did not. In explaining the facts, the court wrote:

246. 856 F.2d 1341 (9th Cir. 1988). For more on the criticism of *Mirage*, see *supra* notes 235–236 and accompanying text.

247. 704 F.2d 1009 (7th Cir. 1983) (defendant manufactured replacement circuit boards to speed up plaintiff’s video game).

248. 964 F.2d 965 (9th Cir. 1992).

249. *Id.* at 969. For more on *Artic*, see *supra* notes 90–95 and accompanying text. For more on *Lewis Galoob Toys*, see *supra* notes 108–115 and accompanying text.

250. *Lewis Galoob Toys*, 964 F.2d at 969.

Defendant sells printed circuit boards for use inside video game machines. One of the circuit boards defendant sells speeds up the rate of play—how fast the sounds and images change—of “Galaxian,” one of plaintiff’s video games, when inserted in place of one of the “Galaxian” machine’s circuit boards. Another of defendant’s circuit boards stores a set of images and sounds almost identical to that stored in the circuit boards of plaintiff’s “Pac-Man” video game machine so that the video game people play on machines containing defendant’s circuit boards looks and sounds virtually the same as plaintiff’s “Pac-Man” game.²⁵¹

Thus, *Lewis Galoob Toys* incorrectly confused the “Galaxian” boards, which merely speeded-up game play, with the “Pac-Man” boards, which stored “a set of images and sounds almost identical to that stored in the circuit boards of plaintiff’s ‘Pac-Man’ video game machine.”²⁵² The “Pac-Man” boards plainly copied, whereas the “Galaxian” boards merely altered. At least one respected commentator has repeated *Lewis Galoob Toys*’ misunderstanding of the facts.²⁵³

This distinction, however, is crucial. Finding the “Pac-Man” circuit boards to be infringing was an uncontroversial application of copyright to protect the “look” and “sound” of the plaintiff’s audiovisual work.²⁵⁴ These circuit boards *copied* the plaintiff’s work by storing and generating “a set of images and sounds almost identical to that stored in the circuit boards of the plaintiff’s ‘Pac-Man’ video game machine.”²⁵⁵ In stark contrast, finding the “Galaxian” circuit boards to be infringing was a novel extension of copyright to protect *mere alterations* to copyrighted works even absent evidence of copying. The “Galaxian” circuit boards did not store any of the plaintiff’s copyrighted images or sounds. Instead, the boards speeded up the rate of play—“how fast the sounds and images change.” Because these boards merely interacted with, and did not recreate, the plaintiff’s video game, the “Galaxian” boards did not *copy* the plaintiff’s work. Instead, the “Galaxian” boards temporarily altered already existing copies of the plaintiff’s work during real-time game play. In the language of the Copyright Act, a speeded-up video game is

251. *Artic*, 704 F.2d at 1010.

252. *Id.* at 1010–11.

253. *See, e.g.*, 2 NIMMER & NIMMER, *supra* note 8, § 8.03[B][1], at 3-16 to -17.

254. *See supra* note 92.

255. *Artic*, 704 F.2d at 1010–11.

not *based upon* that game—it *is* that game, albeit configured in real-time to play differently.

In addition to distinguishing *Artic* on the grounds of copying, *Lewis Galoob Toys* also distinguished *Artic* because the “Galaxian” circuit boards replaced the plaintiff’s boards and because these boards, along with the rest of the arcade game, were offered for general use by the public. Both distinctions are correct, but without difference.

Unlike the separately installable Game Genie, the “Galaxian” boards replaced the original boards and, to a limited degree, supplanted demand for the plaintiff’s boards.²⁵⁶ The court gives no reason, however, to explain why replacement parts, as opposed to purely complementary parts, are infringing derivative works. If the replacement parts *copied* protected expression from the original part, then copyright should prohibit this multiplication of expressive content. The “Galaxian” boards, however, contained no copyrighted images or sounds; these boards merely replaced boards that affected how fast the copyrighted sounds and images, presumably stored on other circuit boards, appeared during game play. If every altered display of a copyrighted work were found to be infringing, the consequences would be far reaching, implicating perhaps even fast-forward and rewind operations for home video players. Moreover, the Copyright Act makes no such distinction between replacement and complementary parts. A work that is not *based upon* a preexisting work is not a derivative work, regardless of whether it replaces component parts that generate audiovisual works, even if such replacements supplant demand for original parts. The same reasoning applies to the attempt of *Lewis Galoob Toys* to distinguish *Artic* on the basis that the arcade game in *Artic* was offered for general public use. The Copyright Act does not distinguish between public and private uses. A work that is not *based upon* a preexisting work is not a derivative work, regardless of whether the work is offered for general public use.

