some day be capable of colorizing black-and-white films automatically, without the intervention of human skill and judgment. Surely, authorship will reside at some level in the efforts that go into devising the computer program capable of automatically colorizing a black-and-white motion picture. But is the colorized motion picture itself the product of authorship?

I see no present reason to delay or deny registration on this largely speculative ground. Under the existing colorization process, authorship clearly appears in the final product. However, the prospect and the question go to the very heart of copyright protection generally, and not just copyright protection for colorized motion pictures. But, these are considerations for the future, not the present. The Copyright Office should be applauded for so early, and so effectively, alerting interested parties to the possible problems raised by copyright protection for colorized versions in its 20 August Notice of Inquiry on the subject. (My response to the Copyright Office's Notice of Inquiry is attached as an appendix.)

2. Consumer Choice. Copyright law has consistently refused to play the role of cultural arbiter. So long as some degree of authorship is evident, copyright will protect the lowest, most common, works alongside the most exalted. As Justice Holmes observed in a decision giving copyright protection to circus posters, "It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits." This prudent rule rests in part

on first amendment traditions that caution against discriminating on the basis of transient or elitist notions of artistic worth. More fundamentally, though, this rule rests on the principle that the purpose of copyright is not to reward authors as an end in itself, but rather is to encourage authors to produce those works that consumers want. The colorization of black-and-white motion pictures serves this purpose well, making classic motion pictures accessible for the first time to audiences -- their tastes shaped by a world of living color -- that would otherwise be disinclined to view them and, because of market forces, might never be able to see these films in any form on television.

3. Producer Control. At the very core of the current debate over the colorization of black-and-white motion pictures lies a concern for authenticity. Conceptually, the concern over colorization differs little from the concern, recently expressed in some quarters, that the restoration of the Sistine Ceiling restore it to its authentic form. To be sure, the concern over colorization is less pressing. While there is only one Sistine Ceiling -- which will be ruined or restored depending upon one's point of view -- colorized and black-and-white versions can exist side by side. But this difference raises the more subtle problem of the original author's possible interest in seeing that only the original, authentic version of his work is available, unclouded by other works that may distort his artistic vision.

Authenticity is an important and highly prized cultural value, one that public policy in this country has implemented through such measures as landmark

preservation. Copyright law, too, secures the author's interest in authenticity. By giving copyright owners control over their works -- including the exclusive right to reproduce and prepare derivative works based on them -- copyright effectively gives motion picture producers the right to stop others from colorizing their works or, if the producer chooses, to authorize colorization under tightly controlled conditions, or to impose no conditions at all.

But, what of copyrighted works already created, and contracts already entered into, before anyone contemplated the colorization process? Does a contract granting the general right to make derivative works based on a black-and-white motion picture include the right to colorize the motion picture? The question, though important, is not one for Congress to answer. Rather it is to be answered by courts interpreting contracts under the canons of state law. These decisions will inevitably turn on the facts of a particular case. But it would not be surprising to see a court hold that the implied obligation of good faith between contracting parties includes an obligation respecting authenticity and requires, at the least, that the colorizer label his product as a colorized version of a black-and-white original.

What of works in which copyright has expired? Tort law has traditionally taken authenticity as one of its objects. Just to note one example, the Federal Trademark Act, which prohibits false representations respecting goods and services, may be construed to require, at the least, that the distributor of a colorized motion picture clearly label the work as a

colorized version of a black-and-white original, thus avoiding any imputation to the original creator of a connection to the colorized version. And, in the many important foreign markets whose legal systems recognize the doctrine of moral right, that doctrine may even more effectively control the performance of colorized versions.

In sum, the brunt of my testimony is that copyright's principles of authorship and consumer choice support copyright protection for colorized films, and copyright's principle of producer control supports contractual arrangements protecting against colorization of black-and-white films. For contracts already made, and for black-and-white works in the public domain, producers must look to state rules of contract interpretation and to state and federal tort rules to secure their interests in authenticity.

APPENDIX

STANFORD LAW SCHOOL, STANFORD, CALIFORNIA 94305

PAUL GOLDSTEIN
STELLA W. AND IRA S. LILLICK PROFESSOR
OF LAW

7 November 1986

Dorothy Schrader, Esq.
General Counsel
Copyright Office
Library of Congress
Washington, D.C. 20559

Re: Notice of Inquiry: Registration of Claim to Copyright in Colorized Motion Pictures

Dear Ms. Schrader:

This letter responds to the Copyright Office Notice of Inquiry, dated 20 August 1986, in connection with the above-referenced matter. I am writing this letter entirely on my own initiative and as an expression of my personal views.

On the basis of the description of the colorization process set forth in the Notice of Inquiry, and on the basis of independently obtained information respecting the colorization process, I believe that, as a general matter, colorized versions of black-and-white motion pictures qualify as derivative works possessing sufficient original content to constitute independently copyrightable subject matter. As currently produced, colorized versions of black-and-white motion pictures appear, at the least, to embody the degree of originality contemplated by such cases as Durham Industries, Inc. v. Tomy Corp., 630 F.2d 905, 908-911 (2d Cir. 1980), and the creators of these works would appear to have deposited "more than a penny in the box" that Professor Kaplan would require "to make the copyright turnstile revolve." B. Kaplan, An Unhurried View of Copyright 46 (1966).

My principal reservation with respect to registrability concerns the extent to which the colors employed in the colorization process are, and will continue to be, dictated by the scenic, costume and dramatic elements of the underlying black-and-white work. If the responses to the Notice of Inquiry reveal that esthetic convention or consumer preference dictate that the colorization process employ colors that are true to the original colors employed when the black-and-white film was produced, then, under the doctrine of Morrissey v. Procter & Gamble Co., 379 F.2d 675, 678 (1st Cir. 1967), copyright might arguably be withheld from the colorized version on the ground that only a single or limited number of ways exist to colorize the underlying black-and-white work, with the result that, by obtaining copyright on one colorized version, the copyright owner could effectively, if not technically, monopolize all colorized versions.

Apart from this speculative reservation, I believe that colorized black-and-white films will, as a general proposition, constitute copyrightable subject matter, and that it would be within the authority of the Copyright Office to accept them for registration. Nonetheless, the Office may, in its deliberations on the question, wish to address three sets of concerns: (1) the concerns of the original creators of black-and-white motion pictures in the integrity of their works; (2) the possibility that copyright for colorized versions may effectively prevent

others from using the underlying black-and-white work even after that work falls into the public domain; and (3) the potential problems raised by the fact -- if it is a fact -- that colorization is to some significant extent accomplished through computer-driven technologies. In my opinion, none of these three concerns requires the Copyright Office to refuse registration to colorized black-and-white motion pictures. However, the latter two concerns do suggest some further steps that the Copyright Office might undertake in the event it decides to accept these works for registration.

(1) Integrity of the Underlying Work. According to articles that I have read in the popular press, some motion picture directors are understandably concerned that the artistic integrity of their black-and-white motion pictures will be impaired by the colorization process. Their plight, however, is no worse than the plight generally of authors who are faced with distortions of their works, and who must rely on interstitial tort doctrines and contract arrangements to secure their interests. Presumably, too, owners of underlying works may in some situations obtain redress under 17 U.S.C. §203's termination of transfer provisions. Although, under section 203(d)(1), a derivative work -- a black-and-white motion picture based on an underlying novel, for example -- "may continue to be utilized under the terms of the grant after its termination," that privilege does not extend to the preparation, after termination, of other derivative works -- which, in this case, would presumably include colorized versions of the derivative, black-and-white work.

In any event, this problem -- to the extent that it is a problem -- stems from the lack of an integrated system of moral right in the United States. In no event should it be redressed through the expedient of withholding copyright registration.

(2) Extension of Copyright Term. In theory, the grant of protection to colorized versions of underlying black-and-white motion pictures will not extend the copyright term in the underlying black-and-white motion picture; although the colorized version itself could not be copied within its copyright term, the underlying work would be free for copying once it falls into the public domain.

