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The Photograph That Broke the Internet Isn't Copyrightable

BY MATTHEW L. SCHAFER

"The shot must be made by a sharp-shooter, for the game cannot be bagged by a careless sportsman."

— Napoleon Sarony

Napoleon Sarony and Justin Goldman have one thing in common: They were both copyright plaintiffs. Goldman is the plaintiff in an ongoing lawsuit against news organizations for reproducing a smartphone snapshot of Tom Brady. Sarony was a world-famous photographer who took his lawsuit over a picture of Oscar Wilde all the way to the Supreme Court.

But that's where the similarities end.

Sarony cared deeply about photography. In the early 1880s, the process was creatively laborious. He had to pose his famous subjects just right (with a self-invented metal apparatus to keep the subject still), stage the foreground and background, and coax the desired expression. The result was the carefully curated picture like the one that formed the basis of the Supreme Court case *Burrow-Giles Lithographic Co. v. Sarony*.

As the 19th century crept to a close, Sarony exploited a new kind of photograph: the snapshot. The snapshot was looser; it was meant to show the subject in the moment, unaware of the camera (which they nevertheless were posing in front of). The snapshot was an artistic exercise—maybe more so than his staged photos.

For Sarony, photographers had to follow three rules to capture a successful snapshot.¹ First, the photographer needed to be "an acquaintance with the habits and life of the subject." Second, the subject had to be confident enough to "surrender" himself to the photographer. Third, they had to be able to work together.

Contrast that with the hundreds of millions of snapshots produced by the smartphone-carrying public today—distant cousins of Sarony's art, if related at all.

In the summer of 2016, one of those millions was taken by Justin Goldman when he noticed New England Patriots QB Tom Brady and Celtics GM Danny Ainge on the street in East Hampton. He snapped a photograph of them and posted it to his Snapchat account. Although the sighting created substantial buzz in the sports world as evidence that Brady was brought in to convince Kevin Durant to play for the Celtics, the photograph itself was unremarkable. It did nothing but reproduce exactly what was in front Goldman. There was no framing; he didn't manipulate any light or shadow. It appears he pointed his smartphone and pressed a digital shutter button. The only defining characteristic of the photograph is that it was taken on an angle. But even the angle appears incidental: it appears that Goldman

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Change Creates Opportunity for Forum Members

BY DAVE GILES

Looking to add value, increase membership, maintain relevancy, and distinguish itself from the multitude of websites providing legal information, the American Bar Association adopted a new membership model at the annual meeting in Chicago last August, which creates opportunities for any enterprising media and communications lawyer.

The new membership model streamlines dues rates and increases benefits for members.

The restructuring is positive news for the Forum on Communications Law, as a growth in overall membership will logically result in new Forum members, and the emphasis on added membership benefits will provide more opportunities for Forum members to publish, present, and network.

Some of the numbers provide a stark glimpse at the current state. Forty years ago, approximately 50 percent of the lawyers in the United States were members of the ABA. That number currently stands at less than 22 percent. While the number of lawyers has increased in those four decades, the smaller market share has had an impact on the organization's influence. Dues-paying attorney members—those who pay the highest dues—have declined over the last few years.

For example, earlier this year, the ABA reported that its operating budget has declined over the past five years, from \$116 million in 2014 to



David Giles

\$96.1 million in fiscal year 2018. That number is projected to drop again by more than \$5 million for fiscal year 2019 to \$90.8 million.

Theories for the precipitous declines in dues rates and revenue run the gamut—from technological innovation and new ways of networking through social media to law firm consolidation

and tightening budgets due to global financial challenges.

To reverse this decline, the ABA plans to roll out the new membership model in May 2019. The model includes a new paywall strategy, added benefits and resources, promises of improved member experience, and a reduction in the dues categories from 157 to five. Further reductions in the fee ranges from \$75 for paralegals to \$450 for those with 20 or more years of experience (depending on what type of work members do, length of service, and other considerations) hope to make the ABA an attractive partner for the future.

The final two parts of the new model are where the opportunities are greatest for Forum members to promote themselves, their firms, and their ideas. First, the ABA is seeking a more robust continuing legal education program.

The goal of the CLE program is to centralize online and on-demand options, providing more than 650 programs for free to members on a wide range of topics. The Forum is set up to provide substantive content for this effort that provides a high-profile platform for members willing to contribute time, brainpower, and ideas. Moving forward, the Forum will be required to provide two online CLE programs each year. The Forum's Webinar Committee is already off to a good start on

this. In early October, it produced a thoughtful and interesting hour-long discussion titled "What News Organizations Need to Know About Protecting Journalists from Harassment," which focused on providing practical advice members can use to advise their newsgathering clients about how to keep them safe on the job, which as recent events in Maryland and elsewhere have demonstrated, is no small task. Members who have ideas for other webinars should raise their hands, so we can promote your ideas.

Second, the ABA is planning a more effective way to curate content. It began this initiative by launching a new website in October. Despite some early troubles with the site, once the kinks are fixed, the new website should improve users' experience, facilitate communication, and showcase the work of ABA members.

As the ABA puts it, curated content is intended to be strategic and free sharing content created by its members in a variety of formats—from traditional articles, digests, and synopses—to slide decks, webinars, video, and podcasts. The ABA intends content to be tailored to a person's individual interests.

The Forum has an obligation to

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contribute two pieces of curated content every year, but there's no harm in creating more. The Forum has several outlets through which members can promote their work, including the *Communications Lawyer*, Young Lawyers newsletter, Women in Communications Law newsletter; or a webinar. With the ABA's plan to raise the profile of the work of the various divisions, forums, and sections, opportunities abound for Forum members.

As part of the new platform content curation, the ABA also launched ABA Connect—a Facebook-like platform for connecting, networking, and distributing content. ABA Connect will allow Forum members to communicate and share information in closed or open groups. We will demonstrate ABA Connect during the Forum's Annual Conference.

The steps the ABA is proposing seem to be a realistic effort to boost membership and put a focus on the work product of all of its members.

And, while Forum membership has trended down in past years, at present things for the Forum are looking up. The hard work of the Forum's Membership Committee has our recent membership numbers on the upswing. Likewise, the Sponsorship Committee has signed up a record number of sponsors, whose contributions support to the Annual Conference in Miami, the Data Privacy Symposium in Washington, DC, and the "Representing Your Local Broadcaster" conference in Las Vegas.

With that in mind, as we embark upon the 24th Annual Conference, I would like to individually thank each of the law firms, insurance companies and media companies who believe in the Forum and what it represents. Passport sponsors contributed \$9,000 each to this year's Forum activities. Conference sponsors contributed \$5,000 to the annual conference. Other sponsors contributed between \$1,500 and \$3,500 to the "Representing Your Local Broadcaster" conference, Women in Communications Law, the Media Advocacy Workshop, and the Diversity Moot Court Competition.

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Talking Points for Your Next Conversation at the Coffee Machine

Don't let your colleagues miss out on all the benefits of belonging to the Forum on Communications Law. Take the next step and tell them why they should join the ABA and the Forum:

- **Sharpen your expertise** with discounted specialty CLE (information about a March 15 webinar appears on page 27) and subscriptions to the widely respected *Communications Lawyer* and the *Journal on International Media and Entertainment Law*.
- **Connect with colleagues** and amplify your voice through specialty committees, conferences, online discussions, and more.
- **Grow your professional profile** through highly visible opportunities to speak and publish on your area of practice. The Forum offers a great opportunity to market yourself to potential clients.

Encourage your colleagues to join now by calling 800-285-2221 or going to www.ambar.org/join.

Morality Clauses in the Age of #MeToo and Time's Up

BY DAVID E. FINK AND SARAH E. DIAMOND

When news of Harvey Weinstein's misconduct broke in October 2017, the entertainment industry and many others were forever impacted. It quickly became apparent that the scope of the problem was much broader than one individual. As additional instances of misconduct by other high-profile figures were revealed (and continue to surface), the American public began to pay close attention to what had previously been a hidden problem. Immediate economic repercussions were felt by those who had invested in projects tarnished by misconduct, and the need for change was clear.

The #MeToo and Time's Up movements are playing an important role in forcing a number of industries, including Hollywood, to address inappropriate conduct. Film studios, networks, and producers have reconsidered the use of morals clauses (or morality clauses). Morality clauses are contractual provisions that give entertainment and media employers—e.g., motion picture studios, television networks, producers, news media providers, advertisers, sports leagues, etc.—the right to terminate contracts if the talent behaves in a way that negatively impacts his or her public image and devalues the services to be provided under the contract. A sample morality clause in an actor talent agreement may read as follows:

Artist shall act at all times with due regard to public morals, conventions, and Studio policies.

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If Artist shall have committed or does commit any act, or if Artist shall have conducted or does conduct himself in a manner, which shall be an offense involving moral turpitude under federal, state, or local laws, or which might tend to bring Artist to public disrepute, contempt, scandal, or ridicule, or which may embarrass, offend, insult, or denigrate individuals or groups, or that may shock, insult, or offend the community or Studio workforce or public morals or decency or prejudice Studio, or which results in or is likely to result in actual or threatened claims against Studio, or which otherwise might tend to reflect unfavorably upon Studio, Studio shall have the right to terminate this Agreement upon notice to Artist given at any time following the date on which the commission of such act, or such conduct, shall have become known to Studio.

Originally introduced by Universal Pictures in 1921, the prevalence of morality clauses in talent agreements declined in the decades after their use during the 1950s McCarthy era. Today, however, following a slew of canceled film releases, film projects, television series, and comedy specials, some companies have revisited the use of morals clauses in talent agreements as a means to protect their investments.

The Origin of Morality Clauses

In 1921, Universal Pictures first introduced morality clauses after the public outcry following the arrest and widely publicized trials of silent film actor Roscoe "Fatty" Arbuckle. Arbuckle was among

the most popular, and most highly compensated, silent film stars of the 1910s. In the summer of 1921, Arbuckle signed a three-year contract with Paramount Pictures for \$1 million a year (estimated to be worth over \$42 million today) to star in eighteen silent films. Arbuckle had just completed his starring role in a comedy called *Leap Year*, which was set for commercial release.¹ Over Labor Day weekend, Arbuckle traveled to San Francisco, checking into a suite at the St. Francis Hotel. During the gin party that ensued (during Prohibition), an actress named Virginia Rappé was found severely injured in Arbuckle's suite. Rappé later died, and Arbuckle was arrested on rape and murder charges. His arrest received considerable attention and was widely reported. Though Arbuckle was acquitted after three trials and was even issued an unprecedented statement of apology from the jury, the scandal marked the end of Arbuckle's career. Public opinion had turned against the once beloved actor. The newly formed Motion Picture Producers and Distributors of America—the organization that later became the Motion Picture Association of America—banned Arbuckle from appearing in films. Though the Association lifted the ban eight months later, Arbuckle's career was over. *Leap Year* was never released, and Paramount presumably lost a substantial investment.

