

COPYRIGHT ESSENTIALS:

**HOW TO PROTECT YOUR COPYRIGHTED WORKS IN AN INTERNET AGE**

Outline Used at a Seminar on October 23, 2008 for Hudson Valley Bank and CUNY Law School

By Andrew Berger, Esq.

Tannenbaum Helpern Syracuse & Hirschtritt LLP

(212) 702-3167; [berger@thshlaw.com](mailto:berger@thshlaw.com)

*Rogers v. Koons, 960 F.2d 301 (2d Cir. 1992)*  
*Plaintiff's Photo*



*Rogers v. Koons, 960 F.2d 301 (2d Cir. 1992)*  
*Defendant's Sculpture*



**Tannenbaum Helpern  
Syracuse & Hirschtritt** LLP

New York | London

# TABLE OF CONTENTS

INTRODUCTION.....	1
I. WHAT IS A COPYRIGHT? .....	1
A. What Does “Original” Mean? .....	1
B. Does Originality Require Aesthetic Appeal?.....	1
C. Does Originality Require Creativity?.....	1
D. What Is Meant By “Fixed in a Tangible Medium”? .....	1
II. What Elements Are Protected by Copyright?.....	2
A. Expressive Elements, Not Ideas .....	2
B. Protected Elements in Literary and Visual Works .....	2
III. WHEN IS COPYRIGHT CREATED?.....	4
IV. WHAT RIGHTS DOES A COPYRIGHT HOLDER HAVE?.....	4
A. What is a Derivative Work?.....	4
V. WHO OWNS THE COPYRIGHT?.....	5
A. What is a Joint Work and What Rights Do Joint Owners Have? .....	5
VI. HOW LONG DOES COPYRIGHT PROTECTION LAST?.....	5
VII. THE IMPORTANCE AND BENEFITS OF REGISTRATION .....	5
A. What is Registration?.....	5
B. How Do You Register? .....	5
C. What Kinds Of Works Can Be Registered?.....	5
D. What Are The Benefits of Registration? .....	6
E. What are Statutory Damages? .....	6
F. What is an Example of “Willful Infringement?” .....	6
G. What Damages Can You Recover If You Register an Infringed Work More Than Three Months After Its First Publication? .....	6
VIII. WHAT IS A COPYRIGHT NOTICE AND WHAT ARE ITS BENEFITS?.....	6
IX. HOW TO ESTABLISH INFRINGEMENT .....	6
A. Establishing Copying .....	7
B. Demonstrating that Defendant Had Access .....	8
C. Demonstrating Probative Similarity .....	8
D. Showing Substantial Similarity.....	8
E. Distinguishing Between Idea and Expression: Three Examples .....	8
1. The <i>Fournier</i> Case .....	8
2. <i>Rogers v. Koons</i> .....	9
3. 500 TVs: <i>Psihoyos v. Microsoft</i> .....	9
X. THE FAIR USE DEFENSE TO INFRINGEMENT .....	10
A. The Elements of Fair Use .....	10
B. Application of Fair Use to Three Cases in the Second Circuit .....	10
XI. THE STEPS YOU SHOULD TAKE IF YOUR WORK HAS BEEN INFRINGED.....	14
XII. THE STEPS YOU SHOULD TAKE IF YOU HAVE BEEN ACCUSED OF INFRINGEMENT.....	14

## INTRODUCTION

This outline explains the essentials of copyright, including:

- i. what a copyright is;
- ii. what elements in a work are protected by copyright;
- iii. when copyright is created;
- iv. what rights a copyright holder has;
- v. who owns the copyright;
- vi. how long copyright protection lasts;
- vii. the importance and benefits of copyright registration;
- viii. the benefits of a copyright notice;
- ix. how to establish copyright infringement and some examples of substantial similarity;
- x. what is the fair use defense to infringement and what are some examples of fair use; and
- xi. what steps a client should take if it has been victimized or accused of infringement.

### I. WHAT IS A COPYRIGHT?

Copyright protects “original works of authorship,” whether or not they were published so long as the works are fixed in a tangible medium. Protected works include literary, musical and artistic creations such as books, magazines, music, poems, photographs, paintings, motion pictures, sound recordings, graphs, sculptures, architectural drawings, maps and choreography.

#### A. What Does “Original” Mean?

Originality requires independent creation, not novelty. Courts will protect a copyrighted work that differs only slightly from earlier ones to encourage the creation of the widest variety of creative expressions. In contrast, patent law protects only those inventions that reflect substantial technological advances. Thus, patent law encourages the making of efficient information while copyright law encourages the creation of abundant information.

#### B. Does Originality Require Aesthetic Appeal?

There is no qualitative, aesthetic threshold for copyright protection. An early Supreme Court case rejected the distinction between the artistic and ordinary. The Court, finding that a very modest expression of personality constitutes sufficient originality for copyright protection, stated it would be dangerous for persons trained only in the law to judge the worth of illustrations.

#### C. Does Originality Require Creativity?

Although copyright does not set a novelty or aesthetic minimum, copyright does require some minimal level of creativity. As another Supreme Court case stated, “the requisite level of creativity is extremely low, even a small amount will suffice.”

Further, copyright protection results from the creative qualities the work displays, not the effort you spent creating it. In other words, “sweat of the brow” does not make a work copyrightable.

