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Originality Proxies

TOWARD A THEORY OF COPYRIGHT AND CREATIVITY

Eva E. Subotnik[†]

INTRODUCTION

Theoretically, a perfect photograph is absolutely inexhaustible. In a picture you can find nothing which the artist has not seen before you; but in a perfect photograph there will be as many beauties lurking, unobserved, as there are flowers that blush unseen in forests and meadows.¹

The recent copyright “case” célèbre *Shepard Fairey v. Associated Press*,² a dispute over images at the heart of a successful presidential campaign, involved a photograph that depicted the intent face of Barack Obama framed by the soft backdrop of the American flag (the “Obama Photograph”).

[†] Assistant Professor of Law, St. John’s University School of Law. The funding for this article was generously provided by the Kernochan Center for Law, Media and the Arts at Columbia Law School during my tenure as an Intellectual Property Fellow. Many thanks to Johan Axhamn, June Besek, Vincent Blasi, Robert Clarida, Jessica Clarke, Mathilde Cohen, Brett Dakin, Erin Delaney, Harold Edgar, Christine Haight Farley, Robert Ferguson, Jane Ginsburg, Lital Helman, Scott Hemphill, Bert Huang, Dan Hunter, Kathryn Judge, Michael Kavey, Joseph Landau, Greg Lastowka, Dina Leytes, Phillipa Loengard, Clarisa Long, Jeffrey Malkan, Saira Mohamed, Anthony O’Rourke, Burak Ozgen, Jessica Roberts, Bertrall Ross, Tali Schaefer, David Simon, Irene Ten Cate, Rebecca Tushnet, Carissa Vogel, Martha Woodmansee, Tim Wu, Diane Leenheer Zimmerman, the participants of the 2010 Intellectual Property Scholars Conference, and the participants of the Columbia Law School Associates and Fellows Workshop. This article is dedicated to the memory of Professor Mayer Freed, greatly missed, who was similarly drawn to law and photography.

¹ Oliver Wendell Holmes, Sr., *The Stereoscope and the Stereograph*, in CLASSIC ESSAYS ON PHOTOGRAPHY 71, 77-78 (Alan Trachtenberg ed., 1980).

² No. 09 Civ. 1123 (S.D.N.Y. Feb. 9, 2009).



AP Images/Mannie Garcia

The case proceeded under competing theories of infringement and fair use, inquiring into the nature of the relationship between the photograph, taken by AP photographer Mannie Garcia,³ and the campaign posters that graphic artist Shepard Fairey created based on it. Thus, the court filings probed whether the posters were sufficiently “transformative,” in the parlance of fair use, and whether they usurped the photograph’s rightful market.⁴ Also swirling around the Obama Photograph were important and recurring questions about the level of originality and authorship reflected in the photograph itself. Cultural critic Luc Sante, for example, suggested that such a photograph “might have been taken by a child or a robot or a chimpanzee—it’s nowhere near as hard as randomly typing Shakespeare, and for that matter, it’s a lot more a matter of luck than are most of the great pieces of photojournalism.”⁵

³ At one point in the litigation, the nature of Garcia’s relationship with the AP during the relevant period, that of independent contractor or employee status, was contested; Garcia, who claimed the former status, ultimately withdrew from the litigation. *See* Stipulation of Discontinuance With Prejudice, *Fairey v. Associated Press*, No. 09 Civ. 1123 (S.D.N.Y. Aug. 20, 2010).

⁴ *See, e.g.*, Amended Complaint for Declaratory Judgment and Injunctive Relief, at 4, 11, *Fairey v. Associated Press*, No. 09 Civ. 1123 (S.D.N.Y. Nov. 13, 2009); Associated Press’s First Amended Answer, Affirmative Defenses and Counterclaims, at 14-15, *Fairey v. Associated Press*, No. 09 Civ. 1123 (S.D.N.Y. Nov. 12, 2009) [hereinafter AP Amended Answer].

⁵ Noam Cohen, *Viewing Journalism as a Work of Art*, N.Y. TIMES, Mar. 23, 2009, at C2 (quoting Sante).

Provocative as Sante's comments are, they do not purport to address—and yet succeed in raising—the legal question of whether the Obama Photograph is an original work of authorship entitling it to copyright protection.⁶ One might suppose that the answer to this question was a foregone conclusion; photographs—especially those of human subjects—have long been deemed, on the highest authority, a worthy subject for copyright protection.⁷ Further, the instances in which courts have denied them protection on originality grounds are very rare and, so far, untested by appellate review.⁸ Nevertheless, court dockets bustle with copyright litigation in which the defendant argues that the plaintiff's photograph lacks originality. Courts continue to feel it necessary (and perhaps enjoy the opportunity) to engage at length with this argument.⁹ Copyright scholars, too, have continued to question the originality of photographs taken in varying contexts and for varying purposes.¹⁰ Some scholarship has taken explicit issue with the protection available for the likes of the Obama Photograph. Accepting the photograph's likely protectability under the current copyright regime, Professor Joseph Miller has maintained that, to the extent such an “accurate, anodyne, [and] conventional” photograph is

⁶ See 17 U.S.C. § 102(a) (2006) (providing for copyright protection for “original works of authorship fixed in any tangible medium of expression”); *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) (determining that originality is a constitutional requirement for copyright protection).

⁷ See *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 60 (1884); see also *Thornton v. Schreiber*, 124 U.S. 612 (1888); *infra* Part I.A.

⁸ In *Oriental Art Printing Inc. v. GS Printing Corp.*, 34 Fed. App'x 401 (2d Cir. 2002), the Second Circuit did not reach the district court's conclusion on this question. *Id.* at 402.

⁹ Almost fifty years ago, Professor Robert Gorman noted how much time courts spent on the question of originality in photography; the issue remains lively today. See Robert A. Gorman, *Copyright Protection for the Collection and Representation of Facts*, 76 HARV. L. REV. 1569, 1596 (1963).

¹⁰ See, e.g., JUSTIN HUGHES, *The Photographer's Copyright*, in AUTHOR IN THE MACHINE: CREATIVITY, COPYRIGHT, AND THE COMPUTER (October 2010) (unpublished manuscript) (on file with the author); Kathleen Connolly Butler, *Keeping the World Safe from Naked-Chicks-in-Art Refrigerator Magnets: The Plot to Control Art Images in the Public Domain Through Copyrights in Photographic and Digital Reproductions*, 21 HASTINGS COMM. & ENT. L.J. 55, 103-14 (1998); Gorman, *supra* note 9, at 1594-1600; Jeffrey L. Harrison, *Rationalizing the Allocative/Distributive Relationship in Copyright*, 32 HOFSTRA L. REV. 853, 898-904 (2004); Michael J. Madison, *Beyond Creativity: Copyright as Knowledge Law*, 12 VAND. J. ENT. & TECH. L. 817, 818-19 (2010); Joseph Scott Miller, *Hoisting Originality*, 31 CARDOZO L. REV. 451, 456-57 (2009).

sufficiently original so as to be protected by copyright, “so much the worse . . . for copyright law.”¹¹

So, should this photograph be considered original for the purpose of copyright? Should all photographs? This article contends that a definitive account of originality as a legal construct is not possible and that, as a result, the current low threshold for originality should be maintained. Under this analysis, most photographs, so long as they comply with certain requirements, should be granted protection, at the very least, against exact copying (for example, through digital copying and pasting). Arriving at this conclusion, however, requires a return to first principles, that is, to the copyright concepts of authorship and originality. These concepts saw their most recent articulation by the Supreme Court in the 1991 landmark decision of *Feist Publications, Inc. v. Rural Telephone Service Co.*, which held that the white page phone listings before it did not merit copyright protection.¹² The Court determined that originality is a constitutional prerequisite for copyright protection and that it entails a two-pronged showing: (1) “that the work was independently created” (that is, that it was not copied), and (2) that the work manifests “some minimal degree of creativity.”¹³ The white page listings failed on the second count; they comprised a factual compilation reflecting insufficient “creative spark.”¹⁴

Since *Feist* was handed down, a vast body of academic work has focused on how the decision should apply outside its immediate factual predicate to other sorts of works. One group of scholars has focused on the degree to which fact-driven works, such as maps, site plans, and many compilations, should be afforded—post-*Feist*—the protections of copyright law.¹⁵ For some, there was concern that socially useful works

¹¹ Miller, *supra* note 10, at 456; see also Madison, *supra* note 10, at 818-19 (questioning the creative merits of the Obama Photograph). For additional discussion of various aspects of the Obama Photograph, including protectability, scope of protection, and fair use, see HUGHES, *supra* note 10, at 28-32 and H. Brian Holland, *Social Semiotics in the Fair Use Analysis*, 24 HARV. J.L. & TECH. (forthcoming 2011).

¹² 499 U.S. 340 (1991).

¹³ *Id.* at 345.

¹⁴ *Id.* at 345, 362-64.

¹⁵ See, e.g., Howard B. Abrams, *Originality and Creativity in Copyright Law*, LAW & CONTEMP. PROBS., Spring 1992, at 3; Alan L. Durham, *Speaking of the World: Fact, Opinion and the Originality Standard of Copyright*, 33 ARIZ. ST. L.J. 791 (2001); Jane C. Ginsburg, *No “Sweat”? Copyright and Other Protection of Works of Information After Feist v. Rural Telephone*, 92 COLUM. L. REV. 338 (1992); Justin Hughes, *Created Facts and the Flawed Ontology of Copyright Law*, 83 NOTRE DAME L. REV. 43 (2007); Dennis S. Karjala, *Copyright and Creativity*, 15 UCLA ENT. L. REV. 169 (2008)

that could be characterized as “too factual” would be produced at suboptimal levels in the face of uncertain protection.¹⁶ A second group of scholars has addressed the ways in which *Feist* should be applied to works closer to what we might loosely deem “the arts.”¹⁷ As Professor Robert Gorman noted, *Feist* “does not address—obviously, the Court had no cause to—the question of how the ‘creative spark’ standard is to be applied to works of art, music and literature.”¹⁸ A number of the scholars taking up this latter question have expressed the opposite concern from the first group. They have cautioned that too many nominally creative works are granted the exclusivity rights of copyright and that these sorts of works ought to undergo more robust scrutiny on originality grounds.¹⁹

Situating photography on the fact-art continuum suggested by *Feist*, and theorizing whether the opinion might

[hereinafter Karjala, *Copyright and Creativity*]; Dennis S. Karjala, *Copyright in Electronic Maps*, 35 JURIMETRICS J. 395 (1995); Douglas Lichtman, *Copyright as a Rule of Evidence*, 52 DUKE L.J. 683 (2003); Jessica Litman, *After Feist*, 17 U. DAYTON L. REV. 607 (1992); Leo J. Raskind, *Assessing the Impact of Feist*, 17 U. DAYTON L. REV. 331 (1992); Pamela Samuelson, *The Originality Standard for Literary Works Under U.S. Copyright Law*, 42 AM. J. COMP. L. SUPP. 393 (1994); David E. Shipley, *Thin But Not Anorexic: Copyright Protection for Compilations and Other Fact Works*, 15 J. INTEL. PROP. 91 (2007); Marc K. Temin, *The Irrelevance of Creativity: Feist's Wrong Turn and the Scope of Copyright Protection for Factual Works*, 111 PENN ST. L. REV. 263 (2006); Alfred C. Yen, *The Legacy of Feist: Consequences of the Weak Connection Between Copyright and the Economics of Public Goods*, 52 OHIO ST. L.J. 1343 (1991).

¹⁶ See, e.g., Ginsburg, *supra* note 15, at 353; Hughes, *supra* note 15, at 92; Karjala, *Copyright and Creativity*, *supra* note 15, at 182.

¹⁷ See, e.g., Olufunmilayo B. Arewa, *The Freedom to Copy: Copyright, Creation, and Context*, 41 U.C. DAVIS L. REV. 477 (2007); Ralph D. Clifford, *Random Numbers, Chaos Theory, and Cogitation: A Search for the Minimal Creativity Standard in Copyright Law*, 82 DENV. U. L. REV. 259 (2004); Robert A. Gorman, *Copyright Courts and Aesthetic Judgments: Abuse or Necessity?*, 25 COLUM. J.L. & ARTS 1 (2001); Harrison, *supra* note 10; Madison, *supra* note 10; Miller, *supra* note 10; Gideon Parchomovsky & Alex Stein, *Originality*, 95 VA. L. REV. 1505 (2009); Russ VerSteeg, *Rethinking Originality*, 34 WM. & MARY L. REV. 801 (1993); Diane Leenheer Zimmerman, *It's an Original!(!): In Pursuit of Copyright's Elusive Essence*, 28 COLUM. J.L. & ARTS 187 (2005).

¹⁸ Gorman, *supra* note 17, at 3; see also Mitch Tuchman, *Inauthentic Works of Art: Why Bridgeman May Ultimately Be Irrelevant to Art Museums*, 24 COLUM.-VLA J.L. & ARTS 287, 304 (2001). For a lyrical approach to the white pages *qua* book, see Lizzie Widdicombe, *Endangered Species*, “In The Book,” NEW YORKER, Sept. 13, 2010, at 22-23.

¹⁹ See Harrison, *supra* note 10, at 859; Miller, *supra* note 10, at 463-64; Parchomovsky & Stein, *supra* note 17, at 1506; Zimmerman, *supra* note 17, at 205-06; cf. Madison, *supra* note 10, at 830 (noting creativity's weak role at policing entry to copyright protection and favoring a reformulated copyright policy aimed at enhancing knowledge). To be sure, there is overlap between the concerns of the two groups of scholars mentioned. Professor Dennis Karjala, for example, also has expressed concern that too many fact-driven works may be granted copyright protection even though they are more appropriate candidates either for patent protection or for no protection at all. See Karjala, *Copyright and Creativity*, *supra* note 15, at 185-87.

lead to an under- or oversupply of works in this medium, is not readily accomplished. Photography has always walked a fine line between “merely” reflecting reality and reflecting artistic imprint.²⁰ “Daguerreotypemania,” for example, captured public attention through its ability to provide portraiture at a level of exacting detail beyond anything previously imaginable.²¹ At the same time, many of the first photographers were former painters whose richly stylized work was seen as reflecting artistic sensibilities.²² Even the Supreme Court’s seminal photography decision of 1884, *Burrow-Giles Lithographic Co. v. Sarony*, potentially set up a dichotomy between “graceful” photographs, which would be protected under copyright, and those in which “accuracy” was the “highest merit,” which might not be.²³ A tension is also apparent in today’s world, where precise digital imaging is relied upon to perform surgery safely.²⁴ At the same time, modern digital photography clearly has opened up many new avenues for creativity. Indeed, some commentators argue that it is digital photography’s extreme susceptibility to creative manipulation, rather than its reflection of reality, that will come to be its hallmark.²⁵

²⁰ This vast topic, including the dual development of photography as an art form and as evidence in court proceedings, has been addressed comprehensively by others. See, e.g., Christine Haight Farley, *The Lingering Effects of Copyright’s Response to the Invention of Photography*, 65 U. PITT. L. REV. 385, 389 (2004); Jennifer L. Mnookin, *The Image of Truth: Photographic Evidence and the Power of Analogy*, 10 YALE J.L. & HUMAN. 1, 14 (1998); Jessica M. Silbey, *Filmmaking in the Precinct House and the Genre of Documentary Film*, 29 COLUM. J.L. & ARTS 107, 110-11 (2005). In his treatment of issues relating to fact-driven works, Professor Gorman evidently saw fit to categorize photographs in that group. Gorman, *supra* note 9, at 1594-1600.

²¹ JOHN TAGG, *THE BURDEN OF REPRESENTATION: ESSAYS ON PHOTOGRAPHIES AND HISTORIES* 42-43 (1993).

²² Walter Benjamin, *Little History of Photography*, in *THE WORK OF ART IN THE AGE OF ITS TECHNOLOGICAL REPRODUCIBILITY AND OTHER WRITINGS ON MEDIA* 274, 281 (Michael W. Jennings et al. eds., Edmund Jephcott et al. trans., Belknap Press of Harvard Univ. Press 2008); MARIA MORRIS HAMBURG ET AL., *THE WAKING DREAM: PHOTOGRAPHY’S FIRST CENTURY* 44-45 (1993); TAGG, *supra* note 21, at 45. Somewhat contradictorily, Benjamin says of the miniaturists-turned-photographers both that “the experience of their original livelihood stood them in good stead” and that “it is not their artistic background so much as their training as craftsmen that we have to thank for the high level of their photographic achievement.” Benjamin, *supra*, at 281.

²³ 111 U.S. 53, 59 (1884).

²⁴ The charge-coupled device, whose inventors were awarded the Nobel Prize in Physics in 2009, advanced immeasurably the fields of astronomy and medicine by enabling the digital imaging of both outer space and the human body. ROYAL SWEDISH ACAD. OF SCI., *SCIENTIFIC BACKGROUND ON THE NOBEL PRIZE IN PHYSICS 2009: TWO REVOLUTIONARY OPTICAL TECHNOLOGIES* 12-14 (2009), available at http://nobelprize.org/nobel_prizes/physics/laureates/2009/sci.html.

²⁵ See, e.g., FRED RITCHIN, *AFTER PHOTOGRAPHY* 58 (2009) (“In the digital arena one cannot with any certainty look at a photograph and say, ‘So that is how it was.’”); Raphael Winick, *Intellectual Property, Defamation and the Digital Alteration of*

On a practical level, however, photographs have been treated, in the vast majority of litigated copyright cases, as works of authorship that easily clear the originality threshold outlined by *Feist*. This tradition of near-presumptive copyright protection exists despite the fact that it is difficult in today's environment to envision a market failure—a condition justifying copyright for some commentators—with respect to the creation of photographs; they are being produced in droves.²⁶ It also exists despite the fact that, as a doctrinal matter, *Feist* seems to rule out assertions of creativity that are couched in “practically inevitable” decision making, such as the alphabetical arrangement of white page listings.²⁷ Theoretically, then, a snapshot reflecting the sole authorial input of instructing a group of subjects to gather closely and say “cheese” might fail *Feist*'s creativity requirement. Not surprisingly, however, the disputes that have fleshed out the requirements for photographic copyright have arisen over professional images,²⁸ which traditionally have involved a more sophisticated web of economic stimuli and authorial decision making than the average snapshot. The courts adjudicating these cases often seem driven by the desire to protect copyright plaintiffs from outright copying by competitors or former clients and frequently do not provide a persuasive explanation of what makes a

Visual Images, 21 COLUM.-VLA J.L. & ARTS 143, 150 (1997) (remarking that “never before has a palette of techniques existed with the variety and power now provided by the computer” by which to modify visual images); Zachariah B. Parry, Note, *Digital Manipulation and Photographic Evidence: Defrauding the Courts One Thousand Words at a Time*, 2009 U. ILL. J.L. TECH. & POL'Y 175, 176; Karen D. Williams, Comment, *Disparity in Copyright Protection: Focus on the Finished Image Ignores the Art in the Details*, 58 AM. U. L. REV. 169, 172 (2008) (“With advances in design and photography software, the lines between photography and graphic design are blurring.”).

²⁶ Indeed, it is difficult to overstate the ubiquity of photographic equipment and images. In 2007, some 250 billion digital photographs were said to have been taken and nearly one billion camera phones used. RITCHIN, *supra* note 25, at 11. In fact, despite the vast differences separating the oldest and the most cutting-edge forms of photography, both rapidly became available to the masses. See, e.g., RICHARD CHALFEN, *SNAPSHOT VERSIONS OF LIFE* 71 (1987) (discussing nineteenth century expansion); Farley, *supra* note 20, at 427 (same); Mnookin, *supra* note 20, at 12 (same).

²⁷ *Feist Publ'ns v. Rural Tel. Serv. Co.*, 499 U.S. 340, 363 (1991).

²⁸ It is true that the case adjudicating the copyright dispute arising out of the amateur filming of the J.F.K. assassination, *Time Inc. v. Bernard Geis*, 293 F. Supp. 130 (S.D.N.Y. 1968), has been influential in the development of photography copyright doctrine, but it is a highly unusual case. So far, the typical swapping of images among friends has not resulted in a discrete body of copyright jurisprudence. See John Tehranian, *Infringement Nation: Copyright Reform and The Law/Norm Gap*, 2007 UTAH L. REV. 537, 545 (describing typical unthinking, unlitigated sharing of amateur photographs); cf. Tim Wu, *Tolerated Use*, 31 COLUM. J.L. & ARTS 617, 619-20 (2008) (discussing prevalence of tolerated use and implicitly licensed use of copyrighted works).

litigated photograph original and hence protectable (an omission that is not unique to photography decisions).

Drawing upon the abundant stock of originality jurisprudence in the area of photography, this article argues that courts are ultimately doomed to fail in the quest to explain, in a satisfying way, how a work of authorship is original in and of itself. Caught between the impermissibility of relying upon aesthetic virtues, on the one hand, and the degree of effort expended by an author, on the other,²⁹ the closest courts can come to identifying originality, at least under the current copyright framework, is through proxies for the legal concept. Building upon the use of the proxy device by others in intellectual property scholarship,³⁰ this article identifies three that serve this function: the proxy of ontology, the proxy of narrative, and the proxy of comparison.

