Music Licensing Transformed by the Passage of the Music Modernization Act

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On October 11, 2018, the president signed into law the Orrin G. Hatch–Bob Goodlatte Music Modernization Act (MMA). This major piece of bipartisan legislation touches on nearly every aspect of U.S. copyright law that relates to licensing of either musical compositions or sound recordings. The legislation is the result of many years of examination of reform proposals by Congress and the Copyright Office and many years of negotiations among industry stakeholders. The lengthy MMA makes five principal sets of changes to the Copyright Act:

1. Creation of a blanket statutory mechanical license for digital music providers, which will be administered by a new “Mechanical Licensing Collective”;

2. Substantial federalization of protection for pre-1972 sound recordings, which generally had been protected only under state law;

3. Adoption of a “willing buyer, willing seller” rate standard to be used when setting rates for musical compositions and sound recordings under statutory licenses;

4. Changes to procedures for “rate court” proceedings

5. Provision of statutory procedures for producers, mixers, and sound engineers to receive royalties for the use of sound recordings under a statutory license.

Blanket License for Digital Reproduction and Distribution of Musical Compositions

The MMA’s centerpiece is a major rewrite of the “mechanical” compulsory license provisions in section 115 of the Copyright Act. That license was originally created as part of the Copyright Act of 1909 to provide a mechanism for licensing reproduction and distribution of musical compositions embodied in piano rolls. Even as recording technology progressed to vinyl records, compact discs, and eventually downloaded digital files, the licensing procedures remained substantially the same. Under section 115, a compulsory mechanical license was available by serving on a copyright owner a notice of intent (NOI) that listed the individual musical compositions that the licensee intended to use, and then paying statutory royalties on those individual compositions. In some cases, an NOI could be filed with the Copyright Office instead.

However, after more than a century since the 1909 Act, the mechanical license system was under strain, as ownership of musical composition copyrights became increasingly fractured and the music market migrated from the sale of products such as CDs and permanent downloads and toward Internet streaming. Digital music providers found it difficult and expensive to obtain and administer mechanical licenses for all the compositions in their vast libraries, while music publishers and songwriters believed that providers often did not obtain valid licenses or pay required royalties and began filing litigation against streaming services on that basis.

The goal of the MMA’s blanket license is to make compulsory mechanical license administration for digital uses simpler and more efficient and to ensure that a higher proportion of usage results in payment of statutory royalties to the proper music publishers and songwriters. To do so, the MMA establishes the Mechanical Licensing Collective, a nonprofit organization that will administer the blanket license industrywide at the expense of digital music providers. Among other things, the Mechanical Licensing Collective will develop and provide a publicly accessible database of current ownership information for musical compositions. The database will address a long-felt need for more accurate and timely ownership information for musical compositions, which should simplify licensing of musical works for all uses.

Because it will take some time to get the Collective up and running, the blanket license will not be available until January 1, 2021. To obtain a blanket license once they become available, a digital music provider will need only submit a notice to the Collective. During the transition period (i.e., prior to the availability of blanket licenses on January 1, 2021), a digital music provider’s potential exposure to liability for copyright infringement is limited, so long as the digital music

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provider engages in good-faith, commercially reasonable efforts to identify, locate, and pay royalties to the owners of musical compositions, and pays any remaining unpayable royalties to the Collective once it is up and running.  

Efforts to implement the new mechanical licensing procedures have begun in earnest. On November 5, 2018, the Copyright Royalty Board published a notice in the Federal Register soliciting comments on “necessary and appropriate modifications and amendments” to its regulations following enactment of the MMA. Industry groups also have begun the process of identifying proposed leaders for the Collective.

Federal Protection for Pre-1972 Sound Recordings

A separate title of the MMA, referred to as the “Classics Protection and Access Act,” or the “Classics Act,” extends copyright-like federal protection to sound recordings fixed before February 15, 1972, commonly referred to as “pre-1972 recordings.” Previously, such recordings were largely excluded from the federal copyright system.

Instead, prior to the enactment of the MMA, pre-1972 recordings were potentially protected under state statutory and common law until February 15, 2067. As a result, the law across the country lacked uniformity. For example, while most states gave the owner of a pre-1972 recording the right to control reproduction and distribution of its recording, and one federal district court found that a state statute provided a property right in the public performance of a pre-1972 recording, the highest courts of two states determined that their state law provided no public performance right in pre-1972 sound recordings. Some large digital music services refused to pay the artists who created these works.

The Classics Act was originally designed as a response to judicial decisions finding no public performance right under state law, and earlier bills would have created only a federal public performance right in pre-1972 sound recordings. However, a last-minute compromise resulted in substantially full federalization of protection of pre-1972 recordings in the enacted version of the MMA.

Now, under a new section 1401 of Title 17, owners of pre-1972 sound recordings have federal protection against unauthorized use of their recordings that largely mirrors the scope of federal copyright protection. That protection will continue for the following periods:

- For recordings published before 1923, the term of protection ends on December 31, 2021;
- For recordings published between 1923 and 1946, the term of protection continues until December 31 of the year 100 years after publication;
- For recordings published between 1947 and 1956, the term of protection continues until December 31 of the year 110 years after publication;
- For all other recordings (including unpublished recordings and ones published after 1956), the term of protection ends on February 15, 2067.

While protection under section 1401 largely mirrors federal copyright protection, there are important differences. For example, formalities such as registration do not apply, but there is a special statutory process for rights owners to record claims to works to be eligible to recover statutory damages. Additional provisions address settlements of state law claims. The Classics Act also includes a special statutory process for seeking permission for noncommercial uses of pre-1972 recordings that are not being commercially exploited.