Nor is a copy of a public domain work copyrightable. For example, a court denied protection to exact photographic reproductions of works of art. Despite the skill, ability, equipment, and judgment the photographer displayed, the reproductions were not protectable because they lacked the spark of originality.

Another court summed up this concept that effort makes no difference as follows:

The copyright laws protect the work, not the amount of effort expended. A person who produces a short new work or makes a small improvement in a few hours gets a copyright for that contribution fully as effective as that on a novel written as a life's work. Perhaps the smaller the effort the smaller the contribution; if so, the copyright simply bestows fewer rights. ... Copyright covers, after all, only the incremental contribution and not the underlying information. The input is irrelevant.

#### D. What Is Meant By “Fixed in a Tangible Medium”?

A work to be protected by copyright must also be fixed in a tangible medium so that it may be “perceived, reproduced or otherwise communicated for more than a transitory duration.” This definition imposes two distinct

but related requirements: the work must be perceived, reproduced or communicated in a medium (the “PRC” requirement); and the work must remain there for more than a fleeting period.

Here are some examples that satisfy the PRC requirement: (i) a song written on paper because it may be perceived; (ii) a speech on a cassette tape because the speech may be communicated; (iii) a photograph on a computer’s hard drive because that photo may be reproduced.

The second requirement for fixation is more difficult to explain because Congress never defined the minimum period during which a work must remain fixed. For many years courts followed the “RAM doctrine” which stated that, because software in a computer’s RAM could be perceived, reproduced, or communicated, the software was “fixed”, even if fixation was temporary and disappeared once the computer was turned off. But the Second Circuit (the appellate court overseeing the federal courts in New York, Connecticut and Vermont) recently backed away from the RAM doctrine in a case involving The Cartoon Network. That case held that data residing in a buffer for no more than 1.2 seconds was too fleeting to satisfy the durational requirement. How much more time beyond 1.2 seconds is enough? Future cases may decide.

## II. WHAT ELEMENTS ARE PROTECTED BY COPYRIGHT?

### A. Expressive Elements, Not Ideas

Copyright protects the expressions of ideas, not the ideas themselves. Courts have long struggled to draw the boundary between the illusive concepts of an idea and its expression. As one court stated, “nobody has ever been able to fix that boundary and nobody ever can.” Decisions are therefore inevitably and unfortunately ad hoc.

### B. Protected Elements in Literary and Visual Works

The uncertain boundary separating idea and expression varies based on the type of work involved. In literary works, unprotected ideas include indispensable, standard or naturally occurring elements that are commonplace in the treatment of a given topic. For example, think of a movie based on police working in the South Bronx. The commonplace elements that usually come to mind in that setting include drunks, prostitutes, rats and derelict cars. They will not be protected because they are “inevitable” in a work of this kind. For the same reason, the traditional Santa costume, white beard and nose like a cherry are unprotectible elements in a depiction of Santa Claus. Basic character types are also not protectible.

Protected elements in literary works include uniquely developed characters and sequences of events in the plot or storyline.

Visual works also refuse to protect elements that necessarily flow from the subject matter depicted. An example is the *Kerr v. New Yorker* case (photos below). There, plaintiff created an illustration of a male figure with a Mohawk haircut in the shape of the New York City skyline.

*Kerr v. New Yorker Magazine, Inc.,  
63 F. Supp.2d. 320 (S.D.N.Y. 1999)*

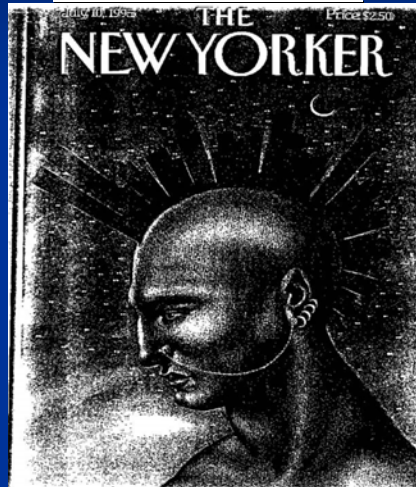
Plaintiff's Illustration



When defendant created a similar drawing (below), plaintiff sued for infringement.

*Kerr v. New Yorker Magazine, Inc.,  
63 F. Supp.2d. 320 (S.D.N.Y. 1999)*

*Defendant's Illustration*



In granting defendant summary judgment, the court stated that the idea of a New York skyline as a Mohawk haircut might reasonably be expected to include other common unprotectible elements such as “eyes, nose, mouth, a figure in profile and certain N.Y. buildings.”

In *Gentieu v. Tony Stone* case (photos below) the court also refused to protect commonplace elements the court concluded were standard in the treatment of the subject matter.

*Gentieu v. Tony Stone Images/Chicago, Inc.,  
255 F. Supp.2d. 838 (N.D. Ill. 2003)*

■ Gentieu Photos



Tony Stone



The court stated that the “poses” in plaintiff’s photos, capturing the natural movements and facial expressions of infants, are implicit in the very idea of a baby photograph and therefore are not protectible. The court dismissed plaintiff’s case because defendant’s photos simply copied elements of plaintiff’s expression that necessarily flowed from the idea of photographing naked babies.

In visual works unprotected ideas include line, color, and the subject matter depicted. Only the treatment of a subject is protected. Other elements the courts will protect in visual works include: the arrangement of the subject, light and shade; suggesting and evoking the desired expression; the particular lighting, the resulting skin tone of the subjects, the angle and perspective selected; and particularly in photographs, determining the precise time of day a work is created.

