

36 F.Supp.2d 191, 50 U.S.P.Q.2d 1110
(Cite as: 36 F.Supp.2d 191)

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United States District Court,
S.D. New York.

THE BRIDGEMAN ART LIBRARY, LTD., Plain-
tiff,
v.
COREL CORPORATION, et ano., Defendants.
No. 97 Civ. 6232(LAK).

Feb. 18, 1999.
As Amended March 2, 1999.

United Kingdom-based company, which marketed transparencies and CD-ROMs of reproductions of public domain works of art brought suit alleging copyright infringement, violation of the Lanham Act, and unfair competition. The District Court, [Kaplan, J.](#), [25 F.Supp.2d 421](#), entered judgment for alleged infringer. Copyright holder moved for reargument and reconsideration. The District Court held that: (1) Berne Convention on copyrights did not require United States courts to enforce copyrights of other countries, when those copyrights did not satisfy originality requirement for copyrights set forth in United States Constitution; (2) reproductions did not satisfy originality requirements for United States copyright; and (3) reproductions did not satisfy United Kingdom requirements for copyright protection.

Motion granted; summary judgment for alleged infringer.

MEMORANDUM OPINION

[KAPLAN](#), District Judge.

On November 13, 1998, this Court granted defendant's motion for summary judgment dismissing plaintiff's copyright infringement claim on the alternative grounds that the allegedly infringed works-color transparencies of paintings which themselves

are in the public domain-were not original and therefore not permissible subjects of valid copyright and, in any case, were not infringed. It applied United Kingdom law in determining whether plaintiff's transparencies were copyrightable. The Court noted, however, that it would have reached the same result under United States law.

Following the entry of final judgment, the Court was bombarded with additional submissions. On November 23, 1998, plaintiff moved for reargument and reconsideration, arguing that the Court erred on the issue of originality. It asserted that the Court had ignored the Register of Copyright's issuance of a certificate of registration for one of plaintiff's transparencies, which it takes as establishing copyrightability, and that the Court had misconstrued British copyright law in that it failed to follow *Graves' Case*, which was decided in the Court of Queens Bench in 1869. At about the same time, the Court received an unsolicited letter from Professor William Patry, author of a copyright law treatise, which argued that the Court erred in applying the law of the United Kingdom to the issue of copyrightability. Plaintiff then moved for an order permitting the filing of an *amicus* brief by one of its associates, The Wallace Collection, to address the United Kingdom law issue. The Court granted leave for the submission of the *amicus* brief and invited the parties to respond to Professor Patry's letter. The matter now is ripe for decision.

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Everything plaintiff has submitted on this motion should have been before the Court earlier, which is more than sufficient reason to deny its motion as an unwarranted imposition on the Court and, indeed, its adversary. *193 The issues, however, are significant beyond the immediate interests of the parties. Accordingly, the Court will address them on the merits.

Choice of Law

[1] Professor Patry argues principally that there can be no choice of law issue with respect to copy-

36 F.Supp.2d 191, 50 U.S.P.Q.2d 1110
(Cite as: 36 F.Supp.2d 191)

rightability because the Copyright Clause of the Constitution permits Congress to enact legislation protecting only original works of authorship. In consequence, he contends, only original works, with originality determined in accordance with the meaning of the Copyright Clause, are susceptible of protection in United States courts.

Of course, the ability of Congress to extend the protection of copyright is limited by the Copyright Clause. Nevertheless, the constitutional issue is not as straightforward as Professor Patry suggests. Bridgeman claims that the infringed works are protected by United Kingdom copyrights and that the United States, by acceding to the Convention for the Protection of Literary and Artistic Works, popularly known as the Berne Convention... and by enacting the Berne Convention Implementation Act of 1988 (the "BCIA"), agreed to give effect to its United Kingdom copyrights.

...

