

**COPYRIGHTS IN THE CREATIVE ARTS:  
Fundamentals, Selected Differences and Trends**

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**I. THE FUNDAMENTALS, 17 U.S.C. § 101, *et seq.***

**A. Copyrightability.**

1. Original Works of Authorship:

- a. *Literary works*: “works other than audiovisual works expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material objects, such as books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards, in which they are embodied;”
- b. *Musical Works*, including any accompanying words (not defined);
- c. *Dramatic works*, including any accompanying music (not defined);
- d. *Pantomimes and choreographic works* (not defined);
- e. *Pictorial, graphic and sculptural works*: “two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawings, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article, as defined in this section, shall be considered a pictorial, graphic, or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article;”

f. *Motion pictures and other audiovisual works*: “Motion pictures” are “audiovisual works consisting of a series of related images which, when shown in succession, impart an impression of motion together with accompanying sounds, if any.” “Audiovisual works” are “works that consist of a series of related images which are intrinsically intended to be shown by the use of machines or devices such as projectors, viewers, or electronic equipment, together with accompanying sounds, if any, regardless of the nature of the material objects, such as film or tapes, in which the works are embodied.

g. *Sound recordings*: “works that result from the fixation of a series of musical, spoken, or other sounds, but not including the sounds accompanying a motion picture or other audiovisual work, regardless of the nature of the material objects, such as disks, tapes, or other phonorecords, in which they are embodied;” and

h. *Architectural work*: “the design of a building as embodied in any tangible medium of expression, including a building, architectural plans, or drawings. The work includes the overall form as well as the arrangement and composition of spaces and elements in the design, but does not include individual standard features.”

*Note: Factual and functional works get distinct analyses.*

2. Requirements: fixed in any tangible medium of expression. 17 U.S.C. § 102(a).
3. Standard of Originality: work must originate with author; generally no requirement of novelty or uniqueness.
4. Titles, phrases and forms not subject to protection.
5. Idea/expression dichotomy. 17 U.S.C. § 102(b).
  - a. Copyright does not protect ideas;
  - b. Copyright protects only the expression of idea.
6. Utilitarian Works are not protected.
  - a. Separate physically or conceptually “aesthetic expression from utilitarian function.” 17 U.S.C. § 101 (definition of “pictorial, graphic and sculptural works”).

b. Facts are distinguished from expression of facts.

7. Publication is no longer key; copyright is secured automatically upon creation, with additional rights through registration. Publication remains important with respect to national origin of work (17 U.S.C. § 104); notice of copyright (17 U.S.C. § 401, *et seq.*); limitations of

Sections 107 through 118; application and deposit requirements (17 U.S.C. §§ 408, 409); year of publication may effect duration (17 U.S.C. § 303).

Copyright protection is available for unpublished work never intended to see the light of day. *Chicago Bd. of Education v. Substance, Inc.*, 354 F.3d 624 (7<sup>th</sup> Cir. 2003).

**B. Exclusive Rights.** 17 U.S.C. § 106:

1. To reproduce the copyrighted work in copies or phonorecords;
2. To prepare derivative works based on the copyrighted work;
3. To distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease or lending (Right of first publication is implicit);
4. To perform the copyrighted work publicly (in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works);
5. To display the copyrighted work publicly (in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including individual images of a motion picture or other audiovisual work); and
6. To perform the work publicly by means of a digital audio transmission (in the case of sound recordings); (Since 1995).

*Note: Right of first publication is implicit.*

*Note: Not all rights apply to all works.*

**C. Authors' "Moral" Rights for "works of visual art" in a "painting, drawing, print, or sculpture" only.** 17 U.S.C. § 106A.

- 1 Attribution; and
- 2 Integrity.

Analogous theories such as unfair competition, invasion of privacy, defamation, breach of contract, state law (RCW 18.100.030(2), and ordinary copyright infringement may apply. *See, e.g.*, 17 U.S.C. § 106 (derivative works), 17 U.S.C. § 115(a)(2) (distortion of musical works under compulsory license); *Gilliam v. American Broadcasting Co.* 538 F.2d 14 (2d Cir. 1976) (mutilation of Monty Python work).

**D. Limitations and Exceptions.** 17 U.S.C. §§ 107-122.

1. Fair Use. 17 U.S.C. § 107.
  - a. Factors:
    - i. Purpose and character of use;
    - ii. Nature of copyrighted work;
    - iii. Amount and substantiality of portion used; and
    - iv. Effect on potential market or value.
  - b. Parody and Satire
2. Other Provisions:
  - a. Compulsory Licenses:
    - i. Cable retransmissions. 17 U.S.C. § 111.
    - ii. Satellite carrier retransmissions. 17 U.S.C. § 119.
    - iii. Mechanical rights. 17 U.S.C. § 115.
    - iv. Public broadcasting. 17 U.S.C. § 118.
    - v. Jukeboxes. 17 U.S.C. § 116.
  - b. Exemptions:
    - i. First sale doctrine. 17 U.S.C. § 109: the owner of a particular lawfully-made copy is entitled to sell or otherwise dispose of that copy. Exception: Record Rental Amendment of 1984: the ownership of a particular phonorecord may not rent it without permission of the copyright holder.
    - ii. Certain public performances. 17 U.S.C. § 110.