One practical problem suggests itself however: there may be a concern that the copyright owner of the colorized version, who also owns the rights to, and all prints of, the black-and-white version, will, at the time the black-and-white version goes into the public domain, destroy all copies of the black-and-white work, with the result that anyone who wishes to copy the black-and-white work must necessarily copy the colorized version, thus exposing himself to liability for copying the copyrighted, colorized work. (This raises a tantalizing question: does one who copies a colorized version onto black-and-white stock infringe the copyrighted, colorized version, or has he merely copied the black-and-white content? Since the colorization process may add shadings to the underlying work, with the result that any black-and-white copy of it is in fact a version of the colorized work and not a true copy of the black-and-white work, liability in this situation seems a real possibility.)

One practical solution to this problem would be for the Copyright Office to require, as a condition to registration of the colorized version, that the copyright owner deposit two copies of the black-and-white version on which the colorized version is based. If this approach is taken, two copies of the black-and-white version could at all times be available for public copying from the collections of the Library of Congress. Although I have not researched the authority of the Copyright Office to require the deposit of complete prints of a motion picture under these circumstances, my initial impression is that such authority exists and that such a deposit requirement could, at the very least, be justified by the Copyright Office's valid

interest in determining whether the colorized version of a black-and-white motion picture indeed constitutes more than a trivial variation on the underlying black-and-white work.

(3) Originality of Computer-Created Works. As I presently understand the colorization process, considerable artistic judgment and skill go into the colorization of a black-and-white motion picture. Nonetheless, it may -- or may soon -- be the case that computer programs will, without the intervention of human skill and judgment, be capable of colorizing black-and-white films automatically. Surely, authorship will reside, at some level, in the efforts that went into devising the computer program capable of automatically colorizing a black-and-white motion picture. But is the colorized motion picture itself the product of authorship?

I see no present reason to delay or deny registration on this largely speculative ground. But the question goes to the very heart of copyright protection generally, not just copyright protection for colorized motion pictures. Computer programs exist today that can themselves write other computer programs. Doubtless, such programs will proliferate in the future. Thus, I believe that it would be appropriate for the Copyright Office, if it has not done so already, to begin giving some thought to the general, very thorny question, of where, if at all, the line of copyrightability should be drawn for this class of works. In any event, although the issue strikes me as sufficiently speculative and complex to warrant a general inquiry at some point, it should not affect the immediate question of the registrability of colorized motion pictures.

If this letter raises any questions, or if there are any points that you would like me to amplify, please do not hesitate to call on me.

Cordially yours,

Paul Goldstein

PG/mmek

Senator LEAHY. After we finish, I would hope that each member of the committee and all the people involved in this issue will read your full testimony. And one of the reasons, of course, I wanted you to join us is your involvement in OTA's recent study on area's where new technology may have surfaced and the laws designed to protect them.

We heard some interesting testimony reflecting sharply differing views on how best to deal with colorization technology. We have made remarkable technological advances which were not even imagined 5 or 10 years ago.

But what do we do with it? Are we going to have to choose between being Luddites or Philistines in this regard? Do we say oh, gee, slam the door, or do we try to do something about it?

Mr. GOLDSTEIN. I do not think that is precisely the choice. I do not think that colorization technology raises any new legal issues that need to be dealt with outside the frame of the current requirements of copyright law, contract law and tort law. There is one area that wasn't testified to at all. The single question that colorization, as a new technology, truly raises for copyright lies in the prospect—not now realized because it's a labor intensive activity—

but that may be realized at some point in the future—10 years, 50 years, who knows—when films might be colorized, indeed whole works might be created, without any intervention of a human hand, without any intervention of a human sensibility. That raises significant questions.

Are the resulting products to be entitled to copyright? I think part of the answer lies on where in the constitutional clause authorizing Congress to enact copyright you place your emphasis. Do you want to place the emphasis on "Authors" or on "Writings"? Do you want to have originality require that, at some level, the human mind reveal its impress in a work?

Those, I think, are the hard questions. They are not presently raised. The present technology leaves no doubt in my mind that these works are protectable. But, for the future there may be problems. We already have computer programs that write computer programs.

Senator LEAHY. Isn't that a philosophical question? As these technological advances come pell mell, one after another, are we too willing to accept change for the sake of change without looking at the long-range implications?

Mr. GOLDSTEIN. I think this is a wonderful occasion for hearings, to stop for a moment and ask precisely those questions.

I would note that there is one very important interconnection, and this extends beyond colorization—the interconnection between copyright policy and patent policy. To the extent that, in the interest of copyright, let's say, or the directors' interest in curbing colorization, you decide to curb colorization, you are effectively curbing the development of a new technology. That interconnection appears in the area of photocopying, and other areas as well.

There is a balancing of interests that needs to be attended to between copyright policy and patent policy.

Senator LEAHY. You see privacy rights here with people colorizing a film and using the artist's name or likeness without permission to publicize the derivative work.

Mr. GOLDSTEIN. It surely does not appear to be privacy in the sense that I conceive of it. I might add that I have not yet been able to get a clear enough fix on the operational consequences of the remarks made by members of the first panel to focus on whether they would like to see this worked out through a privacy route or through a copyright route, or through an entirely separate route. I think their testimony raised far more questions at an operational level than it answered.

Senator LEAHY. This past weekend I went up to my farm in Vermont, brought these huge briefing books that I have here from brilliant staff who have put all this together. They gave me all these things to go over. And I go back and forth and decide as a primary fact it is a fascinating subject, but what do we do now? Where do we go with it?

My next question, partly reading what some of the Berne Convention countries do, leads into this.

Is there any process in either Europe or American intellectual property law for giving leave to the creator of a work whose work becomes more valuable after the creator knowingly and willfully parts with his creation?

Mr. GOLDSTEIN. I was struck that what I thought I was hearing the first panel talk about was the question of moral right. Yet, until I saw the presentation of John Huston on the screen, I didn't hear that phrase used. I don't know if they were studiously staying away from it, or if it was just overlooked. But, to the extent that I can give legal content to the testimony of the first panel, it seems that they are talking to some degree about the continental doctrine of moral right.

I would say, in direct response to your question, that I think it would be wonderful if we began to look at the legal models offered by other countries in responding to many of the same problems that we have here. If anything, copyright policymakers in this country are too xenophobic. We have looked to the United States for the exclusive wisdom of solutions. I would caution, however, on two points.

First, it is common to think of moral right as a unified concept. In fact, it is a multifaceted and a multifarious concept. Moral right is multifaceted in the sense that it covers not only the right against distortion, but in some places a right of withdrawal as well as other rights. It is multifarious in the sense that, although several nations adopt the moral right, none has exactly the same body of law as the other. We must attend carefully, then, to what it is we are talking about when we speak of moral right and recognize as well that we ought not just look at the laws on the books.

German law, for example, might give you the impression that the right against distortion is, in fact, inalienable—that it cannot be waived—and that directors could not waive it even if they wanted to. In fact and in practice, as it works out, it is almost fully, if not fully, waivable.

The other caution I would urge is, if we begin looking abroad for moral right models, we recognize the cultural and political differences that separate many of those nations from the United States.

There is a strong cultural tendency in the civil law tradition to honor authors' rights—a tendency that doesn't exist in the United States. It has cultural roots. To the extent that we want to adopt that, it is a noble object, to be sure, but there may be countervailing considerations, one of them being the principle of freedom of contract which has its own cultural content in this country.

The other caution I would add is that the political systems of other countries differ dramatically from ours in one very important respect. The national government, which has enacted the relevant laws on moral right in France, Germany, and Italy, is a thoroughly centralized government. It is the principal lawmaker in those countries. By contrast, in the United States, with our Federal system, important powers are left to the States. Traditionally, interests in reputation—the interests protected by the law of privacy, publicity, defamation—torts have been the preserve of the States. This would be a notable intrusion, I might add, of the Federal Government into what has traditionally been a State concern.

I am not saying it should preclude that step, but it is another caution that might be considered.

Senator LEAHY. Most of the moral rights clauses have really grown up out of court cases. Invasion of privacy is a definition.

Mr. GOLDSTEIN. Exactly.

Senator LEAHY. I am going to back up and ask you, am I correct that there is no clear-cut line of court cases that would be applicable to the questions we have heard here today?

Mr. GOLDSTEIN. Well, again, if you are dealing with a case where there is no contract, and it is a public domain work, there is little case law.

Actually, one of the most powerful bodies of case laws supporting this approach is Federal case law under section 43(a) of the Lanham Act.

