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## ORIGINALITY REQUIREMENT IN REPRODUCTIONS OF PUBLIC DOMAIN WORKS

*L. Batlin & Son, Inc. v. Snyder*

In implementing the constitutional directive to promote the arts and sciences,<sup>1</sup> Congress has extended the protection granted an author under the Copyright Act to encompass reproductions of works of art.<sup>2</sup> Before an individual may secure this protection, however, it must be shown that the reproduction is in some way original.<sup>3</sup> Although an exact definition of this criterion has proved trou-

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<sup>1</sup> The Constitution provides that "Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8.

<sup>2</sup> 17 U.S.C. §§ 1-216 (1970 & Supp. V 1975). The first copyright legislation enacted by Congress protected only books, maps, and charts. Act of May 31, 1790, ch. 15, 1 Stat. 124. Additional material was added to the statutory list during the following century. See Act of April 29, 1802, ch. 36, § 2, 2 Stat. 171 (prints); Act of Feb. 3, 1831, ch. 16, § 1, 4 Stat. 436 (musical compositions); Act of Aug. 18, 1856, ch. 169, 11 Stat. 138 (dramatic compositions); Act of Mar. 3, 1865, ch. 126, 13 Stat. 540 (photographs and negatives); Act of July 8, 1870, ch. 230, § 86, 16 Stat. 198 (paintings, drawings, chromos, statuettes, statuary, and models or designs intended as works of fine art).

The copyright laws were substantially revised in 1909. Copyright Act of 1909, ch. 320, 35 Stat. 1075 (current version at 17 U.S.C. §§ 1-216 (1970 & Supp. V 1975)). This revision included the extension of copyright protection to reproductions of works of art. 17 U.S.C. § 5(h) (1970). For an outline of the history of copyright legislation in the United States, see Staff Members of the New York University Law Review Under the Guidance of Prof. Walter J. Derenberg, *The Meaning of "Writings" in the Copyright Clause of the Constitution*, in 1 STUDIES ON COPYRIGHT 50-61 (Arthur Fisher Mem. ed. 1963). The basic protections granted to authors of copyrighted works are contained in 17 U.S.C. § 1 (1970) which provides that "[a]ny person entitled thereto, upon complying with the provisions of this title, shall have the exclusive right . . . [t]o print, reprint, publish, copy, and vend the copyrighted work." *Id.* § 101 provides that any person who infringes on another's copyright may be enjoined and is subject to an award of profits, impoundment, and destruction of his infringing material.

In 1976 Congress overwhelmingly passed the first general revision of the copyright law since 1909. Pub. L. No. 94-553, 90 Stat. 2541 (1976) (effective Jan. 1, 1978) (codified at 17 U.S.C.A. §§ 101-810 (Supp. 1976)). See *House Passage: Copyright Law Revision*, 34 CONG. Q. 2638 (1976); *Senate Passage: Copyright Law Revision*, 34 CONG. Q. 482 (1976).

<sup>3</sup> The statutory basis for copyrighting reproductions is found in § 5 of the Copyright Act. While it is clear that a work of art may be copyrighted, 17 U.S.C. § 5(g) (1970), and an author has the exclusive right to "copy" his own copyrighted work, *id.* § 1(a), the Copyright Act also provides for the copyrighting of "[r]eproductions of a work of art," *id.* § 5(h).

It is no simple task to define what is meant by the terms found in § 5 of the Copyright Act. Professor Melville B. Nimmer, the leading authority in the copyright field, devotes two entire sections of his treatise to the two requirements that a reproduction of a work of art must possess—an underlying work of art. 1 M. NIMMER, COPYRIGHT § 20.1 (1976) [hereinafter cited as NIMMER], and originality, *id.* § 20.2. Since, as Professor Nimmer has noted, a reproduction of a work of art must contain an underlying work of art, *id.* § 20.1, it would be appropriate to examine the requirements that an underlying work must possess. To qualify

blesome, it is clear that copying, without more, does not fulfill the originality requirement.<sup>4</sup> With the advent of modern mass production techniques and the concomitant simplification of the means of reproduction,<sup>5</sup> delineating the degree of originality necessary to

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as a work of art a piece must evince a minimal level of creativity, a quality that relates to the nature of the work itself. See *id.* § 19.1. In other words, the work must have a level of "creative authorship in its delineation or form." 37 C.F.R. § 202.10(b) (1976). The Supreme Court has expressed the view that only a slight degree of creativity is required. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903). Justice Holmes, writing for the *Bleistein* Court, did not wish to place judges in the position of art critics lest, due to the inexactitude of a judicial process involving personal tastes, public access to new trends in the art would be frustrated. *Id.* at 251-52.