**E. Ownership and Transfer.**

1. Copyright vests initially in author. 17 U.S.C. § 201(a).
  - a. Joint Authorship. 17 U.S.C. § 101 (joint work definition):
    - i. Two or more authors;
    - ii. Intent that contributions be merged into unitary whole.
  - b. Joint Ownership:
    - i. Undivided share;
    - ii. Tenancy in common;
    - iii. Freedom to license unilaterally, subject to duty to account.
  - c. Works made for hire. 17 U.S.C. § 101 (definition of “work made for hire”):
    - i. Work prepared by employee within scope of employment (common law definition applies). *CCNV v. Reid*, 490 U.S. 730 (1989); or
    - ii. Work specially ordered or commissioned:
      - a. Work falls into one of 9 specific categories;
      - b. Necessity for written agreement expressly designating as work for hire.
2. Ownership of copyright distinct from material object in which embodied. 17 U.S.C. § 202.
3. Transfers of copyright:
  - a. Normally by contract.
  - b. In the case of exclusive rights, not valid unless in writing. 17 U.S.C. § 204(a).

- c. The validity and effect of a transfer of copyright is governed by the law in effect at the time of the transfer. Ownership of a copyright in a work created under a particular act will be determined by the act in effect when the work was created.
4. Right of Termination. 17 U.S.C. §§ 203, 304. Opportunity to undo a transfer 35 years later if:
- a. Give notice of termination between 2 and 10 years before effective date of termination;
  - b. Effective date must be within 5 years after the end of the 35<sup>th</sup> year of the deal.
  - c. Result: 40 years from grant or 35 years after publication.
  - d. Who can terminate: living author, surviving spouse, surviving children or grandchildren or, if none of these is alive, the author's estate.
  - e. For pre-1978 copyrights, a second chance at termination if:
    - i. Right to recapture initially came up before October 27, 1998; and
    - ii. Did not send notice.
    - iii. At any time within 5 years of expiration of the first 75 years of the copyright, can give notice and get back the last 20 years of the copyright as added by the Sonny Bono Copyright Extension Act.
  - f. To protect authors, assignment of termination rights not valid until author receives back rights.
  - g. Exception: after author has given notice of termination, but before author gets rights back, can deal with the party who has the rights.
    - i. Despite termination, original publisher can continue to exploit derivative works. *Mills Music v. Snyder*, 469 U.S. 153, *reh'g denied* 470 U.S. 1065 (1985).
    - ii. Reissues of master recordings are not derivative works within the meaning of *Mills Music*. *Fred*

*Alpert Music Corp. v. Warner/Chappell Music*, 155 F.3d 17 (2d Cir. 1988).

5. Sub-Licensing Rule. Copyright licensee may not sub-license his licensed intellectual property rights without express permission from the licensor. *See, e.g., Gardner v. Nike, Inc.* 279 F.3d 774 (9<sup>th</sup> Cir. 2002). Rule extended to trademarks and rights of publicity. *Miller v. Glen Miller Productions, Inc.*, 454 F.3d 975 (9<sup>th</sup> Cir. 2006).

**F. Notice.**

1. Not required for works published after March 1, 1989; still required for works published prior to that date.
2. Can negate claim of innocent infringement in mitigation for damages. 17 U.S.C. § 401(d).
3. Elements: “Copyright,” “Copr.” or © or the letter “P” in a circle; name of copyright owner, year of publication. 17 U.S.C. §§ 401(b), 402(b).
4. Placement where reasonable. 17 U.S.C. §§ 401(c), 402(c).
5. Savings in case of omission. 17 U.S.C. § 405.

**G. Registration.** 17 U.S.C. §§ 408-410.

Courts repeatedly excuse a wide range of errors in registrations including misidentification of claimant, misclassification of a work, misstatement of work’s author, misstatement of creation and publication dates and misstatement that a work is made for hire, but not always. *See, e.g., Action Tapes, Inc. v. Mattson*, 462 F.3d 1010 (8<sup>th</sup> Cir. 2006) (visual arts registration for graphic embroidery design will not suffice for computer program-embedded disk—the memory cards that enable computer-run sewing machines).

1. Fee has increased; \$45 is new basic registration fee.
2. Prerequisite to suit for works of United States origin. 17 U.S.C. §§ 408(a), 411. Courts differ over whether it is enough to have applied or registration or whether registration certificate must be in hand or registration refused. The Fifth Circuit has taken the position that registration occurs when the applicant’s materials are deposited with the Copyright Office. The Second, Eleventh and Tenth Circuits require that the plaintiff have a certificate in hand. *See La Resolana Architects, PA v. Clay Realtors Angel Fire*, 416 F.3d 1195 (10<sup>th</sup> Cir. 2005). *See also Just Water Heaters Inc. v. Affordable Water Heaters and Plumbing, Inc.*, No. C 05 4996 SC, 2006 WL 449136 (N.D. Cal. Feb. 23, 2006).

3. Prerequisite to statutory damages and attorneys' fees. 17 U.S.C. § 412.

4. Certificate as prima facie evidence. 17 U.S.C. § 410(c).

**H. Recordation of transfers.** 17 U.S.C. § 204.

1. Necessary to perfect security interest in copyright.

2. Not a jurisdictional prerequisite.

3. Constitutes constructive notice of facts stated in the recorded document.

**I. Duration:**

1. Preemption. Copyright preempts "all legal" or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright on and after January 1, 1978.

2. Natural author:

a. For works created on or after January 1, 1978, life of author plus 70 years. 17 U.S.C. § 302(a).

b. For joint works, life of last to survive plus 70 years. 17 U.S.C. § 302(b).

3. Anonymous and pseudonymous works or works made for hire: 95 years from publication or 120 years from creation, whichever first expires. 17 U.S.C. § 302(c).

4. Sonny Bono Copyright Term Extension Act, Pub. L. No. 105-298, 112 Stat. 2827 (1998), is constitutional. *Eldred v. Ashcroft*, 37 U.S. 186 (2003). Ninth Circuit agrees. *Kahle v. Gonzales*, No. 04-17434 (9<sup>th</sup> Cir. Filed Jan. 22, 2007).