The continuation of state protection for pre-1972 recordings when all other works were brought into the federal system in the Copyright Act of 1976 was a historical anomaly. That anomaly made increasingly less sense as the music market migrated away from physical product distribution and toward digital services with national reach. Federalizing protection for these works will provide uniform legal treatment that should facilitate commerce involving these recordings and result in consistent payment for the use of these works.

Willing Buyer, Willing Seller Rate Standard

Previously, some users of music under statutory licenses paid statutory royalties set under a “willing buyer, willing seller” standard, while others paid statutory royalties set under an older standard that had been interpreted to allow the Copyright Royalty Board to set below-market rates. The MMA establishes a “willing buyer, willing seller” standard for setting royalty rates for mechanical licenses under section 115 of the Copyright Act and for all users of sound recordings under the statutory license in section 114 of the Copyright Act.

Changes to ASCAP and BMI Rate Court Proceedings

For many decades, royalty rates under performance licenses for musical compositions issued by the performing rights organizations ASCAP and BMI have been subject to oversight by federal judges in the Southern District of New York, pursuant to consent decrees between those organizations and the Department of Justice dating back to 1941. Proceedings to set rates under those consent decrees are commonly referred to as “rate court” proceedings. Music publishers and songwriters have long sought changes to certain aspects of those proceedings. The MMA makes two such changes.

First, assignments of judges to hear rate-setting proceedings will now be made randomly, on a case-by-case basis. Previously, one judge had retained jurisdiction over each consent decree for many years. The aim of this change is to neutralize any perceived biases and bring a fresh perspective to each rate court case. It also means, however, that the outcomes of proceedings may be less predictable.

Second, the MMA removes a provision in section 114(i) that previously prohibited the rate courts
from considering evidence of royalty rates for sound recordings when setting rates for public performances of musical compositions. When Congress created the digital performance right in sound recordings, that provision was intended to protect musical composition rates from erosion. However, more than twenty years later, it seemed like an unnecessary constraint on the conduct of rate court proceedings.

Payment of Statutory Royalties to Producers, Mixers, and Sound Engineers

Yet another title of the MMA is referred to as the “Allocation for Music Producers Act” or “AMP Act.” The AMP Act codifies procedures used to pay producers, mixers, and sound engineers who participated in the creative process that created a sound recording their share of section 114 statutory royalties. It also creates a new process for such persons who contributed to pre-1995 recordings to claim a share of royalties when they are not able to obtain a “letter of direction” of the kind now contemplated by many producer agreements. Finally, the AMP Act simplifies the tax treatment of situations where a producer is paid out of the artist’s share of statutory royalties.

Endnotes

10. Sound recordings did not receive any protection under federal law at all until the Sound Recording Amendment of 1971. Sound Recordings Act, Pub. L. No. 140, 85 Stat. 39 (1971). Even then, the Sound Recording Amendment of 1971 excluded protections for sound recordings that were made prior to February 15, 1972. Id. Some foreign-origin pre-1972 recordings were “restored” to federal protection during the 1990s. 17 U.S.C. § 104A.
12. Flo & Eddie, Inc. v. Pandora Media, Inc., 113 U.S.P.Q.2d 2031 (C.D. Cal. 2015), question certified, 851 F.3d 950 (9th Cir. 2017). As of this writing, the case is pending before the California Supreme Court.
22. Id.
23. Id.

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The Photograph That Broke the Internet…

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didn’t want to be spotted taking the photograph.

The photograph was eventually screenshotted by Goldman’s friend, posted to Twitter without permission, and embedded in news articles covering the Brady-Durant news. Then came the copyright lawsuit. The suit is now well-known because, on an early summary judgment motion, a judge surprisingly ruled that the news organizations could not hide behind embedding as a workaround to copyright liability.

But maybe this case should be about something else surprising: The photograph isn’t creative enough to be subject to copyright. Admittedly, anyone who took Intro to Intellectual Property knows that the Copyright Act doesn’t demand much creativity to merit protection, but it does require a spark. And maybe under that standard, low as it may be, my photographs or your photographs or Goldman’s, most of them snapped at a moment’s notice and without thought, aren’t creative enough to deserve of copyright protection. Maybe the vast majority of us are not “sharp-shooters” but what Sarony desirously called “careless sportsmen.”

The Making of Oscar Wilde

Sarony made Oscar Wilde famous. In January 1882, Wilde sat for a session with Sarony in his Union Square studio in New York City. Sarony had just paid Wilde’s friend, the French stage actress Sarah Bernhardt, $1,500 (around $40,000 today) to sit—a common practice for photographers at the time who turned around and sold the photographs as trading cards. Wilde, not yet a name in America, sat for free.²

The session resulted in twenty-seven photographs. Photography, then a new technology, was different back then. (The first rudimentary photograph of a person had been taken less than 50 years earlier in Paris.) Cameras didn’t have a mechanical shutter, let alone an automatic one. So in addition to posing, staging, and coaxing an expression from the subject, Sarony or one of his assistants had to remove the lens cap for just the right amount of time so as to not over—or underexpose the glass plate (the precursor to film). Making things even more difficult, there was no artificial light, so natural light was carefully controlled with blinds on the large windows in Sarony’s studio along with mirrors to direct it where it needed to go.³

Sarony sold tens of thousands of the photographs of Wilde. “His face is well known to our readers through the thousands of pictures that have been scattered over the county,” one Ohio reporter remarked during Wilde’s year-long visit to the States in 1882.⁴ Almost overnight, Wilde became a superstar.

