

BRIDGEMAN ART LIBRARY, LTD. V. COREL CORP.

By Robert C. Matz

Digital technology promises to democratize the art world by giving the masses¹ unprecedented access to public domain works of art.² Computer users—both foreign and domestic—can now view digital images of famous works of art over the Internet from the comfort of their homes. Consumers can now buy inexpensive, high-quality reproductions of these same works. Advertisers, drawing on a vast new pool of digital imagery, now use images of public domain works of art to sell everything from cars³ to chocolate bars.⁴ The commodification of images of public domain works of art makes it possible for us to adorn our everyday lives with images of fine art.⁵ And “the transformation of artworks into easily reproducible, usable, images wrests art away from the few specialized experts and gives it to the populace to apply to their own lives.”⁶

Museums, collectors, and private companies impede this democratizing trend by controlling access to the original work of art and by asserting copyright protection in photographic or digital reproductions.⁷ In addition to implementing security measures to prevent museum-goers from photographing the works in their collections, legal analysts have encouraged museums to:

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1. At least that portion of the masses that has access to the Internet. For information on the “digital divide,” see National Telecommunications and Information Administration, *Falling Through the Net II: New Data on the Digital Divide* (visited Dec. 12, 1999) (<http://www.ntia.doc.gov/ntiahome/net2/falling.html>).

2. See HOWARD BESSER & JENNIFER TRANT, INTRODUCTION TO IMAGING 7 (1995) (“The ability to display and link collections from around the world breaks down physical barriers to access, and the potential of reaching audiences across social and economic boundaries blurs the distinction between the privileged few and the general public.”).

3. Pontiac advertised the Sunfire using Edvard Munch’s *The Scream*. See Kathleen Connolly Butler, *Keeping the World Safe from Naked-Chicks-In-Art Refrigerator Magnets: The Plot to Control Art Images in the Public Domain Through Copyrights in Photographic and Digital Reproductions*, 21 HASTINGS COMM. & ENT. L.J. 55, 64 (1998).

4. Recent Hershey’s ads featured a Van Gogh self-portrait holding a Hershey bar. See *id.* at 69 n.50.

5. Images of Raphael’s cherubs have become especially ubiquitous in California, appearing on stationery, greeting cards, magnets, and posters. See *id.* at 64.

6. See *id.* at 60-61 (citing JOHN BERGER, *WAYS OF SEEING* 32 (1972)).

7. For a detailed examination of how museums maintain control over public domain works of art through copyright law, see *id.* at 55-127.

always claim copyright in any reproduction that appears in a poster, postcard, advertisement, brochure, or three-dimensional model. . . . [W]hen the underlying work falls into the public domain, the whole world may copy it. The museum's copyright in its reproduction, however, will not be affected by the underlying work falling into the public domain, and its copyright in its derivative work will continue for the full duration.⁸

Although such blanket assertions of copyright protection do not guarantee their ultimate validity under the Copyright Act, their *in terrorem* effect can curb public use. Moreover, as Corbis Corporation's⁹ recent acquisition of the Bettmann Photo Archives¹⁰ illustrates, private collectors and companies further impede democratization of the art world by purchasing (thus "privatizing") public domain works of art and subsequently claiming copyright protection in all photographic or digital reproductions. Thus, even though the Copyright Act seeks to offset the decidedly "undemocratic" effect of monopoly privileges by "democratically" allowing the public unfettered access to copyrighted works after the statutory period of exclusive control has expired,¹¹ museums, private collectors, and companies have, in the past, been able to circumvent the public domain status of certain works of art by controlling access to the original and by asserting copyright protection in all photographic or digital reproductions.

In *Bridgeman Art Library v. Corel Corporation*,¹² the district court for the Southern District of New York affirmed the public's right to access and use images of public domain works of art by holding that Bridgeman's exact photographic reproductions of public domain works of art were not

8. Rhonda L. Berkowitz & Marshall A. Leaffer, *Copyright and the Art Museum*, 8 COLUM.-VLA J.L. & ARTS 249, 265-67 (1984).

9. Corbis Corporation was founded by Bill Gates in 1989 "to archive and distribute high-quality digital and analog images worldwide." Microsoft Corp., *Bill and Melinda Gates Bring Leonardo da Vinci's Codex Leicester to Life* (visited Dec. 12, 1999) (<<http://www.microsoft.com/BillGates/news/codex.html>). Corbis Corporation is now "home to 65 million of the world's most significant images, with more than 2.1 million available online." Corbis Corp., *About Corbis* (visited Dec. 12, 1999) (<<http://www.corbis.com/press/corbis.asp?s=1>>).

10. The Bettmann Photo Archives is "a renowned image library that illustrates the entire history of humankind, from prehistoric cave paintings to modern-day photojournalism. It contains more than 17 million images in print, transparency, glass negative, and digital file format, making it the largest historical and news photo collection in the world." Corbis Corp., *About Corbis* (visited Dec. 12, 1999). (<<http://www.corbis.com/press/corbis.asp?s=1>>).

11. See 17 U.S.C. § 302 (1994) (setting the duration of copyright to life of the author plus 70 years).

12. 36 F. Supp. 2d 191 (S.D.N.Y. 1999).

copyrightable. This Note briefly surveys the background case law, summarizes the *Bridgeman* court's decision, and then analyzes decision in terms of the doctrine it applied, the policy considerations it upheld, and the legal strategies it suggests. This Note concludes that the court correctly applied existing copyright doctrine to the facts of the case, thereby reinforcing important policy considerations against granting copyrights that would allow reproducers to harass competitors, stifle competition within the market for art reproductions, and impede access to and use of images of public domain works of art.

I. BACKGROUND CASELAW

A. The Originality Requirement

As the Supreme Court explained in *Feist Publications, Inc. v. Rural Telephone Service Company, Inc.*,¹³

The sine qua non of copyright is originality. To qualify for copyright protection, a work must be original to the author. Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity. . . . [T]he requisite level of creativity is extremely low; even a slight amount will suffice. The vast majority of works make the grade quite easily, as they possess some creative spark, "no matter how crude, humble, or obvious it might be."¹⁴

Thus, a work of art is copyrightable only where it (1) originates with the author, and (2) contains a modicum of creativity.