5. "Old Works."

a. Copyrights in their first term on January 1, 1978: 28 years plus renewal term of 67 years. 17 U.S.C. § 304(a).

b. Copyrights in their renewal term at the time of the effective date of the Sonny Bono Copyright Term Extension Act: 95 years from the date originally secured. 17 U.S.C. § 304(4)(b).



6. Terms run from December 31 of anniversary year.  
17 U.S.C. § 305.

7. Renewal Rights. The renewal copyright of a work is the 67 year period that begins once the original copyright term of 28 years expires.  
17 U.S.C. § 304(a)(1)(A). Since 1992, renewal has been automatic.

**J. Infringement:** violation of any of the owner's exclusive rights.  
17 U.S.C. § 501.

1. Elements: "(1) ownership of a valid copyright; and (2) copying of constituent elements of the work that are original." *Feist Publication, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991).

2. Absent proof of direct copying, proof of copying involves fact-based showing of "access" and "substantial similarity." *E.g., Funky Films, Inc. v. Time Warner Entertainment Co.*, 462 F.2d 1072 (9<sup>th</sup> Cir. 2006) (popular TV show "Six Feet Under" did not infringe "The Funk Parlor").

3. Degrees of similarity to support copying:

- a. Identical;
- b. Striking; and
- c. Structural.

4. Improper appropriation requires:

- a. Appropriation of identifiable protected expression; and
- b. Substantial similarity between plaintiffs's protected expression and defendant's work as perceived by laymen ("audience reaction").

5. 4(a) established through extrinsic and/or objective tests sometimes with expert testimony.

6. 4(b) established through intrinsic and/or subjective tests based upon "total concept and feel" for which expert testimony is generally not allowed.

7. Plaintiff who cannot satisfy extrinsic test is vulnerable to summary judgment.

8. Three (3) Year Statute of Limitations. 17 U.S.C. § 507(b).

- a. A claim for infringement can accrue more than once because each infringement is a distinct harm. *Bridgeport Music, Inc. v. Rhyme Syndicate Music*, 376 F.3d 615 (6<sup>th</sup> Cir. 2004).
  - b. A claim for ownership accrues only once and is barred if not brought within 3 years. *Zuill v. Shanahan*, 80 F.3d 1366 (9<sup>th</sup> Cir. 1996).
  - c. When claims for both infringement and ownership are alleged, the infringement claim is timely only if the corresponding ownership claim is also timely. *Ritchie [Kid Rock] v. Williams*, 395 F.3d 283, 288 n.5 (6<sup>th</sup> Cir. 2005)
9. Laches. If a plaintiff files within the applicable limitation period, there is a strong presumption that laches does not bar the claim. Conversely, if the alleged wrongful conduct is outside the limitations period, courts presume that plaintiffs' claims are barred by laches. *Jarrow Formulas, Inc. v. Nutrition Now, Inc.*, 304 F.3d 829, 840 (9<sup>th</sup> Cir. 2002), *cert. denied*, 537 U.S. 1047 (2002).
10. No state immunity for infringement. 17 U.S.C. § 511(a).
11. Limitations on liability relating to online material. 17 U.S.C. § 512.
12. Reasonable license fees for individual proprietors from performing rights societies. 17 U.S.C. § 513.

**K. Remedies.**

1. Damages (to be elected before final judgment is entered). 17 U.S.C. § 504.
- a. Actual Damages and Profits. 17 U.S.C. § 504(b)
  - b. Statutory damages. 17 U.S.C. § 504(c):
    - i. Amount in discretion of court.
    - ii. Normal range: \$750 to \$30,000.
    - iii. Minimum for “innocent” infringement \$200.
    - iv. Maximum for willful infringement \$150,000.
2. Injunctive Relief. 17 U.S.C. § 502.

3. Costs and attorneys' fees in discretion of court. 17 U.S.C. § 505.
4. Seizure and forfeiture. 17 U.S.C. § 509.
5. Criminal penalties for intentional infringement. 17 U.S.C. § 506.

## SELECTED WORKS OF AUTHORSHIP AND RECENT CASES

### II. VISUAL WORKS.

#### A. Pictorial, graphic and sculptural works. 17 U.S.C. § 101.

Includes two-dimensional and three-dimensional works; fine, graphic and applied art; photographs; prints and art reproductions; maps, globes, charts, diagrams, models and technical drawings, including architectural plans.

1. Originality
  - a. Does not carry any implied criterion of artistic taste, aesthetic value or intrinsic quality. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903).
  - b. Originality focuses on the author's contribution to a work. Almost any nontrivial variation upon an otherwise unoriginal work will meet this requirement. *See Collezione Europa USA, Inc. v. Hillsdale House, Ltd.*, 243 F. Supp.2d 444 (M.D.N.C. 2003) (only quantum of originality required).
2. The right of public performance does not apply. 17 U.S.C. § 106.
3. A "modicum" of creativity (not necessarily meritorious creativity) is required.
  - a. "In order to be acceptable as a pictorial, graphic or sculptural work, the work must embody some creative authorship in its delineation or form." Creativity requires some spark of artistic expression. 37 C.F.R. § 202.10(a).
  - b. Some works have failed to meet even this minimal criterion. *E.g.*, *Bailie v. Fisher*, 258 F.2d 425, 426 (D.C. Cir 1958) (cardboard star with folded flaps); *Gardenia Flowers, Inc. v. Joseph Markovits, Inc.*, 280 F. Supp. 776, 781 (S.D.N.Y. 1968) (plastic flower corsage).