[Section 102\(a\)](#) limits copyright protection in relevant part to "original works of authorship..." ^{FN24} Accordingly, there is no need to decide whether the Berne Convention adopts any rule regarding the law governing copyrightability or whether the treaty power constitutionally might be used to extend copyright protection to foreign works which are not "original" within the meaning of the Copyright Clause. Congress has made it quite clear that the United States' adherence to the Berne Convention has no such effect in the courts of this country...

Originality and Copyrightability

United States Law

[2] The Court's prior opinion indicated that plaintiff's exact photographic copies of public domain works of art would not be copyrightable under United States law because they are not original. In view of the Court's conclusion here that U.S. law governs on this issue, it is appropriate to give a somewhat fuller statement of the Court's reasoning.

In *Burrow-Giles Lithographic Co v. Sarony*, the Supreme Court held that photographs are "writings" within the meaning of the Copyright Clause and that the particular portrait at issue in that case was sufficiently original-by virtue of its pose, arrangement of accessories in the photograph, and lighting and the expression the photographer evoked-to be subject to copyright. The Court, however, declined to decide whether "the ordinary production of a photograph" invariably satisfies the originality requirement. While Judge Learned Hand later suggested*196 that the 1909 Copyright Act protected photographs independent of their originality, his view ultimately was rejected by the Supreme Court. Nevertheless, there is broad scope for copyright in photographs because "a very modest expression of personality will constitute sufficient originality."

As the Nimmers have written, there "appear to be at least two situations in which a photograph should be denied copyright for lack of originality," one of which is directly relevant here: "where a photograph of a photograph or other printed matter is made that amounts to nothing more than slavish copying." The authors thus conclude that a slavish photographic copy of a painting would lack originality, although they suggest the possibility that protection in such a case might be claimed as a "reproduction of a work of art." But they immediately go on to point out that this suggestion is at odds with the Second Circuit's *in banc* decision in *L. Batlin & Son, Inc. v. Snyder*.

Batlin involved the defendants' claim to copyright in a plastic reproduction, with minor variations, of a mechanical cast-iron coin bank that had been sold in the United States for many years and that had passed into the public domain. The Court of Appeals affirmed a district court order compelling the defendants to cancel a recordation of copyright in the plastic reproduction on the ground that the reproduction was not "original" within the meaning of the 1909 Copyright Act, holding that the requirement of originality applies to reproductions of works of art. Only "a distinguishable variation"-something beyond technical skill-will render the reproduction original. In consequence:

"Absent a genuine difference between the underlying work of art and the copy of it for which protec-

36 F.Supp.2d 191, 50 U.S.P.Q.2d 1110
 (Cite as: 36 F.Supp.2d 191)

tion is sought, the public interest in promoting progress in the arts—indeed, the constitutional demand [citation omitted]—could hardly be served. To extend copyrightability to minuscule variations would simply put a weapon for harassment in the hands of mischievous copiers intent on appropriating and monopolizing public domain work. Even in *Mazer v. Stein*, [347 U.S. 201, 74 S.Ct. 460, 98 L.Ed. 630 (1954)], which held that the statutory terms ‘works of art’ and ‘reproduction of works of art’ ... permit copyright of quite ordinary mass-produced items, the Court expressly held that the objects to be copyrightable, ‘must be original, that is, the author’s tangible expression of his ideas.’ 347 U.S. at 214, 74 S.Ct. at 468, 98 L.Ed. at 640. No such originality, no such expression, no such ideas here appear.”

The requisite “distinguishable variation,” moreover, is not supplied by a change of medium, as “production of a work of art in a different medium cannot by itself constitute the originality required for copyright protection.”

There is little doubt that many photographs, probably the overwhelming majority, reflect at least the modest amount of originality required for copyright protection. “Elements of originality ... may include posing the subjects, lighting, angle, selection of film and camera, evoking the desired expression, and almost any other variant involved.” But “slavish copying,” although doubtless requiring technical skill and effort, does not qualify. As the Supreme Court indicated in *Feist*, “sweat of the brow” alone is not the “creative spark” which is the *sine qua non* of originality. It therefore is not entirely surprising that an attorney for the Museum of Modern Art, an entity with interests comparable to plaintiff’s and its clients, not long ago presented a paper acknowledging that a photograph of a two-dimensional public domain work of art “might not have enough originality to be eligible for its own copyright.”