Seeking to capitalize on the popularity of Wilde, the Ehrich Brothers department store commissioned Burrow-Giles to print 85,000 copies of Oscar Wilde No. 18 stamped with “Compliments of Ehrich Bros.”⁵ Sarony sued Burrow-Giles for infringement.⁶ In a short opinion, the New York circuit court rejected Burrow-Giles’s argument that “a photographer is not an author” for the purposes of copyright.⁷ According to the court, Sarony was the author of “a useful, new, harmonious, characteristic, and graceful picture” of Wilde. He posed Wilde, selected the costume and other accessories in the photograph, arranged the light and shade, and suggested the “desired expression.”⁸

Burrow-Giles appealed. In the Supreme Court, it continued to argue that “a photograph being a reproduction . . . of the exact features of some natural object or of some person, is not a writing of which the producer is the author.”⁹ The argument was again rejected. Initially, the Court noted that there was “no doubt that the Constitution is broad enough to cover an act authorizing copyright of photographs, so far as they are representatives of original intellectual conceptions of the author.”¹⁰ On that later point, it explained that it “may be true in regard to the ordinary production of a photograph” that the photographer is merely creating a “mechanical reproduction of the physical features or outlines of some object animate or inanimate, and involves no originality of thought” and that “in such case” there may be “no protection.”¹¹ For that reason, the Court stressed the importance that “the existence of those facts of originality, of intellectual production, of thought, and conception on the part of the author should be proved.”¹²

Sarony had carried that evidentiary burden.¹³ Based on the lower court’s findings of fact that he posed Wilde, selected and arranged his costume and other accessories, controlled the light and shade, and suggested an expression, the Court found that the photograph demonstrated sufficient originality to be covered by copyright.¹⁴ Oscar Wilde No. 18 was “an original work of art, the product of plaintiff’s intellectual invention.”¹⁵

Although Burrow-Giles lost, it did seem to convince the Court that at least some class of photographs is not necessarily “original intellectual conceptions of the author.”¹⁶ Photographs, the Court noted, were covered by the Copyright Act but only to the extent they are original. It juxtaposed those original photographs with ones that are merely “mechanical” copies of the real world.¹⁷
Courts at the time read Burrow-Giles as requiring proof of originality—even in Sarony’s age of photography. In 1896, for example, one of Sarony’s contemporaries, Benjamin J. Falk, sued for the reproduction of a photograph of Loie Fuller, a pioneer of modern dance. The Court dismissed the lawsuit, finding that Falk failed sufficiently to plead originality: “[O]ne may be the author of a photograph of a person or natural object without intellectual effort involving invention or originality.” Thus, to be an author of a copyrighted photograph, the court explained, “one must necessarily have injected some intellectual effort into the production.” Yet, Falk only pled that he was “the author, inventor, designer, and proprietor of [the] photograph.” That was not enough.

Where Falk specified what he did to create the photograph, however, he had better luck. In one case, Falk explained: “I tried to produce an ideal portrait of the Greek maiden of the play. I posed [the woman] . . . arranged the illumination and the background . . . and secured the expression . . . and, outside of that, did the mechanical work of attending to the camera, focusing, and exposing the image.” Based on that description, the court held that the photograph was original. It was as much a “mental conception of the character” produced “by the use of lights and shades, and various accessories” as Sarony’s Oscar Wilde No. 18.

By the end of the century then, courts were requiring photographers to demonstrate independent creation and creativity for a photograph to be copyrightable. If the author failed to provide that proof, a loss was inevitable, but a new justice on the Supreme Court was about to change that.

Cue the Copyright Circus
Some 20 years after Burrow-Giles, the Supreme Court was asked to consider the copyrightability of chromolithographs or, as the Court characterized them, “pictorial illustrations.” Those illustrations were made to advertise the Wallace Circus—the main competitor of Ringling’s The Greatest Show on Earth. Initially, the Circus’s owner, E.B. Wallace, commissioned the prints from the Courier Lithographing Company. Apparently, Wallace was something of a cheap-skate and when he ran out of copies of the ads, he had Donaldson Lithographing Co. print more without Courier’s permission.

Today, the case, Bleistein v. Donaldson Lithographing Co., is cited as an early commercial speech case. The main argument that Donaldson advanced below was that works that were advertisements had no “intrins-cic merit or value” and thus did not “promote the progress of science and the useful arts.” The newly minted Justice Holmes, writing for six others, emphatically rejected that idea: “A picture is none the less a picture and none the less a subject of copyright that it is used for an advertisement.”

But he didn’t stop there. Holmes spent the rest of the opinion riffing on originality, concluding that creativity wasn’t a requirement for copyright so long as the work was an independent creation. Although there was testimony that the plaintiff had “composed [the illustrations] from hints or description, not from sight of performance,” Holmes said that even if they had been copies of the real world composed from sight, they still would be protectable because the drawings could not be divorced from their author. “Personality always contains something unique,” Holmes explained. “[A] very modest grade of art has in it something irreducible, which is one man’s alone.”

Holmes also didn’t want judges deciding what was art and what wasn’t (or, as he later put it, what was “low art” and what was “high art”). It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits,” Holmes cautioned. He added, dubiously, that the novel “etchings of Goya” or the paintings of Manet “might not have been considered “original” had judges had their say.”

Holmes’ sweeping rhetoric about personality innate in authorship was a striking departure from Burrow-Giles. It collapsed the two prongs of the originality requirement (independent creation and creativity) into a single question: whether the work was an independent creation, and, so long as it was, it was subject to protection. It was simply unnecessary, under a broad reading of Bleistein, to consider creativity because every work contains a part of the author’s personality. Maybe, then, it’s not surprising that Holmes mentioned Burrow-Giles just once.

On the other hand, maybe Holmes didn’t think Burrow-Giles was relevant. The work at issue in Bleistein, after all, wasn’t a photograph—it was a drawing. Holmes himself seemed focused on drawing, quoting John Ruskin’s Elements of Drawing to demonstrate the skill required to draw. And he made reference not to the photographs of Sarony but to the “paintings” of Manet and “etchings” of Goya. Whether Holmes intended his opinion to leach out into classes of works beyond drawings, Bleistein did soon metastasize.