In response to the public disenchantment with Arbuckle and a growing concern about Hollywood scandals, the Universal Film Company announced that it would include clauses in all its talent agreements "permitting the company to discontinue their salaries if

they forfeit the respect of the public.”²² The announcement noted that though “[i]t may have a restraining influence on some thoughtless or willful actors; it will reassure the public, who for the moment may be inclined to fear that all their screen idols have feet of clay, and it will protect the company in an investment, often of hundreds of thousands of dollars.”²³ Other studios followed suit, and morality clauses became a standard term in talent agreements for decades.

Morality Clauses and McCarthyism

During the 1940s and 1950s, several studios used morality clauses to terminate talent contracts based on politics. Morality clauses were used to dismiss the so-called Hollywood Ten, a group of ten actors and screenwriters who were jailed and blacklisted by movie studios for publicly denouncing the activities of the House Committee on Un-American Activities (HUAC) during its investigation of Communist influence in Hollywood. In a series of controversial decisions, the Ninth Circuit Court of Appeals upheld the dismissals under the morality clauses. In one case, *Loew’s, Inc. v. Cole*, the Court held that “because, even in 1947, a large segment of the public did look upon Communism and Communists as things of evil,” by failing to assist the HUAC, the screenwriter breached his agreement to “not do or commit any act or thing that will tend to degrade him in society or bring him into public hatred, contempt, scorn or ridicule, or that will tend to shock, insult or offend the community or ridicule public morals or decency, or prejudice the producer or the motion picture, theatrical or radio industry in general.”²⁴ The Ninth Circuit reached similar conclusions in *Twentieth Century-Fox Film Corp. v. Lardner and Scott v. RKO Radio Pictures, Inc.*⁵

In the decades that followed, the prevalence of morality clauses in film and television contracts started to decline. While such clauses remained common in celebrity endorsement agreements, morals clauses were criticized by some for their vagueness and fell out of favor.

The DGA and WGA Prohibition on Morality Clauses

Both the Director’s Guild of America (DGA) and the Writer’s Guild of America (WGA) have banned morals clauses in guild member agreements for decades. The DGA Basic Agreement states: “Employer agrees that it shall not include or enforce any so-called ‘morals clause,’ as the term is commonly understood in the motion picture and television industries, in any contract of employment or deal memo for the services of an employee.”²⁶ Similarly, the WGA Basic Agreement states: “Company agrees that it will not include the so-called ‘morals clause’ in any writer’s employment agreement covered by this Basic Agreement.”²⁷ The guilds take the position that, once hired, directors and writers are entitled to the protections of their member agreements, and among the most important of these rights is the right to screen credit.

The Screen Actors Guild–American Federation of Radio and Television Artists (SAG-AFTRA) does not contain a similar prohibition. Morality clauses, however, are often stricken or significantly limited in the course of talent negotiations, especially when celebrity talent can exercise leverage in the negotiations.

Morality Clauses in the Age of #MeToo and Times’ Up

Today, in the age of the #MeToo and Times’ Up movements, morality clauses in talent agreements are making a comeback based, at least in part, on the substantial financial impact on a project when public opinion turns against a project’s star or key executives. Recent events involving actor Kevin Spacey are a case in point.

After multiple reports surfaced that Kevin Spacey engaged in sexual misconduct, studios canceled a number of his pending film and television projects. Imperative Entertainment, the financier of Ridley Scott’s *All the Money in the World*, spent \$10 million to reshoot Spacey’s scenes with Christopher Plummer and save the film in time for its holiday release. Separately,

Netflix immediately severed its relationship with Spacey, reportedly losing tens of millions of dollars by shutting down production on *House of Cards* and scrapping its Spacey-driven Gore Vidal biopic, which was already in post-production. Because Spacey did not have a morality clause in his contracts, he was reportedly paid for the entire final season of *House of Cards* and for *All the Money in the World*. In January 2018, Netflix announced that it took a “\$39m non-cash charge in Q4 for unreleased content [it] decided not to move forward with.”²⁸ Netflix CFO David B. Wells confirmed in its Q4 earnings call that the “write-downs” were “related to the societal reset around sexual harassment.”²⁹

Following the cancelations of the Netflix productions, on August 17, 2018, Vertical Entertainment released *Billionaire Boys Club*, one of the last movies Spacey filmed before the reports concerning his sexual misconduct were made public. In deciding to release the film, Vertical Entertainment stated: “We hope these distressing allegations pertaining to one person’s behavior—that were not publicly known when the film was made almost 2.5 years ago and from someone who has a small, supporting role in *Billionaire Boys Club*—does not tarnish the release of the film.”³⁰ However, the film—with a budget approximated at \$15 million—had a box office of only \$1.5 million, earning only \$126 on its opening day.³¹

Indeed, this is the very scenario Universal Pictures sought to avoid when it first announced the use of morality clauses in September 1921:

As contracts are drawn today, a company seems to be liable not only to continue to pay the salary of an actor or actress who forfeits the respect of the public, but has to bear the obloquy of still having them in its employ. Pictures on the market or unreleased and unreleasable are sufficient penalty to pay for an infraction of the moral law by an employee in whose good name millions may be tied up and over whose

moral conduct the company has no control whatever.¹²

Striking a Balance

Those who oppose the use of morality clauses worry that they can be drafted too broadly and are subject to abuse. This criticism is supported, in part, by the politicized history of morality clauses in the 1940s and 1950s. Even today, those representing talent argue that morality clauses, particularly those that are broad or ambiguous, may create pretext for termination of contracts based on other factors. There is also concern that morality clauses can be unfair to talent because anyone can invent an accusation, or make a public statement that is not necessarily true.

Despite these concerns, the ambiguities highlighted by opponents of morality clauses can be negotiated to tailor these clauses more precisely and address each parties' concerns. *First*, the incentive to avoid deliberately destroying a project provides a check against an unwarranted termination of a talent agreement pursuant to a morality clause. *Second*, morality clauses can be negotiated to be as specific as possible. For instance, the parties can negotiate the applicability of a particular morality clause, asking questions such as whether it is triggered by a criminal conviction or just an allegation of criminal misconduct, whether certain topics posted on social media constitute a per se violation, or whether reports of misconduct by certain publications (e.g., *The New York Times*) constitute a violation but not others (e.g., tabloids). *Finally*, if the prevalence of morality clauses in talent agreements continues, the terms of morality clauses will become more standardized. Only time will reveal whether the use of these clauses will continue or will fall out of favor once again. ■

Endnotes

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The Legislative Response to a Perceived “Free Speech Crisis” on Campus

BY FRANK D. LO MONTE

Amid national outcry over a perceived erosion of support for freedom of expression on America’s college campuses,¹ state legislators are responding with a flurry of “campus free speech” proposals. Inspired in part by a model proposed by the nonprofit Goldwater Foundation, ten states have enacted statutes since 2016 that restrict colleges’ ability to curtail speech. Some of these enactments, however, have been criticized as overreactions, “solutions in search of a problem” capitalizing on an overblown handful of clashes.²

This article surveys recent legislative action addressing students’ right to speak and publish freely in the postsecondary-education setting, identifying where the first wave of “campus free speech” laws may be vulnerable to constitutional challenge. It concludes by identifying unsettled areas of student-speech law where, in the absence of guidance from the U.S. Supreme Court, state legislation may be needed to clarify speakers’ rights.

The Constitutional Backdrop

Constitutional rights apply only at state colleges and universities, not private ones, but 73 percent of all U.S. college students attend state institutions.

Whether the First Amendment applies with full force to college students’ interactions with their institutions is an unsettled question. The Supreme Court has never indicated that the robust prohibitions against content-related punishment of speech diminish when the speaker is a student and the regulator is a college. To the contrary, the Court has consistently protected the right to engage in provocative and even offensive speech on a college campus,³ which is regarded as “uniquely the

marketplace for ideas.”⁴

Confusion arises because student speech at K–12 institutions receives significantly less protection than speech in the adult, off-campus world. The Supreme Court recognized a half-way-measure level of protection in the landmark 1969 case of *Tinker v. Des Moines Independent Community School District*,⁵ involving a silent anti-war protest by students in an Iowa high school and middle school. There, the justices struck a compromise that enables schools to engage in otherwise-forbidden content-based regulation of speech if it can be shown that the speech portends “substantial disruption of or material interference with school activities.”⁶

The Supreme Court has never said that postsecondary students are limited to the rights recognized in *Tinker*. In the Court’s first college-speech case after *Tinker*, Justice Lewis Powell wrote, “the precedents of this Court leave no room for the view that, because of the acknowledged need for order, First Amendment protections should apply with less force on college campuses than in the community at large.”⁷ But in the absence of binding Supreme Court precedent, lower courts have regularly treated *Tinker* as the standard for content-based restrictions on student speech everywhere, even when the speaker and audience members are legal adults.⁸

A “Crisis” Declared

College campuses have long been places of tension over speech, mini-communities where people of diverse backgrounds are thrown together and expected to coexist in the confines of shared residential and working space. In 1992—a generation before the contemporary “crisis” declaration—a committee of the American Association of University Professors decried the imposition of “civility” codes that threatened students with punishment for speech perceived as racist, sexist, or

otherwise offensive:

[F]reedom of expression requires toleration of “ideas we hate,” as Justice Holmes put it. The underlying principle does not change because the demand is to silence a hateful speaker, or because it comes from within the academy. Free speech is not simply an aspect of the educational enterprise to be weighed against other desirable ends. It is the very precondition of the academic enterprise itself.⁹

If anything is “new” about the current campus climate, it is the ability of online news organizations and social media (and especially ideologically aligned media) to amplify and prolong episodes that once were locally contained, and the heightened focus of the national media on campus-based controversies. The appearance of white nationalist agitator Richard Spencer at the University of Florida in October 2017 led national newscasts, even though Spencer ended up drawing only about two dozen supporters to an auditorium otherwise populated by hecklers.¹⁰

A series of incidents in which polarizing conservative figures were interrupted or denied the ability to speak on college campuses led to national media coverage and a widespread perception that the First Amendment is under attack.¹¹ A proposed visit by right-wing provocateur Milo Yiannopoulos at the University of California–Berkeley sparked massive protests, leading the college to cancel and later reschedule the speech, citing safety concerns.¹² Author Charles Murray, whose writings have been criticized as stigmatizing racial minorities, was nearly shouted from the stage while speaking at a small liberal-arts college in Vermont, where protesters jumped on the car carrying him and delayed his departure until police intervened.¹³

As tensions escalated into confrontation over controversial speakers, stories were emerging at campuses across the country in which educators faced

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discipline, and at times removal, for speech deemed insensitive. A Northwestern University professor was the target of formal complaints that she created a hostile climate on campus for women, after she wrote a magazine article suggesting that the Title IX gender-discrimination process had been overused.¹⁴ A faculty member who worked as a “house parent” at Yale University was pressured to relinquish her position, and eventually left the university, after being mobbed by students infuriated by her memo suggesting that they resolve disagreements over offensive Halloween costumes informally rather than involving disciplinary authorities.¹⁵