In summary, *Lewis Galoob Toys* acknowledged *Artic*’s holding based on an erroneous understanding of facts. Upon careful comparison

256. Only demand for replacement parts was supplanted. Consumers of the defendant’s enhancement kit must have previously purchased the entire video arcade unit from the plaintiff. Conceivably, if the original circuit board needed replacement, a video arcade operator might have been persuaded to purchase the enhancement kit in lieu of purchasing an original replacement board from the plaintiff. This scenario seems unlikely. It is more probable that video arcade owners replaced completely functional boards with the enhancement kit boards. Thus, the “Galaxian” boards are virtually indistinguishable from the Game Genie because the enhancement kits operate as purely complementary devices that may even augment demand for the original work.

of the facts of the two cases, *Lewis Galoob Toys* appears to be in direct conflict with *Artic*. Based on the requirement of copying for infringement, *Lewis Galoob Toys* should be followed, and *Artic* should be disavowed. Had *Lewis Galoob Toys* not erred in distinguishing *Artic*, it might have directly addressed whether evidence of copying is necessary to find infringement of the derivative right. As such, it might have also concluded, in the words of the Copyright Act, that altered video games are not *based upon* the unaltered games—they *are* the unaltered games, albeit configured in real-time to play differently. Instead, *Lewis Galoob Toys* reached its decision by reasoning that the Game Genie did not “incorporate” a portion of the copyrighted work.²⁵⁷ To avoid an inconsistent result with *Lewis Galoob Toys*, future courts requiring evidence of copying before finding infringement of the derivative right could interpret “incorporate” to mean copy.

3. Home-Video Filtering and the Family Movie Act of 2005

If courts interpret the Copyright Act to require evidence of copying in order to establish infringement of the derivative right, narrowly drafted amendments to the Copyright Act, such as the Family Movie Act of 2005,²⁵⁸ would be unnecessary. Of all the noncopying-alteration controversies, home-video editing/filtering has likely attracted the most media attention, including features in popular newspapers,²⁵⁹ radio programs,²⁶⁰ and television programs.²⁶¹ Additionally, legal professionals²⁶² and students²⁶³ have already devoted significant

257. *Lewis Galoob Toys*, 964 F.2d at 967–69.

258. Pub. L. No. 109-9, §§ 201–202, 119 Stat. 218, 223–24 (to be codified at 17 U.S.C. § 110, 15 U.S.C. § 1114).

259. See, e.g., Michael Janofsky, *Utah Shop Offers Popular Videos with the Sex and Violence Excised*, N.Y. TIMES, Jan. 31, 2001, at A11(1).

260. See, e.g., John Ydstie & Jacki Lyden, *Clean Flicks' Lawsuit Against 16 A-List Directors*, ALL THINGS CONSIDERED, Sept. 16, 2002.

261. See, e.g., Matt Lauer, *Ray Lines, Owner of CleanFlicks, and Screenwriter Joe Eszterhas Discuss Editing Sex, Violence, and Profanity from Rental Movies*, TODAY, Feb. 1, 2001.

262. See, e.g., Matthew S. Bethards, *Can Moral Rights Be Used To Protect Immorality?: Editing Motion Pictures To Remove Objectionable Content*, 3 VA. SPORTS & ENT. L.J. 1 (2003) (focusing exclusively on video editing); Ochoa, *supra* note 151, at 1033–44 (discussing, *inter alia*, home-video editing).