After the Circus
The Court’s opinion in Bleistein, which even Holmes admitted he just “fired off,” reads a bit like a late-night missive composed after a drink or two. Nevertheless, it went on to have a drastic effect on how lower courts enforced the originality requirement for photographs—and it’s mostly Judge Learned Hand’s fault.

In 1921, Hand extended Bleistein’s logic to photographs. In Jewelers’ Circular Pub. Co. v. Keystone Pub. Co., he declared that “no photograph, however simple, can be unaffected by the personal influence of the author, and no two will be absolutely alike.” (It seemed lost on Hand that photographs of the same object, while distinct, may both lack creativity.)
At any rate, Hand didn’t need to rely on his sweeping pronouncement because he concluded that there was no “personality” requirement at all for photographs under the 1909 Act. (The Supreme Court would clarify some seven decades later that Hand was wrong on this latter point too.)\(^{35}\)

Although Hand’s language was dicta, other courts adopted it. In *Time Inc. v. Bernard Geis Associates*, the court found that frames of the Zapruder film showing President Kennedy being assassinated were protected as a matter of law.\(^{36}\) After recounting Hand’s opinion, including erroneously adopting Hand’s conclusion that the 1909 Act protected photographs “without regard to the degree of ‘personality’ which enters into them,” the court held that the frames were per se copyrightable.\(^{37}\)

Maybe disquieted by its own conclusion, the court still went on to consider whether the frames had hallmarks of creativity: “Zapruder selected the kind of camera (movies, not snapshots), the kind of film (color), the kind of lens (telephoto), the area in which the pictures were to be taken, the time they were to be taken, and (after testing several sites) the spot on which the camera would be operated.”\(^{38}\)

Not all courts though were so quick to adopt Hand’s Cartesian view of copyright: *I am a photograph; therefore, I am creative.*

In 1916, just over a decade after *Bleistein* but before Hand’s extension of *Bleistein* in *Jewelers Circular Pub. Co.*, a district court in *Pagano v. Charles Beseler Co.* considered whether a photograph of the New York Public Library was subject to copyright.\(^{39}\) The plaintiff alleged that his photograph was “his own original conception” because he “select[ed] the position and place from which to take said picture and the moment when the light, shade, cloud and sky effects upon said New York Public Library and its surroundings combined to make a new, harmonious, and artistic picture.”

The court, however, refused to assume that the photograph was per se creative. In fact, it expressly rejected the allegation that the photograph was a “new harmonious, and artistic picture” as conclusory. So it went on to consider the creative elements of photograph, many of which were pleaded. After recounting how the photographer used “light, shade, [and] the position” of the animate and inanimate objects, including timing the photograph well to capture “artistic” positions of the subjects in the scene, the court concluded that the “work . . . comes well within what the authorities have held to be the subject matter of copyright.”

In the end, the court in *Pagano* was faithful to *Burrow-Giles* by requiring proof of creativity, but *Pagano* was largely relegated to the jurisprudential trash heap. Hand’s opinion in *Jewelers Circular Pub. Co.*, however, went on to be vastly influential and was cited frequently, even outside of the Second Circuit. Eventually, it was enshrined as gospel by Professor Nimmer, who said it had “become the prevailing view.”\(^{40}\)

**Feist and the Constitutional Requirement of Originality**

A century after *Burrow-Giles*, telephone books, of all things, forced the Supreme Court to reassess the originality requirement. In that case, *Feist Publications, Inc. v. Rural Telephone*, Justice O’Connor, writing for a unanimous Court, rejected Holmes’ sweeping language in *Bleistein*. Independent creation alone, O’Connor explained, was insufficient to merit copyright protection.\(^{41}\) For a work to be “original,” it also had to be creative.

Rural was a telephone service provider for northwest Kansas. In exchange for its monopoly, Kansas required Rural to issue a telephone book. For Rural, that meant printing subscriber information on file, specifically, names, towns, and numbers, in alphabetical order. Feist was a publishing company. It created area-wide telephone books that covered substantially larger swaths of the region than individual providers. It bought the rights to use the information in ten of the eleven providers in northwest Kansas, but Rural refused to sell. Not to be deterred, Feist took the information anyway using 1,309 entries that were identical to Rural’s. Rural sued.

*Feist* presented a problem for the Court because, as O’Connor pointed out, facts like names, addresses, and telephone numbers are not subject to copyright, but compilations of those facts may be. Noting the “undeniable tension” there, O’Connor admitted that “[c]ommon sense tells us that 100 uncopyrightable facts do not magically change their status when gathered together in one place.”\(^{42}\) The “key” to making sense of this tension, O’Connor explained, was in how we think about original works of authorship.\(^ {43}\)

“Original,” in the copyright context, had two distinct requirements, she said. First, it meant that the work must be independently created by the author.\(^ {44}\) Second, O’Connor said, it meant that the work also must possess a minimal degree of creativity.\(^ {45}\) In other words, some works may be independent creations but not creative (a short phrase, for example), while others may be creative but nonetheless not independent creations (a highly technical copy of the Mona Lisa).

But what did creativity mean? It didn’t mean novelty, O’Connor wrote. Two poets could write the same poem ignorant of the other and neither would be novel, but both would be copyrightable.\(^ {46}\) Pulling from *Burrow-Giles*, O’Connor pointed out, however, that the Court had long “stressed the importance of requiring an author who accuses another of infringement to prove ‘the existence of those facts of originality, of intellectual production, of thought, and conception.’”\(^ {44}\) And relying on *The Trade-Mark Cases*, she added that creativity required evidence of the “fruits of intellectual labor,” i.e., the use of the “creative powers of the mind.”\(^ {45}\) Creativity, she said, was not
just a requirement of copyright law; it was the “touchstone.”46

Applying these principles, O’Connor concluded that facts are not subject to copyright because they “do not owe their origin to an act of authorship”: “The distinction is one between creation and discovery.”47 A census taker, for example, holds no copyright in the data he collects.

