



American Society of Media Photographers

U.S. COPYRIGHT OFFICE

NOTICE OF INQUIRY

80 Fed. Reg. 23054 (Apr. 24, 2015)

**COPYRIGHT PROTECTION FOR CERTAIN
VISUAL WORKS**

**REPLY COMMENTS
OF
AMERICAN SOCIETY OF MEDIA
PHOTOGRAPHERS (ASMP)**

**SUBMITTED BY
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The American Society of Media Photographers (ASMP) again thanks the Copyright Office for providing the opportunity for working visual artists to comment on enforcement issues, and to amplify our remarks. Although relayed from different perspectives, the concerns raised by the American Photographic Artists, Graphic Artists Guild, Professional Photographers of America, the Digital Media Licensing Association, and other visual artists' groups paint a clear picture of an industry facing severe degradation of the incentives the copyright system was intended to provide. We wish to take this opportunity to give two more concrete examples of the kinds of challenges that our members face in the marketplace, and a description of the way in which that marketplace is getting worse.

As ASMP mentioned in its initial comments, its members can create thousands of images in conjunction with a single project, many of which will be of limited value. Every so often, however, through the use of lighting, editing, posing, and accumulated professional skill, an ASMP member creates an iconic image. Ordinarily, one might think that copyright's originality standard would protect such photographs from blatant knockoffs—either via slavish imitation or by printing the image on goods. But even now, some courts are applying dangerous and destructive standards of liability to cases involving photographs.

First, as we alluded to in our opening comments, services like Photobucket have improperly used the safe harbor in section 512 to shield themselves from liability for acts that go well beyond the text of that provision. One visual artist found this out to her detriment, in a case she brought without a lawyer.¹

¹ *Wolk v. Kodak Imaging Network, Inc.*, 840 F. Supp. 2d 724 (S.D.N.Y. 2012), *aff'd*, *Wolk v. Photobucket.com, Inc.*, 2014 U.S. App. LEXIS 11211 (2d Cir. N.Y., June 17, 2014).

Photobucket and sites like it have created two levels of arrangements. The first involves the creation of environments in which the “free” photographs—vast numbers of which are infringing—serve as draws for advertising. The second involves the online service entering into profit sharing relationships whereby they share in the revenues gained from printing posters, t-shirts, and coffee mugs.

In *Wolk*, a visual artist attempted to sue Photobucket on two theories. The plaintiff identified over 3,000 instances of infringing copies of her images.² The first involved allegations that Photobucket had exceeded the scope of the safe harbor in the DMCA (17 U.S.C. § 512(c)), a contention that the district court rejected.³ Given the trend of such decisions, that result is unfortunate (and misguided) but not surprising.

Bizarrely, however, the district court excused the second portion of this arrangement. In this case, the defendant had entered into an agreement in which an automatic procedure sent Photobucket-hosted images to be printed by Kodak, and Photobucket received a portion of the proceeds from the sale of those items.⁴ According to that court, however, neither Kodak nor Photobucket had any responsibility for those infringing sales.⁵ The result of this exceedingly narrow reasoning (which thankfully not all courts have adopted)⁶ is that a photo “sharing” service

² *Id.* at 735.

³ *See id.* at 746.

⁴ *See id.* at 730-31.

⁵ *See id.* at 742; *id.* at 748 (“While Wolk alleges that Photobucket receives a financial benefit from infringements from a profit-sharing relationship with the Kodak Defendants, there is no evidence indicating that either the Kodak Defendants or Photobucket capitalizes specifically because a given image a user selects to print is infringing.”)

⁶ *Compare, e.g., Nat'l Photo Group, LLC v. Allvoices, Inc.*, 2014 U.S. Dist. LEXIS 9190 (N.D. Cal. Jan. 24, 2014) (quoting *Ellison v. Robertson*, 357 F.3d 1072, 1079 (9th Cir. 2004)) (stating that “the essential aspect of the ‘direct financial

may easily make itself legally blind and profit from any infringement that occurs.⁷ "Viewed in terms of Congress' regulatory objectives, why should any of these technological differences matter?"⁸

Indeed, uncertainty has now arisen over the standard of originality applicable to photographs. For example, *Rentmeester v. Nike* (No. 3:15-cv-00113-MO) (D. Oregon, June 15, 2015) creates daunting challenges for visual artists pursuing infringers, as it renders proving substantial similarity between two photographs very, very difficult—even when the photographer has made potentially hundreds of creative choices about how to complete a particular assignment. There, the United States District Court for the District of Oregon dismissed a complaint for failing to state sufficient infringing similarity between two photographs of Michael Jordan, one of which became the basis for the “Jumpman” logo.⁹

benefit' inquiry is whether there is a causal relationship between the infringing activity and *any* financial benefit a defendant reaps, regardless of how substantial the benefit is in proportion to a defendant's overall profits.” (emphasis supplied); 4 Melville B. Nimmer & David Nimmer, Nimmer on Copyright § 13.08[C][3][a] (“A party that only supplies equipment can avoid culpability for the infringing conduct to which third parties adventitiously put that equipment. But engineering an entire system and supplying some equipment at home that is designed so that third parties may infringe copyrighted material at the “push of a button”).

⁷ See *Wolk*, 840 F. Supp. 2d at 748 (“Photobucket has no knowledge of which images users may select to send to the Kodak Defendants to be printed, and, as such, Photobucket has no ability to control whether users request that infringing material be printed.”).