The proxy of ontology reflects the reliance by courts on a work's existence as a photograph as the basis for their originality determinations. This proxy is the most suspect under *Feist* because it implies that an image is original merely if it is not a copy³¹ and sidesteps the creativity requirement. The proxy of narrative refers to the courts' use of authorial

²⁹ See *infra* Part I.

³⁰ Several scholars have invoked the proxy device as a means of describing various aspects of the workings of intellectual property law, even if they have not all employed the particular term. See, e.g., Amy B. Cohen, *Copyright Law and the Myth of Objectivity: The Idea-Expression Dichotomy and the Inevitability of Artistic Value Judgments*, 66 IND. L.J. 175, 216, 219-20 (1990) (identifying the judge's "personal reaction" to the works, their relative commercial success, and the reputation of the creators as proxies for judicial idea/expression determinations); Christine Haight Farley, *Judging Art*, 79 TUL. L. REV. 805, 845-49 (2005) (arguing that judicial intuitions have guided judges' analysis on aesthetic issues); Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965, 1001-02, 1004 (1990) (discussing reliance by courts on burden allocation to avoid thorny originality determinations); Clarisa Long, *Information Costs in Patent and Copyright*, 90 VA. L. REV. 465, 482-95 (2004) (discussing proxies for identifying the protected features of an intellectual good); Madison, *supra* note 10, at 822 (arguing that, in light of the low creativity threshold, the "who?" of copyright is asked rather than the "what?"—that is, the content); Alfred C. Yen, *Copyright Opinions and Aesthetic Theory*, 71 S. CAL. L. REV. 247, 268, 273-74 (1998) (showing how courts' reasoning in ways that parallel aesthetic theory has served as proxy for originality determinations); see also Raymond Shih Ray Ku et al., *Does Copyright Law Promote Creativity? An Empirical Analysis of Copyright's Bounty*, 62 VAND. L. REV. 1669 (2009). Using copyright registration as a proxy for the creation of works, the authors of the latter study conclude that a rise in population, rather than the incentives afforded by the expansion of copyright protection, best accounts for the increase in the number of works documented. *Id.* at 1673-74.

³¹ See, e.g., *Schrock v. Learning Curve Int'l, Inc.*, 586 F.3d 513, 519 (7th Cir. 2009); *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1076-77 (9th Cir. 2000) (subsequent history omitted); *Ets-Hokin*, 225 F.3d at 1083 n.2 (Nelson, J., dissenting); see also 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.08[E][2].

narrative submitted by copyright plaintiffs to identify originality. Through this method, a court translates a visual work into text, a medium in which it more comfortably operates.³² The proxy of comparison reflects the way in which courts attempt to identify originality by comparing a litigated image to others, which have often been submitted by the parties. This method of relying on a visual comparison to assess a visual work arguably comes closest to grounding an originality determination in the image itself.³³

Given the courts' inability to reach originality in an unmediated fashion, the current originality threshold, which is low, should be left intact and the problematic aspects of copyright's expansiveness should be checked at other points. In contrast to scholars who argue that raising the threshold would lead to the production of more highly creative works, this article submits that such a modification would likely result in greater manipulation of the proxies, determinations based on judicial subjectivity, and/or undesirable distortions of behavior to comply with a legal rule. Finally, the article leaves off with the question of whether, to the extent raising the originality threshold would rule out copyright protection for images such as the Obama Photograph, such a move should be considered in light of the structure of American copyright and the ways in which industries may have organized themselves around that structure. Specifically, a move to withdraw protection from "low originality" works might actually impair "high creative" output where the low originality works serve as a kind of cross-subsidy for the creative endeavors, it is hoped, authors will undertake over the course of their careers.

This article proceeds in three Parts. In Part I, it discusses the originality standards that furnish the basis for judicial assessments of originality today. This Part traces the origins of the proxy approach to originality. In Part II, the article sets forth the contemporary legal settings in which questions about originality in photography typically arise—copyright infringement suits over commercial photographs. This Part develops the three proxies, described above, which function as methods for making originality determinations. Finally, Part III draws upon the standards and cases discussed in

³² See generally Rebecca Tushnet, *Worth a Thousand Words: The Images of Copyright Law*, HARV. L. REV. (forthcoming Jan. 2012).

³³ As will be discussed, a variation on this proxy exists where the relevant comparison is between an image and its depicted subject matter. See *infra* Part II.D.2.

the foregoing Parts to draw conclusions and raise questions about how the originality doctrine should be applied to photography and other “artistic” works. Diverging from recent proposals in the scholarly literature, the article argues against a heightened burden of proof for originality in works of authorship.

I. PRINCIPLES OF ORIGINALITY AND ORIGINS OF PROXIES

As the latest word on originality from the Court, *Feist* stands as a prism through which its earlier jurisprudence is to be interpreted. But it is unclear how the originality doctrine in *Feist*—and in particular, the “minimal degree of creativity” component—should be applied outside the context of that case. Did the Court intend creativity to be descriptive with respect to certain works—that is, as an explanation of why, in contrast to some fact-driven compilations, traditional works of art are protected by copyright? Or was the creativity requirement meant to be prescriptive—that is, intended to subject all works, at least at the margins, to some meaningful scrutiny? If the latter, what might such scrutiny entail? In addressing these questions, it is necessary to consider how originality was assessed prior to, and in, the *Feist* opinion.

A. *Legal Roots of Originality and Proxies*

The Copyright Act of 1976, as amended, protects “original works of authorship fixed in any tangible medium of expression” but provides no definition of the term “original.”³⁴ Discerning both statutory and constitutional imperatives, the Court in *Feist* held that copyright protection turns on the presence of originality.³⁵ In arriving at this conclusion, the Court cited a few seminal precedents, the earliest of which had referenced originality and creativity elements. The *Trade-Mark Cases* held that liability for trademark infringement could not be grounded in the constitutional clause protecting copyrights and patents³⁶ because protectable “[w]ritings” must be

³⁴ 17 U.S.C. § 102(a) (2006).

³⁵ It has been widely noted that the Constitution does not use the term “original.” See U.S. CONST. art. I, § 8, cl. 8 (granting Congress the power “To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries”). Nevertheless, the Court explicitly determined that “[o]riginality is a constitutional requirement.” *Feist Publ'ns v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991).

³⁶ U.S. CONST. art. I, § 8, cl. 8.

“original,” “the fruits of intellectual labor,” and “founded in the creative powers of the mind,” and none of those criteria was required for a protectable trademark.³⁷ While originality and creativity were thus explicitly mentioned, the concepts were not explored in great depth and were defined primarily in opposition to the supposedly mundane activity, in the Court’s view, of appropriating a symbol as a trademark.

Five years later, in *Burrow-Giles*, the Court offered its first affirmative account of originality in the copyright sense when it assessed whether the extension of federal copyright protection to photographs was constitutional.³⁸ With respect to general qualifications, the Court determined that authorial status could be bestowed upon one “to whom anything owes its origin; originator; maker; one who completes a work of science or literature.”³⁹ Likewise, protectable writings could “include all forms of writing, printing, engraving, etching, [etc.], by which the ideas in the mind of the author are given visible expression.”⁴⁰ From these principles, the Court reasoned that the Constitution could “cover an act authorizing copyright of photographs, so far as they are representatives of original intellectual conceptions of the author.”⁴¹

With respect to the particular photograph at issue, the *Oscar Wilde, No. 18* photograph, the Court accepted the lower court’s finding that it was a

useful, new, harmonious, characteristic, and graceful picture, and that plaintiff made the same . . . entirely from his own original mental conception, to which he gave visible form by posing the said Oscar Wilde in front of the camera, selecting and arranging the costume, draperies, and other various accessories in said photograph, arranging the subject so as to present graceful outlines, arranging and disposing the light and shade, suggesting and evoking the desired expression, and from such disposition, arrangement, or representation, made entirely by plaintiff, he produced the picture in suit.⁴²

Accordingly, the photograph qualified as a constitutionally cognizable writing and Napoleon Sarony, its prominent

³⁷ Trade-Mark Cases, 100 U.S. 82, 94 (1879).

³⁸ 111 U.S. 53 (1884).

³⁹ *Id.* at 57-58; see also *Feist*, 499 U.S. at 346.

⁴⁰ *Burrow-Giles*, 111 U.S. at 58.

⁴¹ *Id.* In yet another formulation, the Court similarly stated that in seeking copyright protection for a “writing,” it was important to prove “those facts of originality, of intellectual production, of thought, and conception on the part of the author.” *Id.* at 60.

⁴² *Id.*

photographer,⁴³ qualified as a constitutionally recognized author.⁴⁴ The photograph merited copyright protection.



The *Oscar Wilde, No. 18* photograph,
Copyright 1882, by N. Sarony
Courtesy of the Library of Congress

⁴³ Sarony's prominence was such that, a few years after the *Burrow-Giles* litigation, on February 4, 1890, he photographed the Justices on the occasion of the 100th anniversary of the Judiciary. According to available sources, Sarony was the only photographer to photograph that particular group of Justices, who sat together a relatively short period of time. E-mail from Franz Jantzen, Collections Manager, Office of the Curator, Supreme Court of the United States, to author (Jan. 10, 2011, 14:16 EST) (on file with author); accord Farley, *supra* note 20, at 406 & n.69; Tuchman, *supra* note 18, at 299 & n.65.

⁴⁴ *Burrow-Giles*, 111 U.S. at 58. Professor Christine Haight Farley notes that Sarony regularly worked with a cameraman, Benjamin Richardson, and that it is quite likely that Richardson was the person who pressed the shutter button and made other technical choices. Farley, *supra* note 20, at 434-35.

The Court's unqualified adoption of this elaborate description appears to reflect a full engagement with the contents of the photograph. Indeed, the artistic choices delineated in the description, including those with respect to composition, lighting, angle, and shading, have informed judicial analyses of photographs ever since.⁴⁵ Professor Christine Haight Farley has argued, however, that while ostensibly listing the attributes of the *Oscar Wilde, No. 18* photograph that render it an original, authored work, the Court in fact located authorship in the figure of the Romantic author—the photographer—who made “pre-shutter” decisions about the arrangement of the subject and scene.⁴⁶ She notes that most of the attributes praised by the Court are not qualities of the photograph per se, but rather, they constitute a running narrative of the artistic activities undertaken by the photographer in setting up the photograph.⁴⁷ Thus, she contends that the Court found authorship in photographic practice above photographic product, thereby supporting a view of photography in which a “photograph is simply a duplication of nature unless it is actively constructed” by the practices delineated.⁴⁸

One could argue, contrary to Farley, that by describing the photograph as “useful, new, harmonious, characteristic, and graceful,” the Court was attempting to lodge originality within the four corners of the image.⁴⁹ Farley herself acknowledges the Court's use of those descriptive words, but she attempts to dispel any meaningful effect they might have as a direct evaluation of the photograph by maintaining that the Court merely stated, without explaining, what made the

⁴⁵ *E.g.*, *Schrock v. Learning Curve Int'l, Inc.*, 586 F.3d 513, 519 (7th Cir. 2009); *Ets-Hokin v. Skyy Spirits Inc.*, 225 F.3d 1068, 1076-77 (9th Cir. 2000) (subsequent history omitted); *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444, 450-52 (S.D.N.Y. 2005).

⁴⁶ Farley, *supra* note 20, at 390-91, 431-32. *Accord* JANE M. GAINES, *CONTESTED CULTURE: THE IMAGE, THE VOICE, AND THE LAW* 69 (1991) (“Since personality cannot mix and mingle or flow through the machine in any way, it must make its mark without touching.”).

⁴⁷ Farley, *supra* note 20, at 427-29. This view contrasts with Professor Joseph Miller's characterization of the Court's analysis as a “work-centered” creativity inquiry. Miller, *supra* note 10, at 475-76.

⁴⁸ Farley, *supra* note 20, at 432. Accordingly, she reasons that, for the Court, the default position of photography was that it is authorless absent some “authorial intervention.” *Id.*; *cf.* GAINES, *supra* note 46, at 47 (quoting French scholar Bernard Edelman's argument that intellectually appropriating a landscape scene requires the photographer to produce it rather than reproduce it).

⁴⁹ *See, e.g.*, Yen, *supra* note 31, at 247, 268, 273-74 (arguing that the Court invoked both formalist and intentionalist theories in assessing the *Oscar Wilde, No. 18* photograph); *infra* note 56 (describing these theories).

photograph “harmonious” or “original.”⁵⁰ Farley is correct that the Court did not define these terms in a generally applicable—or textual—way, but the Court arguably did provide a concrete definition by applying the descriptive terms to the photograph itself—that is, it defined them through a visual explanation.⁵¹

However, the strength of this latter reading of the Court’s analysis is undercut, at least to some degree, by another aspect Farley identifies: that the Court’s elegant pronouncement (set out in the block quote above) did not draw upon words of its own. The very language originated not with the Court or the lower court but almost word for word from Sarony himself (or likely his counsel).⁵² Thus, as seemingly descriptive as the language of the decision might appear when held up to the image itself, the *Burrow-Giles* Court in the end relied upon a proxy for the qualities of originality it clearly viewed the photograph as possessing—not only in the form of emphasis on authorial practice, but at a more fundamental level, in the form of authorial account of authorial practice.⁵³ It suggested, in effect, that a court may deem a work original if a persuasive narrative of authorship that “owes its origin” to an author is presented.

The Court’s narrative approach to originality is also observable in the portion of the opinion in which it withheld judgment about the extension of federal copyright protection to all photographs. Specifically, the Court declined to address whether copyright would apply to the “ordinary production of a

⁵⁰ Farley, *supra* note 20, at 431-32.

⁵¹ Unlike many photography cases today, the *Oscar Wilde, No. 18* photograph was not appended to the *Burrow-Giles* opinion. It is an interesting thought experiment to imagine how the precedential effect of a case might change depending on whether a subsequent court sees or does not see a litigated photograph along with the written opinion adjudging it. For a critique of the Supreme Court’s later use of appended images in its opinions, see Hampton Dellinger, Commentary, *Words Are Enough: The Troublesome Use of Photographs, Maps, and Other Images in Supreme Court Opinions*, 110 HARV. L. REV. 1704 (1997).

⁵² Farley, *supra* note 20, at 411 & n.92, 438, 455. Professor Farley identifies Sarony’s brief as the source of the language. In fact, the origin of the language can be traced back further still, nearly word for word, to Sarony’s complaint in the lower court. See Transcript of Record at 4, 6-7, *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884) (No. 1071) (setting out the complaint in the Circuit Court for the Southern District of New York). The language appears in the second paragraph of each of Sarony’s causes of action. *Id.* While it is not uncommon for courts to adopt litigants’ language, this mode of analysis set the stage in originality decisions for close reliance on a plaintiff’s authorship narrative. See *infra* Part II.C.

⁵³ Farley, *supra* note 20, at 426, 432; see also ROBERTA ROSENTHAL K WALL, *THE SOUL OF CREATIVITY* 81 (2010) (“According to the Court, although authorship was evident in the photograph itself, the narrative supplied by the photographer was vital in assisting the Court’s perception.”).

photograph” wherein “[i]t is simply the manual operation, by the use of . . . instruments and preparations, of transferring to the plate the visible representation of some existing object, the accuracy of this representation being its highest merit.”⁵⁴ The Court did not provide guidelines for determining when a photograph might cease to be an “original intellectual conception” and fall into the “ordinary production” category—which might or might not warrant protection—other than to caution against employing too strong an authorial emphasis on photographic accuracy in litigation documents.⁵⁵ But this distinction, particularly in a highly representational medium like photography, would usually need to occur at the level of narrative presented to a court, rather than at the level of the formal properties of the image.⁵⁶

Although the Court’s reasoning in a subsequent visual arts decision, *Bleistein v. Donaldson Lithographing Co.*,⁵⁷ is often seen as a divergence from *Burrow-Giles*,⁵⁸ it is in some ways a natural extension of the earlier case. In *Bleistein*, the Court addressed an infringement action in which chromolithographic posters advertising a circus had been copied. The Court, through Justice Holmes, emphasized “the personal reaction of an individual upon nature” and the conviction that “[p]ersonality

⁵⁴ *Burrow-Giles*, 111 U.S. at 59; accord *Thornton v. Schreiber*, 124 U.S. 612, 613 (1888) (“As we have heretofore decided in the case of [*Burrow-Giles*], photographs are included, *under certain circumstances*, among the things which may be copyrighted.” (emphasis added)).

⁵⁵ As discussed *infra* Part II, the question of this emphasis would become a touchstone for originality debates in photography cases. See *Bridgeman Art Library, Ltd. v. Corel Corp.*, 36 F. Supp. 2d 191, 197 (S.D.N.Y. 1999) (plaintiffs’ stated goal of accuracy in depiction was fatal to claim). For another example of the lengths to which copyright plaintiffs will go to emphasize a lack of intent to capture the underlying subject accurately, see *Schiffer Publ’g, Ltd. v. Chronicle Books, LLC*, No. Civ.A. 03-4962, 2004 WL 2583817, at *8 (E.D. Pa. Nov. 12, 2004) (in finding originality, relying upon evidence that photographers “did not attempt to replicate fabric swatches as precisely as possible,” that they rather “stroved to create images that were visually interesting,” and noting that “several photographers clearly stated that they never compared the fabric swatches to their photographs, precisely because such a comparison was unimportant to their goals”).

⁵⁶ The distinction here is akin to that in aesthetic theory between an intentionalist approach—where one considers the creator’s intention to create a work of art—and formalist theories—where one considers the qualities within the four corners of an image. See *Farley*, *supra* note 30, at 842-43; *Yen*, *supra* note 30, at 253-58.

⁵⁷ 188 U.S. 239 (1903). Note that *Feist* cites *Bleistein* just once, and not in the section where it sets up the standards for originality. See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 359 (1991).

⁵⁸ See *Jewelers’ Circular Publ’g Co. v. Keystone Publ’g Co.*, 274 F. 932, 934 (S.D.N.Y. 1921) (subsequent history omitted); *Farley*, *supra* note 20, at 456 n.266; *Miller*, *supra* note 10, at 475; *Zimmerman*, *supra* note 17, at 201.

always contains something unique.”⁵⁹ Thus, even a “very modest grade of art has in it something irreducible, which is one man’s alone” and “[t]hat something he may copyright” unless barred by statute.⁶⁰ The Court found the posters sufficiently original to warrant copyright protection.

While one cannot help but be bemused by the parade of great masters Holmes offers up in his quest to ensure the protection of “works of little merit or of humble degree,”⁶¹ the overwhelming thrust of the opinion is to open wide the door of copyright to any work that reflects the imprint of personality. Because this might include every work ever produced, the opinion reduced, at least in theory, the role of copyright courts as art critics.⁶² Importantly, whatever doubt remained after *Burrow-Giles* as to the protectability of “ordinary” art was, in the view of Judge Learned Hand, firmly and resoundingly erased by *Bleistein*.⁶³ The originality of a work under the *Bleistein* paradigm could be equated with its having originated with an author or, as Professor Diane Leenheer Zimmerman phrases it, “if it is not copied, it is original.”⁶⁴

Given Justice Holmes’ institutional commitment to minimizing the role of courts in disputes over artistic merit, it is perhaps not surprising that unlike the text of *Burrow-Giles*, no part of the *Bleistein* opinion attempted to explain which intrinsic aesthetic qualities of the posters rendered them sufficiently original for copyright protection.⁶⁵ Rather, Holmes went out of his way to offer proxies for that determination: that, as a default proposition, works of art contain the “irreducible” imprint of individual “[p]ersonality”; that there was “express testimony” as to the posters’ originality; that the posters were copied by the defendant, reflecting their “worth.”⁶⁶ As argued above, however, the use of these proxies in fact reflects the jurisprudential approach taken in *Burrow-Giles*.

⁵⁹ *Bleistein*, 188 U.S. at 250.

⁶⁰ *Id.*

⁶¹ *Id.* at 249-51 (referencing Velasquez, Whistler, Rembrandt, Degas, Goya, and Manet).

⁶² See *id.* at 250-52; see also Diane Leenheer Zimmerman, *The Story of Bleistein v. Donaldson Lithographing Company: Originality as a Vehicle for Copyright Inclusivity*, in *INTELLECTUAL PROPERTY STORIES* 77, 96-99 (Jane C. Ginsburg & Rochelle Cooper Dreyfuss eds., 2006).

⁶³ *Jewelers’ Circular*, 274 F. at 934; accord Gorman, *supra* note 9, at 1595; Yen, *supra* note 30, at 271.

⁶⁴ Zimmerman, *supra* note 17, at 202.

⁶⁵ See Yen, *supra* note 30, at 273.

⁶⁶ *Bleistein*, 188 U.S. at 250-52.