The requirement of creativity cannot apply, however, to a reproduction of a work of art because, as a reproduction, it must be based upon a work of art that has previously been "created." It has been stated that a requirement of creativity is "self-contradictory" where reproductions are concerned since "[t]hat element . . . is supplied by the basic underlying work." *L. Batlin & Son, Inc. v. Snyder*, 187 U.S.P.Q. 721, 729 (2d Cir. 1975), *rev'd on other grounds en banc*, 536 F.2d 486 (2d Cir.), *cert. denied*, 97 S. Ct. 156 (1976); see notes 16-17 and accompanying text *infra*. Both works of art and reproductions of works of art, however, require a degree of originality, a contribution by the author to the work. See M. NICHOLSON, A MANUAL OF COPYRIGHT PRACTICE 54 (2d ed. 1956); NIMMER, *supra*, §§ 19.2, 20.2. No precise definition of originality may be postulated. With regard to reproductions, it is an ephemeral standard that must be based on a comparison with the underlying work. See *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951), *modifying and aff'g* 74 F. Supp. 973 (S.D.N.Y. 1947), which required a "distinguishable variation" from the preexisting work, 191 F.2d at 102, *quoting* *Gerlach-Barklow Co. v. Morrison & Bendien, Inc.*, 23 F.2d 159, 161 (2d Cir. 1927), and a contribution of "something more than a 'merely trivial' variation" by the author or artist. 191 F.2d at 103, *quoting* *Chamberlin v. Uris Sales Corp.*, 159 F.2d 512, 513 (2d Cir. 1945). For a discussion of *Alfred Bell*, see notes 22-24 and accompanying text *infra*. An alternative approach has been used in at least one case holding that reproduction of a work reduced in scale using "great skill" and "exactitude" amounts to a level of originality sufficient to satisfy the originality requirement. See *Alva Studios, Inc. v. Winninger*, 177 F. Supp. 265, 267 (S.D.N.Y. 1959). For a discussion of *Alva Studios*, see notes 26-29 and accompanying text *infra*.

It should be noted that while the requirements for works of art and reproductions of works of art are different, an artist will not be penalized in any way for an error in classification in the copyright application. 17 U.S.C. § 5 (1970); see, e.g., *Soptra Fabrics Corp. v. Stafford Knitting Mills, Inc.*, 490 F.2d 1092, 1094 (2d Cir. 1974).

<sup>4</sup> NIMMER, *supra* note 3, § 20.2.

<sup>5</sup> See generally Note, *Constitutional Limits on Copyright Protection*, 68 HARV. L. REV. 517 (1955); Comment, *Copyright Protection for Mass-Produced, Commercial Products: A Review of the Developments Following Mazer v. Stein*, 38 U. CHI. L. REV. 807 (1971). For example, photocopying of copyrighted works is a practice presently prevalent in our society. It is estimated that the approximately 600,000 photocopiers in use in the United States today which are capable of reproducing drawings and other works of art produce 30 billion copies a year. II N. HENRY, COPYRIGHT—INFORMATION TECHNOLOGY—PUBLIC POLICY 2 (1976). This obviously has created numerous problems in the publishing field with regard to royalties, loss of sales and subscriptions, declining sales of back issues and reprints, and loss of advertising revenues. See W. NASRI, CRISIS IN COPYRIGHT (1976).

For other examples of two- and three dimensional articles that have been mass-reproduced commercially due to advanced industrial processes, see *Soptra Fabrics Corp. v. Stafford Knitting Mills, Inc.*, 490 F.2d 1092 (2d Cir. 1974) (work of art transferred onto cloth);

bring a reproduction within the ambit of the Copyright Act has been further complicated. Specifically, the question has arisen whether the reproduction in a different medium of a public domain<sup>6</sup> work of art is sufficiently original in itself to warrant copyright protection. In *L. Batlin & Son, Inc. v. Snyder*,<sup>7</sup> the Second Circuit, sitting en banc, held that the reproduction of a public domain toy bank in a different medium, with only minor variations, is not sufficiently original to warrant copyright protection.<sup>8</sup>

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Roth Greeting Cards v. United Card Co., 429 F.2d 1106 (9th Cir. 1970) (work of art used on a greeting card); Millworth Converting Corp. v. Slika, 276 F.2d 443 (2d Cir. 1960) (work of art reexpressed in a dress fabric design); Cynthia Designs, Inc. v. Robert Zentall, Inc., 416 F. Supp. 510 (S.D.N.Y. 1976) (small silver pendant shaped to resemble a T-shirt); Gardenia Flowers, Inc. v. Joseph Markovits, Inc., 280 F. Supp. 776 (S.D.N.Y. 1968) (traditional flower corsage arrangements composed of artificial flowers); Barton Candy Corp. v. Tell Chocolate Novelties Corp., 178 F. Supp. 577 (E.D.N.Y. 1959) (Christmas motif greeting card designed as a container for chocolate).