The perceived upsurge in confrontations over speech deemed insensitive to minorities was given currency by national polls suggesting that students are prepared to sacrifice First Amendment freedoms to make campuses more inclusive. For instance, a Knight Foundation survey published in April 2016 found that 69 percent of students agreed colleges should have the authority to penalize speakers for “intentionally offensive” language, and 62 percent agreed colleges should be able to ban Halloween costumes that stereotype ethnic groups.¹⁶

The University of Chicago and its noted First Amendment scholar Geoffrey Stone attempted to arrive at some governing principles with a January 2015 faculty committee report reaffirming that “the University’s fundamental commitment is to the principle that debate or deliberation may not be suppressed because the ideas put forth are thought by some or even by most members of the University community to be offensive, unwise, immoral, or wrong-headed.”¹⁷ The Chicago Statement has since been adopted by nearly three dozen other universities across the country.¹⁸ In a letter to the incoming Class of 2020, Chicago’s dean of students served notice that the highly ranked private institution would not use its authority to heavily regulate offensive speech: “Our commitment to academic freedom means that we do not support so-called trigger warnings, we do not cancel invited speakers because their topics might prove controversial, and we do not condone the creation of intellectual ‘safe spaces’ where individuals can retreat from ideas

and perspectives at odds with their own.”¹⁹ The Chicago Statement and Dean John Ellison’s letter themselves provoked backlash; one student wrote to Ellison that she felt “belittled” by his dismissal of the value of trigger warnings for works of literature depicting rape or other traumatizing events.²⁰

The Legislative Response: Campus Free-Speech Statutes

States Take Diverging Approaches to Protecting Campus Speakers

Concern for protecting free expression on college campuses is not new, but it gained newfound urgency with the backlash against student disruptions of conservative speakers. As a result, legislators across the country began introducing bills to assure all speakers, including politically controversial ones, the opportunity to use campus property for expression. Since 2016, variations of such laws have passed in ten states: Arizona, Colorado, Florida, Georgia, Kentucky, Louisiana, North Carolina, Tennessee, Utah, and Virginia.²¹ Bills have been considered but not enacted elsewhere, including South Dakota and Wisconsin, where the measures have run into opposition from groups representing students, faculty, and civil libertarians.²² (Although the Wisconsin legislature has been unable to agree on the terms of a campus-speech bill, the University of Wisconsin system’s regents enacted their own policy that adopts aspects of the Goldwater model.²³)

One of the easiest and least-divisive of the reforms has been eliminating colleges’ practice of confining expressive activity to “free-speech zones,” which by implication declare the remaining campus off-limits to protests, leafleting, and other constitutionally protected speech. Free-speech zones have fared poorly when challenged in court because they often fail to provide speakers with a reasonable opportunity to reach their intended audience,²⁴ so outlawing them by statute probably does no more than ratify what is already the law.

Before the most recent wave of state legislation, Virginia and Missouri lawmakers directed colleges in their states to do away with designated speech zones and allow expression on any

public area of the campus.²⁵ Recent statutes in Arizona, Colorado, Florida, North Carolina, Tennessee, and Utah expressly direct colleges to cease reliance on “free-speech zones” and declare all public spaces to be “forums” for expression.²⁶ Designation as a “forum” carries decisive constitutional significance; once government property is categorized as a forum, content-based regulations are presumptively unconstitutional and, if challenged, must satisfy the strictest judicial review.²⁷

Beyond dispensing with free-speech zones, the terms of recent campus-speech enactments vary. The statutes in Arizona, Florida, Georgia, and North Carolina require an annual report to the legislature of all instances of disruption to legally protected expression on campus. Tennessee’s statute explicitly protects faculty against punishment for views expressed in class, so long as the speech is “reasonably germane” to the subject of the course and is otherwise constitutionally protected. The Kentucky and Louisiana statutes forbid colleges from withholding official recognition from student organizations that enforce adherence to their political or religious beliefs as a condition of membership—a response to the Supreme Court’s 2010 ruling in *Christian Legal Society v. Martinez*,²⁸ which held that a public university could deny the privileges of official recognition to a student organization that refused to admit members unwilling to pledge adherence to Christian religious precepts.

The Kentucky statute is unique because it applies at the K–12 as well as postsecondary level. The law protects students at all levels of public education against viewpoint-based discrimination for religious or political speech, including in-class expression. It also provides that political or religious views may not be a factor in selecting speakers for school events such as commencement ceremonies, and that schools may not make viewpoint-based changes to the remarks students prepare for those ceremonies.²⁹ Because the law gives student organizations at K–12 schools the right to enforce adherence to organizational doctrine as a condition of participation, it has

been criticized as giving effect to discrimination.³⁰

Mandatory-Discipline Laws May Invite Constitutional Challenge

No constitutional challenge to this recent wave of legislative enactments has yet emerged. But challenges are likely, under some combination of First Amendment and due process theories, if the statutes result in punitive action against students or faculty who engage in nonviolent forms of counter-expression (such as waving signs, booing, or standing up and turning their backs, all of which are common reactions to divisive speakers).

The Goldwater Institute template provides in part that higher-ed institutions should be required to enforce “a range of disciplinary sanctions for anyone under the jurisdiction of the institution who interferes with the free expression of others.”³¹ Making it a punishable offense to “interfere with” speech is itself a doubtfully constitutional restriction on expression. Because college students must necessarily have at least the *Tinker* level of First Amendment protection (if not more), they cannot be disciplined for expressive activity unless it crosses the line of a “substantial” or “material” disruption to school functions.³² As proposed, the Goldwater legislation does not require that the “interference” be more than fleeting and immaterial, and does not even require that the interference be intentional or knowing. It takes little imagination to come up with innocent forms of “interference” that could be swept within the ambit of such a prohibition; a loud coughing fit in an auditorium might qualify, or monopolizing the microphone with an overly verbose question that consumes the Q-and-A period before every questioner can be heard. Because “interference” has no consensus legal definition, its vagueness could itself chill a speaker from attempting legitimate forms of expression.³³

Thus far, states have largely avoided the apparent constitutional infirmity of the Goldwater model by couching the requirement of disciplinary sanctions in more guarded

terms. North Carolina, which most closely resembles the Goldwater template, deviated slightly by specifying that universities must discipline “anyone under the jurisdiction of a constituent institution who *substantially disrupts* the functioning of the constituent institution or *substantially* interferes with the protected free expression rights of others.”³⁴ Similarly, Wisconsin’s new regulation provides that a one-semester suspension will be mandatory upon a student’s second offense of “materially and substantially” disrupting speech on campus.³⁵

Other states have similarly couched the requirement of disciplinary sanctions to encompass speech unprotected by *Tinker* or have dispensed with making disciplinary sanctions compulsory. For instance, the Florida version states, without using the term “interfere” and without reference to penalties: “Students, faculty, or staff of a public institution of higher education may not materially disrupt previously scheduled or reserved activities on campus occurring at the same time.”³⁶ Georgia’s newly enacted variant provides that a college must impose discipline if a student or employee’s conduct “interfered with the board of regents’ regulations and policies relevant to free speech and expression,” so that the “interference” refers to the policy rather than to the speaker. It is unclear whether this will prove to be a meaningful distinction.³⁷

Even with accommodations to soften the threat of punitive action, these statutes remain controversial, including among organizations that normally support free-expression rights. The PEN America Foundation issued a report in November 2017 questioning the need for any legislative fix beyond abolishing free-speech zones.³⁸ The report cautioned that “mechanisms for oversight of the implementation of these laws are subject to politicization and polarization, posing the risk that decisions on the permissible scope of campus speech may be colored by viewpoint-specific concerns.”³⁹

Constitutional challenges by those disciplined for disrupting campus speech are inevitable. Their success will depend on how carefully colleges

craft their regulations to incorporate recognized constitutional standards, including the requirement to provide due process to both students and employees before imposing discipline.

Conclusion

The Supreme Court has been highly protective of the “marketplace for ideas” on college campuses. But lower courts have been less predictable. College journalists cannot count on judicial recourse when they are censored by their institutions because of the growing acceptance of the *Hazelwood* standard in higher education. And when students are disciplined for offensive or controversial speech, they cannot reliably expect the courts to vindicate their rights. Over the past decade, courts have become exceedingly deferential to colleges’ adjudication of disciplinary cases, even when students are punished for speech that would be beyond governmental regulation in the off-campus world. For example:

- In *Tatro v. University of Minnesota*,⁴⁰ mortuary-sciences student Amanda Tatro challenged disciplinary action imposed for posts made off-campus on a personal Facebook page, where she engaged in dark humor about the cadaver she was assigned to dissect. In affirming the dismissal of Tatro’s First Amendment claims, the state supreme court acknowledged that the speech was nondisruptive and otherwise constitutionally protected but fashioned a newfound First Amendment exemption for speech contrary to “established professional conduct standards,”⁴¹ an exception never before recognized. (Tatro died of a chronic illness before her counsel could seek U.S. Supreme Court review.)
- Relying in part on *Tatro*, the federal Eighth Circuit upheld disciplinary action against Craig Keefe, who was summarily dismissed without process from the nursing program at a two-year college in Minnesota because he used a personal

Facebook page to vent about his frustrations with his classmates and his perception that the college engaged in gender discrimination.⁴² Central Lakes College insisted that Keefe's removal was an unreviewable academic decision, not a disciplinary decision to which due-process rights adhere, because the nursing school decided his speech was "unprofessional" and rendered him academically unsuitable for a nursing career. The federal courts agreed. Keefe petitioned the Supreme Court to review the circuit's 2-1 decision, but the Court declined certiorari.⁴³

- A federal district court in Alabama applied the *Hazelwood* doctrine (birthed in a high-school newsroom) to dismiss constitutional claims brought by a graduate student in her 50s, who claimed she was issued retaliatory disciplinary write-ups for complaining about inequities in her college's grading and disciplinary systems. The court found that, because the complaints were about an academic matter, they were governed by *Hazelwood*, which applies when a student uses a curricular vehicle (such as a newspaper or yearbook) to convey her speech.⁴⁴

In the current climate of unquestioning judicial deference to educational institutions, advocates predictably have turned for relief to state legislatures. While this first wave of legislation takes aim at a subset of the most-publicized points of contention over campus speech—the dis-invitation or disruption of speakers with extreme views—significant challenges remain. The pressure on colleges to censor disagreeable speech, both by offended listeners and self-generated by colleges' own determination to project a favorable public image, is intensifying. With that intensification will come more line-drawing debates, until the Supreme Court, Congress, or state legislatures erect clear boundaries cabining the authority of colleges to enforce image-motivated restrictions on speech. ■

Endnotes

1. Conservative commentators regularly inveigh against a culture of "political correctness" enforced on college campuses through such devices as "trigger warnings" to inform students that they are about to encounter potentially troubling subject matter. *See, e.g.*, David French, *A New Campus Survey Reveals Just How Students Are "Unlearning Liberty,"* NAT'L REV. (Mar. 13, 2018), <https://www.nationalreview.com/2018/03/a-new-campus-survey-reveals-just-how-students-are-unlearning-liberty/>; Kathleen Parker, *Trigger Warnings, Colleges, and the "Swaddled Generation,"* WASH. POST, May 19, 2015.