In this case, plaintiff by its own admission has labored to create “slavish copies” of public domain works of art. While it may be assumed that this required both skill and effort, there was no spark of originality—indeed, the point of the exercise was to reproduce the underlying works with absolute fidel-

ity. Copyright is not available in these circumstances.

United Kingdom Law

[3] While the Court’s conclusion as to the law governing copyrightability renders the point moot, the Court is persuaded that plaintiff’s copyright claim would fail even if the governing law were that of the United Kingdom.

...

Laddie, a modern British copyright treatise the author of which now is a distinguished British judge, discusses the issue at Bar in a helpful manner:

“It is obvious that although a man may get a copyright by taking a photograph of some well-known object like Westminster Abbey, he does not get a monopoly in representing Westminster Abbey as such, any more than an artist would who painted or drew that building. What, then, is the scope of photographic copyright? As always with artistic works, this depends on what makes his photograph original. Under the 1988 Act the author is the person who made the original contribution and it will be evident that this person need not be he who pressed the trigger, who might be a mere assistant. Originality presupposes the exercise of substantial independent skill, labour, judgment and so forth. *For this reason it is submitted that a person who makes a photograph merely by placing a drawing or painting on the glass of a photocopying machine and pressing the button gets no copyright at all; but he might get a copyright if he employed skill and labour in assembling the thing to be photocopied, as where he made a montage. It will be evident that in photography there is room for originality in three respects. First, there may be originality which does not depend on creation of the scene or object to be photographed or anything remarkable about its capture, and which resides in such specialties as angle of shot, light and shade, exposure, effects achieved by means of filters, developing techniques etc.: in such manner does one photograph of Westminster Abbey differ from another, at least potentially. Secondly, there may be creation of the scene or subject to be photographed. We have al-*

36 F.Supp.2d 191, 50 U.S.P.Q.2d 1110
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ready mentioned photo-montage, but a more common instance would be arrangement or posing of a group ... Thirdly, a person may create a worthwhile photograph by being at the right place at the right time. Here his merit consists of capturing and recording a scene unlikely to recur, e.g. a battle between an elephant and a tiger ...”

Moreover, the authors go on to question the continued authority of *Graves' Case* under just this analysis:

“It is submitted that *Graves' Case* (1869) LR 4 QB 715 (photograph of an engraving), a case under the Fine Arts Copyright Act 1862, does not decide the contrary, since there may have been special skill or labour in setting up the equipment to get a good photograph, especially with the rather primitive materials available in those days. Although the judgments do not discuss this aspect it may have been self-evident to any contemporary so as not to require any discussion. *If this is wrong it is submitted that Graves' Case is no longer good law and in that case is to be explained as a decision made before the subject of originality had been fully developed by the courts.*”

This analysis is quite pertinent in this case. Most photographs are “original” in one if not more of the three respects set out in the treatise and therefore are copyrightable. Plaintiff's problem here is that it seeks protection for the exception that proves the rule: photographs of existing two-dimensional articles (in this case works of art), each of which reproduces the article in the photographic medium as precisely as technology permits. Its transparencies stand in the same relation to the original works of art as a photocopy stands to a page of typescript, a doodle, or a Michelangelo drawing.

Plaintiff nevertheless argues that the photocopier analogy is inapt because taking a photograph requires greater skill than making a photocopy and because these transparencies involved a change in medium. But the argument is as unpersuasive under British as under U.S. law.

The allegedly greater skill required to make an exact photographic, as opposed to Xerographic or compa-

rable, copy is immaterial. As the Privy Council wrote in *Interlogo AG v. Tyco Industries, Inc.*, “[s]kill, labor or judgment merely in the process of copying cannot confer originality....” The point is *199 exactly the same as the unprotectibility under U.S. law of a “slavish copy.”