<sup>6</sup> For copyright purposes, the "public domain" is a status into which falls all unprotected works that have been made available to the community at large. See generally M. NICHOLSON, A MANUAL OF COPYRIGHT PRACTICE 147 (2d ed. 1956). A work of art may enter the public domain for any one of a number of reasons, including failure to properly register for a copyright by not following the procedures set out in 17 U.S.C. §§ 1-32 (1970 & Supp. V 1975) or expiration coupled with a failure to renew pursuant to *id.* § 24. Cf. *Letter Edged in Black Press, Inc. v. Public Bldg. Comm'n*, 320 F. Supp. 1303 (N.D. Ill. 1970), wherein a monumental sculpture could not be copyrighted because the model on which it was based had been placed in the public domain when it was shown to the press after recognition that its sculptor, Pablo Picasso, was to donate the monument to the people of Chicago.

Once a work is in the public domain, it is "free to anybody's use . . . . Any member of the public would therefore have an equal right to make an independent adaption, arrangement, etc., of such original works as are in the public domain." H. HOWELL, THE COPYRIGHT LAW 42 (3d ed. 1952). Section 8 of the Copyright Act, guaranteeing these public rights, provides that "no copyright shall subsist in the *original* text of any work which is in the public domain," 17 U.S.C. § 8 (1970 & Supp. V 1975) (emphasis added). To provide for reproduction copyrights, however, § 7 of the Copyright Act provides that "*versions* of works in the public domain . . . shall be regarded as new works subject to copyright under the provisions of this title." *Id.* § 7 (emphasis added); see *id.* § 5(h) (copyright protection extended to reproductions of works of art).

<sup>7</sup> 536 F.2d 486 (2d Cir.) (en banc), *cert. denied*, 97 S. Ct. 156 (1976), *rev'g* 187 U.S.P.Q. 721 (2d Cir.), *aff'g* 394 F. Supp. 1389 (S.D.N.Y. 1975).

<sup>8</sup> 536 F.2d at 492. The new law, to go into effect on January 1, 1978, should not change the judicially determined limitations on the subject matter of copyrights affirmed in *Batlin*. See Pub. L. No. 94-553, 90 Stat. 2598 (1976) (effective Jan. 1, 1978) (codified at 17 U.S.C.A. § 102 (Supp. 4 1976)). The new statute neither refers to reproductions of works of art nor the public domain per se; it does, however, state in § 103 of the transitional and supplementary provisions that "the Act does not provide copyright protection for any work that goes into the public domain before January 1, 1978." 90 Stat. at 2599. See H.R. REP. NO. 94-1476, 94th Cong., 2d Sess. 180 (1976), *reprinted in* [1976] U.S. CODE CONG. & AD. NEWS 6089, 6226. Provision is made for the protection of derivative works employing preexisting material. 17 U.S.C.A. § 103 (Supp. 4 1976). This section is apparently intended to replace those concepts. In fact, the definition of a derivative work states that it "is a work based on [a] preexisting [work], such as a[n] . . . art reproduction . . . or any other form in which a work may be recast, transformed, or adapted." 17 U.S.C.A. § 101 (Supp. 4 1976). It must be assumed that

The reproduction involved in *Batlin* was a nine-inch plastic "Uncle Sam Mechanical Bank" produced in Hong Kong by the defendant Snyder. Snyder's sculptor had produced the mold using as a model an eleven-inch cast iron bank originally produced in the United States in the late 1800's.<sup>9</sup> The metal bank had entered the public domain upon expiration of its design patent sometime prior to the 1909 copyright law revision.<sup>10</sup> In addition to the two-inch height differential, the plastic version varied slightly from the original in such areas as the width of the base on which "Uncle Sam" stood and the design work on both the figure and base. Design requirements of the single-mold method of production resulted in these differences in Snyder's plastic version.<sup>11</sup> Although the medium was dissimilar, the essential design work and function of the bank remained the same—an Uncle Sam figure dropping a coin into a carpetbag when a lever was depressed.<sup>12</sup>

Due to Snyder's copyright registration, the United States Customs Service prevented Batlin, a novelty merchant, from importing an identical plastic bank from the Orient.<sup>13</sup> Consequently, Batlin sought an injunction in the Southern District of New York to compel cancellation of Snyder's copyright. District Judge Metzner granted the injunction,<sup>14</sup> foreseeing little probability that Snyder's copyright

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preexisting material without a valid copyright in effect is equivalent to the notion of the public domain.

<sup>9</sup> A design patent (No. 16,728) was granted on the metal toy savings bank on June 8, 1886. 536 F.2d at 488.

<sup>10</sup> 187 U.S.P.Q. at 723. This bank, itself, could not be copyrighted again because of the provisions of 17 U.S.C. § 8 (1970). See note 6 *supra*.

<sup>11</sup> For a list of the variations between the plastic and metal versions of the bank, see note 37 *infra*.

<sup>12</sup> 536 F.2d at 488.

<sup>13</sup> 19 C.F.R. § 133.42(c) (1976) grants a United States Customs Service district director the power to "seize and forfeit an imported article which he determines constitutes a piratical copy of a recorded copyrighted work."

<sup>14</sup> 394 F. Supp. at 1390. It has been stated that in a copyright case:

[O]nce a prima facie case of infringement has been made out, a preliminary injunction should issue, even in the absence of a detailed showing of irreparable injury . . . since "a copyright holder in the ordinary case may be presumed to suffer irreparable harm when his right to the exclusive use of the copyrighted material is invaded."