Compilations of those unprotected facts, however, “may possess the requisite originality” because the compilation itself may be an independent creation and creative.48 In addition to the facts, an author of a compilation “typically chooses which facts to include, in what order to place them, and how to arrange the collected data so that they may be used effectively by readers.”49 But even then, not all choices made by a compiler will necessarily be creative: “These choices . . . , so long as they are made independently by the compiler and entail a minimal degree of creativity, are sufficiently original . . .”50

To put a fine point on it, O’Connor explained that an author like President Ford in Harper & Row, Publishers, Inc. v. Nation Enterprises could not protect the “bare historical facts” underlying his autobiography—a compilation of sorts in its own right—but could protect his “subjective descriptions and portraits” of those facts.51 But where the author adds no personal expression of facts in the world, “but rather lets the facts speak for themselves, the expressive element is more elusive.”52 This “fact/expression dichotomy,” O’Connor noted, “limited severely the scope of protection in fact-based works.”53

Based on this, O’Connor held that Rural’s alphabetical compilation was not sufficiently creative and thus not original. The creativity requirement, while not a “stringent standard,” could not be satisfied by that which is “so mechanical or routine to require no creativity whatsoever”: The “standard of originality is low, but it does exist.”54 Rural’s compilation, far from meeting the “minimal degree of creativity” required,55 was “entirely typical,” “garden variety.”56

O’Connor cited Bleistein just once (much as Holmes cited Burrow-Giles just once). She did so, ironically, not for the proposition that all works are necessarily creative but for the opposite proposition—that some works are not.57 Although O’Connor didn’t linger on Bleistein, commentators have concluded that her opinion for the Court “effectively . . . overruled” it by demanding both independent creation and creativity.58

Creativity After Feist

After Feist, challenges to the copyrightability of photographs ticked up. While not all came out the same way, taken together, they suggest the slow death of Hand’s per se rule that photographs must be creative. As Justice Stephen G. Breyer noted, Hand’s per se rule “effectively . . . overruled” it by requiring a sufficient “spark” of creativity.59

Most of these post-Feist cases were brought by professional photographers. Despite the status of these contemporaries of Sarony (admittedly of varying degrees), Feist pushed courts to question whether the photographs were creative enough to merit protection. And, at least in some cases, they concluded that they were not.

In SHL Imaging, Inc. v. Artisan House, Inc., a case concerning the originality of product shots of mirrored frames, Judge Paul Oetken of the Southern District of New York rejected Hand’s per se rule.60 He explained that, although Burrow-Giles ultimately lost its battle, the Supreme Court “did not reject [its] attack [on the copyright of the photographs] entirely” but rather “observed that a lack of originality may be ‘true in regard to the ordinary production of a photograph.’”61 It was only that Oscar Wilde No. 18 was “no ordinary photograph.”62 And, although Judge Paul Oetken recognized the “broad sweep” of Holmes’ decision in Bleistein, he made clear that Feist had “augmented” Bleistein by requiring a sufficient “spark” of creativity.63 Under this augmented test, “no work is per se protectable.”64

Without a per se rule to lean on, courts returned to assessing the creative choices photographers made. At issue in Oriental Art Printing, Inc. v. Goldstar Printing Corp., for example, were several photographs of plates of Chinese food that were used on restaurant menus.65 Relying on Feist, the court explained that “this is the rare case where the photographs contained in plaintiffs’ work lack the creative or expressive elements that would render them original works subject to protection under the Copyright Act.”66 Indeed, the photographs “were not designed with creativity or art in mind.”67 The plaintiff could not even provide a “description of either the lighting or angles employed, or any desired expression.”68 Instead, the photographs served a “purely utilitarian purpose: to identify for restaurant customers those dishes on a take-out menu.”69

Following suit, in Custom Dynamics, LLC v. Radiantz LED Lighting, Inc., the District Court for the Eastern District of North Carolina held that product shots of various automotive parts were likely not sufficiently creative to be protected.70 The court threw out altogether Hand’s idea that all photographs are subject to copyright. Instead, it adopted its own categorical rule that “there is no ‘creative spark’ involved in a purely descriptive picture of a product.”71 The court emphasized that the photographs at issue were “purely utilitarian” in their depiction of the product and compared the product shots to the insufficiently creative arrangements of “names alphabetically in a whitespace directory.”72

The SHL Imaging, Inc. court, while rejecting a per se rule that all photographs were creative, went on to find the pictures of the mirrored frames to be adequately creative. Recognizing that creativity could be found in
Two years later, Coors Brewing was hoping to create an ad campaign targeting young black men. One advertising agency created a sample image for a billboard and “used a [cropped] version of the Garnett Photograph and superimposed on it the words ‘Iced Out’... and a picture of a can of Coors Light beer.” It used the photograph with permission. Once the billboard was approved, rather than license the photograph for further use, the agency hired a different photographer to recreate the idea of the Garnett photograph: namely, “the torso of a muscular black man, albeit a model other than Garnett, shot against a cloudy backdrop.”

Mannion sued, asserting that the copycat photograph infringed upon his copyright in the original. In denying summary judgment to both the defendant and the plaintiff, the court undertook an extended discussion of the originality of the photograph. But unlike the courts in SLAM Imaging, Inc., Oriental Art Printing, and Custom Dynamics, LLC, Judge Kaplan concluded that listing “potential components of a photograph’s originality” was “somewhat unsatisfactory.”

