Legal issues for photography

Orphans, freelancers and the random snapshot, by **Cydney A. Tune** and **Erin E. Wagner** of Pillsbury Winthrop Shaw Pittman LLP

AUTHORS

Cydney Tune (pictured) leads Pillsbury Winthrop Shaw Pittman's copyrights practice section and media & entertainment industry team. She represents and advises clients in a variety of intellectual property issues, including copyrights and trademarks, as well as in a broad array of entertainment, licensing and e-commerce matters.

Erin Wagner is a summer associate at Pillsbury. She currently attends The University of Chicago Law School and earned her undergraduate degree from the University of California, Los Angeles.

Photographers face a number of issues regarding their ownership rights under US copyright law. Due to the nature of photographs, copyright notices are rarely affixed to the face of the photograph itself, making it difficult for a person or entity that is interested in reproducing or using the work to (a) be on notice that the work is protected under copyright law, and (b) know who owns the copyrights in the photograph.

Moreover, if a photograph was first published in the US before 1989 without a copyright notice, it may have lost copyright protection and become part of the public domain. While a copyright notice on the first page of a written article hardly affects the work itself, a copyright notice anywhere on the face of a photograph of, say, a pristine landscape, detracts from the visual effect the photograph is meant to have on the viewer. Furthermore, these issues are compounded by digital technology and by the internet. Images are often and easily "ripped" from the internet and digital technology permits easy manipulation and copying as well as wide-spread, fast distribution of photographic images, all without discernable deterioration in the quality of the image.

The lack of copyright notices on photographs, the confusion with respect to copyright ownership rights when multiple parties are involved in the creation of a work, and the ease of capturing instantaneous images all result in a number of problems amplified in the area of photography. This article will discuss orphan works as a profound problem in particular for photographers and illustrators. It will also touch on the

Copyright WORLD

muddled ownership rights of freelance artists, particularly conflicts between photographers and publishers. Finally it will conclude with a brief discussion of emerging rights of publicity and First Amendment concerns for photographers and ordinary citizens alike.

Orphan Works

Because the nature of the photograph is to be void of any indication of ownership on its face, many copyright-protected photographs fall into a category known as "orphan works". A work becomes "orphaned" when the copyright owner cannot be determined or, if known, cannot be located.

The extension of the term of copyrights in the US has further exacerbated this problem with respect to photographs. In 1992, the United States government enacted the Copyright Term Extension Act (CTEA), which lengthens the amount of time a work is protected under US copyright law. As a result of this extension, copyright protection was reinstated for many works that had lost copyright protection and thus moved into the public domain. This in turn resulted in a substantial number of works that were anticipated to be free for all to use being suddenly subject to a longer period of protection. By extending the term of copyright protection, CTEA amplified the confusion and potential risks flowing from exploitation of orphan works.

> **"If a photograph was first published in the US before 1989 without a copyright notice, it may have lost copyright protection and become part of the public domain"**

Orphan works are problematic for both the potential users of a photograph and for the photographer or other copyright owner. A potential user needs to know whether the work is still protected under copyright law and if so, whom he must contact to seek a licence to the photograph. A potential user is in a difficult position if faced with an unknown photographer and an unknown date of creation. If a potential licensee searches tirelessly but unsuccessfully for the copyright owner and then proceeds to use the work, the copyright owner may emerge and make a claim of infringement. Under US law, a user of an orphan work faces significant risk if the copyright owner asserts ownership rights after the user appropriates the work.

Members of Congress have made attempts to propose a solution to this problem as recently as 2008 with the proposal of the Orphaned Works Act. That proposed legislation would mitigate the copyright owner's potential damages in situations in which a user of a work made a diligent but unsuccessful effort to find the copyright owner where the owner later appeared and asserted rights. If the proposed Orphaned Works Act were to become law, a user of an orphan work who followed the steps set forth in the Act would only face damages in the amount of a lost licensing fee. Many negative comments were submitted regarding the proposed Orphaned Works Act, a large number of which came from photographers and from those who own substantial rights in photographs.