Robert Stigwood Group Ltd. v. Sperber, 457 F.2d 50, 55 (2d Cir. 1972), quoting American Metropolitan Enterprises, Inc. v. Warner Bros. Records, Inc., 389 F.2d 903, 905 (2d Cir. 1968). This standard was formulated to apply to copyright holders seeking protection from infringers, whereas in *Batlin* it was the alleged infringer who was seeking an injunction to compel cancellation of the copyright. For the copyright holder to prevent such action, he must come forward with sufficient evidence to show the existence of a valid copyright. In *Batlin*, Judge Metzner held that Snyder failed to make his prima facie case and found "little probability

would be found valid at a trial on the merits. It was Judge Metzner's opinion that the artistic skill employed by Snyder's sculptor did not contribute anything "more than a 'merely trivial variation'"<sup>15</sup> to the original work. Upon appeal, Judge Meskill, writing for the majority of the three-judge appellate panel, reversed the grant of the injunction.<sup>16</sup> He found the "originality of process" utilized in transferring the cast iron bank to the plastic medium sufficient to satisfy the burden of establishing copyrightability.<sup>17</sup>

On rehearing, however, the Second Circuit, sitting en banc, reinstated the preliminary injunction granted by the district court.<sup>18</sup> In an opinion authored by Judge Oakes, who had dissented from the initial appellate decision,<sup>19</sup> the en banc *Batlin* court emphasized that originality is the key factor in determining whether a reproduction of a public domain expression is copyrightable.<sup>20</sup> According to

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that defendants' copyright [would] be found valid in a trial on the merits." 394 F. Supp. at 1390.

<sup>15</sup> The requirement of more than a merely trivial variation in cases where public domain works have been reproduced was incorporated from the leading court of appeals case in this area, *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951), *modifying and aff'g* 74 F. Supp. 973 (S.D.N.Y. 1947), *discussed in* notes 22-24 and accompanying text *infra*. It should be noted that Judge Metzner had initially formed his opinion on the non-copyrightability of this particular bank in a similar action, *Etna Products Co. v. E. Mishan & Sons*, No. 75-428 (S.D.N.Y. 1975). That case was held in abeyance pending the final outcome of the *Batlin* appeals. 187 U.S.P.Q. at 723 n.3.

<sup>16</sup> 187 U.S.P.Q. at 729.

<sup>17</sup> *Id.* The original appellate decision held that the required originality for a reproduction was satisfied by the fact that Snyder's "sculptor needed special skill, training and knowledge, and independent judgment to create the mold." *Id.* No reference was made to whether the bank satisfied the "trivial variation" test of *Alfred Bell*, which, as the original dissent noted, "is the heart of the originality requirement." *Id.* at 730 (Oakes, J., dissenting) (emphasis in original). The majority's "novel conclusion" was to be reversed upon rehearing en banc and was even abandoned by Judge Meskill in his dissent therein. *See* text accompanying note 46 *infra*.

<sup>18</sup> 536 F.2d 486, 492.

<sup>19</sup> In the original decision by the Second Circuit, Judge Oakes forcefully dissented, noting:

The majority opinion rendered today eviscerates this circuit's line of cases requiring a modicum of originality for copyrightability and in doing so opens the door to copyrights for slavish copies of any object in the public domain. Incidentally to doing so the majority also totally disregards the substantial evidence supporting Judge Metzner's findings that the likelihood that appellants can show any input of originality to justify their copyright is small since change of material and change in size do not alone render an object copyrightable. The majority opinion cheapens copyrights . . . by making them meaningless . . .

187 U.S.P.Q. at 730 (Oakes, J., dissenting).

<sup>20</sup> 536 F.2d at 492. The court conceded that although "the test of 'originality' may leave a lot to be desired, . . . it is the only one we have . . . Here as elsewhere in the copyright law there are lines that must be drawn even though reasonable men may differ where." *Id.* (citation omitted). *See* NIMMER, *supra* note 3, § 20.2.

the *Batlin* court, for a work to qualify for copyright protection, it is necessary that the author contribute "at least some substantial variation, not merely a trivial variation such as might occur in the translation to a different medium."<sup>21</sup>

This standard was first delineated in an oft-cited decision, *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*<sup>22</sup> In *Alfred Bell*, public domain paintings by the "old masters" were hand reproduced by engravers into mezzotints with sufficient variation to be considered copyrightable by the Second Circuit.<sup>23</sup> It is true that, as in *Batlin*, the engraver expressed the original in another medium, but since each mezzotint required separate hand inking the court believed that a distinguishable effect, although modest, did result, and this entitled the works to protection.<sup>24</sup> Applying this originality test, the en banc *Batlin* court refused to hold copyrightable what it termed "miniscule variations" in a work where there exists no "genuine

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<sup>21</sup> 536 F.2d at 491.