263. See, e.g., Nicole Griffin Farrell, Comment & Note, *Frankly, We Do Give a . . . Darn! Hollywood's Battle Against Unauthorized Editing of Motion Pictures: The "CleanFlicks" Case*, 2003 UTAH L. REV. 1041 (addressing both trademark and copyright claims in the “CleanFlicks” case); Michael P. Glasser, Note, *“To Clean or Not To Clean”: An Analysis of the Copyright and*

attention to home-video editing/filtering, even though no court has made a substantive ruling on the issue. Although other alterations to copyrighted works have evoked the ire of the respective copyright holders,²⁶⁴ no controversy has approached the intensely emotional debate surrounding video editing/filtering; professionals in the film industry have accused video editors/filterers of “stealing,”²⁶⁵ of “vandalism,”²⁶⁶ and even of “creative terror[ism].”²⁶⁷ Owing, at least in part, to the hostile response to their business practice, a franchisee of the popular video-editing company, CleanFlicks, filed a preemptory strike against sixteen Hollywood directors, requesting a declaratory judgment upholding their video-editing practice.²⁶⁸ In response, the Directors Guild of America and a group of the largest motion picture studios countersued the entire video-editing industry, including in the lawsuit other parties that utilized video-filtering technologies. Video editors and

Trademark Issues Surrounding the Legal Battle Between Third Party Film Editors and the Film Industry, 22 CARDOZO ARTS & ENT. L.J. 129 (2004) (discussing both trademark and copyright claims in the “CleanFlicks” case); Ashley Kerns, Note and Comment, *Modified To Fit Your Screen: DVD Playback Technology, Copyright Infringement or Fair Use?*, 24 LOY. L.A. ENT. L. REV. 483 (2004) (focusing exclusively on noncopying video filtering); Christina Mitakis, Note, *The E-Rated Industry: Fair Use Sheep or Infringing Goat?*, 2004 VAND. J. ENT. L. & PRAC. 291 (focusing on whether video editing is a fair use of the copyrighted movies); Nikki D. Pope, Comment, *Snipping Private Ryan: The Clean Flicks Fight To Sanitize Movies*, 20 SANTA CLARA COMPUTER & HIGH TECH. L.J. 1045 (2004) (focusing on the copyright and trademark claims in the “CleanFlicks” case); Laura Jeanne Monique Silvey, Comment, *Cutting Out the “Good” Parts: The Copyright Controversy over Creating Sanitized Versions of VHS/DVD Movies*, 2004 SW. U. L. REV. 419 (focusing on copyright issues surrounding home-video editing); Philip Vineyard, Comment, *“No One Expects the Spanish Inquisition”—Twice: Subduing the Moral Rights Monster*, 6 TUL. J. TECH. & INTEL. PROP. 223 (2004) (discussing moral rights in the context of video filtering).

264. For example, the plaintiff in *Muñoz v. Albuquerque A.R.T. Co.*, 829 F. Supp. 309 (D. Alaska 1993) (defendant art company mounted plaintiff’s copyrighted works onto ceramic tiles), *aff’d*, 38 F.3d 1218 (9th Cir. 1994) (unpublished opinion), described the appearance of the tile-art as “tacky.” *Id.* at 311 (internal quotation marks omitted).

265. Ray Richmond, *Battle Lines Drawn in War over Who Gets To Say “Cut!”*, DGA MAGAZINE, Nov. 2002, available at http://www.dga.org/news/v27_4/feat_digitalpiracy2.php3 (internal quotation marks omitted) (quoting movie director Michael Mann).

266. Lauer, *supra* note 261 (internal quotation marks omitted) (quoting screenwriter Joe Eszterhas).

267. *Id.* (internal quotation marks omitted) (quoting screenwriter Joe Eszterhas).

268. See Second Amended Complaint at 5–6, *Huntsman v. Soderbergh* (D. Colo. filed Oct. 28, 2002) (No. 02-M-1662), <http://news.findlaw.com/hdocs/docs/copyright/cflixtud102802cmp.pdf>; see also, e.g., Anita Chabria, ‘Clean’ Video Store Publicly Attacks DGA, PR WEEK, Sept. 30, 2002, at 3; Sarah Huntley, *Rental Firm a Cut Above Directors?*, ROCKY MOUNTAIN NEWS, Aug. 30, 2002, at 30A.

video filterers, however, use techniques that should result in different consequences under copyright law.