Reproductions of works of art are copyrightable as derivative works¹⁵ or as separately copyrightable subject matter.¹⁶ As derivative works, reproductions of works of art are copyrightable if they (1) substantially or wholly copy the expressive elements of an underlying work of art, (2) contain an original element not present in the underlying work, and either (3) are made with the consent of the copyright owner, or (4) are copied

13. 499 U.S. 340 (1991).

14. *Id.* at 345 (citations omitted).

15. See 17 U.S.C. § 103(a) (defining a derivative work as "a work based upon one or more pre-existing works, such as a[n] . . . art reproduction").

16. See 17 U.S.C. § 102(a)(5) (including art reproductions within the category of pictorial, graphic, or sculptural works).

from a work of art which is in the public domain.¹⁷ Copyright protection is afforded only to the original elements not present in the underlying work.¹⁸ As separately copyrightable subject matter, an art reproduction must (1) be based on a prior work of art that satisfies the originality and creativity requirements, and (2) contain an original contribution not present in the underlying work of art (i.e. it must be more than a mere copy).¹⁹ As with derivative works, copyright protection in reproductions of works of art extends only to the original elements contributed by the author of the reproduction.²⁰

In determining whether a given reproduction or derivative work is "original," New York courts²¹ generally apply one of two tests: the "distinguishable variation" test or the "skill, labor, and judgment" test.

1. *The distinguishable variation test*

In 1927, in *Gerlach v. Barklow Co. v. Morris Bendien, Inc.*²², the Second Circuit Court of Appeals held that "[w]hile a copy of something in the public domain will not, if it be merely a copy, support a copyright, a distinguishable variation will, even though it present the same theme."²³ Twenty-four years later, in *Alfred Bell & Co., Ltd. v. Catalda Fine Arts, Inc.*²⁴, the Second Circuit altered the test slightly by holding, "[a]ll 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.'"²⁵ By requiring something more than a trivial variation, the *Alfred Bell* court sought to draw a distinction between "distinguishable variations" that met the Constitutional and statutory require-

17. See MELVILLE B. NIMMER & DAVID NIMMER, 1 NIMMER ON COPYRIGHT, §§ 3.01, 3.03, 3.06 (Sept. 1998).

18. See *id.* § 3.04.

19. See *id.* § 2.08[C][1].

20. See *id.* § 2.08[C][3].

21. This Note focuses on New York case law because other courts often look to this body of law to guide them in their evaluation of art reproductions and derivative works. See, e.g., *Big Moore Pub., Inc. v. Big Sky Marketing, Inc.*, 756 F.Supp. 1371, 1374 (D. Idaho 1990) (relying on cases from the Second Circuit because it is "a preeminent authority" on copyright matters). Moreover, while the tests articulated in other jurisdictions may be worded differently, they are consistent with the standards articulated by New York courts. See, e.g., 1 NIMMER, *supra* note 17, §§ 2.08[C][1], 3.04 (citing predominantly to New York case law in support of review of the standards of copyrightability that apply to art reproductions and derivative works).

22. 23 F.2d 159 (S.D.N.Y. 1927).

23. *Id.* at 161.

24. 191 F.2d 99 (2d Cir. 1951).

25. *Id.* at 102-03.

ments of originality and variations that—while distinguishable—were “merely trivial” and therefore not original. This fine distinction, however, seemed at odds with the court’s oft-cited illustration that “[a] copyist’s bad eyesight or defective musculature, or a shock caused by a clap of thunder, may yield [something more than merely trivial] distinguishable variations. Having hit upon such a variation unintentionally, the ‘author’ may adopt it as his and copyright it.”²⁶ Hence, *Alfred Bell*’s restatement of the distinguishable variation test seemed somewhat contradictory—it explicitly heightened the standard by requiring something more than a trivial variation, but it also suggested that the requisite originality could be found in the seemingly trivial variation produced by the inadvertent slip of an artist’s brush.²⁷

This seeming anomaly was addressed twenty-five years later in *L. Batlin & Son, Inc. v. Snyder*,²⁸ in which the Second Circuit explained that “[t]he requirement of substantial as opposed to trivial variation . . . [is] inherent in and subsumed by the concept of originality. . . . There is implicit in that concept a ‘minimal element of creativity over and above the requirement of independent effort.’”²⁹ In other words, since the prior case law seemed to suggest that art reproductions were copyrightable solely upon a finding of originality,³⁰ the Second Circuit’s decision in *Batlin* can be seen as an attempt to harmonize the originality requirement for works of art (originality plus a modicum of creativity) with the originality requirement for reproductions of works of art. Indeed, in discussing the originality requirement for works of art, the *Batlin* court pointed out that “none of these underlying principles is different in the case of ‘reproductions of works of art.’”³¹ Therefore, despite Nimmer’s assertion that reproductions of works of art are copyrightable solely upon a finding of originality,³² Second Circuit case law supports the proposition that repro-

26. *Id.* at 105.

27. *But see* 1 NIMMER, *supra* note 17, § 2.01[B] n.30 (seeing no inherent inconsistency since “the unintentional should not be confused with the trivial”).

28. 536 F.2d 486 (2d Cir. 1976).

29. *Id.* at 490, (quoting 3 NIMMER, *supra* note 17, § 10.2).

30. This is a proposition echoed by David Nimmer. *See* 1 NIMMER, *supra* note 17, § 2.08[C][3] (arguing that “a reproduction of a work of art need not contain any creativity other than that that is inherent in the underlying work of art of which it is a reproduction.”).

31. *Batlin*, 536 F.2d at 490.