<sup>22</sup> 191 F.2d 99 (2d Cir. 1951), *modifying and aff'g* 74 F. Supp. 973 (S.D.N.Y. 1947). Premonitions of the *Alfred Bell* originality test can be seen as early as 1927. In that year, the Second Circuit noted that a painting of subject matter in the public domain would not support a copyright unless there was "distinguishable variation" present. See *Gerlach-Barklow Co. v. Morris & Bendien, Inc.*, 23 F.2d 159 (2d Cir. 1927), wherein it was held that although plaintiff's painting of a scene from nature entitled "Song of the Bluebird" was similar to a public domain picture entitled "Spring Song," it contained sufficient variation to be the subject of a copyright. In 1945, another Second Circuit opinion noted that "the Constitution does not authorize . . . a monopoly grant to one whose product lacks all creative originality." *Chamberlin v. Uris Sales Corp.*, 150 F.2d 512, 513 (2d Cir. 1945). There, it was held that because part of plaintiff's version of the rules and board for the game "Acey-Ducey" lacked originality, the portion of plaintiff's copyright covering those aspects of the game was ineffective. The plaintiff had copied them from rules and an object in the public domain. The court did not consider it relevant that plaintiff's board contained slight distinctions from the original.

<sup>23</sup> 191 F.2d at 104.

<sup>24</sup> *Id.* at 102. *Alfred Bell* concerned an infringement action brought by the producer of eight mezzotint engravings of public domain works by the "old masters." Deciding that all that was necessary to uphold a copyright of the mezzotints was a "distinguishable variation" from the public domain paintings, the *Alfred Bell* court held that the mezzotints were indeed sufficiently "original." Although the *Alfred Bell* district court noted that "[t]he artists employed to produce [the] mezzotint engravings . . . attempted faithfully to reproduce paintings in the mezzotint medium so that the basic idea, arrangement, and color scheme . . . [were] those of the original artist," sufficient originality was found in that the work of the engraver was an expensive, "tedious process requiring skill and patience." 74 F. Supp. at 975. The Second Circuit, however, did not rely on the author's skill or the expense of the process involved. Instead, it articulated the following test: "All that is needed to satisfy both the Constitution and the statute is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own'. Originality in this context 'means little more than a prohibition of actual copying.'" 191 F.2d at 102-03. (footnotes omitted), *citing* *Chamberlin v. Uris Sales Corp.*, 150 F.2d 512 (2d Cir. 1945), and *Hoague-Sprague Corp. v. Frank C. Meyer Co.*, 31 F.2d 583, 586 (E.D.N.Y. 1929).

difference between the underlying work of art and the copy of it for which protection is sought."<sup>25</sup>

Finding the bank insufficiently original to satisfy the *Alfred Bell* test, the court turned to an analysis based upon a test which recognizes that originality occasionally may be expressed in a reproduction absent any distinguishable variation other than size. In *Alva Studios, Inc. v. Winninger*,<sup>26</sup> a copyright was sustained where the work reproduced was identical to the original, but had been reduced in size through the effort of highly skilled artisans.<sup>27</sup> The public domain work of art in *Alva Studios*, Rodin's "Hand of God," a highly acclaimed statue on permanent display in a museum, was reproduced in minute detail in a one-half scale model approved by the museum and sold to the public. Noting that it had taken "an extremely skilled sculptor" many hours working directly in front of the original"<sup>28</sup> to produce the copy, the *Alva Studios* court upheld the copyright because of the "great skill and originality . . . called for . . . to produce a scale reduction of a great work with exactitude."<sup>29</sup>

Although recognizing the viability of the *Alva Studios* standard whereby "sheer artistic skill and effort can act as a substitute for the requirement of substantial variation,"<sup>30</sup> the en banc *Batlin* court emphatically held that Snyder's sculptor, who had produced his mold in less than two days, had not exhibited the degree of skill and effort necessary to satisfy this test.<sup>31</sup>

Clearly, the basic issue in all phases of the *Batlin* litigation was

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<sup>25</sup> 536 F.2d at 492. The en banc majority listed a number of variations which Snyder contended were present in his work. The variations were in "very minute details," many of which were "not perceptible to the casual observer." Many of the changes listed were a result of the differences in the texture of the respective materials used; others were caused by the fact that a single mold was used for the plastic version. The court also set forth a partial list of major similarities, including the attire of Uncle Sam, his pose, the color scheme, and the method in which the carpetbag opened. *Id.* at 489.

<sup>26</sup> 177 F. Supp. 265 (S.D.N.Y. 1959).

<sup>27</sup> *Id.* at 266.

<sup>28</sup> *Id.*

<sup>29</sup> *Id.* at 267.

<sup>30</sup> *Id.* at 266.