Senator LEAHY. If we wanted to make clear law in this area of moral rights, we have to write the law anew?

Mr. GOLDSTEIN. That is correct, if one wanted to do that.

Senator LEAHY. If one wanted. I realize that becomes a political question as well as a legal question, of course.

Mr. GOLDSTEIN. It is also a resources question. Do you want to rely on a system that has lots of holes in it but does incrementally protect authors' rights, or do you want to spend the time and place that high on your agenda?

Senator LEAHY. I think you stated the issue very well, Professor. I appreciate it.

Again, I appreciate your taking the time to come here. And once you have received your copy of your testimony back, if there is something additional you want to add, don't hesitate to do so. Let me know and we will make it part of the record because I think more and more, as we look back at this question, that you are going to be seen as the wrap-up hitter. It is your testimony we are going to be looking to.

Mr. GOLDSTEIN. Thank you very much.

Senator LEAHY. We will stand in recess subject to the call of the Chair.

[Whereupon, at 12:20 p.m., the subcommittee adjourned, subject to the call of the Chair.]

APPENDIX

ADDITIONAL SUBMISSIONS FOR THE RECORD

Statement of Edward J. Damich

Associate Professor of Law, George Mason University

Submitted to the Subcommittee on Technology and the Law

of the Committee on the Judiciary

United States Senate

On Colorization of Motion Pictures

June 8, 1987

Mr. Chairman, members of the Subcommittee. My name is Edward Damich. I am Associate Professor of Law at George Mason University. I am pleased to be able to submit this testimony for inclusion in the hearings of the Subcommittee on the colorization of black and white motion pictures. The views that I am about to express are my own. I am not acting as advocate for any group.

I am delighted that the Subcommittee has moved so promptly to inform itself and to attempt to identify and prioritize the issues in the colorization controversy. As I see it, the central issue is artistic integrity. I do not oppose colorization because I think that modern viewers need a cultural uplift; I oppose it because the motion picture that they will see will not be the motion picture as it was made.

The claim that colorization widens the audience for classic black and white motion pictures is spurious for the simple reason that viewers will not be seeing those motion pictures at all; rather, they will be seeing distortions of them in colors suggestive of a 1939 World's Fair postcard. (This fact produces a curious dilemma for the colorizers: on the one hand, they must argue that colorizing results in more people seeing the

original--an argument that tends to minimize the effect of colorization on the original; on the other hand, they must argue that the colorized version is sufficiently different from the original to consitute a derivative work--an argument that weakens their claim that they are widening the audience for the original.)

I believe that the authors of motion pictures--as all authors--have the right to have their work presented to the public in the form in which it was created. At a time when the United States is considering adherence to the Berne Convention with its clear moral rights provision (Article 6bis) and at a time when five states have moved in the direction of insuring artistic integrity, it would be anomalous for Congress to withold legal protection for the integrity of black and white motion pictures.

Legal protection of artistic integrity, however, is not a matter of accepting a foreign concept. Even our current copyright law--which I admit is primarily aimed at economic rights--recognizes the non-economic or personal dimension of the creative process. The U.S. Supreme Court, for example, recently reiterated that the personal values of privacy and creative control were implicit in the sec. 106(3) right of first publication. Harper & Row Publishers v. Nation Enterprises, 105 S.Ct. 2218, 2228 (1985). As far back as 1976 the U.S. Court of Appeals for the Second Circuit held that a cause of action to protect artistic integrity was implicit in copyright law. Gilliam v. American Broadcasting Cos., 538 F.2d 14, 24 (1976). (That case involved a broadcast of a Monty Python television program. It should be noted that the "mutilation" identified by the court was the showing of the program--the original versions of the program were unaffected by the defendants' actions.) The Copyright Act of 1976 even contains an express provision protective of artistic integrity. Sec. 115, which deals with compulsory licenses for making and distributing phonorecords, provides that "the arrangement shall not change the basic melody or fundamental character of the work."

The Copyright Act's provision for derivative works does not negate the concept of artistic integrity. The fact that French law provides for both derivative works and for artistic integrity through the concept of droit moral (moral rights) is evidence of the fact that there is no inherent theoretical problem. Francon, Propriete Litteraire et Artistique, 52-53 (1970). Moreover, the requirement of originality in our own Copyright Act indicates a distinction between mere distortions and bona fide derivative works. Indeed, the late Professor Nimmer when writing in his famous treatise on copyright law about the issue of preemption of the artistic

integrity provisions of the California Art Preservation Act supported a distinction between mutilation and defacement on the one hand and true derivative works on the other. Sec. 8.21[D], text accompanying nn. 34.23-.30 (1986).

The distinction is admittedly a fine one, but surely no less evanescent than the concept of originality itself. Compare, for example, the reasoning in Alva Studios v. Winninger, 177 F.Supp. 265 (S.D.N.Y. 1959), where a scale reduction of Rodin's sculpture, "Hand of God," was held to have sufficient originality with L. Batlin & Son v. Snyder, 536 F.2d 486 (2d Cir. 1976), where a plastic model of a cast iron "Uncle Sam" bank was held not to be sufficiently original. When Congress and the courts are convinced that a value should have legal protection, imprecise distinctions have proved workable.

Common law copyright is another indication that the personal dimension of the creative process has been recognized in American law. Warren and Brandeis, for example, relied on the privacy protection aspect of the common law right of first publication in their famous article to prove that the value of privacy had been given legal recognition in American law. "The Right of Privacy," 4 Harv. L. Rev. 193 (1890). The fact that common law copyright has largely been preempted by the 1976 Copyright Act does not negate the point that American law has been appreciative of the non-economic aspects of copyright, one of which is artistic integrity. Indeed, the U.S. Supreme Court in Harper & Row drew on the personal aspect of the common law right of first publication in arriving at its decision regarding sec. 106(3) of the current Act. Supra at 2226-27.

Thus far I have tried to prove that there is ample evidence in American copyright law, both common and statutory, of the recognition of personal values, such as artistic integrity. Although this recognition is emerging more and more out of the background of copyright law through cases such as Harper & Row and through awareness of the structure of copyright law in other countries, such as the adherents of Berne, federal legislation is necessary not only to fix the concept firmly in the American legal consciousness, but also to deal with the more pressing, concrete violations of the personal rights of authors such as the infringement of the artistic integrity of black and white motion pictures through colorization.

The law of contract interpretation and the Federal Trademark Act are not adequate to insure the artistic integrity of motion pictures. What I have said regarding moral rights in general in my comment on the Report of

the Ad Hoc Working Group on U.S. Adherence to the Berne Convention is equally applicable to the constituent right of artistic integrity: "[T]he attempt to find inchoate moral rights protection in more familiar causes of action is largely wishful thinking." 10 Colum.-VLA J. Law & Arts 655, 662 (1986).

There are only a few cases that, through a close reading, suggest a right of integrity separate from the issue of attribution. Preminger v. Columbia Pictures, 148 U.S.P.Q. 398, 402 (N.Y. Sup. Ct. 1966); Stevens v. NBC, 148 U.S.P.Q. 755, 758 (Cal. Super. Ct. 1966); Autry v. Republic Productions, 213 F.2d 667 (9th Cir. 1954). Most of the cases confuse the issue with that of reputation. In other words, the issue becomes the association of the name of the author with a distorted or mutilated work such that his/her reputation is imperiled. Although this is a legitimate concern, the main issue in colorization as I see it is less the damage to the author's reputation that may result from the association of his/her name with the colorized version, and more the fact that his/her work has been distorted whether it is attributed to him or not.

The same confusion manifests itself when reliance on sec. 43(a) of the Federal Trademark Act (the Lanham Act) is urged. Again, sec. 43(a) is aimed at deceptive practices, a concept that seems to require attribution of a distorted work. Is it conceivable that Woody Allen would feel that his complaint was addressed merely by a disclaimer of authorship of a colorized version of Broadway Danny Rose?

I do not, however, wish to overstate my case. It is possible that contract interpretation and the Federal Trademark Act could evolve into protection of artistic integrity; indeed, the recognition of a Lanham Act cause of action in Gilliam (supra at 24-25) is promising. The disclaimer issue, however, is bound to bedevil such attempts, and the normally slow, gradual progress of case law is a luxury that cannot be indulged in given the pace at which black and white motion pictures are being colorized.