2. *See, e.g.*, Aaron Hanlon, *Are Liberal College Students Creating a Free Speech Crisis? Not According to Data,* NBCNEWS.COM, Mar. 22, 2018), <https://www.nbcnews.com/think/opinion/are-liberal-college-students-creating-free-speech-crisis-not-according-ncna858906> (analyzing polls that indicate young people are less likely to tolerate racist speech but are overall more tolerant of "offensive" speech than other age cohorts). Louisiana Gov. John Bel Edwards used the phrase "solution in search of a problem" when vetoing a campus speech-protection bill in 2017. *See* Will Sentell, *Gov. John Bel Edwards Vetoes Campus Speech and Highway Bills; Signs Controversial Name Change,* THE ADVOCATE, June 27, 2017.

3. *See, e.g.*, *Papish v. Bd. of Curators of Univ. of Mo.*, 410 U.S. 667 (1973) (finding that First Amendment prohibited university from expelling student over offensive "underground" newspaper that contained strong profanity and cartoon imagery crudely ridiculing police).

4. *Keyishian v. Bd. of Regents*, 385 U.S. 589, 603 (1967).

5. 393 U.S. 405 (1969).

6. *Id.* at 414.

7. *Healy v. James*, 408 U.S. 169, 180 (1972).

8. *See, e.g.*, *Axson-Flynn v. Johnson*, 356 F.3d 1257, 1285 (10th Cir. 2004) (applying Supreme Court's student-speech cases from K-12 schools to claim of college student removed from theater program); *Univ. of S. Miss. Chapter of Miss. Civil Liberties Union v. Univ. of S. Miss.*, 452 F.2d 564, 567 (5th Cir. 1972) (applying *Tinker* "disruption" standard to university's refusal to grant recognition to antiwar organization).

However, not all courts have consistently applied the student-speech analysis to postsecondary institutions. *See* *Am. Future Sys., Inc. v. Penn. State Univ.*, 752 F.2d 854 (3d Cir. 1984) (applying Supreme Court's *Central Hudson* framework for commercial speech to uphold a university's restriction of Tupperware-style group-sales parties in student residence halls). A concurring opinion noted the majority's failure to apply the Court's student-speech precedent, which, in the concurring judge's view, would have produced the same outcome. *See id.* at 870 (Adams, J., concurring).

9. *Am. Ass'n of Univ. Professors, On Freedom of Expression and Campus Speech Codes* (adopted Nov. 1994), available at <https://www.aaup.org/report/freedom-expression-and-campus-speech-codes>.

10. *See, e.g.*, David Greene, *University of Florida Officials Brace for White Nationalist's Speech*, NPR.ORG (Oct. 19, 2017), <https://www.npr.org/2017/10/19/558706805/university-of-florida-officials-brace-for-white-nationalists-speech>.

11. *See, e.g.*, Tom Lindsay, *35 Universities Adopt "The Chicago Statement" on Free Speech—1,606 to Go*, FORBES, Feb. 28, 2018 (stating that "there is no more pressing issue in higher education today" than "intolerance" for controversial speech); Megan McArdle, *Commentary, College Campuses Can't Become One Big "Safe Space,"* CHI. TRIB., Apr. 4, 2016.

12. *See* Emily DeRuy et al., *Milo Yiannopoulos' 15 Minutes in Berkeley Cost University \$800,000*, MERCURY NEWS, Sept. 24, 2017.

13. Laura Krantz, *"Bell Curve" Author Attacked by Protesters at Middlebury College*, BOS. GLOBE, Mar. 5, 2017.

14. Jeannie Suk Gersen, *Laura Kipniss' Endless Trial by Title IX*, NEW YORKER, Sept. 20, 2017.

15. Conor Friedersdorf, *The New Intolerance of Student Activism*, THE ATL., Nov. 9, 2015.

16. KNIGHT FOUND., *FREE EXPRESSION ON CAMPUS: A SURVEY OF U.S. COLLEGE STUDENTS AND U.S. ADULTS* (Apr. 4, 2016), https://kf-site-production.s3.amazonaws.com/publications/pdfs/000/000/184/original/FreeSpeech_campus.pdf.

17. The complete Report of the

Committee on Free Expression is available online at <https://provost.uchicago.edu/sites/default/files/documents/reports/FOECommitteeReport.pdf>.

18. Osita Nwanevu, *When “Free Speech” Is a Marketing Ploy*, SLATE (Mar. 23, 2018), <https://slate.com/news-and-politics/2018/03/when-campus-free-speech-is-a-marketing-ploy.html>.

19. Richard Perez et al., *University of Chicago Strikes Back Against Campus Political Correctness*, N.Y. TIMES, Aug. 26, 2016.

20. Scott Jaschik, *The Chicago Letter and Its Aftermath*, INSIDE HIGHER ED (Aug. 29, 2016), <https://www.insidehighered.com/news/2016/08/29/u-chicago-letter-new-students-safe-spaces-sets-intense-debate>.

21. See ARIZ. REV. STAT. § 15-1861 et seq.; COLO. REV. STAT. ANN. § 23-5-144; FLA. STAT. ANN. § 1004.097 (West); GA. CODE ANN. § 20-3-48; KY. REV. STAT. ANN. § 164.348; Campus Free Expression Act, S.B. 364 (La. 2018) (to be codified at LA. REV. STAT. § ____); N.C. GEN. STAT. ANN. § 116-300; TENN. CODE ANN. § 49-7-2401 et seq.; UTAH CODE ANN. § 53B-27-101 et seq.; VA. CODE ANN. § 23.1-900.1.

22. See Dana Ferguson, *Lawmakers Table Campus Free Speech Bill, Its Twin Lives on in S.D. Legislature*, ARGUS-LEADER, Feb. 2, 2018; Nico Savidge, *Senate Unlikely to Take up Republican Campus Speech Bill Before Fall*, WISC. ST. J., June 27, 2017.

23. Karen Herzog, *Regents Approve Punishments up to Expulsion for UW Students Who Repeatedly Disrupt Speakers*, MILWAUKEE J.-SENTINEL, Oct. 6, 2017.

24. See *Roberts v. Haragan*, 346 F. Supp. 2d 853 (N.D. Tex. 2004) (striking down Texas Tech policies requiring two-day advance notice to apply for a permit for expressive activity and limiting the distribution of printed material outside designated free-speech zones); *Univ. of Cincinnati Chapter of Young Americans for Liberty v. Williams*, No. 1:12-cv-155, 2012 WL 2160969 (S.D. Ohio June 12, 2012) (granting injunction preventing university from enforcing compliance with free-speech zone that comprised only .1 percent of the acreage of the campus).

25. See Jeremy Bauer-Wolf, *The Death of College Free-Speech Zones*, INSIDE HIGHER ED (Feb. 2, 2018),

<https://www.insidehighered.com/news/2018/02/02/experts-states-likely-keep-abolishing-free-speech-zones>.

26. *Id.*

27. *Cornelius v. NAACP Legal Def. & Educ. Fund, Inc.*, 473 U.S. 788, 802 (1985).

28. 561 U.S. 661 (2010).

29. Federal courts have applied the *Hazelwood* standard to student commencement speeches, giving schools broad latitude to censor remarks deemed politically controversial or otherwise unsuitable for the occasion. See, e.g., *Corder v. Lewis Palmer Sch. Dist.* No. 38, 566 F.3d 1219 (10th Cir. 2009) (rejecting speaker’s First Amendment challenge to punishment imposed when she deviated from school-approved text to interject Christian religious message); *Lassonde v. Pleasanton Unified Sch. Dist.*, 320 F.3d 979 (9th Cir. 2003) (upholding California school’s decision to remove religious references from student’s Christian-themed graduation speech).

30. See Jack Brammer, *Discrimination Against Gay Students or Religious Freedom? New Law Draws Fire*, LEXINGTON HERALD-LEADER, Mar. 27, 2017.

31. The Goldwater Institute model legislation and accompanying report are online at https://goldwaterinstitute.org/wp-content/uploads/cms_page_media/2017/2/2/X_Campus%20Free%20Speech%20Paper.pdf.

32. *Tinker v. Des Moines Indep. Cmty. Sch. Dist.*, 393 U.S. 405, 509

(1969).

33. See *Reno v. ACLU*, 521 U.S. 844, 871–72 (1997) (explaining that vague prohibitions are disfavored because of their “obvious chilling effect on free speech”).

34. N.C. GEN. STAT. ANN. § 116-300 (emphasis added).

35. The regulation has yet to be codified in the Wisconsin Administrative Code, but the version as approved by the state Board of Regents is available as part of the regents’ agenda packet at <https://profs.wisc.edu/wp-content/uploads/2017/10/BoR-Freedom-of-Expression-10-17.pdf>.

36. FLA. STAT. ANN. § 1004.097 (West).

37. GA. CODE ANN. § 20-3-48.

38. PEN AM., *WRONG ANSWER: HOW GOOD FAITH ATTEMPTS TO ADDRESS FREE SPEECH AND ANTI-SEMITISM ON CAMPUS COULD BACKFIRE* (Nov. 7, 2017), available at https://pen.org/wp-content/uploads/2017/11/2017-wrong-answer_11.9.pdf.

39. *Id.* at 5.

40. 816 N.W.2d 509 (Minn. 2012).

41. *Id.* at 511.

42. *Keefe v. Adams*, 840 F.3d 523 (8th Cir. 2016).

43. *Keefe v. Adams*, cert. denied, 137 S. Ct. 1448 (2017).

44. *Heenan v. Rhodes*, 757 F. Supp. 2d 1229 (M.D. Ala. 2010), amended op. at 761 F. Supp. 2d 1318 (M.D. Ala. 2011).



Counseling Your Clients on Fair Use of Others' Works . . . While Standing on One Foot¹

BY STEVE ZANSBERG

It's 4:30 in the afternoon, and your office phone rings. The call is from your client, the news director at the local TV station: "This afternoon, the cops busted two seniors at Ridgeway High who were planning an attack on the school. The only photos we can find of the two alleged perps are their portraits in last year's high school yearbook. The school says a private company, Alumni Photo, is the copyright owner. We've tried reaching that shop but have received no response. We're OK to run the photos on our 5:00, 5:30, and 6:00 casts . . . It's a fair use, right?"

Ugh.