That opinion's reliance upon a proxy—in the form of wholesale adoption of the plaintiff-author's narrative—implicitly set the stage for *Bleistein*, in which Justice Holmes could say a great deal, but not much about the works at issue.⁶⁷

In an influential pronouncement that both reflected⁶⁸ and contributed to the liberal treatment of photographs under copyright, Judge Hand extended *Bleistein*'s permissive stance on originality to photographs. In the context of assessing photographs of jewelers' trademarks used to illustrate a trade circular, he announced that “no photograph, however simple, can be unaffected by the personal influence of the author, and no two will be absolutely alike.”⁶⁹ The relevant statute in that case, the Copyright Act of 1909,⁷⁰ was like our current statute in that it protected photographs without further qualification and, according to Hand, “[t]he suggestion that the Constitution might not include all photographs seems . . . overstrained.”⁷¹ In Judge Hand's reasoning, accordingly, we see adoption of a proxy based on ontology; it is a photograph, and therefore it is original. The question thus presents itself: to what degree is this notion still valid after *Feist*?⁷²

B. *The Feist Opinion*

In the years following *Bleistein*, the Court had occasion to pronounce upon the originality of works before it,⁷³ but it was almost ninety years later that the Court re-engaged closely with the topic in *Feist*. As mentioned, it deemed originality to be both statutorily and constitutionally required for copyright protection and as entailing (1) that a work be independently

⁶⁷ The closest the opinion comes to making a judgment about the contents of the posters is in its statement that “[t]here is no reason to doubt that these prints in their *ensemble* and in all their details, in their design and particular combinations of figures, lines, and colors, are the original work of the plaintiffs' designer.” *Id.* at 250. This language is fairly noncommittal and is certainly less specifically evaluative than the effulgent language used by the *Burrow-Giles* Court.

⁶⁸ See Farley, *supra* note 20, at 438-46, for a discussion of the ways in which courts in the early aftermath of *Burrow-Giles* applied the decision.

⁶⁹ See *Jewelers' Circular Publ'g Co. v. Keystone Publ'g Co.*, 274 F. 932, 934 (S.D.N.Y. 1921) (subsequent history omitted).

⁷⁰ Pub. L. No. 60-349, § 5, 35 Stat. 1075, 1076-77 (repealed).

⁷¹ *Jewelers' Circular*, 274 F. at 934-35.

⁷² Courts that have addressed this question understand Judge Hand's viewpoint to have been rejected by *Feist*. See *Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.*, 528 F.3d 1258, 1263 n.5 (10th Cir. 2008); *Bridgeman Art Library, Ltd. v. Corel Corp.*, 36 F. Supp. 2d 191, 196 (S.D.N.Y. 1999).

⁷³ See, e.g., *Mazer v. Stein*, 347 U.S. 201, 206-08 (1954).

created (that is, not copied) by the author, and (2) that it possess a modicum of creativity.⁷⁴ The originality requirement operates at two levels, both of which are of particular relevance to photography litigation. First, in order to be eligible for copyright protection at all, a work must be sufficiently original when judged in gestalt fashion, as a whole greater than the sum of its parts.⁷⁵ Second, originality determines the scope of a work's protection. Unless the work has been copied outright in its entirety, originality performs its heavy lifting at this second level—that is, at the level of the work's parts—since an author may protect only the original elements of the work.⁷⁶ An author's ability to obtain relief will depend upon a court's determination that what the second author has appropriated are these original elements.⁷⁷ As we will see, photography litigation raises both kinds of claims.

With respect to the jurisprudential approach adopted in *Feist*, it could be argued, on the one hand, that the Court returned to, and therefore condoned, an attempt to engage directly with the contents of the work presented to it. That is, on a substantive, textual level, the Court freely characterizes the listings as “garden-variety” and “typical,” among other

⁷⁴ *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991). Although further discussion is beyond the scope of this article, it should be noted that determining whether a work is “not copied” raises difficult questions. Drawing on theory developed in other academic disciplines, such as musicology and literary criticism, a number of legal scholars have argued that the law does not sufficiently reflect the complex interconnections and borrowings that have always existed, and been encouraged, between texts. See, e.g., Arewa, *supra* note 17, at 520-44; Julie E. Cohen, *Creativity and Culture in Copyright Theory*, 40 U.C. DAVIS L. REV. 1151, 1176 (2007).

⁷⁵ Cf. *Boisson v. Banian, Ltd.*, 273 F.3d 262, 272 (2d Cir. 2001) (noting that “original works broken down into their composite parts would usually be little more than basic unprotectible elements like letters, colors and symbols”).

⁷⁶ *Feist*, 499 U.S. at 348 (“The mere fact that a work is copyrighted does not mean that every element of the work may be protected. . . . [C]opyright protection may extend only to those components of a work that are original to the author.”); Cohen, *supra* note 30, at 196 (“[T]he real value of the copyright in a given work is measured by the scope of protection it provides to the copyright owner who claims that his or her copyright in that work has been infringed.”); cf. Jeanne C. Fromer, *Claiming Intellectual Property*, 76 U. CHI. L. REV. 719, 721 (2009) (noting that the extent of copyright protection is determined “only down the road in case-by-case infringement litigation”).

⁷⁷ *Feist* set out the two principal elements of an infringement suit: “(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.” 499 U.S. at 361. As Professor Jane Ginsburg has pointed out, although the Court granted certiorari in *Feist* to adjudicate the scope of protection for the listings, *id.* at 342, the Court decided that the 1309 names, towns, and telephone numbers in the plaintiff's white pages were not copyrightable at all. Ginsburg, *supra* note 15, at 342, 349. Accordingly, despite the fact that much copyright litigation occurs over the scope of protection for a plaintiff's work, *Feist* joined *Burrow-Giles* and *Bleistein* to create a triumvirate of cases dealing with the threshold question of originality.

things.⁷⁸ On the other hand, this commentary is more comparative than definitional and, in any event, is framed in the negative, ruling out works as unoriginal rather than providing an affirmative account of creativity.⁷⁹

Feist does not provide substantive guidelines for its creativity component, nor does it address how rigorously the requirement should be applied to works of authorship for which a well-developed jurisprudence already existed, as in the case of photography.⁸⁰ Did the creativity requirement mean that photographs must now meet a higher (or lower⁸¹) burden in obtaining copyright protection, or did the requirement codify the existing liberal treatment of photography? The opinion could be read to say that, as a descriptive matter, anything that can be labeled as “art” inherently possesses the originality that is lacking in phonebook-like works. After all, the opinion flatly says that the “requisite level of creativity is extremely low” and that the “vast majority of works” do “possess some creative spark.”⁸² If the denominator for the “vast majority of works” means all works of expression ever produced (rather than in each medium), then these guidelines could be understood to indicate that a work’s status as a non-fact-driven work is a sufficient proxy for originality. In this way, the *Feist* opinion hints at the proxy of ontology discussed below. By way of a borrowed hypothetical from Judge Hand, the Court implies as much by stating that a theoretical stumbling block for protecting a familiar-sounding poem might be a novelty problem, not an originality problem.⁸³

Nevertheless, the Court’s use of unqualified language in setting out the originality requirements strongly indicates that some form of creativity scrutiny is meant, at least at the

⁷⁸ *Feist*, 499 U.S. at 362.

⁷⁹ See, e.g., Ginsburg, *supra* note 15, at 343; Justin Hughes, *The Personality Interest of Artists and Inventors in Intellectual Property*, 16 CARDOZO ARTS & ENT. L.J. 81, 101 (1998); Miller, *supra* note 10, at 481. Of course, given its resolution of the case, the failure to provide an affirmative account is not surprising.

⁸⁰ Gorman, *supra* note 17, at 3.

⁸¹ Professor Douglas Lichtman points out that “[w]ithout discussion, the *Feist* Court adopted the creativity interpretation—interestingly, adding that only a ‘minimal degree’ of creativity is necessary, even though the *Trade-Mark Cases* opinion itself contains no such qualifying language.” Lichtman, *supra* note 15, at 698.

⁸² *Feist*, 499 U.S. at 345.

⁸³ *Id.* at 345-46 (“To illustrate, assume that two poets, each ignorant of the other, compose identical poems. Neither work is novel, yet both are original and, hence, copyrightable.” (citing *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir. 1936))). The Court assumes counterfactually, for the purpose of this example, that novelty is relevant to copyright.

margins, to be applied to each work.⁸⁴ Such a conclusion, favoring a unified originality standard,⁸⁵ is bolstered by the Court's reliance upon *Burrow-Giles* and *Bleistein*—precedents grounded in the arts.

If the originality standard is applicable across the board, then a method is required for interpreting the Court's implication that some works will, or indeed "must," fail to achieve copyright protection on originality grounds.⁸⁶ These statements, to be sure, are offered in the context of discussing the protection for compilations, which raise a particular set of considerations. Yet the opinion contains the unmistakable theme that any type of work is theoretically open to challenge so as to ensure the vibrancy and integrity of the copyright regime even if, as Professor Zimmerman points out, the Court did not specify what the overall goal of the originality requirement is.⁸⁷

Writing in the immediate aftermath of *Feist*, Professor Russ VerSteege expressed concern that the originality assessment might call for a medical assessment of the subjective processes engaged in by the author to see if they evidenced

⁸⁴ The key statements are offered without reservation: the "*sine qua non* of copyright is originality" and "[o]riginal, as the term is used in copyright" requires independent creation and minimal creativity. *Id.* Professor Gorman accepts that *Feist* is applicable to traditional art works and that it calls for "an assessment of the worth or merit of a work." Gorman, *supra* note 17, at 3. But, he urges that there be "very strong reasons to withhold copyright protection from a work on account of its lack of creativity" because the "vast majority of works" are original and injecting courts into "highly subjective disputes" over aesthetic merits will constitutionalize routine copyright disputes. *Id.* at 3-4.

⁸⁵ See Ginsburg, *supra* note 15, at 341 ("The Court elected to impose a unitary concept of creative originality and declared that the Constitution compels this standard.")

⁸⁶ The Court, for example, says that there "remains a narrow category of works in which the creative spark is utterly lacking or so trivial as to be virtually nonexistent," *Feist*, 499 U.S. at 359, and that it is a "[g]iven that some works must fail" on originality grounds, *id.* at 364; see also *id.* at 358 (noting, in the context of the statutory definition of compilations, that "[n]ot every selection, coordination, or arrangement will pass muster"). Indeed, the Court closes its opinion with the unreserved view that "[a]s a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity." *Id.* at 363.

⁸⁷ Zimmerman, *supra* note 17, at 206. Professor Diane Leenheer Zimmerman is critical of *Feist* on this score, arguing that rather than providing an affirmative theory of copyright, it only rules out potential theories that had been in the running. The Court's analysis precludes, for instance, a market failure theory, since it forecloses copyright claims based on labor-intensive, "sweat of the brow" collections of facts—such as compilations of white page listings—that possess undeniable social utility. *Id.* Additionally, the Court in *Feist* rules out a pure liberty or rights-based theory of copyright insofar as it prioritizes the public's use of communicative works where only an "infinitesimal" showing of individuality has been made. *Id.* at 208.

sufficient creativity.⁸⁸ More recently, drawing on neurobiological research, Professor Ralph Clifford also has argued that the “creative spark” is not the proper way to determine creative output and that the “spark” requirement may be used to deny copyright protection to sufficiently creative works.⁸⁹

In practice, however, at least in the area of photography litigation, courts have not overtly evaluated the internal psychological processes engaged in by photographers. Furthermore, the vast majority of works have been granted threshold protection against copying.⁹⁰ The next Part fleshes out the proxies for originality that courts have utilized in contemporary photography disputes.

II. ORIGINALITY PROXIES IN CONTEMPORARY PHOTOGRAPHY CASES

Skepticism about the degree of authorship required for creating a photograph—a work capable of mass production that is mediated by machine rather than human hand—has existed since the dawn of the medium.⁹¹ As a legal matter, following the Court’s decision in *Burrow-Giles*, virtually every litigated photograph has been deemed original at the threshold level for purposes of copyright protection.⁹² Cases challenging photographs on originality grounds, however, have persisted. These challenges were perhaps fated to reassert themselves in the age of digital photography, with its ubiquitous presence in contemporary culture and further attenuation of, as Walter Benjamin phrased it, the “here and now” quality of an original.⁹³

⁸⁸ See generally VerSteeg, *supra* note 17, at 840-43; see also Russ VerSteeg, *Sparks in the Tinderbox: Feist, “Creativity,” and the Legislative History of the 1976 Copyright Act*, 56 U. PITT. L. REV. 549 (1995) (critiquing *Feist’s* creativity rule and suggesting that Congress could overturn it).

⁸⁹ Clifford, *supra* note 17, at 289.

⁹⁰ See Madison, *supra* note 10, at 830, 851 (arguing that the creativity component does not serve as a gatekeeper and critiquing the appropriateness of internal investigations into creative processes).

⁹¹ See, e.g., *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884); cf. WALTER BENJAMIN, *The Work of Art in the Age of Its Technological Reproducibility*, in 4 WALTER BENJAMIN: SELECTED WRITINGS, 1938-1940, at 251, 256 (Howard Eiland & Michael W. Jennings eds., Edmund Jephcott et al. trans., Belknap Press of Harvard University Press 2003) (“From a photographic plate . . . one can make any number of prints; to ask for the ‘authentic’ print makes no sense.”).

⁹² See, e.g., Farley, *supra* note 20, at 438-39; Tuchman, *supra* note 18, at 299.

⁹³ BENJAMIN, *supra* note 91, at 253.

One might expect that the contests over originality in photography would arise in connection to photojournalistic works. For the “factual” nature of those sorts of photographs might readily prompt arguments that protection of the images would be tantamount to the protection of facts, in violation of *Feist*.⁹⁴ And, arguably, protection under the principles of *Burrow-Giles* might prove less certain in this context since, except in portraiture, a significant number of news photographs do not emerge out of the orchestrated scenes that *Burrow-Giles* blessed as “original.” To be sure, disputes do occasionally arise out of photojournalistic images. Prior to *Fairey*, a famous assessment of authorship involved frames from the “citizen photojournalist” Abraham Zapruder’s film of the John F. Kennedy assassination.⁹⁵ The news-driven context of those kinds of images, however, is usually considered later, at the fair use stage, rather than in determining whether a plaintiff’s photograph is original in the first place.⁹⁶

The contemporary cases that continue to press questions about originality and authorship in photography arise in much less dramatic circumstances. This Part will first provide an overview of these cases. It will then present proxies that courts have used in making their determinations about originality in photographs.

A. Cases

The disputes in photography that cut to the core of the originality doctrine commence over images of perfume bottles,⁹⁷ hardware equipment components,⁹⁸ electrical products,⁹⁹ toy

⁹⁴ See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 347 (1991); cf. *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 such protection.”); *Burrow-Giles*, 111 U.S. at 59 (reserving judgment on accurate representations); 4 NIMMER & NIMMER, *supra* note 31, § 13.03[B][2][b] (“Liability likewise cannot arise to the extent that the similarity between plaintiff’s and defendant’s work is that both graphically reproduce an object exactly as it occurs in nature.” (footnotes omitted)).

⁹⁵ See *Time Inc. v. Bernard Geis Assocs.*, 293 F. Supp. 130 (S.D.N.Y. 1968).

⁹⁶ See, e.g., *L.A. News Serv. v. KCAL-TV Channel 9*, 108 F.3d 1119, 1121-22 (9th Cir. 1997) (considering footage of Reginald Denny beating); *Bernard Geis*, 293 F. Supp. at 146; see also Collette Leland, *All’s Fair in Love and News: How the Current Application of the Fair Use Doctrine Favors the Traditional Media over Amateur Content Providers*, 8 WAKE FOREST INTELL. PROP. L.J. 226 (2008) (arguing that the application of fair use disfavors the interests of non-news professionals).

⁹⁷ *FragranceNet.com, Inc. v. FragranceX.com, Inc.*, 679 F. Supp. 2d 312, 315 (E.D.N.Y. 2010).

⁹⁸ *Decker, Inc. v. G & N Equip. Co.*, 438 F. Supp. 2d 734, 738 (E.D. Mich. 2006).

trains,¹⁰⁰ mirrored picture frames,¹⁰¹ Chinese food dishes,¹⁰² fabric swatches,¹⁰³ and the like. These types of images, often produced for advertising or marketing purposes, feature products shot close up, framed with little or no background, and with any lighting and shading choices hard for the lay viewer to discern.

In some ways, the continued originality challenges are surprising. After all, these photographs are often created under the conditions addressed by the earlier Supreme Court precedents. Consistent with *Burrow-Giles*, for example, the subjects are photographed in controlled environments,¹⁰⁴ in which the photographer can make choices about lighting, focus, and the other elements and has the opportunity to “evok[e] the desired expression.”¹⁰⁵ Likewise, the fact that the purpose of these images is frequently to sell products should be no bar to protection under the rule of *Bleistein*.¹⁰⁶ Thus, originality in these circumstances would seem premised comfortably upon the rendering choices made (as to lighting, angle, etc.)¹⁰⁷ and, often, upon the arrangement of poses and scenery.¹⁰⁸

⁹⁹ E. Am. Trio Prods., Inc. v. Tang Elec. Corp., 97 F. Supp. 2d 395, 399 (S.D.N.Y. 2000).

¹⁰⁰ Schrock v. Learning Curve Int'l, Inc., 586 F.3d 513, 516 (7th Cir. 2009).

¹⁰¹ SHL Imaging, Inc. v. Artisan House, Inc., 117 F. Supp. 2d 301, 303 (S.D.N.Y. 2000).

¹⁰² Oriental Art Printing, Inc. v. Goldstar Printing Corp., 175 F. Supp. 2d 542, 544 (S.D.N.Y. 2001) (subsequent history omitted).

¹⁰³ Schiffer Publ'g, Ltd. v. Chronicle Books, LLC, No. Civ.A. 03-4962, 2004 WL 2583817, at *1 (E.D. Pa. Nov. 12, 2004).

¹⁰⁴ See, e.g., Latimer v. Roaring Toyz, Inc., 574 F. Supp. 2d 1265, 1269 (M.D. Fla. 2008), *aff'd in part and rev'd in part on other grounds*, 601 F.3d 1224 (11th Cir. 2010); *SHL Imaging*, 117 F. Supp. 2d at 303. For an argument that much of commercial photography requires merely stock lighting and set-up, see Patricia L. Baade, *Photographer's Rights: Case for Sufficient Originality Test in Copyright Law*, 30 J. MARSHALL L. REV. 149, 187 (1996).

¹⁰⁵ *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 60 (1884).

¹⁰⁶ *Bleistein* famously states that the fact that works have “a real use—if use means to increase trade and to help to make money?”—should not prohibit copyright protection. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903). “A picture is none the less a picture and none the less a subject of copyright that it is used for an advertisement.” *Id.*

¹⁰⁷ See, e.g., *Schrock v. Learning Curve Int'l, Inc.*, 586 F.3d 513, 519-22 (7th Cir. 2009); *FragranceNet.com, Inc. v. FragranceX.com, Inc.*, 679 F. Supp. 2d 312, 320-21 (E.D.N.Y. 2010); *Masterson Mktg., Inc. v. Lotus Int'l, Inc.*, No. 04cv2133, 2008 WL 667412, at *6-7 (S.D. Cal. Mar. 7, 2008); *Decker Inc. v. G & N Equip. Co.*, 438 F. Supp. 2d 734, 742 (E.D. Mich. 2006); *SHL Imaging*, 117 F. Supp. 2d at 311; *E. Am. Trio Prods., Inc. v. Tang Elec. Corp.*, 97 F. Supp. 2d 395, 417-18 (S.D.N.Y. 2000); *Epic Metals Corp. v. Condec, Inc.*, 867 F. Supp. 1009, 1013 (M.D. Fla. 1994).

¹⁰⁸ See, e.g., *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444, 455 (S.D.N.Y. 2005); *Fournier v. Erickson*, 202 F. Supp. 2d 290, 297 (S.D.N.Y. 2002).

Nevertheless, cases continue to challenge these sorts of photographs on originality grounds. Courts, for the most part, are reluctant to deny copyrightability in the context in which these challenges are typically raised—as defenses to allegations of copying by a competitor or by a former client of the copyright holder.¹⁰⁹ However, these courts often do not ground their decisions in any developed, articulated theory of originality.