Much to the relief of photographers and to the frustration of potential users, however, the Orphaned Works Act has not been enacted by Congress. Therefore, potential users of photographs and other works for which the copyright owner is unknown or cannot be located are still left to weigh the risks of unlicensed use with the potential rewards of such use. Attorneys are left to counsel their clients by relying on best practices, rather than having the guidance that would be provided by relevant legislation. Nevertheless, it is highly advisable to consult a copyright attorney when confronted by a possible orphan work issue. While there is no legislated means to mitigate the risks, there are strategies that can be followed to help minimise the risks that arise from exploitation of an orphan work. Additionally, a photographer or an owner of copyright in photographs should consult a copyright attorney if it appears that their works may have been orphaned.

Freelance photographers

A second and highly contentious issue pertaining to photographs under US copyright law involves works that are commissioned on a work made for hire basis. Under US copyright law, the individual who commissions the photograph (Commissioning Party) is deemed to be the original "author" of a work that was commissioned as a work made for hire. As such, the Commissioning Party will own the copyrights in the photograph as a matter of law. Whether or not the Commissioning Party or, in an employment context the employer, actually owns the copyrights in a particular photograph would depend on whether the statutory requirements were met for a commissioned work and on whether the photograph was taken within the course and scope of the employee's job in the employment context.

Freelance photographers are often, though not always, commissioned for a specific project. Sometimes such freelancers work on a work made for hire basis, but often the freelancer retains the copyrights in the photograph and provides a licence to the client instead. Even if a freelance photographer retains the copyrights in a particular photograph, however, she may not have a copyright infringement claim if the photograph is subsequently incorporated by that photographer's media client into a compilation. In fact, the situation between publishers and freelance photographers has become particularly contentious. The extent to which freelance photographers retain a copyright interest in all additional publications of their photographs is unclear and depends in large part on the specific contract between the parties (if such a contract exists), but recent cases have shed light on the copyright "sharing" between publishers of larger works that contain individual works by freelance photographers retained by the publisher and the freelancers.

Take, for example, a freelance artist who is commissioned to photograph a whale for National Geographic and licenses the rights in the photograph to National Geographic for publication in a specific edition. The photographer would retain all copyrights in the single photograph, but would not own any copyrights in the specific edition in which the photograph is published. Courts in the United States have held that digital reproductions of entire archives do not infringe on the freelance photographer's copyrights as long as no alterations are made in the digital version from the original publication and thus, in such circumstances, no additional consideration would be owed to the photographer.[1] On the other hand, if the publisher were to alter the contents of the

larger work containing the reproduced photograph or use that photograph in a different way from the original manner in which it was used, the freelance photographer may have a claim against the publisher.[2] As with most areas of the law, a freelance photographer can (and should) contract with the owner of the larger work (i.e. National Geographic) to ensure that additional compensation will be paid for such future reproductions of the photographs.

Rights of publicity in copyright

A third, very important, issue facing photographers is the realm of privacy law and the related right of an individual under state law to control commercial use of his or her image, the so-called publicity right. A photographer in the United States must consider the rights of those who are photographed, though the analysis in each case depends in large part on the intended use of the image captured. And individuals, particularly those in the public eye, must actively work to preserve their publicity rights to the extent US law will allow.

Privacy and publicity rights are both governed by state law, and the laws of the various states are not uniform. The law of the state in which the person depicted is domiciled will govern any right of publicity or privacy issues. In each instance, the particular state's law must be examined and the facts must be analysed in light of that state's laws. To potentially give rise to a claim, the image of a person must be personally recognisable. Also, an invasion of privacy claim cannot be brought unless the person depicted had a reasonable expectation of privacy at the time the photograph was taken; this requirement excludes most photographs taken in public locations from claims. There is no such requirement, however, for a publicity right claim.