The problem, he explained, was that “courts have not always distinguished between [1] decisions that a photographer makes in creating a photograph and [2] the originality of the final product.” As Judge Kaplan put it, “[d]ecisions about film, camera, and lens, for example, often bear on whether an image is original,” but “that a photographer made such choices does not alone make the [resulting] image original.” That must be the case, he explained, because otherwise courts risk granting copyright protection based on the discredited sweat-of-the-brow doctrine. Rather, protection “derives from the features of the work itself, not the effort that goes into it.”

Pulling from a decision he had written years earlier, Judge Kaplan turned to UK law to create a more definitive test for creativity. Specifically, he borrowed a three-part test from a British copyright treatise, which contended that a photograph may be sufficiently creative in its (1) rendition, (2) timing, and/or (3) creation of the subject. Each, he noted, may support an argument that a photograph is creative.

On the first point, Judge Kaplan explained that the rendition of a photograph could be sufficiently creative to merit protection. By rendition, he meant those choices relating to “angle of [the] shot, light and shade, exposure, effects achieved by means of filters, developing techniques,” so long as they evinced in the photograph some degree of creativity.

Timing also could be the basis of creativity. Reaching back to the 1916 decision in Pagano, Judge Kaplan explained that it “undoubtedly requires originality to determine just when to take the photograph, so as to bring out the proper setting for both animate and inanimate objects.” In Pagano, after all, the photographer caught the “men and women in not merely lifelike, but artistic, positions.” A more modern example offered by the court was the Times Square photograph of a sailor kissing a woman on V.J. Day, “the memorability of which is attributable in significant part to the timing of its creation.”

Finally, on the third point, a photographer’s creation of the subject could be creative. As an example, Judge Kaplan used the “contrived scene of the photographer’s acquaintance... and his wife on a park bench with eight puppies on their laps” at issue in Rogers v. Koons. Because the author created the subject itself, protection would extend to “attempt[s] to replicate precisely... the content of the photograph.” Turning back to the Garnett photograph, Judge Kaplan concluded that there “can be no serious dispute that it was an original work.”

The rendition in the purposeful use of an “unusual angle” and “distinctive lighting” strengthened “the photograph’s originality.” Moreover, Mannion’s orchestration of the scene—the entire scene: the plain clothes, the hands folded across the waist, the jewelry—added to the originality in the creation of the subject.

The existence of a copyright isn’t determined based on whether a Napoleon Sarony or a Jonathan Mannion or a Justin Goldman took a photograph. Copyright does not distinguish between the professional
and the amateur, or between high art and low art. But, as Judge Kaplan explained, creativity is determined by the degree of the effect that choices as to rendition, timing, and the creation of the subject have in a photograph. For that reason, even professional photographers may create garden variety photographs that are not copyrightable—no matter how much work they put in before they click the shutter. And if even professional photographers can fail to clear this hurdle, so too can Justin Goldman.

The Goldman Photograph Isn’t Copyrightable
Goldman’s photograph isn’t original. Although his registration provides prima facie evidence of originality, discovery will no doubt reveal what choices Goldman made when he took the photograph.39 If Goldman cannot explain how those choices are sufficiently original—and for the reasons set out below it seems unlikely he will—then the defendants may be able to show a lack of what Barron-Giles called those requisite “facts of originality, of intellectual production, of thought, and conception on the part of the author.”96

As an initial matter, Goldman did not create the subject of the photograph, and, thus, his photograph cannot be protected on those grounds. Unlike Sarony, who painstakingly posed Wilde against an arranged background, Goldman simply “noticed Tom Brady, Danny Ainge, and others on the street” and “took a photograph of them.” That is not enough to claim protection for the subject itself. As the First Circuit explained, “Where the photographer is uninvolved in creating his subject, that subject matter—whether a person, a building, a landscape or something else—is equivalent to an idea that the law insists be freely available to everyone.”97

Goldman’s photograph also lacks any meaningful rendition. While it’s currently impossible to know what Goldman will ultimately claim his intentions were when taking the photograph, we can make some educated guesses.98 Goldman likely noticed Brady, as he has said, then passed him on the sidewalk and took the photograph on his smartphone, equipped with point-and-shoot functionality. In other words, it seems unlikely that Goldman put any thought at all into the rendition of the photograph, equipped with a smartphone camera that automatically made all sorts of decisions that Sarony had to perfect.

Goldman also did not control shadows. The photograph was taken outside in the sun. In fact, the only aspect of rendition that is anywhere detectible in the photograph is the angle. Apparently when Goldman took the photograph, he did so at an angle because he didn’t want Brady seeing him take the photograph. But that angle isn’t the product of a creative choice, it’s the unremarkable byproduct of a utilitarian one that copyright does not protect. In sum, his rendition is far less than that at issue in Oriental Arts, Inc., where the court found creativity lacking, and far, far less than at issue in SHL Imaging, Inc., where the court found sufficient creativity.

Timing is also a problem for Goldman. While Judge Kaplan characterized timing as “being at the right place at the right time,” the timing must be something more than just that pithy phrase. As David Nimmer observed, “it would seem that intent is a necessary element of the act of authorship.”99 Timing alone thus cannot be an element of authorship and cannot be considered an aspect of originality, unless a photographer puts it to use in some nontrivial way.100 Were it otherwise, creativity, through timing, would equate to happenstance and not any “intellectual production,” “thought,” or intent.101 Even Judge Kaplan, relying on the scene outside the New York Public Library in Pagano, recognized that timing was not protectable simply because the photograph was taken at that time but because of the effect that the timing was put to use by Pagano, i.e., to capture the “artistic[] positions” of the pedestrians.102

The kiss on V.J. Day example raised by Judge Kaplan proves the point. Alfred Eisenstaedt’s photograph wouldn’t be protectable simply because he was at the right place at the right time. It’s protectable because he used timing to his advantage to gain a particular effect in the photograph. As he described it, “I was walking through the crowds on V-J Day, looking for pictures. I noticed a sailor coming my way. He was grabbing every female he could find and kissing them all—young girls and old ladies alike.”103 At that point, he explained, “I noticed the nurse, standing in that enormous crowd. I focused on her, and just as I’d hoped, the sailor came along, grabbed the nurse, and bent down to kiss her.”104 And then he took the picture.