The Ninth Circuit, for example, discussed both the traditional criteria for originality in photography and the *Feist* criteria in *Ets-Hokin v. Skyy Spirits, Inc.*, in which it assessed photographs of the blue Skyy vodka bottle.¹¹⁰ Some language used by the court initially appears to imply that, by interacting with one another, these criteria produce an originality requirement for photography that is doubly low: “When [*Feist*’s] articulation of the minimal threshold for copyright protection is combined with the minimal standard of originality required for photographic works, the result is that even the slightest artistic touch will meet the originality test for a photograph.”¹¹¹

However, the court did not pursue a fine-tuned analysis of how the *Feist* standard bears on the traditional approach; rather, it simply drew upon the earlier photography cases to supply the content for *Feist*’s modicum of creativity requirement.¹¹² Thus, it referred to Judge Hand’s pronouncement about the personality-imbued medium, and also to its own precedent, which provided that the “selection of subject, posture, background, lighting, and perhaps even perspective alone [may function] as protectable elements of a photographer’s work” so as to render a photograph copyrightable.¹¹³ Accordingly, the court articulated a view under which *Feist*’s modicum of creativity requirement codifies the prior judicial treatment of photography. It stopped short of

¹⁰⁹ Consistent with Professor Justin Hughes’ analysis, courts’ protection of the targets of free riding—corporate entity and individual photographer alike—appears to undermine a notion that they are consumed solely by a concern for the Romantic author. See Hughes, *supra* note 79, at 120-21. Separately, while Professor Stewart Sterk is surely correct in his intuition that market forces encourage creative risk-taking by photographers, see Stewart E. Sterk, *Rhetoric and Reality in Copyright Law*, 94 MICH. L. REV. 1197, 1214 (1996), the frequency of fallouts between photographers and their clients suggests that the interests of the two groups are not always aligned and that copyright protection may play a role as an incentive. See *infra* Part III.B.1.

¹¹⁰ 225 F.3d 1068, 1071 (9th Cir. 2000), *aff’d after remand*, 323 F.3d 763 (9th Cir. 2003).

¹¹¹ *Id.* at 1076.

¹¹² *Id.* at 1076-77.

¹¹³ *Id.* at 1077 (quoting *L.A. News Serv. v. Tullo*, 973 F.2d 791, 794 (9th Cir. 1992) and *United States v. Hamilton*, 583 F.2d 448, 452 (9th Cir. 1978)).

stating affirmatively that all photographs will manifest the requisite creativity, but to the extent that it all but approves the potential authorial contribution of “perspective alone,” the decision would seem to suggest that every photograph is likely to qualify for protection, since every photograph entails some choice of perspective.¹¹⁴

In *Mannion v. Coors Brewing Co.*, Judge Lewis Kaplan, who has written a number of important photography decisions, attempted to grapple directly with the ways in which a photograph might be examined for originality following *Feist*.¹¹⁵ First, he drew on familiar principles to proclaim that a photograph may display *originality in the rendition*, which relates to the way in which a subject is depicted through choice of angle, lighting, shading, filter, exposure, developing technique, and the like.¹¹⁶ In an influential statement, he declared that “[u]nless a photograph replicates another work with total or near-total fidelity, it will be at least somewhat original in the rendition.”¹¹⁷ Next is *originality in the timing*, which relates to the capturing of an event by being at the right place at the right time.¹¹⁸ Third is *originality in the creation of the subject*, which relates to the planning, conception, and arrangement of the photographic scene.¹¹⁹

¹¹⁴ Dan Hunter & F. Gregory Lastowka, *Amateur-to-Amateur*, 46 WM. & MARY L. REV. 951, 963 (2004) (“Of course, any given photograph *must* demonstrate . . . selection and [personal] influence [through temporal and spatial framing], even if the intent of the photographer is simply to capture factual information, not to express an artistic vision. Selection is inherent in the technology; one cannot take a picture of everything.”).

¹¹⁵ 377 F. Supp. 2d 444, 450-54 (S.D.N.Y. 2005). These ways are not mutually exclusive. *Id.* at 452.

¹¹⁶ *Id.* (citing 1 HON. SIR HUGH LADDIE ET AL., *THE MODERN LAW OF COPYRIGHT AND DESIGNS* § 4.57, at 229 (3d ed. Butterworths 2000)). Judge Kaplan acknowledged that his analysis primarily addressed itself to traditional print photography and not digital photography, which “may or may not demand a different analytical framework.” *Id.* at 454 n.65.

¹¹⁷ *Id.* at 452. The Nimmer treatise agrees with this general statement of the case law. See 1 NIMMER & NIMMER, *supra* note 31, § 2.08[E][1] (“[A]ny (or . . . almost any) photograph may claim the necessary originality to support a copyright merely by virtue of the photographers’ personal choice of subject matter, angle of photograph, lighting, and determination of the precise time when the photograph is to be taken.”).

¹¹⁸ *Mannion*, 377 F. Supp. 2d at 452-53. An example is Alfred Eisenstaedt’s famous photograph of a VJ Day kiss in Times Square. *Id.* at 453.

¹¹⁹ *Id.* at 453-54. Examples of this form of originality are found in *Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992), and *Gross v. Seligman*, 212 F. 930 (2d Cir. 1914), in which the photographers’ “creation” of their respective subjects, a couple holding eight puppies and a nude model in a particular pose, were protected from subsequent reworking. *Mannion*, 377 F. Supp. 2d at 453-54. The *Oscar Wilde, No. 18* photograph itself would likely qualify for rendering and subject matter originality under Judge Kaplan’s taxonomy, since the Supreme Court noted the particular posing and arranging

Judge Kaplan's metrics are useful in probing which aspects of a photograph might make it worthy of copyright protection. He goes further, however, and maintains that courts should use them as a way of focusing on the "originality of the final product"—that is, the photograph itself—rather than the decisions that went into creating it.¹²⁰ This move in favor of establishing originality within the four corners of an image highlights the absence of guidance as to the substantive content of originality from either Congress or the Supreme Court. As mentioned, the Court has noted that the quantum of originality required is low, and it has made statements about what is *not* required: artistic merit, novelty, or any appreciable effort.¹²¹ Accordingly, in the absence of specific guidance, courts have adopted proxies for their originality determinations, some of which are valid and some of which are in tension with the reasoning of *Feist*. These proxies are the proxy of ontology, the proxy of narrative, and the proxy of comparison.

Before moving on to describe the proxies, a brief word must be said about burdens of proof. In this article, originality is discussed in terms of a determination a court makes. This shorthand elides the important point that, by statute, a certificate of registration will generally constitute prima facie evidence of the validity of the copyright, including proof of the work's originality.¹²² Thus, as a matter of burden allocation, it falls to the defendant challenging a work to rebut the presumption of a work's originality. Defendants sometimes attempt to meet this burden by providing evidence that the plaintiff has copied from some prior source, and for that reason,

decisions made by Saronby with respect to the subject, costume, draperies, and accessories, including even the expression that Saronby had "suggest[ed]" and "evok[ed]" from Oscar Wilde. See *Burrow-Giles Lithographic Co. v. Saronby*, 111 U.S. 53, 60 (1884).

¹²⁰ *Mannion*, 377 F. Supp. 2d at 451. It has been argued that *Feist* left unclear whether the overarching originality inquiry was into the work itself or the process by which it was created. See, e.g., Raskind, *supra* note 15, at 334. Courts do elide the difference between product and production. In *Southco, Inc. v. Kanebridge Corp.*, the court described the *Oscar Wilde, No. 18* photograph as a "not 'ordinary' photo." 390 F.3d 276, 284 (3d Cir. 2004) (en banc). By contrast, the *Burrow-Giles* Court had distinguished that photograph's creation from the "ordinary production of a photograph." *Burrow-Giles*, 111 U.S. at 59 (emphasis added).

¹²¹ *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345, 358-60 (1991); *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903).

¹²² 17 U.S.C. § 410(c) (2006); see, e.g., *Johnson v. Gordon*, 409 F.3d 12, 17 (1st Cir. 2005); *Boisson v. Baniyan, Ltd.*, 273 F.3d 262, 268 (2d Cir. 2001); *Bibbero Sys., Inc. v. Colwell Sys., Inc.*, 893 F.2d 1104, 1106 (9th Cir. 1990). Section 410(c) specifies that this evidentiary weight is to be afforded where registration is made before or within five years after the work's first publication and that the weight afforded to a registration made thereafter is within the court's discretion. 17 U.S.C. § 410(c).

the plaintiff's work should not be presumed original.¹²³ It is not entirely clear what should be required to rebut the presumption on the alternate ground of lack of minimal creativity because, as is argued throughout this article, the legal concepts of creativity and originality are highly elusive. Further, courts are not always precise in specifying whether the burden has been rebutted before launching into discussions of originality. Accordingly, this article addresses the proxies for originality that courts, viewing the evidence in the record, have adopted without necessarily identifying whether the burden has shifted at the time of decision.

The next three sections introduce and discuss three proxies for identifying originality in photography litigation.

B. *Proxy of Ontology*

Employing perhaps the most controversial proxy, the proxy of ontology, courts use the fact that a photograph exhibits the essential features of a photograph to ground a finding of originality. Under this line of reasoning, originality becomes a constituent aspect of a photograph. In *Decker, Inc. v. G & N Equipment Co.*,¹²⁴ for example, the plaintiff alleged that the defendants had copied photographs of equipment components from its catalog, including closely framed images of rubber replacement "shoes" for doorstops. In opposing summary judgment, the plaintiff mounted an argument based almost entirely on provenance. Other than to stress that *it* was the source of the photographs, the only modicum of creativity the plaintiff could identify was that the "products are presented in a . . . certain way using lighting and unique positions to enhance their appeal and thereby the sales of the products."¹²⁵ The court denied the defendants' summary judgment motion as

¹²³ See, e.g., *N. Coast Indus. v. Jason Maxwell, Inc.*, 972 F.2d 1031, 1033-34 (9th Cir. 1992); *Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663, 668-69 (3d Cir. 1990); *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 908-09 (2d Cir. 1980); see also 3 NIMMER & NIMMER, *supra* note 31, § 12.11[B][1][b].

¹²⁴ 438 F. Supp. 2d 734 (E.D. Mich. 2006).

¹²⁵ Plaintiff's Brief In Opposition, at 4, *Decker, Inc. v. G & N Equip. Co.*, 438 F. Supp. 2d 734, 742 (E.D. Mich. 2006) (No. 05-cv-70128). Similarly, plaintiff's president submitted an affidavit stating that the plaintiff "photographed products in a certain way using lighting and unique positions to enhance their appeal" and that its original "photographs are prominently featured in its catalogs and are not copies of competitors' photographs and are in no way copies of other pre-existing works. Rather, the photographs solely originate with" the plaintiff. Affidavit of John Chase, at 2, *Decker, Inc. v. G & N Equip. Co.*, 438 F. Supp. 2d 734, 742 (E.D. Mich. 2006) (No. 05-cv-70128).

to the photographs, determining that “to the extent that lighting and posing were involved in the photographs, the Plaintiff has shown sufficient evidence to support a claim of originality in the photographs.”¹²⁶

While the posture of *Decker*, ruling on a summary judgment motion by defendants, no doubt contributed to the court’s terse discussion, its seemingly perfunctory recitation of photographic elements perpetuates a legal discourse in which a work’s existence as a photograph—its constitution as a two-dimensional work in which lighting and perspective are perceptible—signals that the work is sufficiently original. This signaling function is reflected in pronouncements by both the Copyright Office and the circuit courts (although, as discussed below,¹²⁷ a few district courts have, on rare occasion, denied protection to photographs on originality grounds). According to a Copyright Office representative, photographs receive far less scrutiny in the registration process than, for example, works of art that are seen as potentially appropriating simple geometric shapes.¹²⁸ Typically, the images for which the Office denies registration are X-rays or other medical images whose purpose is articulated to be diagnostic rather than creative or instructional.¹²⁹ Indeed, although it later rejected this stance, the Copyright Office at one time suggested that, given the

¹²⁶ *Decker*, 438 F. Supp. 2d at 742; see also *Reece v. Island Treasures Art Gallery, Inc.*, 468 F. Supp. 2d 1197, 1202 (D. Haw. 2006) (citing applicable principles without explaining what made photograph of hula performance original other than its existence as a photograph); *Epic Metals Corp. v. Condec, Inc.*, 867 F. Supp. 1009, 1013-14 (M.D. Fla. 1994) (same with respect to photographs of construction sites).

¹²⁷ See *infra* Part II.C.

¹²⁸ Telephone Interview with William R. Briganti, Assistant Chief, Visual Arts & Recordation Div., U.S. Copyright Office, in Wash., D.C. (July 20, 2010) [hereinafter Briganti Interview]. The decisions of the internal appeals body, the Copyright Office Review Board, bear this out: no rejections of photographs appear to have been appealed, suggesting that none was rejected by the examiner in the first instance. See *Decisions of the Appeals Board—U.S. Copyright Office, 1995-2009*, IP MALL, http://www.ipmall.info/hosted_resources/CopyrightAppeals/fplchome.asp (last visited May 12, 2011).

¹²⁹ Briganti Interview, *supra* note 128. This stance accords with an intentionalist view of art. See sources cited *supra* note 56. In other contexts, such as Ansel Adams’ prints of X-rays recently auctioned by Sotheby’s, one would expect that such images would be registered by the Office. See Catalog from Polaroid Exhibit Displaying Ansel Adams Print of X-ray of Hand (Lot 460), SOTHEBY’S, http://www.sothebys.com/app/ecatalogue/fhtml/index.jsp?event_id=30084#/r=index-fhtml.jsp?event_id=30084|r.main=lot.jsp?event_id=30084&id=460 (last visited Apr. 14, 2011). Professor Jessica Silbey’s recent article brings to mind another example. See Jessica Silbey, *Evidence Verité and the Law of Film*, 31 CARDOZO L. REV. 1257, 1277 (2010) (discussing Lennart Nilsson’s iconic “Life Before Birth” photograph of a fetus *in utero*, published in Life magazine on April 30, 1965). Such images would likely be deemed to reflect the requisite intentionalist and institutionalist bona fides to qualify as art that is protectable.

choices usually reflected in photographs, “there is no issue with respect to whether or not a photograph is copyrightable” and that “it is possible to consider registration without an actual deposit of the work.”¹³⁰

The circuit courts echo this position. As expressed in *Schrock v. Learning Curve International, Inc.*, a case that will be discussed in greater depth below, the Seventh Circuit’s view appears to be that photographs will contain sufficient originality in the rendering choices they display unless they copy other works, either “slavishly” or by mimicking the choices expressed in earlier photographs with “total or near-total fidelity.”¹³¹ This apparently is also the view of the Eleventh Circuit¹³² and, as outlined above in *Ets-Hokin*, the Ninth Circuit. This position, which makes originality in photography turn entirely on the first prong of *Feist*—independent creation (or noncopying)—implies that the minimal creativity standard will always be met in a photograph. Even if, as this article argues, definitive accounts of originality and its creativity component are elusive, encouragement for the position that one medium is free from these requirements is difficult to square with *Feist*.

Nor is it clear that the first prong of *Feist*, noncopying, will play much of a role as gatekeeper. The Seventh Circuit in *Schrock* felt compelled to rule out the possibility that the plaintiff’s photographs might be “slavish copies” of the toy trains depicted in the images.¹³³ The court derived this

¹³⁰ Registration of Claims to Copyright, Group Registration of Photographs, 60 Fed. Reg. 62,057, 62,058 (Dec. 4, 1995). The Copyright Office proffered this view, which it later rejected, in the course of its creation of a group registration option for photographs. In connection with a request for comments on a version of the regulations that was not ultimately adopted (another version was), the Office stated:

Photographs are generally copyrightable; an individual selects a camera, lens, film, and an image to capture taking into consideration choices such as lighting and composition. Since photographs are usually entirely new works, for examination purposes there is no issue with respect to whether or not a photograph is copyrightable. Therefore, it is possible to consider registration without an actual deposit of the work.

Id.

¹³¹ *Schrock v. Learning Curve Int’l, Inc.*, 586 F.3d 513, 519 (7th Cir. 2009) (quoting *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444, 452 (S.D.N.Y. 2005) and citing *Bridgeman Art Library, Ltd. v. Corel Corp.*, 25 F. Supp. 2d 421, 427 (S.D.N.Y. 1998)).

¹³² *Latimer v. Roaring Toyz, Inc.*, 601 F.3d 1224, 1234 (11th Cir. 2010) (“Except for a limited class of photographs that can be characterized as ‘slavish copies,’ courts have recognized that most photographs contain at least some originality in their rendition of the subject-matter.” (citing *Schrock*, 586 F.3d at 519 and *Rogers v. Koons*, 960 F.2d 301, 307 (2d Cir. 1992))).

¹³³ *Schrock*, 586 F.3d at 519. The need for the discussion is perplexing given that the court had assumed for the purposes of the appeal that the photographs

exception from *Bridgeman Art Library, Ltd. v. Corel Corp.*¹³⁴ In that case, the originality of photographic transparency and digital image replicas of old masters' public domain paintings was challenged. It seems reasonable, with facts that involve the duplication of one two-dimensional work into another, as in *Bridgeman*, to consider the possibility that the photographic transparencies were in fact slavish copies.¹³⁵ But in *Schrock*, the issue was the traditional role of photography: capturing a three-dimensional object in a two-dimensional format. The import of the Seventh Circuit's analysis is that, unless a photograph of a three-dimensional subject matter has too closely mimicked aspects of another photograph, then it will be original.¹³⁶

The proxy of ontology raises issues beyond doctrinal compliance with *Feist* with respect to photographs. A recent Tenth Circuit case revealed how the powerful attachment to photography as a reliably original medium can be used to find the originality in "nonphotographs" lacking. In *Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.*,¹³⁷ the question of originality arose in the context of computer-generated imagery (CGI) depicting digital wire-frame models of Toyota vehicles. These digital renderings substituted for product photographs of the cars and permitted the advertiser to alter the car's color, features, and surroundings with the click of a mouse.¹³⁸ Drawing upon lessons from photography,¹³⁹ the court held that

qualified as derivative works with respect to the copyrighted toy trains and, hence, by definition, were "recast, transformed, or adapted" from the underlying trains in some way. 17 U.S.C. § 101 (2006).

¹³⁴ 25 F. Supp. 2d 421 (S.D.N.Y. 1998), *aff'd on reh'g*, 36 F. Supp. 2d 191 (S.D.N.Y. 1999).

¹³⁵ See Butler, *supra* note 10, at 106 ("When the purpose of the photograph is to copy a two-dimensional image, the originality of that photograph deserves closer scrutiny than the assertion that all photographs contain some personal influence by the photographer.")

¹³⁶ See Mary Campbell Wojcik, *The Antithesis of Originality: Bridgeman, Image Licensors, and the Public Domain*, 30 HASTINGS COMM. & ENT L.J. 257, 264-67 (2008) (discussing application of *Bridgeman* to three-dimensional context); *infra* Part III.C (discussing staging and shooting of similar scenes).

¹³⁷ 528 F.3d 1258 (10th Cir. 2008).

¹³⁸ *Id.* at 1260.

¹³⁹ *Id.* at 1263-64. For a critique of the court's comparison of the models to photographs, see Andrew C. Landsman, Comment, *Fender Bender: 3D Computer Modeling of Commercial Objects and the Meshwerks v. Toyota Decision*, 8 J. MARSHALL REV. INTELL. PROP. L. 429 (2009); Michael Palumbo, Note, *Copyright Protection for the Fruits of Digital Labor: Finding Originality in Digital Wire-Frames*, 44 NEW ENG. L. REV. 127, 150 (2009); see also Bryce Clayton Newell, *Independent Creation and Originality in the Age of Imitated Reality: A Comparative Analysis of Copyright and Database Protection for Digital Models of Real People*, BYU INT'L L. & MGMT. REV., Spring 2010, at 93.

the computer screen images “accurately,” in intent and achievement, depicted the real-world cars, and it therefore denied copyright protection.¹⁴⁰ The images appended to the opinion, however, belie the court’s claim that the models “depict nothing more than unadorned Toyota vehicles—the car as car.”¹⁴¹ They depict a graphic representation of a car in three stages—one of pure gridlines, one of gridlines over a solid car body, and one purely solid, appearing almost like clay.¹⁴² Although a viewer would think the models represent a car,¹⁴³ these images appear *far less* like an actual car than the shiny finished product images that are also appended by the court.¹⁴⁴ Nevertheless, the plaintiff’s images stray from the photographic ideal imagined by the court: the images are “untouched by a digital paintbrush; they are not depicted in front of a palm tree, whizzing down the open road, or climbing up a mountainside” and are not original.¹⁴⁵

While the implications of the growth of CGI in many different realms are beyond the scope of this article, it is sufficient to say that CGI is extending to many areas formerly occupied by photography.¹⁴⁶ Thus, a principled basis should be found for the application of copyright to these areas—more than the not-being-a-photograph analysis applied here.

C. Proxy of Narrative

Use of authorial narrative is a species of analysis, advocated by some¹⁴⁷ and questioned by others,¹⁴⁸ that assesses a

¹⁴⁰ *Meshwerks*, 528 F.3d at 1268-69.

¹⁴¹ *Id.* at 1265.

¹⁴² *Id.* at 1271.

¹⁴³ See Jeffrey Malkan, *What Is a Copy?*, 23 CARDOZO ARTS & ENT. L.J. 419, 427-32 (2005) (discussing differences between representation, resemblance, and reproduction and arguing that representation “has a figural or metaphorical structure”).

¹⁴⁴ See *Meshwerks*, 528 F.3d at 1272; see also Tushnet, *supra* note 32, at 33-34 (discussing aspects of the depictions of cardinals, abstracted from any background, in *Franklin Mint Corp. v. National Wildlife Art Exchange, Inc.*, 575 F.2d 62 (3d Cir. 1978), which undermine the notion that the images are representations of reality even if, because of representational convention, we perceive them as such). The fact that the images were later to be filled out and manipulated by the Toyota advertising team, *Meshwerks*, 528 F.3d at 1266, should not be dispositive of the question of whether the plaintiff had made its own creative contribution to the project.