4. Utilitarian or mechanical aspects of visual works are not protected. 17 U.S.C. § 101. *E.g.*, *Bonazoli v. R.S.V.P. Intern, Inc.*, 353 F. Supp.2d 218 (D.R.I. 2005) (heart-shaped measuring spoons inseparable from utilitarian function and not copyrightable); *Stanislawski v. Jordan*, 337 F. Supp.2d 1103 (E.D. Wis. 2004) (protection for wooden frames limited to aspects of designs that existed apart from utilitarian value).

a. A useful article will be denied copyright protection except to the extent its artistic features can be separately identified and can exist separately. House Report at 54.

b. Whether a work is a useful article is a question of fact. *Poe v. Missing Persons*, 745 F.2d 1238, 1242 (9<sup>th</sup> Cir. 1984). *Boyd's Collection, Ltd. v. Bearington Collection, Inc.*, 365 F. Supp. 2d 612 (M.D. Pa. 2005).

5. Characters are subject to copyright protection as pictorial works. *Garman v. McFarlane*, 360 F.3d 644 (2004). Visual expressions of characters are easier to protect than literary characters. *Id.*

6. Infringement. Copying is a less frequent issue than for literary or musical works.

a. Sometimes the two subtests of protected expression and audience reaction merge into emphasis on impression or total concept and feel.

b. Side by side comparison is generally possible

c. Unprotectible ideas tend to include color, perspective and geometric shape.

7. Registration: Form VA; deposit requirements vary by type of work; group registrations of unpublished and published works possible to reduce costs. 37 C.F.R. § 202.3(b)(3)(A) and (B).

Will registration in one category protect another? *See, e.g.*, *Kay Berry, Inc. v. Taylor Gifts, Inc.*, 421 F.3d 199 (3d Cir. 2005) (registration of catalogue featuring sculptures covered sculpture). *Action Tapes, Inc. v. Mattson*, 462 F.3d 1010 (8<sup>th</sup> Cir. 2006) (visual arts registration would not suffice for computer program embedded in disk).

## **B. Selected Categories of Visual Expression.**

1. Works of art are generally copyrightable.

a. “Art” includes traditional fine arts of painting, drawing and sculpture as well as applied art.

b. “A thing is a work of art if it appears to be within the historical and ordinary conception of the term art.” *Rosenthal v. Stein*, 205 F.2d 633, 635 (9<sup>th</sup> Cir. 1953).

c. With respect to two-dimensional art, the Ninth Circuit appears to focus on total concept and feel. Originality is easier to find in nonrepresentational art.

d. Three-dimensional works: virtually all three-dimensional forms of fine and popular art are copyrightable. Originality is easier to find in nonrepresentational art. *See, e.g., Satava v. Lowry*, 323 F.3d 805 (9<sup>th</sup> Cir. 2003) (artist’s jellyfish protectable to the extent that artist’s choices not governed by jellyfish physiology).

e. Protectable elements lie in the artist’s original and expressive use of shape, detail and color. *E.g., Kay Berry, Inc. v. Taylor Gifts, Inc.*, 421 F.3d 199 (3d Cir. 2005) (garden sculptures copyrightability derived from combination of texture, color, size and shape, as well as inscribed verse).

f. Most judicial decisions about three-dimensional works involve novelty items such as jewelry, dolls and figurines rather than fine art, and consequently, courts focus on individual elements, most of which are not protectable because of a lack of originality. *See, e.g., Todd v. Montana Sliversmiths, Inc.*, 379 F. Supp. 2d 1110 (D. Colo. 2005) (barbed wire bracelet and earring designs insufficiently original to warrant copyright protection because works contained no expression not necessarily concomitant of idea of barbed-wire jewelry).

g. The Visual Artists Rights Act of 1990 (“VARA”) gave moral rights of attribution and integrity to any “work of visual art” in a “painting, drawing, print, or sculpture.”

Special limitations on right to integrity in buildings and public art, *see* 17 U.S.C. § 113 (d), were recently in public art case: *Phillips v. Pembroke Real Estate, Inc.*, 459 F.3d 128 (1<sup>st</sup> Cir. 2006) (under the public presentation exception, developer was entitled to remove “site-specific,” “integrated art” (*i.e.*, two or more physical objects that must be presented together as the artist intended for the work to retain its meaning and integrity) of nationally recognized sculptor from Eastport Park in South Boston).

- h. Fair use issues have figured prominently in recent visual arts cases. *Compare Blanch v. Koons*, 467 F.3d 244 (2d Cir. 2006) (affirming summary judgment finding that adaptation and use of “Silk Sandals” Gucci fashion photograph from “Allure” magazine in “Niagra” painting constituted fair use) *with Rogers v. Koons*, 960 F.2d 301 (2d Cir.) *cert. denied* 506 U.S. 934 (1992) (three-dimensional reproduction of photograph in “String of Puppies” wood sculpture in artist’s “Banality” series infringed and did not constitute fair use).
2. Reproductions: A reproduction may be sufficiently “original” if more than a mere copy or reproduction of a work of art; need not be creative. However, the underlying work must qualify as creative and the reproduction must make an original contribution.
- a. “[T]here must be at least some substantial variation, not merely a trivial variation such as might occur in the translation to a different medium.” *Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 491 (2d Cir.), *cert. denied*, 429 U.S. 857 (1976) (plastic scale reproduction of cast iron “Uncle Sam” bank lacked originality). *See also Rogers v. Koons*. 1 NIMMER § 2.08[c] at 2-108 and cases cited.
- b. An *exact* copy of a work of art is not a reproduction for copyright purposes and is not subject to protection because it lacks sufficient originality to be protected.
- c. A reproduction that meets the originality requirement will be subject to protection even if the underlying work is in the public domain, *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99 (2d Cir. 1951), but only to the extent of the original contribution. House Report at 57.
- d. If the underlying work is not in the public domain and is incorporated without the copyright owner’s consent, the reproduction is not copyrightable. 17 U.S.C. § 103(a). *E.g.*, *Rogers v. Koons, supra*.
3. Photographic works are expressly included in the definition of “pictorial, graphic and sculptural works.” 17 U.S.C. § 101. Includes prints, negatives and slides. Film strips, slide sets and sets of transparencies “intended to be shown by the use of machines or devices such as projectors, viewers, or electronic equipment” are regarded as audiovisual works. 17 U.S.C. § 101.