### III. WHEN IS COPYRIGHT CREATED?

Once a copyrightable work is fixed in a tangible medium for more than a few seconds, the work is automatically protected by copyright; you don't need to do anything further. But as discussed below, you should register the work and place a copyright notice on it.

### IV. WHAT RIGHTS DOES A COPYRIGHT HOLDER HAVE?

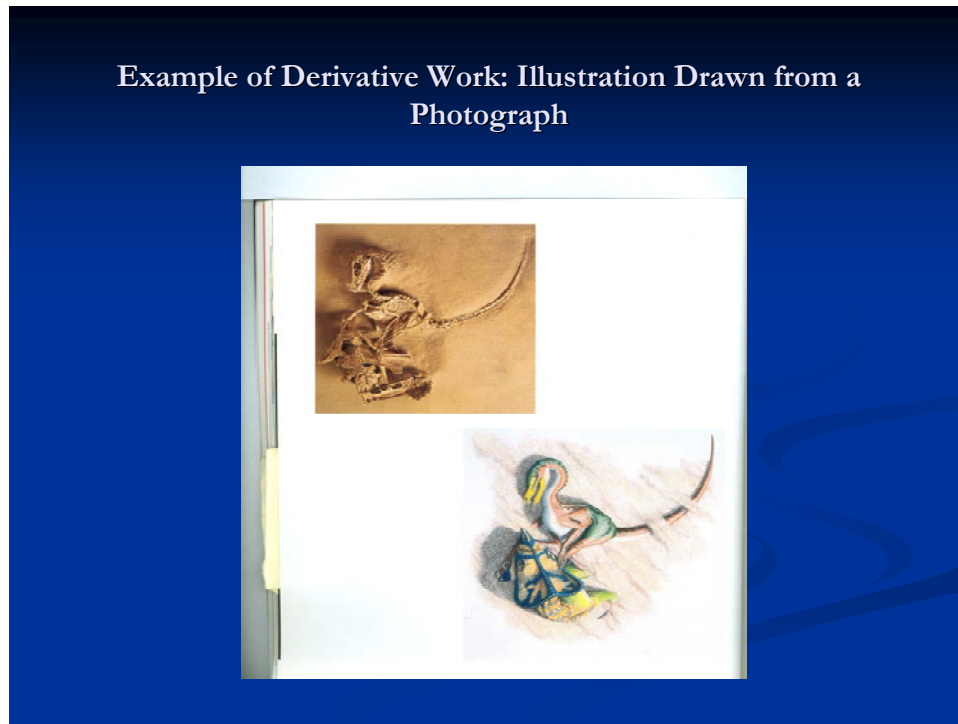
The holder has a bundle of rights, including the right to:

1. reproduce (copy) the work
2. prepare derivative works
3. publicly perform the work
4. publicly distribute the work
5. publicly display the work, and
6. publicly perform sound recordings by digital audio transmission.

#### A. What is a Derivative Work?

Most of these rights are clear; but a derivative work needs some explanation. A derivative work must not only borrow original and expressive content from an underlying work but must also "recast, transform or adapt," not simply copy, that underlying work.

An example of a derivative work is an illustration (below) of what two dinosaurs likely looked like before death drawn from a photograph of their fossil remains. Because the illustration borrows the expressive content of the photo, its angle, lighting and shade and then transforms that photo by adding color, skin tones and an expression to what had been a lifeless fossil, the resulting illustration qualifies as a derivative work.



An example of a work that is not derivative is a motion picture that simply copies a novel's stock themes such as a hard-drinking, aging Irish cop chasing fleeing criminals in a big-city setting. These themes do not qualify because courts have found them too commonplace to be protectable. A volume that combines a novel in the public domain with biographical information about the author also does not qualify because the volume does not transform the preexisting work. Further, changing a work from one medium to another does not "recast, transform or adapt," the underlying work. Thus, a plastic bank made from a cast iron original in the public domain is not a derivative work. Nor is a novelty crown based on one worn by the Statue of Liberty.

## **V. WHO OWNS THE COPYRIGHT?**

The creator does unless he or she transferred the copyright to another or the work is one for hire. If the work is for hire, the employer or hiring party owns the copyright.

Works for hire are those created by the employee within the scope of his or her employment. Some examples of works for hire are: (a) a photograph created by a staff photographer of a newspaper during the normal course of that photographer's employment; and (b) a musical arrangement written for a music company by an arranger on its staff.

A work will also be for hire where: (a) the hiring party specially ordered or commissioned it for one of several statutorily specified uses, including as a contribution to a magazine or as part of a motion picture; and (b) "the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire." The work for hire agreement does not have to contain the magic words "for hire" so long as the words used in the agreement indicate that the party commissioning the work has all rights to it.

Thus, if you authorize a third party to create a web site for you and agree in writing with that party that the site created will be a work for hire, you will own the copyright to that site. But absent that writing, the independent contractor you employ to create your site will own the copyright to the site.

### **A. What is a Joint Work and What Rights Do Joint Owners Have?**

A joint work is created when two or more authors agree to merge their contributions together to form an inseparable or interdependent combination. Here are two examples: (a) a composer and lyricist (such as Gilbert and Sullivan) contribute separate components that they intend to be combined into a single piece; (b) several programmers create portions of the code with the understanding that the portions will be merged to create a single program. The contributions to a joint work do not need to be equal in quality or quantity; the contributions must only be copyrightable and the parties must intend that their contributions merge into a unitary whole. If a joint work is created, each contributor becomes a co-owner of the work and each shares jointly in the proceeds generated by the work.