¹⁴⁵ *Meshwerks*, 528 F.3d at 1265.

¹⁴⁶ See, e.g., Conor Risch, *Why CGI?*, PHOTO DISTRICT NEWS, Nov. 2010, at 30.

¹⁴⁷ See, e.g., David Nimmer, *Copyright in the Dead Sea Scrolls: Authorship and Originality*, 38 HOUS. L. REV. 1, 159 (2001).

¹⁴⁸ See, e.g., Jane C. Ginsburg, *The Concept of Authorship in Comparative Copyright Law*, 52 DEPAUL L. REV. 1063, 1085-88 (2003) (critiquing intent as principle

work by resorting to authorial intent. Author narratives, proffered on some occasions by individual author-plaintiffs and on other occasions by corporate copyright holders, constitute the second proxy courts rely on in challenges to photographic originality.¹⁴⁹ It is not surprising that this is so. With overt aesthetic assessment ostensibly ruled out by *Bleistein*, a return to word-based evidence of originality in the form of testimony from the photographer was a likely substitute.¹⁵⁰ Indeed, as mentioned above, this method was employed in *Burrow-Giles*. Cases in the last twenty years, following *Feist*, have had to walk a fine line, since authorial process could form a part of the originality picture, but it could not be phrased so as to indicate that sweat-of-the-brow labor outweighed creative input.¹⁵¹

In *Schrock*, for example, the Seventh Circuit adjudicated a copyright infringement suit by a photographer against his former client. Daniel Schrock, who was hired to photograph the “Thomas & Friends” toys for promotional materials, alleged that the client had used the photographs beyond the specified term.¹⁵² The defendants countered, in part, with the argument that the photographs lacked originality.¹⁵³

of authorship); Russ VerSteeg, *Intent, Originality, Creativity and Joint Authorship*, 68 BROOK. L. REV. 123, 132-33 (2002) (arguing that intent to author, while a factor, should not be dispositive for originality determination).

¹⁴⁹ Professor Clarisa Long has pointed out that given the inexpressible and idiosyncratic nature of copyright goods, the cost of rules requiring exhaustive description of these goods would outweigh the benefits. Long, *supra* note 30, at 469; *see generally* Fromer, *supra* note 76. While this is true with respect to upfront copyright claiming, detailed description is clearly part of the litigation dance. Long, *supra* note 30, at 500, 510. It is not just with respect to originality determinations that authorial narrative may play a crucial role. In the fair use case *Blanch v. Koons*, the Second Circuit placed heavy emphasis on defendant Jeff Koons’ explanation of his purpose in using the plaintiff’s photograph in its conclusion that Koons’ work was transformative. *See* 467 F.3d 244, 252-53 (2d Cir. 2006).

¹⁵⁰ *See* Tushnet, *supra* note 32, at 3-6 (discussing the law’s comfort with text in contrast to images).

¹⁵¹ *See* Mannion v. Coors Brewing Co., 377 F. Supp. 2d 444, 451 (S.D.N.Y. 2005) (framing this tension).

¹⁵² *Schrock v. Learning Curve Int’l, Inc.*, 586 F.3d 513 (7th Cir. 2009). The defendants were the “Thomas & Friends” copyright owner and its licensee who had hired Schrock. As is common, the suit arose against the backdrop of a number of contractual relationships and the alleged use of the photographs by the defendants beyond the term provided by the photographer. *Id.* at 516. Indeed, the contractual relations were so unclear that the court remanded for a determination of whether the defendants had secured an implied license to continue using the photographs and whether the parties had agreed to alter the default rules relating to Schrock’s right to seek copyright for his photographs as derivative works. *Id.* at 516, 524-25.

¹⁵³ *Id.* at 517.

Citing *Feist's* low threshold requirement for creativity,¹⁵⁴ the court accepted the idea that original expression contributed by a photographer often pertains not to the staging of the depicted scene but to the way in which an image is rendered.¹⁵⁵ But its attempt to describe affirmatively what made the photographs original was palpably weak. It acknowledged that the photographs were “accurate depictions” of the trains, but it held that the photographer’s “artistic and technical choices combine to create a two-dimensional image that is subtly but nonetheless sufficiently his own.”¹⁵⁶ As in *Burrow-Giles*, the court “confirmed” this conclusion by invoking the photographer’s description of his “creative process in depicting the toys”:

Schrock explained how he used various camera and lighting techniques to make the toys look more “life like,” “personable,” and “friendly.” He explained how he tried to give the toys “a little bit of dimension” and that it was his goal to make the toys “a little bit better than what they look like when you actually see them on the shelf.”¹⁵⁷

While styled as a confirmation, however, this testimony of the photographer in fact serves as the sole content for the court’s conclusion that the photographs were “subtly but nonetheless sufficiently” original. The adoption of language, even wholesale, from parties’ court papers is, of course, not unusual in litigation. But the mode of reasoning creates a copyright system in which an authorship narrative, as a proxy for originality, threatens to trump the attributes of the work itself: nearly any straightforward commercial image of a toy train will be capable of being described, a priori, as “friendly.”¹⁵⁸

This mode of analysis was also visible in a rare instance of originality addressed at trial. In *Schiffer Publishing, Ltd. v. Chronicle Books, LLC*, the district court’s findings of fact on the issue of originality consisted of the trial and deposition testimony of the five photographers who had taken the

¹⁵⁴ *Id.* at 519. As discussed *infra*, the court assumed, without deciding, that the photographs were derivative works and reviewed them on that basis as well. *Id.*

¹⁵⁵ *Id.* (describing originality in the rendition as “the effect created by the combination of [the photographer’s] choices of perspective, angle, lighting, shading, focus, lens, and so on” (citing *Rogers v. Koons*, 960 F.2d 301, 307 (2d Cir. 1992); *Mannion*, 377 F. Supp. 2d at 452)).

¹⁵⁶ *Id.* Thus they deserved the limited protection afforded to derivative works. *Id.* at 519-20.

¹⁵⁷ *Id.* at 519.

¹⁵⁸ *But see* *SHL Imaging, Inc. v. Artisan House, Inc.*, 117 F. Supp. 2d 301, 310 (S.D.N.Y. 2000) (where the court begins its analysis by recounting the photographer’s description of his creative process but continues on to a more in-depth discussion of the photographs’ formal properties).

photographs—in this case, 118 photographs of fabric swatches for a book on the topic.¹⁵⁹ In particular, the court relied upon the testimony as to the processes by which the photographers selected and shot the images, including testimony that a medium format camera was used “not because it more accurately depicted the colors and details” but because, for the photographer, “it was just a preference.”¹⁶⁰ Likewise, Kodak film was chosen over Fuji because it provided “warmer tints.”¹⁶¹

The court’s conclusion that the originality of the images had been demonstrated was couched in the language of photographer choice: choice of cameras, choice of film, choice of lens, choice of lighting, and choice to take multiple images.¹⁶² “In the words of [photographer] Joy Shih, the decision of which picture to use was made according to ‘which image would project what [she] was trying to get [the fabric] to look like.’”¹⁶³ And the court held that these choices were reflected in the images:

Certain of the photographs evoke the texture of a particular fabric. Others have exaggerated or understated the tone and values of the colors in a pattern when compared to the original fabric swatches. Some photographs are more blurry than the patterns they represent, while others display an almost clinical sharpness.¹⁶⁴

The court’s conclusions appear to synthesize the evidence in a fair manner, but they do not identify what makes the images creative other than the fact that they reflect authorial whimsy and that they were not intended to depict, nor succeeded in depicting, the underlying fabric swatches too accurately.¹⁶⁵ Indeed, the decisive factor in the court’s analysis was the evidence that, unlike in *Bridgeman*, the plaintiffs’ photographers were not striving for accuracy as the goal.¹⁶⁶ “In fact, several photographers clearly stated that they never

¹⁵⁹ *Schiffer Publ’g, Ltd. v. Chronicle Books, LLC*, No. Civ.A. 03-4962, 2004 WL 2583817, at *1-3 (E.D. Pa. Nov. 12, 2004).

¹⁶⁰ *Id.* at *1 (quoting photographer Joy Shih) (internal quotation marks omitted).

¹⁶¹ *Id.*

¹⁶² *Cf. Ginsburg, supra* note 148, at 1077 (“To say that a work’s creator exercised choice as to the contents and presentation of the work is another way of saying that the work is original . . .”).

¹⁶³ *Schiffer Publ’g, 2004 WL 2583817*, at *7 (quoting photographer Joy Shih).

¹⁶⁴ *Id.*

¹⁶⁵ *See generally VerSteeg, supra* note 17 (favoring comparative variation test over creativity test).

¹⁶⁶ *Schiffer Publ’g, 2004 WL 2583817*, at *7-8.

compared the fabric swatches to their photographs, precisely because such a comparison was unimportant to their goals.”¹⁶⁷

As mentioned above, the *Bridgeman* case showed that even images of venerated works of art might fall victim when accompanied by the wrong sort of narrative. That case presents difficult questions because the rendering elements typically protectable in photographs, such as choice of subject, lighting, and composition, were surely present. And yet the court, seizing upon an emperor-has-no-clothes insight, determined that the finished products were copies of the paintings “as exact as science and technology [would] permit.”¹⁶⁸ Relying in no small part on the Nimmer treatise’s categorical exceptions to the protectability of photographs—slavish copying and exact reenactment¹⁶⁹—the court held that the transparencies were “slavish copies” and hence insufficiently creative.¹⁷⁰ While Professor VerSteeg has argued that the court did not rely upon authorial intent in denying protection to the *Bridgeman* images,¹⁷¹ the court’s repeated invocation of the plaintiff’s express goals belies this claim. In fact, by repeatedly pointing to the plaintiff’s admissions of intent to achieve exactitude in its reproductions,¹⁷² the court was able to sidestep fraught questions about why the nature of the subject matter—public domain paintings—should thwart the traditionally protected rendering choices. In this way, *Bridgeman* is the pinnacle of judicial decision making premised upon authorial narrative—or the express disclaimer of one.

Absence of authorial narrative has also grounded two other decisions in which courts have found originality lacking, albeit at an early stage of litigation. In *Custom Dynamics, LLC v. Radiantz LED Lighting, Inc.* and *Oriental Art Printing, Inc. v. Goldstar Printing Corp.*, the district courts denied motions

¹⁶⁷ *Id.* at *8.

¹⁶⁸ *Bridgeman Art Library, Ltd. v. Corel Corp.*, 25 F. Supp. 2d 421, 427 (S.D.N.Y. 1998), *aff’d on reh’g*, 36 F. Supp. 2d 191 (S.D.N.Y. 1999).

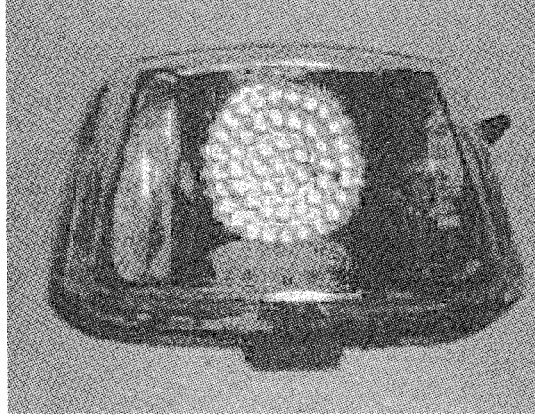
¹⁶⁹ 1 NIMMER & NIMMER, *supra* note 31, § 2.08[E][2]. *But see* Ann Bartow, *The Hegemony of the Copyright Treatise*, 73 U. CIN. L. REV. 581 (2004) (critiquing heavy dependence by courts on the Nimmer treatise on copyright).

¹⁷⁰ *Bridgeman*, 36 F. Supp. 2d at 196-97 (“[T]here was no spark of originality” when the goal was to “reproduce the underlying works with absolute fidelity.”).

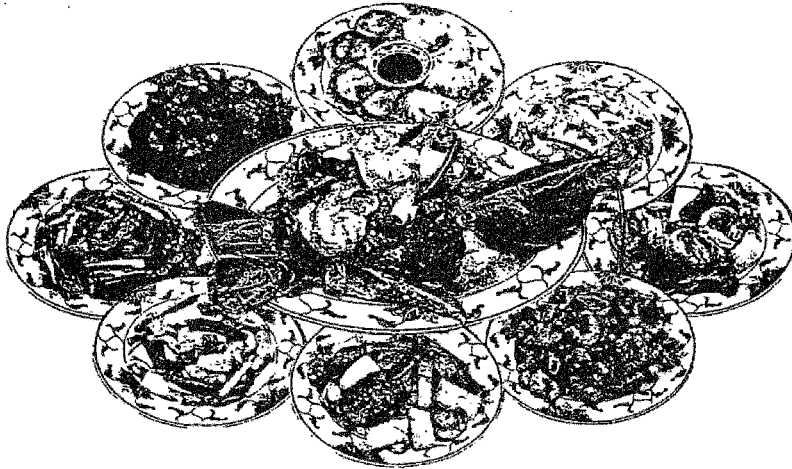
¹⁷¹ VerSteeg, *supra* note 148, at 137-39.

¹⁷² *See Bridgeman*, 36 F. Supp. 2d at 197 (noting that “plaintiff by its own admission has labored to create ‘slavish copies’ of public domain works”); *see also Bridgeman*, 25 F. Supp. 2d at 427 (noting that “Bridgeman admittedly seeks to duplicate exactly the images of the underlying works”).

for preliminary injunctions concerning images of motorcycle lighting accessories and Chinese food dishes, respectively.¹⁷³



A photograph lacking originality,
*Custom Dynamics, LLC v. Radiantz LED Lighting, Inc.*¹⁷⁴



A photograph lacking originality,
*Oriental Art Printing, Inc. v. Goldstar Printing Corp.*¹⁷⁵

¹⁷³ *Custom Dynamics, LLC v. Radiantz LED Lighting, Inc.*, 535 F. Supp. 2d 542, 549 (E.D.N.C. 2008); *Oriental Art Printing, Inc. v. Goldstar Printing Corp.*, 175 F. Supp. 2d 542, 544 (S.D.N.Y. 2001) (subsequent history omitted). In *Oriental Art Printing*, the court also granted the defendants' motion to dismiss the plaintiffs' copyright claim as to the photographs on the ground that they were not original, copyrightable works. 175 F. Supp. 2d at 550.

¹⁷⁴ Verified Complaint at exhibit 7, *Custom Dynamics, LLC v. Radiantz LED Lighting, Inc.*, 535 F. Supp. 2d 542 (E.D.N.C. 2008) (No. 07 Civ. 493).

¹⁷⁵ Complaint at exhibit A, *Oriental Art Printing, Inc. v. Goldstar Printing Corp.*, 175 F. Supp. 2d 542 (S.D.N.Y. 2001) (No. 00 Civ. 8374).

Both courts reasoned, in part, that the photographs “were meant to serve the purely utilitarian purpose of displaying examples of [the] product to potential consumers” and, citing *Feist*, held that there was “no ‘creative spark’ involved in a purely descriptive picture of a product.”¹⁷⁶ In *Oriental Art Printing*, upon which *Custom Dynamics* relied heavily, the court specifically noted the absence of a plausible authorship narrative in that “no description of either the lighting or angles employed, or any desired expression” was provided.¹⁷⁷ Reading these decisions, one has the sense that the courts felt they had encountered an opportunity to apply *Feist* in a principled way by rejecting a garden-variety photograph. But these images, while low-grade, apparently reflected at least some lighting and compositional decision making.¹⁷⁸ What was missing was an authorship narrative the courts deemed sufficient.¹⁷⁹

D. Proxy of Comparison

Perhaps the closest courts come to grounding originality in an image itself is through the proxy of comparison. Comparison may take one of two forms: (i) comparison of the litigated photograph to other photographs, and (ii) comparison of the photograph to the underlying subjects depicted therein.

1. Comparisons to Other Photographs

Courts have compared a litigated photograph to other photographs submitted by the parties to illustrate the possible range of creative expression available under the circumstances. In one case, for instance, a court found that “master

¹⁷⁶ *Custom Dynamics*, 535 F. Supp. 2d at 549 (citing *Oriental Art Printing*, 175 F. Supp. 2d at 546-47). The court in *Oriental Art Printing* also stated that each of the potentially protectable elements in the photographs would be barred from protectability under the *scènes à faire* doctrine since they “flow necessarily” from the “realistic depiction of most common Chinese food dishes.” 175 F. Supp. 2d at 547 n.3. See *infra* part III.C (discussing *scènes à faire* doctrine).

¹⁷⁷ *Oriental Art Printing*, 175 F. Supp. 2d at 547. The absence of any authorial narrative was exacerbated by the failure to attach attractive copies of the relevant photographs. See *id.* (noting that “as presented by plaintiffs . . . each photograph is a rather obscure, black-and-white, depiction of a particular Chinese dish”).

¹⁷⁸ See *id.* (“From the exhibits submitted, both the lighting and angle appear to be equivalent in every photograph.”).

¹⁷⁹ Note that Professor Michael Madison’s argument, that we should reformulate copyright as a knowledge law, involves, at some level, a narrative basis. Madison, *supra* note 10, at 849 (suggesting that artists, lawyers, and courts would have to reformulate what they do in knowledge-oriented terms).

photographs” supplied by the defendant in an attempt to show that the plaintiff’s photographs of mirrored picture frames had been shot in a “straightforward manner”¹⁸⁰ actually undermined that very claim. The court determined that the master photographs had “none of the aesthetic elements that ma[d]e plaintiff’s photographs attractive. The gilded frames [were] dull and the details [were] obscured by shadows or over exposed.”¹⁸¹ Similar reasoning was applied by another court in response to the parties’ submissions of multiple images depicting sniper teams in different positions; the court concluded that a “wide range of possibilities [was] available” and found plaintiff’s compositional choices sufficiently original.¹⁸²

Even where it is not clear that a court is referring to alternate images in the record, courts appear to engage in reasoning that relies upon the proxy of comparison. In *Mannion*, for example, Judge Kaplan examined the photograph at issue, which depicted a close-up, upwardly-focused shot of basketball star Kevin Garnett wearing white clothing and much jewelry against a clouded sky, and he held it to be original. Originality in the rendition, which the court anchored in the fact that the photograph had not been copied, was bolstered by the photographer’s “relatively unusual angle and distinctive lighting.”¹⁸³ Additionally, the photographer’s “composition—posing man against sky—evidences originality in the creation of the subject.”¹⁸⁴ In the absence of any reference to other photographs in the record, the only way in which these statements may be understood are as statements of comparison between the Garnett photograph and others that Judge Kaplan had seen during the course of his lifetime (if not in the course of the litigation).

2. Comparisons to the Underlying Subject Through the Derivative Work Framework

Product photographs are sometimes categorized as derivative works, that is, works based upon one or more preexisting works.¹⁸⁵ For courts subscribing to this view, the

¹⁸⁰ *SHL Imaging, Inc. v. Artisan House, Inc.*, 117 F. Supp. 2d 301, 311 (S.D.N.Y. 2000).

¹⁸¹ *Id.*

¹⁸² *Bryant v. Gordon*, 483 F. Supp. 2d 605, 615-16 (N.D. Ill. 2007).

¹⁸³ *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444, 455 (S.D.N.Y. 2005).

¹⁸⁴ *Id.*

¹⁸⁵ A “derivative work”

notion is that photographs recast and adapt their subject matter and that their originality should be assessed through the framework applied to derivative works. As usually formulated, the test for originality in a derivative work is whether the author has “contributed something more than a merely trivial variation, something recognizably his own” or a “distinguishable variation” from the underlying work.¹⁸⁶

The typical fact pattern driving the cases’ inquiry into derivative work status is a business relationship gone awry between a photographer and a client—usually a product manufacturer whose products the photographer was hired to shoot. The defendants in these cases have defended their use of the photographs beyond the agreed-upon terms by arguing that the photographs are derivative works that do not stand as protectable works on their own. This argument is premised on the notion that derivative works are subject to a higher burden of originality¹⁸⁷ or that any originality expressed in the photographs relates to the defendants’ products.¹⁸⁸

Application of derivative work status to photographs is not without debate,¹⁸⁹ but there are several reasons to think that the controversy is a red herring, at least with respect to the ultimate conclusion of whether originality has been

is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a “derivative work.”

17 U.S.C. § 101 (2006).

¹⁸⁶ See *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 (2d Cir. 1976) (en banc) (quoting *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 103 (2d Cir. 1951) (internal quotation marks omitted); *Gerlach-Barklow Co. v. Morris & Bendien, Inc.*, 23 F.2d 159, 161 (2d Cir. 1927)).

¹⁸⁷ See *Schrock v. Learning Curve, Int’l*, 586 F.3d 513, 520 (7th Cir. 2009); *SHL Imaging, Inc. v. Artisan House, Inc.*, 117 F. Supp. 2d 301, 305 (S.D.N.Y. 2000).