This is no time to deliver a scintillating tutorial on copyright infringement, statutory damages, and the muddled state of the law applying the defense of fair use. Your client wants a simple answer: "Yes" or "No."

We've all been in this position. So, what do *you* say?

My stock answer goes something like this: "Unless you have obtained permission from the copyright owner, you will be committing copyright infringement, and *if* the photos are registered with the U.S. Copyright office, your station may be subject to paying statutory damages starting at \$750 and rising to either \$30,000 or \$150,000 (for willful infringement). The likelihood of your successfully claiming your use of these students' portraits, merely to illustrate your story, was a 'fair use' is pretty slim. After all, professional photographers make a living, in part, by licensing their photos for such uses.² However, your actual financial exposure is probably quite low: The photos (from last year's high school yearbook) are probably not registered in the Copyright Office, so you can probably

negotiate a low settlement with this local photographer, say two or three times his or her ordinary licensing fee." Of course, the two high school yearbook photos will appear, somewhere, on the evening news.³

Can Broader Lessons Be Learned?

The point of the above thought exercise/hypothetical is that counseling clients about whether a particular use of a copyrighted work in reporting the news (or in longer-form documentary works) constitutes "fair use" is no simple matter. While our clients may wish there were a plain and easy "litmus test," I know of no "cookie cutter, once-size-fits-all" standard that can be applied, easily, to all (or even most) factual scenarios. As our friend Mark Sableman has aptly declared, "Fair use isn't arithmetic."⁴

So, how can we media attorneys best serve our clients to navigate these shoals, not only when called upon to make individual "judgment calls," like the example above, but to provide them helpful guidance to make these determinations on their own? As anyone who has examined the body of case law applying the four factors set forth in 17 U.S.C. § 107 knows, the interplay between those factors and various factual circumstances frequently requires nuanced and subjective analyses. This article is not the appropriate place for a lengthy exegesis of the fair use doctrine and its application in published judicial decisions.⁵ Instead, I offer here two simple rules of thumb that I, and my clients, have found understandable and practicable. But first, I will briefly outline *what fair use is*, according to the Copyright Act.

The Basics

What Is Copyright?

Copyright is the intellectual property right of ownership in original expression (text, photos, painting, music, sculpture, etc.) created by a human

(not a monkey or machine) that attaches (springs into life) the moment the creative expression is "fixed in a tangible medium." The right of ownership exists, under the law, the moment one creates *expression* (not merely an idea) and records it, in some way, in a "tangible medium." Among the so-called bundle of rights the owner of a copyrighted work possesses is the right to prohibit others from making copies of that protected expression without the owner's prior permission. An additional right of the copyright owner is the right to prohibit others from creating, without prior permission, a "derivative work" that is generated by express or implicit reference to the original copyrighted work. Additional rights (including the recovery of statutory damages) come to a copyright owner upon formally registering the copyrighted work with the US Copyright Office, but such registration is not necessary for the right of ownership in the intellectual property to exist.

What Is Fair Use?

Recognizing that a 100 percent prohibition on the copying of original expressive works by others would stifle creativity and the generation of additional expressive works that incorporate prior works, Congress enacted an exception to the copyright owner's right to grant permission to others to reproduce his/her copyrighted work. Section 107 of the Copyright Act states:

[T]he fair use of a copyrighted work, including . . . by reproduction in copies . . . , for purposes such as criticism, comment, news reporting, teaching . . . , scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

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- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work. . . .

Courts Struggle When Applying the Factors—No Wonder Journalists Do Too

The difficulty in predicting, in advance of a judicial determination, whether a particular use of another's copyrighted work in a news report, magazine article, or documentary film is fair use is evidenced by the wildly disparate outcomes reported in published judicial decisions to date. I will not catalog them here. Two examples sufficiently illustrate the point.

In 1993, the “not guilty” verdict, in Simi Valley, California, following the trial of the white police officers who beat African American Rodney King, set off widespread rioting in the streets of Los Angeles. Perhaps the most famous incident of those riots was the beating of a truck driver, Reginald Denny, at the now infamous intersection of Florence and Normandie. The entire incident of African American rioters pulling Denny out of his truck and almost beating him to death was captured on videotape by a local

helicopter news crew. The copyright owner of that footage, Los Angeles News Service, sued several different companies that had incorporated that footage into their reports. In one case, the usage was found to be a fair use and therefore not copyright infringement.⁶ In the other case, decided earlier by the same appeals court, the inclusion of the same footage (though a longer clip) in a different broadcast report was deemed not necessarily a fair use, and therefore left to a jury to decide whether it constituted copyright infringement.⁷

The difference between the two cases' outcomes turned largely on the factors of “nature and purpose of the use” and the amount of the footage that the two defendants had used. In the earlier case against Los Angeles television station KCAL-TV, the defendant used only 45 seconds of the four-minute footage, but it was “the heart of the matter,” showing the brutal assault on the helpless truck driver as he lay in the street. And that defendant's use—on a nightly news broadcast that competed directly with the news reporting of LANS—was found to present an open question (for the jury to decide) whether the use was “fair” or infringing.

In contrast, in the second case, the defendant, cable channel Court TV Network, used only a few seconds of the Denny beating footage, in a promotional spot advertising the networks' coverage of the trial of one of Denny's assailant's (for that assault), and also in a stylized promo for the network's nightly program of courtroom coverage from across the nation. These two uses were found to be “transformative” and incorporated a much shorter length clip than KCAL's usage, and, perhaps most importantly, Court TV was not in direct competition with LANS in delivering nightly breaking news. Thus, Court TV's use was held to be “fair” as a matter of law.

The lack of predictability of fair use safety is compounded by two additional facts: (1) Judges have made clear that no one of the four statutory factors is itself dispositive, and all four factors must be considered, in tandem.⁸ Thus, judges or juries must independently determine how much weight to give to each of the four statutory factors. (2) The courts have crafted

a legal doctrine—the “transformative use test”—to guide the factfinder's decision making. First proposed by federal District Judge Pierre Leval of the Southern District of New York in 1990, this theory posits that use of copyrighted work is deemed “fair use” if, considering the totality of circumstances, the use in the new work is “transformative” of the original work's original purpose, intent, or effect.⁹ This doctrine has garnered a significant amount of judicial recognition and adoption,¹⁰ notwithstanding the unquestionable subjectivity of its application. The added difficulty of predicting whether a judge or jury will find a particular use sufficiently “transformative” to be deemed a “fair use” hardly moves the ball forward.¹¹

The Two Rules of Thumb

The bottom line, then, is that there is no “simple, easy test” that a news producer or documentarian can apply to a proposed usage, without permission, of a particular copyrighted work in a particular documentary. In the training sessions I put on, I halfjokingly say that if two lawyers are presented with a particular use of a copyrighted work in a particular film or broadcast report, they are likely to offer at least three different opinions whether the fair use exemption applies.

Notwithstanding this considerable uncertainty, there are some reasonably reliable guideposts that are helpful to both news producers and documentary filmmakers. For example, it is notable that the first of the four factors in the statutory exemption is whether the preexisting copyrighted work is put to a commercial or noncommercial use. Thus, the usage of materials for a journalistic or educational project is *more likely* to be deemed a fair use under this factor than a profit-making commercialization (e.g., selling tee shirts, posters, or coffee mugs bearing a copyrighted image). However, merely because copyrighted work is incorporated into a news report, or a documentary film, does not thereby *automatically* exempt it from copyright infringement.¹²

And the unauthorized use of professional photographs in straight-ahead news reporting can give rise to serious financial exposure. The news agency Agence France-Press and

Getty Images learned this lesson the hard way back in 2010, when they distributed to news outlets across the globe the harrowing images taken by a local photographer in the immediate aftermath of the January 12, 2010, earthquake in Haiti (though fair use was not the basis for the defense); a jury awarded the professional photographer, David Morel, the maximum statutory damages of \$150,000 for each of the eight photos, for a total award of \$1.2 million.¹³

In light of this significant financial exposure for using others' copyrighted works without permission, what "rules of thumb" can guide reporters, editors, and others engaged in nonfiction production (news and/or documentaries) as they ponder whether to use copyrighted works in their productions?

Rule of Thumb No. 1: Determine what you are reporting or commenting upon. This rule is perhaps the easiest way to determine, with a fairly high degree of certainty, whether any usage you make of another's copyrighted work will be deemed a fair use, under Factor 1 and the "transformative use" test. Fair use of a copyrighted work "for purposes such as criticism, comment, [or] news reporting" means, essentially, that you are permitted to report on, or provide criticism or commentary of, *the copyrighted work itself*. Perhaps this point is best demonstrated by example.

Voiceover: "The student protests against continued American involvement in Vietnam garnered an extensive amount of media coverage, both in daily newspapers across the nation, and on the evening news." Clearly, a documentary film focusing on historical events of the 1960s and 70s, or the anti-war movement more specifically, could make a fair use of existing newspaper articles, headlines, and brief snippets of news reports that were broadcast by major news outlets to illustrate this narration. The voiceover makes clear that the documentarian is reporting/commenting on *the existence of those copyrighted works*. The fact that such copyrighted works were made and widely distributed is the focus of the report, not the underlying events depicted in them.

In contrast, use of the exact same set of copyrighted images and news footage to illustrate the following

narration is less likely to be deemed a fair use: "The 1960s were a turbulent time in which society wrestled with profound issues of war and peace, civil rights, and generational change." Certainly, an argument could be made that the use of such footage to accompany this narration is *also* a fair use. However, in this latter scenario, the press coverage of Vietnam War protests would be considered more in the nature of "wallpaper," or "B-roll"—visual imagery used to depict *the underlying events* captured in those news clips, not *the fact that such footage was broadcast*. Although this distinction may be subtle, in some cases, it is of crucial importance to distinguishing between whether the footage is being utilized to illustrate a narrative *distinct from the existence of the copyrighted work*, i.e., the underlying subject matter of that copyrighted work (i.e., the turbulent events of the 1960s), as opposed to the amount and nature of *press reports covering those events* at the time.¹⁴

Another useful example of the distinction is the historical file footage of legendary prize fighter Muhammad Ali, a/k/a "The Greatest," engaging in verbal jousting with legendary ABC sportscaster Howard Cosell, epitomized by Ali's trademark "float like a butterfly, sting like a bee" eloquence.¹⁵ Using such a clip in a documentary that addresses the evolution of boxing as a sport or a biography of Ali might be deemed a fair use, depending on what the footage is used to "demonstrate." Put another way, it is unclear whether incorporating such footage (and depending on the amount of it used) will be deemed sufficiently "transformative" to warrant a fair use finding. One thing is fairly clear though: If the documentary focused, in whole or in part, on Ali's transformation of the sport *as a result of his deft handling of the press* and his being a master showman/self-promoter, the use of such a clip (or clips) is far more likely to be deemed a fair use because it is commentary on *the existence of the copyrighted work(s)*.