- a. Minimal originality is necessary – may be supplied by selection of subject matter, equipment and technique. *Burrow-Giles*, 111 U.S. at 62; *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444 (S.D.N.Y. 2005) (photograph of young black man wearing white T-shirt and lots of jewelry sufficiently original because photographer used relatively unusual and distinctive lighting, posed subject against sky and orchestrated clothing and facial expression).
- b. Aspects of a photograph that flow from its idea are not protectable. *Bill Diodata Photography, LLC v. Kate Spade LLC*, 388 F. Supp. 382 (S.D.N.Y. 2005) (features of photograph of bathroom stall with legs and feet of female displaying shoes under clothes not protectable).
- c. For purposes of VARA, whether a still photograph is a “work of visual art” produced for exhibition purposes is determined not at the moment the shutter clicks, but when the work in question is produced. *Lilley v. Stout*, 384 F. Supp. 83 (D.D.C. 2005).
- d. Using photographs of others. *See Archives v. Dorling Kindersley Limited*, 448 F.3d 605 (2d Cir. 2006) (aff’g summary judgment finding that reproduction of Grateful Dead images from event posters and tickets in historical book *Grateful Dead: The Illustrated Trip* constituted fair use).
- e. Application of Section 201(c) – photographic works as part of collective works:
  - i. *New York Times Co., Inc. v. Tasini*, 533 U.S. 483 (2001) (publishers of periodicals and owners of electronic databases infringed when they reproduced and published individual articles online without author’s permission);
  - ii. *Faulkner v. National Geographic Soc’y*, 409 F.3d 26 (2d Cir. 2005) (National Geographic Society (“NGS”) CD-ROM collections of its magazines were privileged revisions of original collective works under Section 201(c));
  - iii. *Greenberg v. National Geographic Soc’y*, 244 F.3d 1267 (11th Cir.), *cert. denied*, 534 U.S. 951 (2001) (NGS CD-ROMs were not privileged under Section 201(c));

iv. *Jarvis v. K2*, No. 05-35609 (9<sup>th</sup> Cir.) may resolve questions: a) whether Section 201(c) supports exercise of rights after expiration of a license; b) whether presentation of a photograph online is a public display; and c) whether Section 201(c) offers a privilege of public display of images.

4. Maps.

Courts may have a tendency to require a higher standard of originality when dealing with maps that are highly factual. Geographic names, delineations of socio-political characteristics and arbitrary signs or compilations of these items are not subject to protection. *E.g.*, *Sparaco v. Lawler, Matusky, Skelly Engineers LLP*, 303 F.3d 460 (2d Cir. 2002). *cert. denied*, 583 U.S. 945 (portions of surveyors site plan setting forth physical characteristics of site not protected by copyright).

5. Architectural Plans and Structures.

Plans were historically protected under common law and under the 1976 Copyright Act which included express protection for technical drawings, diagrams and models. By subsequent amendments, protections for architectural plans and architectural works (with limitation) were made explicit (providing that visual works include “technical drawings, diagrams and models, *including architectural plans*”) (emphasis added).

a. Cases involving alleged infringement of architectural works are beginning to reach appellate courts. *E.g.*, *T-Peg, Inc. v. Vermont Tiber Works, Inc.*, 459 F.3d 97 (2006) (“This is the first occasion for us to address a copyright infringement suit under the Architectural Works Copyright Protection Act (“AWCPA”)) (rev’g district court’s summary judgment finding that no reasonable jury could conclude that the defendant copied the plaintiff’s work). *LGS Architects, Inc. v. Concordia Homes of Nevada*, 434 F.3d 1150 (9<sup>th</sup> Cir. 2006) (reversing district court’s refusal to grant preliminary injunction where plaintiff owned a valid copyright in architectural plans and defendant-licensee exceeded the scope of the license and therefore infringed). *E.g.*, *Trek Leasing Inc. v. U.S.*, 66 Fed. Cl. 8 (Fed. Cl. 2005) (protection in architectural work “thin” and protects only from nearly verbatim copying or showing of “substantial similarity”).

b. Delay in asserting rights particularly likely to give rise to laches. *See Chirco v. Crosswinds Communities, Inc.*, No. 05-1715 (6<sup>th</sup> Cir. Jan. 10, 2007) (remanding to the district court for clarification of its summary judgment finding that defendants were



prejudiced by plaintiffs unnecessary delay between time they learned that allegedly infringing construction of “12-plex” condominium building was planned and the time complaint was filed, even though the action was filed within applicable 3-year statute of limitations of 17 U.S.C. § 507(b)). With respect to monetary relief, Sixth Circuit gives effect to presumption that statute of limitations must prevail, but to the extent the relief sought is destruction of the infringing complex, laches is properly interposed.

c. Pictorial representations of public art/sculptural work deemed part of an architectural work are not infringing. *Leicester v. Warner Bros.*, 232 F.3d 1212 (9<sup>th</sup> Cir. 2000) (under 17 U.S.C. § 120, Warner Bros. did not infringe sculptor Zanja Madre’s sculptural work created in the courtyard space of the 801 Tower in downtown Los Angeles in including film of the work in *Batman Forever*).

#### 6. Fashion.

Copyright generally does not protect “clothing designs” because they are “useful articles.” *E.g., Jane Galiano and Gianna, Inc. v. Harrah’s Operating Co., Inc.*, 416 F.3d 411 (5<sup>th</sup> Cir. 2005). However, separable design elements in clothing, to the extent they may exist, may be eligible for copyright protection. *Chosun Int’l, Inc. v. Chrisha Creations, Ltd.*, 413 F.3d 324 (2d Cir. 2005) (Rule 12(b)(6) dismissal of infringement claim with respect to Halloween costumes).

