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PHOTOGRAPHER'S RIGHTS: CASE FOR SUFFICIENT ORIGINALITY TEST IN COPYRIGHT LAW

PATRICIA L. BAADE*

INTRODUCTION

'Origination' versus 'originality,'¹ as standards used to justify granting exclusive rights to sell or reproduce new products and creations, have competed for legal force throughout the history of intellectual property law. While patent law used the *Hotchkiss*² standard of 'originality' for over a century to qualify inventions for a patent, copyright law set no such standards. Justice Douglas, dissenting in *Lee v. Runge*,³ argued that "copyrightability" should apply to copyright as patentability applies to patents because "the constitutional power over copyrights is found in the same clause that governs the issuance of patents."⁴ Justice Douglas further argued that:

No reason can be offered why we should depart from the plain import of this grant of congressional power and apply more lenient constitutional standards to copyrights than to patents. Indeed . . . a copyright may have to meet greater constitutional standards for

* Ms. Baade studied intellectual property law at the University of Virginia Law School. She is a former gallery owner and dealer in fine art photography. This Article is based on a previous work by the author, PATRICIA BAADE, *GUIDE TO CASELAW IN COPYRIGHT: PHOTOGRAPHY* (1996), available from Foto-Galerie, P.O. Box 4706, Charlottesville, Va. 22905.

1. The contrast between these two terms is a matter of degree: the first means to merely "bring into being." *THE AMERICAN HERITAGE COLLEGE DICTIONARY* 1277 (3d ed. 1993). Originality is "[t]he quality of being original." *Id.* Original is defined as "[p]receding all others in time; not derived from something else; fresh and unusual." *Id.* at 1276.

2. *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248 (1850). The Court invalidated *Hotchkiss*' patent for lack of "invention," reasoning as follows:

Unless more ingenuity and skill . . . were required . . . than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitute essential elements of every invention. In other words, the improvement is the work of the skillful mechanic, not that of the inventor.

Id. at 267.

3. 404 U.S. 887 (1971).

4. *Id.* at 888 (Douglas, J., dissenting).

validity than a patent. The limitations set forth in *Graham v. John Deere Co.*, [383 U.S. 1 (1966)] therefore, apply with at least equal force to copyrights.⁵

Naturally, court opinions on the issue of originality have ranged widely and produced inconsistent results. Since the Copyright Act of 1976,⁶ principles of both property and contract law guide most courts in settling disputes over rights to copy. The value of fine art and its copyrightability, unlike that of commercial work, derives not only from ownership rights to the art object or from reproduction rights to the subject depicted, in the case of commissioned works, but also from the creative expression unique to its maker.

The cases surveyed in the author's GUIDE TO CASELAW IN COPYRIGHT: PHOTOGRAPHY⁷ show a variety of approaches to analyzing originality in copyrighted expression in photography generally. Rights to control the reproduction and dissemination of photographic images depend on which of three faces of the copyright the court will focus on: the photograph, the subject photographed, or the photographer. Rights to the object photograph can be preserved under property law; rights of the subject or owner of the subject photographed can be preserved under contract law; and all other work, in the absence of contract or property rights of others, is controlled by the photographer who created the image. To the degree that the photographer's expression is creative and is his own discovery, the constitutional mandate provides for exclusive rights to those authors and inventors. All other work belongs in the public domain. Most courts surveyed here deemed expression to be the equivalent of authorship and, failed to validate the photographs at issue for originality, as measured by aesthetics.

The U.S. Supreme Court has addressed the question several times whether all photography, artistic straight photography as well as documentary or commercial works, qualifies for copyright protection. Judge Wyatt, in *Time, Inc. v. Bernard Geis*,⁸ traced the history of those decisions and found a variety of opinions on this issue. In *Burrow-Giles Lithographic Co. v. Sarony*,⁹ the Court distinguished portraiture, the genre of the disputed work, from "the ordinary production of a photograph," which, in Judge Wyatt's

5. *Id.* at 890 (Douglas, J., dissenting) (citing *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 59 (1884) (citations omitted)).

6. 17 U.S.C. § 201 (1994).

7. PATRICIA L. BAADE, GUIDE TO CASELAW IN COPYRIGHT: PHOTOGRAPHY (1996).

8. 293 F. Supp. 130, 141-42 (S.D.N.Y. 1968).

9. 111 U.S. 53 (1884).

opinion, "left open whether an ordinary photograph of a real life object could constitutionally be a proper subject of copyright."¹⁰ Judge Wyatt also noted that in *Bleistein v. Donaldson Lithographing Co.*,¹¹ the Court found it "obvious" that the result could not be affected by the fact that the pictures represented "actual groups — visible things" and that such pictures "drawn from the life" [as opposed to a 'composed' subject] could be copyrighted. In this connection the *Bleistein* Court declared: "Others are free to copy the original. They are not free to copy the copy The least pretentious picture has more originality in it than directories and the like, which may be copyrighted."¹²

Consistent with *Bleistein*, Judge Learned Hand, in *Jewelers Circular Publishing Co. v. Keystone Publishing Co.*,¹³ reasoned that:

[N]o photograph, however simple, can be unaffected by the personal influence of the author, and no two will be absolutely alike . . . photographs are protected without regard to the degree of 'personality' which enters into them. At least there has been no case since 1909 in which that has been held to be a condition. The suggestion that the Constitution might not include all photographs seems to me overstrained.¹⁴

Finally, on the other hand, Judge Wyatt noted the dissenting opinion of Justice Brandeis in *International News Service v. Associated Press*,¹⁵ wherein Justice Brandeis, separating artistic from routine documentary photography, stated that the "mere record of isolated happenings, whether in words or by photographs not involving artistic skill, are denied [copyright] protection."¹⁶ Although Judge Wyatt recognized that the *Jewelers* opinion might be the prevailing view at that time, he found that the particular photographs at issue in *Time Inc.* did not qualify for copyright because they lacked expressive content and artistic composition.¹⁷ In the

10. *Time Inc.*, 293 F. Supp. at 141 (citing *Burrow-Giles*, 111 U.S. at 56). Photography did not receive copyright protection until 1865, or 26 years after invention of the process. In *Altman v. New Haven Union Co.*, the court reaffirmed this law. 254 F. 113 (D. Conn. 1918). The court noted "whether [a] photographer is an author, and a photograph a writing, within the constitutional provision under which copyrights may be granted, [the] constitutionality of the [Act of March 3, 1865] was sustained." *Id.* at 117 (citations omitted).

10. U.S. CONST. art. I, § 8, cl. 8.

11. 188 U.S. 239 (1903).

12. *Time Inc.*, 293 F. Supp. at 141 (citing *Bleistein*, 188 U.S. at 249-50).

13. 274 F. 932 (S.D.N.Y. 1921).

14. *Id.* at 934.

15. 248 U.S. 215 (1918).

16. *Id.* at 254 (Brandeis, J., dissenting).

17. *Time Inc.*, 293 F. Supp. at 142-44 (referring to the Abraham Zapruder

more recent court decisions from the 1980s and 1990s that will be examined here, the artistic/non-artistic criteria for copyright set forth in *Time Inc.* was largely ignored.

Photography as a medium of artistic expression is not unlike a novel. Although there have been relatively few cases that turned on photographers' artistic rights to copyrighted photographs, it is well worth pausing to consider those cases that have arisen, and how the courts have addressed the problem of discerning originality in expression in straight photography. The issues one confronts here parallel those found in validating copyright protection in fiction and nonfiction. A fine line exists between fiction and nonfiction. Whereas authors of the former enjoy broad protection under copyright law comparable to free speech, protection for the latter grows increasingly thin. An especially dangerous trend emerges among copyrighted 'factual' works where courts fail to discern the difference between theoretical or propositional works that try to describe our world more completely, and other commercial works that trivialize facts and ideas. The same blurring of the line between creative straight photography and documentary commercial work is found in the cases examined for this article.

Creative straight photography, like nonfictional academic and scientific work, is closer to philosophy than it is to art. It is work based on a belief system, circumstantial evidence, deduction, necessarily lonely and tedious, but, more important for the rest of the world, the explorer producing these works is driven to know what he does not know. The comments made about this kind of photography apply with equal force to copyright protection of both academic and scientific work. The intent and purpose of this kind of work is wholly different from fictional art work in photography or novels, but every bit as creative. It is equally different from nonfictional documentary and commercial works in photography, but every bit as precise and incisive. Though courts know it is not art in the manipulated, fictional sense, many courts have yet to realize that creative straight photography is not nonfiction either, like commercial works found in newsprint and advertising, where skills in the craft apply mostly and where personal expression must be set aside to deliver a specified product. Conversely, most commercial work lacks that degree of creativity found in great, straight art photography.

While commercial work has demonstrable market value and property value, thus making it the most common type of photography at issue in court, on grounds of originality alone—and the courts need go no further—the author will argue, most commercial

pictures of the assassination of President John F. Kennedy).

work does not qualify for copyright protection.

I. CONSTITUTIONAL AND STATUTORY AUTHORITY FOR COPYRIGHT

The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries¹⁸

Originality, though subtle and harder to define than origination, deserves to be recognized uniformly according to predictable standards in order to fulfill the constitutional mandate. Were there to be a standard written into copyright law, comparable to patent law,¹⁹ but closer to the *Hotchkiss* standard,²⁰ straight fine art photography²¹ would pass, whereas most other photography would fail. Although in *Lee v. Runge*,²² Justice Douglas argued that applying the nonobviousness standard of patent law's § 103 would not "invalidate the copyright in the substantial portion of all literary works, where novelty as distinguished from originality is a very rare commodity,"²³ while others have argued a novelty standard would eliminate copyright protection for many useless works.

The Framers of the Constitution provided a constitutional mandate for Congress to grant patents and copyrights to "Authors and Inventors" for "Writings and Discoveries" to protect the individual's exclusive right to sell his work and insure a continuous flow of ideas. In exchange for these exclusive rights, according to this mandate, the would-be author or inventor must demonstrate a contribution to "Science and useful Arts." In qualifying a "simple" photograph for copyright protection under the mandate Gorman explains:

18. U.S. CONST. art. I, § 8, cl. 8.

19. 35 U.S.C. § 103 (1994). In order to receive a patent, an invention must not have been anticipated or have been obvious to one having ordinary skill in the art to which the invention pertains. *Id.*

20. See *supra* note 2 for a discussion of the *Hotchkiss* standard.

21. The Author defines straight fine art photography broadly to include not only that work produced by artists who sell and publish, but also some memorable exceptions from commercial or documentary work, produced with signature style or in a "highly distinctive manner." Examples of the latter include: Irving Penn and Richard Avedon (advertising); Edward Steichen and August Sander (portraiture); Henri Cartier-Bresson and Robert Capa (documentary work). See generally JOHN SZARKOWSKI, *LOOKING AT PHOTOGRAPHS: ONE HUNDRED PICTURES FROM THE COLLECTION OF THE MUSEUM OF MODERN ART* (1973).

22. 404 U.S. 887 (1971).

23. *Id.* at 891 (Douglas, J., dissenting) (citing MELVILLE B. NIMMER, *NIMMER ON COPYRIGHT* § 33 (1971), though noting that Professor Nimmer might have retracted somewhat from this view).

Another reason for granting copyright protection to the simple photograph is the familiar saw which tells us that one picture is worth a thousand words. If it can be as instructive as a lengthily written description of the same scene, a photograph advances our knowledge of the useful arts and sciences, and enhances our understanding of historical occurrences and natural events, just as much as does the written description.²⁴

The Copyright Act of 1976²⁵ codifies the development of common law in copyright throughout this century. The authority to determine the statutory boundaries of copyright is vested in Congress, and it is within these boundaries that intellectual property owners may gain or lose copyright protection. According to the 1976 Act, creative expression becomes "intellectual property," once it is "fixed in any tangible medium of expression."²⁶ The Act measures the value of intellectual property by its value in the market place, as encoded in the Fair Use doctrine.²⁷ The value of commercial work is relatively easy to measure this way, but artistic work is measured differently.

Even in early cases such as *Folsom v. March*,²⁸ the Court declined to recognize exclusive rights for authors under copyright law.²⁹ Writing for the Court, Justice Story described the test for Fair Use as a measure of injury to the plaintiff, stating that "[i]f so much is taken, that the value of the original is sensibly diminished, or the labors of the original author are substantially to an

24. Robert A. Gorman, *Copyright Protection for the Collection and Representation of Facts*, 76 HARV. L. REV. 1569, 1597-98 (1963). See also Stephen Breyer, *The Uneasy Case for Copyright: A Study of Copyright in Books, Photographs, and Computer Programs*, 84 HARV. L. REV. 281 (1970) (arguing that a standard of nonobviousness would not disserve the interests underlying copyright power).

25. 17 U.S.C. §§ 101-914 (1994).

26. *Id.* § 102. In *Altman v. New Haven Union Co.*, 254 F. 113 (D. Conn. 1918), the court, in the context of discussing 'fixing' expression, noted that:

[The photographer] did all of the work necessary to secure a proper negative, from which an acceptable photograph can be made, and which resulted in a pleasing, satisfactory, and, so far as such a production may be, an artistic photograph, at least sufficiently so as to bring it within the realm of those things which may be copyrighted.

Id. at 115 (citations omitted).

27. 17 U.S.C. §§ 107-20. The courts are required to weigh four factors of fair use: (1) the purpose and character of the use, including whether such use is of a commercial nature or is for non-profit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work. *Id.* § 107.

28. 9 Fed. Cas. 342 (C.C.D. Mass. 1841) (No. 4901).