For the final example, let's return to the use of high school yearbook photos in connection with a breaking news event, as discussed at the start of this article. On April 20, 1999, Eric Harris and Dylan Klebold, two seniors at Columbine High School in Littleton,

Colorado, committed a homicidal (and suicidal) assault killing twelve students and one teacher and wounding twenty-four others. At the time, it was the worst mass shooting in US history. One newspaper published a collage of the two shooters' school yearbook photos. (See photos page 15.)

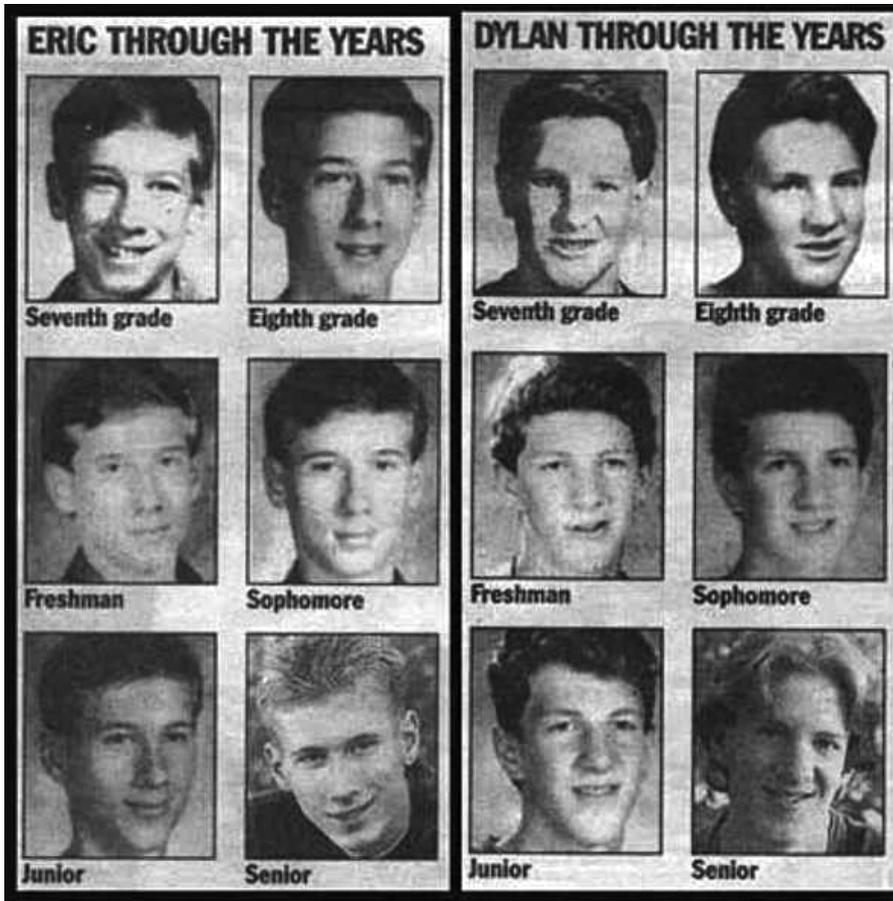
While publishing these copyrighted works, presumably without the photographer(s)' permission, could arguably be deemed "fair use" in connection with reporting on the Columbine massacre, it is far from clear that those photos were used to illustrate anything other than *their content*¹⁶—what the two killers looked like over the course of six years.

In contrast, a different photograph from that time period would likely have a much stronger claim to fair use by the news media. Shortly before the shooting occurred, a photographer at the Chrystal Light Photography agency took the class photo of the 1999 Senior Class, above.

In the upper-left-hand corner of the photo, two seniors, Eric Harris and Dylan Klebold, sitting essentially beside one another, posed with a group of their peers pretending to point firearms at the camera.

Posting or broadcasting this photo, in connection with reporting on the Columbine High School tragedy, to draw attention to the photograph's existence, not merely its contents, is far more likely to be deemed a fair use than the montage of class photos above. The fact that this photo was taken only a couple of weeks prior to the deadly massacre at Columbine High School is itself "newsworthy," or at least a subject of legitimate commentary.¹⁷ In other words, the report is *about the photo itself*, not merely that it contains Harris and Klebold (as well as some of their victims).

A couple of cautionary points with respect to this rule of thumb. First, it is *not* a "necessary" condition for coming within the fair use safe harbor that the report focus on the existence of the copyrighted work. Instead, it is, more likely than not, a *sufficient* condition for being a fair use. Second, the distinctions discussed above can be quite subtle. And merely changing the voiceover narration in a documentary on history of professional boxing, for example, to reference the fact that Ali



was a frequent guest on ABC's *Wide World of Sports* program, in order to "set up" that clip, could be deemed a contrived, artificial, or pretextual "foundation" for using the clip, and, therefore, an unsuccessful claim of fair use.

The bottom line is that if there is a legitimate "need," within a news report or documentary, to address the existence and/or significance of a prior copyrighted work itself, then showing a small portion of that work (see Rule 2 below) is far more likely to be deemed a fair use than the claim that "the

public is entitled to see" the *content of the underlying work* merely as illustrating a point made in the report.

Rule of Thumb No. 2: Use only what you need and no more. This rule relates primarily to the third statutory factor, which examines "the amount and substantiality of the portion used in relation to the copyrighted work as a whole." Taking merely a few frames or seconds out of a two-hour feature film or a six-minute song is far less likely to be deemed copyright infringement than copying the entirety of a photograph, a 20-line poem, or a 30-second

television advertisement.

Thus, republishing a photograph (100 percent of the copyrighted work) is a riskier proposition for fair use than reproducing only a small fraction of a longer song, film, book, or painting. This does not mean that photographs or entire paintings can never be used under the fair use doctrine without the owner's permission, but it is always a harder case to make. Again, presidential-campaign-ending photo of Donna Rice sitting on Gary Hart's lap on the *Monkey Business* yacht proves that the existence of a photograph, in its entirety, may well constitute a fair use.

Perhaps the easiest way to convey the rule "Use only what you need to illustrate your point, and no more," is the famous quotation from Atticus Finch in *To Kill a Mockingbird*: "You never really understand a person until you consider things from his point of view . . . until you climb into his skin and walk around in it." Thus, when filmmakers and news producers ask me whether their incorporating ten or twelve seconds of another company's video clip constitutes a fair use, my rejoinder is, "How would *you* react if that was *your* footage that some other filmmaker incorporated into his or her production?" Photographers, videographers, reporters, and producers understand, intrinsically, what it means to have their work reproduced without permission, and they appreciate that *their copyrighted works* should not be used by others without permission (and, perhaps, appropriate licensing fees) unless the usage is, in fact, a "fair use." Thus, even if the inclusion of the copyrighted work in a news report or documentary is for the legitimate purpose of "comment, criticism, or news reporting" on the existence of the copyrighted work, the report must use no more of the copyrighted work than is necessary to make that point. If a full sound-up of Muhammad Ali's "I'm so fast, that last night I turned off the light switch in my hotel room and was in bed before the room was dark" is sufficient to demonstrate his verbal prowess in the media, then stringing together two or three additional such clips thereafter, especially from the same source, runs the risk of "taking too much," under the third and fourth statutory factors. And, thus, the fair use defense may be abandoned.

Conclusion

These two rules of thumb are, once again, by no means the end-all and be-all of fair use. Others have presented robust and persuasive positions, with which I agree, that fair use in news reporting and documentaries is not narrowly limited to merely commenting on and demonstrating the existence of prior published copyrighted works. So, *please* do not mistake these two rules of thumb as exhausting the universe for fair usage of copyrighted works in documentaries. Put another way, the diagram below shows that Rule of Thumb No. 1 describes merely a subset of the universe of uses that constitute a fair use.

Nevertheless, Rule No. 2 applies to *all* uses outside the smaller inside circle of fair uses encompassed by Rule No. 1 above. In other words, one should *always* use the *smallest* amount of the copyrighted work being reproduced without permission that is necessary to illustrate the point for which the fair use is being made.

Like the great sage Hillel's one sentence synopsis of the Torah, I hope you find these two rules of thumb of some use in counseling your clients on the intricacies of fair use. "Now go and study." ■

Endnotes

1. According to the Talmud (Shabbat 31a), the great Jewish sage Rabbi Hillel was challenged to teach a potential convert the entire Torah while the student stood on one foot. Rabbi Hillel responded, "What is hateful to you, do not do to your neighbor. That is the whole Torah; the rest is the explanation of this—go and study it!" Shoshannah Brombacher, *On One Foot*, CHABAD.ORG, https://www.chabad.org/library/article_cdo/aid/689306/jewish/On-One-Foot.htm.

2. See, e.g., *Dlugolecki v. Poppel*, Case No. 2:18-cv-03905 GW (GJSx) (W.D. Cal. 2018) (high school yearbook photographer's copyright infringement claim premised on news organizations' use of Meghan Markle's yearbook portraits).

3. Although the attempted school shooting hypothetical is not taken, literally, from any particular real-world incident, it is representative of an all-too-familiar factual scenario. See, e.g., Nicky Woolf, *Two Teenage Girls Face Trial in Colorado for "Planning Mass School Shooting,"*

DEMOCRATIC UNDERGROUND (Jan. 14, 2016), <https://www.democraticunderground.com/10141315325> (publishing photos of two accused school assailants, with cut line "credit: Mountain Vista High School yearbook photo"); *2nd Teen Accused in High School Murder Plot Appears in Court*, CBS4 DENVER (Feb. 27, 2017), <https://denver.cbslocal.com/2017/02/27/2nd-teen-accused-in-high-school-murder-plot-appears-in-court/>.

4. See Mark Sableman, *Fair Use Isn't Arithmetic*, THOMPSON COBURN LLP (Oct. 25, 2018), <https://www.thompsoncoburn.com/insights/blogs/in-focus/post/2018-10-25/fair-use-isn-t-arithmetic> ("Any arithmetical method for determining fair use will almost always be erroneous.").

5. For more extended and scholarly discussions, see WILLIAM F. PATRY, PATRY ON FAIR USE (2018); 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1305 (2018). More practical guides (for news and documentary producers) include CTR. FOR SOC. MEDIA, AM. UNIV., SET OF PRINCIPLES IN FAIR USE FOR JOURNALISM (2013), available at <http://cmsimpact.org/code/set-principles-fair-use-journalism/>; CTR. FOR SOC. MEDIA, AM. UNIV., DOCUMENTARY FILMMAKERS' STATEMENT OF BEST PRACTICES IN FAIR USE (2005), available at <http://cmsimpact.org/wp-content/uploads/2016/01/Documentary-Filmmakers.pdf>. Also, the University of Texas offers a helpful guide to applying the four statutory factors in practice: *Four Factor Test*, UNIV. OF TEX. LIBRARIES (Mar. 5, 2018), <https://guides.lib.utexas.edu/copyright/fourfactors>

6. *L.A. News Serv. v. CBS Broad., Inc.*, 305 F.3d 924 (9th Cir. 2002).