I would like to conclude by reiterating that for me the issue of artistic integrity is at stake in the colorization controversy. It is not a question of dictating the tastes of the viewing public, but rather of protecting an author's right to have his/her work presented to the public in the form in which it was created. A deep understanding of the values protected by American copyright law reveals a sensitivity to this personal aspect of artistic creativity. This understanding is further confirmed by the experience of other nations who have expressly protected artistic

integrity for years without discernible negative impact on the production of derivative works.

Article 6bis of the Berne Convention states:

> (1) Independently of the author's economic rights, and even after the transfer of the said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation, or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation.

If Congress is seriously considering subscribing to these principles, it would seem appropriate to move in that direction by protecting the artistic integrity of black and white motion pictures, and eventually to expressly provide in our Copyright Act for the comprehensive protection of the personal dimension of the creative process.

Paint Your Wagon - Please!: Colorization, Copyright and the Search for Moral Rights.

David J. Kohs

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"Citizen Kane could definitely be colored. It would be easier on the eye."

- Brian Holmes, director of creative services for Colorization, Inc.

"They have the sensitivity of wallpaper."

- film director Richard Brooks, in response to the argument that attempts to interfere with the colorization process amount to censorship.

"The last time I checked I owned those films."

- notorious "colorizer" Ted Turner.

A war is being waged over the colorization of old black-and-white films.[1] The battle lines are for the most part clearly drawn. On the one side are colorization firms and television moguls such as Ted Turner, who have invested millions of dollars in the exploitation of this new technology. In opposition to colorization are film directors, both old and new, as well as such professional organizations as the Directors Guild of America and the Screen Actors Guild. Scattered among the two sides are film critics and film viewers. It is perhaps the opinion of this latter group, the viewing public, which will ultimately determine the success or failure of the colorization industry.

This battle for public opinion is currently being waged in the press and other media.[2] It will no doubt eventually take on more of a legal character and invade the courts and perhaps the legislatures of our country. While creative and artistic objections to colorization are easily articulated, it is much

more uncertain exactly what legal obstacles might actually stand in the way of the process. This article will examine the colorization process and briefly describe the various components of intellectual property law which might, either successfully or not, be invoked in response to the issue. In particular, our system of copyright protection will be examined as it relates to colorization, with emphasis on its notable absence of protection for moral, as opposed to economic, rights of authors and creators.[3] Finally, the relative merit of construing these legal theories to defeat the colorization of black-and-white films will be addressed, along with some possible recommendations.

Colorization of Old Films - The Money of Color

The new technology which allows the coloring of movies originally filmed in black-and-white was developed independently by three computer companies, Colorization, Inc., Color Systems Technology, Inc., and Tintaretto, Inc. Of the three, Colorization, Inc. and C.S.T. figure most prominently in the current colorization controversy. Both these firms apply color mainly to feature length black-and-white films, usually under contract with the owner of the copyright in such films. Or, in the case of public domain films, meaning films whose copyrights have expired, these colorization firms apply their trade without the necessity of contractual agreement.[4] Tintaretto, a Canadian based firm, has presently confined its activities to colorized, updated versions of old "music videos" of Fred Astaire, Frank Sinatra and the like.

The colorization process is essentially akin to painting by numbers, only with computer sophistication. A computer artist initially colors a single frame of a film, assigning one of some 50,000 available hues to each of the 525,000 pixels, or dots, which may comprise any given frame. Once this frame has been colored, the computer keeps track of the object as it moves from frame to frame, but only until the scene changes. When a new scene appears, the process must be repeated. For this reason, the colorization process is painstakingly slow, and sometimes takes several hours to complete just one minute of film.[5] The process is very expensive as well: It can cost upward of $3,000 per colorized minute - about $300,000 per feature length film.

In spite of the steep initial cost, colorization means big bucks for the owner of the revised film. Black-and-white films have a low market value, especially to a younger generation which has known almost nothing but color in its lifetime. In contrast, it is estimated that a typical colorized movie could be worth over $2,000,000 from television and video cassette sales alone. Recent experience has supported such an estimate: A recent television broadcast of the colorized version of The Maltese Falcon resulted in almost a 65% increase in market-share rating.[6] Accordingly, advertising time slotted to future colorized broadcasts is now sold out months, even years, in advance. Since over 1/3 of all movies made to date were filmed in black-and-white, the available supply and potential market for colorized films is staggering.

Today's foremost vehicle for colorized films is Ted Turner's

"Color Classic Network". Recently, Turner paid $1.2 billion for MGM's collection of over 3000 old movies, which includes pre-1948 Warner Brothers and RKO films. Subsequently, Turner contracted with CST to colorize 100 of these films. Already colorized are Yankee Doodle Dandy, Miracle on 34th Street, Casablanca, and The Maltese Falcon. Films still to be colorized include Father of the Bride, They Drive by Night, and The Bad and the Beautiful. Hal Roach Studios, which owns 50% of Colorization, Inc., has already reached an agreement with Otto Preminger Films to colorize The Moon is Blue, The Man With the Golden Arm, Saint Joan, and Advise and Consent.[7] In addition, Colorization, Inc. has already completed public domain films such as Topper, Way Out West and It's a Wonderful Life.[8]

Technical results of the colorization process have been varied. On early conversions like Topper, the colors have a tendency to follow the objects around the screen imperfectly. For instance, the color representing Cary Grant's hands often strays from his limbs and into midair, creating a flickering effect. A common criticism is that the colors produced are by no means what we associate with those of contemporary color films, but are rather pale, pastel colors. Vivid colors such as red are difficult, if not impossible, to reproduce. Frank Sinatra's eyes and Humphrey Bogart's hair have also proven especially troublesome. Nonetheless, the results obtained in such conversions as Way Out West and Yankee Doodle Dandy have been viewed by some as technically very good.

CST and Colorization, Inc., while using essentially similar

technology, take different approaches toward their respective products. Before assigning color values to film, CST performs often extensive research in an effort to "authenticate" its work. First, it tries to locate someone who was actually involved in the production of the original black-and-white work, in an attempt to match actual set and costume colors. If this fails, CST's research department attempts to determine these actual colors through alternate means. In contrast, Colorization, Inc. makes no attempt to match its assigned colors with actual colors. Says chairman Earl Glick, "We give the pictures the modern look we think the audience would like to see fit today's times".

"Authentic" colors or not, Hollywood directors are virtually unanimous in their hostility towards colorization of original black-and-white films. Woody Allen, Martin Scorsese, Arthur Hiller and Peter Bogdanovich have all taken vocal public stands against the process. Recently, an ailing John Huston appeared at a news conference in wheelchair and oxygen mask to denounce the colorization of his Maltese Falcon. The American Film Institute recently joined the fray by holding a meeting at which actor Jimmy Stewart spoke critically of the conversion of It's a Wonderful Life.[9] Additionally, a host of other professional and arts organizations have come out against colorization.[10]

The crux of the controversy is essentially one of ownership versus creative rights. As directors are quick to point out, black-and-white is not merely the absence of color, but rather constitutes an array of creative choices. Black-and-white films were conceived, designed and photographed to be black-and-white

films. The medium has its own set of rules and effects in regard to lighting, contrast, framing and camera use. Furthermore, recent black-and-white movies such as The Wild Child and Elephant Man, shot in an era when directors clearly have a well developed color alternative, attest to the fact black-and-white films have a unique mood and aesthetic character. It is easy for directors to argue that artistic intent justifies preservation of the integrity of their black-and-white works. It is a different question indeed as to whether they have an equally compelling legal argument.

When Art and Commerce Collide - Copyright and Moral Rights

Copyright is a legal fiction which developed somewhat independently under various national legal systems to regulate, and ultimately encourage, the flow of intellectual works. Essentially, it is a monopolistic right, generally limited in duration, which was first conferred upon publishers and later upon authors.[11] Without copyright, an author would have little, if any, incentive to ever publish or make known his work. Upon first revelation of the work, anyone would be free to duplicate the work and sell it. The work would become essentially a commodity item of little remaining value to the author. By granting a copyright holder, usually the author or artist, the right to commercially exploit a work for at least a limited time, development, revelation and dissemination of creative works is encouraged.