29. *Id.* at 348-49.

injurious extent appropriated by another, that is sufficient, in point of law, to constitute a piracy *pro tanto*.³⁰ In *Time Inc.*,³¹ Judge Wyatt distinguished Fair Use of the patentee from that of the copyright owner, stating that “[u]nlike the owner of a patent (35 U.S.C. § 154), the owner of a copyright is not given by statute (17 U.S.C. § 1) any exclusive right to use the work.”³²

Fair Use doctrine has been considered in three recent Supreme Court decisions: *Stewart v. Abend*,³³ *Harper & Row Publishers, Inc. v. Nation Enterprises*,³⁴ and *Sony Corp. of America v. Universal Studios, Inc.*³⁵ In the recent copyright infringement cases under discussion here, the courts relied on these decisions to varying degrees which affected the results. Relying primarily on *Stewart* and *Sony*, the district court in *Rogers v. Koons*,³⁶ defined Fair Use doctrine as an “equitable rule of reason . . . which permits courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster.”³⁷ However, with reference to *Harper*, another New York district court in *Caratzas v. Time Life, Inc.*,³⁸ noted that Fair Use doctrine favors plaintiffs where, regardless of the amount used, the portion used is “essentially the heart” of the copyrighted work.³⁹

In applying Fair Use doctrine, the ‘heart’ of creative expression, cannot be ‘fixed,’ as it were, the same as for commercial works. The value of creative, innovative products varies with the audience or the times or context in which the product is consumed. Some artistic work may not have material value for a long time after its creation but it may have intangible value as a window-on-the-world, expanding knowledge of the world that can lead to other discoveries. The value of a work, with respect to copyright protection for the artist or creator, depends on how the court interprets the word ‘progress’ in the constitutional mandate. ‘Progress’ in the sense of ‘more is better,’ with its wide array of material gadgets, quite often serves to separate the individual from experiencing life in a meaningful way. ‘Progress’ in the sense of discovery and expanding knowledge is, without exception, worth protecting.

30. *Id.* at 348.

31. *Time Inc. v. Bernard Geis Assoc.*, 293 F. Supp. 130 (S.D.N.Y. 1968).

32. *Id.* at 144.

33. 495 U.S. 207 (1990).

34. 471 U.S. 539 (1985).

35. 464 U.S. 417 (1984).

36. 751 F. Supp. 474 (S.D.N.Y. 1990).

37. *Id.* at 479 (citations omitted).

38. No. CIV. CIV. 92-6346, 1992 WL 322033 (S.D.N.Y. Oct. 23, 1992).

39. *Id.* at *8.

Unlike patent law, the federal court decisions examined here seldom measured copyrightability by the second, intangible standard of 'progress,' but were guided instead by property and contractual rights. In those infringement cases where pre-existing copyrighted material had been used, copyright owners were not required to show improvement over the pre-existing work, only that the work belonged to them. The *Rogers* appellate court decision, for example, described the present day standard of 'originality'⁴⁰ as if it meant 'origination'⁴¹ so that it does not count for much: "The quantity of originality that need be shown is modest—only a dash of it will do."⁴² Unfortunately, applying such a low copyrightability standard for creative work, at issue in this case, leaves some work dealing with 'facts' unprotected, while it protects other, obvious work which does not deserve copyright protection.

II. THREE FACES OF COPYRIGHT

In *CONTESTED CULTURE*,⁴³ Jane M. Gaines outlined three analogies that were drawn initially by the Court in *Burrow-Giles Lithographic Co. v. Sarony*.⁴⁴ The first is between photographers and painters, the second between photographs and prints, and third, the subjects photographed and 'Writings' to find photography worthy of copyright, stating that the "American theorization of original artistry in the photograph . . . is the product of the convergence of at least three analogies: the written composition, the painted canvas, and the printed lithograph."⁴⁵ Thus, photography received copyright protection because the Court analogized it to fine art.⁴⁶ Some may argue Sarony's photograph was commercial work, but that particular portrait was not of that ilk. The photograph communicated a message from the photographer that went

40. See, e.g., *Feist Publications v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 345 (1991).

The sine qua non of copyright is originality . . . [which] means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity To be sure, the requisite level of *creativity* extremely low; even a slight amount will suffice.

Id. (Emphasis added). The statement appears early in the opinion in the context of explaining why factual compilations are generally not copyrightable.

41. See *supra* note 1 for the definition of 'originality' and 'origination.'

42. *Rogers v. Koons*, 960 F.2d 301, 307 (2d Cir. 1992) (paraphrasing loosely *Feist Publications, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 346 (1991)).

43. JANE M. GAINES, *CONTESTED CULTURE THE IMAGE, THE VOICE, AND THE LAW* (1991).

44. 111 U.S. 53 (1884).

45. GAINES, *supra* note 43, at 54.

46. *Burrow-Giles*, 111 U.S. at 58.

beyond merely depicting a personage.

In copyright litigation over time, courts shifted focus from those early cases about the rights of the photographer/artist,⁴⁷ to cases about property rights of the owner of the photograph,⁴⁸ Work for Hire⁴⁹ and Fair Use⁵⁰ cases, then shifted focus for a third time in post-*Feist* decisions, to what was photographed, construing 'fact' from 'idea,' and using the "modest" standard of originality.⁵¹ The shift in copyright law from protecting the expression of the artist to protecting intellectual property can be traced back to *Pushman v. New York Graphic Society*.⁵² There, the court held that the rights of reproduction passed with the sale of a painting.⁵³ The court further stated that in order to retain reproduction rights, an artist would have to expressly provide for such a right.⁵⁴ Even before *Pushman*, the artist's "exclusive right" to control reproduction of his copyrighted work had been eroded for portraiture works, vesting reproduction rights with the sitter, unless the photograph was made at the expense of the photographer.⁵⁵ The Copyright Act of 1976 expressly took away artists' "exclusive Right" in the constitutional mandate by permitting the use of a copyrighted work within certain limits⁵⁶ and by denying the presumption of copyright ownership for "Authors and Inventors" in the Work for Hire provision.⁵⁷

Most of the recent copyright decisions involving photography

47. See generally *id.*; *Altman v. New Haven Union Co.*, 254 F. 113 (D. Conn. 1918).

48. See generally *Time Inc. v. Bernard Geis Assoc.*, 293 F. Supp. 130 (S.D.N.Y. 1968); *Chamberlain v. Feldman*, 89 N.E.2d 863 (N.Y. 1949); *Pushman v. New York Graphic Soc.*, 39 N.E.2d 249 (N.Y. 1942).

49. 17 U.S.C. § 201(b) (1994). For a discussion of commissioned work see *Schatt v. Curtis Management Group, Inc.*, 764 F. Supp. 902 (S.D.N.Y. 1991). For a discussion of employee work see *Marco v. Accent Publ'g Co.*, No. CIV.A.91-2057, 1991 WL 212187 (E.D. Pa. Oct. 15, 1991).

50. 17 U.S.C. § 107 (1994).

51. See *supra* notes 40-42 for a discussion of the originality standard.

52. 39 N.E.2d 249 (N.Y. 1942).

53. *Id.* at 251.

54. *Id.*

55. *Altman*, 254 F. at 118. In *Altman*, the court stated:

Where the photographer takes the portrait for the sitter under employment by the latter, it is the implied agreement that the property in the portrait is in the sitter, and neither the photographer nor a stranger has a right to print or make copies without permission from the sitter.

Where, however, the photograph is taken at the expense of the photographer and for his benefit, the sitter loses control of the disposition of the pictures, and the property right is in the photographer.

Id. (citations omitted).

56. See 17 U.S.C. § 107 (1994).

57. *Id.* § 201 (b).

concern commercial work, guided by commercial values, in applying Fair Use and Work for Hire areas of the law. Several recent cases involving different kinds of photography will be examined. These cases fall under two kinds of infringement disputes. In the first group, the defendant admits copying but denies infringement on grounds of an invalid copyright for the plaintiff's work. In the second group, the defendant denies copying more than is permitted under Fair Use.

In connection with common law and statutory law eroding artists' constitutional rights, this Article examines the use of an Ordinary Observer⁵⁸ standard in copyright validation tests and copying tests under the Merger doctrine.⁵⁹ In copyright infringement cases, the validity of the copyright can be challenged for Sufficient Originality⁶⁰ by invoking Merger doctrine. A defendant may claim the work at issue is devoid of originality and monopolizes abstract ideas, themes or plots. Merger doctrine may also be used as an affirmative defense under Fair Use in a test of Substantial Similarity,⁶¹ if the subject matter of the copyrighted work

58. Courts differ in applying the Ordinary Observer test. Part One of the Two-Step Sufficient Originality test is an extrinsic test: "the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same." *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960). The Ordinary Observer test of the Two-Part Substantial Similarity test questions whether the copying would be noticed generally, thus making it an intrinsic test between two works. *Ideal Toy Corp. v. Fab-Lu Ltd.*, 360 F.2d 1021, 1022 (2d Cir. 1966).

59. Under fair use, Merger doctrine is defined as "expression is not protected in those instances where there is only one or so few ways of expressing an idea that protection of the expression would effectively accord protection to the idea itself." *BellSouth Adver. & Publ'g Corp. v. Donnelley Info. Publ'g, Inc.*, 999 F.2d 1436, 1442 (11th Cir. 1993), *cert. denied*, 510 U.S. 1101 (1994) (citations omitted). Merger doctrine under a sufficient originality test is defined as "similarities . . . not sufficient to preclude coincidence since (1) there [is] no resemblance to the ear of the lay listener and/or (2) the plaintiff's contribution [is] too banal." *Arnstein v. Porter*, 154 F.2d 464, 475 (2d Cir. 1946).

60. To be valid, copyright protection of 'authored' work has always required Sufficient Originality. To what degree, however, is not a settled question. The *Feist* decision teaches authoring alone is not enough. See generally *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991). A Sufficient Originality test was first articulated as a test for illicit copying in *Arnstein v. Porter*. 154 F.2d at 468. It is a Two-Step test, separating copying from illicit copying. Thus, direct copying may be permitted under common law fair use if two works are extrinsically different or if the copied work lacks Sufficient Originality.

61. The Two-Part test to discern Substantial Similarity between two works at issue calls for "substantial similarity not only of the general ideas but of the expressions of those ideas as well." *Curtis v. General Dynamics Corp.*, 18 U.S.P.Q.2d 1608, 1615 (W.D. Wash. 1990) (citing *Sid & Marty Krofft Tel. Prod., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977)). The *Curtis* court further stated that, "[i]n reviewing the copyrighted work against the infringing

is very common and certain similarities cannot be avoided.⁶² A Sufficient Originality test for copyright validation is still good law,⁶³ but the author argues that it was misconstrued in *Krofft v. McDonald's Corp.*⁶⁴ and thereafter, fell into disuse.

The two legal tests for illicit copying, Substantial Similarity (a Two-Part test) and Sufficient Originality (a Two-Step test), rely on an Ordinary Observer judgment and on application of the Merger doctrine, though from different perspectives. The first test presumes expression to be equivalent to the ideas or facts depicted in the disputed work, while the second test evaluates expression for *meaning*, and facts depicted are not necessarily equivalent to the idea. The first test is intrinsic, comparing the properties or concrete parts of the works at issue, while the second is extrinsic, comparing the attributes of each whole work and, as against all other works of its kind. The post-*Feist* decisions seem unduly focused on the subject matter photographed, literally, as the Substantial Similarity test is applied. In general, these courts applied this infringement test without regard to function equivalency between works.

Based on the cases reviewed, unless raised at the outset of a case, together with an admission of copying, Sufficient Originality tests were subsumed under the Fair Use doctrine. In these cases, quite often infringement suits never went beyond a Substantial Similarity test for copying, either because of denials and a subsequent finding of Substantial Similarity between the works at issue, followed by summary judgment, or property rights of the owner controlled reproduction, and thus preempted application of the Merger doctrine defense under Fair Use.⁶⁵ In order to be heard, a Sufficient Originality defense must be raised at the beginning of the suit under a motion to dismiss.⁶⁶

Currently, there is no requirement to specify function or intended use of a copyrighted work on the copyright registration form. Not unlike fraudulent infringement claims in patent law be-

copy, the court is allowed to dissect the similarities between the images, but not the dissimilarities." *Id.* at 1616.

62. Pictures of famous historical landmarks would be an example of situations where the work is common and similarities are inevitable.

63. See generally *Feist Publications*, 499 U.S. 340; *Harper & Row Publishers, Inc., v. Nation Enter.*, 471 U.S. 539 (1985); *Mathieson v. Assoc. Press*, 23 U.S.P.Q.2d 1685 (S.D.N.Y. 1992).

64. 562 F.2d 1157 (9th Cir. 1977).

65. See generally *Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992); *Epic Metals v. Condec, Inc.*, 867 F. Supp. 1009 (M.D. Fla. 1994).

66. See generally *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946). In *Arnstein*, the court never reached the illicit copying issue because the plaintiff's contribution was too banal. *Id.* at app. at 475.

fore the Patent Act of 1870 required patentees to declare specifications of their claim,⁶⁷ after a copyrighted work is copied the copyright owner often enlarges the scope of his intended, albeit unwritten, claim. For commercial photography, terms of the contract generally limit the purpose and use of the image and could just as well serve as evidence of specifications of the copyright. Even though most photographs at issue in lawsuits are commissioned or commercial in nature, the courts accept evidence of a registered copyright in place of a copyright validation test, and inquire no further about Sufficient Originality of the disputed work. More often than not, commercial photography produces generic documents which are not actually distinguishing for any discovery in the art, even though the images may be unique for some narrow use or function. The constitutional mandate seeks to encourage discoveries found in creative expression, not just expression like free speech. To this end, the author argues for a greater emphasis on a Sufficient Originality test.

A. *Idea-Fact/Expression Dichotomy*

The Copyright Act of 1976 prohibits copyrighting facts and ideas generally.⁶⁸ Throughout copyright law, there is a broad, general prohibition against copyrighting what is already in the public domain. Courts interpret this prohibition as applying to broad concepts such as algorithms and pre-existing common knowledge. The prohibition however does not encompass, copyrighting original "Writings and Discoveries." The author contends, moreover, that the 1990 amendment to § 102(b) of the 1976 Copyright Law, read broadly to include original discoveries, is unconstitutional.