## **VI. HOW LONG DOES COPYRIGHT PROTECTION LAST?**

The term of copyright begins with the work's fixation in a tangible medium and ends 70 years after the death of the work's author, thereby empowering the author's heirs or successors to enforce all rights of the author during this 70-year period.

If the work is for hire or is owned by a corporation, copyright protection lasts for 95 years from the work's publication or 120 years from its creation, whichever ends first. In the case of joint works, the copyright term extends for the life of the last surviving author plus 70 years after that author's death.

## **VII. THE IMPORTANCE AND BENEFITS OF REGISTRATION**

### **A. What is Registration?**

Registration puts the public on notice of facts with respect to the copyright. Registration is not a condition to copyright protection. But you must register works of U.S. origin with the Copyright Office before bringing suit. However long the Copyright Office takes to process an application, the date of registration will be when the Copyright Office received the application.

### **B. How Do You Register?**

You now have the option of using the Copyright Office's online system which offers a lower registration fee (\$35 for online registration vs. \$45 for a paper application), faster processing time and online tracking or registering by written application. If you opt for written application, you should use the new fill-in form CO. Because the new form employs scanning technology, the Copyright Office processes these forms much faster and more efficiently than paper forms that you complete manually. Whether method you choose, you deliver the registration form, the fee and a sample of the work being registered to the Copyright Office. For additional information or help in filling out the registration form, go to the Copyright Office's website at <http://www.copyright.gov> or call their helpline at (202) 707-5959.

### **C. What Kinds Of Works Can Be Registered?**

All works, whether published or unpublished.

#### **D. What Are The Benefits of Registration?**

“Timely” registration gives you the right to recover what are called statutory damages and possibly attorneys’ fees. The prospect of recovering statutory damages and attorneys’ fees is a useful bargaining club in inducing an infringer to settle. Your work will be timely registered and thus qualify for statutory damages if you registered it at any time before the work was infringed. If infringed, the work will qualify for statutory damages if you registered it within 3 months of the work’s initial publication which is defined as its distribution to the public.

#### **E. What are Statutory Damages?**

They are a range of damages set by Congress recoverable if you timely registered the infringed work. The trial judge or jury determines these damages at the end of the case based on the blameworthiness of the defendant-infringer.

There are three ranges of possible statutory damages. First, if the judge or jury determines that an infringement was willful, they can set statutory damages from \$30,000 to up to \$150,000 for each work infringed. Second, if you are unable to prove that the infringement was "willful," you can be awarded statutory damages of "not less than \$750 or more than \$30,000" per work infringed. Third, if the infringer demonstrates that it committed the infringement innocently, the infringer can be assessed statutory damages of “not less than \$200” per infringed work.

#### **F. What is an Example of “Willful Infringement?”**

In the absence of a definition of willfulness in the Copyright Act, the courts have stated that there are three ways to establish willfulness: actual awareness that one’s conduct is infringing; acting in reckless disregard for the copyright owner’s rights or willful blindness of them.

Here is an example of each category of willfulness. Courts have found actual awareness where a defendant, after being warned by what is referred to as a cease and desist letter that its conduct is infringing, continues that conduct. An example of reckless disregard is where a defendant uses another’s copyrighted work without attempting to obtain permission from the copyright owner even though that owner has placed a copyright notice on its work and warned others not to use the work without permission.

Willful blindness means wanting not to know that one is infringing. That blindness arises where one suspects wrongdoing and deliberately fails to investigate it. An example is where a company profits from its sales of pirated DVDs without taking any steps to determine if it was authorized to make those sales.

#### **G. What Damages Can You Recover If You Register an Infringed Work More Than Three Months After Its First Publication?**

If the registration is untimely (made with respect to an infringed work more than three months after the work was first published), you will only be entitled to recover actual damages and whatever lost profits you can show that resulted from the infringement. Your actual damage is the lost license fee the infringer would have paid you if the infringer had instead negotiated with you for the use of the work.

A lost license fee can be small (\$100-\$200) depending on the market value of the work infringed compared with up to \$150,000 for each work willfully infringed. Further, proving the infringer’s profits arising from the infringement may be difficult, especially if your work is only one of many included in an infringing product. For example, assume that your work consists of three illustrations that appear in an infringing book containing hundreds of illustrations. Determining the extent to which the profits from the infringing work are attributable only to your illustrations is no easy task and will most likely require that you retain an accounting expert at considerable cost to assist in that determination.

### **VIII. WHAT IS A COPYRIGHT NOTICE AND WHAT ARE ITS BENEFITS?**

A copyright notice contains three elements: the copyright symbol; the name of the copyright holder; and the date the work was published. For works created after March 1, 1989, you don’t have to attach a notice to your work for it to be protected by copyright. But you should include a notice. It tells the world that you are the copyright owner and thus prevents an infringer from later claiming that it infringed innocently. Stripped of an innocence defense, the infringer faces increased statutory damages.

### **IX. HOW TO ESTABLISH INFRINGEMENT**

Establishing copyright infringement is a step-by-step process that is often confusing. You must first show you own a valid copyright in the work infringed and that the elements of your work that have been copied amount

to what the courts refer to as an improper appropriation. To prove copying, you must demonstrate that defendants actually copied the work or that the defendant had the work in mind when the defendant created the work.