32. *See* 1 NIMMER, *supra* note 17, § 2.08[C][3] (“a reproduction of a work of art need not contain any creativity other than that that is inherent in the underlying work of art of which it is a reproduction”).

ductions of works of art must demonstrate both originality *and* creativity in order to be copyrightable.³³

2. *The skill, labor, and judgment test*

Although *Alfred Bell* contains language that can be construed as establishing an alternate test which looks for and rewards skill and labor,³⁴ the fullest articulation of the skill, labor, and judgment test is found in *Alva Studios, Inc. v. Winninger*.³⁵ In *Alva Studios*, the District Court for the Southern District of New York held that "to be entitled to copyright, the work must be original in the sense that the author has created it by his own skill, labor, and judgment without directly copying or evasively imitating the work of another."³⁶ Subsequent cases—while not directly overruling *Alva Studios*—have interpreted the skill, labor, and judgment test as requiring "true artistic skill,"³⁷ as opposed to the mere "skill of an artisan,"³⁸ and have thus denied copyright protection to reproductions of works of art where the process involved only the expenditure of "great effort and time."³⁹

B. The Copyrightability of Photographs

In *Burrow-Giles Lithographic Co. v. Sarony*,⁴⁰ the Supreme Court held that photographs are "writings" within the meaning of the Copyright Clause of the Constitution.⁴¹ In assessing the photograph's originality, Justice Miller pointed out that originality could be found in "posing [the subject] in front of the camera, selecting and arranging the costume, draperies, and other various accessories in [the] photograph, arranging the subject . . . arranging and disposing the light and shade, suggesting and invoking the desired expression."⁴² Justice Miller concluded the "disposi-

33. Though Nimmer argues that it is "of only semantic significance whether originality is defined as embodying . . . creativity or whether such creativity is regarded as a necessary adjunct to originality," Nimmer himself suggests that "a greater clarity of expression is perhaps achieved by regarding originality and creativity as separate elements." See 1 NIMMER, *supra* note 17, at § 2.01[B], 2-14 to 2-15.

34. See *Alfred Bell*, 191 F.2d at 106, n.22 (quoting WALTER COPINGER, THE LAW OF COPYRIGHTS (7th ed. 1936) 46, which states that an artist's work may "be original in the sense that he has employed skill and judgment in its production").

35. 177 F. Supp. 265 (S.D.N.Y. 1959).

36. *Id.* at 267.

37. *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 491 (2d Cir. 1976).

38. *Hearn v. Meyer*, 664 F. Supp. 832, 839 (S.D.N.Y. 1987).

39. *Id.*

40. 111 U.S. 53 (1884).

41. *Id.* at 57-58.

42. *Id.* at 60.

tion, arrangement, or representation, made entirely by [the photographer], produced the picture. . . . These findings show this photograph to be an original work of art.”⁴³ While Justice Miller conceded, in dictum, that some photographs might be rightly said to be “merely mechanical, with no place for novelty, invention, or originality,”⁴⁴ Judge Learned Hand disagreed with Justice Miller in *Jeweler’s Circular Publishing v. Keystone Publishing*,⁴⁵ and concluded that “no photograph, however simple, can be unaffected by the personal influence of the author, and no two will be absolutely alike.”⁴⁶ Subsequent decisions have rejected Hand’s assertion in favor of Nimmer’s proposition that photographs which are no more than “slavish copies” of photographs or other printed matter are not original.⁴⁷

II. THE CASE

Bridgeman is a United Kingdom-based company that acquires photographs of public domain works of art and then licenses use of reproductions of these photographs.⁴⁸ Bridgeman obtains its photographs by securing permission to photograph the works of art themselves or by purchasing existing photographs from freelance photographers.⁴⁹ Bridgeman stores its photographic images in two formats: high-resolution color transparencies and low-resolution CD-ROMs.⁵⁰ To ensure that each transparency accurately represents the colors contained in the original work, Bridgeman attaches a color correction strip to each of its color transparencies.⁵¹ In the United States, Bridgeman’s marketing strategy was to provide potential customers with the CD-ROM version of its photographic images as a catalog of its available images and then license use of its high-resolution color transparencies.⁵²

Corel Corporation is a Canadian corporation that sells computer software products.⁵³ One of these products is a set of seven CD-ROMs entitled “Corel Professional Photos CD-ROM Masters I-VII” (“Masters CD-

43. *Id.*

44. *Id.* at 59.

45. 274 F. 932 (S.D.N.Y. 1921)

46. *Id.* at 934.

47. *See, e.g.,* *Simon v. Birraporetti’s Restaurants*, 720 F. Supp. 85, 86-87 (1989).

48. *See* *Bridgeman Art Library, Ltd. v. Corel Corp.*, (“Bridgeman I”) 25 F. Supp. 2d 421, 423-24 (S.D.N.Y. 1998).

49. *See id.* at 423.

50. *See id.* at 424.

51. *See id.* at 423.

52. *See id.* at 424.

53. *See id.*

ROMs").⁵⁴ The Masters CD-ROMs contain seven hundred photographic images of public domain paintings by European artists and are sold in Canada, the United Kingdom, and the United States.⁵⁵ Corel claims to have obtained the images for its Masters CD-ROMs from 35-millimeter slides owned by Off the Wall, Inc. ("OWI"), an allegedly defunct California corporation.⁵⁶ Of the seven hundred works of art represented on Corel's Masters CD-ROMs, one hundred and twenty are works of art which are also contained in Bridgeman's library of photographic images.⁵⁷

A. Procedural History

Bridgeman filed suit against Corel and OWI in the District Court for the Southern District of New York. OWI was never served and the case against it was dismissed.⁵⁸ In its amended complaint, Bridgeman asserted that Corel's sales of its Masters CD-ROMs infringed Bridgeman's copyrights, violated sections 32(1) and 43(a) of the Lanham Act,⁵⁹ and constituted common law unfair competition.⁶⁰ Corel moved for summary judgment on the grounds that: (1) Bridgeman did not possess valid copyrights in its images, and (2) there was no evidence that Corel copied Bridgeman's images.⁶¹ Bridgeman cross-moved for summary judgment on the validity of its copyrights under the laws of the United Kingdom.⁶²

B. The District Court's November Decision

In its November, 1998 decision, the district court entered summary judgment against Bridgeman on its copyright claims.⁶³ After concluding that U.K. law governed copyrightability while U.S. law governed the alleged infringements, the court held that since Bridgeman's images were "copied from the underlying works without any avoidable addition, alteration, or transformation," they were not copyrightable under British law since they lacked originality.⁶⁴ With respect to the alleged infringements, the court held that even if Bridgeman's images were copyrightable, there was "substantial doubt as to whether Bridgeman has made out even a

54. *See id.*

55. *See id.* at 423-24.