¹⁸⁸ See *Latimer v. Roaring Toyz, Inc.*, 574 F. Supp. 2d 1265, 1273 (M.D. Fla. 2008) (subsequent history omitted).

¹⁸⁹ Compare *Schrock*, 586 F.3d at 518 (assuming without deciding that photographs were derivative works), and *Ets-Hokin v. Sky Spirits, Inc.*, 225 F.3d 1068, 1077-81 (9th Cir. 2000) (suggesting that photographs could be derivative works if their subjects are copyrightable “preexisting works”) (subsequent history omitted), and *Latimer*, 601 F.3d 1224, 1234-35 (11th Cir. 2010) (suggesting that derivative work status would be more consistent with copyright law but refraining from deciding the question), with *SHL Imaging*, 117 F. Supp. 2d at 305-06 (ruling that photographing a subject does not create derivative work). Accord 1 NIMMER & NIMMER, *supra* note 31, § 3.03[C] (discussing controversy).

shown.¹⁹⁰ First, a controversial version of the nontrivial/distinguishable variation test, earlier espoused by the Seventh Circuit, has now been clarified: *Schrock* makes explicit that derivative works need not demonstrate a higher degree of originality than ordinary works.¹⁹¹ Second, courts routinely refer to *Feist's* originality test as part of their analysis,¹⁹² so any claim that a modicum of creativity does not suffice—or is not necessary—for derivative work authorship is misguided. Rather, there is every reason to expect that in the determination of courts, creativity-based originality and nontrivial/distinguishable variation will rise or fall together.

The continued reliance by courts on the nontrivial/distinguishable variation test undoubtedly reflects its attractiveness as a straightforward, judicially applicable test for the award of copyright. For this reason, some have proposed grounding the criteria for originality in variation rather than creativity.¹⁹³ Nevertheless, unless and until such a reformulation officially occurs, there appears to be no reason why the originality of a photograph should be assessed differently based upon its subject matter.¹⁹⁴ The same added

¹⁹⁰ 1 NIMMER & NIMMER, *supra* note 31, § 3.03[C][3]; Robert W. Clarida & Robert J. Bernstein, *Revisiting Derivative Works in Schrock Reversal*, N.Y. L.J., Nov. 20, 2009.

¹⁹¹ *Contra* Gracen v. Bradford Exch., 698 F.2d 300, 305 (7th Cir. 1983) (requiring “a sufficiently gross difference between the underlying and the derivative work” and that a “derivative work must be substantially different from the underlying work to be copyrightable”). Clarifying Seventh Circuit precedent, *Schrock* stated: “(1) the originality requirement for derivative works is not more demanding than the originality requirement for other works; and (2) the key inquiry is whether there is sufficient nontrivial expressive variation in the derivative work to make it distinguishable from the underlying work in some meaningful way.” 586 F.3d at 521. The precise language of the Seventh Circuit’s formulation is drawn from the *Nimmer* treatise. *See Schrock*, 586 F.3d at 520-21; 1 NIMMER & NIMMER, *supra* note 31, § 3.03[A].

¹⁹² *See, e.g., Schrock*, 586 F.3d at 519; ATC Distrib. Grp. v. Whatever It Takes Transmissions & Parts, Inc., 402 F.3d 700, 712 (6th Cir. 2005); *Dam Things from Den. v. Russ Berrie & Co.*, 290 F.3d 548, 563-64 (3d Cir. 2002); *Matthew Bender & Co. v. West Publ’g Co.*, 158 F.3d 674, 680 (2d Cir. 1998). The Tenth Circuit has signaled an interest in a unitary, *Feist*-based standard. *See Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.*, 528 F.3d 1258, 1266 n.7 (10th Cir. 2008).

¹⁹³ *See, e.g., VerSteeg*, *supra* note 17, at 840-43; *VerSteeg*, *supra* note 88, at 588.

¹⁹⁴ *Cf. Gorman*, *supra* note 17, at 7 (“[I]t is strange—given the nature of the photographic medium—to insist as a condition of copyrightability that derivative photographs be substantial or gross departures from an underlying work. The same ‘minimal creativity’ standard should apply whether a photographer captures a scene from nature, a public domain art work, or an art work protected by copyright.”). Likewise, William F. Patry argues that there is just one test for originality, the *Feist* standard, which should be applied to nonderivative and derivative works alike. The courts’ continued invocation and proliferation of a multitude of tests for originality in derivative works is, he argues, incorrect and unnecessarily confusing in a post-*Feist* world. 2 WILLIAM F. PATRY, *PATRY ON COPYRIGHT*, §§ 3.53, 3.55 (2010).

value that a photographer contributes—decisions about lighting, angle, and composition, for example—are made whether the photographic subject is a thing in nature or an object for sale, and it would be patently absurd to ask whether the Obama Photograph reflects a nontrivial/distinguishable variation from the man himself as the basis for copyright protection.

The Seventh Circuit's application of the variation test reveals its shortcomings in identifying originality or creativity, at least when it comes to the comparison of two-dimensional photographs and their three-dimensional subject matters:

If the photographer's rendition of a copyrighted work varies enough from the underlying work to enable the photograph to be distinguished from the underlying work (aside from the obvious shift from three dimensions to two¹⁹⁵), then the photograph contains sufficient incremental originality to qualify for copyright. Schrock's photos of the "Thomas & Friends" toys are highly accurate product photos but contain minimally sufficient variation in angle, perspective, lighting, and dimension to be distinguishable from the underlying [toy trains]; they are not "slavish copies."¹⁹⁶

Is the comparison that yields the conclusion of "minimally sufficient variation" in this quote being made between the photographs and the toy trains as seen in appellate court chambers, under the conditions the judges happened to view them in reviewing the lower court record? Presumably it would be possible for the court to view the toys at the right angle, and with the right lighting, such that there would be no variation between the photographs and the toys other than the change of medium. In any event, the bare ability to distinguish between two works does not appear to say anything about a work's creativity.

III. TOWARD A THEORY OF COPYRIGHT AND CREATIVITY

Returning to the question that animates this article: after *Feist*, what should originality analysis in a traditionally protected, yet heavily litigated medium such as photography consist of? Should courts be looking to weed out unoriginal photographs as a means of preserving the integrity of the copyright system?

¹⁹⁵ It is worth pausing to reflect that the most obvious variation, the change of medium from toy to photograph, is discounted in light of prior precedent. See *Schrock*, 586 F.3d at 519 n.3, 522 (citing *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 910 (2d Cir. 1980); *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 491 (2d Cir. 1976) (en banc)).

¹⁹⁶ *Id.* at 522 (internal citation omitted).

This final section of the article attempts to address these questions by evaluating the proxies described above in the broader context of originality jurisprudence and scholarship and of the photography industry. While originality determinations made pursuant to the proxies of narrative and comparison are not likely to be demanding, they offer some benefit above and beyond those made pursuant to the proxy of ontology. Because originality is such an elusive concept, however, the threshold requirement for originality should not be heightened, as some have called for in recent scholarship. While the issues raised by the proliferation of copyrightable images are serious, the originality threshold is not the best stage at which to address these issues. First, heightening the originality bar might distort artistic production or increase judicial tastemaking. Second, rigorous policing of the scope of protection to which a work is entitled can go a long way toward alleviating the need to raise the originality threshold. Finally, any proposal to heighten the originality requirement should take into account the complex ways in which creators and industries finance the production of original, creative works.

A. *Evaluating the Proxies in the Context of Originality Jurisprudence*

Photography is a peculiar copyright beast. On the one hand, its creative facets have been touted time and again by court after court. On the other hand, the reason for this legacy of judicial support is the parade of challenges to its status that continues to this day. It is not entirely clear why litigants continue to view the lack of originality defense as a viable weapon in their arsenal. Lurking in the background seems to be the expectation that, as technology increasingly facilitates high-quality image taking by amateurs, courts will start to conclude that any authorship evidenced in litigated photographs is miniscule and fungible.¹⁹⁷ Widely known repositories of amateur-produced images, such as the website Flickr,¹⁹⁸ only serve to confirm this viewpoint. Assuming the status quo continues, and the originality issue continues to be

¹⁹⁷ Judge Owen colorfully illustrated this concept in seeking, albeit in a different context, “more than mere cocktail pianist variations of the piece that are standard fare in the music trade by any competent musician.” *Woods v. Bourne Co.*, 841 F. Supp. 118, 121 (S.D.N.Y. 1994) (subsequent history omitted).

¹⁹⁸ See FLICKR, <http://www.flickr.com> (last visited Feb. 20, 2011).

litigated, does *Feist* command that courts look to deem some percentage of these photographs unoriginal?

One clear virtue of the current system, from the viewpoint of copyright holders, is predictability. Photographers and firms holding copyrights in photographs can be fairly assured that, should they press a copyright claim, they can protect their images from, at the very least, outright copying.¹⁹⁹ If predictability were the utmost goal, efficient policy surely would dictate that every photograph be deemed copyrightable *ex ante*, thus sparing litigants and courts the regular need to retrace the history of copyright protection for photography and to recite the protectable photographic elements of lighting and angle when the outcome of these machinations is usually known from the start.²⁰⁰ After all, as argued above, courts ultimately rely on proxies for originality rather than provide in each instance a robust accounting of what makes the particular constellation of choices embedded in a photograph original. If no such explanation is forthcoming, even for a heavily litigated medium, then why not opt for predictability?

At a doctrinal level, the answer to this question is that blanket protection would be incompatible with *Feist*. The opinion can fairly be read to apply outside the confines of its own facts and to require minimal creativity for any copyrightable work.²⁰¹ At a deeper policy level, the opinion suggests that retaining a shred of doubt as to the protectability of a work provides a needed check on the granting of copyright. Whether justified on utilitarian or natural rights grounds, copyright under *Feist* presents a system under which artists can generally protect their works, yet must be prepared to explain their works when challenged.

Accordingly, the proxy of ontology, whereby originality is viewed as an element of a photograph, is at odds with the policy of *Feist*. While *Feist* does not require much for copyright protection to attach at the threshold level, it does seem to require something beyond the mere fact of creation through the tools of the trade.²⁰² Furthermore, the appellate courts have

¹⁹⁹ Of course, applicable defenses, such as fair use, may permit copying.

²⁰⁰ See, e.g., *Schrock*, 586 F.3d 513; *FragranceNet.com, Inc. v. FragranceX.com, Inc.*, 679 F. Supp. 2d 312 (E.D.N.Y. 2010); *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444, 455-56 (S.D.N.Y. 2005); *SHL Imaging, Inc. v. Artisan House, Inc.*, 117 F. Supp. 2d 301 (S.D.N.Y. 2000).

²⁰¹ See *supra* Part I.B.

²⁰² See Harrison, *supra* note 10, at 872 (“Thus, having [merely] produced something is not a useful test of creativity.”).

indicated in recent years that some visual renderings will fail to achieve copyright protection on originality grounds.²⁰³ Questions about the degree to which copyright should apply uniformly across media are difficult and important, but largely beyond the scope of this article.²⁰⁴ Nevertheless, some rationale should explain the difference in approach.

For example, the Tenth Circuit in *Meshwerks* found that grayscale digital wire-frame models owed their origin to the defendants' cars and failed to make the grade.²⁰⁵ In *Darden v. Peters*, the Fourth Circuit affirmed the Copyright Office's refusal to register a map and website, holding that coloring a preexisting census map blue and shading it for three-dimensional effect were insufficiently creative contributions.²⁰⁶ In *ATC Distribution Group v. Whatever It Takes Transmissions & Parts, Inc.*, the Sixth Circuit found hand-drawn illustrations based on photographs of automobile parts not original.²⁰⁷ And the Second Circuit, in *Sparaco v. Lawler, Matusky, Skelly, Engineers LLP*, affirmed the grant of summary judgment to defendants where an allegation of infringement involved a site plan that "sets forth the existing physical characteristics of the site," employing no original features, but only "standard cartographic features."²⁰⁸ Even among more "artistic" works, it can be difficult to square the deep-seated deference to photographs with assessments in other genres. In *Satava v. Lowry*, for example, the Ninth Circuit all but denied copyright protection to a glass-in-glass jellyfish sculpture.²⁰⁹ While the courts may be correct in concluding that some of these works

²⁰³ See, e.g., *Meshwerks, Inc. v. Toyota Motor Sales U.S.A., Inc.*, 528 F.3d 1258, 1266 (10th Cir. 2008) (digital wire-frame models of cars); *Darden v. Peters*, 488 F.3d 277, 285 (4th Cir. 2007) (maps and website displaying real estate appraiser locations); *ATC Distrib. Grp. v. Whatever It Takes Transmissions & Parts, Inc.*, 402 F.3d 700, 712-13 (6th Cir. 2005) (illustrations of parts closely based on photographs); *Sparaco v. Lawler, Matusky, Skelly, Eng'rs LLP*, 303 F.3d 460, 467 (2d Cir. 2002) (site plan incorporating standard cartographic features).

²⁰⁴ See generally Michael W. Carroll, *One Size Does Not Fit All: A Framework for Tailoring Intellectual Property Rights*, 70 OHIO ST. L.J. 1361 (2009); Michael W. Carroll, *One for All: The Problem of Uniformity Cost in Intellectual Property Law*, 55 AM. U. L. REV. 845 (2006).

²⁰⁵ 528 F.3d at 1266.

²⁰⁶ 488 F.3d at 287; see also 37 C.F.R. § 202.1(a) (2010) (proscribing the award of copyright for "mere variations of . . . coloring").

²⁰⁷ 402 F.3d at 712-13.

²⁰⁸ 303 F.3d at 467.

²⁰⁹ 323 F.3d 805, 807 (9th Cir. 2003); see generally Morgan M. Stoddard, Comment, *Mother Nature as Muse: Copyright Protection for Works of Art and Photographs Inspired by, Based on, or Depicting Nature*, 86 N.C. L. REV. 572 (2008) (critiquing lack of protection by courts for works based on natural phenomena).

are too tied to their underlying subject matters or too minimally creative for copyright, the notion that the election of perspective alone in the case of a photograph²¹⁰ manifests more originality than some of the authorial-seeming decisions made in these cases is hard to justify.

By contrast, the other two proxies identified above, that of narrative and that of comparison, at least supply “something” in support of a claim for copyright protection. Specifically, if a copyright plaintiff wishes to press a claim, the proxy of narrative permits the something to subsist in an explanation of the work from which society, as a tradeoff for copyright, may benefit. For example, the narrative offered in the *Burrow-Giles* case itself contributed an elegant account of authorial practice in the relatively new medium of photography. The photographer’s explanation in *Schrock* was perhaps less flowery, but the narrative it offered—that the photographer was trying to make the toy trains look “friendly”—is at least a plausible account of the work that can be held up in court as a way of backstopping an originality finding. This is not to say that courts should, adhering to Tom Wolfe’s classic exposition on modern art, *The Painted Word*, cease to look at the image in favor of the narrative.²¹¹ Nor is it a call to begin dissecting the internal processes of the creative mind.²¹² The claim is only that, as between an assertion that “if X is a photograph, then it is original,” and some compelling, or at least plausible explanation of what a photographer was trying to accomplish, the latter is more capable of being subject to scrutiny in litigation, may be more informative to the public, and therefore is a more justifiable basis for copyright protection.

How, then, should we characterize the Obama Photograph in the *Fairey* case? The Associated Press argued that Garcia, the photographer, brought his artistic input to bear through his “deliberate selection of a specific moment in time to capture President Obama’s expression,” his choice to use a particular lens and lighting, and his composition of the photograph.²¹³ The AP provided further color by way of an

²¹⁰ *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1077 (9th Cir. 2000) (subsequent history omitted).

²¹¹ TOM WOLFE, *THE PAINTED WORD* 6 (1975) (describing the way in which theory, in modern art, dwarfed the images themselves—“In short: frankly, these days, without a theory to go with it, I can’t see a painting.”).

²¹² See Madison, *supra* note 10, at 851; VerSteeg, *supra* note 17, at 840-43.

²¹³ AP Amended Answer, *supra* note 4, at 13-14.

interview Garcia gave to National Public Radio about his steps in taking the photograph:

I'm on my knees, I'm down low, and I'm just trying to make a nice, clean head shot. And I'm waiting. I'm looking at the eyes. I mean, sure, there's focus, and I want the background to be a little bit soft. I wanted a shallow depth of field. I'm looking and waiting. I'm waiting for him to turn his head a little bit. I'm just patiently making a few pictures here and there, and I'm just looking for a moment when I think is right, and I'm taking some images as I'm going along, and then it happened. Boom, I was there. I was ready.²¹⁴

While one can imagine from this description that Garcia's brow did in fact shed some sweat during the creation of the photograph, it adequately conveys processes, in support of the photograph's originality, that are at least as creative as the selection of a canvas and paints that would factor into a protectable painting. Even if "waiting" for Obama to turn his head should not be characterized as the creation of a scene under Judge Kaplan's taxonomy, timing and rendering creativity appear to be present. Further, the fact that Garcia took more than one photograph at the event should not affect the analysis; Monet's haystacks are not judged unoriginal because they entailed repeated renderings. While Professor Farley is correct that courts do not emphasize explicitly the "plodding" nature of the artistry behind some photography²¹⁵—here, Garcia's "waiting"—acknowledgement of that aspect of photography is perhaps implicit in all the first-order challenges to originality that are never brought (as in the *Fairey* case itself).

The proxy of comparison also remains a valid mechanism by which courts may assess photographs following *Feist*. The Supreme Court's assessment of the garden-variety nature of the alphabetization of the white pages was implicitly made in a comparative context; one can expect that each Justice had encountered a number of these types of compilations, and compilations organized according to other principles, in the course of his or her lifetime.²¹⁶ Permitting parties to a copyright litigation to challenge or defend originality with a bevy of related images squares with the competence of courts to make comparative judgments, which

²¹⁴ *Id.* at 28 (quoting National Public Radio Interview with Garcia (Feb. 26, 2009)).

²¹⁵ Farley, *supra* note 20, at 449.

²¹⁶ See Miller, *supra* note 10, at 487 n.180 (making this point).

they do regularly in the context of infringement analyses.²¹⁷ Furthermore, given the ways in which professional photographers work—taking multiple (and sometimes hundreds or thousands) of photographs of a scene—the proxy of comparison may come closest to allowing a court to distill the creative input of the photographer. When courts attach a copy of the challenged image to their decisions along with others that they relied upon by way of comparison, that contrast affords later litigants the benefit of a graphic definition of originality (in the way that the *Oscar Wilde, No. 18* photograph serves as a visual exemplar of originality).

Thus, continued adoption of this proxy is appropriate, but with one caveat. As discussed above, in the case of comparisons made in the derivative work context, courts ask whether there is any nontrivial or distinguishable variation between a photograph and the subject matter depicted. In so doing, they are engaging in an exercise with a foregone conclusion, at least with respect to the ordinary transcription of three-dimensional objects into two-dimensional photographs. Variation and hence originality will be found. Thus, this particular comparative proxy is at odds with *Feist*.

In the end, obligating a copyright plaintiff to defend a challenge to originality, either by narrative or by visual comparison or by some other means, will likely prove an easy burden to bear. This is not a new test to meet; rather, as has been described, parties and courts are already engaging in these approaches to litigation. This article encourages transparency in the way in which originality is assessed so as to contribute to ongoing conversations about the social tradeoffs for the exclusive rights afforded by copyright.

B. *Scholarly Calls to Raise the Originality Threshold*

While this article calls for a more transparent—if not content-rich—application of originality principles to photography and other works that may be located on the more “artistic” end of the continuum, others recently have gone further and called for a heightening of the creativity

²¹⁷ They do this in the course of asking whether two works are substantially similar. See, e.g., *Peter F. Gaito Architecture, LLC v. Simone Dev. Corp.*, 602 F.3d 57, 63 (2d Cir. 2010) (setting out the elements of a copyright infringement claim); see also Miller, *supra* note 10, at 487 (advocating thick factual record to be presented to a court with a range of examples, but suggesting review more akin to nonobviousness assessment in patent law).

requirement. This group, rather than eschewing a determination of the merits of a litigated work, sees promise in the possibility that courts might openly engage with the level of a work's achievement. Specifically, they embrace the creativity component of originality as a meaningful tool by which to yield a more optimal level of socially valuable works—even if the policy behind that Court-created tool has not been clearly elucidated.²¹⁸ For Professor Zimmerman, for example, *Feist*, through its insistence upon a modicum of creativity, can be read as a corrective halt on the tradition of expansive readings of originality under *Bleistein*, under which “if it is not copied, it is original.”²¹⁹ She proposes that perhaps a more exacting approach to the application of the originality doctrine, as a proxy for quality, is called for.²²⁰

This suggestion is taken up in the scholarship of Professors Joseph Miller and Jeffrey Harrison. These scholars explicitly argue for a heightened creativity demonstration—that is, something above and beyond what is required now for the full panoply of copyright rights to attach—that could be brought about by a modified legal test or a modified application of the present one. The precise proposals vary in the specifics but share core commonalities. Drawing on the “nonobviousness” requirement in patent law, Miller would premise an originality determination on the degree to which a work is a “departure from that which is conventional, routine, or pedestrian” in the particular genre.²²¹ Harrison proffers a “modicum-times-2” standard that would require “more than minimal expertise, skill, taste, or judgment” and that the work “be capable of being distinguished from other ordinary objects.”²²² He would also adapt the concept of authorship to require some degree of “preconception.”²²³

These proposals aim to remedy two types of perceived ills. The first set of harms consists of a range of costs imposed by copyright. It is widely acknowledged that copyright has permeated many facets of life in the digital age; this

²¹⁸ Zimmerman, *supra* note 17, at 206.