### A. Establishing Copying

An infringer usually will not admit to copying; but *Rogers v. Koons* was an exception. There, Mr. Koons, a self-styled appropriation artist, admitted he told his artisans to copy plaintiff's photograph to create the infringing sculpture (both below).

*Rogers v. Koons, 960 F.2d 301 (2d Cir. 1992)*

*Plaintiff's Photo*



*Rogers v. Koons, 960 F.2d 301 (2d Cir. 1992)*

*Defendant's Sculpture*



In the absence of direct evidence of copying, a court may infer copying if you prove that defendant had access to your work and that both works share what the Second Circuit refers to as “probative similarities.”

## B. Demonstrating that Defendant Had Access

Access means that an alleged infringer had a reasonable possibility—not simply a bare possibility—of hearing or seeing your work. Evidence that a corporation received your work is not enough. You will need to show a connection between the individual recipients and those responsible for creating the infringing product. For example, simply sending your work unsolicited to a network will not establish access if it later airs a work that is similar to yours. But if you send your work to a particular person within the network and you can demonstrate that that person passed on your work to those who develop content for the network, you may then be able to show access if it later produces a work similar to yours.

Access may also be inferred where your work has been widely disseminated. You don't have to show that the defendant actually saw the work; it is enough that defendant had the opportunity to see the work. For example, if the defendant subscribed to a magazine and received the issue containing your work, you don't have to show that the defendant actually viewed your work in that magazine to demonstrate access. But you can't simply rely on speculation and conjecture.

## C. Demonstrating Probative Similarity

To show what the courts refer to as probative similarity (as opposed to substantial similarity), a court compares the two works, including their public domain or non-protectible elements. The similarities need only raise a question of actual copying. For example evidence in one case was sufficient to raise a question of copying where both photographs were “taken in the same small corner” of the same “nightclub,” the “same striking mural appears as a background,” both subjects “are seated and holding a musical instrument,” and the “lighting [and] camera angle” were similar.

## D. Showing Substantial Similarity

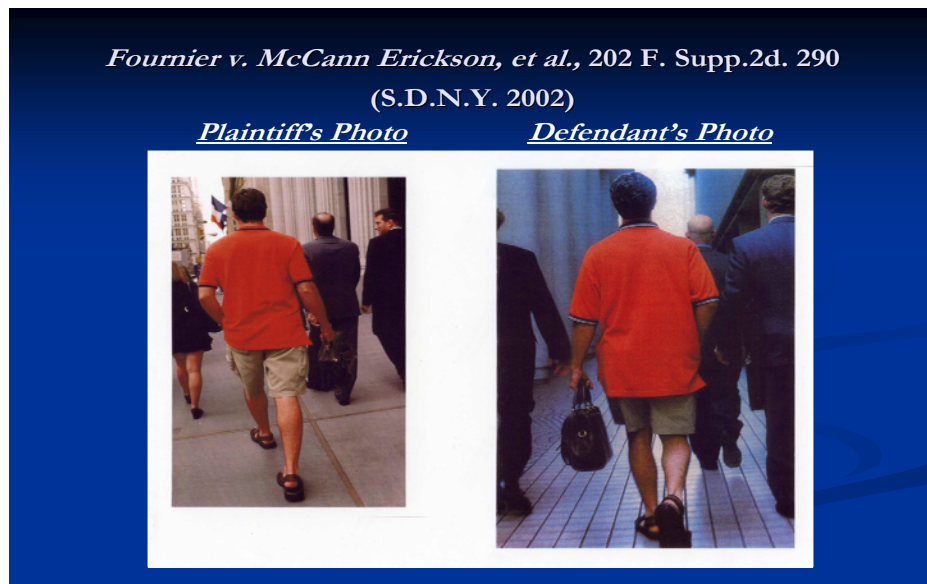
If there is copying, you must then show that the works are substantially similar. Substantial similarity is a term of art. It is also a conclusion, not a formula. Determining whether the protectible elements of two works are substantially similar is a difficult question for which there are no useful guidelines. Without referring to the specific works in question, it is almost always impossible to say whether the defendant took too much of the plaintiff's work. As one case correctly observed, “Good eyes and common sense may be as useful as deep study of reported and unreported cases, which themselves are tied to highly particularized facts.”

## E. Distinguishing Between Idea and Expression: Three Examples

In determining substantial similarity, the court attempts to distinguish between the idea underlying your work and its expression. Only the expression is protectible. Some examples of how courts have drawn the boundary between idea and expression will aid in understanding that boundary.

### 1. The *Fournier* Case

In this case, the idea underlying plaintiff's photo below was to depict a casually dressed man walking down a city street surrounded by businessmen. The court found that defendant's photo (also below) shared enough similarities in the expression of that idea to deny defendant's request for summary judgment seeking to dismiss the case.



In reaching that result, the court noted the flowing similarities in expression:

- a. both use a background bordered by structures with imposing columns on one side and office buildings on the other;
- b. the poses of the models and what they wear are similar; plaintiff's photo depicts a commuter casually dressed in a reddish-orange polo shirt with border stripes on the sleeves and collar; defendant also shows a young man in a slightly brighter orange polo shirt with marginally different stripe patterns;
- c. the models carry similar leather bags that are variants of the traditional briefcase.
- d. the models are tightly flanked, although in varying degrees, by businessmen in traditional suits. A balding, well-dressed businessman appears in both pictures directly to the right of the model.
- e. the angles, although not identical, are also similar. The casually dressed commuter is the central figure in both works, occupying the position closest to the photographer. The other models are situated slightly ahead of the central figure.