In Goldman’s case, it doesn’t appear that he made any use of timing like that. Goldman offered nothing in his pleading or in his summary judgment declaration regarding how he used time except in the most basic sense: Both he and Brady were in the same town around 2:30 p.m. one day and he took a photo. But if that alone is enough, if timing is sufficiently creative in the broadest sense, then any photograph would be protectable because it was taken at a particular time.105 But as now-Judge Gorsuch cautioned, the Supreme Court’s jurisprudence makes clear that not all photographs are protectable.106

For all these reasons, Goldman’s photograph, taken as it was without regard to creation of the subject, rendition, and timing, is not copyrightable. It is, as Justice O’Connor explained, nothing more than an
amalgam of “bare historical facts” and in no way contains any “subjective descriptions and portraits” of those facts. Because it “lets the facts speak for themselves,” the photograph is not subject to copyright protection. Were there any doubt, one need look no further than the caption Goldman wrote for the photograph: “Celtics and Tom Brady roll thru to get Durant #Hamptons.” Goldman cared about sharing the fact that Brady was there; the photograph was proof of that fact, not a creative endeavor.  

The Age of the Ordinary Photograph

It’s estimated that more photographs are taken every two minutes than were taken in the entirety of the 1880s when Sarony took his photograph of Wilde. By 2020, there will be nearly 3 billion smartphone users walking around the world snapping photographs here and there. If 2017 is any indication, where it’s estimated that 1.2 trillion photographs were taken, the number of photographs by 2020 will trend toward 2 trillion. Hundreds of millions more photographs are taken today than Hand could have ever imagined when he declared that no photograph will ever lack creativity. If we are not in the age of, as the Supreme Court put it, the “ordinary production of a photograph,” then it’s hard to know when we ever would be.  

Under Burrow-Giles, Feist, and Manimon, not all of these billions of photographs—taken without thought by smartphone users around the world—should be considered sufficiently creative to merit copyright protection. Goldman’s photograph is a perfect example. It’s “entirely typical,” “garden variety,” run-of-the-mill; it is nothing more than all of these things. In the end, over a hundred years of case law demonstrate that being so obviously ordinary is simply not enough for a copyright to attach. Reinvigorating the requirement of originality in an age of billions of photographs is important doctrinally, but it is doubly important in a world where copyright trolls have made a cottage industry out of alleged trifling infringements of everyday photographs. While many of the copyright trolls have limited their cases to photographs taken by professional photographers, there is no reason to believe that the next wave won’t be photographs taken by random people, on the street, with their smartphones (especially because it’s already begun). But whether professional or not, it is worth challenging plaintiffs on originality to stem the rising tide of vexatious infringement suits. I have little doubt that most photographs—even as the production of them has dramatically increased—will be found to be original even if defendants start fighting on this front. Courts have, historically, been afraid to distinguish between high art and low art. Yet, it should be defense lawyers’ mission to remind courts that creativity has nothing to do with distinguishing good art from bad art. Rather, it asks courts only to decide what photographs are “entirely typical” and what photographs are not. And line drawing, whether in negligence or copyright or any other area, is exactly what the law requires courts to do.  

Endnotes

3. Id.
6. Wilde apparently was unaware of the lawsuit, and a right of publicity wouldn’t be recognized in New York for twenty years. Upon learning of Sarony’s lawsuit, Wilde was incensed at Sarony, so much so that he worked it into The Canterfield Ghost, where he recounts a character “amusing himself by making satirical remarks on the large Saroni photographs.” OSCAR WILDE, THE CANTERFIELD GHOST (1887); see also FRIEDMAN, supra note 2.
9. Id. at 56.
10. Id. at 59 (emphasis added).
11. Id.
12. Id. at 59–60 (emphasis added).
15. Id.
16. Id. at 58.
17. Id. at 59–60.
22. Bleistein, 188 U.S. at 250.
23. Id. at 249–50.
24. Id. at 250.
27. Id.
28. Id. at 252.
29. Id. at 250.
30. See Bracha, supra note 25; see also Craig Joyce & Tyler T. Ochoa, Reach out and Touch Someone: Reflections on the 25th Anniversary of Feist Publications, Inc. v. Rural Telephone Service Co., 54 Hous. L. Rev. 257, 270 (2016–2017) (“Bleistein was widely interpreted as lowering the standard of originality that had been established in the late 18th-century cases.”).
31. 274 F. 932, 934 (S.D.N.Y. 1921).
33. 293 F. Supp. 130 (S.D.N.Y. 1968); see also Cleland v. Thayer, 121 F. 71 (8th Cir. 1903) (noting, in light of Bleistein, that the photographs at issue were copyrightable without considering creativity).
34. The court in Time Inc. characterized Judge Hand as recognizing that Bleistein “held” that “no photograph” was unoriginal. But, of course, Bleistein wasn’t a case about photographs.
35. Other courts similarly noted the per se rule, but nevertheless went on to say why the work in question was creative. See, e.g., Vitaphone Corp. v. Hutchinson
Amusement Co., 28 F. Supp. 526, 528 (D. Mass. 1939) (“[T]hese pictures were ‘shorts’ and the subjects were comedy, but they had a story, not of great intellectual value, to be sure, but it must be admitted they showed originality.”).

36. 234 F. 963 (S.D.N.Y. 1916); see also Gross v. Seligman, 212 F. 930, 931 (2d Cir. 1914) (discussing “exercise of artistic talent” as evidenced by “pose, light, and shade, etc.”).