7. *L.A. News Serv. v. KCAL-TV Channel 9*, 108 F.3d 1119 (9th Cir. 1997).

8. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578 (1994) ("Nor may the four statutory factors be treated in isolation, one from the other. All are to be explored, and results weighed together, in light of the purposes of copyright.").

9. Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105 (1990); see also Authors Guild, Inc. v. HathiTrust, 755 F.3d 87, 96 (2d Cir. 2014) ("A use is transformative if it does something more than repackage or republish the original copyrighted work.").

10. Neil Netanel, *Making Sense of Fair Use*, 15 LEWIS & CLARK L. REV. 715 (2011) (surveying case law and presenting data

"showing that since 2005 the transformative use paradigm has come overwhelmingly to dominate fair use doctrine").

11. As one university's guide states, "the outcome of a court's fair use analysis can be hard to predict since the test is subjective and open to interpretation." *Basic Information on Copyright and Fair Use for Using Works of Others* at 3, UNIV. S. CAL. BULL. (2006).

12. See *L.A. News Serv. v. CBS Broad., Inc.*, 305 F.3d 924, 939 n.13 (9th Cir. 2002) ("even straight [news] reporting may, in some cases, be 'commercial' for purposes of the [fair statutory] factor.") (citations omitted); *L.A. News Serv.*, 108 F.3d at 1121 ("[N]ewscasts are commercially supported by advertisers, who pass the cost of sponsorship on to those who purchase their products.") (citations omitted).

13. See James Estrin, *Haitian Photographer Wins Major U.S. Copyright Victory*, N.Y. TIMES, Nov. 23, 2013.

14. See, e.g., *Otto v. Hearst Communs., Inc.*, No. 1:17-cv-4712-GHW, 2018 U.S. Dist. LEXIS 208698, at *24 (S.D.N.Y. Dec. 10, 2018) ("Though 'news reporting is a widely-recognized ground for finding fair use under the Copyright Act,' the use of an image solely to illustrate the content of that image, in a commercial capacity, has yet to be found as fair use in this District.") (emphasis added); *Psihoyos v. National Examiner*, No. 97-cv-7624 (JSM), 1998 U.S. Dist. LEXIS 9192, 1998 WL 336655, at *3 (S.D.N.Y. June 22, 1998) ("The Examiner's use is not transformative, because its piece uses the photo to show what it depicts.").

15. See, e.g., *Muhammad Ali Moments Alongside Sportscaster Howard Cosell*, YOUTUBE (2016), https://www.youtube.com/watch?v=BR_5XrRYbpU.

16. See *Barcroft Media, Ltd. v. Coed Media Grp., LLC*, 297 F. Supp. 3d 339, 352 (S.D.N.Y. 2017) ("CMG's articles did not comment on, criticize, or report news about the Images themselves; instead, they used the Images as illustrative aids because they depicted the subjects described in its articles. CMG's argument, if accepted, would eliminate copyright protection any time a copyrighted photograph was used in conjunction with a news story about the subject of that photograph. That is plainly not the law.") (emphasis added).

17. See, e.g., Keryn Donnelly, *The Tragedy Behind This High School Class Photo Will Give You the Chills*, MAMAMIA (Mar. 11, 2017), <https://www.mamamia.com.au/columbine-photo/>.

Music Licensing Transformed by the Passage of the Music Modernization Act

BY STEVEN R. ENGLUND, ALISON I. STEIN AND AVA U. MCALPIN

On October 11, 2018, the president signed into law the Orrin G. Hatch–Bob Goodlatte Music Modernization Act (MMA).¹ 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

for public performance licenses administered by ASCAP and BMI, including randomized assignment of judges to hear those proceedings and permitting those judges to consider royalty rates for sound recordings; and

- (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.²

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.³ Among other things, the Mechanical Licensing Collective will develop and provide a publicly accessible database of current ownership information for musical compositions.⁴ 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, 2021.⁵ To obtain a blanket license once they become available, a digital music provider will need only submit a notice to the Collective.⁶ 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.⁷

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.⁸ Industry groups also have begun the process of identifying proposed leaders for the Collective.⁹

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.¹⁰

Instead, prior to the enactment of the MMA, pre-1972 recordings were potentially protected under state statutory and common law until February 15, 2067.¹¹ 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,¹² the highest courts of two states determined that their state law provided no public performance right in pre-1972 sound recordings.¹³ Some large digital music services refused to pay the artists who created those works for the use of their recordings.

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; and
- For all other recordings (including unpublished recordings and ones published after 1956), the term of protection ends on February 15, 2067.¹⁴

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.¹⁵ Additional provisions address settlements of state law claims.¹⁶ 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.¹⁷

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 distribution by 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 Act¹⁸ and for all users of sound recordings under the statutory license in section 114 of the Copyright Act.¹⁹

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.²⁰ 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.²¹ 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.²² Finally, the AMP Act simplifies the tax treatment of situations where a producer is paid out of the artist’s share of statutory royalties.²³ ■

Endnotes

1. Orrin G. Hatch–Bob Goodlatte Music Modernization Act, Pub. L. No. 115-264, 132 Stat. 3676 (2018).

2. *See, e.g.*, Wixen Music Publ’g, Inc. v. Spotify USA, Inc., consolidated with Ferrick v. Spotify USA, Inc., 16-cv-08412-AJN (S.D.N.Y.).

3. 17 U.S.C. § 115(d)(3), *as amended* by Pub. L. No. 115-264, tit. I, § 102, 132 Stat. at 3686–88.

4. 17 U.S.C. § 115(d)(3)(C)(i)(IV) & (E), *as amended* by Pub. L. No. 115-264, tit. I, § 102, 132 Stat. at 3687, 3692.

5. 17 U.S.C. § 115(b)(2)(B), (d)(2)(B), (e)(15), *as amended* by Pub. L. No. 115-264, tit. I, § 102, 132 Stat. at 3678, 3685–86, 3720.

6. 17 U.S.C. § 115(d)(2)(A), *as amended* by Pub. L. No. 115-264, tit. I, § 102, 132 Stat. at 3684.

7. 17 U.S.C. § 115(d)(10), *as amended* by Pub. L. No. 115-264, tit. I, § 102, 132 Stat. at 3713–16.

8. Modification and Amendment of Regulations to Conform to the MMA, 83 Fed. Reg. 55,334 (Nov. 5, 2018); *see also* Extension of Comment Period, 83 Fed. Reg. 60,384 (Nov. 26, 2018).

9. *E.g.*, Ed Christman, *Licensing Experts Wanted: Now That the Music Modernization Act Is Law, Who Will Lay It Down?*, BILLBOARD (Oct. 19, 2018), <https://www.billboard.com/articles/business/8480843/music-modernization-act-law-licensing-experts-wanted>; Nat’l Music Publishers’ Ass’n, *Music Publishers: Please Read the Music Modernization Act (MMA) Mechanical Licensing Collective (MLC) Board Submission Guide: Apply to Serve on the MLC Board and Committees*, <http://nmpa.org/music-publishers-please-read-the-music-modernization-act-mma-mechanical-licensing-collective-mlc-board-submission-guide-apply-to-serve-on-the-mlc-board-and-committees/>.

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.

11. *See* 17 U.S.C. § 301(c), *prior to amendment* by Pub. L. No. 115-264.

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.

13. *See, e.g.*, Flo & Eddie, Inc. v. Sirius XM Radio, Inc., 229 So. 3d 305 (Fla. 2017); Flo & Eddie, Inc. v. Sirius XM Radio, Inc., 28 N.Y.3d 583 (N.Y. 2016).

14. 17 U.S.C. § 1401, *as amended* by Pub. L. No. 115-264, tit. II, § 202, 132 Stat. at 3728–3737.

15. 17 U.S.C. § 1401(f)(5), *as amended* by Pub. L. No. 115-264, tit. II, § 202, 132 Stat. at 3735. The Copyright Office has announced interim rules for the recording of claims to pre-1972 recordings by rights owners. Filing of Schedules by Rights Owners and Contact Information by Transmitting Entities Relating to Pre-1972 Sound Recordings, 83 Fed. Reg. 52,150 (Oct. 11, 2018) (to be codified at 27 C.F.R. pt. 201).

16. 17 U.S.C. § 1401(d)(2)(B), (e)(1), *as amended* by Pub. L. No. 115-264, tit. II, § 202, 132 Stat. at 3732, 3733–34.

17. 17 U.S.C. § 1401(c), *as amended* by Pub. L. No. 115-264, tit. II, § 202, 132 Stat. at 3729–32. The Copyright Office has commenced a rulemaking proceeding to provide details concerning this process. Noncommercial Use of Pre-1972 Sound Recordings That Are Not Being Commercially Exploited, 83 Fed. Reg. 52,176 (Oct. 11, 2018); *see also* Extension of Comment Period, 83 Fed. Reg. 57,386 (Nov. 15, 2018).

18. 17 U.S.C. § 115(c)(1)(F), *as amended* by Pub. L. No. 115-264, tit. I, § 102, 132 Stat. at 3680.

19. 17 U.S.C. § 114(f)(1)(B), *as amended* by Pub. L. No. 115-264, tit. I, § 103, 132 Stat. at 3723.

20. 28 U.S.C. § 137(b), *as amended* by Pub. L. No. 115-264, tit. I, § 104, 132 Stat. at 3726.

21. 17 U.S.C. § 114(g), *as amended* by Pub. L. No. 115-264, tit. II, § 301, 132 Stat. at 3737–3741.

22. *Id.*

23. *Id.*

The Photograph That Broke the Internet...

Continued from page 1

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 be deserving of copyright protection. Maybe the vast majority of us are not "sharp-shooters" but what Sarony derisively 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.¹⁸ 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.”¹⁹ 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.”²⁰ 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 “intrinsic merit or value” and thus did not “promote the progress of science and the useful arts.”²¹ 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.”²²

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.²³ “Personality always contains something unique,” Holmes explained. “[A] very modest grade of art has in it something irreducible, which is one man’s alone.”²⁴

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”).²⁵ “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.²⁶

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.²⁷ Nose turned up, he went on to say that permitting judges to decide what is copyrightable would exclude “pictures which appealed to a public less educated than a judge.”²⁸

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.