*But note:* H.R. 5055 Section 1 Protection for Fashion Design, proposing to amend 17 U.S.C. § 1301 to protect “fashion designs” and articles of apparel, along with vessel hulls, but requiring that the designs be registered within 3 months of being made public, or protection lost.

### III. LITERARY WORKS.

#### A. Implications of “Original, Fixed Expression” for Literary Works.

1. Facts are not copyrightable; only their expression is. Facts do not originate with authors and are not protected by copyright. *Feist Publication, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, \_\_\_ (1991) (nothing remotely creative about arranging names alphabetically in a white pages directory).

a. “Copyright treats facts and factual compilations in a wholly consistent manner. Facts, whether alone or as a part of a compilation, are not original and therefore may not be copyrighted. A factual compilation [a collection arrangement or assemblage of

facts] is eligible for copyright if it features an original selection or arrangement of facts, but the copyright is limited to the particular selection or arrangement. In no event may copyright extend to the facts themselves.”

b. Fact-based works such as histories, biographies, directories and catalogues are protected by copyright. But the protection extends only to the original expression and not the underlying facts. Thus, President Ford’s decision-making process is something anyone can write about, but how he chose to express that process in his memoirs was subject to protection. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 544 (1985) (unauthorized publication constituted an infringement).

## 2. Idea/expression continuum.

Ideas are not protected; only the particular expression of them is. *Sid & Marty Krofft Television Productions, Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1163 (9<sup>th</sup> Cir. 1977). Courts have developed the notion of a continuum, with ideas at one end and concrete language or dialogue at the other.

a. Plot, theme and character are all forms of ideas, and generally not protected, apart from their concrete expression. *Reyher v. Children’s Television Workshop*, 533 F.2d 87 (2d Cir.), *cert. denied*, 429 U.S. 980 (1976); *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930), *cert. denied*, 282 U.S. 902 (1931) (involving the play “Abie’s Irish Rose”).

b. “Scenes à faire” Doctrine:

i. “Scenes à faire” or “scenes for action” is a theatrical term meaning the climactic scene in a play or opera.

ii. As used in copyright law, the doctrine is that “a copyright owner can’t prove infringement by pointing to features of his work that are found in the defendant’s work as well but that are so rudimentary, commonplace, standard, or unavoidable that they do not serve to distinguish one work within a class of works from another.” *Bucklew v. Hawkins, Ash, Baptie & Co.*, 329 F.3d 923, 929 (7<sup>th</sup> Cir. 2003). The doctrine prevents the liability net from being cast too wide. *Id.*

iii. Implications for characters.

- Stock characters (e.g., a drunken bum, a fire-breathing dragon, a masked magician) are not copyrightable under this doctrine. *Rice v. Fox Broadcasting Co.*, 330 F.3d 1170, 1175-76 (9<sup>th</sup> Cir. 2003).
- An unexpectedly knowledgeable old wino with a specific name (“Cogliostro”), phony title (“Count”) with a specific age and appearance (faintly mosaic facial features) combine to create a distinctive character protected by copyright. *Gaiman and Marvels and Miracles, LLC v McFarlane*, 360 F.3d 644 (7<sup>th</sup> Cir. 2004) (aff’g protection given comic book characters).
- It is probably easier to protect a graphic character than a literary character: “The description of a character in prose leaves much to the imagination, even when the description is detailed.” *Id.*

c. Spare retelling of historical events will not be protected.

3. Fixation: Writing, computer file, video tape, audio cassette or other tangible medium will do. Speech is not protected, unless recorded.
4. Registration is on Form TX.

**B. Titles Are [Still] Not Subject to Copyright Protection.**

*Planesi v. Peters, Register of Copyrights*, 26 S. Ct. 1182 (Mem.) (2006), *aff’g* 2005 WL 1939885 (9<sup>th</sup> Cir. Aug. 15, 2005) (One-word name of Planesi’s board game, KINGMASTER, a chess variant, is not entitled to copyright protection).

**C. Fair Use.**

1. Transformative use is important. *Bell Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605 (2d Cir. 2006) (use of Grateful Dead concert posters in geographical coffee table was fair use because a form of historic scholarship, a transformative purpose “plainly different from the original purpose for which they [the posters] were created).
2. Sometimes it is necessary to copy an entire image to make “fair use” in a literary work. *Nunez v. Caribbean Int’l News Corp.*, 235 F. 3d 18, 24 (1<sup>st</sup> Cir. 2000).

#### **D. Infringement.**

“The essence of infringement lies in taking not a general theme but its particular expression through similarities of treatment, details, scenes, events and characterization.” *Reyher*, 533 F.2d at 91. The more detailed a plot or character description is, the closer it lies to the expression end of the continuum and the more likely it is to be protected under copyright law. Similarity of ideas will help support a finding of infringement if there also is similarity of expression. *Krofft, supra*, 562 F.2d at 1164.

- a. In infringement context, copyright will protect the particular arrangement of words, literal copying or paraphrasing drawn from literal arrangement of protected work.
- b. Writers will be required to show similarities in stylistic nuance, copying of elaborated plot and characters beyond stock features.

#### **E. First Sale Doctrine as Applied to Audio Books.**

The record rental exception to copyright’s first sale doctrine, 17 U.S.C. § 109(b) applies only to sound recordings of musical works, and not sound recordings of literary works (“audio books” or “books on tape”). *Brilliance Audio, Inc. v. Hights Cross Communications, Inc.* No. 05-1209 (6<sup>th</sup> Cir. filed Jan. 26, 2007).

