



ANNOUNCEMENT

from the Copyright Office, Library of Congress, Washington, D.C. 20559

FINAL REGULATION

COPYRIGHT REGISTRATION FOR COLORIZED VERSIONS OF BLACK AND WHITE MOTION PICTURES; FINAL RULE

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LIBRARY OF CONGRESS

Copyright Office

37 CFR Part 202

[Docket No. RM 86-1B]

Copyright Registration for Colorized Versions of Black and White Motion Pictures; Final Rule

AGENCY: Copyright Office, Library of Congress.

ACTION: Final regulation.

SUMMARY: The Copyright Office of the Library of Congress is adopting a final rule with respect to the deposit of a black and white print of a motion picture along with a copy of the computer colorized version in order to register a claim to copyright in the colorized version. This is intended to improve the ability of the Copyright Office to process applications to register claims to copyright.

EFFECTIVE DATE: August 9, 1988.

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SUPPLEMENTARY INFORMATION: On June 22, 1987, the Copyright Office announced its decision to register certain colorized versions of black and white motion pictures (52 FR 23443). Two days later, the Office published a proposed rule that would require the deposit of a black and white print along with a copy of the computer-colorized version in order to register a claim to copyright in the selection of colors. (52 FR 23691).

Interested persons were asked to comment on the proposed rule.

Six comment letters were submitted. Two of these objected to the decision to register claims to copyright in the colorized version. For the reasons given in the June 22, 1987 registration decision, the Office maintains the view that certain colorized films can satisfy the original work of authorship standards of the copyright law.

Of the other four comments, one represents the attorney's own views; two represent groups who are making colorized versions; and the fourth is characterized as a summary of responses to the proposed rule made by thirteen members of the Copyright Office Affairs Committee of the Patent, Trademark and Copyright Section of the American Bar Association ("ABA").¹ These comments specifically address the proposed deposit regulation by questioning in one way or another the Copyright Office's authority to make such a rule, the wisdom of requiring the comparison of the two versions in the examination process, or the necessity of requiring a black and white print as a deposit instead of a black and white videotape. They also raise other issues related to this rulemaking.

¹ The Chairman of this Committee mailed a cover letter summing up his views and past discussion to each member with a space provided for each member to check a box denoting whether he or she agreed with the proposed rule or believed the Committee should oppose the rule. A space was also provided for each member to comment on the rule. It is not clear from the comment submitted to the Copyright Office, primarily a distillation of the views set out in the Chairman's cover letter, how many members made individual comments.

1. The Authority Issue

One attorney questions whether the Copyright Office, a legislative branch agency, should exercise what he characterizes as even broader administrative and executive functions. He contends that the proposed rule on deposit violates both the letter and the spirit of the copyright statute. Eleven of the thirteen ABA committee members who responded felt that the Office lacks the statutory authority to establish the proposed deposit requirement. On the other side, two ABA members including a law professor felt the Copyright Office had sufficient authority to do so. The comments submitted on the behalf of colorizers indicate a willingness to¹ deposit a black and white copy of the motion picture for the benefit of the public without conceding the Office's authority to require one, provided the requirements are reasonable.

The Copyright Office finds that authority for requiring a black and white copy in addition to the colorized copy exists under both the general rulemaking authority of 17 U.S.C. 702 and the specific authority given to the Register of Copyrights to specify by regulation, the "nature of the copies or phonorecords to be deposited in the various classes specified." 17 U.S.C. 408(c)(1). In *National Conference of Bar Examiners v. Multistate Legal Studies, Inc.*, 692 F.2d 478 (7th Cir. 1982), the Seventh Circuit found that the Copyright Act "vest[s] broad authority in the Register of Copyrights to fashion a workable system of registration and deposit of copyrighted works." 692 F.2d at 484. It is clear that the deposit requirements serve many purposes: examination of claims; evidence of the

¹ Error; line should read: "colorizers indicate a willingness to"

identity, content, and scope of the registered work for litigation and commercial transaction purposes; and enrichment of the collections of the Library of Congress for contemporary users (both the general public and the Congress) and for posterity. The Register of Copyrights is vested with broad authority to establish reasonable deposit requirements that take account of the varied, and sometimes conflicting, purposes of the registration-deposit system.

When the Copyright Office announced its decision to register certain colorized versions of black and white prints, it specified a set of criteria it would use to determine whether the color added to a black and white motion picture is a modification of a preexisting work "which, as a whole, represent(s) an original work of authorship." 17 U.S.C. 101. One of these criteria is that the color added be more than a trivial variation. Another confirms the existing regulatory prohibition on copyright registration based on mere variations of color.