A brief review of the case law in the development of separating public domain knowledge from original discoveries in copy-

67. See generally *Winnans v. Denmead*, 56 U.S. (15 How.) 330 (1853). In *Winnans*, the Court enlarged the scope of patentee's claims because use of the invention for which it was intended did not depend on its form. *Id.* at 344. The Court held,

[w]here form and substance are inseparable, it is enough to look at form only. Where they are separable; where the whole substance of the invention may be copied in a different form, it is the duty of the courts and juries to look through the form for the substance of the invention—for that which entitled the inventor to his patent, and which the patent was designed to secure

Id. at 343. See *infra* notes 259-60 accompanying text for a discussion of reverse doctrine of equivalents.

68. 17 U.S.C. § 102(b) (1994). "In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodies in such work." *Id.*

righted works follows. The legal concept is referred to generally as the idea/expression dichotomy. This review shows that in the past, courts eliminated broad concepts or pre-existing raw data from the scope of copyright protection. In contrast, post-*Rogers* courts seem to have applied the copyright law⁶⁹ indiscriminately to invalidate copyright of factual depiction or description of any kind and in any kind of photograph or writing. The Author expands 'idea-fact/expression dichotomy' to highlight this latest development.

Idea-fact/expression dichotomy, with respect to the Merger doctrine, evolved over the past century beginning with *Burrow-Giles Lithographic, Inc. v. Sarony*.⁷⁰ In *Burrow-Giles Lithographic*, the Court found that artistic expression could be separated and described as input to the product itself.⁷¹ It was, in fact, the quality of originality in the work that made it worthy of copyright protection. After *Burrow-Giles*, another copyright validity challenge came before the Court in *Bleistein v. Donaldson Lithographing Co.*⁷² In *Bleistein*, Justice Holmes remarked in support of modest artistic expression found in the advertising posters at issue before the Court: "[o]thers are free to copy the original. They are not free to copy the copy."⁷³ The Court defined "to copy" in terms of what motivated it: "the personal reaction of an individual upon nature."⁷⁴ In a dissenting opinion, Justice Harlan argued that the infringed work lacked original artistic design, thus lacking "intrinsic" value, and could not function to promote the useful arts.⁷⁵

Subsequently, in *Sheldon v. Metro-Goldwyn Pictures Corp.*,⁷⁶ Judge Learned Hand distinguished that which was in the public domain, and that which must be original, but not necessarily new. In so doing, he reasoned that the copyright did not protect the "broader outline of the plot."⁷⁷ Rather, only that part that originated with the author was protected.⁷⁸ The infringer in that case had taken literally Justice Holmes' invitation to copy. Judge Hand explained "[i]f the copyrighted work is . . . original, the public demesne is important only on the issue of infringement . . . [i]f

69. *Id.*

70. 111 U.S. 53 (1884).

71. *Id.* at 60.

72. 188 U.S. 239 (1903).

73. *Id.* at 249.

74. *Id.* at 250.

75. *Id.* at 301 (Harlan, J., dissenting).

76. 81 F.2d 49 (2d Cir. 1936).

77. *Id.* at 54.

78. *Id.*

the defendant has had access to other material which would have served him as well, his disclaimer becomes more plausible.⁷⁹ Historical material, which is "of necessity what events have made it"⁸⁰ could be drawn from freely, for example.

Arnstein v. Porter,⁸¹ decided some ten years after *Sheldon*, described the test for infringement by using two procedural steps: Step One, asked whether there was "copying," and Step Two, asked whether that copying constituted "illicit copying," or improper appropriation.⁸² In the first part of Step One, copying may be determined by an admission or by circumstantial evidence such as access.⁸³ If copying is denied but there are similarities, "analysis [intrinsic comparison] is relevant, and the testimony of experts may be received to aid the trier of fact."⁸⁴ Absent evidence of access, the similarities must be "so striking as to preclude the possibility . . . [of] independently arriv[ing] at the same result."⁸⁵ If copying is striking, the second part of Step One of the inquiry applies. The court separates that which was already in the public domain from that part which was original to the copyrighted work at issue. To the extent reasonable minds may differ on what part is original and therefore protected, again, expert opinions may be used, depending on the complexity of the objects. After filtering out the unprotected part of the work, what remains is then examined for illicit copying, an extrinsic test contrasting one work to the other, under Step Two. The response of the "ordinary lay hearer"⁸⁶ determines whether that protected original part of the expression, the 'heart,' was copied. This is an intuitive test in which "dissection" and expert testimony become irrelevant.⁸⁷

In *Greenbie v. Noble*,⁸⁸ historical biography was added to the list of noncopyrightable material "unless transformed by the first taker."⁸⁹ The court further stated that generally, "[t]here is no copyright of facts, news or history."⁹⁰

79. *Id.*

80. *Oxford Book Co. v. College Entrance Book Co.*, 98 F.2d 688, 691 (2d Cir. 1938).

81. 154 F.2d 464 (2d Cir. 1946).

82. *Id.* at 468.

83. *Id.*

84. *Id.*

85. *Id.*

86. *Id.* The case concerned copyrighted music. Any other source of intuitive sense perception may be substituted for "hearer," depending on the copyrighted object at issue.

87. *Id.*

88. 151 F. Supp. 45 (S.D.N.Y. 1957).

89. *Id.* at 65.

90. *Id.* at 66.

A lengthy discussion of common law "fair use" doctrine appeared in *Rosemont Enterprises, Inc. v. Random House Inc.*⁹¹ The court repudiated the *Oxford Book* holding that "absolutely precluded" an author from using copyrighted ideas and facts developed from independent research.⁹² Weighed against the public interest and the nature of the material, reasonable copying, not "extensive verbatim copying or paraphrasing" could be considered fair use.⁹³ In *Gardner v. Nizer*, the defendants asserted the fair use doctrine as an affirmative defense concerning their use of two non-fiction works on the lives of two individuals.⁹⁴ Though the historical and biographical facts in the public domain were "necessarily similar in content," the court declared that the author's expository techniques, if original, were protected.⁹⁵ The factual nature of the works precluded the finding of substantial copying.⁹⁶ Style and form were compared intrinsically for verbatim copying, but not for overall effect or message.

Concerning competing fictional works, the court in *Fuld v. National Broadcasting Co.*, reasoned that "it is impossible to copyright historical facts or fictional material previously published by others."⁹⁷ Note, however, that the themes at issue in *Fuld* were abstract ideas, and the copyright owner sought monopoly on expository techniques like flashbacks, not the plot itself.⁹⁸ The court dissected the parts of the works and found copying, though only of abstract ideas and general themes. Applying the "ordinary lay observer test" to reach this holding, as outlined in *Arnstein's Step One*, each work, as a whole, was compared for effect, conveyance, and purpose.

Arnstein v. Porter was resurrected in the Ninth Circuit although substantially changed in *Sid & Marty Krofft Television Production, Inc. v. McDonald's Corp.*⁹⁹ *Krofft* presented a new two-part test formula to measure Substantial Similarity.¹⁰⁰ Though claiming *Arnstein* as its model, the Two-Part test established in *Krofft* differs from the Two-Step test presented in *Arnstein*.¹⁰¹ *Arn-*

91. 366 F.2d 303, 306-10 (2d Cir. 1966).

92. *Id.* at 310.

93. *Id.*

94. 391 F. Supp. 940 (S.D.N.Y. 1975). The two individuals were Julius and Ethel Ronsenberg.

95. *Id.* at 942.

96. *Id.* at 943.

97. 390 F. Supp. 877, 882 (S.D.N.Y. 1975).

98. *Id.* at 881-82.

99. 562 F.2d 1157 (9th Cir. 1977).

100. *See id.* at 1163-69.

101. There are major differences between the *Krofft* Two-Part test and the *Arnstein* Two-Step procedure in measuring infringement. The following is a

stein's model works because it can accommodate both fiction and nonfiction, broadly defined, as well as the absolute property value and relative intangible value of creative works. The model established by *Krofft* fails to separate out expression borrowed from the public domain from that which is original to the Author. When, in *Krofft's* Part Two test, content is dissected under illicit copying, the formal, relative differences between the works are never examined. Thus, the Two-Step procedure outlined in *Arnstein* allows the "ordinary lay hearer" to detect copying of protected original

brief analysis of the more important distinctions.

1. *Krofft's* Two-Part Test may only be compared with Step One of the Two-Step procedure of *Arnstein*. *Arnstein's* Part Two-Step One is a test for how much of the work is already known to be part of common knowledge and how much is original. It is, in effect, a novelty test and a test to measure a given work's contribution to "Science and the useful Arts."

2. *Krofft's* Two-Part test measures "substantial similarity" while *Arnstein's* Step One-Part Two measures "sufficient originality." The distinction between "substantial similarity" or "sufficient originality" is one of focus. The *Krofft* court placed greater importance on material taking, while the *Arnstein* court cared more about finding adequate originality to justify enforcement of the copyright claim. Equity depends on striking a balance between creative input and useful production.

3. *Krofft's* "idea-fact/expression" concept renders the facts and ideas in a copyrighted work copyable by others, by defining 'idea' concretely, or as the equivalent of the fixed expression. *Arnstein's* model defines idea as an abstract. *Arnstein* recognizes part of idea comes from the public domain and part of it comes from the author.

4. *Krofft's* Two-Part test is two-dimensional, black and white, all fact. *Arnstein's* Two-Step procedure is three-dimensional, with shadings of gray, a mixture of fact and intuition.

5. *Krofft* defines 'dichotomy' as a reflection, the idea being the equivalent of expression. *Arnstein's* concept of dichotomy is like a two-sided coin with the idea being the flip-side of expression.

6. Part One of *Krofft's* test claims to be "extrinsic" because "it depends not on the responses of the trier of fact, but on specific criteria which can be listed and analyzed. . .and expert testimony is appropriate." *Krofft*, 562 F.2d at 1164. *Krofft* dissects parts of the work, not of the whole, and it is therefore not extrinsic, but intrinsic, by definition.

7. *Krofft* uses the term 'general ideas' to mean overall impression. *Arnstein* used 'general ideas' to mean those in the public domain.

8. *Krofft's* Part One is equivalent to the first half of *Arnstein's* Step One. Both courts agree that this first part is a factual matter but one that may be decided as a matter of law. The second half of *Arnstein's* Step One is equivalent to *Krofft's* Part Two: both tests dissect the works for similarities, but in *Krofft*, the task is to look at the manner of expression generally for similarities between two works, as would an "ordinary reasonable person." This is still an analytical exercise, but at the level of general impression, a subjective view.

9. The second half of *Arnstein's* Step One, on the other hand, is an alternative procedure only if copying is denied. Given a denial, dissecting the works becomes necessary, equivalent to *Krofft*, Part One.

expression between works as wholes, while the *Krofft* version tests for copying substantial parts of the manner of expression, whether the ideas are original or drawn from the public domain. *Krofft* presumes manner of expression must be unique to every person, while prohibiting protection of ideas, be they original or not.

In *Hoehling v. Universal Studios, Inc.*¹⁰² the Second Circuit held that protection for an author's interpretation of certain historical facts is "not copyrightable as a matter of law."¹⁰³ The court reasoned that in order to "avoid a chilling effect on authors who contemplate tackling an historical issue or event, broad latitude must be granted to subsequent authors who make use of historical subject matter, including theories or plots."¹⁰⁴ Though the *Hoehling* court noted that other circuits recognized protection of original research,¹⁰⁵ it reaffirmed the view of the Second Circuit that an author should not be "absolutely precluded from saving time and effort by referring to and relying upon prior published material."¹⁰⁶

Following the *Hoehling* decision, the court in *Durham Industries, Inc. v. Tomy Corp.*¹⁰⁷ confronted copyright violations in the context of commercial designs, or 'nonfiction' in the broad sense, and relied in part on *Krofft*.¹⁰⁸ Unlike the concrete analysis of plane and shape found in *Krofft*, *Durham* did not dissect the intrinsic similarities because both of the works at issue were generic variations on a common theme.¹⁰⁹ As such, it was inevitable that copying would be found, but not *substantial* copying because originality was lacking. Because the plaintiff owned the copyright registration and maintained a property right to control copying, it became necessary to look beyond dissecting intrinsic properties of the work.¹¹⁰ Thus, the court focused upon function and effect and found no substantial copying.¹¹¹ In the marketplace of ideas, as the *Durham* case illustrates, two works may look the same yet be sufficiently different in function to compete without loss of profits to

102. 618 F.2d 972 (2d Cir. 1980).

103. *Id.* at 978.

104. *Id.*

105. *Id.* at 979 (citing *Toksvig v. Bruce Publications Corp.*, 181 F.2d 664 (7th Cir. 1950); *Miller v. Universal City Studios, Inc.*, 460 F. Supp. 984 (S.D. Fla. 1978)).

106. *Id.* (citing *Rosemont Enters., Inc. v. Random House, Inc.*, 366 F.2d 303 (2d Cir. 1966); *Oxford Book Co. v. College Entrance Book Co.*, 98 F.2d 688 (2d Cir. 1938)).

107. 630 F.2d 905 (2d Cir. 1980).

108. *Id.* at 909.

109. *Id.* at 908-10.

110. *Id.* at 907-08.

111. *Id.* at 918.

the copyright holder.