In the formative years of the industry, video editors simply cut from videocassette tapes those portions with scenes and dialogue deemed objectionable.²⁶⁹ Although video-editing companies, including those who are parties to the pending lawsuit, may have originally practiced this simple form of noncopying, static alteration to videocassette tapes, the movie studio parties have alleged that video editors, including CleanFlicks, currently make a digital copy of the movie, alter that master copy with digital editing programs, and then recopy the edited version onto videocassette tapes or digital video discs.²⁷⁰

Video-filtering companies, however, do not make copies of, but rather make filters for, copyrighted movies. Video filters mask predetermined images and sounds during real-time playback. Filters map each image and sound marked for excision to a particular timing code on a digital video disc. In a sense, the filter is an index of certain images and sounds that are stored on the digital video disc. During real-time playback, the disc reader skips the images and mutes the sounds indexed by the filter.²⁷¹ Similar to video-game components and website-advertising tools, video filters work in conjunction with (or complement) the display of copyrighted works.

As discussed, video editing is a complicated controversy that includes cutting videocassette tape, creating edited versions from digitally altered master copies, and filtering real-time playback of original copies. Viewed through the lens of copying, the video editing/filtering controversy is straightforward. Altered cassette tapes are not *based upon* the movies fixed in the unaltered tapes—they *are* those movies, albeit in an altered condition. If, however, video editors make a digital copy of the movies to make their altered copies, then video editors most likely infringe the reproduction right.²⁷² Filtered playbacks of

269. See, e.g., Matt Richtel, *For \$5, a Family Video Store Will Cut 2 'Titanic' Scenes*, N.Y. TIMES, Sept. 10, 1998.

270. See Motion Picture Studio Defendants' Answer and Counterclaims at 14–15, *Huntsman v. Soderbergh* (D. Colo. filed Dec. 13, 2002) (No. 02-M-1662), <http://news.findlaw.com/hdocs/docs/copyright/cflixstud121302acc.pdf>.

271. For more on video filtering, see Kerns, *supra* note 263.

272. Video-editing parties may have a defense based on the doctrine of fair use, but this consideration is beyond the scope of this Comment. Because the Family Movie Act of 2005 did not exempt video editing, litigation is still pending against the video-editing parties. See, e.g., Accola, *supra* note 149.

movies, similar to altered cassette tapes, are not *based upon* the unfiltered movies—they *are* those movies, albeit filtered to remove certain content. If courts had consistently required proof of copying to prove infringement of the derivative right, the litigation surrounding video editing/filtering would have been a straightforward examination for evidence of copying. Instead, the outcome of the litigation was uncertain, and Congress specifically intervened to exempt the practice of video-filtering. If courts begin *emphasizing the copy in copyright* by requiring evidence of copying to prove infringement of the derivative right, future intervention by Congress to exempt other noncopying alterations will be unnecessary.

V. CONCLUSION

Since the enactment of the 1976 Copyright Act, an increasing number of plaintiffs have alleged copyright infringement even absent evidence of copying. Although evidence of copying is a well-established requirement for proving copyright infringement in general—affirmed most recently in *Feist Publications, Inc. v. Rural Telephone Service Co.*²⁷³—courts have not directly addressed whether copying is an element to prove infringement of the derivative right. Even in its most narrow reading, *Feist's* holding, which is arguably dictum as applied to the derivative right, should at least be enough for courts to conclude that evidence of copying is presumptively required for the derivative right (which grew out of the reproduction right), leaving it to the Court to further clarify. In addition, the “based upon” requirement in the definition of an infringing derivative work implies that evidence of copying is necessary to prove infringement. Observing that mere altered copies of works (either static or dynamic) are not *based upon* those works—but rather *are* those works—this Comment concludes that noncopying alterations do not prepare infringing derivative works.

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273. 499 U.S. 340 (1991).

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