After examination of all of the comments submitted in response to the original Notice of Inquiry and to the proposed regulation, the Copyright Office concludes that the deposit of a black and white film version will facilitate the examination necessary to determine that the colorized version for which registration is sought is more than a trivial variation. Color conversion of films by computer clearly represents a new way of creating derivative works. The Office has stated that it will monitor technological developments to assess further the quantity of human authorship and the degree of control the "technician-author" exercises in relation to the computer. The Office could have adopted other requirements to gain information that would assist in the examination of claims, such as affidavits or other paper documentation. The deposit requirement selected by the Office has the advantage both of facilitating examination to ascertain the fact of original authorship in the colorized version compared to the previous versions of the film, and of enriching the collections of the Library of Congress for the benefit of the public and posterity.

The Office has considered the expense and possible inconvenience to registrants of requiring deposit of the black and white copy. The Office notes that the colorization process itself is expensive. The average cost is \$180,000 to \$200,000 per film. The cost of a print for registration is modest in comparison, especially when one also considers the value of the intellectual property protected by the registration.

With respect to convenience, in order

to make the colorized version, the colorizer must already have access to the black and white version; and, as a rule, this will be a celluloid print. In those cases where the particular copy does not satisfy the archival standards of the Library, special relief may be requested, based on a proposal to deposit the best available, near-archival quality black and white print.

Precedent exists for requiring supplementary or identifying deposit materials in addition to the copy of the work for which registration is sought. In the case of motion pictures, the Copyright Act of 1909 required the deposit of a description of the work in addition to photographs or prints; the regulations issued in 1978 require deposit of a separate description of the contents, such as a continuity or pressbook, in addition to one complete print. When the Copyright Office first registered claims to copyright in computer programs in 1984, the Office² required deposit of two machine-readable copies, a complete print-out in human-readable form, and any accompanying manuals, flow charts, or other documentation. Like computer program registration in 1964, registration of computer-colorized motion pictures in the 1980's presents the Office with difficult, new copyright examination issues. The deposit requirement adopted today is responsive to the unique nature of the computer-colorizing process.

2. Comparison of Different Versions

Two comments question the wisdom of allegedly establishing a precedent by comparing the original work and the derivative work to determine the copyrightability of the derivative work.

One comment asserts that if such a practice is limited to colorized motion pictures, it is discriminatory. The commentator maintains that although the proposed deposit rule is not "expressly forbidden," Copyright Office practice and the Compendium of Copyright Office Practices "make it clear that the examination process is not intended to include the making of comparisons." He quotes a pre-1978 regulation which said that the Office does not make comparisons "to determine similarity of works." He also cites a current Compendium statement that the Office does not "generally make comparisons of copyright deposits to determine whether or not particular material has already been registered." *Compendium II Copyright Office Practices*, 108.03. (Emphasis added).

The other comment that addresses this issue reports that most of the ABA members who oppose the proposed deposit rule feel that examination of the derivative work by comparison with the original would establish a dangerous precedent. Some of them also expressed

the fear that the Copyright Office is moving toward a patent type examination. To the contrary, another ABA respondent asserted that he had already considered all of these arguments, and still felt the proposed deposit requirement to be a good one that would not "place the Copyright Office on a 'slippery slope' toward becoming anything that even begins to approximate the Patent and Trademark Office."

The Copyright Office has considered these arguments especially in light of the grounds asserted for registration of claims to copyright in colorized versions of films. The Copyright Act specifies that the issuance of the certificate follows the examination and determination that "the material deposited constitutes copyrightable subject matter * * *" 17 U.S.C. 410(a). Moreover, "the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate." 17 U.S.C. 410(c). The Compendium specifies in section 108.01 that examination is made to determine:

- (1) Whether or not the work for which registration is sought constitutes copyrightable subject matter and
- (2) Whether or not legal and formal requirements have been met * * *

The arguments based on the pre-1978 regulation or section 108.03 of the Compendium are not persuasive. Like existing 37 CFR 201.2(a)(1), the pre-1978 regulation cited by one commentator applies to "information given by the Copyright Office," in response to requests from a member of the public. Neither regulation applies to examination of claims to copyright, which is governed by regulations set forth at 37 CFR Part 202 and by the *Compendium*. Section 108.03 would apply to a situation where there is a possibility that more than one colorized version of the same black and white film may exist. In that case the Copyright Office would not "generally" make a comparison based on determining whether a prior colorized version has already been registered, although it may do so occasionally—hence we use the qualifying term "generally."

Thus, even if section 108.03 were applicable, it merely states a *general* practice that admits of exception. While the practice may not be generally known, in fact, the Copyright Office does occasionally compare previously registered works in examining a given claim. We have done so for several decades. The application forms have long requested disclosure of a previous registration (including the registration number) where registration is sought for a derivative work. The comparison is

² Error; line should read:
"computer programs in 1964, the Office"

made depending on a number of factors, including the nature of the work, the nature of the authorship claimed as new matter, the availability of the prior registered copy, whether the registration number is known, whether the copy of the pending work discloses information that presents a registration issue (e.g. the year date in the notice) that may be resolved by review of the previously registered work, and so forth. In the past, comparisons have been made especially between unpublished music and published music claims, between ad interim books and the American edition, and between original term works and renewal applications for such works.