Historically, there are two dominant theories which have

been used to legitimize this limited monopoly on literary and artistic works. The first is copyright - or literally, the right to copy. Copyright is an exclusive right to perform specified, essentially commercial, acts in relation to a work. By granting the right to do such things as make and sell copies of a literary or artistic work, copyright recognizes and protects the economic or pecuniary rights of the copyright owner.

The second dominant theory justifying protection of creative works is the droit d'auteur or author's right. In contrast to copyright, which only recognizes pecuniary rights, droit d'auteur additionally recognizes moral or personal rights of the author or artist, distinct from his economic rights and interests. Under this theory, the droit d'auteur is vested personally in a work's creator in recognition of the unique relationship he shares with it. While almost universally recognized in continental European countries, the notion of author's right has never become imbedded in Anglo-American law.[12]

Our 1976 Copyright Act, promulgated pursuant to Congress' constitutional authority, continues our country's heritage of safeguarding only the pecuniary interests of copyright owners.[13] Thus, the Act focuses on the economic value of copyright by granting the copyright owner the exclusive right to produce and distribute the original work, prepare and distribute derivative works, and to perform or display publicly most types of copyrighted works.[14]

Most pertinent to the colorization of existing black-and-white movies is this second exclusive right - the right to

prepare and distribute derivative works based upon the original copyrighted work.[15] This right is an important and valuable right to the copyright owner of the existing black-and-white film. It permits him to not only prevent the unauthorized duplication and distribution of the original film, but also to prevent the unauthorized making and distribution of a derivative, i.e. colorized, version of the same film. Thus, where the "author" of such a film is in possession of the copyright, no colorization problem exists because a colorized version of the film may not be made without his permission.[16]

Still, the Copyright Act provides little protection to the most vocal opponents of colorization - namely, directors, actors and other creative participants to the movie making process. While copyright usually initially vests in what we would ordinarily consider the "author" of a work, i.e. the writer of a novel or the painter of a painting, motion pictures are generally deemed "works make for hire" under the Act, with copyright vesting in the "employer" for whom the work was prepared.[17] In the case of motion pictures, this employer is usually a production company or studio which distributes the film. While individual contributions such as the mise en scene or "style" of the director, cinematographer and film editor, are protected by copyright, this copyright vests in the "employer" and not the individual creative participants to the film making process. Thus, except in the rare instance where a director also produces a film and is otherwise an "employer" for purposes of the Copyright Act,[18] the right to exploit his creative contribution,

or object to an alteration of the same, is not his to assert.[19] Furthermore, the copyright owner, usually a production company or major studio, has economic interests which are generally adverse to the director's interest in preserving the artistic integrity of his work.

Even where a director plies his trade for a sympathetic employer who is unwilling to authorize the colorization of the finished work, the limited duration of protection afforded by copyright ensures that any other person may eventually create a colorized version of the original film. Under the Copyright Act, the maximum duration of protection for most types of work does not exceed 75 years.[20] Prior to the 1976 Act, this term of protection was shorter, generally not exceeding 56 years.[21] As a result, after the expiration of this prescribed period of time, a copyrighted work drops into the public domain, and anyone can exercise any of the formally "exclusive" rights in relation to the work.[22] Thus, after this time colorizers can, and do, color existing black-and-white films without obtaining anyone's permission.[23] By recognizing only economic rights, which may be exploited for only a limited amount of time, the Copyright Act essentially assures that a colorized version of a black-and-white film may eventually be made.

In direct contrast to the our Copyright Act are national schemes of protection of intellectual works which recognize the droit d'auteur, or author's right. This form of protection recognizes and protects both economic and moral rights of the author. This distinction is perhaps most clearly expressed by

French copyright law which provides in relevant part:

> The author of an intellectual work shall, by the mere fact of its creation, enjoy an incorporeal property right in the work, effective against all persons. This right includes attributes of an intellectual or moral nature as well as attributes of an economic nature as determined by this law.[24]

The precise scope of these moral rights vary in part among jurisdictions which recognize and protect them, but the doctrine generally encompasses three major components: the right of disclosure, the right of paternity, and the right of integrity.[25]

The right of disclosure and its corollary, the right to refuse to disclose, are manifestations of the belief that the creator is the sole judge of when a work is first ready for public disclosure. Pursuant to this theory, it is only the author who can posses any rights in an uncompleted work.[26] Prior to circulation of his work, the author retains the sole right to determine both the completed form of the work, as well as the time public circulation will commence. Similarly, the second component of moral right, the right of paternity, recognizes the author's unique relationship to his work. Paternity safeguards a creator's right to compel recognition for his work, and additionally prevents the recognition of anyone else as the creator. Conversely, the right additionally protects an author in the event someone falsely attributes another's work to him.[27]

Most pertinent to the colorization issue is the third component of moral right - the right of integrity. Integrity is perhaps the most powerful of all the moral rights in that it empowers the author to prevent any distortion or modification to

his work which would constitute a misrepresentation of his artistic expression.[28] This right, as the other moral rights, is held by the author or creator independently of any economic rights he may or may not have in the work. The Berne Convention, an international union for the protection of authors' and artists' rights, provides in relevant part:

> Independently of the author's economic rights, and even after the transfer of said rights, the author shall have the right to claim authorship of the work and object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honour or reputation.[29]

Under the Berne Union, the "author" of a film would clearly be able to prevent the colorization of the same, at least if the alteration would prove "prejudicial to his honour or reputation." This right would be held regardless of whether he had any continuing economic interest in the film. The United States is not a signatory to the Berne Convention,[30] and for good reason: The Convention's recognition of moral, as opposed to economic, rights is contrary to our own domestic scheme of copyright protection.

A second, yet related, difference exists between copyright protection under our 1976 Act and in those countries recognizing moral rights. Under our 1976 Act, ownership of the copyright in a motion picture generally vests initially in the "employer" in relation to the project.[31] This employer is generally a production company or film studio. In contrast, in droit d'auteur countries such as France, owners of the copyright in a

motion picture include the individuals who contributed creatively to the finished work: individuals such as directors, cinematographers and film editors.[32] Thus, in contrast to our country's protective scheme, the "author" of a motion picture in such moral rights countries is not a production company or other employer, but rather the very creative contributors who make the film.

Such a theory of copyright protection, i.e. one that allows individual creative contributors to enforce rights individually and on their own behalf, has perhaps a pertinent parallel in conflicting paradigms which have arisen in relation to film making. Classic Hollywood's generally accepted conception of the film director's contribution has in essence been one of an "invisible style". Under this paradigm, the directorial contribution, as well as every other cinematic element, is viewed as most effective when subordinated to the interests of the movie's narrative.[33] This traditional subordination of style to story is paralleled by our country's scheme for protection of motion pictures by copyright. While a director's mise en scene, or style, is indeed creative enough to warrant copyright protection,[34] it is perhaps viewed as too intermeshed and inseparable from the completed work as a whole to warrant enforcement by anyone other than a common "employer".

In contrast, the la politique des auteurs, or "auteur", theory represents a film paradigm in direct conflict with Hollywood's "invisible style". First advocated by the French "New Wave" film makers, the auteur theory advocates the director

as the "author" and preeminent personality inscribed in a film.[35] Pursuant to the auteur view, the directorial contribution is viewed as independent of and dominant to the film's narrative. The camera is a stylus, and the movie in essence is a mirror expression of the director's personality. It is not surprising then that a country such as France, birthplace of the New Wave movement, recognizes a personal right of the director to prevent the unauthorized alteration of his film.

While such a system of enforcement of non-economic moral rights via copyright law may be satisfying from an artistic viewpoint, it would never meet the demands of the commercial marketplace if enforced without restrictions. Due to the scanning, panning and editing functions which are usually necessary to present a theatrical film in television format, it might be possible for a single unreasonable director or film editor, by personally invoking his moral rights, to prevent indefinitely the television broadcast of a film. For this reason, most countries recognizing moral rights limit in some fashion the type of alterations to which an author or creative contributor may object. Thus, the French judiciary will allow, if not otherwise violative of copyright, reasonable alterations that do not distort the spirit of the creator's work, particularly where the creator's work is a contribution to a collective work.[36] Similarly, the Berne Convention specifically limits the types of alterations to a work to which individual creative contributors may object.[37]

Thus, in most droit d'auteur countries, only certain

alterations meeting some pertinent standard of reasonableness may be made without offending the moral right.[38] While there is not yet any caselaw on point, it would seem that colorization, without at least the director's consent, would indeed violate the moral right. The process is not one of the established "reasonable" types of alterations recognized as permissible under moral rights schemes, and could be fairly described as altering the spirit of the original black-and-white work.