56. *See id.* at 423 n.1, 424.

57. *See id.* at 424.

58. For this reason, neither Bridgeman nor Corel's factual claims with respect to OWI were established in this action. *See id.* at 423 n.1.

59. 15 U.S.C. §§ 1125 (a), 1125 (a)(1)(A), 1125 (a)(1)(B) (1988).

60. *See Bridgeman I*, 25 F. Supp. 2d at 423.

61. *See id.*

62. *See id.* at 424.

63. *See id.* at 423-31.

64. *Id.* at 426.

prima facie case of access [by Corel],” and that there was “reason to doubt also” whether there was substantial similarity between Bridgeman’s high-resolution color transparencies and Corel’s low-resolution Masters CD-ROMs.⁶⁵ The court then dismissed Bridgeman’s claims for alleged infringements in Canada and the United Kingdom because “the [Copyright] Act has no extraterritorial operation.”⁶⁶

After disposing with Bridgeman’s claims under the Copyright Act, the court entered summary judgment against Bridgeman on its Lanham Act claims and then dismissed Bridgeman’s unfair competition claims for lack of jurisdiction. The court entered summary judgment against Bridgeman on its Lanham Act claims because: (1) Bridgeman admitted that the images in question did not serve to identify the source of its products or services, and (2) Bridgeman had failed to allege or offer evidence of any trademark use by Corel of any of the images at issue and thus there was no possibility of confusion.⁶⁷ The court then dismissed Bridgeman’s common law unfair competition claims because its jurisdiction over these state claims was dependent upon jurisdiction over Bridgeman’s federal (Copyright and Lanham Act) claims.⁶⁸

C. Bridgeman’s Motion for Reconsideration

Ten days after the entry of summary judgment, Bridgeman moved for reargument and reconsideration on the grounds that the court had erred on the issue of originality under British law.⁶⁹ Specifically, Bridgeman contended that the court had overlooked the British Register of Copyrights issuance of a certificate of registration for one of its transparencies and had misconstrued British law by failing to apply *Graves Case*.⁷⁰ The court also received an unsolicited letter from Professor William Patry which argued that the court erred in applying British law on the issue of copyrightability.⁷¹ The court granted leave for the submission of an amicus

65. *Id.* at 428.

66. *See id.* at 428.

67. *See id.* at 429-30.

68. *See id.* at 431.

69. *See Bridgeman Art Library, Ltd. v. Corel Corp.*, (“Bridgeman II”) 36 F. Supp. 2d 191, 192 (S.D.N.Y. 1999).

70. *See id.* at 192. In *Graves Case*, L.R. 4 Q.B. 715 (1869), Justice Blackburn held that “[A]ll photographs are copies of some object . . . [and therefore] a photograph taken from a picture [i.e. painting] is an original photograph.” *Id.* at 197 (quoting *Graves Case*, L.R. 4 Q.B. at 722).

71. *See id.* at 192.

brief by The Wallace Collection and invited the parties to respond to Professor Patry's letter.⁷²

D. The District Court's March Decision

While the court's March 1999 decision⁷³ ultimately affirmed its earlier entry of summary judgment against Bridgeman, it reached its decision by applying different law. In its November, 1998 decision, the court had applied British law on the question of copyrightability.⁷⁴ In its March, 1999 decision, the court held that the Berne Convention Implementation Act "made it quite clear" that Congress did not view the United States' adherence to the Berne Convention as requiring U.S. courts to apply foreign law in copyright infringement cases brought by foreign plaintiffs in U.S. courts.⁷⁵

The court then gave a somewhat "fuller statement" of the reasons why Bridgeman's images were not copyrightable under U.S. law.⁷⁶ The court began by explaining that "there is broad scope for copyright in photographs because 'a very modest expression of personality will constitute sufficient originality.'"⁷⁷ The court then cited Nimmer for the proposition that copyright is not available "where a photograph of a photograph or other printed matter is made that amounts to nothing more than slavish copying."⁷⁸ While the court conceded the "possibility that protection in such a case might be claimed as a 'reproduction of a work of art'"⁷⁹ the court explained that the Nimmers "point out that this suggestion is at odds with the Second Circuit's en banc decision in *L. Batlin & Son, Inc. v. Sny-*

72. *See id.*

73. *Bridgeman Art Library, Ltd. v. Corel Corp.*, 36 F. Supp. 2d 191 (S.D.N.Y. 1999).

74. *See Bridgeman Art Library, Ltd. v. Corel Corp.*, 25 F. Supp. 2d 421, 426 (S.D.N.Y. 1998). The court did, however, use U.S. law to construe British law since it found (a) there was "substantial similarity between the originality requirements of the UK Act and the Copyright Act," and (b) "the Privy Council itself has looked to American law as persuasive authority with respect to copyright originality." *See id.* at 427 n.41 (citing *Interlego AG v. Tyco Industries Inc.*, 3 All ER 949, 969 (P.C. 1989)(appeal taken from Hong Kong)).

75. *Bridgeman II*, 36 F. Supp. 2d at 195.

76. *Id.*

77. *Id.* at 196 (citing 1 NIMMER, *supra* note 17, § 2.08[E][1]).

78. *Id.* (citing 1 NIMMER, *supra* note 17, § 2.08[E][2]).