#### **F. Most of the Literary News is Digital.**

1. The Google Book Search Project. Two facets:
  - a. Partner Program: a publisher controlling the rights in a book can authorize Google to scan the full text of the book into Google’s search database. In response to a query, the user receives bibliographic material and a link to relevant text. Links would enable purchase. No copyright issues; conducted under agreement between Google and copyright holder.
  - b. Library project. Google plans to scan into its search database materials from the libraries of Harvard, Stanford and Oxford, University of Michigan and the New York Public Library. Each library is to receive digital copy of the books in its collections scanned by Google; probably agrees to use its copies only for purposes permitted under the Copyright Act. In response to search queries, users will be able to browse full text of public domain materials, but only a few sentences around the search term in

books still covered by copyright. Authors and copyright owners can opt out. Google claims fair use.

2. Digitization by other search engines: Yahoo and Microsoft also have announced digitization projects – only public domain or opt-in works. *Kahle, supra*, involved an attempt to digitize orphan works.
3. In February 2007, Random House and HarperCollins announced that they would let customers browse books on-line. Amazon.com Inc. has allowed customers to browse since 2003 and Google has done so since 2005.

#### **IV. MUSICAL WORKS.**

##### **A. Two Types of “Works of [Music] Authorship” or Music Copyrights:**

1. Musical Works, including any accompanying words, 17 U.S.C. § 102(a)(2), or so-called “composition copyrights;” and
2. Sound Recordings, 17 U.S.C. § 102(a)(7).

##### **B. Compositions.**

1. Neither “musical works,” nor “composition” copyrights, nor “accompanying words” are defined in the 1976 Copyright Act.
2. Words and music can be separately protected or if music and accompanying words are an integrated whole, then the combination is also protected. The combination can be protectible even if the individual elements are not.
3. Public display right not applicable.
4. Idea/expression dichotomy as applied to music:
  - a. Melody – protectible;
  - b. Harmony – rarely protectible;
  - c. Rhythm – rarely protectible.

Rhythm and harmony are generally thought of as unprotectible ideas.

5. Exceptions:
  - a. Nondramatic musical compositions are subject to

compulsory mechanical license upon specified conditions.  
17 U.S.C. § 115.

- i. Notice;
- ii. Recorded nondramatic musical work;
- iii. Released to the public (no first use);
- iv. Statutory royalty rates (\$.091 for 5 minutes or less; \$1.75 for each additional minute or fraction thereof.
- v. audio only.
- vi. Does not apply to sampling.
- vii. Does not apply to synchronization license or movie rights.

b. The mechanical compulsory license encompasses “digital phonorecord delivery,” 17 U.S.C. § 115(c). This includes downloading of records over the Internet, telephone lines, satellites. Ringtones are subject to compulsory license. *In re Mechanical and Digital Phonorecord Delivery Rate Adjustment Proceeding*, No. RF 2006-1, October 16, 2006.

6. Registration on Form PA.

7. Infringement:

a. Courts uniformly reject quantitative assessment; there is no “six note” or “six bar rule” or other limitation of a safe amount of melody to mimic or copy.

b. Courts take a qualitative approach; may deny protection to music if too close to other well-known phrases or would unreasonably limit other musicians’ ability to compose. Approach takes into account the limits of musical vocabulary.

8. Licensing of Performance Rights: There are collecting societies for performance rights: the American Society of Composers, Authors & Publishers (“ASCAP”) and Broadcast Music Inc. (“BMI”). They collect royalties for exploitation of nondramatic performance rights to virtually all domestic copyrighted music for authors who meet their criteria (“small

performance rights”). The collecting societies license performance rights only, not reproduction rights.

9. **Reproduction Rights:** Multimedia production companies and motion picture producers may require as many as 3 reproduction licenses from owner of a composition:

- (1) synchronization right (whenever music is synchronized with moving images; *e.g.*, commercial);
- (2) rights to make copies for distribution or sale; and
- (3) mechanical right -- right to manufacture and distribute records (*e.g.*, to release a soundtrack in album form).

### **C. Sound Recordings**

1. **Definition:** “works that result from a series of musical, spoken or other sounds, but not including the sounds accompanying a motion picture or other audiovisual work, regardless of the nature of the material objects, such as disks, tapes, or other phonorecords, in which they are embodied.”

2. Sound recordings constitute copyrightable subject matter.  
17 U.S.C. § 102(a)(7).

a. Protection is limited to sound recordings fixed on or after February 15, 1972. (Congress resisted efforts to extend copyright protection to recorded performances for a long time, and limited the rights it did grant.)

b. Copyright protection in a sound recording does not extend to imitations of sound recordings. *See* 17 U.S.C. § 114. “The reproduction right does not extend to the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording,” House Report at 106 (such a duplication might infringe the right of publicity, however), but does encompass piracy.

c. Reproduction of sound recordings included in educational television and radio programs distributed through public broadcasting entities are exempt from liability for infringement.  
17 U.S.C. § 114(d)(1).