## **2. *Rogers v. Koons***

In *Rogers v. Koons* (photos above), the court stated that the idea underlying plaintiff's photo was to depict a couple with eight small puppies seated on a bench. The court found that defendant's sculpture infringed because it copied plaintiff's expression of this idea. The appellate court stated that defendant had copied the following elements of Rogers' expression: his composition, light, placement and poses and expressions of his subjects.

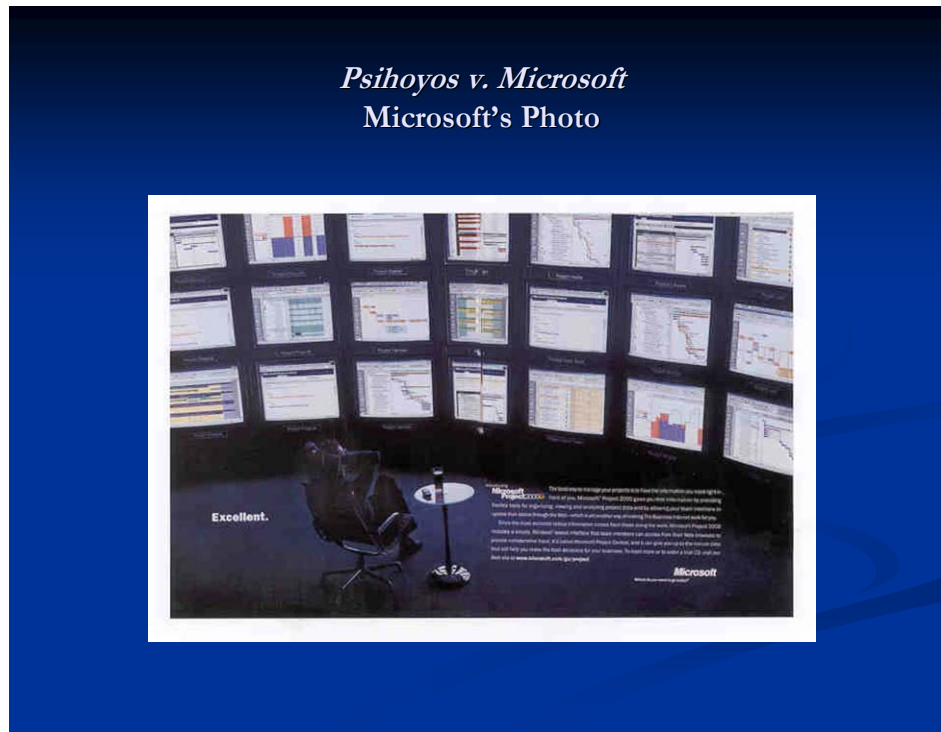
## **3. 500 TVs: *Psihoyos v. Microsoft***

The third case involves a celebrated photo called 500 TVs that photographer Louis Psihoyos created.



Mr. Psihoyos wanted to convey the idea of a man relaxed and in control of multiple streams of information. To express this idea, he obtained 100 TV screens, 100 VCRs and access to a warehouse to conduct the shoot; covered the windows in the warehouse in black velvet to seal out all natural light; videotaped still images from entertainment or news programs so that the TV screens would display the stills in primary colors; stacked the 100 TV screens in rows on shelves he painted black and arranged the shelves in a parabola; painted the floor with two-coat epoxy; had a male model dress in casual business clothes with rolled-up sleeves; selected an office chair with five legs and placed the model in the chair in the center of the room with his back to the camera and with no barrier separating him from the screens he faces; backlit the set by having the blue light emitted by the TV screens serve as the only light source; and had the model pose with his legs crossed, looking at the screens with his hands behind his head. From a ten-foot ladder, Mr. Psihoyos created his photograph in five exposures. He first shot 100 screens; then moved the screens to the next location on the set, shot that section, thereby creating the second exposure and repeated the process three more times. He then fused the five exposures together completing the photograph. The photograph has enjoyed commercial and critical success.

Mr. Psihoyos sued Microsoft and its ad agency when they created a similar photo.



In a case this firm handled, we argued that defendants captured the expression underlying Mr. Psihoyos' photo because each photo: (a) depicts the model in the same relaxed pose sitting with hands behind his head and legs crossed facing a bank of monitors arranged in a parabola; (b) shows the model similarly dressed, sitting in a similar office chair; (c) uses exclusively backlit lighting; (d) has a similar raised perspective with the viewer looking down at the model and monitors; (e) presents a horizontal composition that focuses the viewer's eye towards the bank of monitors; and (f) places the model in the center of the photo, a few feet in front of the monitors.

Our able adversary argued that Mr. Psihoyos' photo of a person in a "control room" facing a bank of monitors was commonplace and therefore not protectible. He presented a videotape of similar scenes from various media, including the Simpsons TV show, showing some of the same elements present in Mr. Psihoyos' photo. We resolved the case on a confidential basis after each side had moved for summary judgment.