79. *Id.* (citing 1 NIMMER, *supra* note 17, § 2.08[E][1]). Nimmer's proposition is based on the argument that a photograph of a photograph should not be protectable since (a) it does not constitute a distinguishable variation, and (b) because the first photograph might not be regarded as a work of art since there are separate classifications for "works of art" and photographs under the Copyright Act. *See* 1 NIMMER, *supra* note 17, § 2.08[E][2] n.212.

der.”⁸⁰ After noting that “the requisite ‘distinguishable variation’ [required by *Batlin*] is not supplied by a change of medium,”⁸¹ the court ruled that the images at issue were not copyrightable since they were “‘slavish copies’ of public domain works of art” and therefore “there was no spark of originality”⁸² in them. While the court conceded that Bridgeman’s photography “doubtless requir[ed] technical skill and effort,” it ruled that the Supreme Court’s decision in *Feist* rejected such justifications for copyright since ‘sweat of the brow’ alone is not the ‘creative spark’ which is the sine qua non of originality.”⁸³ Therefore, after dispensing with Bridgeman’s contentions that the court had overlooked evidence supporting the validity of its copyrights and had misconstrued British law,⁸⁴ the court affirmed its entry of summary judgment against Bridgeman.⁸⁵

III. DISCUSSION

A. The Court Properly Denied Copyright Protection to Bridgeman’s Exact Reproductions of Public Domain Works of Art

The *Bridgeman* court’s application of existing copyright doctrine to the facts of this case was as proper as it was unremarkable. Since Bridgeman’s exact reproductions were not “distinguishable variations” of the underlying works,⁸⁶ its Copyright Act claims were ultimately premised on two arguments: (1) that photographs are per se copyrightable, and (2) that its photography demonstrated sufficient “skill, labor, and judgment” to warrant protection. The court rejected both arguments by holding:

80. *Bridgeman II*, 36 F. Supp. 2d at 196. *See supra* Part I.A.1.

81. *Bridgeman II*, 36 F. Supp. 2d at 196 (quoting *Past Pluto Prod. v. Dana*, 627 F. Supp. 1435, 1441 (S.D.N.Y. 1986)).

82. *Id.* at 197.

83. *Id.*

84. The court addressed these arguments by ruling (a) that certificates of registration, while establishing the prima facie validity of the copyright, do not create an irrebuttable presumption that the alleged copyrights are valid, and (b) that *Graves Case* is no longer good case law in the United Kingdom. *See id.* at 197-200.

85. *See id.* at 200.

86. Bridgeman did argue, however, that its images were distinguishable variations of the underlying works since each of its high-resolution transparencies contained a color correction bar. The court rejected this argument in its November decision by explaining that “even if the images with the color bars attached are copyrightable, they may be infringed only by reproduction of Bridgeman’s unique variation, the color bars. As Corel’s images did not include color correction strips, their significance for copyrightability is academic in this case.” *Bridgeman I*, 25 F. Supp. 2d at 427.

[t]here 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.⁸⁷

Given the Second Circuit's acceptance of Nimmer's proposition that "'slavish copies' of photographs or other printed matter are not copyrightable,"⁸⁸ and given that Bridgeman "by its own admission [] labored to create 'slavish copies' of public domain works of art,"⁸⁹ the court's rejection of Bridgeman's "per se" argument is not surprising. Equally unremarkable was the court's rejection of Bridgeman's argument that its photography demonstrated sufficient skill, labor, and judgment to warrant protection. First, "technical skill and effort" does not fulfill the requirements of *Alva Studios'* skill, labor, and judgment test; the test requires "something more than the skill of an artisan,"⁹⁰ which has been interpreted to require that the work evidence "true artistic skill."⁹¹ Although the court did not make any specific findings of fact on this point, trade literature supports the court's conclusion that copy photography indeed requires technical skill, not artistic talent.⁹² Second, *Alva Studios* requires that this skill, labor, and judgment be exercised "without directly copying . . . the work of another."⁹³ Since Bridgeman admitted that the photographs were

87. *Bridgeman II*, 36 F. Supp. 2d at 197 (quoting *Rogers v. Koons*, 960 F.2d 301, 307 (2d Cir. 1992)) (emphasis added).

88. See *Hearn v. Meyer*, 664 F. Supp. 832, 835 (S.D.N.Y. 1987) (holding that slavish reproductions of public domain original works are not copyrightable.).

89. *Bridgeman II*, 36 F. Supp. 2d at 197.

90. *Hearn*, 664 F. Supp. at 839.

91. *Batlin*, 536 F.2d at 491.

92. As Sheldon Collins, former photographer for the Metropolitan Museum of Art explains, copy photography consists of six steps: "getting instructions, choosing a perspective, preparing a set, lighting the art, computing the exposure, and exposing the film." SHELDAN COLLINS, HOW TO PHOTOGRAPH WORKS OF ART 137 (1992). In describing the two elements that are arguably the most creative steps in this process—choosing a perspective and lighting the art—Collins explains that "perspective requires that an observer look at it from a centered position for an ideal view . . . [c]onsequently the camera is nearly always placed in the exact center of the field of view" and that a copy photographer's "choice of lighting" consists of "placing an even number of light sources of equal intensity and an identical design . . . symmetrically, at an equal distance to the left and right of the art." *Id.* at 139. Therefore, the overwhelmingly technical nature of the process lends support to the *Bridgeman* courts' finding that such photography demonstrates only technical skill and effort.

93. *Alva Studios, Inc. v. Winninger*, 177 F. Supp. 265, 267 (S.D.N.Y. 1959).

direct copies of the underlying works, it seems safe to conclude that the court correctly applied existing copyright doctrine to the facts of this case and properly denied protection to Bridgeman's exact photographic reproductions of public domain works of art.⁹⁴

B. The *Bridgeman* Court's Decision Upholds Important Policy Considerations

The *Bridgeman* court's decision is significant not for the doctrine it applied but for the policy considerations it embodied. These policy considerations, in turn, serve to promote fair competition between producers of art reproductions. Understanding this dynamic requires analysis of the end product of art reproductive photography, the applicable doctrine, and the market in which Bridgeman operates.