Backdooring Moral Rights - Some Copyright Alternatives

With one notable exception, our 1976 Copyright Act is completely devoid of any recognition for the moral rights of authors or artists. This limited exception deals with recognition of the moral rights of songwriters. While the Act grants to a musician the right to make, perform and record his own version of a songwriter's original musical work, he is subject to certain limitations with respect to the songwriter's moral rights. The Copyright Act specifically provides that the new version may not change the basic melody or fundamental character of the original song without the express consent of the copyright owner.[39] Thus, while the Act otherwise recognizes the economic rights of the songwriter through an elaborate forced royalty scheme, it additionally recognizes his moral rights by ensuring that any remake of his work may not substantially alter it.[40]

It is tempting to draw an analogy to this recognition afforded the moral rights of songwriters and assert that film

directors should similarly be able to prevent the unauthorized colorization of their work. There is, however, one critical distinction in the Copyright Act's respective protection afforded these distinct forms of authorship which obviates this otherwise compelling argument. In the case of motion pictures, a copyright owner may see to it that, at least for the duration of his copyright, no other version of his film is ever made. This is because only he holds the exclusive and absolute right to make derivative versions of the original film.[41]

In contrast, the drafters of the Copyright Act saw fit not to grant this exclusive right to the owner of copyright in a musical composition. Fearful that any greater protection would give the songwriter an unjustified monopoly in the performance and recording of his original work, Congress provided that any other persons may, pursuant to a compulsory license scheme, do either of these acts upon payment of a statutory royalty to the owner of copyright in the original musical work.[42] Thus, being unable to prevent for any period of time the performance or recording of his original musical work by others, it makes sense to at least ensure the songwriter that any such derivative works will not make a travesty of his original creation.[43] When viewed in this light, the Act's recognition of the moral rights of songwriters but not film directors appears, at the very least, rational.

In light of the almost complete statutory absence of protection for moral rights of authors and artists, American courts have sometimes strained to make factual interpretations

leading to an unspoken recognition of these same moral rights. One such example is Gilliam v. American Broadcasting Companies, Inc.,[44] a case involving the American broadcast of the popular Monty Python's Flying Circus television series. In Gilliam, Plaintiff writers and performers had previously struck a deal with the BBC for British broadcast of their original shows.[45] The BBC, pursuant to this agreement, additionally licensed the overseas broadcast of the series, specifically granting to licensees the right to edit the programs for commercials and applicable censorship purposes.[46] Interestingly, the agreement did not specifically grant this same right to the BBC for its own domestic broadcast of the Python shows.[47]

Plaintiffs subsequently brought an action to enjoin what it deemed to be an unauthorized mutilated American broadcast of its original work.[48] The court acknowledged that it was unclear under the agreement whether it was the Monty Python group or the BBC which owned the copyright in the completed programs produced by the BBC.[49] Nonetheless, the court noted that nothing in the agreement specifically entitled the BBC to alter a program once it had been recorded, and held the alterations for American television exceeded the scope of any license the BBC was entitled to grant.[50]

The Gilliam court determined it was essentially irrelevant whether the agreement merely created a limited license in the BBC, or in fact gave to the BBC all the exclusive rights associated with copyright, save the right to alter a previously recorded program.[51] Yet this distinction is in fact crucial to

the correct outcome of the case. If the agreement in fact granted merely a limited license of broadcast to the BBC, then it is reasonable to conclude the BBC had no right to authorize edited rebroadcast of the shows absent specific mention of this right in the contract. However, if the agreement in fact conveyed copyright to the BBC, then it is just as reasonable to require the contract spell out any specific rights in the work reserved by Plaintiffs.

In its haste to grant de facto recognition to Plaintiffs' moral rights, the Gilliam court, by giving a strained interpretation to an admittedly ambiguous contract, sidestepped fundamental limitations imposed by our copyright law. While expressly recognizing that American copyright law provides no cause of action for protection of moral, rather than economic, rights of authors, the court went on to state:

> "Our resolution of these technical arguments serves to reinforce our initial inclination that the copyright law should be used to recognize the important role of the artist in our society and the need to encourage production and dissemination of artistic works by providing adequate legal protection for one who submits his work to the public....[C]ourts have long granted relief for misrepresentation of an artist's work by relying on theories outside the statutory law of copyright, such as contract law. [citations omitted] Although such decisions are clothed in terms of proprietary right in one's creation, they also properly vindicate the author's personal right to prevent the presentation of his work to the public in distorted form."[52]

While the Gilliam decision does sound quite like improper judicial legislation for the protection of moral rights, it does raise the important point that certain moral rights might be

legitimately safeguarded by a properly drafted contract. In the context of film making, copyright in this country will not normally vest in the director, or any other creative participant for that matter.[53] Rather, it will generally vest in the production company or studio employing the individual participants creating the film. Yet, a director contemplating making a black-and-white film for such an employer might insist upon a contractual provision that the employer will never authorize the creation of a colorized version of the film. Even if the employer later finds it economically necessary to later sell his copyright in the film to a third party, he can transfer all exclusive rights but the right to prepare a derivative colorized work.[54]

Yet there exist practical limitations to the contractual protection of directors' moral rights from colorization. First, while "name" directors such as Woody Allen now regularly insist upon such contractual provisions before directing a black-and-white movie, it is perhaps unreasonable to believe lesser known directors might be able to negotiate a similar guaranty. Second, works presently threatened by the colorization process were made long before anyone contemplated the possible colorization of films. It is now too late to "rewrite" these contracts between directors and production companies. Even if it weren't too late, most of these films are now owned by television concerns such as the Turner Network, which are desperately eager to offer colorized versions. Third, even as to black-and-white films yet to be made, the longest anyone would be able to thwart the

colorization process would be a period equal to the duration of the copyright in the film itself. After this period, which is generally 75 years, the film falls into the public domain and anyone is free to make a colorized version.[55]

Ironically, instead of contract, it is copyright, our very body of law which denies recognition to moral rights, which might eventually prove the death knell of the colorization process. In order to be subject to copyright protection, a work must first meet some minimal standard of creativity.[56] This requirement has traditionally been imposed in order to meet the dual constitutional requirements of "author" and "writings", both of which must be satisfied before copyright protection may be afforded.[57] For this reason, the 1976 Copyright Act only protects "original works of authorship".[58] Thus, in order to be entitled to copyright protection, the creator of a colorized version of a film must first show that the colorized product is sufficiently original and varied from the original black-and-white work to itself merit copyright protection.

The level of variation traditionally required in order for a derivative work to support a copyright independent of the original work has been described alternately as "more than merely trivial variation"[59] and "substantial variation"[60] from the underlying work. Ironically, it is here that colorizers begin to sing two different songs. In response to directors' artistic objections to colorization, proponents of the process argue colorization alters neither the essential character nor essence of the underlying black-and-white film. Yet, when dealing with

the issue of copyrightability of the altered version, colorizers insist colorized versions of films satisfy even the more rigorous "substantial variation" test of originality.

How the courts eventually decide this issue will have a substantial, if not dispositive, effect upon the future of colorization. If the courts decide colorized films do not meet the applicable standard of originality necessary to support independent copyright, colorization of black-and-white films already in the public domain will effectively come to a standstill. With no originality sufficient to support an independent copyright and no copyright remaining in the original underlying work, anyone would be free to duplicate and exploit the colorized version of a public domain film without compensation to the colorizer. Such a decision would prove especially devastating to firms which have already spent hundreds of thousands of dollars to colorize such public domain films.[61]

Similarly, a finding that colorization lacks sufficient originality to independently sustain copyright would also have a detrimental effect on colorizers, such as Ted Turner, who own the copyright in the underlying black-and-white film. With no independent copyright in the colorized version, such persons could only protect their colorized work from duplication and exploitation for as long as their copyright in the underlying work survives. Most of these underlying black-and-white works are rapidly nearing the end of their prescribed terms of copyright protection.[62] Given the tremendous costs associated with creating colorized versions of such films, it is doubtful

whether new versions would be made in light of this extremely limited period for exclusive economic exploitation.