Nor is the change in medium, *standing alone*, significant. The treatise relied upon by plaintiff for the contrary proposition does not support it. It states that “a change of medium will *often* entitle a reproduction of an existing artistic work to independent protection.” And it goes on to explain:

“Again, an engraver is almost invariably a copyist, but his work *may* still be original in the sense that he has employed skill and judgment in its production. An engraver produces the resemblance he wishes by means which are very different from those employed by the painter or draughtsman from whom he copies; means which require a high degree of skill and labour. The engraver produces his effect by the management of light and shade, or, as the term of his art expresses it, the *chiaroscuro*. The required degree of light and shade are produced by different lines and dots; the engraver must decide on the choice of the different lines or dots for himself, and on his choice depends the success of his print.”

Thus, the authors implicitly recognize that a change of medium alone is not sufficient to render the product original and copyrightable. Rather, a copy in a new medium is copyrightable only where, as often but not always is the case, the copier makes some identifiable original contribution. In the words of the Privy Council in *Interlogo AG*, “[t]here must ... be some element of material alteration or embellishment which suffices to make the totality of the work an original work.” Indeed, plaintiff's expert effectively concedes the same point, noting that copyright “may” subsist in a photograph of a work of art because “change of medium is *likely* to amount to a material alteration from the original work, unless the change of medium is so insignificant as not to confer originality ...”

Here, as the Court noted in its earlier opinion, “[i]t is uncontested that Bridgeman's images are substan-

36 F.Supp.2d 191, 50 U.S.P.Q.2d 1110
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tially exact reproductions of public domain works, albeit in a different medium.” There has been no suggestion that they vary significantly from the underlying works. In consequence, the change of medium is immaterial.

Lady Bridgeman, plaintiff’s principal, testified that the goal of the transparencies is to be as true to the original work as possible. (Bridgeman Dep. 15) The color bars (referred to in the prior opinion) are employed to make sure that “the transparency is a genuine reflection of the colors” of the original works of art. (Eichel Dep. 29) Plaintiff has argued “that in creating the transparencies ..., Bridgeman strives to make the transparency look as identical to the underlying work of art as possible ...” (Pl.Mem. in Opp. to Summary Judgment 4)

Finally, the *amicus* argues that this result is contraindicated because public art collections in the United Kingdom charge fees for reproductions of photographic images of works in their collections, thus evidencing their view that the images are protected by copyright. But the issue here is not the position of an economically interested constituency on an issue that has not been litigated, at least in this century, but the content of the originality requirement of the British Copyright Act. Moreover, it is far from clear what the understanding of British art collections, if any, actually is. Certainly, for example, there are original works of art in British public art collections in which copyright subsists and is owned by the collections, in which case reproduction rights no doubt are a fit subject for exploitation.

For all of the foregoing reasons, the Court is persuaded that its original that Bridgeman’s transparencies are not copyrightable under British law was correct.

***200** *The Certificate of Registration for The Laughing Cavalier*

As indicated above, plaintiff argues also that the fact that the Register of Copyright issued a certificate of registration for one of plaintiff’s transparencies demonstrates that its photographs are copyrightable under U.S. law. The argument is misguided.

No one disputes that most photographs are copyrightable. In consequence, the issuance of a certificate of registration for a photograph proves nothing. And while the certificate is *prima facie* evidence of the validity of the copyright, including the originality of the work, the presumption is not irrebuttable. Here, the facts pertinent to the issue of originality are undisputed. The Court has held as a matter of law, and reiterates, that plaintiff’s works are not original under either British or United States law.

Conclusion

Plaintiff’s motion for reargument and reconsideration of this Court’s order granting summary judgment dismissing the complaint is granted. Nevertheless, on reargument and reconsideration, defendant Corel Corporation’s motion for summary judgment dismissing the complaint is granted.