In *Hearn v. Meyer*,¹¹² the plaintiff had, for over a year, painstakingly hand-copied reproductions from an out-of-print book and wrote and organized the text around the images.¹¹³ Judge Leisure denied copyright protection on the drawn images because the ideas from the out-of-print work were in the public domain. Verbatim copying of text by the defendant was permitted because the text was a factual description.¹¹⁴ The defendant did not infringe on selection and presentation of facts, as the same pictures were grouped by theme while the plaintiff grouped the pictures by artist. Moreover, because the publisher owned the copyright, though no royalties had been paid, the artist lacked standing to recover damages.¹¹⁵ A 'beneficial owner' argument for bringing this work back into publication was rejected, relying primarily on *Hoehling* and *Rosemont* since the "plot" of the artist's work was already in the public domain and, therefore, not copyrightable.¹¹⁶

Finally, in the history of the idea-fact/expression dichotomy concept, the law came full circle in *Caratzas v. Time Life, Inc.*¹¹⁷ In this case, the plaintiff's theoretical ideas which were illustrated in photographs, lost copyright protection because the evidence to support the ideas concerned real life. In *Caratzas*, the court found that "[w]hen expressing facts within the context of a particular factual background, an author is confined to a limited number of terms that will adequately convey the nature of the facts described."¹¹⁸ The court further stated that "[i]nfringement of a work's structure is proven only where direct copying is shown, as the law recognizes that an author dealing with the same data or facts will inevitably duplicate, to some extent, the work of other authors."¹¹⁹

B. Nature of Creative Works

To be sure, most memorable photographs are calculated by the photographer to express a particular idea.¹²⁰ The photographer

112. 664 F. Supp. 832 (S.D.N.Y. 1987).

113. *Id.* at 834-37.

114. *Id.* at 836, 846-47.

115. *Id.* at 840-41.

116. *Id.* at 851.

117. No. CIV.92-6346, 1992 WL 322033 (S.D.N.Y. Oct. 23, 1992).

118. *Id.* at *6.

119. *Id.* at *5 (relying on compilation doctrine in *Feist Publications, Inc., v. Rural Tel. Serv. Co.*, 499 U.S. 340, 357-58 (1991)).

120. One example of an exception to this general statement would be photographs by Abraham Zapruder of the Kennedy assassination. See generally *Time, Inc. v. Bernard Geis Assoc.*, 293 F. Supp. 130 (S.D.N.Y. 1968).

does try to merge the facts to his idea when he frames the image, and to the extent his "selection, coordination, or arrangement"¹²¹ of facts succeeds, society benefits in learning some truth or irony. The facts of a fine art photograph function as a whole idea just as words in a sentence function to convey a thought. The photographer, same as an author, seeks copyright protection on the sum total of facts, not the individual facts themselves. Although relatively few works qualify as original discoveries, some can inform beyond the subject matter depicted, if one knows how to look. The following excerpts from JOHN SZARKOWSKI, *LOOKING AT PHOTOGRAPHS*¹²² demonstrate this idea as an intellectual way of seeing.

Things of everyday experience had been transformed for [Edward Weston into organic sculptures, the forms of which were both expression and the justification of the life within.¹²³

He [Eugene Atget] set himself the task of understanding and interpreting in visual terms a complex, ancient and living tradition. The pictures that he made in the service of this concept are seductively and deceptively simple, wholly poised, reticent, dense with experience, mysterious, and true.¹²⁴

Under the current legal standards, would photographs like Atget's 'historical facts' of Paris at the turn of the century by

121. *Feist Publications, Inc., v. Rural Tel. Serv. Co.*, 499 U.S. 340, 362 (1991).

122. SZARKOWSKI, *supra* note 21. Szarkowski comments about the works of photographers in note 21 as follows:

[S]ome of the most interesting pictures were made on the periphery of the historical events." (Robert Capa, American, born in Hungary, 1913-1954). *Id.* at 146.

"They spring from a response to specific life; their formal eloquence is a tribute to their human meaning." (Cartier-Bresson, French, 1908-). *Id.* at 112.

"His sensitivity to his individual subject—to expression, gesture, posture, costume, symbol, habitat—seem unerringly precise. (August Sanders, German, 1876-1964). *Id.* at 102.

"The true subject of the photograph is the sinuous, vermicular, richly subtle line that described the silhouetted shape." (Irving Penn, American, 1917-). *Id.* at 158.

"The character drawn in that composite portrait is of a piece, persuasive, and less than reassuring." (Richard Avedon, American, 1923-). *Id.* at 168.

"It does not deal with the concept of architectural styles, but with the adventure of building grandly—and with confidence, heroism, eternity, and time. (Edward Steichen, American, born in Luxembourg, 1879-1973). *Id.* at 76.

123. *Id.* at 84. (Edward Weston, American, 1886-1958). Photographs show "intent that resides in natural form." *Id.*

124. *Id.* at 64. (Eugene Atget, French, 1857-1927). Atget's photographs are known for "purity and intensity of vision." *Id.*

someone unknown be protected by copyright? Would Weston's "Pepper No. 30, 1930" or "Cabbage Leaf 1931" be copyrightable by the Ordinary Observer standard? Aesthetically informing work does not depend on notoriety or professional standing of the photographer. Atget, himself, was undiscovered during his lifetime. When the validity of a copyright is challenged under Merger doctrine, will courts know how to separate quality photographic achievement, worthy of copyright protection from other images that fail to inform as original discoveries?

Merger doctrine, as applied to compilations of raw data as in *Feist*,¹²⁵ draws the line on just how low an originality standard can go.¹²⁶ Unlike *Hotchkiss*, the *Feist* decision has a very narrow application, limited to compilations of raw data.¹²⁷ Under Merger doctrine, *Feist* clearly denies copyright protection to 'garden variety compilations of raw data,' works devoid of intellectual creativity, or works of marginal improvement on the works of others.¹²⁸ *Feist* demands originality in copyrighted works, and even under *Feist*'s low creative standard alone, many documentary and commercial photographs can lose copyright protection.

A review of photography cases that considered artistic expression under the Fair Use doctrine follows. These examples show how *Feist*, an accurate ruling within its scope, has been applied inaccurately to intellectual property elsewhere, to lower

125. 499 U.S. at 345. Raw data is distinct from analyzed or qualitatively sorted data. The Court defines raw data as "wholly factual information not accompanied by any original written expression." *Id.* "Selection implies the exercise of judgment in choosing which facts from a given body of data to include in a compilation . . . [a]rrangement refers to the ordering or grouping of data into lists or categories that go beyond the mere mechanical grouping of data as such . . ." *Key Pub. Inc., v. Chinatown Today Pub. Enters.*, 945 F.2d 509, 513 (2d Cir. 1991) (citations omitted). "As a statutory matter, 17 U.S.C. § 101 does not afford protection from copying to a collection of facts that are selected, coordinated, and arranged in a way that utterly lacks originality." *Feist*, 499 U.S. at 363-64.

126. The *Feist* decision is reminiscent of *Hotchkiss* decision which drew a similar line between merely substituting construction materials and receiving a patent on the product. *See generally* *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248 (1850). In comparing the pre-existing product made of porcelain to the "new" one made of clay, which sought the patent protection, the *Hotchkiss* Court stated, "[t]he object of the act of Congress is to encourage men to devote their time and talent in making new and useful discoveries in the arts, manufactures, and compositions of matter. *Id.* at 260. "[T]he difference [between the two products at issue] is formal, and destitute of ingenuity or invention." *Id.* at 266.

127. *See* 17 U.S.C. § 103 (1994). "The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material." *Id.*

128. *See, e.g.,* *Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992).

originality standards, and to deny copyright protection because of the subject matter depicted.

III. RECENT CASES RELATED TO PHOTOGRAPHY

Several recent decisions are examined below for the application of copying tests under both the Merger doctrine and the Fair Use doctrine. This Part first discusses the cases that preceded *Feist*, including the *Rogers* district court decision. The next Section analyzes the *Rogers* Circuit Court of Appeals decision for application of the originality standard as set forth in *Feist*. Finally, this Part reviews those cases that rely on the *Rogers* and *Feist* opinions for application of copyright infringement tests.

A. Pre-Feist Cases

1. *Alt v. Morello*¹²⁹

In *Alt*, the defendant denied the infringement claim, rather than setting forth a Fair Use defense.¹³⁰ The court found that the slight alterations in the defendant's image proved infringement.¹³¹ In addition, the plaintiff was able to prove copying by showing evidence of access,¹³² although both parties had access to each other's work.¹³³ The court compared the two works under an 'ordinary lay observer' standard,¹³⁴ and held that although the defendant's work was not an exact photographic copy, substantial copying¹³⁵ proved

129. 227 U.S.P.Q. 49, 51 (S.D.N.Y. 1985).

130. *Alt*, 227 U.S.P.Q. at 50-51. The plaintiff, a commercial photographer, filed suit against the defendant, another commercial photographer, for willful copying of his photograph, under 17 U.S.C. § 501. *Id.* at 50. The defendant did not challenge the validity of plaintiff's copyright for Sufficient Originality or plaintiff's standing under Work for Hire doctrine, but instead stressed the differences between the objects depicted and between the compositions. *Id.* at 51.

131. *Id.* Minor changes strongly suggested copying. *Id.* (citing *Concord Fabrics, Inc. v. Marcus Bros. Textile Corp.*, 409 F.2d 1315, 1316 (2d Cir. 1969); *Couleur Int'l Ltd. v. Opulent Fabrics, Inc.*, 330 F. Supp. 152, 154 (S.D.N.Y. 1971); *Gross v. Seligman*, 212 F.2d 930, 931-32 (2d Cir. 1914)).

132. *Alt*, 227 U.S.P.Q. at 51.

133. *Id.*

134. *Id.* This court follows *Arnstein's* Two-Step approach substituting "ordinary lay observer" for *Arnstein's* "ordinary lay hearer" as it was applied in *Novelty Textile Mills v. Joan Fabrics Corp.*, 558 F.2d 1090, 1092 (2d Cir. 1977) and *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 489, 489 (2d Cir. 1960). *Alt*, 227 U.S.P.Q. at 51. The court stated that "the differences between the two photographs are so insignificant that 'the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same.'" *Id.*

135. *Alt*, 227 U.S.P.Q. at 51.

the defendant had appropriated the expression.

2. *Curtis v. General Dynamics Corp.*¹³⁶

The plaintiff in *Curtis*, while a college student in Ohio, had made a fine art print of a neighbor's wheelchair sitting on his neighbor's back porch.¹³⁷ Years later, the image was published and attracted the attention of an advertising firm.¹³⁸ A direct photostat copy of the plaintiff's image was circulated to photographers, and the plaintiff was asked to submit a bid for a promotional shoot featuring the wheelchair.¹³⁹ A competing commercial photographer won the job, and proceeded to copy the plaintiff's idea in most every detail.¹⁴⁰

Though the defendants challenged the plaintiff's copyright due to lack of copyright notice on early prints, the court found that the photographs were original works of art and therefore exempt from the statutory notice requirement.¹⁴¹ The defendants admitted access, but they denied copying by claiming independent creation and different use.¹⁴² The court examined evidence of Substantial Similarity, and applied *Krofft's* Two-Part intrinsic test.¹⁴³ The inquiry was bifurcated to test for copying the nonliteral artistic organization of the work utilizing an expert witness and also tested for literal copying.¹⁴⁴ The *Curtis* court substituted "one skilled in the art"¹⁴⁵ for the "ordinary reasonable person" found in *Krofft*. The Fair Use defense of copying only the central part of the image failed.¹⁴⁶ Photocopying the image for the purpose of soliciting bids

136. 18 U.S.P.Q.2d 1608 (W.D. Wash. 1990).

137. *Id.* at 1610. The plaintiff was not a commercial photographer. *Id.* Personal acquaintance and involvement by the photographer supported his claim of artistic rights to the copyrighted image. *Id.*

138. *Id.* at 1612.

139. *Id.*

140. *Id.* at 1613.

141. *Id.* at 1614 (referencing 17 U.S.C. § 401(a)).

142. *Id.* at 1612-15.

143. *Id.* at 1615. Copying can be shown by circumstantial evidence of access and substantial similarity test for copying "not only of the general ideas but of the expressions of those ideas as well." *Id.*

144. *Id.* (citing *Sid & Marty Krofft Tel. Prods., Inc., v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977); *Curtis*, 562 F.2d at 1162; *Durham Indus., Inc., v. Tomy Corp.*, 630 F.2d 905, 913 (paraphrasing 17 U.S.C. § 101: "[T]hus, in copyright actions, similarity of idea or function must be distinguished from similarity of artistic expression.")).

145. *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248 (1850).

146. *Curtis*, 18 U.S.P.Q.2d at 1615 (citing *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 56 (2d Cir. 1936) (stating that "no plagiarist can excuse the wrong by showing how much of his work he did not pirate.")).

for the ad campaign was deemed illicit copying.¹⁴⁷ The court further found willful copyright infringement because other views of the wheelchair were rejected in favor of the one that matched the plaintiff's work most closely.¹⁴⁸

3. *Rogers v. Koons: District Court Decision*¹⁴⁹

The defendant in *Rogers* challenged the copyright validity for the non-copyrightable elements by arguing that "copyright protection extends only to original acts of expression, so that purely factual information is in the public domain."¹⁵⁰ The defendant's counter-claim was rejected, the court asserting manner of expression was protected "as the certificate issued by the Copyright Office reflects."¹⁵¹ The defendant denied copyright infringement because the changed medium precluded infringement. The court, however, rejected the argument because it considered Koons' sculpture to be a derivative of the photograph.¹⁵²

The plaintiff argued that because the defendant admitted direct copying, the court did not need to analyze substantial similarity. Citing *Durham*, the plaintiff argued that "where direct copying was conceded substantial similarity drops out of the analysis."¹⁵³ Note, here the plaintiff substitutes *Krofft's* Substantial

147. *Mirage Editions, Inc. v. Albuquerque A.R.T. Co.*, 856 F.2d 1341, 1343-44 (9th Cir. 1988).