<sup>31</sup> 536 F.2d at 492. In *Millworth Converting Corp. v. Slifka*, 276 F.2d 443, 444 (2d Cir. 1960), it took the plaintiff's stylist "some months to develop an arrangement of varying colors" to qualify the reproduction of a design in fabric as a copyrightable work. Similarly, in *Alva Studios* it took "an extremely skilled sculptor" many hours working directly in front of the original" to achieve exactitude in the reduction. 177 F. Supp. at 266. It should also be noted that the *Alfred Bell* district court placed heavy emphasis on the "tedious process requiring skill and patience" involved in producing the mezzotints containing the substantial variation. 74 F. Supp. at 975.



whether either one or both of these standards was achieved by Snyder's bank.<sup>32</sup> While noting that the threshold requirement of originality is minimal and that a mass produced reproduction is capable of supporting an independent copyright, the en banc panel held that something more than a de facto copying of a public domain article is required.<sup>33</sup> Some quantum of originality, some creative addition or substantial variation over and above the independent effort expended for the minor variations which inadvertently occur as a result of the production of the mold, was required by the *Batlin* court.<sup>34</sup> Consequently, the Second Circuit concluded that the district court judge had not abused his discretion by granting Batlin the injunction, for Snyder's "copyrighted" bank was not, in fact, worthy of copyright protection.<sup>35</sup>

Although it is conceded that when Snyder's bank is viewed in terms of the variation and skilled reduction standards for determining originality, it exhibits elements of both, it is submitted that the *Batlin* court was correct in finding that the degree of either was not sufficient to raise the bank to a copyrightable status. When compared to the *Alfred Bell* mezzotint engravers who added distinguishable variations to their finished artistic works, Snyder's sculptor added only trivial variations. As for the *Alva Studios* standard, although Snyder's sculptor did require some skill to create the mold, the necessary ability fell far short of the "true artistic skill" exemplified in the reduction of Rodin's intricate work.<sup>36</sup> Thus, although Snyder's bank contained elements of both criteria, it did not display the degree of originality required by either test to secure copyright status.

In contrast to the majority's conclusion, the en banc dissent believed that the variations found in the plastic version were indeed

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<sup>32</sup> Compare the en banc majority's characterization of the facts, see note 25 *supra*, with that of the dissent, see note 37 *infra*. In the district court decision, Judge Metzner did not find an *Alfred Bell* distinctive variation and distinguished *Alva Studios* on the basis of the lack of "complexity" in Snyder's work. He specifically rebuked the defendant for claiming substantial differences under the *Alfred Bell* test while also trying to bring the plastic bank under the umbrella of the exactitude test of *Alva Studios*. 394 F. Supp. at 1390-91.

<sup>33</sup> 536 F.2d at 490-91.

<sup>34</sup> *Id.* at 492.

<sup>35</sup> *Id.*

<sup>36</sup> The *Batlin* en banc majority noted that, "the plastic version is not, and was scarcely meticulously produced to be, an exactly faithful reproduction. Nor is the creativity in the underlying work of art the same order of magnitude as in the case of the 'Hand of God.'" *Id.* at 492. Similarly, in *Letter Edged in Black Press, Inc., v. Public Bldg. Comm'n*, 320 F. Supp. 1303, 1310 (N.D. Ill. 1970), a "mere copy" coupled with a change in size, "albeit on a grand scale," could not qualify a monumental sculpture for a copyright.

more than trivial.<sup>37</sup> Thus, Judge Meskill, author of both the original majority opinion and the en banc dissent, concluded that Judge Metzner had abused his discretion<sup>38</sup> in finding that the copyright could not be supported at a trial on the merits.<sup>39</sup>

It would appear that in reaching this conclusion, the dissent was more concerned with public policy considerations<sup>40</sup> than with

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<sup>37</sup> 536 F.2d at 492. The dissent maximized the differences between the two banks, stating: The primary variations between the two banks involve height; medium; anatomical proportions of the Uncle Sam figure, including shape and expression of face; design of the clothing (hat, tie, shirt, collar, trousers); detail around the eagle figure on the platform; placement of the umbrella; and the shape and texture of the satchel. 536 F.2d at 493 (Meskill, J., dissenting). The majority couched its explanation of the differences in terms of "minute details." *Id.* at 489 (Oakes, J.); see note 26 *supra*.

<sup>38</sup> Since the grant of a preliminary injunction is a matter of discretion for the trial court, *Perry v. Perry*, 190 F.2d 601, 602 (D.C. Cir. 1951), a reversal would be warranted upon an abuse of that discretion in a copyright infringement case. See *Ideal Toy Corp. v. Sayco Doll Corp.*, 302 F.2d 623, 624 (2d Cir. 1962). A finding that a district court judge abused his discretion is not extraordinary in itself, and is proper where the reviewing "panel has the same record and no part of the decision below turned on credibility." 536 F.2d at 493 (Meskill, J., dissenting). The original appellate opinion in *Batlin*, however, was a reversal of a particularly strong opinion, one in which the district court concluded that the "differences [were] so infinitesimal [that] they make no difference." *Id.* at 489 (Oakes, J.).

<sup>39</sup> 536 F.2d at 493 (Meskill, J., dissenting).