Despite the precise and technical nature of the photographic process involved in reproducing two-dimensional works of art,⁹⁵ the end product of such photography can vary significantly. Thus, it is often possible to point to distinguishable variations between the original work of art and an "exact" reproduction; and it is also possible to point to distinguishable variations between two "exact" copies of the same work.⁹⁶ Although there may be a multitude of reasons for this, it seems that a photographer's "stylistic decisions" may play a role. As Robert A. Baron, Chair of the In-

94. The court's decision is doctrinally significant only in that it suggests that *Feist* can be applied to works that are more artistic than telephone directories. In fact, before *Bridgeman II*, copyright commentators wondered whether *Feist* "spelled the end of *Alva Studios* as viable doctrine." Howard Abrams, *Copyright and Legislation: The Kastenmeier Years*, 55 LAW & CONTEMP. PROBS. 3, 42 (1992). And while the *Bridgeman II* court's use of language from *Feist* will certainly add fuel to this fire, its decision does not spell the end of *Alva Studios* because (a) the court never comments, discusses, or purports to apply the *Alva Studios* test, and (b) *Alva Studios* is a three-pronged test that rewards true artistic skill, labor, and judgment, not "sweat of the brow" alone. See *Alva Studios*, 177 F. Supp. at 267.

95. See generally COLLINS, *supra* note 92.

96. On a recent visit to U.C. Berkeley's School of Art and Architecture, Maryly Snow, Slide Librarian and author of several articles on the history of art reproductions, demonstrated this in a matter of minutes. First, Snow showed a slide of a reproduction of a work of art that was produced in the early 1970s. Next, Snow showed a contemporary slide of the same work. In comparing the new reproduction against the old, the old reproduction appeared "dated"—the colors appeared "metallic," the lighting bathed the entire image in a yellowish haze—and this older reproduction was readily distinguishable from the newer reproduction, the colors of which appeared "softer," the lighting "cleaner," and the resulting image sharper. When I mentioned this to Snow, she agreed, adding "[a]nd 50 years from now we will probably look at these [both the old and the new reproductions] as antiques." Interview with Maryly Snow, Slide Librarian, U.C. Berkeley School of Art and Architecture, in Berkeley, Cal. (Nov. 25, 1999).

Intellectual Property Committee at the College Art Association, points out, art reproduction photography:

has undergone “stylistic” changes. [For example], in the 1950s and 1960s, the publisher Skira in Switzerland hit on a new way to photograph paintings that made them considerably more luminous. By photographing them close up under high illumination, depths of color were revealed that were not visible to the human eye in ordinary light. . . . [T]he very fact that you can write a stylistic history of reproductive photography may indicate that photographers (whether they know it or not) are making stylistic decisions—and in these decisions [may be] the needed original elements.⁹⁷

Thus, if the differences between two “exact” photographic reproductions are “distinguishable,” and if the goal of Congress’s grant of copyright protection to art reproductions is to give publishers like Skira the incentive to pursue such innovations,⁹⁸ then it is at least arguable that courts ought to uphold—rather than reject—the validity of such copyrights.

While copyright doctrine protects art reproductions and derivative works that contain “distinguishable variations,” it cannot protect works that contain only slight (i.e., “merely trivial”) distinguishable variations because to do so would “put a weapon for harassment in the hands of mischievous copiers intent on appropriating and monopolizing public domain work.”⁹⁹ The requirement that art reproductions and derivative works demonstrate more than a “merely trivial” distinguishable variation serves an important evidentiary purpose—it prevents overlapping claims. As Judge Posner explained in *Gracen v. Bradford Exchange*:¹⁰⁰

Suppose Artist A produces a reproduction of the Mona Lisa, a painting in the public domain, which differs slightly from the original. B also makes a reproduction of the Mona Lisa. A, who has copyrighted his derivative work sues B for infringement. B’s defense is that he was copying the original, not A’s reproduction. But if the difference between the original and A’s reproduction is

97. E-mail from Robert A. Baron, Chair, Intellectual Property Committee, College Art Association, to Kathleen Connolly Butler, Professor of Law, Thomas M. Cooley School of Law (Jun. 21, 1999) (on file with author).

98. See U.S. CONST. art I, § 8, cl. 8 (providing 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) (emphasis added).

99. *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 492 (2d Cir. 1976).

100. 698 F.2d 300 (7th Cir. 1983).

slight, the difference between A's and B's reproductions will also be slight, so that if B had access to A's reproductions, the trier of fact would be hard pressed to decide whether B was copying A or copying the Mona Lisa itself.¹⁰¹

Bridgeman presents the precise problem highlighted by Judge Posner. Because Bridgeman's high-resolution color transparencies were as true to the original works of art as possible,¹⁰² Corel's images (if they too were true to the original) would have been necessarily substantially similar to Bridgeman's. If Bridgeman had established access, Corel would have had the burden of proving that their images were copied from another source. If courts were to place such a burden on defendants in copyright infringement suits, "mischievous" image vendors could use their copyrights to harass competitors, thereby stifling fair competition in the market for art reproductions.

The court's decision also reinforces important policy considerations against impeding public access to public domain works of art. Initially, Bridgeman claimed it owned "the only images of the works in question and that the works themselves could not have been photographed anew."¹⁰³ Had the court granted copyright protection to these images, Bridgeman could have used its copyright in the photograph to prevent the public from reproducing or distributing any image that was substantially similar.¹⁰⁴ Thus, while Justice Holmes once defended the copyrightability of art reproductions by pointing out that the public would always be "free to copy the original,"¹⁰⁵ it is plain to see how an "exclusive right" to photograph the original work of art, coupled with a copyright in the only authorized photograph, would render such a promise illusory. Therefore, by denying Bridgeman a copyright in their exact photographic reproduc-

101. *Id.* at 304.

102. *See* *Bridgeman Art Library, Ltd. v. Corel Corp.*, 36 F. Supp. 2d 191, 199, n.54 (S.D.N.Y. 1999).

103. *Bridgeman Art Library, Ltd. v. Corel Corp.*, 25 F. Supp. 2d 421, 428, n.50 (S.D.N.Y. 1998). Bridgeman later recanted and admitted that it was not the only possible source for 119 of the 120 images. *See id.* The court dispensed with Bridgeman's claims to "exclusive rights" in all existing images of the underlying works because it found "the record arguably supports the view that Bridgeman is merely an exclusive licensing and sales agent for reproductions owned by the museums." *Id.* at 426.

104. *See* 17 U.S.C. §§ 106 (1) & (3) (1994) (granting authors the exclusive right to reproduce and distribute their works.).