148. *Curtis*, 18 U.S.P.Q.2d at 1617. The slavish copying of 57 shots of the wheelchair compared to two or three considered works by the plaintiff, also undermined the defendant's independent creation defense. See *id.* at 1616 (citing *Roth Greeting Cards v. United Card Co.*, 492 F.2d 1106, 1110 (9th Cir. 1970) (holding that good intentions not to copy are immaterial)).

149. 751 F. Supp. 474 (S.D.N.Y. 1990). *Rogers*, a commercial photographer commissioned to photograph puppies, asked the owners to hold the puppies for the purpose of the photographs. *Id.* at 475. The image with a copyright notice was reproduced and distributed on notecards. *Id.* Koons copied the scene in sculpture for his "Banality Show" at Sonnabend Gallery in New York. *Id.*

150. *Id.* at 477 (citing *Hoehling v. Universal Studios, Inc.*, 618 F.2d 972, 979 (2d Cir. 1980)).

151. *Id.* The court added, "[i]t is well settled that a photographer's originality in photographic expression is entitled to full copyright protection." *Id.* (citing *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 55 (1884)).

152. *Id.* at 497.

153. *Id.* at 478. To support his argument, the defendant cited *Illinois Bell Tel. v. Haines & Co., Inc.* 905 F.2d 1081, 1086 (7th Cir. 1990). According to the court, "[t]o satisfy the copying element of infringement, direct evidence of copying will suffice Establishing substantial similarity is necessary when direct evidence of copying is unavailable." *Id.* The court also cited the *Feist* district court decision, *Rural Telephone Service Co., Inc. v. Feist Publications*. 663 F. Supp. 214, 218 (D. Kan. 1987). In *Rural Telephone Services*, Judge Rogers reasoned that since the defendants admitted using Rural's work

Similarity test for the second part of the the test for copying original material under *Arnstein*. Under *Arnstein*, if direct copying is found, it is not necessary to test for indirect copying. However, under *Arnstein* copying is not necessarily illicit copying and only copying of truly original parts or aspects of the work may be considered under Step Two. The *Rogers* court did not then recognize the Sufficient Originality test as such in *Durham*, but did find *Durham* analogous as follows: "two-dimensional cartoons [copied from three-dimensional characters] are the functional equivalents of a three-dimensional sculpture copied from a two-dimensional photograph."¹⁵⁴ The court held, therefore, that the sculpture constituted a derivative work based upon the photograph, and as such, violated the exclusive rights of the plaintiff as artist.¹⁵⁵ Finally, in considering whether the defendant "intended to comment satirically upon contemporary values" under the Fair Use doctrine, the court rejected the argument because the defendant's work did not "criticize" or "comment" on the plaintiff's photograph.¹⁵⁶

*B. Feist Publications, Inc. v. Rural Telephone Service Co.*¹⁵⁷

On March 27, 1991, the U.S. Supreme Court reversed the Tenth Circuit's opinion, *Rural Telephone Service Co. v. Feist Publications, Inc.*¹⁵⁸ The Supreme Court reversed *Rural* subsequent to the *Rogers* District Court decision,¹⁵⁹ but prior to the Second Circuit *Rogers* appeal.¹⁶⁰ *Rural* was reversed on the basis that "raw data" alone may not be copyrighted.¹⁶¹ Had the lower court properly considered Feist's Sufficient Originality counter-claim against evidence of direct copying of fictitious listings, the Circuit Court would likely have reached the same result.

to prepare their own, it was "unnecessary to consider the defendant's contentions that copying did not occur. The 'substantial similarity' test is used when there is no direct evidence of copying." *Id.* (paraphrasing *Durham Indus. v. Tomy Corp.*, 630 F.2d 905, 911-12 (2d Cir. 1980)).

154. *Rogers*, 751 F. Supp. at 478. It is "fundamental that copyright in a work protects against unauthorized copying not only in the original medium in which the work was produced, but also in any one medium as well." *Id.* (citation omitted).

155. *Id.*

156. *Id.* at 479.

157. 499 U.S. 340 (1991).

158. *Id.*

159. *Rogers* was decided on December 13, 1990, prior to the decision of the U.S. Supreme Court in *Feist Publications*. *Rogers* was before the court on a motion for summary judgment.

160. See *Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992) (decided on April 2, 1992).

161. *Feist*, 499 U.S. at 362-64.

C. Post-Feist Publications Cases

1. *Rogers v. Koons: Second Circuit Decision*¹⁶²

A year later, *Rogers* was affirmed on appeal,¹⁶³ using the low creativity standard in the *Feist* compilation doctrine to validate *Rogers*' copyright. This opinion has generated much controversy among authors.¹⁶⁴ This author found three errors in the opinion, two of which concern the Merger doctrine, and the third relates to Fair Use.

First, concerning the copyright validity challenge, the court cited *Durham*, but failed to follow its teaching. In both *Durham* and *Arnstein*, copying is not necessarily illicit copying. Had the court applied an extrinsic test based on an informed judgment, comparing the works with respect to use and function, the 'heart' of *Koons*' sculpture would have appeared very different from *Rogers*' photograph, though superficially the same.

The second error is reading *Feist* as having established a low standard of originality for all intellectual property. Though the *Rogers* court cites *Feist* for support, it clearly contradicts the Supreme Court's view about the importance of originality in copyrighted works.¹⁶⁵ In analyzing copyright infringement disputes,

162. 960 F.2d 301 (2d Cir. 1992).

163. *Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992).

164. See, e.g., Louise Harmon, *Law, Art, and the Killing Jar*, 79 IOWA L. REV. 367 (1994) (criticizing *Rogers*); Willajeanne F. McLean, *All's not Fair in Art and War: A Look at the Fair Use Defense after Rogers v. Koons*, 59 BROOK. L. REV. 373 (1993) (criticizing *Rogers*); Steven Shonack, *Postmodern Piracy: How Copyright Law Constrains Contemporary Art*, 14 LOY. L.A. ENT. L.J. 281 (1994) (criticizing *Rogers*); E. Kenly Ames, Note, *Beyond Rogers v. Koons: A Fair Use Standard for Appropriation*, 93 COLUM. L. REV. 1473 (1993) (detailing the *Rogers* decision); Robert A. French, Note, *Copyright: Rogers v. Koons: Artistic Appropriation and the Fair Use Defense*, 46 OKLA. L. REV. 175 (1993) (criticizing *Rogers*); Marlin H. Smith, Note, *The Limits of Copyright: Property, Parody, and the Public Domain*, 42 DUKE L.J. 1233 (1993) (criticizing *Rogers*); Jessica L. Darraby, *The 'Koons' Case Exposes the Dog-Eat-Dog Art World*, L.A. DAILY J., Aug 5, 1992, at 7; Deborah Squiers, *Illegal Copying of Photograph Found: Artist's Change in Medium to Sculpture no Bar to Infringement Suit*, N.Y.L.J., Dec 14, 1990, at 1.

165. See *Feist*, 499 U.S. at 346. Citing *The Trademark Cases*, the Court stated that:

The [*Trademark Cases*] Court emphasized the creative component of originality. It described copyright as being limited to 'original intellectual conceptions of the author' . . . and stressed the importance of requiring an author who accuses another of infringement to prove 'the existence of those facts of originality, of intellectual production, of thought, and conception.'

Id.

Judge Caramone's catch phrase "only a dash of it will do"¹⁶⁶ has been relied upon by other courts, as if an accurate paraphrase of *Feist*.¹⁶⁷ It is not. According to *Feist*, only a "dash" of originality, even for compilations of raw data, will not do. The Supreme Court reversed the Tenth Circuit in *Feist* because the copyrighted work was not sufficiently original. The *Rogers* court defined originality as if it meant "origination."¹⁶⁸

The third error concerns damages. Under Fair Use doctrine, the court balanced the defendant's profits from sales of his work, construed as 'the nature of the use,' Factor One,¹⁶⁹ against plaintiff's anticipated losses, Factor Four.¹⁷⁰ In weighing profits against losses in order to calculate a "reasonable royalty,"¹⁷¹ under patent law, the plaintiff must show actual damages or, alternatively, a pre-infringement projection of the profits that would result from the infringement.¹⁷² The *Rogers* court, however, required no such showing and held that the defendant's commercial exploitation of the image and personal enrichment weighed against the defendant's Merger doctrine challenge on copyright validity.¹⁷³ The court, citing *Sony Corp. of America*, reasoned that "where a use has no demonstrable impact on a copyright owners' potential market, the use need not be prohibited to protect the artist's incentive to pursue his inventive skills. Yet where the use is intended for com-

166. *Rogers*, 960 F.2d at 307.

167. See generally *Epic Metals Corp. v. Condec, Inc.*, 867 F. Supp. 1009, 1013 (M.D. Fla. 1994); *Davidov v. Tapemeasure Enter. Inc.* 27 U.S.P.Q.2d 1382, 1384-86 (S.D.N.Y. 1993). See also *Santrayll v. Burrell*, 39 U.S.P.Q.2d 1052 (S.D.N.Y. 1996); *Tienshan, Inc. v. C.C.A. Int'l, Inc.*, 895 F. Supp. 651 (S.D.N.Y. 1995); *Modern Publishing Co. v. Landoll, Inc.*, 841 F. Supp. 129 (S.D.N.Y. 1994).

168. See supra note 1 for the definitions of originality and origination.

169. 17 U.S.C. § 107(1) (1994). "[T]he factors to be considered shall include . . . the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes . . ." *Id.*

170. *Id.* § 107. "[T]he factors to be considered shall include . . . the effect of the use upon the potential market for or value of the copyrighted work . . ." *Id.* Under Factor Four, the *Rogers* court decided a balance "must be struck between the benefit gained by the copyright owner when the copying is found an unfair use and the benefit gained by the public when the use is held to be fair." *Rogers*, 960 F.2d at 311.

171. For a discussion of "reasonable royalty," see *Georgia-Pacific Corp. v. United States Plywood Corp.*, 318 F. Supp. 1116 (S.D.N.Y. 1970).

172. ROBERT P. MERGES, PATENT LAW AND POLICY 801 nn.1, 2 (1992) (citing *Skenyon & Porcelli, Patent Damages*, 70 J. PAT. & TRADEMARK OFF. SOC'Y 762, 765 (1988)).

173. A similar commercial exploitation challenge to Fair Use defense under Merger doctrine was used in *Mathieson v. Associated Press*, 23 U.S.P.Q.2D 1685 (S.D.N.Y. 1992), but with different results. See *infra* notes 175-84 and accompanying text for a discussion of the *Mathieson* decision.

mercial gain some meaningful likelihood of future harm is presumed."¹⁷⁴

In the field of intellectual property law and in the context of alleged infringements, commercial success has little to do with proving illicit copying and is therefore outside the constitutional mandate. Such challenges to a Fair Use defense are usually made only when there is evidence of "bad faith" dealings, such as fraud, deception, or passing off. As for the purely speculative infringement losses claimed by *Rogers*, the burden of proof was on Koons to show the two works would not compete for the same buyers. The price difference alone proved that.

2. *Mathieson v. Associated Press*¹⁷⁵

The plaintiff in *Mathieson*, a commercial photographer and personal acquaintance of Oliver North, photographed North in a bullet-proof vest.¹⁷⁶ The photograph was to appear in a brochure for North's company.¹⁷⁷ An Associated Press (AP) photographer photographed North holding the brochure which displayed the plaintiff's copyrighted photographs. Thereafter, AP separated plaintiff's photograph from the brochure and disseminated the work through the news wire in connection with a news story.¹⁷⁸

The defendant asserted the Fair Use defense, arguing that, under Merger doctrine, news reporting is a permissible use of a copyrighted photograph in the context of distributing the images with a news story.¹⁷⁹ The plaintiff alleged "bad faith" use of the images in a stock photo file and argued the defendant should therefore be precluded from making a Fair Use defense.¹⁸⁰ The defendant, however, stopped commercial use of the photographs upon notification to desist, and the court reasoned that purely speculative allegations, in the absence of probative evidence of likelihood or intent of infringement, did not support a "bad faith"

174. *Id.* at 312 (citing *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 451 (1984)). *Sony* was a contributory infringement case. No such presumption of harm is available where the infringer created profits by making valuable improvements on the copyrighted work. See *Sheldon v. Moredall Realty Corp.*, 29 F. Supp. 729, 731 (S.D.N.Y. 1939) (holding actual damages should be weighed against profits, as apportioned with respect to relative contribution).

175. 23 U.S.P.Q.2d 1685 (S.D.N.Y. 1992).

176. *Id.* at 1685-86.

177. *Id.*

178. *Id.*

179. *Id.* at 1686.

180. *Id.* The plaintiff also argued that the defendant should be barred from using the Fair Use defense on the grounds of the defendant filing a copy of the photographs to make it available for reuse, and on the grounds of the commercial purpose outweighing the news reporting purpose. *Id.* at 1687-88.

claim.¹⁸¹

Under Factor Two of Fair Use doctrine, Nature of Copyrighted Work, the court reasoned that the plaintiff no longer controlled “first public appearance of the photos”¹⁸² and the factual or informational nature of the work favored the defendant.¹⁸³ The court stated that,

[i]n making the determination as to a work’s non-factual or creative component, the threshold is not so low as the ‘originality’ standard for copyrightability (i.e. the “minimal creative spark” requirement from *Feist Publications, Inc. v. Rural Telephone Services Co.* []); rather, for the second factor in the fair use analysis to weigh in favor of the creator, the work must be ‘creative, imaginative, and original’.¹⁸⁴

3. *Caratzas v. Time Life, Inc.*¹⁸⁵

In *Caratzas*, the plaintiff sought a preliminary injunction against the defendant for alleged infringement, although the plaintiff could not prove ownership of the infringed photographs and thus could not show irreparable harm.¹⁸⁶ The content of the photographs was substantially similar, but the court determined that the images were non-copyrightable as a matter of law because they depicted historical facts.¹⁸⁷ The same held true on the issue of theme appropriation.¹⁸⁸ The structure and presentation of the *Caratzas* book was protected, although in a limited way.¹⁸⁹

181. *Id.* at 1687-88.