<sup>40</sup> In reaching its decision, the en banc majority specifically declined to follow a Ninth Circuit case, *Sunset House Distributing Corp. v. Doran*, 304 F.2d 251 (9th Cir. 1962), *aff'g* 197 F. Supp. 940 (S.D. Cal. 1961). In *Doran*, a case with strong public policy overtones, the copyright for a three-dimensional plastic Santa Claus was upheld. The Santa Claus figure, which was sold as an ornament, consisted of two plastic bags that could be filled with newspaper and assembled, using accompanying ornamentation, to depict a five and one-half foot figure. 197 F. Supp. at 942. The district court questioned only the originality of the "medium of expression" in determining that the Santa Claus figure met the "modest" requirement. It was held that the author was "contributing something 'recognizably his own' to prior treatments of the same subject," and that the "Santa is 'original' because of its form and medium . . ." *Id.* at 944-45. Professor Nimmer has labelled the *Doran* and original appellate level *Batlin* decisions "ludicrous" for suggesting that "the first person to execute a public domain work of art in a different medium" achieves something copyrightable "for the reason that no one can claim to have independently evolved any particular medium." NIMMER, *supra* note 3, § 20.2, at 94 (1976 & Supp. June 1976) (footnote omitted).

The apparent direct conflict between the Ninth and Second Circuits becomes less significant upon an examination of the factual situations in each case. On their faces, both seem to concern public domain "personages" transferred into plastic and mass-produced for consumption during specific time periods (Christmas and the Bicentennial). While the concepts of Santa Claus and Uncle Sam are indisputably in the public domain, it is eminently clear that manifestations of these concepts are open to protection as *works of art* if the prescribed degrees of originality and creativity are met. See note 3 *supra*. *Doran* met this test while *Batlin* could only hope to qualify as a reproduction of a previously existing work.

As background to a determination of the efficacy of the *Doran* work, it is important to consider the universally recognized principle that a copyright is the protection of the *expression* of an idea, as opposed to a patent which protects the inventor's *idea* itself. See *Mazer v. Stein*, 347 U.S. 201, 217 (1954). This theory was initially given credence in 1884 when the Supreme Court noted that the term "writings" in the Constitution section enabling

the specific factual issues present before the court.<sup>41</sup> It was the opinion of Judge Meskill that the refusal to recognize Snyder's copyright would serve only to defeat a valid purpose, *viz.*, that of securing "protection from someone using Snyder's figurine to *slavishly copy* and make a mold."<sup>42</sup> While a natural disinclination exists towards a manufacturer such as Batlin, a competing businessman who learns of a new product and seeks to derive a share of the expected profits, judicial attempts to prevent this form of business practice should not include finding that the copyright in question is valid regardless of whether it satisfies the *Alfred Bell* and *Alva Studios* standards. Protection of the increments added by Snyder would have avoided allowing Batlin to reap the benefits of what was essentially Snyder's commercial idea.<sup>43</sup> Commercial ideas such as the one in *Batlin*, however, are not provided for in the statutory framework of copyright laws.<sup>44</sup> Rather, it is the physical expressions of ideas

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copyright legislation, U.S. CONST. art. I, § 8, "meant the literary productions of . . . authors, and Congress very properly has declared these to include all forms of writing, printing, engraving, etching, etc., by which the ideas in the mind of the author are given visible expression." *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884). See *Baker v. Selden*, 101 U.S. 99, 101-03 (1879); *Unedda Doll Co. v. P & M Doll Co.*, 353 F.2d 788, 789 (2d Cir. 1965) (per curiam); *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960); *Gardenia Flowers, Inc. v. Joseph Markovits, Inc.*, 280 F. Supp. 776, 783 (S.D.N.Y. 1968). It can be readily seen that in accordance with the above principle, the *Doran* "Santa Claus" was an expression of an idea while "Uncle Sam" was merely an expression of another expression.

In sum, while policy considerations were relied on heavily by the Ninth Circuit in affirming *Doran*, see 304 F.2d at 252, such factors did not have to be determinative of the decision. The Santa Claus figure was sufficiently original to qualify on the merits as a work of art based on a public domain idea and not as a reproduction. 197 F. Supp. at 944-45. As the district court noted, the plaintiffs in *Doran* "envisioned, and then created by their own skill, labor and judgment" the subject piece. *Id.* at 944. The inherent difference in the *Batlin* case is the prior existence of the exact same expression in the public domain. Once an expression has been manifested and copyrighted, it is protected until the copyright's expiration. Once expired, it may not be protected again.

<sup>41</sup> While the district court and en banc majority were chided for basing their decisions on "[a]fter the fact speculation as to whether Snyder made changes for aesthetic or functional reasons," 536 F.2d at 493 (Meskill, J., dissenting), the dissent was guilty of a similar transgression. After the fact speculation concerning whether an idea will be copied by another manufacturer should not enter into the determination of whether an object meets the standard of originality required of reproductions of public domain works. The question whether a work deserves copyright protection should be determined strictly on the merits.