## **X. THE FAIR USE DEFENSE TO INFRINGEMENT**

One of the most potent defenses to infringement is the doctrine of fair use. That doctrine allows you to use another's copyrighted work without permission if your use is for a socially beneficial purpose. The courts reason that the social or public benefit from the use outweighs the harm to the copyright owner.

### **A. The Elements of Fair Use**

Works created for purposes of criticism, parody, comment, news reporting, teaching, scholarship or research are likely candidates for fair use. Courts in determining whether the use is fair examine four non-exclusive factors: (a) the purpose and character of the use; (b) nature of the copyrighted work; (c) amount and substantiality of the portion of the copyrighted work used; and (d) the effect of the use upon the potential market for or value of the copyrighted work.

But predicting whether a challenged work qualifies for fair use is nearly impossible. That is because courts do not agree what the fair use doctrine means; and the cases are imprecise, inconsistent and results-oriented. A judge often appears to first decide whether or not to allow the use and then aligns the four factors to justify the result.

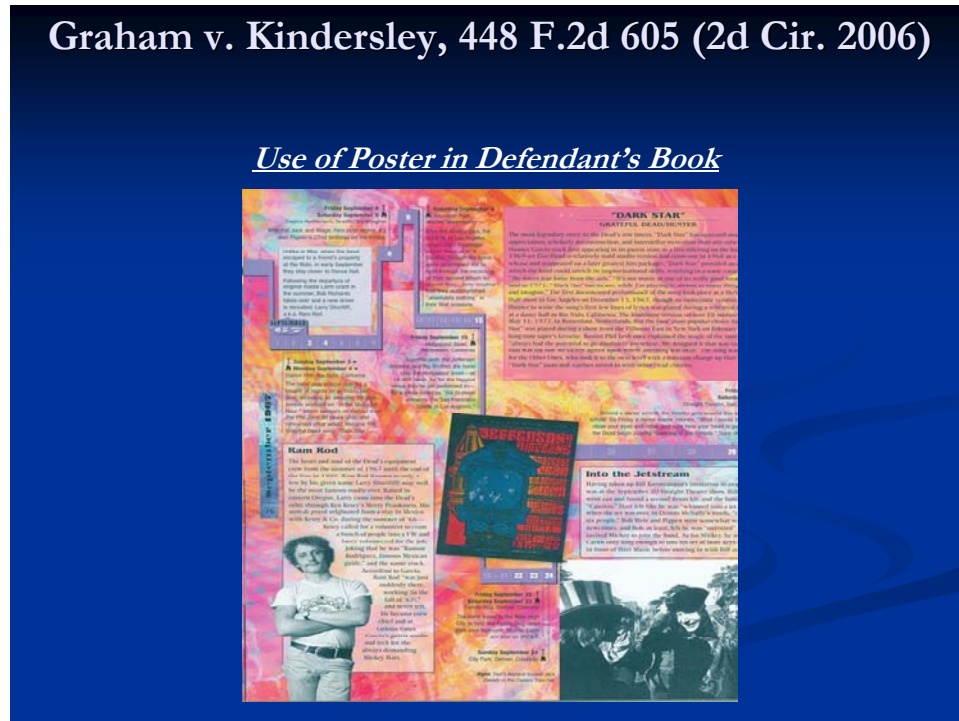
### **B. Application of Fair Use to Three Cases in the Second Circuit**

The first factor, the purpose and character of the use, may be the most important. This factor asks whether the new work adds something new to the original work, giving it a further purpose or different character or

altering the first with new expression, meaning, or message. Courts refer to works that fall into this category as ‘transformative.’”

Two recent cases illustrate that the more transformative the use the more likely courts will find the use to be fair. In the first, *Graham v. Kindersley*, defendant publisher used without authorization seven famous Bill Graham concert posters in a 480-page Grateful Dead biography.

The Second Circuit affirmed the dismissal of the action, finding the use transformative because the posters were not used for their original purpose, to promote the concerts, but for a different purpose, “as historical artifacts” to enhance the “biographical information” about the Grateful Dead in the book and to provide a “visual context” for its accompanying text. One of the posters appears on in the center of the page below.



The court, in finding the use fair, noted that the publisher had minimized the expressive value of the posters by reducing them in size, combining them into a collage and ensuring that they accounted for only “an inconsequential portion” of the book. Each poster was also used only one time inside the book not on the covers or in any advertising for the book. As counsel for the publisher successfully argued to the appellate court, if the publisher could not make the use it did, then what less could it have done except to forgo use altogether.

In another recent case, *Blanch v. Koons*, plaintiff created a photograph for a fashion magazine of a woman’s lower legs and feet wearing Gucci sandals resting on a man’s lap. Plaintiff depicted the legs and feet at close range; and they dominate the photo.

*Blanch v. Koons, 467 F.3d 244 (2d Cir. 2006)*

*Plaintiff's Photo*



Jeff Koons changed the photograph and the use plaintiff had made of it. Koons copied the legs and feet from the photograph and shifted their orientation so they point vertically downward. (They are the second pair of legs and feet from the left in the collage below.) Koons added three other pairs of women's feet and legs to the collage, all dangling over images of food and landscapes.

*Blanch v. Koons, 467 F.3d 244 (2d Cir. 2006)*

*Koon's Collage Painting*



The district court dismissed plaintiff's infringement action and the Second Circuit affirmed finding fair use.