An individual's right to protect his or her image publicly is often at odds with the First Amendment to the United States Constitution, which protects freedom of speech and of the press. The First Amendment has been the basis for many successful defences on behalf of publishers and artists alike where the law would otherwise point to liability for infringement of the publicity right. The First Amendment protects extensive publication of speech, including differing forms of speech such as photography, news articles and other literary works. This balance between competing concerns of an individual's ownership of his or her likeness and the rights of others to express themselves provides for inconsistent judicial decisions and has resulted in much confusion on behalf of both sides of the balancing act.

In 2008, Woody Allen initiated an action against American Apparel for violation of his right of publicity. His claim arose from the use of a photograph of him dressed as a Hasidic Jew, from the movie "Annie Hall." American Apparel used the photograph extensively in an advertising campaign without his consent. As a result of the campaign, Allen believed his rights had been infringed and sued under both the US Lanham Act and New York privacy statutes.[3] The New York Privacy statutes prohibit the use of a person's likeness without their consent for purposes of commercial gain. Had the photographer given consent to American Apparel, it likely would not have made a difference as consent to use Allen's likeness is not the photographer's to give. The case eventually settled for US$5 million, highlighting the serious consequences that can arise from infringing uses.

In a case involving an ordinary citizen, First Amendment and fair use concerns ultimately outweighed the individual's privacy interests. Erno Nussenzweig was, without his knowledge, photographed in New York City by Philip-Lorca diCorcia, a highly regarded photographer. DiCorcia went on to sell limited editions of the image for thousands of dollars and it was also included in an expensive "coffee table" book. Although Nussenzweig's religious beliefs forbid him from being photographed, he was unable to successfully sue DiCorcia for the use of his image without his consent because his claim was found to be time barred.[4] Under US law, as in many countries, strict limits are in place to with respect to the time frame in which claims can properly be asserted against others. Here, the photographs were published and sold in 2001, and it was not until 2005 that Nussenzweig became aware of the use of his image and filed suit. The highest court in New York State held that because the applicable New York statute[5] provides for a one-year statute of limitations from the date of publication of the work, Nussenzweig was barred from recovering. Although the highest court in New York did not rule on any other issue apart from the statute of limitations, the court below had found in favour of diCorcia for all of Nussenzweig's claims, finding that the photograph was "art" as opposed to being used purely for commercial gain and relying on the fact that New York courts had interpreted "art" liberally in prior cases. The case has been interpreted to mean that photographers can publish and sell photographs in limited editions without obtaining consent from the subjects depicted in such photographs.

Users of photographs can be liable for images taken by others even if they acquire a licence from the photographer. If that photograph contains a recognisable image of an individual who did not consent to use of his or her likeness, the user of the photograph may be liable for invading that individual's privacy or for violation of the right to publicity. It is particularly appealing to many advertisers to use the image of a famous individual for advertising and promotional purposes, or to generate revenue in other ways. But if done without consent from parties depicted, it may turn into a much bigger headache than it is worth (as American Apparel discovered very recently). It is wise to consult an attorney specialising in publicity and privacy rights if there are any issues with respect to whether an intended use of a photograph is commercial in nature or whether an image contained in a photograph was unlawfully appropriated.

Photographs present particular challenges for photographers, publishers, users, would-be users and members of the public generally under US copyright and other laws. Because of the seriousness of the rights involved, it is important to be well-informed when working within the laws of the United States. If not, an advertising campaign, mishandled archive, incorrect contract provision or a misguided search for ownership can become very costly for all parties involved. As is typical with many problems, the most cost-effective solution is to address the situation through preemptive measures rather than after-the-fact damage control.

Notes

1. *New York Times v. Tasini*, 533 U.S. 483 (2001); *Faulkner v. National Geographic Enterprises*, 409 F.3d 26 (2d Cir. 2005).
2. *Greenberg v. National Geographic Society*, 533 F.3d 1244 (11th Cir. 2008).
3. 15 USC 1125 § 43(a); New York Civil Rights Law §§ 50, 51.
4. *Nussenzweig v. diCorcia*, 9 N.Y.3d 184 (2007).
5. New York Civil Rights Law § 51.