²¹⁹ *Id.* at 202.

²²⁰ *Id.* at 212. For a comparison of the application of originality standards in non-U.S. jurisdictions, see Elizabeth F. Judge & Daniel Gervais, *Of Silos and Constellations: Comparing Notions of Originality in Copyright Law*, 27 *CARDOZO ARTS & ENT. L.J.* 375 (2009).

²²¹ Miller, *supra* note 10, at 477; *id.* at 464, 486-87.

²²² Harrison, *supra* note 10, at 867 (internal quotation marks omitted).

²²³ *Id.* at 859.

phenomenon both hovers as a perpetual threat of liability for downstream users and may deter would-be authors.²²⁴ Likewise, it is argued, copyright litigants do not internalize the full cost of disputes that are often of purely private significance with little associated public benefit of the sort copyright was designed to promote.²²⁵ A heightened threshold for originality would address these problems by reining in—up front—the number of works that become subject to copyright in the first place.

The second type of harm addressed in this scholarship is a structural weakness. The current regime, it is said, does not incentivize the creation of the optimal number of truly original works since authors likely “aim low” in their creative endeavors as a result of the minimal creativity demanded of them.²²⁶ The modifications proposed, they contend, would have the salubrious effect of encouraging authors to achieve greater creative heights (to thereby advance knowledge and learning) and, at the same time, would more readily justify the social costs of awarding the full slate of copyright exclusions and penalties.

These proposals raise important policy questions, which will be evaluated for their potential effects at the time of a work’s creation and at the time of enforcement.

1. Effects at the Time of Creation

The proposals described above embrace an incentive-based theory of copyright with an added twist: not only can copyright encourage the creation of works in the neighborhood of being creative,²²⁷ but manipulation of the quantum of creativity required will affect the level of creativity achieved. The implicit idea is that anxiety about whether a particular work would be protected, or the extent of its protection, will propel artists to reach for greater heights. And, having reached these heights, copyright would reward them for their achievements.

As an initial matter, there is reason to question the proposition that artists aim low because the originality threshold is low. The scholars advocating this position present

²²⁴ *Id.* at 859 & n.41; Miller, *supra* note 10, at 457-59, 464, 466-68; *see also* Parchomovsky & Stein, *supra* note 17, at 1508, 1518-20.

²²⁵ Harrison, *supra* note 10, at 855-56 (distinguishing between distributive and allocative interests); *see also* Parchomovsky & Stein, *supra* note 17, at 1512, 1518.

²²⁶ Harrison, *supra* note 10, at 857-58, 873-77; Parchomovsky & Stein, *supra* note 17, at 1506, 1517; *cf.* Miller, *supra* note 10, at 463-64.

²²⁷ *Cf.* Cohen, *supra* note 74, at 1152 (noting the distinction between creativity and mere production); Harrison, *supra* note 10, at 865, 872 (same).

no evidence that this is the case. With respect to the current professional photography market, moreover, there is reason to believe that financial considerations exert their own pressures on photographers to produce high quality works of authorship. Many sectors of the professional photography industry are undergoing significant structural change, with the traditional business models no longer seen as viable.²²⁸ In the face of pools of talented amateur photographers, stock houses that accumulate and supply low-cost, serviceable photographs for many needs, and reduced opportunities for paid work in the print media, market forces already encourage photographers to distinguish themselves creatively in order to attract clients and paying work.²²⁹

Furthermore, even assuming that a ratcheting up of the originality requirement would alter the behavior of authors, we should exercise caution in constructing a system in which adherence to a copyright rule is a foremost consideration during the process of artistic creation.²³⁰ Authors must already be increasingly conscious of one thread of copyright—the need to steer clear of infringement. There is a serious question about whether the further shaping of primary behavior through this sort of legal rule is desirable.²³¹ It is possible to have too much creativity; strange and radical departures from convention, undertaken merely for the sake of ensuring copyright protection, do not necessarily advance science and learning to the optimal degree.²³²

²²⁸ The comments are legion. See, e.g., Neil Burgess, *For God's Sake, Somebody Call It!*, EPUK (Aug. 1, 2010), <http://www.epuk.org/Opinion/961/for-gods-sake-somebody-call-it>; David Jolly, *Lament for a Dying Field: Photojournalism*, N.Y. TIMES, Aug. 10, 2009, <http://www.nytimes.com/2009/08/10/business/media/10photo.html>; Jay Kinghorn, *Rethinking Your Business Model*, STRICTLY BUSINESS BLOG (May 25, 2011), <http://www.asmp.org/strictlybusiness>; Holly Stuart Hughes & Conor Risch, *How Art Buyers Find Photographers Now*, PHOTO DISTRICT NEWS, Jan. 2010, at 36; Thomas Werner, *Photography Isn't Dead, the Business Model Is*, STRICTLY BUSINESS BLOG (May 27, 2011), <http://www.asmp.org/strictlybusiness>.

²²⁹ See, e.g., Stephanie Clifford, *For Photographers, the Image of a Shrinking Path*, N.Y. TIMES, Mar. 29, 2010, <http://www.nytimes.com/2010/03/30/business/media/30photogs.html> (describing financial pressures on established professional photography paths).

²³⁰ I want to thank Kathryn Judge for her helpful insight on this point.

²³¹ Parchomovsky and Stein argue that a benefit to their proposal of a tiered system under which the most original works would receive both the greatest freedom from liability in drawing upon preexisting works and also the strongest rights to pursue downstream infringement, is that it “will prompt authors to focus on the originality factor.” Parchomovsky & Stein, *supra* note 17, at 1517.

²³² See Jeanne C. Fromer, *A Psychology of Intellectual Property*, 104 NW. U. L. REV. 1441, 1479-83 (2010) (arguing that with respect to artistic endeavors, society generally tolerates less “newness” than it does with respect to scientific endeavors); Madison, *supra* note 10, at 823 (“More—more creativity, more creative goods, more

2. Effects at the Time of Litigation

Even setting aside the degree to which changing the legal standard might distort artistic production, the proposals raise the related issue of the desirable level of uncertainty that accompanies an infringement suit. As this article has argued, *Feist* does contain the seed of an approach to copyright under which the absence of guaranteed protection serves as a check on the system. By ruling out blanket protection for any medium, including photography, the opinion does inject some degree of uncertainty into copyright litigation—albeit uncertainty that typically can be remedied by an appropriate accompanying narrative or comparative evidence of originality.

By contrast, the proposals of Miller and Harrison to raise the originality threshold would introduce a greater level of uncertainty into the current litigation regime. This uncertainty would result from an increased lack of predictability as to whether a work was creative enough to merit copyright protection at all. Given the elusiveness of originality as a legal concept, the notion that the system could rationally articulate what is pedestrian or what is especially original—without deferring to the internal preferences of the decision maker—is difficult to comprehend.

Miller offers the example of a CT-scanned photograph of a rubber duck toy—“radiology art”—as the sort of thing copyright should protect in contrast to the Obama Photograph.²³³ Professors Gideon Parchomovsky and Alex Stein cite Alice Randall’s book *The Wind Done Gone* as the kind of work they view as highly original.²³⁴ But no principled basis for these determinations is clearly delineated. Furthermore, producing an attractive, high quality work where the range of authorial discretion is narrow—such as, perhaps, a press photograph at a political event—may support, rather than undermine, a claim of originality. For, many authorial decisions have often contributed to even a seemingly mundane photograph.²³⁵

creators—is not necessarily better; more is merely different.”); Parchomovsky & Stein, *supra* note 17, at 1522 (“We do not dispute that originality has an optimal amount.”).

²³³ See Miller, *supra* note 10, at 491 (“It strikes me, at the outset, as unconventional expression (in great contrast to Mr. Garcia’s photo of then-Senator Obama).”).

²³⁴ Parchomovsky & Stein, *supra* note 17, at 1529-31 (asserting that Randall’s book is “brimming with originality” and that the author “attempted—successfully—to break new literary ground”).

²³⁵ See, e.g., *supra* text accompanying note 214. Photographer Ryan Matthew Smith’s images for a new book on culinary techniques involved a series of creative decisions:

In any event, as this article has argued throughout, unless the system is revised explicitly to permit aesthetic judgments by courts on the originality question,²³⁶ courts will continue to use proxies for that assessment. Thus, rather than necessarily yielding a better crop of creative works, a heightened standard is likely to promote more elaborate narratives and more controversies over the appropriate comparative specimens offered in a litigation setting. This, if anything, is likely to result in more outcomes determined by judicial subjectivity.

Two additional reasons exist for enforcing, but not heightening, the requirement for originality. These will be taken up in the remaining subsections. The first is that the proposals to raise the requirement do not take full account of the way in which originality already functions—at the level of scope of protection—to allow downstream authors to operate, to a meaningful degree, free from the reach of an earlier photographer's copyright. The second is that heightening the originality threshold inadvertently may cause economically sustaining work to evaporate; if this is the case, creative endeavors—the sort that Miller, Harrison, Parchomovsky, and Stein would like to incentivize—that depend on that income may not come to fruition.

C. *Scope of Protection Safety Valve*

One argument sometimes proffered against protecting photographs of common scenes or mundane items is that the copyright holder will then be in a position to harass others who

The project required Smith to figure out creative ways to shoot a wide range of subjects. His shots of root crops growing underground were inspired by drawings of tree root structures he had seen. He also made those images by combining multiple shots. The challenges were keeping the lighting consistent, and propping up greens with toothpicks and tweezers as they wilted under the lights, Smith says. For the images of liquids and pours, he used Broncolor 3200 w/s strobes (and power packs) capable of firing at 1/9000th of a second, and some trial and error. "Getting the perfect splash or pour is all about timing," he says, explaining that he often threw some liquid with one hand and triggered his camera and strobes with the other.

David Walker, *Picture Story: An Accidental Adventure in Food Photography*, PHOTO DISTRICT NEWS (May 25, 2011), <http://www.pdnonline.com/pdn/features/Picture-Story-An-Ac-2932.shtml>.

²³⁶ As mentioned above, a number of scholars have argued that courts are already engaging in aesthetic determinations, even if the courts are not labeling them as such. *See supra* note 30.

independently photograph similar subjects.²³⁷ For example, several circuit courts have expressed concern that product manufacturers licensing the production of derivative works could find themselves prevented from the further licensing of—and possibly even liable for the infringement of—photographs of their own copyrighted works.²³⁸ To defuse this potential problem, courts must be rigorous in circumscribing the conditions under which a defendant can be held liable for staging and/or shooting a similar scene.²³⁹

Striking the right balance in the infringement context is crucial since the principles derived from these cases could affect the copyright status of the billions of unlitigated photographs that depict common scenes and setups. Given the highly representational nature of photography,²⁴⁰ the notion that the average snapshot in front of the Statue of Liberty might theoretically infringe a similar photograph seen elsewhere by the snap-shooter would not be an ideal copyright policy. Aware of what rests in the balance, courts already perform reasonably well in determining whether two different, but similar, photographs lead to a determination of infringement of one by the other.

1. General Principles

The seminal Supreme Court decisions do not provide direct guidance on how close a subsequent photograph may come to an earlier photograph since they addressed threshold copyrightability problems. Once it was decided that Saroni's photograph was original, no further work was undertaken to

²³⁷ *Custom Dynamics, LLC v. Radiantz LED Lighting, Inc.*, 535 F. Supp. 2d 542, 549 (E.D.N.C. 2008) (expressing concern that finding photographs copyrightable would allow plaintiff to “corner the market on advertising aftermarket motorcycle lighting accessories by copyrighting purely descriptive pictures of its wares”); *Oriental Art Printing, Inc. v. Goldstar Printing Corp.*, 175 F. Supp. 2d 542, 548 (S.D.N.Y. 2001) (subsequent history omitted); see also Ginsburg, *supra* note 148, at 1077 (discussing this argument).

²³⁸ *Entm't Research Grp. v. Genesis Creative Grp.*, 122 F.3d 1211, 1224 (9th Cir. 1997); *Gracen v. Bradford Exch.*, 698 F.2d 300, 303-04 (7th Cir. 1983); *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 910-11 (2d Cir. 1980).

²³⁹ *SHL Imaging, Inc. v. Artisan House, Inc.*, 117 F. Supp. 2d 301, 311 (S.D.N.Y. 2000); cf. Gorman, *supra* note 9, at 1591-92, 1598-99 (discussing distinction between exact duplication and re-staging).

²⁴⁰ See GAINES, *supra* note 46, at 67 (contrasting written composition and photography and remarking that “two different men may very well produce *identical* photographs using the same apparatus identically positioned”).

probe the nature of the defendant's 85,000 lithographic copies—they were infringing.



The Burrow-Giles Lithographic Co.'s lithograph,
Courtesy of the Library of Congress

The Court was not asked to decide, for example, whether another photographer would have been permitted to pose and photograph Oscar Wilde in a similar fashion or how close such a subsequent photograph could have come to Sarony's image before it infringed.²⁴¹

²⁴¹ This did not prevent the defendant in *Burrow-Giles* from making an argument, along these lines, that should the Court affirm the copyrightability of the photograph, Oscar Wilde would not be permitted to hire a painter to paint him in a similar setting. See Statement and Brief for Plaintiff in Error at 15, *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884) (No. 1071).

The general consensus is that exact reconstruction of an earlier copyrighted photograph is infringement.²⁴² How should a court determine if a subsequent photograph infringes an earlier one? While there is a gray area here, courts are better equipped institutionally to decide this question—of whether a later photograph appropriated original material from an earlier one—than the first-order originality status of the earlier one; after all, courts are institutions designed to balance and compare.²⁴³

Proxies play a role at this phase of litigation as well. Comparative techniques are clearly at the heart of the infringement analysis. But even authorial narrative may help to define the scope of protection to which a copyright plaintiff's work is entitled. *Sahuc v. Tucker*, for example, involved two photographs of the St. Louis Cathedral at Jackson Square in New Orleans and the claim that the later one infringed the earlier one.²⁴⁴ The plaintiff proffered a narrative about the way he sought a “spectral,” “mysterious,” and “timeless” quality of the setting in his black-and-white photo.²⁴⁵ He testified that “‘it all works,’ that there is ‘no one thing’ and ‘all of the elements’ are important.”²⁴⁶ According to the court, however, that narrative sufficiently departed from the second photographer's testimony that he photographed in color so as to provide the “viewer with more information.”²⁴⁷ The second photograph focused primarily on the Cathedral as its “center of interest,” aiming to capture it “under optimum conditions” and to provide a visual path of “rising up.”²⁴⁸ Taking all of this into account,

²⁴² See 1 NIMMER & NIMMER, *supra* note 31, § 2.08[E][2]; Malkan, *supra* note 143, at 446. The court in *SHL Imaging* suggested that certain reconstructions would constitute infringing derivative works. See 117 F. Supp. 2d at 306 (remarking that “[r]e-shooting an earlier photographic work with some alteration of the expressive elements is an[] example” of derivative authorship since “the nature of photographic authorship would have been recast, adapted, or transformed”).

²⁴³ Cf. Malkan, *supra* note 143, at 448 (questioning how one should assess the respective contributions to an image of a beautiful subject matter as between the first photographer and any subsequent photographers and suggesting that it is the “level of original authorship in the earliest photograph [that] is the wild card”).

²⁴⁴ 300 F. Supp. 2d 461, 463 (E.D. La. 2004) (subsequent history omitted).

²⁴⁵ *Id.* at 463, 465. (The court does not use quotation marks with respect to these descriptions, but does cite the plaintiff as the source of them.)

²⁴⁶ *Id.* at 465 (quoting plaintiff).

²⁴⁷ *Id.* at 466. (The court does not use quotation marks with respect to this description, but does cite the defendant as the source of them.). Coming closer to the plaintiff's narrative, the defendant also described his photo as “ethereal, unearthly, spiritual, and mysterious.” *Id.* (The court does not use quotation marks with respect to these descriptions, but does cite the defendant as the source of them.)

²⁴⁸ *Id.* (quoting defendant) (internal quotation marks omitted).

the court held that there was no infringement.²⁴⁹ Accordingly, reliance on a plaintiff's narrative account of originality does not necessarily entail a victory for the plaintiff.

Recent case law and scholarship, however, have questioned the utility of some of the tools courts use to perform this kind of analysis. These tools, however, are essential to upholding the principles of *Feist*. Although the precise formulation of the test for copyright infringement varies among the circuits and in different contexts, copyright protection is generally available only to the extent that the allegedly infringing work is substantially similar to the protectable original elements in the earlier work.²⁵⁰ Two doctrines operate to limit the scope of a work's protection: merger and *scènes à faire*.²⁵¹

The merger doctrine is an extension of the idea/expression dichotomy, under which copyright protection applies only to the expression of ideas, not to the ideas themselves.²⁵² The merger doctrine takes this notion to its logical conclusion: if an idea can be expressed in only one way, then the expression of that idea is said to merge with the idea.²⁵³ In such a case, the expression cannot be protected by copyright because it would give an author a monopoly on the underlying idea.²⁵⁴ Accordingly, others may freely copy merged

²⁴⁹ *Id.* at 467.

²⁵⁰ See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991) ("To establish infringement, two elements must be proven: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original."); see, e.g., *Peter F. Gaito Architecture, LLC v. Simone Dev. Corp.*, 602 F.3d 57, 63 (2d Cir. 2010) (setting out substantial similarity test).

²⁵¹ Although I discuss these doctrines at the scope of protection phase, in some circuits they are invoked at the copyrightability phase. See generally Andrew B. Hebl, *A Heavy Burden: Proper Application of Copyright's Merger and Scenes à Faire Doctrines*, 8 WAKE FOREST INTELL. PROP. L.J. 128 (2007) (analyzing the treatment of these doctrines, and the corresponding burdens of proof, across the circuits). It is not uncommon to see the doctrines invoked where, as discussed above, a defendant has challenged the plaintiff's work as garden variety. See, e.g., *Schrock v. Learning Curve Int'l, Inc.*, 586 F.3d 513, 522 n.5 (7th Cir. 2009); *Oriental Art Printing, Inc. v. Goldstar Printing Corp.*, 175 F. Supp. 2d 542, 547 n.3 (S.D.N.Y. 2001) (subsequent history omitted).

²⁵² 17 U.S.C. § 102(b) (2006).

²⁵³ *Computer Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 707-08 (2d Cir. 1992); *Concrete Mach. Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 606 (1st Cir. 1988). Articulation of the rule, however, is far easier than the application of it. As Professor Hughes puts it, "the doctrine's indeterminacy comes from trying to apply an either/or dichotomy—with draconian implications—to a multilayered world." Hughes, *supra* note 15, at 91.

²⁵⁴ *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971); Michael D. Murray, *Copyright, Originality, and the End of the Scenes à Faire and Merger Doctrines for Visual Works*, 58 BAYLOR L. REV. 779, 788 (2006) (citing *Educ. Testing Servs. v. Katzman*, 793 F.2d 533, 539 (3d Cir. 1986)).

expression. To illustrate, the First Circuit upheld the application of the merger doctrine in an infringement dispute over candle fragrance labels in which the defendant-competitor's photographs of eucalyptus, cranberry, and other vegetation were similar to those of the plaintiff.²⁵⁵ It explained that "there were few associated expressions, of which the most obvious was a realistic representation of the fruit or flower at issue" and that the defendant could use "the same subject matter on its labels, even if the genesis for [its] choice of subject matter was [the plaintiff's] labels."²⁵⁶

The *scènes à faire* doctrine has come to refer to stock phrases, events, themes, and characters that are commonly employed in the context of a particular kind of work, such as "the cars in a car chase, the kiss in a love scene, [or] the dive bombers in a movie about Pearl Harbor."²⁵⁷ There are several purposes undergirding this doctrine. First, there is a fairness argument that stock themes and conventions belong in the public domain.²⁵⁸ Another purpose is evidentiary; given their prevalence in the culture, it would be impossible, in a copyright infringement case, to determine whether one work had copied from another or had simply drawn upon familiar human experiences.²⁵⁹ Finally, *scènes à faire* are seen as "essential to the presentation of the subject matter of [a] work" and accordingly lack originality.²⁶⁰ Some scholars have described

²⁵⁵ *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 32 n.1 (1st Cir. 2001).