3. Sound recordings are distinct from underlying works whose performances they embody (*e.g.*, poem or song).

- a. A recorded performance may contain (1) a separately copyrighted musical composition; and (2) a sound recording of the musical composition.
  - b. To make a sound recording, the performer of a copyrighted work will need a license from the proprietor of the composition. *E.g., Palladium Music, Inc. v. EatSleepMusic, Inc.*, 398 F.2d 1193 (10<sup>th</sup> Cir. 2005) (karaoke music sound recordings were derivative of underlying musical compositions and were not entitled to copyright protection absent licenses from owners of the underlying compositions).
4. There is no exclusive right to publicly perform sound recordings, *see* 17 U.S.C. § 106(4), except by means of a digital audio transmission. 17 U.S.C. § 106(6). Thus, artists do not receive royalties for radio performances. However, composers and publishers do.
5. Owners of recordings are required to allow performance on digital radio (including on Internet broadcast or webcasting) under compulsory license. 17 U.S.C. § 114. The transmission cannot be interactive or publish titles in advance (to avoid copying by users).
6. Under the Digital Millenium Copyright Act (“DMCA”), performance of a sound recording by means of a digital audio transmission is exempt from public performance royalties only if:
  - a. Nonsubscription broadcast transmission;
  - b. Conducted by an FCC-licensed broadcaster.
7. Record rental exception to copyright’s first sale doctrine. 17 U.S.C. § 109(b).
  - a. *I.e.*, may not rent CD’s, cassettes and records of sound recordings.
  - b. Exception applies only to sound recordings of musical works, and not sound recordings of literary works (“audio books” or “books on tape”). *Brilliance Audio, Inc. v. Hights Cross Communications, Inc.* No. 05-1209 (6<sup>th</sup> Cir. filed Jan. 26, 2007).
8. Copyright preemption “as applied to the facts.” *See Laws v. Sony Music Entertainment, Inc.*, 448 F.3d 1134 (9<sup>th</sup> Cir. 2006) (claims of misappropriation of common law right to privacy and California statutory right of publicity preempted by the Copyright Act, not as a matter of law,



but as applied to the particular facts, because subject matter of a right of publicity in one's voice is not different from a copyright claim when the voice is embodied within a copyrighted sound recording).

a. Sony obtained a license to sample Debra Law's recording of "Very Special," in the song "All I Have" by Jennifer Lopez and L.L. Cool J, but did not seek permission from Laws.

b. *Midler v. Ford Motor Co*, 849 F.2d 460 (9<sup>th</sup> Cir. 1988) and *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9<sup>th</sup> Cir. 1992), distinguished as cases in which the licensing party obtained only a license to the song and then imitated the artist's voice, rather than obtaining a license to use the artist's recording itself.

9. Registration is on Form SR. Registration on this form will cover both composition and particular recording.

10. Statutory Damages. Plaintiff can elect one statutory damage award for each work infringed; for purposes of calculating statutory damages, all parts of a derivative work or compilation constitute one work. 17 U.S.C. § 504(c)(1).

a. Section 504(c)(1) refers to copyrighted works, not infringing works. *Warner Brothers Music Corp. v. RTV Commun. Group, Inc.*, 445 F.3d 538 (2d Cir. 2006) (where defendant produced 7 music CD's that infringed plaintiff's copyrights in 13 different songs, defendants were liable for 13 statutory damage awards, not 7 for 7 infringing compilations).

b. Statutory damages not dischargeable in bankruptcy if plaintiff follows right steps. *In re Albarran*, No. SC-05-1398-MaSPa (9<sup>th</sup> Cir. July 24, 2006) (award of statutory damages for copyright infringement can constitute a debt for "injury" to property under Section 523(a) of the Bankruptcy Code, even without evidence of actual damages, and a nondischargeable debt for willful and malicious injury under Section 523(a)(6) of the Bankruptcy Code).

11. Renewal Rights. The renewal copyright of a work is the 67 year period that begins once the original copyright term of 28 years expires. *Roger Miller Music, Inc. v. Sony/ATV Publishing LLC*, No. 05-6824 (6<sup>th</sup> Cir. February 13, 2007) *citing* 17 U.S.C. § 304(a)(1)(A) (renewal rights in country music singer Roger Miller's 1958-63 songs belonged to Sony because publishing agreements with Sony's predecessor in interest incorporated language evincing intent to transfer these rights and Sony

paid Miller and his estate royalties during the original term and during the renewal term).

a. The renewal term is distinct from the original copyright term and can therefore be transferred independently of the original copyrights. *P.C. Films Corp. v. MGM/UA Home Video, Inc.*, 138 F.3d 453, 456-57 (2d Cir. 1998).

b. There is a strong presumption against conveyance of renewal copyright interests simultaneously with conveyance of the original copyright interest. *Corcovado Music Corp. v. Hollis Music*, 981 F.2d 679, 684 (2d Cir. 1993). Thus, a valid transfer of a renewal right generally must expressly grant rights in the renewal copyright.

c. An author can assign the right to the renewal copyright before the renewal period commences and is valid against the world if the author is alive at the commencement of the renewal period. *Miller Music Corp. v. Charles N. Daniels, Inc.*, 362 U.S. 373, 375 (1960). But if the author dies before vesting of the renewal copyright, the party to whom the renewal right was conveyed loses the entitlement to that interest. *Id.* at 378.

12. General release. A broad general release and grant of life story rights for the film “Flashdance” precluded claims for copyright infringement, unfair competition and infringement of state right of publicity for alleged recreations of well-known scenes from “Flashdance” in music video for Jennifer Lopez song “I’m Glad.” *Marder v. Lopez*, 450 F.3d 445 (9<sup>th</sup> Cir. 2006).

#### **D. Much of the Music News is Digital.**

1. *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913 (2005) (the probable scope of infringement is staggering (100 million copies of the software in question downloaded and billions of files are shared across FastTrack and Gnutella networks each month)).

2. RIAA pursuing individual infringers nationwide and especially on college campuses.

3. Online digitization project aims at the sampling market. *BMG Music v. Gonzalez*, 2005 U.S. App. LEXIS 26903 (7<sup>th</sup> Cir. Dec. 9, 2005).

4. Ringtone Opinion. *In re Mechanical and Digital Phonorecord Delivery Rate Adjustment Proceeding*, No. RF 2006-1, October 16, 2006 (ringtones made available for use on cellular telephone and similar devices

qualify as digital phonorecord deliveries (“DPDs”) as defined in 17 U.S.C. § 115; whether a particular ringtone falls within the statutory scope of the statutory compulsory license depends primarily on whether what is performed is simply the original musical work (or a portion thereof) or a derivative work).