The Copyright Office is not embarking, and does not seek to embark, upon a patent or trademark-like examination. The regulations we are adopting will ensure that a Copyright Office examiner will have the necessary material to determine whether the colorized version is more than a trivial variation of the original film from which it is derived. The Office will examine *each* colorized version on its own merits in relation to the material each added to the original black and white film.

3. The Necessity of Requiring a Black and White Print

Three comments are directed to the burden imposed on the registrant of a colorized version by requiring a deposit of a black and white print. One comment argues that if this deposit requirement is retained, it must be recognized as "ancillary" and cannot impose any "meaningful burden" on the copyright owner. Another urges that the proposed deposit rule "imposes a burdensome and expensive" requirement on one type of derivative work. The third comment asserts that real practical impediments exist:

1. No single print of the underlying work may exist.
2. The registrant may not own the black and white print.
3. It would be "extremely difficult, and prohibitively expensive, to produce a 'complete print' of the version upon which the colorized version was based."

Two of these comments assert that the person making the deposit should be given the option of depositing either a videotape or a print of the black and white version. One of them suggests that the regulations could require deposit of "one viewable copy of the black and white motion picture upon which the color-converted version is based." The other insists that a balance is needed to accommodate the needs of the Copyright Office and the Library of Congress without burdening the copyright owner.

On the other side, a film group opposed to registration of colorized film

urges that only black and white print is acceptable. This group observes that the black and white videotape used to produce colorized versions "is intentionally printed with low contrast to facilitate colorization" and says that the proposed rule does not recognize the "crucial differences in format" between the colorized motion picture, which exists only on videotape, and the original black and white film, which exists in celluloid. It emphasizes that the black and white videotape is unsuitable for archival purposes and questions whether *any* tape, black and white or color, is a viable form of deposit for archival purposes since it has a short shelf life especially when compared to celluloid print.

While only six parties responded to the proposed new regulation, forty-three responded to the original inquiry concerning registrability. A majority of the individuals who responded to the original inquiry characterized colorization as a desecration of the original black and white film, and many of them expressed the fear that the original black and white film would be lost to posterity. In legislative hearings, colorizers assured the congressional copyright subcommittees that colorizing not only enhances the quality of the old black and white film, but also ensures that the old film will be preserved and will always be available in its original form.²

In the original comment period, several of those who supported registration of the colorized version, also saw the need for deposit of the black and white print. The Copyright Office preliminarily concluded that such a deposit would serve two purposes: To enable the examiner to determine better whether the colorized version satisfies the applicable standards for copyright registration, and to enrich the collections of the Library of Congress since in many cases the older black and white films were never registered or otherwise deposited with the Library.³

² See Hearing on Colorization Before the Subcommittee on Technology and Law of the Senate Judiciary Committee, May 12, 1987. (statement of Roger L. Mayer, President, Turner Entertainment Co.) (statement of Rob Word, Senior Vice President, Creative Affairs, Corporate Officer, Hal Roach Studios, Inc.) (hereafter "1987 Senate Hearing").

³ The gaps in the Library's collection exist primarily with respect to 1930's and 1940's films. Before the introduction in 1942 of the special contractual arrangement, known as the Motion Picture Agreement, many films were not registered; the films could not be acquired through the demand deposit provisions of the Copyright Act of 1909 because the films were arguably unpublished under that former law. Contrary to the assertion of one commentator, the Motion Picture Agreement has been a vehicle for filling gaps in the collection and is not the cause of the gaps.

Both in this administrative proceeding and in congressional hearings, one or more proponents of colorization stated that they obtained the best quality print of the original black and white film *before* transferring it to a black and white videotape. Representations were made that restoring the black and white print sometimes meant re-assembling the film by putting together several flawed prints, restoring lost reels, putting the restored work on 35mm. or transferring 35mm nitrate stock to safety stock. In the words of a representative of Hal Roach Studios, "That cost a lot of money. We would not be doing this if we did not feel that we could at least get our money back through colorizing the film. But besides that, we are taking a film that nobody really cared about, preserving it, giving it lasting value and making it available to the public in both black and white and color." This spokesperson went on to say that Hal Roach "has a tremendous film library." ⁴ Hal Roach Studios now asserts that it would be extremely difficult, and prohibitively expensive, to produce a "complete print of the version upon which the colorized version was based."⁵

On the other hand, film archivists assert that a black and white videotape will not serve any use for archival purposes. Moreover it would be much more expensive for the Library of Congress to take a black and white videotape and transfer it to a print that would be viable for archival purposes than it would be for the colorizer to prepare a print for deposit. Ultimately the deposit of the black and white videotape would satisfy only one of the purposes the Copyright Office foresaw in proposing the new rule—the examination purpose. Moreover, such a deposit would do nothing to assure for posterity that the black and white prints will be preserved.