105. *Bleistein v. Donaldson Lithographic Company*, 188 U.S. 239, 249 (1903).

tions of public domain works of art, the court ensured that these images would remain “part of the public domain[,] available to every person.”¹⁰⁶

C. The Market Already Provides Bridgeman with an Adequate Economic Incentive

Copyright law is premised on a fundamental principle of micro-economics—in the absence of an economic reward, producers (here artists) will not have an adequate incentive to create new works.¹⁰⁷ Although this assumption is problematic,¹⁰⁸ and fails to address a myriad of concerns,¹⁰⁹ it is a creature of the Constitution.¹¹⁰ From this, it follows that where the market already provides an adequate reward for the production of new (or in this case reproductive) works, the case for copyright is, in the words of Justice Stevens, weak.¹¹¹ The background facts suggest this may be true in *Bridgeman*.

The primary market for high-resolution transparencies of public domain works of art is universities, publishers, and advertising agencies.¹¹² Universities require high-resolution transparencies for their art history and art courses as well as for research purposes.¹¹³ Publishers use high-resolution transparencies in textbooks and other printed matter.¹¹⁴ Advertising agencies require “color transparencies [because they] provide much higher quality reproduction than would a . . . photograph.”¹¹⁵ High-resolution color transparencies are more expensive than other types of art reproductions.¹¹⁶ Therefore, the background facts suggest that Bridge-

106. *Feist Publications, Inc. v. Rural Telephone Service Company, Inc.*, 499 U.S. 340, 348 (1991).

107. See Linda Lacey, *Of Bread and Roses and Copyrights*, 1989 DUKE L.J. 1532 (pointing out that this incentive theory is “boilerplate micro-economic analysis”).

108. See Stephen Breyer, *The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs*, 84 HARV. L. REV. 281, 350 (1970) (arguing that “the case for copyright protection is weak, particularly as applied to certain classes of works”).

109. See Lacey, *supra* note 107, at 1532-96 (pointing out that this “boilerplate micro-economic analysis” fails to account for the fact that many artists create for non-economic reasons and further noting that this justification for copyright fails to protect an artist’s moral right in her work).

110. See *supra* note 98.

111. See Breyer, *supra* note 108.

112. See Butler, *supra* note 3, at 59-78.

113. See *id.* at 62-63, 77.

114. See *id.* at 62.

115. Ronald Alsop, *Fine Art is Now on Exhibit in Many Ads But Critics Say Commercial Use Cheapens the Great Masterpieces*, WALL ST. J., Mar. 25, 1988, available in 1988 WL-WSJ 475381.

116. See Butler, *supra* note 3, at 63 n.24.

man's business strategy was to service this large, high-end market for color transparencies. Bridgeman's marketing strategy reflects this focus—in the U.S., Bridgeman provided its potential customers with copies of its low-resolution CD-ROMs free of charge as a catalogue of their high-resolution transparencies.¹¹⁷

But even though the court refused to extend copyright protection to Bridgeman's images, it does not affect Bridgeman's ability to compete in the market for high-resolution color transparencies. As Ronald Alsop explains, "[b]ecause good reproduction is so important in advertisement, agencies typically won't use a certain painting unless they can get the transparencies."¹¹⁸ Therefore, given the need for high-resolution color transparencies in certain contexts, it is reasonable to assume that certain customers will continue to purchase transparencies from Bridgeman because it is already well-positioned to service this market. In fact, the real threat to Bridgeman's position in the market for high-resolution color transparencies comes not from those who would make low-resolution copies of their high-resolution transparencies, but from technology that would permit others to make high-resolution copies of their high-resolution transparencies. Thus, the court's decision in *Bridgeman* may reflect a judicial determination that as Bridgeman already possesses an adequate economic incentive to produce high-resolution color transparencies (even in the absence of a copyright in the images themselves), their case for copyright—based on an incentive theory—is weak.

The court's decision does not affect Bridgeman's ability to compete in the market for low-resolution reproductions of public domain works of art. In fact, the court's decision tells Bridgeman (and others like Bridgeman) that courts will not impede access to this market and will thus leave it to the market itself to provide producers with the requisite incentive. Therefore, most image vendors are pursuing a marketing strategy designed to attract customers who want access to the widest variety and greatest number of works.¹¹⁹ Bridgeman, which claims to own images from 800 museums, galleries and contemporary artists,¹²⁰ can hardly be said to be at a

117. *Bridgeman I*, 25 F. Supp. 2d at 424.

118. Alsop, *supra* note 115.

119. For example, while Corbis Corporation claims that it owns "The World's Largest Collection of Fine Art and Photography," Corbis Corp. *About Corbis*, (visited Jan. 29, 2000) (<http://corbis.com>), Bridgeman boasts that it owns "The World's Most Comprehensive Source of Art Images for Reproduction." Bridgeman Art Library, Ltd., *About Us* (visited Jan. 29, 2000) (<http://bridgeman.co.uk>).

120. Bridgeman Art Library, *About Us* (visited Jan. 29, 2000) (<http://bridgeman.co.uk/public/aboutus/index.jhtml?go=true&r=513890>).

disadvantage in this market—even in the absence of copyright protection. Therefore, since *Bridgeman* already possesses an adequate economic incentive to produce low-resolution reproductions of public domain works of art, the court's decision may reflect a judicial determination that granting copyright protection to this class of works would give art reproducers like *Bridgeman* unjustified monopolies in a market in which they are already able to compete.

D. The Court's Decision Channels Protection to a More Appropriate Form of Intellectual Property Protection

The court's decision does not mean *Bridgeman*'s intellectual property is unprotectable. In fact, as Professor Peter Menell writes: "given the broad array of modes of intellectual property protection, each with differing standards and terms of protection, the overall efficacy of the intellectual property regime depends significantly upon the ability of the system to properly channel innovation among the various modes."¹²¹ Thus, the court's refusal to protect *Bridgeman*'s images as derivative or photographic works may serve to channel this type of innovation into a more appropriate form of protection.