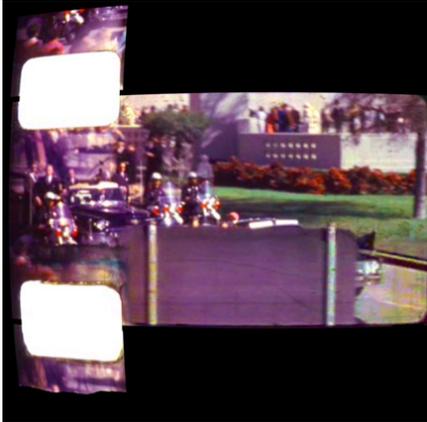
On the other hand, maybe Holmes didn’t think *Burrow-Giles* was relevant. The work at issue in *Bleistein*, after all, wasn’t a photograph—it was a drawing. Holmes himself seemed focused on drawing, quoting John Ruskin’s *Elements of Drawing* to demonstrate the skill required to draw.²⁹ And he made reference 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.³⁰

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.”³¹ (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.³²)



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.³³ 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.³⁴

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."³⁵

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.³⁶ 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 ensconced as gospel by Professor Nimmer, who said it had "become the prevailing view."³⁷

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.³⁸ 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."³⁹ The "key" to making sense of this tension, O'Connor explained, was in how we think about original works of authorship.⁴⁰

"Original," in the copyright context, had two distinct requirements, she said. First, it meant that the work must be independently created by the author.⁴¹ Second, O'Connor said, it meant that the work also must possess a minimal degree of creativity.⁴² 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.⁴³ 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*

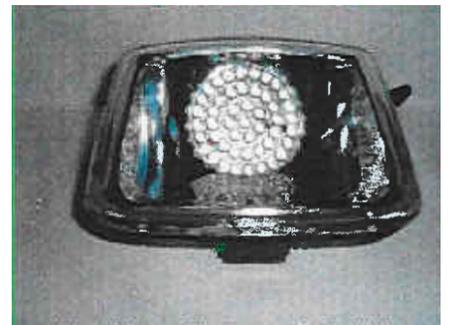
After *Feist*, challenges to the copyrightability of photographs ticked up. While not all came out the same way, taken together, they suggest the slow death of Hand’s per se rule that photographs must be creative. As then-Tenth Circuit Judge Gorsuch in deciding a case of infringement over a “wire frame” representation of an automobile wrote: “It is . . . not the case, . . . that ‘no photograph, however simple, can be unaffected by the personal influence of the author, and no two will be absolutely alike,’ that photographs (or any other works, for that matter) are *per se* protectable.”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 Pauley 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 “observ[ed] 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 Pauley 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,

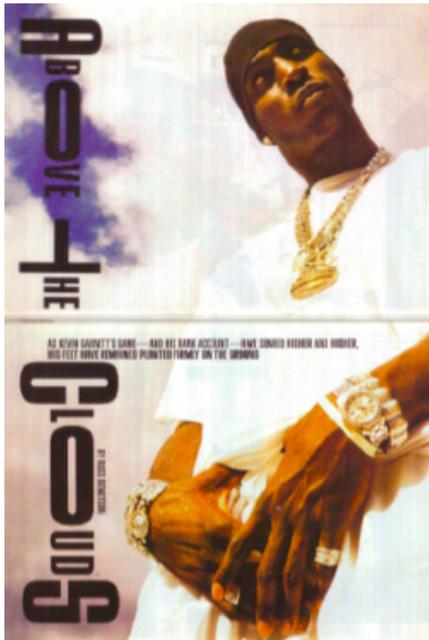
courts returned to assessing the creative choices photographers made. At issue in *Oriental Art Printing, Inc. v. Goldstar Printing Corp.*, for example, were several photographs of plates of Chinese food that were used on restaurant menus.⁶⁵ Relying on *Feist*, the court explained that “this is the rare 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 whitepages 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

camera, lens, film, shutter speed, and filter choice, the court cautioned that the question was not the potential creativity of the medium, but rather how “to gauge [creativity] as one moves from sublime expression to simple reproduction.”⁷³ The works there were sufficiently creative because the plaintiff purposefully “use[d a] single light source with a ‘reflector to fill out the shadows’ in order to ‘give a chiaroscuro effect,’” “employed artistic judgment in determining the amount of shadowing for each individual frame that would emphasize the detail without obscuring it,” and “creat[ed] a ‘unique light design on a reflector that would appear in the mirror without showing any part of the room or [himself] in the mirror.’”⁷⁴ That was enough.⁷⁵



Looking for a Test for Creativity

It wasn't until 2006 that a court finally stepped away from the laundry list of choices about lenses and shadow and angles to try to bring some certainty to the creativity inquiry. In that case, *Mannion v. Coors Brewing Co.*, freelance photographer Jonathan Mannion was hired by *SLAM* magazine to photograph basketball player Kevin Garnett to run along a feature article about the athlete.⁷⁶ Mannion eventually met with Garnett and created “a three-quarter-length portrait of Garnett against a backdrop of clouds with some blue sky shining through.”⁷⁷

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.”⁷⁸ 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.”⁷⁹

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 *SHL Imaging, Inc.*, *Oriental Art Printing*, and *Custom Dynamics, LLC*, Judge Kaplan concluded that listing “potential components of a photograph’s originality” was “somewhat unsatisfactory.”⁸⁰

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.”⁸¹ 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.”⁸² 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.”⁸³

Pulling from a decision he had written years earlier, Judge Kaplan turned to UK law to create a more definitive test for creativity.⁸⁴ 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.⁸⁵ 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.⁸⁶

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.”⁸⁷ In *Pagano*, after all, the photographer caught the “men and women in not merely lifelike, but artistic, positions.”⁸⁸ 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.”⁸⁹

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*.⁹⁰ Because the author created the subject itself, protection would extend to “attempt[s] to replicate precisely . . . the content of the photograph.”⁹¹

Turning back to the Garnett photograph, Judge Kaplan concluded that there “can be no serious dispute that it was an original work.”⁹² The rendition in the purposeful use of an “unusual angle” and “distinctive lighting” strengthened “the photograph’s originality.”⁹³ 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.⁹⁴

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.⁹⁵ 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 *Burrow-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 detectable 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 Imagining, 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-Justice Gorsuch cautioned, the Supreme Court's jurisprudence makes clear that not all photographs are per se 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.¹⁰⁷ 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.¹⁰⁸ 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.¹⁰⁹ 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 *Mannion*, 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).¹¹⁰ 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

1. Gilson Willets, *The Art of Not Pos-ing—An Interview with Napoleon Sarony*, 10 AM. ANNUAL OF PHOTOGRAPHY & PHOTOGRAPHIC TIMES ALMANAC 188 (1896).
2. See generally DAVID M. FRIEDMAN, WILDE IN AMERICA: OSCAR WILDE AND THE INVENTION OF MODERN CELEBRITY (2014).
3. *Id.*
4. OSCAR WILDE, OSCAR WILDE IN AMERICA: THE INTERVIEWS 141 (2010).
5. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 54 (1884).
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.
7. *Sarony v. Burrow-Giles Lithographic Co.*, 17 F. 591, 592 (C.C.S.D.N.Y. 1883).
8. *Burrow-Giles Lithographic Co.*, 111 U.S. at 54.
9. *Id.* at 56.
10. *Id.* at 59 (emphasis added).
11. *Id.*
12. *Id.* at 59–60 (emphasis added).
13. For an expanded discussion of

the development of photography as art, see Haight Farley, *The Lingering Effects of Copyright’s Response to the Invention of Photography*, 65 U. PITT. L. REV. 385 (2004).

14. *Burrow-Giles Lithographic Co.*, 111 U.S. at 60.
15. *Id.*
16. *Id.* at 58.
17. *Id.* at 59–60.
18. *Falk v. City Item Printing Co.*, 79 F. 321 (C.C.E.D. La. 1897).
19. *Falk v. Donaldson*, 57 F. 32, 34 (C.C.S.D.N.Y. 1893); see also, e.g., *Falk v. Brett Lithographing Co.*, 48 F. 678, 679 (C.C.S.D.N.Y. 1891) (same).
20. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903).
21. *Courier Lithographing Co. v. Donaldson Lithographing Co.*, 104 F. 996 (6th Cir. 1900).
22. *Bleistein*, 188 U.S. at 250.
23. *Id.* at 249–50.
24. *Id.* at 250.
25. Oren Bracha, *Commentary on Bleistein v. Donaldson Lithographing Co. (1903)*, PRIMARY SOURCES ON COPYRIGHT (1450–1900) (Lionel Bently & Martin Kretschmer eds., 2008), <http://www.copyright-history.org>.
26. *Bleistein*, 188 U.S. at 251.
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).
32. See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 359–60 (1991).
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 copy-rightable 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.)).

38. 499 U.S. 340 (1991).

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).

51. *Id.* (citing Harper & Row, Publishers, Inc. v. Nation Enter., 471 U.S. 539, 556–57, 563 (1985)).

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. Skyy 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.*

65. 175 F. Supp. 2d 542 (S.D.N.Y. 2001).

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 hallmarks 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 *Pagano* 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).

70. 535 F. Supp. 2d 542 (E.D.N.C. 2008).

71. *Id.* at 549.

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

73. SHL Imaging, Inc. v. Artisan House, Inc., 117 F. Supp. 2d 301, 310 (S.D.N.Y. 2000).

74. *Id.*

75. *See also* Schrock v. Learning Curve Int’l, Inc., 586 F.3d 513 (7th Cir. 2009) (finding sufficient originality after expressly considering the issue); *E. Am. Trio Prods. v. Tang Elec.*, 97 F. Supp. 2d 395 (S.D.N.Y. 2000) (same); *Decker Inc. v. G&N Equip. Co.*, 438 F. Supp. 2d 734 (E.D. Mich. 2006) (same).

76. 377 F. Supp. 2d 444 (S.D.N.Y. 2005).

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 HON. SIR 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*, 960 F.2d 301 (2d Cir. 1992)).

91. *Id.* at 454.

92. *Id.* at 454–55.

93. *Id.*

94. *Id.* at 455.

95. *Hasbro Bradley, Inc. v. Sparkle Toys, Inc.*, 780 F.2d 189 (2d Cir. 1985).

96. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 59–60 (1884).

97. *Harney v. Sony Pictures Television, Inc.*, 704 F.3d 173 (1st Cir. 2013) (citing *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349–50 (1991)); *see also* *Int’l News Serv. v. Associated Press*, 248 U.S. 215, 254 (1918) (Brandeis, J., dissenting) (“The mere record of isolated happenings, whether in words or by photographs not involving artistic skill, are denied [copyright] protection.”).

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]”).

99. David Nimmer, *Copyright in the Dead Sea Scrolls: Authorship and Originality*, 38 HOUS. L. REV. 1, 204 (2001).

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)).

103. *V-J Day in Times Square*, WIKIPEDIA, https://en.wikipedia.org/wiki/V-J_Day_in_Times_Square.

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).

107. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348 (1991).

108. *Number of Smartphone Users Worldwide from 2014 to 2020 (in billions)*, STATISTA (2018), <https://www.statista.com/statistics/330695/number-of-smartphone-users-worldwide>.

109. *QuHarrison Terry, More Than 1.2 Trillion Photos Were Taken in 2017. What to Do with All These Memories?*, *QT (Mar. 20, 2018), <https://quharrison.com/buying-conversations>.

110. *Otto v. Hearst Comm'cns, 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”).

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