37. L.A. News Serv. v. Tullo, 973 F.2d 791, 794 (9th Cir. 1992) (citing 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT (NIMMER) § 2.08[E][1], at 2-126.3 (1992 ed.)).


39. Id. at 345.

40. Id.

41. Id.

42. Id.

43. Id. at 345–46.

44. Id. at 347–48.

45. Id. at 346 (quoting Trade-Mark Cases, 100 U.S. 82, 94 (1879)).

46. Id. at 347.

47. Id.

48. Id. at 348.

49. Id.

50. Id. (emphasis added).


52. Id. at 349.

53. Id. at 350.

54. Id. at 362.

55. Id.

56. Id.

57. Id. at 359 (citing Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 251 (1903)).

58. See Joyce & Ochoa, supra note 30, at 308.

59. Meshwerks, Inc. v. Toyota Motor Sales USA, Inc., 528 F.3d 1258, 1263 n.5 (10th Cir. 2008). But see Ets-Hokin v. Skyu Spirits, Inc., 225 F.3d 1068, 1076 (9th Cir. 2000) (endorsing, despite Feist, Judge Hand’s admonition that all photographs are necessarily creative) and Morris v. Young, 925 F. Supp. 2d 1078 (C.D. Cal. 2013) (seeming to assume sufficient originality in a photograph), where Bleistein haunts copyright law like a zombie.

60. 117 F. Supp. 2d 301, 309 (S.D.N.Y. 2000).

61. Id. at 308.

62. Id.

63. Id. at 309.

64. Id.


66. Id. at 546.

67. Id. at 547.

68. Id.

69. Id. Although the court discussed the “purpose” of the photograph as utilitarian, Bleistein held that purpose (at least commercial purpose) was irrelevant to the originality inquiry. See Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 251 (1903). Nevertheless, it’s better to understand the court’s utilitarian point as a proxy for the lack of the hallmark of creativity courts normally look for like angle, light, shadow, etc. See ORIENTAL ART PRINTING, INC., 175 F. Supp. 2d at 547–48 (comparing the utilitarian nature of the photograph to those in cases like Burrow-Giles and Pagan and their discussions of creative choices made by the photographer). As the Copyright Office has explained, “The Office may register a photograph of food if the photographer exercised some minimal level of creativity in taking the picture.” See Compendium of U.S. Copyright Office Practices § 312.1 (2017) (emphasis added).


71. Id. at 549.

72. Id. (“there is no ‘creative spark’ involved in a purely descriptive picture of a product”).


74. Id.


77. Id. at 447.

78. Id. at 447–48.

79. Id. at 448.

80. Id. at 451.

81. Id.

82. Id.

83. Id.

84. Id. at 451–52 (citing Bridgeman Art Library, Ltd. v. Corel Corp., 36 F. Supp. 2d 191 (S.D.N.Y. 1999)).

85. Id. at 452–54 (citing HUGH LADDIE ET AL., THE MODERN LAW OF COPYRIGHT AND DESIGNS (3d ed. Butterworths 2000)).

86. Id. at 452.

87. Id. at 452–53.

88. Id. at 453.

89. Id.

90. Id. (citing Rogers v. Koons, 60 F.2d 301 (2d Cir. 1992)).

91. Id. at 454.

92. Id. at 454–55.

93. Id.

94. Id. at 455.


98. Watts v. Indiana, 338 U.S. 49, 52 (1949) (courts “should not be ignorant as judges of what [they] know as men [and women]”).


100. Cf. Trade-Mark Cases, 100 U.S. 82, 94 (1879) (explaining that, unlike trademarks, the creativity requirement of copyright demands some “work of the brain”).

101. Alan R. Durham, The Random Muse: Authorship and Indeterminacy, 44 WM. & MARY L. REV. 569, 574 (2002) (“Wholly indeterminate works have been held uncopyrightable because some cognitive component essential to an original work of authorship is missing: mental effort, intention, personality, or meaning.” (emphasis added)).

102. This understanding of timing is in line with Judge Kaplan’s understanding of rendition. See Mannion v. Coors Brewing Co., 377 F. Supp. 2d 444, 452 (S.D.N.Y. 2005) (“Again, what made the photographs original was not the lens and filter selection themselves. It was the effect produced by the lens and filters selected, among other things.” (emphasis added)).


104. Id.

105. That timing requires something more than serendipity does not destroy
protection for photographs of breaking news events. Breaking news photography may still be protected as a result of a photographer’s use of timing. It’s just that their use of timing must be more than I was in the right place at the right time. Raising the Flag at Ground Zero isn’t creative simply because Thomas Franklin was in the right place at the right time. It is creative because he captured the precise moment that each firefighter looked up toward the flag while hoisting it—a moment in time that Franklin said had the effect of symbolizing “patriotic solidarity.” You probably don’t remember the other photographs he took in the same burst because the timing didn’t have the same effect. See Remembering 9/11 with Thomas E. Franklin, YOUTUBE (Aug. 3, 2017), https://www.youtube.com/watch?v=XAINtlaAgDc. Moreover, breaking news photographs also may be protectable on the grounds of the photographer’s chosen rendition. See, e.g., Harney v. Sony Pictures Television, Inc., 704 F.3d 173, 182 (1st Cir. 2013) (explaining the protectable elements of “news photography, which seeks to accurately document people and events”).

106. Meshwerks, Inc. v. Toyota Motor Sales USA, Inc., 528 F.3d 1258, 1263 n.5 (10th Cir. 2008).


110. Otto v. Hearst Comm’ns, Inc., No. 17-cv-4712 (Dec. 10, 2018) (copyright suit over photographer of Donald Trump brought by a Vice President at Deutsche Bank who “self-described as just a ‘guy with an iPhone’ who “is not and has never been a professional photographer”).