1. Bridgeman's image library may be copyrightable as a compilation

Bridgeman's image library may be copyrightable as a compilation.¹²² Admittedly, "copyright in a . . . compilation is thin."¹²³ Nonetheless, as the *Feist* Court explained, authors of such compilations are entitled to protection since:

[t]he compilation author typically chooses which [pre-existing material] to include, in what order to place them, and how to arrange the collected data so that they may be effectively used. . . . These choices as to selection and arrangement, so long as they are made independently by the compiler and entail a minimal

121. Peter S. Menell, *Intellectual Property: General Theories*, in *ENCYCLOPEDIA OF LAW AND ECONOMICS* (B. Bouckaert & G. De Geest eds., forthcoming 2000).

122. Section 101 of the Copyright Act defines a compilation as "[a] work formed by the collection and assembling of pre-existing materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." 17 U.S.C. § 101 (1994).

123. *Feist Publications, Inc. v. Rural Telephone Service Company, Inc.*, 499 U.S. 340, 349 (1991).

degree of creativity, are sufficiently original that Congress may protect such compilations through the copyright laws.¹²⁴

Thus, to the extent that Bridgeman independently and creatively selected, coordinated, and arranged public domain works of art, it is entitled by statute to enjoin others from selling substantially similar compilations.¹²⁵ Granting protection to Bridgeman's images as compilations has several advantages from a policy perspective. First, since the copyright in such a compilation extends only to the selection, coordination, and arrangement of the materials, it would not affect the public's right to access and use the individual images and would thus guarantee the images remain "part of the public domain available to every person."¹²⁶ Second, granting copyright protections to compilations would give museums and image vendors an incentive to add value by creatively compiling the information so that it may be effectively used by the general public. Finally, granting protection to such works as compilations comports with the purposes of copyright—which is to encourage creation, not slavish copying.

2. *Bridgeman's photographic process may be patentable*

To the extent that Bridgeman's photography employs new, useful, non-obvious processes which are fully disclosed¹²⁷ in the application, Bridgeman may be entitled to a patent on the process. Indeed, after the court's March decision, Stephen A. Weingrad, a lawyer for Bridgeman, spoke of Bridgeman's images as though they were novel and unique: "the images . . . were magnificent 8+ 10 positive transparencies made under superb conditions. They are not reproducible by a walk-by photographer with a point-and-shoot camera."¹²⁸ Channeling protection for Bridgeman's photography to patent law provides Bridgeman (and society in general) with several benefits. First, it gives Bridgeman an economic incentive to invent new photographic processes that will "advance the Progress of Science."¹²⁹ Second, by requiring Bridgeman to disclose their process in the patent application, it allows others to use the process once the statutory

124. *Id.* at 348.

125. See 17 U.S.C. §§ 501-506 (1994) (listing the remedies for infringement of copyrights).

126. *Feist*, 499 U.S. at 348 (quoting *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365, 1369 (5th Cir. 1981)).

127. See Patent Act, 35 U.S.C. §§ 101-103, 112 (1994).

128. Deborah Pines, *Copyright Protection Refused for Photographs of Classic Art*, N.Y. L.J., Feb. 24, 1999, at 1, col. 3.

129. See *supra* note 98.

period of exclusive control has ended.¹³⁰ Finally, by protecting the process of art reproductive photography rather than the end product, the public is assured their access to public domain works of art will remain unfettered.

3. *Bridgeman may be protected by unfair competition laws*

Although the court dismissed *Bridgeman's* unfair competition claims for lack of jurisdiction, it might be that this body of law is better suited to address the wrongs alleged in this suit. While a full discussion of unfair competition law is beyond the scope of this Note, the alleged wrong that forms the basis of *Bridgeman v. Corel* was that Corel had violated a property right by copying *Bridgeman's* images without compensating them for this use. If we substitute the words "committed a wrong" for "violated a property right," it seems *Bridgeman* would still have a cause of action that adequately describes the alleged wrong, except that the former sounds in property while the other sounds in tort. Remedying these wrongs through unfair competition law might be better since such causes of action would not threaten the public domain status of the underlying images, would provide plaintiffs with the ability to bring such suits beyond the statutory limit set for copyright actions, and might lessen problems of proof inherent in most copyright infringement actions.

IV. CONCLUSION

The *Bridgeman* decision has evoked strong feelings on both sides of a long-standing divide that has existed in the art community since the advent of digital technology. On one side of this divide are those (usually museum directors) who see digitization as potential "cash cows"¹³¹ for their enterprises. For these people, the *Bridgeman* decision represents a dangerous precedent they hope will not be affirmed in the higher courts. For those on the other side of this divide—generally egalitarian minded museum workers and art historians who see digital technology as an ideal way to educate the public about art—the *Bridgeman* decision represents an affirmation of what they've asserted from the beginning—that public domain works of art ought to remain accessible to the public and that granting copyright privileges to public domain works of art inevitably creates unwarranted, unjustifiable barriers to access.

130. See Patent Act, 35 U.S.C. §§ 112, 154 (1994) (stating the written description requirement and patent term.).

131. Interview with Rick Rinehart, Information Systems Manager, U.C. Berkeley Art Museum, in Berkeley, Cal. (Nov. 18, 1999).

But even though the *Bridgeman* decision ultimately affirms the public's right to use public domain works of art, it may lead museums and private companies to exert tighter control over these images. Indeed, as one commentator concluded in his summary of the *Bridgeman* decision:

[I]mage vendors would be thus wise to reexamine their licensing practices and, in particular, the form and content of the restrictions they place upon access and use. Absent copyrights, it becomes critical to the possessor of valuable images that they not be let loose upon the world without binding, contractual restrictions.¹³²

While the enforceability of such contractual provisions has not yet been fully settled by the courts,¹³³ their *in terrorem* effect may curb public use. Therefore, it seems the full impact of the *Bridgeman* decision will be felt only if courts prevent image vendors from achieving through contract what they couldn't achieve—at least in *Bridgeman v. Corel*—through copyright.

132. Paul Dennis Connuck, *No Copyright for Art Reproductions?*, N.Y. L.J., May 17, 1999, at S3.

133. See 17 U.S.C. § 301(a) (federal copyright preemption); U.S. CONST. art. VI, cl. 2 (Supremacy Clause).