The appellate court accepted Koons' argument that he was motivated to create the collage to "comment on the ways in which some of our most basic appetites—for food, play, and sex—are mediated by popular images. By re-contextualizing these fragments as I do, I try to compel the viewer to break out of the conventional way of experiencing a particular appetite as mediated by mass media."

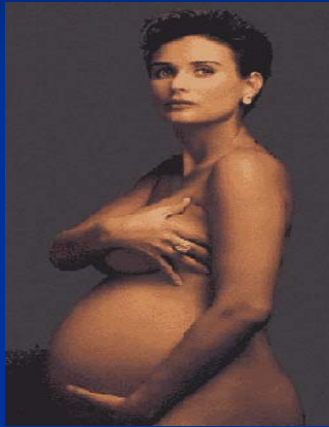
The court found the collage transformative because Koons "stated objective is thus not to repackage ... [plaintiff's photo], but to employ it in the creation of new information, new aesthetics, new insights and understandings. When, as here, the copyrighted work is used as raw material in the furtherance of distinct creative or communicative objectives, the use is transformative."

The court also noted that Koons had changed the photograph's "colors, the background against which it is portrayed, the medium, the size of the objects pictured, [and] the objects' details." The court added that "Koons had a genuine creative rationale" to borrow plaintiff's photograph "to satirize life as it appears when seen through the prism of slick fashion photography."

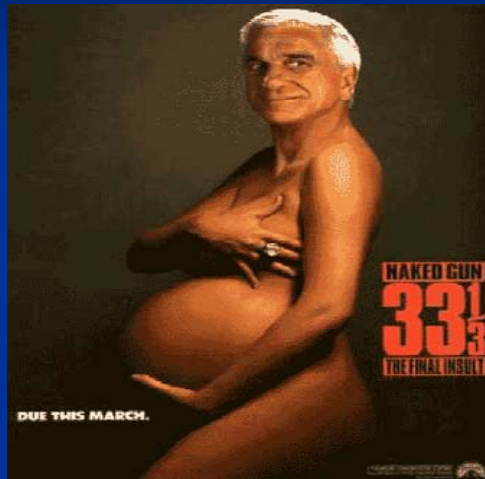
The third case, *Leibovitz v. Paramount*, is an example of a protected parody, the favorite son of fair use. A parody is a literary or artistic work that targets or imitates the characteristic style of an author or a work for comic effect or ridicule. Courts generally protect parodies because they provide entertainment and social criticism. One important factor prompting a finding of fair use is if the parody is unlike any the copyright owner might be expected to create.

In *Leibovitz v. Paramount* (photos below), defendant created an ad for its film *Naked Gun* by superimposing Leslie Nielsen's face on plaintiff's well-known photo of Demi Moore's 7 months-pregnant, naked body. The Second Circuit found that Paramount's photo was fair use because that photo not only differed from Annie Leibovitz's work but ridiculed what a viewer might perceive as the undue self-importance conveyed by the subject of the Leibovitz photo.

*Leibovitz v. Paramount Pictures, Corp.*, 137  
F.3d 109 (2d Cir. 1998)



*Leibovitz v. Paramount Pictures, Corp.*, 137  
F.3d 109 (2d Cir. 1998)



## XI. THE STEPS YOU SHOULD TAKE IF YOUR WORK HAS BEEN INFRINGED

Here is a checklist you may wish to follow if you have been the victim of infringement:

- Check to see if you registered your infringed work with the Copyright Office. If so, did you register before the infringement or within three months of the work's initial publication, thereby entitling you to statutory damages?
- Try to find out how the alleged infringer obtained access to your work. Was it by license? If so, examine the license to see if it contemplated or could be interpreted to authorize the challenged use.
- Did you orally consent at some point to the alleged infringer's use of your work? If so, try from any available documentation to determine the scope of the consent you provided.
- Did you place a copyright notice on the work before it was published, thereby preventing the alleged infringer from arguing that its use was innocent.
- How much money has the work generated? The more valuable the work is in the marketplace the greater the lost license fee you may be able to recover in actual damages assuming you did not timely register the work.
- Also examine the alleged infringing work to determine what elements of your work were copied. Was the heart of the work copied or merely some of its elements?

## XII. THE STEPS YOU SHOULD TAKE IF YOU HAVE BEEN ACCUSED OF INFRINGEMENT

Here is a checklist:

- Try to obtain a copy of the registration for the allegedly infringed work from the Copyright Office's web site to see if that work was timely registered.
- Did you participate in the creation of the allegedly infringed work? If so, you may have some rights to it.
- Were you authorized, either orally or in writing, to exploit the work?
- Find out if the work that was allegedly infringed is protected by copyright or in the public domain.
- Did you innocently made use of the work without knowing it was protected by copyright?
- Did you make fair use of the work by using it, for instance, for educational purposes?
- Also focus on the three years statute of limitations for copyright infringement. The three-year period starts to run in the federal courts within the Second Circuit from the date the infringement took place even if the victim of the infringement was unaware of the infringing activity until much later. Thus, see whether the three-year statute has run by the time the victim threatens you with suit.

© 2008 Andrew Berger



**Tannenbaum Helpern  
Syracuse & Hirschtritt** LLP

New York | London

Note: this outline is general in nature and is not intended as a substitute for legal advice or a legal opinion in response to a specific set of facts and should not be relied on for that purpose. If you wish additional information about the above, please contact Andrew Berger at (212) 702-3167 or at [berger@thshlaw.com](mailto:berger@thshlaw.com).