Yet the sounder legal argument would seem to be that colorized versions of films are, in fact, sufficiently original to support an independent copyright. Courts have repeatedly stated that imposing an unduly demanding standard of originality for copyright protection would lead judges to inappropriately engage in value judgments as to the worth of artistic works. As stated by none other than Justice Holmes: "It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of [artistic works]."63

Furthermore, the judicial trend from the "more than merely trivial variation" to the more demanding "substantial variation" standard of originality appears to have begun subsequent to the drafting and adoption of the 1976 Copyright Act.64 The trend is directly contrary to the legislative history of the Act, which reveals Congress intended to incorporate the standard of originality which courts had previously established.65 Prior to the drafting of the Act, this established judicial standard was clearly the less demanding "more than merely trivial variation" test.

Pursuant to case law construing other types of copyrightable works, courts have held that original combinations or arrangements of colors are properly regarded as artistic creations deserving of copyright protection.66 Additionally, the tremendous skill and labor involved in the colorization process

may properly be considered as evidence of originality.[67] Neither should the fact that colorization is aided by use of a new technology mitigate against a finding that colorized versions of films are creative enough to support an independent copyright.[68]

Perhaps most important, colorization's worth can most clearly be shown by the fact that, given the legal right to do so, other entrepreneurs would surely wish to expropriate and exploit a colorized work. As stated by one court: "[If a work has] merit and value enough to be the object of piracy, it should also be of sufficient importance to be entitled to protection."[69] Thus, placing all artistic objections aside, sound legal principals dictate the conclusion colorization does meet the de minimis originality requirement of copyright, and colorized versions of films are independently entitled to copyright protection.[70]

Contrary to this seemingly sound legal analysis, artistic objections to the colorization process have made headway in legal forums. To date, the United States Copyright Office has refused to issue certificates of copyright registration for colorized motion pictures.[71] Instead, in response to objections regarding the process, the Copyright Office has recently issued a notice of inquiry inviting public comments on the copyrightability of colorized motion pictures.[72] While not a requisite to bringing a copyright infringement suit, a certificate of registration does constitute prima facie evidence of the validity of a copyright in any judicial proceeding.[73]

In spite of the Copyright Office's refusal to register

colorized films, potential pirates have been reluctant to test in court the validity of the colorizers' copyright claim. Although colorized versions of public domain movies have already been repeatedly broadcast on television, there is not yet one reported instance of expropriation and commercial exploitation of any of these films. This is in spite of the fact that such an act would be no more difficult than videotaping and making copies of any scheduled commercial broadcast. Perhaps potential film pirates have given more thought to the validity of the colorization industry's copyright argument than has the United States Copyright Office.

Some Non-Copyright Alternatives - The Rest of the Intellectual Property Law Arsenal

In light of the Copyright Act's general absence of protection for moral rights, it has been urged that an aggrieved party might be able to look to other areas of intellectual property law for vindication of these same rights.[74] Three specific branches of this body of law shall be briefly examined, and their respective relevance to the specific issue of colorization considered.

The common law recognizes a right of publicity, which protects the proprietary interest of an individual in the commercial exploitation of his act, name, or likeness.[75] This right stems from the tort law of privacy, and is now codified in many states.[76] Essentially, the cause of action arises when a person's name or likeness is commercially appropriated without

that person's consent.[77] At least one commentator has said this right of publicity will inevitably be violated when producers of colorized films use the names and likenesses of actors and directors in conjunction with the commercial use of such a film.[78] Such an argument is simplistic and ignores the commercial realities of film making.

While proprietors of colorized films do in fact make commercial use of the names and likenesses of actors and directors, this is not necessarily done without consent. Standard in any employment contract between original film producers and actors or directors are clauses permitting the producer to use commercially the latter's names and likenesses.[79] This right extends to subsequent adaptations and derivative uses of the motion picture by the original or successor copyright owners.[80] Yet, it is argued, upon expiration of the original copyright into the public domain, a colorizer may no longer exercise this contractual right to use these names and likenesses.[81]

This argument misunderstands the nature of the public domain function. Public domain deals solely with the expiration of any of the exclusive copyrights formally held by a copyright owner.[82] It does nothing to alter any contractual relations previously existing between or among parties - public domain does not give back to actors and directors what they contracted away prior to expiration of the work into the public domain.[83]

Even if an actor or director had the foresight and the leverage to contract with the original film producer to never use

or authorize use of his name or likeness in conjunction with a colorized version of the film, the provision would be of limited benefit. Unlike contract rights, rights of publicity are personal and sustainable only during the lifetime of the actor or director.[84] Upon the actor's or director's death, any other party would be able to make free use of his name and likeness, in spite of any contractual provisions to the contrary. Thus, the right of publicity is, at best, of limited utility to actors and directors in their war against colorization.

It has similarly been suggested that a director aggrieved by the colorization process might be able to assert a cause of action pursuant to our federal law of unfair competition.[85] Section 43(a) of the Lanham Act protects the public from the false designation of the origin of goods or services, as well as false descriptions or representations of the same.[86] By presenting a colorized work, at least in part, as that of the original director's, a colorizer might be said to be misrepresenting the origin of the colorized film.[87] In essence, the director is presented to the public as the creator of a work that is not really his own, possibly subjecting him to criticism for work he has not in fact done.[88]

At first blush, Lanham protection has a certain appeal. In fact, the court in Gilliam stated in dicta that a "mutilated" version of plaintiff's work, if accompanied by plaintiff's name, constituted a violation of Section 43(a).[89] Yet the Lanham Act does not protect moral rights. Like state unfair competition laws, the Act's purpose is merely to protect the public against

deception.[90] Any Lanham danger experienced by a colorizer could easily be remedied by an effective disclaimer, negating any inference that the director of the original film is in any way connected with the colorized version.[91]

Furthermore, absent any contractual obligation to the contrary, the colorizer could simply decide not to include the director's name in the credits of the colorized film. The right of paternity, meaning the right to have one's work attributed to himself, is a moral right not recognized by our Copyright Act.[92] Thus, like rights of publicity, Section 43(a) of the Lanham Act provides little protection for a director aggrieved by the colorization process.

A third distinct area of intellectual property law which bears upon the alteration of creative works is state legislation for the protection of the fine arts. Four states now prevent the physical alteration, mutilation, or destruction of certain works of fine art.[93] This protection is distinct and beyond that afforded by copyright, which does not concern the material object in which a work is embodied.[94] By preserving the integrity of an artist's work even after the artist has sold the work and has no further economic interest in the same, these statutes implicitly recognize moral rights.[95]

Only one of these states, Massachusetts, defines "fine art" to include motion pictures.[96] Yet even here, the mechanics of the colorization process still allow the colorizer to ply his trade. The colorization process begins with the transfer of the original black-and-white film to a videotape. It is only this

copy which is altered, the original film remains unchanged. Thus, there is no defacement of an original work of art as required by the act.[97]

Even if alteration of the original film were necessary, the Massachusetts statute would still fail to prevent most acts of colorization. Like other states, Massachusetts does not protect artistic works created in an employment relationship.[98] This necessarily excludes almost every feature length film currently threatened by the colorization process.[99] In spite of Massachusetts' apparent inclusion of motion pictures, these statutes are really designed to protect generally unduplicated forms of fine visual art - paintings and sculptural works for example. For this reason, even the Massachusetts statute provides little, if any, protection from colorization.

Coping with Colorization - Let's Not Cut Off Ted's Arm to Spite Our Face.

As we have seen, the European model of copyright protection, by recognizing moral rights, specifically acknowledges the unique relationship between an author and his work, and of the two in relation to society in general.[100] In addition to traditional copyright protection for the economic rights of authors and artists, recognition of moral rights constitutes an additional reward to these creative persons for their works.