<sup>42</sup> *Id.* at 494 (emphasis added).

<sup>43</sup> Batlin's defense to these charges was based on his claim that he had ordered cast iron copies of the bank as early as August 9, 1974. When he thereafter became aware of what he considered "'an almost identical copy' of the cast iron bank," he decided to order his own plastic version. *Id.* at 488 (Oakes, J.).

<sup>44</sup> See 17 U.S.C. § 5 (1970 & Supp. V 1975). Ideas are to be protected under the Patent Law, 35 U.S.C. §§ 1-293 (1970 & Supp. V 1975).

that copyrights are designed to protect.<sup>45</sup>

A further indication of public policy considerations underlying the dissent is the complete retreat by Judge Meskill from the "originality of process" theory he had propounded in his original majority opinion.<sup>46</sup> His utilization in the en banc dissent of a totally new approach based on the claim that the variations were not, in fact, minimal, may signal a desire to prevent on any ground available the type of practice engaged in by *Batlin*.

Certainly policy considerations were present in both *Alfred Bell* and *Alva Studios*. In *Alfred Bell*, the district court condemned the defendants for "us[ing] proofs taken from the plaintiff's plates and sold by the plaintiff, carrying notice of plaintiff's copyright, as the subjects of their colored photoengravings."<sup>47</sup> In *Alva Studios*, there was "convincing credible evidence to establish actual copying" of the plaintiff's work.<sup>48</sup> Such charges are clearly inherent in all copyright infringement actions. In addition, according to the *Batlin* en banc majority, the policy aspects of *Alva Studios* included a desire on the part of that court to increase public access to fine works of art,<sup>49</sup> a factor absent in *Batlin*.<sup>50</sup> These policy considerations, however, were not determinative. The *Alfred Bell* and *Alva Studios* works were independently supported by sufficient originality, whereas the *Batlin* work was not.

Where a work simply does not warrant protection on its merits, general policy aspects should not dictate copyright determinations. Such an "amorphous, far-reaching principle"<sup>51</sup> could serve to disrupt the already minimal copyright standards applicable to works

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<sup>45</sup> See note 40 *supra*.

<sup>46</sup> 187 U.S.P.Q. at 729.

<sup>47</sup> 74 F. Supp. at 977.

<sup>48</sup> 177 F. Supp. at 268.

<sup>49</sup> 536 F.2d at 492. No mention of increasing public access to the Rodin sculpture was made in the *Alva Studios* decision.

<sup>50</sup> While referring to the public policy "access" aspects of the *Alva Studios* decision, the *Batlin* en banc majority noted with particularity the skill and exactitude necessary to make that reproduction:

Rodin's sculpture is . . . so unique and rare, and adequate public access to it such a problem that a significant public benefit accrues from its precise, artistic reproduction. No such benefit can be imagined to accrue here from the "knock-off" reproduction of the cast iron Uncle Sam bank. Thus appellants' plastic bank is neither in the category of exactitude required by *Alva Studios* nor in a category of substantial originality; it falls within what has been suggested . . . is a copyright no-man's land.

*Id.*

<sup>51</sup> Comment, *Copyright Protection for Mass-Produced, Commercial Products: A Review of the Developments Following Mazer v. Stein*, 38 U. CHI. L. REV. 807, 821 (1971).

of art and their reproductions. Despite the policy aspects of the *Alfred Bell* and *Alva Studios* decisions, there was present in both subject works a substantial amount of originality. Whether one considers the originality of process used to create Snyder's bank or the originality of the variations created, it seems obvious that the bank did not possess the requisite originality to merit protection. Snyder's bank was copied directly from a prior public domain expression of an idea, and did not meet even the minimal originality requirements previously established to protect public access to items belonging to the national culture.<sup>52</sup>

If copyright protection for Snyder's bank had been sustained, public access to the object would have been severely limited. Allowing a manufacturer who adds little or nothing to a design to copy and then copyright it would conceivably provide an opportunity for unscrupulous producers to gain control over public domain works through utilization of different medium originality.<sup>53</sup> The *Batlin* court's affirmance of the "trivial variation" test and refusal to equate process originality with the traditional definitions of originality creates a strong precedent that, hopefully, will serve to preserve public access to public domain articles.

*Steven L. Young*

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<sup>52</sup> The *raison d'être* of copyright is not only to ensure profit for authors. As Professor Nimmer has stated:

The primary purpose of copyright is not to reward the author, but is rather to secure "the general benefits derived by the public from the labors of authors."

Thus the authorization to grant to individual authors the limited monopoly of copyright is predicated upon the dual premises that the public benefits from the creative activities of authors, and that the copyright monopoly is a necessary condition to the full realization of such creative activities. Implicit in this rationale is the assumption that in the absence of such public benefit the grant of a copyright monopoly to individuals would be unjustified.

NIMMER, *supra* note 3, § 3.1, at 6.6 (footnote omitted).

<sup>53</sup> 536 F.2d at 492.