On balance, the Copyright Office has decided to adopt the proposed amendment modified by a reference to special relief. Upon a showing in a particular case that the registrant does not own an archival quality print or that it would be prohibitively expensive to prepare a new archival quality print where none is otherwise available, the Copyright Office will consider deposit under special relief. The claimant must in such cases make a good faith effort to deposit the best available, near-archival quality print. Special relief to deposit a black and white videotape will be granted only where a celluloid print is demonstrably unavailable. Given the previously noted representations of the colorizers regarding their acquisition or

⁴ 1987 Senate Hearing, Statement of Rob Word.

⁵ RM 86-1B, Comment 6.

development of archival-like quality black and white prints, we would expect that ordinarily special relief is unnecessary.

4. Related Issues

(a) *Availability of the Motion Picture Agreement.* One comment requests clarification of whether a form of the Motion Picture Agreement will be available for black and white deposits. The Motion Picture Agreement does not apply to these deposits. The Agreement was developed to encourage timely registration of a motion picture without requiring the registrant to keep a print out of circulation at the very time that the motion picture was being exhibited for the first time. Such a consideration does not exist here where the registrant is planning primarily to exhibit the colorized videotape version.

Moreover, the Library intends to select all black and white prints received under this regulation. If the Motion Picture Agreement were available, this would lead to unnecessary back and forth transportation of prints between the Library and the depositor.

The Motion Picture Agreement is currently available in the case of the colorized videotape version.

(b) *Applicability of "best edition".* One comment requests confirmation that the Best Edition Statement of the Library of Congress is inapplicable. The Library would prefer deposit of the black and white print in the order of preference listed in the Best Edition Statement. We recognize, however, that older works may not be available in certain gauges, and would request that the registrants make a good faith effort to deposit the best available film print, in particular a print that is clear, undamaged, undeteriorated, and free of splices. We understood that restoring or cleaning the black and white print before colorization involves preparation of an excellent quality print. If

preservation of the black and white print is one of the benefits of colorization, the Library would expect that a "complete" black and white print will be deposited to achieve that benefit for posterity. Special relief is available, of course, if the requirement cannot be satisfied in a particular case, for example, where a black and white kinescope copy is colorized.

With respect to the Regulatory Flexibility Act, the Copyright Office takes the position that this Act does not apply to Copyright Office rulemaking. The Copyright Office is a department of the Library of Congress and is a part of the legislative branch. Neither the Library of Congress nor the Copyright Office is an "agency" within the meaning of the Administrative Procedure Act of June 11, 1946, as amended (title 5 Chapter 5 of the U.S. Code, Subchapter II and Chapter 7). The Regulatory Flexibility Act consequently does not apply to the Copyright Office since that Act affects only those entities of the Federal Government that are agencies as defined in the Administrative Procedure Act.⁶

⁶ The Copyright Office was not subject to the Administrative Procedure Act before 1976, and it is now subject to it only in areas specified by section 701(d) of the Copyright Act (i.e., "all actions taken by the Register of Copyrights under this title [17]," except with respect to the making of copies of copyright deposits). [17 U.S.C. 706(a)]. The Copyright Act does not make the Office an "agency" as defined in the Administrative Procedure Act. For example, personnel actions taken by the Office are not subject to APA-FOIA requirements.

List of Subjects in 37 CFR Part 202

Claims, Claims to copyright, Copyright registration.

Final Regulation

In consideration of the foregoing, the Copyright Office is amending Part 202 of 37 CFR, Chapter II.

1. The authority citation for Part 202 continues to read as follows:

Authority: Copyright Act, Pub. L. 94-553, 90 Stat. 2541 [17 U.S.C. 702].

2. Section 202.20(c)(2)(ii) is amended by adding the following sentence at the end thereof:

§ 202.20 Deposit of copies and phonorecords for copyright registration.

(c) * * *

(2) * * *

(ii) *Motion pictures.* * * * In the case of colorized versions of motion pictures made from pre-existing black and white motion pictures, in addition to the deposit of one complete copy of the colorized motion picture and the separate description of its contents as specified above, the deposit shall consist of one complete print of the black and white version of the motion picture from which the colorized version was prepared. If special relief from this requirement is requested and granted, the claimant shall make a good faith effort to deposit the best available, near-archival quality black and white print, as a condition of any grant of special relief.

Dated: July 28, 1988.

Ralph Orman,
Register of Copyrights.

Approved by:
James H. Billington,
The Librarian of Congress.

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