182. *Id.* at 1689.

183. *Id.*

184. *Id.* (citing *MCA, Inc. v. Wilson*, 677 F.2d 180, 182 (2d Cir. 1981). Finding “sufficiently non-factual” work was gauged against “fine art photographs of surrealist character. *Id.* (comparing *Haberman v. Hustler Magazine, Inc.*, 626 F. Supp. 201 (D. Mass. 1986) with *Guccione v. Flynt*, 617 F. Supp. 917 (S.D.N.Y. 1985).

185. No. CIV.92-6346, 1992 WL 322033 (S.D.N.Y. Oct. 23, 1992).

186. *Id.* at *1-*3. The plaintiff publisher did not own 11 of the copyrighted and infringed photographs and therefore lacked standing. *Id.* at *3. The defendant denied copying the other 33 images by showing evidence of independent creation. *Id.* at *3-*4.

187. *Id.* at *2-*4. The plaintiffs argued that by using the term ‘appropriating,’ they meant to suggest “that the concepts and ideas developed throughout [the work of the defendant] were contained in [the plaintiffs’] text and illustrations.” *Id.* at *4.

188. *Id.* at *4-*5.

189. *Id.* at *5 (citing *Feist Publications v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 358 (1991)). The defendants had conceded access yet were not required to show independent creation. Though the court found many of the same selections of subjects, the subjects appeared in different parts of the books. *Id.* at

The defendant admitted copying, but invoked the Fair Use doctrine.¹⁹⁰ The court held that all four factors favored the defendant, stating that the use was "scholarly in that it provides a historical treatment that is more accessible to the general public;" the plaintiffs' works were previously published; the quantity of the plaintiffs' works, illicitly copied, constituted a very small portion of the works; and the "public will benefit from the broad dissemination of historical information [contained in] this material."¹⁹¹ The court reached no final decision on whether the Fair Use defense would succeed at trial, but denied issuance of a preliminary injunction because the plaintiffs could not show substantial similarity.¹⁹²

In balancing the plaintiffs' substantial similarity claims, the court relied heavily on *Hoehling* and Merger doctrine to invalidate copyright protection for most of the plaintiff's work.¹⁹³ *Hoehling*, however, only invalidates copyright for historical facts and themes *already in the public domain*, and where each author has equal access to the public works.¹⁹⁴ Since most of the plaintiffs' copyright was invalidated at the outset, the defendants in *Caratzas* were not required to show independent creation concerning the structure and creation of the book. The court saw the work as mostly historical fact and attributed almost none of its value to Professor Jashemski's expression, exposition, or intellectual achievement.

*6. The court determined that the subjects were typical, "general ones" normally found in comprehensive works on Pompeii. *Id.*

190. *Id.* at *7.

191. *Id.* at *7-*8.

192. *Id.* at *8.

193. *Hoehling* warns that "in distinguishing between themes, facts, and *scenes a faire* on the one hand, and copyrightable expression on the other, courts may lose sight of the forest for the trees. By factoring out similarities based on non-copyrightable elements, a court runs the risk of overlooking wholesale usurpation of a prior author's expression." *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 979-80 (2d Cir. 1980). *Hoehling* further stated that, "courts should assure themselves that the works before them are not virtually identical." *Id.* at 980. Finally, the court stated:

In works devoted to historical subjects . . . a second author may make significant use of prior work, so long as he does not bodily appropriate the expression of another . . . Knowledge is expanded as well by granting new authors of historical works a relatively free hand to *build upon* the work of their predecessors.

Id. at 980 (emphasis added).

194. *Id.* at 974. The *Hoehling* court noted that "the scope of copyright in historical accounts is narrow indeed, embracing no more than the author's original expression of particular facts and theories *already in the public domain.*" *Id.* (emphasis added).

4. *Davidov v. Tapemeasure Enterprises Inc.*¹⁹⁵

In *Davidov*, the plaintiffs claimed infringement based upon the defendants' use of the plaintiffs' photographs for a new fabric design.¹⁹⁶ The defendant challenged the copyright validity on the ground that the fabric design was copyrighted before the photographs were copyrighted.¹⁹⁷ However, because the photographs were part of a larger commissioned and copyrighted work owned by the plaintiff, the photographs were protected.

The court held that the actual pieces of jewelry depicted in the photographs were "noncopyrightable elements" and could be freely used by others for design.¹⁹⁸ If the plaintiff's original studio set-up had not been copied, the court reasoned, the defendant would only have "mimicked plaintiff's arrangement and depiction of the jewelry"¹⁹⁹ If the photographer's set up had not been copied the claim would have been dismissed. Four infringing images were found using the "ordinary observer" test for Substantial Similarity.²⁰⁰ Extrinsic differences due to different medium and use were not considered under the Fair Use doctrine. The defendants had denied copying by claiming that "dimensions, color, and image clarity" differed enough that a reasonable juror would not find the two items substantially similar.²⁰¹ Additionally, the defendant did not produce sufficient evidence to show independent creation.²⁰² Summary judgment was denied, in part, but granted

195. 27 U.S.P.Q.2d 1382 (S.D.N.Y. 1993).

196. *Id.* at 1383.

197. *Id.* at 1384 n.3. The defendants denied copying but admitted access to the photographs. *Id.* at 1384.

198. *Id.* at 1385.

199. *Id.* The court cited *Rogers v. Koons*, 960 F.2d 301, 307 (2d Cir. 1992), and reasoned that "[e]lements of originality in a photograph may include posing the subjects, lighting, angle, selection of film and camera, evoking the desired expression, and almost any other variant involved." *Davidov*, 27 U.S.P.Q.2d at 1385.

200. *Id.* at 1385-86 (relying on *Rogers*, 960 F.2d at 307 (quoting *Ideal Toy Corp. v. Fab-Lu Ltd.*, 360 F.2d 1021, 1022 (2d Cir. 1966)). The court also refers to *Peter Pan, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960). *Id.* The *Davidov* court hereby reaffirmed the error in *Rogers* where the intrinsic test for copying in *Ideal Toy* was lumped with the extrinsic test for copyright validity in *Peter Pan Fabrics*, both under Fair Use doctrine in the test for Substantial Similarity. See *supra* note 58 for a discussion of the Ordinary Observer test.

201. *Davidov*, 27 U.S.P.Q.2d at 1386 n.4. To the degree commissioned work is dictated by clients, laws, rules, or other constraints inhibiting free choice and creative expression, originality is lacking. "Practically inevitable" selection and arrangement of subject matter does not possess the "minimal creative spark required by the Copyright Act and the Constitution." *Feist*, 449 U.S. at 363.

202. *Davidov*, 27 U.S.P.Q.2d at 1386. "[E]vidence of independent creation

for those works where “the lack of substantial similarity is so clear as to fall outside the range of reasonably disputed fact questions requiring resolution by a jury.”²⁰³ The plaintiff claimed injury without specifying the amount, but statutory damages may be claimed if actual losses are unknown.²⁰⁴

5. *Epic Metals Corp. v. Condec, Inc.*²⁰⁵

The defendants in *Epic* challenged the copyright of the photographs under Merger doctrine²⁰⁶ because they “simply depict various stages of construction which could easily be obtained from any number of job sites.”²⁰⁷ The plaintiff, a competing manufacturer, sought to “protect the actual reproduction of the expression of the idea, the photographs themselves.”²⁰⁸ The court found that photographs, in general, were protected by copyright law, citing *Rogers* for support.²⁰⁹ As for this variety of photography “[t]he quantity of originality that need be shown is modest—only a dash of it will do.”²¹⁰ Relying on *Blackman v. Hustler Magazine, Inc.*,²¹¹ the court held that the plaintiff’s property right to control reproduction trumped the defendant’s Merger doctrine defense.²¹² Ironically, the *Epic* court did require a showing of sufficient creative content in the charts and tables of numerical data.

may rebut a plaintiff’s prima facie case of copyright infringement” *Id.* (citing *Eden Toys, Inc., v. Marshall Field & Co.*, 675 F.2d 498, 501 (2d Cir. 1982)).

203. *Id.* at 1385 (quoting *Warner Bros. v. American Broadcasting Cos.*, 720 F.2d 231, 239 (2d Cir. 1983). Judge Freeh found the “arrangement and depiction” of the jewelry “strikingly similar.” *Id.*

204. *Id.* at 1382 (citing 17 U.S.C. § 504 (plaintiff may “elect statutory, rather than actual damages when actual damages are difficult to ascertain.”)); *Lauratex Textile Corp. v. Allton Knitting Mills, Inc.*, 517 F. Supp. 900, 903-04 (S.D.N.Y. 1981) (holding statutory damages appropriate “as a deterrent to further activity of this kind.”).

205. 867 F. Supp. 1009 (M.D. Fla. 1994).

206. The Merger doctrine under Fair Use doctrine as defined in *Bellsouth Adver. & Publ’g Corp. v. Donnelley Info. Publ’g*, 999 F.2d 1436, 1442 (11th Cir. 1993), *cert. denied*, 510 U.S. 1101 (1994) (holding “where there is only one or so few ways of expressing an idea that protection of the expression would effectively accord protection to the idea itself.”).

207. *Id.* at 1013-14 (citing *Bellsouth Adver. & Publ’g Corp. v. Donnelley Info. Publ’g*, 999 F.2d 1436, 1442 (11th Cir. 1993), *cert. denied*, 510 U.S. 1101 (1994)).

208. *Id.* at 1014.

209. *Id.* at 1013. (citing *Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992)).

210. *Id.*

211. 620 F. Supp. 792 (D.D.C. 1985).

212. *Epic Metals*, 867 F. Supp. at 1013-14.

D. COMPARATIVE SUMMARY

The case results are here compared and contrasted in light of the four main issues to decide in a copyright infringement lawsuit: copyright validity, reproduction or direct copying, substantial similarity, and fair use. Some of the inconsistency between courts can be explained by the different kinds of photography, the different purposes served, and the varied circumstances of ownership of the photographs. The chart in Table 1 locates the cases on a continuum of most-to-least copyright protection, sorted by these factors of kind, purpose and authorship. Grouped along these lines, the cases, identified by plaintiff, can be sorted as follows:

Kind of Photography- *Alt*, *Davidov*, and *Rogers* are studio setups; *Mathieson*, *Caratzas* and *Epic Metals* were on-site photography. *Alt* and *Curtis* photographs were art work for their portfolios.

Purpose- The photographs at issue in *Rogers* and *Caratzas* were commissioned for documentary work; *Davidov*, *Epic Metals*, and *Mathieson* photographs were commissioned for advertising.

Copyright Ownership- Works belonging to *Caratzas*, *Mathieson*, *Davidov* and *Epic Metals* were part of larger, copyrighted works. With the exception of *Mathieson*, the photographs were not taken by and printed by the plaintiff. *Alt*, *Curtis* and *Rogers* were singular photographs and plaintiffs were the photographers.

1. Copyright Validity

Proof of copyright ownership was challenged in *Curtis*,²¹³ *Mathieson*,²¹⁴ *Caratzas*,²¹⁵ *Davidov*,²¹⁶ and *Epic Metals*.²¹⁷ The plaintiffs' standing was validated in all cases, except for certain photographs made by a deceased artist in *Caratzas*.²¹⁸ In *Curtis*, the original photographic work lacked copyright notice but, as art work, it was exempt from the statutory notice requirement.²¹⁹ In *Davidov* and *Epic Metals*, however, copyright on the larger works sufficed to cover the photographs. In *Caratzas*, the book's copyright did not extend to the photographs which were either owned or commissioned by others.²²⁰ The defendant had reproduced the copyrighted image without its copyright notice in *Mathieson*, but

213. See discussion *supra* Part III.A.2.

214. See discussion *supra* Part III.C.2.

215. See discussion *supra* Part III.C.3.

216. See discussion *supra* Part III.C.4.

217. See discussion *supra* Part III.C.5.

218. *Caratzas v. Time Life, Inc.*, No. CIV.92-6346, 1992 WL 322033, at *2-*3 (S.D.N.Y. Oct. 23, 1992).

219. *Curtis v. General Dynamics Corp.*, 18 U.S.P.Q.2d 1608, 1614-15 (W.D. Wash. 1990).

220. *Caratzas*, 1992 WL 322033 at *2-3.

in the context of news reporting.²²¹

Challenges based upon non-copyrighable subject matter were made in all of the cases.²²² In *Epic Metals, Rogers* and *Alt*, generic images were challenged for lack of originality, whereas in *Caratzas, Mathieson, Curtis*, and *Davidov*, the factual objects depicted were challenged for copyrightability. Originality was deemed sufficient in *Epic Metals* and *Rogers*, both courts citing *Feist*.²²³ Factual elements of a composition, such as pens in *Alt*, and a wheelchair in combination with other elements in *Curtis*, did not lose copyright protection, but historical facts such as the ancient gardens in *Caratzas*, news reports in *Mathieson*, and previously copyrighted facts in *Davidov's* jewelry designs were separated out from the rest of the image and thereby rendered not copyrighable.

2. *Reproduction or Direct Copying*

Direct copying was admitted in *Epic Metals, Mathieson, Rogers*, and in *Caratzas* with respect to certain unprotected photographs. Access to plaintiffs' work was found in all cases. In *Alt* and *Davidov*, access was denied but no proof of independent creation was provided. The defendants prevailed, in part by showing independent creation in *Curtis* and in *Caratzas*.