In contrast, our American model of copyright protection, by generally failing to recognize moral rights, limits the type of benefits conferred to authors and artists in acknowledgment of

their work.[101] While economic rewards are provided these persons, these are viewed only as a necessary step in ensuring society ultimately benefits by the disclosure of creative works. Thus, economic protection of authors and artists, which is limited in duration, is not so much for the personal benefit of these creative persons, but for benefit society in general.

This fundamental difference in these respective systems of copyright is brought to the forefront by the colorization controversy. To a film director, black-and-white is more than just a medium, but is rather a part of the very message of the film. Richard Brooks, who directed In Cold Blood, has observed: "When anyone's afraid, it's in black and white, not color. It should not be pretty. It should be stark. The footsteps that come from a candy-colored spectrum are not the same as footsteps that come in the dark." Similarly, Orson Wells, director of the black-and-white classic Citizen Kane, has said that no truly great performance has ever been filmed on color film.

Whether or not these artistic declarations are true, our system of copyright fails to protect an artist's creative, as opposed to economic, interests. When economic rights collide with creative choice, the latter necessarily must give way. At least in regard to protection of the oldest black-and-white films, proponents of colorization have attempted to justify this result on the basis there is no real creative choice to protect. They claim that film technology had not yet developed a color alternative at the time most of these films were made, therefore directors shot in black-and-white out of necessity and not by

choice. Given color technology, it is said, these directors would have originally chosen to shoot their movies on color film.

This argument is not necessarily true. Black-and-white classics such as The Red Badge of Courage, High Noon, and A Place in the Sun were filmed at a time color films were both technologically and commercially practical.[102] Similarly, many movies are yet today filmed in black-and-white, in recognition of the uniqueness and character of the medium. It can not be categorically stated that, given a well developed color alternative, the earliest movie makers would have always chosen to film in color.

Yet the colorization process is not entirely without parallel in the history of movie making. Years before true color film was developed, certain theatrical releases would be uniformly tinted with a colored dye for editorial effect.[103] Other movie makers went as far as to hand paint, frame by frame, their otherwise black-and-white films prior to release.[104] Similarly, as soon as technology permitted, the late D.W. Griffith began dubbing sound versions of his early silent works.[105] However, unlike the present colorization controversy, these earlier alterations were generally performed with the consent of the original director.

Colorizers additionally justify their art on the ground that the original black-and-white work will continue to exist, it being merely a copy of that work which is altered by the colorization process.[106] Yet this argument may be merely academic. As a practical matter, these films will be principally

accessible on television and in video cassette in the form they are marketed. Given the tremendous financial investment required for colorization, it is likely to be the colored version which will, perhaps exclusively, be marketed. The public cannot go into the archive to see the original black-and-white print. As a result, original black-and-white works might indeed be effectively done away with by colorization.[107]

While recognition of moral rights to prevent the colorization of existing black-and-white films has clear artistic appeal, it might actually ultimately discourage the creation and dissemination of creative works generally. Copyright in most motion pictures, pursuant to the American model of protection, vests initially in an "employer".[108] This employer subsequently has the sole power to authorize particular alterations of the original copyrighted work.[109] In contrast, moral rights under the European model of copyright vest individually in each of the creative participants to the film making process.[110] Thus, it is the creative participants individually, and not a common employer, who enforce such moral rights.

While it might seem reasonable to allow individual creative participants to enforce their moral rights, questions would inevitably arise as to just which of these participants should be allowed to do so. While a director might be allowed to thwart the colorization process, what about the right of the cinematographer to do so? What about the moral rights of an actor who appeared in the original black-and-white version, or the designer who created the original set? An impossible

situation might arise should individual creative participants split among themselves in regard to the propriety of a colorized version of their original work.[111]

Furthermore, recognition of the moral right to prevent colorization would be difficult to separate from the moral right to prevent other forms of alteration to a film. Scanning, panning and editing are common forms of alteration which are arguably commercially necessary for the television broadcast of many films. Would recognition of the moral right also include the right of individual creative participants to object to and prevent these less offensive forms of alteration?

The Berne Convention, by regulating throughout the European community the assertion of moral rights, attempts to deal with this problem.[112] The Convention specifically defines and limits the types of alterations which creative contributors may object to.[113] Similarly, the French judiciary will refuse to prevent alterations to original works which it considers "reasonable" in nature.[114] Nonetheless, these methods are cumbersome and necessarily uncertain in application. To deem an alteration "reasonable" or "unreasonable" is akin to judging the intrinsic merit of the original work. Such a value judgment has traditionally been considered not to have a place in copyright law.[115]

If construed as preventing such common and "necessary" forms of alteration as panning, scanning and editing, recognition of moral rights might ultimately discourage the very creation of artistic works. Knowing that he may never make any alterations

to a film for display in media other than first run movie houses, a movie producer might never have sufficient economic incentive to even create such a work. With the growing importance of the cable television and video cassette markets, such a situation is much more than a mere possibility. It is unlikely that even the most ardent opponent of colorization would favor such a result.

If moral rights are to be recognized, it should be by forthright amendment of our copyright law. To construe our existing Copyright Act to prohibit colorization would be reading provisions into the Act which simply don't exist. While our Copyright Act does not generally recognize or protect moral rights, it nonetheless provides a consistent and rational scheme of protection for creative works.[116] Giving backdoor recognition to moral rights through strained interpretations of copyright law or, as in Gilliam, [117] contractual provisions, might have ramifications far beyond the mere prevention of colorization of black-and-white films. For example, artists and authors associated with other media might similarly invoke their moral rights to prevent alterations to their works which are much less artistically objectionable than the colorization process.[118] Our system of copyright protection presupposes that a high level of permissable commercial exploitation of creative works is desirable. Relatively modest alterations to creative works are often required by this commercial process. Departure from our present scheme of copyright protection, without comprehensive consideration of all the possible ramifications of the same, might have serious consequences regarding the general

marketability of creative works.

Similarly, state and federal unfair competition laws should not be used to grant backdoor recognition to moral rights. Properly construed, this body of law deals not with moral rights, but rather with the prevention of deception and confusion of the public.[119] Given adequate disclaimers, unfair competition law does not prohibit the colorization process.[120] Moral rights are a topic properly addressed under copyright law, and are appropriately considered pursuant to our federal Copyright Act.[121] In fact, giving backdoor recognition to moral rights via state unfair competition laws would probably run afoul of constitutional principles. Pursuant to our Constitution, the power to promulgate laws pertaining to copyright protection resides in Congress.[122] Accordingly, the 1976 Copyright Act specifically preempts any equivalent state protection for works of authorship falling within the subject matter of copyright.[123] Since Congress clearly understood the nature of moral rights in drafting the Act,[124] its failure to generally protect these rights via copyright is reasonably construed as denying the states the power to do so.[125] Thus, the states constitutionally lack the power to protect rights Congress has specifically chosen not to recognize pursuant to the Copyright Act.[126]

For this reason, any legislation specifically governing colorization must come at the federal level. However, the colorization controversy has not yet been viewed by Congress as sufficiently compelling to warrant federal legislation. Senator Edward Kennedy recently introduced a bill in Congress patterned

after the state fine art statutes.[127] Like the majority of state statutes, the bill makes no provisions for motion pictures, but rather protects other forms of visual art.[128] Apparently Congress does not, at least as of yet, share the same level of outrage over colorization as the Hollywood creative community.

Assuming Congress' lack of concern over the colorization process is a conscious one, its refusal to legislate specially in this area is probably justified. It is perhaps unfair to treat motion pictures differently under copyright then other types of creative works. Congress has historically made a fundamental decision to provide for a high degree of marketability of copyrightable works. This commitment is exemplified by our Copyright Act's general absence of protection for moral rights,[129] as well as its basic "works made for hire" scheme.[130] To treat film directors differently than other artists in an employment situation should be justified only by extremely compelling circumstances.[131]

As artistically unpalatable as it may be, the colorization process probably doesn't justify departure from our established scheme of copyright protection. Hollywood movie making is above all a <u>business</u>. Perhaps even more than any other type of creative endeavour, film making requires the highest degree of commercial exploitation for its works, as is currently provided by the Copyright Act.[132] Director Steven Spielberg, one of the leading opponents of colorization, regularly demands up to twenty percent of the gross from his movies. It is perhaps hypocritical for him to assert that film making is nothing more than art for