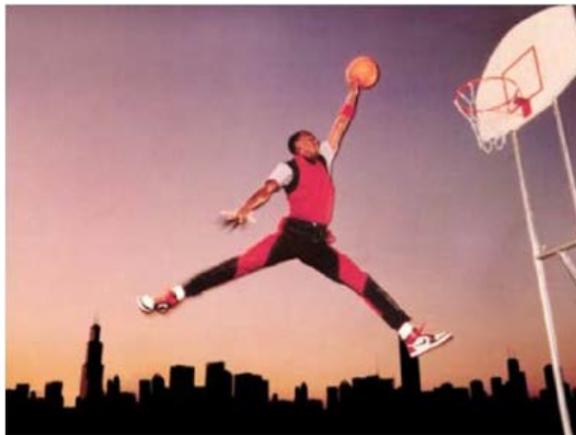
⁸ *ABC, Inc. v. Aereo, Inc.*, 134 S. Ct. 2498, 2508 (2014).

⁹ No ambiguity exists about Nike’s access, or its intentions: Nike rented transparencies from the plaintiff for “slide presentation only, no layout or other duplication.” (Slip op. at 3). Seven months later, Nike created its photo which appeared on billboards, posters, and elsewhere. Indeed, for two years, Nike paid a limited

Here is the plaintiff's photograph:



And the alleged infringer's version:



The District Court dismissed the complaint because it found that Nike had only copied unprotected elements—

license to use the Nike photograph. In 1987, it stopped paying, and has been using it ever since.

the idea of the work. While claiming to reject Nike’s suggestion that the photographs have to be “virtually identical” for infringement to lie, the court nonetheless found:

the idea Mr. Rentmeester tried to express in his photograph was that of, “Michael Jordan in a gravity-defying dunk, in a pose inspired by ballet’s grand-jeté. This is the idea that matters and therefore the one that will be used for the subsequent steps in the *Mattel* analysis.¹⁰

Accordingly, as there were so few ways to express that idea, the court found that the defendant’s photograph did not trespass on Rentmeester’s copyright, as the underlying work merited only “thin” protection.

This kind of reasoning gravely threatens the licensing market for photographs that require a great deal of thought and creativity in their composition, aesthetic expression and final editing choice. As the Copyright Office is well aware, the line between unprotected “idea” and uncopyrightable “expression” can be in some cases hard to draw, but it is a critical one to the maintenance of the incentive to create. If the line for ideas is set too loosely (as the district court did in this case), then the incentive at the heart of copyright erodes.

While pretending to eschew a requirement that the infringing work be “virtually identical,” the district court not only made a distinction without a difference, it rewrote traditional standards of copyright protection. The district court incorrectly focused on the subjective “idea” that the photographer had in creating this photograph erodes copyright protection in any visual work. Of all the possible ways that the photographer could have chosen to photograph this basketball player, the plaintiff chose that particular pose to demonstrate that particular subject,

¹⁰ *Rentmeester v. Nike* (No. 3:15-cv-00113-MO) (D. Oregon, June 15, 2015), slip op. at 7-8 (internal quotation and citation omitted).

using strobe lights, shooting angles, staging, and other tools of the art to portray Michael Jordan in a particular way. Under the district court's analysis, none of those choices seem to receive protection. As a result, the district court's opinion permits users to sell and exploit any artistically staged photograph with only trivial variation. Its logic is certainly not limited to photographs: any visual rendition of a subject could fall prey to the same analysis. Licensing for derivative works would simply dry up.

Moreover, one cannot miss the subtext to this decision that undermines the hard-fought victory ASMP, the, PPA, and other individual authors' groups won in *Petrella v. MGM*, 134 S. Ct. 1962 (2014). In *Petrella*, the Court rejected a movie studio's claim (and a Ninth Circuit holding) that if a copyright owner waits too long to enforce its rights against an infringer, it effectively loses them. Instead, the Court ruled that copyright owners can recover all damages incurred during the Copyright Act's three-year limitations period. Although one can perhaps understand the lower court's reticence to rule against a successful and iconic advertising campaign, the proper place for such concerns is the remedy stage,¹¹ not the originality determination. But if affirmed, these kinds of originality rulings will destroy secondary licensing markets for many ASMP members' works, as even the most carefully composed photograph can be simply trivially altered and copied wholesale.¹²

Rentmeester has been appealed (and will hopefully be reversed), and *Wolk* has some ways to go before it becomes

¹¹ E.g., *New York Times Co. v. Tasini*, 533 U.S. 483, 505 (2001) (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578 n.10 (1994)); see *eBay, Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 392-93 (2006); *Elvis Presley Enters. v. Passport Video*, 357 F.3d 896, 899 (9th Cir. 2004).

¹² So severe is the infringement of ASMP works that the reprographic royalties which would have in past years have funded amicus brief efforts have dwindled to negligible amounts, placing many associations without the resources that existed in past years to file briefs amicus curiae in cases like these.

the law of the land. The common-law development of these standards, however, will take time — a luxury that visual artists do not have. Read together, the kinds of results in *Wolk* and *Rentmeester* should make clear that: (1) the only sure-fire way for a photographer to recover is against the infringer/uploader and (2) such recovery is only certain when the infringing copy is identical to the original. That is exactly the kind of case that improved group registration procedures combined with a small claims process can address fairly, promptly, and efficiently. Such changes cannot occur soon enough.

Thank you for your consideration.

Respectfully submitted,

A handwritten signature in black ink that reads "Thomas Kennedy". The signature is written in a cursive, flowing style with a large initial "T" and a long, sweeping underline.

Thomas Kennedy
Executive Director