3. *Substantial Similarity*

Under the doctrine of Substantial Similarity, the court first analyzes the works at issue for similarities.²²⁴ If substantial similarities are found, the court then decides, as a matter of law, whether the ordinary observer, rather than one-skilled-in-the-art, would recognize one work as copied from another. Technical differences, like cropping out all but the wheelchair in *Curtis* or changed medium in *Rogers* and *Davidov*, was looked upon as evidence of trying to hide copying. Plaintiff in *Epic Metals* and *Caratzas* did not claim infringement beyond the facts pictured, relying instead on property rights to the object photograph to control copying. *Mathieson* and *Rogers* claimed both copyright ownership

221. *Mathieson*, 23 U.S.P.Q.2d at 1685-86.

222. See generally discussion *supra* Parts III.A, III.B, III.C.

223. See generally *Epic Metals Corp. v. Condec*, 867 F. Supp. 1009 (M.D. Fla. 1994); *Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992). Both cases discussed the sufficiency of originality while referring to the standard under factual compilation doctrine in *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991)).

224. See, e.g., *Curtis*, 18 U.S.P.Q.2d at 1617. According to the court, "[a] copyright infringement may occur by reason of a substantial similarity that involves only a small portion of each work." *Id.* at 1616 (quoting *Burroughs v. Metro-Goldwyn Mayer, Inc.*, 683 F.2d 610, 624 n.14 (2d Cir. 1982)).

and artistic rights. On the artistic rights claim, Mathieson failed,²²⁵ and Rogers succeeded.²²⁶ Courts found Substantial Similarity between the plaintiffs' and defendants' works in *Alt, Rogers, Davidov* and *Curtis* on the basis of defendants copying the same facts in the same manner, presumably to express the same idea. Courts considered similar lighting strong evidence of copying.²²⁷

4. Fair Use

Given a finding of substantial copying, a Fair Use defense, under § 107, can be used depending on the following factors: 1) purpose and character of the use; 2) nature of the copyrighted work; 3) amount copied; and 4) market effect of the infringed work.²²⁸ Fair Use defense was raised under Factor One in *Mathieson, Caratzas, and Rogers*; under Factor Two in *Rogers, Caratzas* for the photographs, and *Epic Metals* for the photographs and tables; under Factor Three in *Caratzas, Epic Metals*, both with respect to the text, and *Mathieson*; and under Factor Four in *Caratzas* and *Rogers*.

The courts were not persuaded by the Fair Use defense in *Epic Metals* or *Rogers* and entered summary judgment against the defendants. The *Caratzas* court accepted defendant's Fair Use defense on all four factors, and denied plaintiff's motion for preliminary injunction. Fair Use defense was not offered in *Curtis, Alt, or Davidov*, as defendants denied copyright infringement. In *Mathieson*, with the news reporting analyzed under Factor One, the non-copyrightable elements copied analyzed under Factor Three, and the market effect analyzed under Factor Four, Fair Use doctrine favored the defendant, while degree of creativity, despite an advertising purpose, weighed for plaintiff. In these courts, pointing out the differences between the plaintiffs' and defendants' works was not a defense under Fair Use doctrine.

IV. CRITICAL SYNTHESIS

The *Rogers* court set in motion a body of law that can greatly diminish copyright protection for creative photography, and crea-

225. The court cited *M.C.A., Inc. v. Wilson* for the standard in creativity, and cited *Feist* for the originality requirement. See *Mathieson*, 23 U.S.P.Q.2d at 1689.

226. The court cited the *Feist* compilation doctrine, "a dash will do." *Rogers*, 960 F.2d at 307.

227. See generally *Rogers v. Koons*, 960 F.2d 301, 308 (2d Cir. 1992) (suggesting that a particular light is part of one's expression of ideas making it "original and copyrightable").

228. See 17 U.S.C. § 107 (1994).

tive expression generally. The *Rogers* decision and other post-*Feist* cases reviewed above set undesirable precedents in two ways: first, the decisions seem to render all facts and ideas not copyrightable, whether original to the author or pre-existing in the public domain; and second, the decisions fail to apply Merger doctrine against pre-existing public domain ideas to invalidate those works lacking in original ideas, while deferring to property rights to control direct copying. By asserting that ideas are equivalent to the facts expressed in a given work and no more, that all kinds of facts are the same, and that no facts are copyrightable, then no ideas are copyrightable. A substantive analysis to distinguish between different kinds of ideas and different kinds of facts, namely a test for originality and use of the works at issue, is missing from this logic.

The superficial way of discerning illicit copying from copying found in *Rogers*, based on the Ordinary Observer test, is rooted in *Krofft*.²²⁹ But, as previously noted, the *Krofft* intrinsic test for Substantial Similarity is a substitute for the extrinsic test in *Arnstein*, which judged originality, copyright validity and copying *per se* as a matter of law. *Arnstein* also provides for jury consensus, where reasonable minds may differ on what is original, and experts may be necessary to discern copying where public domain ideas are not commonly known. *Mathieson* applied an extrinsic test for creativity, but not for originality.²³⁰

Under the rationale used in *Arnstein*, Step One-part one, an extrinsic test, permits the court to decide direct copying as a matter of law on the basis of either property rights or by taking the 'heart' of another's work, which again may require an expert to discern the "heart." If copying is indirect, then substantive analysis, Step One-part two, comparable to the Substantial Similarity test found in *Krofft*, is necessary to discern copying the author's *original* idea, the 'heart' of the work. This subjective part of Step

229. *Sid & Marty Krofft Tel. Prods., Inc., v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977). In *Rogers*, the court described the Ordinary Observer test to discern Substantial Similarity. *Rogers v. Koons*, 960 F.2d 301, 307-08 (2d Cir. 1992). The court relied on varying precedent, including *Peter Pan Fabrics*, though omitting an important caveat in *Peter Pan Fabrics* which tests for use or function of the infringing work as follows: the Ordinary Observer test is enough to determine illicit copying, "unless protection against infringement is to be denied because of variants irrelevant to the purpose for which the design is intended." *Peter Pan Fabrics v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).

230. See Judith B. Prowda, *Application of Copyright and Trademark Law in the Protection of Style in the Visual Arts*, 19 COLUM.-VLA J.L. & ARTS 269-79 (1995), for a discussion of expert testimony and protecting style in the visual arts.

One determines whether the indirect copying of one from the other would be recognized, generally, by the "ordinary observer."

Krofft merges *Arnstein's* copying and illicit copying tests, using *Arnstein's* extrinsic superficial test but dropping what it was designed to measure, namely originality and function. *Krofft* uses the copying test to dissect superficial features of both works in question for similarities, whereas in *Arnstein*, the Ordinary Lay Hearer in the copying test is used to detect differences.

As previously noted, inquiry into copying the 'heart,'²³¹ or extrinsic use and function,²³² and indirect copying, has been subsumed in *Krofft* under Fair Use doctrine. If the defendant denies copying but striking similarities are found, the court can enter summary judgment²³³ and the defendant's arguments under Factor Two and Factor Three can never be made. Even if copying is admitted, but copyright infringement is denied under Fair Use, and the Factor Two and Factor Three analyses are used at trial, Factor One and Factor Four²³⁴ may trump, as the court must weigh all four factors together.²³⁵ 'Better and cheaper' way and 'personal enrichment,' results of copying, are extrinsic to discerning illicit copying in the *Arnstein* tradition, however, and therefore lie outside the constitutional mandate.

Factor One and Factor Four were merged in *Caratzas* to permit copying for a 'better and cheaper' way, but were used to penalize copying for 'personal enrichment' where the infringing work lacked educational value, as in *Rogers*.²³⁶ 'Educational value,'

231. The 'heart' relates to Factor Three of the Fair Use Doctrine: "[T]he amount and substantiality of the portion used in relation to the copyrighted work as a whole." 17 U.S.C. § 107. Factor Three must be evaluated on both a quantitative and a qualitative basis. *New Era Pub. Int'l v. Carol Pub. Group*, 904 F.2d 152, 158 (2d Cir. 1990). Factor Three provides plaintiffs a remedy where the significant portion used was "essentially the heart" of the copyrighted work. *Wright v. Warner Books, Inc.*, 953 F.2d 731, 738 (2d Cir. 1991).

232. Extrinsic use and function relates to Factor Two of the Fair Use doctrine: "the nature of the copyrighted work." 17 U.S.C. §107. Two aspects of Factor Two apply, namely excluding noncopyrightable information from protection and excluding banal works from protection under the Merger doctrine. The first aspect applies traditionally to historical and biographical facts in non-fiction, news reports, and compilations. The second aspect, the Merger doctrine, applies to both fiction and non-fiction to eliminate copyright protection for broad concepts pre-existing in the public domain. This Article has focused on Factor Two and clarifying the distinction between these two aspects of the Fair Use doctrine.

233. See generally Alan J. Hartnick, *Summary Judgment in Copyright: From Cole Porter to Superman*, 3 CARDOZO ARTS & ENT. L.J. 53 (1984).

234. See generally *Rogers v. Koons*, 960 F.2d 301, 311 (2d Cir. 1992) (discussing Factor One and Factor Four analysis).

235. *Id.* at 309.

236. See also *Caratzas v. Time Life, Inc.* No. CIV.92-6346, 1992 WL 322033,

a normative judgment, can be censorship under the guise of public policy. Thus, the *Hotchkiss* Court wisely separated out products of entrepreneuring *per se* from gaining protection as a policy matter under copyright law.²³⁷ Compare, for example, the results on this point in *Caratzas, Rogers, Mathieson*: Plaintiffs lost in *Caratzas* and *Mathieson*, where, in both cases, the work was directly commercially reproduced. Mathieson's images of Oliver North had more commercial value than the photographs in *Caratzas*, yet Mathieson had to show actionable copying beyond use for news reporting. In *Rogers*, plaintiff won, although the work that was copied was itself a commercial reproduction, of limited value by a non-famous photographer, while the 'reproduction' was an original work, site specific, made for an entirely different market, and valued for the artist's name.

A. Artistic Expression

The courts, in the cases under discussion, worked from a concrete definition of 'idea,' presuming a one-to-one idea-fact/expression dichotomy after *Krofft*, whereas traditionally, 'idea' in copyright law has been defined in the abstract.²³⁸ Ideas-facts and expression are rarely one-to-one reflections of each other in straight art photography, though that is precisely the goal and what tends to motivate originality. Ideas-facts, generally concrete and routine in commercial work, can be reflected one-to-one in their expression because of rigid constraints. Defining idea as equivalent to manner of expression captures most of what can be original in commercial work, since usually the abstract ideas come from the public domain and most concrete ideas are determined by others who commission the work.

In art, idea is everything. Distinctive manner, in the craft and in the execution of the idea, is expected to be there as well, but it is measured by degree of fineness or aesthetics. If the work is routine or banal, the manner of expression is all there is to copy. In such cases, the idea-equivalent-to-expression framework of analysis is probably a reasonable way to proceed to show copying, but not necessarily infringement. The copied image must first be

at *7 (S.D.N.Y. Oct. 23, 1992) (noting that the infringer is favored if the use is for scholarship or research).

237. See *supra* note 2 and accompanying text for a discussion of the *Hotchkiss* standard.

238. Copyright law distinguishes between abstract concepts, which are not copyrightable, and original ideas, which are copyrightable. See generally MELVILLE B. NIMMER, NIMMER ON COPYRIGHT, §§ 13.03, 1.10, 16.01 (1974) (commenting on protecting unfixed ideas under contract and fiduciary trust law).

copyrightable.

Important productive creative works, works that deserve further consideration or start a movement, will have original ideas, in addition to commonly known ideas, born out of common knowledge and invention. As evidenced by the existence of memorable, exponential works that spawn the works of others, idea, as the flip-side of expression, is not necessarily at unity with expression in creative works. Originality, beyond technique, in "Writings and Discoveries" then, can only be measured by its impact on mind and spirit of the Ordinary Observer, or by its distinctiveness in its field, as measured by the expert witness. If courts define ideas or facts as equivalent to manner of expression under Fair Use doctrine, then 'heart,' Factor Three, and 'soul,' Factor Two, found in some important works are left unprotected.

Traditionally, a suspected infringing work is permitted to draw from *pre-existing* material in the public domain. Two authors may, with or without access to each other's work, use some of the same commonly known or accessible facts, theories, or themes in their respective works.²³⁹ Traditionally, Merger doctrine has been used to prevent validating works that merely mimic common knowledge and ways of expression, works which are so devoid of a point of view that it merges with the prototype or abstract concept itself. Those repetitive works contribute nothing to the societal pool of knowledge.

Today, however, the absence of a nonobviousness standard in copyright law and in the absence of a Sufficient Originality test, permits prototypical images to be copyrighted and, in effect, monopolize abstract ideas. The courts compare the works before them for similarities in manner of expression, and without reference to their significance as compared to similar works in a wider field of use. The courts examined in this article did not measure the work, both plaintiff's and the defendant's, against abstract concepts in their respective works, to qualify each work's Discovery and thereby, right to copyright.

239. See *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 980 (2d Cir. 1980). According to the court,

[a] verbatim reproduction of another's work, of course, even in the realm of nonfiction, is actionable as copyright infringement In works devoted to historical subjects . . . a second author may make significant use of prior work, so long as he does not bodily appropriate the expression of another.

Id.

B. Commercial Expression

The purely commercial, commissioned photographs in *Rogers*, *Davidov*, and *Epic Metals*, record the unedited facts before them in a repetitive way. Generally, the commissioning party should own the copyright to these works,²⁴⁰ unless, by contract, rights are retained by the photographer. Mathieson knew his client Oliver North, a factor that separates his work from the others. His personal involvement improved his artist's rights to the work.

Commercial work can appropriately be measured against *Feist* for copyrightability when it is nonfiction, broadly defined, at the level of compilations and directories. Nothing but the technical aspects of commercial works can set them apart from thousands of others made from the same prototype. Courts assume that studio lighting and set-up are part of expression. It can be, as in the Sarony photograph, but normally it is not. In fact, a commercial photographer's reputation depends on delivering consistent and predictable results. Lighting and set-up generally follow standard published formulas. Sarony's portrait of Oscar Wilde is copyrightable, by the constitutional standard, only because he broke those rules in a dramatic new way that worked.

C. Originality Standard

Prior to the 1976 Copyright Act, common law copyright protected unpublished works of authorship.²⁴¹ Rooted in privacy rights under the First Amendment and its general prohibition against usurpation of another's own expression, federal protection under the Copyright Act of 1909 was an option to common law protection under state law.²⁴² The Copyright Act of 1976 did not seek

240. See *Schatt v. Curtis Management Group, Inc.*, 764 F. Supp. 902, 906 (S.D.N.Y. 1991) (citing *Lumier v. Robertson-Cole Distrib. Corp.*, 280 F. 550, 553 (2d Cir. 1922)). "Where a party commissions specific work by a photographer, the right to the copyright in the underlying photographs resides with the commissioning party." *Id.*

241. 17 U.S.C. § 302(a) affords protection under federal copyright law for those works "created on or after January 1, 1978" and that right "subsists from its creation." *Id.* "Created" means "fixed in a copy or phonorecord for the first time." *Id.* § 101. See RALPH S. BROWN & ROBERT C. DENICOLA, *CASES ON COPYRIGHT*, 24-34 (6th. ed. 1995); see also *Schatt*, 764 F. Supp. at 902 (discussing investive and divestive publication of James Dean photographs); See NIMMER, *supra* note 238 at §§ 13.03, 1.10, 16.01 for a discussion on protecting 'unfixed' ideas under contract and fiduciary trust law.

242. Today, common law copyright still protects some works already in the public domain prior to January 1, 1978, while existing unpublished works created prior to January 1, 1978, were brought under federal law. See BROWN & DENICOLA, *supra* note 241, at 29.

to change the Copyright Act of 1909.²⁴³ Therefore, the body of law cited to trace the history of the idea-fact/expression dichotomy with respect to originality should be valid. The "originality requirement articulated in *The Trade-Mark Cases* and *Burrow-Giles Lithographic* remains "the touchstone of copyright protection to-day."²⁴⁴

In *Burrow-Giles Lithographic*, the Court held that pre-existing facts must be separated from original new ideas. Furthermore, non-copyrightable material cannot be infringed upon, and authors claiming illicit copying or copyright infringement must prove "the existence of those facts of originality, of intellectual production, of thought, and conception."²⁴⁵ Judge Meskil, in *Durham*,²⁴⁶ noted with reference to the Ordinary Observer test for originality in copyrighted works, "copyright protection extends only to the artistic aspects, but not the mechanical or utilitarian features, of a protected work."²⁴⁷ Direct copying is not necessarily illicit copying under Merger doctrine and Fair Use doctrine.

Hoehling teaches that fiction may draw freely from nonfiction. Devoid of artistic distinction, the photographic image at issue in *Rogers* was, by analogy, nonfiction and *Koons'* sculpture was fiction. Though the sculpture lacked artistic quality in its form, its creativity, as evidenced by its function in the Banality Exhibit, made it fiction. If *Koons* only meant to comment satirically on contemporary values depicted in *Rogers'* photograph, then why did he want the sculpture to look exactly like *Rogers'* photograph when he could have used a composite? The *Koons'* sculpture was not created to stand alone. It was used as a symbol, one element of many. He created the work as curator, not artist. Viewed as part of a larger work, *Koons'* expression shows us that *Rogers'* photograph was no more infringed upon than the noncopyrightable Bakelite jewelry designs pictured on *Tapemeasure's* cloth in *Davidov*.

D. A Three-Step Test

The Two-Part intrinsic test for Substantial Similarity, applied in *Rogers* and in other cases reviewed here, is inadequate to filter

243. In a report to Congress, the Register of Copyrights "suggested making the originality requirement [of the 1909 Act] explicit." *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 355 (1991).

244. *Id.* at 347

245. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 59-60 (1884).

246. *See Durham Indus. v. Tomy Corp.*, 630 F.2d 905, 909-18 (2d Cir. 1980) for a discussion of originality, relying in large part on *Batlin & Son, Inc., v. Snyder*, 536 F.2d 486 (2d Cir. 1976).

247. *Id.* at 913 (citing *Mazer v. Stein*, 347 U.S. 201, 218 (1954)).

out expression borrowed from the public domain, particularly in commercial and documentary works. The unique features of straight creative photography, in particular, pose problems as to the correct standard of originality for protection of those works. The Three-Step test²⁴⁸ for illicit copying otherwise being applied to functional works in copyright law holds promise as a possible solution. Typically the Three-Step test has been used in disputes over computer programs, accounting systems, management programs and the like. This test recognizes that non-literal as well as literal elements in a work may be protected under copyright law. Like *Arnstein's* Two-Step test, this test eliminates noncopyrightable elements before any comparison for illicit copying is made.

In Step One, Abstraction, elements of the process are identified, starting with directional cues or instructions, rising to modules of processing, and ending with abstract concepts or function. Step Two, Filtration, deals with eliminating those elements incidental or necessary to the function and validating protectible those elements "not necessary to that purpose or function."²⁴⁹ For example, in photography, an unnecessary or nonstandard element in Sarony's portrait²⁵⁰ was the confrontational pose and frontal lighting to complement and enhance Oscar Wild's personality. Filtration serves "the purpose of defining the scope of plaintiff's copyright."²⁵¹ Elements dictated by efficiency or by external factors are not copyrightable. As for the court's role in construing the claims, *Markman v. Westview Instruments, Inc.*²⁵² recently affirmed this filtration process is a matter law for the court, rather than for the jury.²⁵³ The Third Step, Comparison, completes the copying test for

248. The utilitarian doctrine begins with *Baker v. Selden*, 101 U.S. 99 (1879), holding that processes *per se* are not protectible under copyright law and further, identifying aspects of a work which "must necessarily be used as incident to' the idea, system or process" from other aspects that are not unavoidable but instead creative selections and organization of steps and elements that make the process perform a unique function. *Id.* at 104. *Baker* found no difference between visual or written instructions. "[I]llustrations are the mere language employed by the author to convey his ideas more clearly." *Id.* at 103. The Three-Step test was adopted in the Second Circuit in *Computer Associates Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693 (2d Cir. 1992).

249. *Whelan Assocs., Inc. v. Jaslow Dental Lab., Inc.*, 797 F.2d 1222, 1236 (3d Cir. 1986).

250. *BROWN & DENICOLA*, *supra* note 241, at 49.

251. *Brown Bag Software v. Symantec Corp.*, 960 F.2d 1465, 1476 (9th Cir. 1992).

252. *Markman v. Westview Instruments, Inc.*, 116 S. Ct. 1384 (1996).

253. To assist in this inquiry the court may appoint its own independent expert under FED. R. EVID. 706. See *Harbor Software, Inc. v. Applied Sys., Inc.*, 925 F. Supp. 1042, 1045 (S.D.N.Y. 1996) (stating "[T]he filtration analysis is a matter of law for the [c]ourt," analogizing *Markman* in patent law to copyright

nonliteral elements. Step Three is the familiar Substantial Similarity test, testing for copying copyrightable elements at the "core of expression"²⁵⁴ and at the 'heart' of the work with respect to their degree of importance.

A filtration statement applying the Three-Step test for nonliteral elements in Sarony's portrait of Oscar Wilde, obtains information far more relevant to its function. Briefly, in summary form, with a few examples of items to consider: Step One, Abstraction: 1) the frame: framing the image sets the rules and grammatical relations within. 2) the objects: positioning the objects, planes, and lines sets the syntax (rhythm, mood, tone); Step Two, Filtration; as dictated by efficiency, would eliminate commercial prints unless they were made under the artist's direct supervision; as dictated by external factors, would eliminate such factors as formulaic lighting, items of clothing and furniture designs; Step Three, Comparison, would raise questions such as: Can the image function the same or communicate the same message in color? with a round or square frame? without selective burning and dodging? without the confrontational pose and frontal lighting? without the same shadows and highlights? A three-step analysis results in filtering out noncopyrightable elements, but fully protects the intangible creative elements of the image in its "selection coordination and arrangement"²⁵⁵ of the elements, as well as certain processes employed to produce a print from the original negative image.

CONCLUSION

When each of the post-*Feist* decisions is taken to its logical conclusion, set against a backdrop of idea-fact/expression dichotomy, it renders copyright law next to useless for protecting creative aspects of intellectual property. No distinction is being drawn between "Writings and Discoveries" by "Authors and Inventors" and all other repetitive works drawn from common knowledge.

Photography has seen the evolution of scientific advancement with the onset of digital-imaging technology.²⁵⁶ Digital-imaging

law).

254. *Computer Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 710 (2d Cir. 1992).

255. *Feist Publications, Inc., v. Rural Tel. Serv. Co.*, 499 U.S. 340, 362 (1991).

256. See generally William J. Mitchell, *When Is Seeing Believing? - Digital Technology for Manipulating Images has Subverted the Certainty of Photographic Evidence*, SCI. AM., February 1994, at 68; Bennett Daviss, *Picture Perfect - The Latest Computer Technology is Spreading a New Visual Medium - The Perfect Faked Photo - So Fast It's Making the Experts Uneasy*, DISCOVER, July

technology can generate digital composites from existing photographs, improving on the author's combination of elements, and in doing so, receive copyright protection, the equivalent of a product-by-process patent. Clearly, the courts' focus on objects photographed, literally, opened the way for such appropriations of another's creation, as just innocent recombinations of public facts. The Three-Step test for copying would set the scope of the copyrightable material, both literal and nonliteral, and eliminate wholesale appropriations as such.²⁵⁷

Under the present reading of the law, once an artist's discoveries are published, they become unprotected with respect to controlling the first copy.²⁵⁸ Will the courts permit competing commercial interests to successfully argue under the Fair Use doctrine, similar to the reverse doctrine of equivalents from patent law,²⁵⁹ that their technology made the images more appealing and more accessible; thereby, better satisfying the public interest? Such appropriation would be rewarded, while the original work would receive nothing.

On the other hand, will copyright owners in the absence of specifications be permitted to expand their rights beyond the intended purpose of their work? Even when specifications are prescribed, as under the doctrine of equivalents in patent law,²⁶⁰ Justice Douglas, dissenting in *Graver Tank & Manufacturing Co. v. Linde Air Products Co.* concluded,

[M]oreover, a doctrine [of equivalents] which is said to protect against practicing 'a fraud on a patent' is used to extend a patent to a composition which could not be patented Thus we end with a strange anomaly: a monopoly is obtained on an unpatented and un-

1990, at 85.

257. See *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 980 (2d Cir. 1980).

258. See generally *Mathieson v. Associated Press*, 23 U.S.P.Q.2d 1685, 1689 (S.D.N.Y. 1992).

259. A patent extends to the function of a device only in a particular way, as different inventions can do the same thing. Known as the Reverse Doctrine of Equivalents in patent law, it acknowledges that "one may only appear to have appropriated the patented contribution, when a product precisely described in a patent claim is in fact 'so far changed in principle' that it performs a 'substantially different way' and is not therefore an appropriation." *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1123 (Fed. Cir. 1985).

260. See *Graver Tank & Mfg. Co., Inc. v. Linde Air Prods. Co.*, 339 U.S. 605, 608-10 (1950) (reviewing the theory of the doctrine of equivalents). "[I]f two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form or shape." *Id.* at 608.

patentable article.²⁶¹

Justice Douglas, dissenting in *Lee v. Runge* asked, in support of denying copyright for a compilation of public information, "[w]here . . . a writer has published a book which compiles and applies information available to all men, should that writer have a monopoly on the ideas in that book through a copyright, issued merely because the words used were the author's own?"²⁶² Justice Douglas defines "ideas" here as pre-existing general knowledge, or widely known facts, like the white pages in *Feist*. A creative, original product, on the other hand, would communicate something that was *not* known before, either through original research or through intangible means in its selection, coordination and arrangement of pre-existing facts.

Photography, same as sculpture, painting, writing, and other intellectual property, has its commercial side. The difference between commercial work and art lies, for the most part, in the originator's purpose and the intended use of the work. The sample of courts discussed in this Article focused on property rights of the owner of the product created by equating fixed expression to expression and failed to acknowledge different goals in artistic expression from those of commercial work.

The basics of proving copyright infringement, ownership of the copyright and that another copied illicitly, are becoming more and more difficult to prove as the boundary between private personal achievement and public domain becomes ever less well defined. The solution for keeping copyright protection viable for art may rest in the constitutional mandate and the issuance of copyrights to individuals who can show in a filtration statement the intellectual, creative and original part of their claim to intellectual property, as the benefit to be derived by the public. Otherwise, today's literal reading of copyrighted works tends to discourage creative or theoretical expression for the public use, the exact opposite of the constitutional mandate for which it was intended to fulfill.

261. *Id.* at 618 (Douglas, J., dissenting).

262. *Lee v. Runge*, 404 U.S. 887, 890-91 (1971) (Douglas, J., dissenting).

Table 1. Competing Factors in Copyright Protection for Photography*

Copyright Protection	Kind	Purpose	Ownership of Copyright
Most	Art Work	Personal Work	Photographer Owns
	Curtis*	Alt* Curtis*	Alt* Curtis* Rogers*
	Studio Set -Up	Commissioned-Documentary	Subject Owns
	Alt* Davidov* Rogers*	Rogers* Caratzas	Rogers*? Mathieson?
Least	On-Site	Commissioned-Advertising	Publisher Owns
	Epic Metals* Mathieson Caratzas	Epic Metals* Mathieson Davidov*	Epic Metals* Mathieson Davidov* Caratzas

* Opinion favorable to plaintiff.

? Indicates absence of information about any contract between the commissioning party and the photographers. Under 17 U.S.C. § 201(b) (1994) (work for hire) unless otherwise provided for in a contract, copyright is owned by the commissioning party.