²⁵⁶ *Id.* at 36. However, the court discerned limitations in the merger doctrine's application to this case, where there were "sufficient details in th[e] photographs to make them unique." *Id.* According to the court, the merger doctrine would not have allowed the defendant to scan the plaintiff's labels into a computer and "reproduce[] them exactly," and it might also have prevented the defendant from taking its own photographs of the photographic subjects arranged "nearly identical[ly]" to the plaintiff's arrangement. *Id.*

²⁵⁷ *Bucklew v. Hawkins, Ash, Baptie & Co.*, 329 F.3d 923, 929 (7th Cir. 2003).

²⁵⁸ *See Scott-Blanton v. Universal City Studios Prods. LLLP*, 539 F. Supp. 2d 191, 201 (D.D.C. 2008) ("Indeed, the public domain would have a scant selection if stock settings such as the movie theatre, the kitchen, Las Vegas, a church picnic or a club were subject to copyright protection."); Murray, *supra* note 254, at 794 (citing several cases).

²⁵⁹ *See Lichtman, supra* note 15, at 739; Murray, *supra* note 254, at 794.

²⁶⁰ Murray, *supra* note 254, at 794. Note, however, that some view *scènes à faire* as protectable expression and others do not. *Compare Murray Hill Publ'ns, Inc. v. Twentieth Century Fox Film Corp.*, 361 F.3d 312, 319 (6th Cir. 2004) ("[E]xpressions not protectable because they follow directly from unprotectible ideas are known as *scènes à faire* . . ."), with *Taylor Corp. v. Four Seasons Greetings, LLC*, 315 F.3d 1039, 1042-43 (8th Cir. 2003) ("Labeling certain stock elements as '*scènes à faire*' does not imply that they are uncopyrightable; it merely states that similarity between plaintiff's and defendant's works that are limited to hackneyed elements cannot furnish the basis

scènes à faire as “infrastructural, for they constitute the ‘elements of creation, a vocabulary needed to create a work.’”²⁶¹

The *scènes à faire* doctrine often serves as a convenient catch-all of elements, without sufficient attention paid to the nature of the element as it relates to the genre of work under consideration. This is particularly true in the case of photography. Some courts seem prepared to invoke this doctrine, but to limit consideration of it to what may be thought of as the “plot” of the photograph, that is, to those aspects that relate to what the photograph purports to be about. For example, one court identified the portrayal of a dancer’s motion and dress, associated with a traditional type of dance, as *scènes à faire*.²⁶² In another case, where two photographs of the same dinosaur fossil were shot surrounded by sand, the court held that sand was a *scène à faire* in that “it is the obvious choice of background for the [f]ossil.”²⁶³

In order to translate this doctrine to the photographic context, however, courts should consider the stock and trade elements of photography. In particular, if, as is frequently stated, creativity in photography relates more to the depiction of subject matter than to any claim to the photographic subject itself, then defendants should be permitted to adopt any angle, lighting, or composition technique that is routinely used in professional photography without fear of infringement. Some courts have signaled that they are willing to take such choices into consideration when adjudicating alleged infringement. In one dispute, where the two fashion photographs at issue each portrayed a woman’s legs and handbag in a bathroom stall, the court was inclined to include as *scènes à faire* some of the choices traditionally associated with photography, such as angle and focus:

[I]t is standard for the photographer to take such a photograph from or near the floor, and it follows that a portion of the floor closest to the camera might be out of focus. A natural consequence of that positioning is also, often, a head-on view of the toilet. In addition, a

for finding substantial similarity.” (citing 1 NIMMER & NIMMER, *supra* note 31, § 13.03[B]4 at 13-75)).

²⁶¹ Peter Lee, *The Evolution of Intellectual Infrastructure*, 83 WASH. L. REV. 39, 61 (2008) (quoting Leslie A. Kurtz, *Copyright: The Scènes à Faire Doctrine*, 41 FLA. L. REV. 79, 114 (1989)).

²⁶² *Reece v. Island Treasures Art Gallery, Inc.*, 468 F. Supp. 2d 1197, 1207 (D. Haw. 2006).

²⁶³ *Psihoyos v. Nat’l Geographic Soc’y*, 409 F. Supp. 2d 268, 275 (S.D.N.Y. 2005).

photographer of such a scene would generally want the fashion and model to be in sharp focus.²⁶⁴

2. Critiques

The application of these doctrines to visual works, including photography, is not without controversy.²⁶⁵ In the *Mannion* opinion discussed above,²⁶⁶ Judge Kaplan questioned the applicability of the idea/expression and merger principles to visual works.²⁶⁷ He reasoned that “it is not clear that there is any real distinction between the idea in a work of [visual] art and its expression. An artist’s idea, among other things, is to depict a particular subject in a particular way.”²⁶⁸

Relatedly, Professor Michael Murray argues that merger and *scènes à faire*, while well suited to literary works, are ill suited to the realm of visual works and should play no part in the infringement analysis of such works.²⁶⁹ The doctrines are a “great curse” in the visual arts, he claims, because their application rests on the “fallacy . . . [t]hat an idea of a visual work and the expression of the idea can merge, or that artists must copy a standard image in order to depict an idea.”²⁷⁰ Specifically, in the literary context, he acknowledges that the doctrines operate to safeguard the public domain from the “excessively broad enforcement” of rights at a level of abstraction “beyond [the] actual words.”²⁷¹ In the visual arts context, by contrast, infringement “is much more often based on a claim of literal or actual copying; no abstraction of the work is required, and, therefore, there is no need to circumscribe the scope of plaintiff’s work to protect the public

²⁶⁴ *Bill Diodato Photography, LLC v. Kate Spade, LLC*, 388 F. Supp. 2d 382, 392 (S.D.N.Y. 2005) (internal citation omitted); *see also* *Oriental Art Printing, Inc. v. Goldstar Printing Corp.*, 175 F. Supp. 2d 542, 547 n.3 (S.D.N.Y. 2001) (subsequent history omitted) (noting that “each of the potentially protectable elements, i.e. the photographs’ lighting, angle, and the choice of plates, flow necessarily from the subject matter of the photographs, i.e. the realistic depiction of most common Chinese food dishes”).

²⁶⁵ Hon. Jon O. Newman, *New Lyrics for an Old Melody: The Idea/Expression Dichotomy in the Computer Age*, 17 *CARDOZO ARTS & ENT. L.J.* 691, 697-98 (1999) (critiquing the application of doctrines applicable in one medium to others, including the abstraction analysis applicable to literary texts to visual works).

²⁶⁶ *See supra* Part II.D.1.

²⁶⁷ *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444, 455-56 (S.D.N.Y. 2005).
²⁶⁸ *Id.* at 458.

²⁶⁹ Murray, *supra* note 254, at 784.

²⁷⁰ *Id.* at 848.

²⁷¹ *Id.* at 849.

domain from an expansive protection of abstractions of plaintiff's work."²⁷²

Murray appears to differ from Judge Kaplan on whether the idea/expression dichotomy makes sense as applied to visual works. While generally supporting Judge Kaplan's view, which limits the application of the idea/expression, merger, and *scènes à faire* doctrines, Murray identifies the idea/expression dichotomy as a safety valve in his attack on the other two doctrines. Specifically, he states that "[t]o the extent that the idea of certain images is in the public domain, they are free for use whether characterized as *scènes à faire* or simply themes and ideas."²⁷³ In this sense, unlike Judge Kaplan, he seems to contemplate that it is possible, if difficult, to separate an idea from its visual representation. Where they share common ground is in their agreement that it is possible to express oneself visually in a myriad of ways.

For Judge Kaplan, the upshot is that later artists should not be able to appropriate the original aspects of a work and avoid an infringement determination by pleading "shared idea." This view is undercut, however, by the irrefutable fact that the idea/expression dichotomy is a basic concept around which infringement is assessed.²⁷⁴ Photography is generally a highly representational art form, and there would seem to be no reason why courts should not use the traditional modes of analysis to assist in the infringement inquiry. Photographs implementing similar ideas are bound to look more alike than hand-painted canvases doing the same, but that does not mean that photography should be closed off to the free use of ideas.

For his part, Murray is concerned that most infringement suits in the visual arts involve "literal or actual copying."²⁷⁵ He argues, therefore, that there is less of a role for abstraction to play, and thus less of a need to constrain an earlier artist's monopoly over abstractions. Without diminishing Murray's comprehensive survey of merger and

²⁷² *Id.*

²⁷³ *Id.* at 794.

²⁷⁴ This is the case even if, as Professor Amy Cohen argues, the dichotomy boils down to aesthetic judgment in the final analysis. *See generally* Cohen, *supra* note 30.

²⁷⁵ Murray, *supra* note 254, at 849. By this, he explains, he means more than duplication by "photo-mechanical means such as photographing, photocopying, or scanning"; he would also include the direct copying by hand of a visual work, among other things. Unfortunately, Murray does not explain what would constitute "literal or actual copying" in the photographic context, though he does acknowledge the imprecision of these terms. *Id.* at 849 n.455.

scènes à faire in the visual arts, a fair number of the disputes in the context of photography in fact do involve some kind of subsequent arrangement and photographing of similar subject matters rather than copy-and-paste duplication.²⁷⁶ In such cases, Murray's views are not persuasive.

At their core, the idea/expression, merger, and *scènes à faire* doctrines are useful tools in assessing the scope of protection to which an earlier photograph is entitled.²⁷⁷ In part, this is because of the nature of the photographic medium; given the likely similarity between two photographs of the same subject matter, reliance on these doctrines is essential to ensuring—if we are truly committed to the principle—that successive photographers are free to try their hands at similar material. In part, this is also because of the nature of the disputes that often arise over photographs. Where a product manufacturer enlists a second photographer to photograph its products—rather than engage in infringement through continued use of an earlier photographer's work beyond the contractual terms—it must have reasonable latitude to proceed without threat of a suit by the earlier photographer. In these cases, where there may be little room for variety in how a product is shot, the idea/expression, merger, and *scènes à faire* doctrines can assist in assuring fluid marketing and advertising practices. In such cases, these doctrines, along with

²⁷⁶ See, e.g., *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25 (1st Cir. 2001); *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068 (9th Cir. 2000) (subsequent history omitted); *Leigh v. Warner Bros., Inc.*, 212 F.3d 1210 (11th Cir. 2000); *Leibovitz v. Paramount Pictures Corp.*, 137 F.3d 109 (2d Cir. 1998); *Gross v. Seligman*, 212 F. 930 (2d Cir. 1914); *Masterson Mktg., Inc. v. KSL Recreation Corp.*, 495 F. Supp. 2d 1044 (S.D. Cal. 2007); *Straus v. DVC Worldwide, Inc.*, 484 F. Supp. 2d 620 (S.D. Tex. 2007); *Reece v. Island Treasures Art Gallery, Inc.*, 468 F. Supp. 2d 1197 (D. Haw. 2006); *Psihoyos v. Nat'l Geographic Soc'y*, 409 F. Supp. 2d 268 (S.D.N.Y. 2005); *Bill Diodato Photography, LLC v. Kate Spade, LLC*, 388 F. Supp. 2d 382 (S.D.N.Y. 2005); *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444 (S.D.N.Y. 2005); *Sahuc v. Tucker*, 300 F. Supp. 2d 461 (E.D. La. 2004); *Gentieu v. Tony Stone Images/Chicago, Inc.*, 255 F. Supp. 2d 838 (N.D. Ill. 2003); *Fournier v. Erickson*, 202 F. Supp. 2d 290 (S.D.N.Y. 2002); *Kaplan v. Stock Market Photo Agency, Inc.*, 133 F. Supp. 2d 317 (S.D.N.Y. 2001); *Pampered Chef, Ltd. v. Magic Kitchen, Inc.*, 12 F. Supp. 2d 785 (N.D. Ill. 1998); *Caratzas v. Time Life, Inc.*, No. 92 Civ. 6346, 1992 WL 322033 (S.D.N.Y. Oct. 23, 1992); *Kisch v. Ammirati & Puris Inc.*, 657 F. Supp. 380 (S.D.N.Y. 1987).

²⁷⁷ Parchomovsky and Stein argue that “[copyright law fails to take the next step [beyond the threshold inquiry into originality] and calibrate the scope of the copyright protection to the degree of the work's originality.” Parchomovsky & Stein, *supra* note 17, at 1506. The three doctrines discussed in this section, however, are important tools that serve to promote that calibration even under the current system. See Shyamkrishna Balganes, *Response: Tiered Originality and the Dualism of Copyright Incentives*, 95 VA. L. REV. IN BRIEF 67, 75-76 (2009) (discussing doctrine of thin copyright in this capacity).

proof of engagement of a second photographer and the specifications given to the second photographer, should be sufficient—as long as they do not advocate copying—to defend against an infringement charge.²⁷⁸ This approach likewise coheres with our basic intuitions that amateur snapshot takers should have wide berth to shoot familiar scenes without being deemed copyright infringers.

D. *Structure of Copyright, Creation, and Career*

The remaining question is whether a heightened originality threshold would yield more creative output from creators. As argued above, it would be difficult, if not impossible, under the system as it currently stands to determine how such output would be measured. And, it is far from clear that we would want courts to play that role. But even if one were to defer to Miller's, Harrison's, and Parchomovsky and Stein's view of what heightened creative output might consist of, it is important to consider whether raising the level of originality required for protection might actually decrease the level of creativity achieved by authors because of how the relevant professional industries are structured. Photography is a case in point.

For example, if protection for photographs of common commercial and industrial items is eliminated as a consequence of ratcheting up the originality threshold, rampant copying of photographs may begin to occur in the ordinary course of business. In the recent *Fragrancenet.com* case, some 900 images of perfume bottles were alleged to have been copied outright.²⁷⁹ As displayed on its website,²⁸⁰ *Fragrancenet.com*'s images appear professionally and attractively rendered and, if they are made legally available for the taking, there is every reason to expect that many competing perfume retailers will simply copy the images of the bottles and attempt to attract customers by reducing prices or

²⁷⁸ Cf. Malkan, *supra* note 143, at 452 (suggesting that if the district court in *SHL Imaging* was correct that “[p]ractically, the plaintiff’s works are only protected from verbatim copying,” then “a product owner evidently would be permitted to intentionally reconstruct a copyrighted photograph of the product, even borrowing the same lighting techniques and creative details (like the blue sky reflection in the mirrors), as long as the second photograph was discernible from the first” (internal footnote, emphasis, and quotation marks omitted)).

²⁷⁹ *FragranceNet.com, Inc. v. FragranceX.com, Inc.*, 679 F. Supp. 2d 312, 315 (E.D.N.Y. 2010).

²⁸⁰ <http://www.fragrancenet.com> (last visited Feb. 12, 2011).

altering other visual elements on their own websites. No perfume bottle would need to be photographed twice.

Such a consequence may not prove troubling to many. Indeed, Professor Miller states that “unconventional . . . expression does more to advance knowledge and learning than does pedestrian, convention-bound expression.”²⁸¹ While Miller’s views of the ultimate aims of copyright are unobjectionable, the means he advances—potentially eliminating protection for the arguably “pedestrian,” such as standard photographs of perfume bottles—might prove self-defeating. The reason, at least with respect to professional photography, is the nature of the financial arrangements undergirding creative endeavors.

Specifically, even assuming some commercial photographs—of motorcycle parts, rubber doorstop covers, and ceramic plates for catalogs, advertisements, and magazine covers—may not represent the best of what the Constitution’s Framers had in mind for the copyright system that would be established, many professional photographers, who are often freelancers, rely upon income from these sorts of images to support the challenging, creative, and artistic work they do.²⁸² Thus, the key role that these “orthodox” images play in support of “original” work, and the fact that they continue to be copied and litigated, may weigh against Miller’s view that “unorthodox creative expression has greater need of protection against purely imitative copying”²⁸³ even if we agree that the increased production of “unorthodox creative expression” is in fact an ultimate goal of copyright.

This interconnected business model is not new. In a well-known handbook, *Best Business Practices for Photographers*, photographer John Harrington acknowledges the second-class status that commercial work assumes for

²⁸¹ Miller, *supra* note 10, at 464.

²⁸² See, e.g., MICHAL HERON, CREATIVE CAREERS IN PHOTOGRAPHY: MAKING A LIVING WITH OR WITHOUT A CAMERA 45, 92, 99 (2007) (noting that a number of photographers have made hybrid careers in both the commercial and fine art photography markets and that “assignments can pay for the personal work which often is undertaken with the photographer’s own finances”) (quoting interview with photographer Joyce Tenneson); Clifford, *supra* note 229 (describing freelance photojournalist Matt Eich who “has been supplementing magazine work with advertising and art projects, in a pastiche of ways to earn a living”); Paula Lerner, *An Open Letter to Students Contemplating Photojournalism*, DIGITAL JOURNALIST (Dec. 2002), <http://www.digitaljournalist.org/issue0212/lerner.html> (describing different methods of supporting creative photography pursuits).

²⁸³ Miller, *supra* note 10, at 464.

some.²⁸⁴ But, he cites Ansel Adams and Richard Avedon as photographers who were able to pursue creative projects based upon the income streams generated from commercial work.²⁸⁵ These sorts of personal projects constitute work, it is submitted, that the scholars identified earlier might be more inclined to support through copyright. For example, Boston-based photographer Paula Lerner has financed several trips to photograph and interview women in Afghanistan—photojournalistic work that recently was honored with an Emmy Award—by accepting commercial assignments in the United States.²⁸⁶ A New York-based food photographer interviewed for this article stated that while the stylish and artistic images posted on her website at times might be too unique to be used for a commercial job, whether it be advertising or food packaging, they project a sense of style that attracts paying clients for commercial work, which in turn permits her to continue developing a portfolio of personally-driven work that is made freely available for public viewing on her website.²⁸⁷ This sentiment is echoed by photographer Kevin Arnold:

I believe strongly in the value of personal projects. As a commercial photographer, I get to do some great work on assignment, but the fact is that a lot of that work ends up getting watered down in terms of creativity. Even clients who appreciate good imagery have to cover their basis. They are usually spending a lot of money and need to make sure they tick off all the boxes—having the right product used by the right demographic in the right environment. In the end, the imagery can be good, but it is rarely something the [sic] pushes your creative boundaries. I find that clients will hire you to do the work you love, but they need to see it first. Convincing a potential client to

²⁸⁴ JOHN HARRINGTON, *BEST BUSINESS PRACTICES FOR PHOTOGRAPHERS* (2d ed. 2010).

²⁸⁵ *Id.* at xxvii-xxix; see also JANET MALCOLM, *Men Without Props*, in DIANA & NIKON: *ESSAYS ON PHOTOGRAPHY* 42 (expanded ed. 1997) (noting Richard Avedon's "corollary career" as a serious portrait photographer). Although she critiques the incentives theory of copyright in a recent article, Professor Zimmerman concedes that "[c]ommon sense . . . suggests that people will be able to spend less time, overall, producing copyrightable works if they have no prospect of being able to support themselves, either directly or indirectly, from this kind of work." Diane Leenheer Zimmerman, *Copyright as Incentives: Did We Just Imagine That?*, 12 *THEORETICAL INQUIRIES* L. 29, 47 (2011). And she notes that "certain works [such as 'potboiler' bodice-rippers] are probably produced almost entirely because they are expected to generate a good return on the investment." *Id.* at 47-48.

²⁸⁶ See, e.g., Paula Lerner, *The Life and Death of Sitara Achakzai*, *THE WORLD* (July 29, 2009), <http://www.theworld.org/tag/paula-lerner>. For coverage of the award, see Nat'l Acad. of Television Arts & Sci., 31st Annual News & Documentary Emmy Awards (Sept. 27, 2010), http://www.emmyonline.tv/mediacenter/pdf/news_31st_winners_v03.pdf.

²⁸⁷ E-mail from Beth Galton, Beth Galton Studio, to author (Apr. 9, 2011, 13:07 EST) (on file with author) (follow-up to in-depth interview (June 16, 2010)).

shoot in a particular style or to shoot particular subjects is hard. But if they see the work and it is good, they respond.²⁸⁸

It may be argued that basing policy on these snapshots of how some photographers have structured their livelihoods so as to produce creative work is tantamount to proposing that copyright be used as “a form of protection for the industries of the present at the expense of those of the future” or as a means of preventing professional photography’s “natural death.”²⁸⁹ Likewise, it might be asked whether it follows from this line of inquiry that the Supreme Court should have remanded in *Feist* for further evidence of the creative side projects of the phone book compilers whose incomes might have been crimped by the decision. These are valid concerns. This article simply suggests that, without close consideration of the ways in which tinkering with the originality requirement may affect particular industries,²⁹⁰ a well-intended proposal to increase creative output may end up stifling just that sort of work.

According to the constitutional language, Congress is accorded the power to protect the “Writings”—plural—of authors.²⁹¹ Perhaps this textual formulation highlights the expectation that authorial careers will produce a range of output, some of which may be quite banal but which serves to support evolving grasps at greatness. Under this theory, even if a photograph of an everyday commercial product or political event is not a masterpiece, as long as it is plausibly original, it can be seen as serving as a placeholder (or proxy) for the more creative works that the copyright system hopes—but can never guarantee—that an author will create over the course of his or her career. Parchomovsky and Stein are surely correct to note that “[i]f society wishes to encourage authors to produce highly original works and not settle for the bare minimum necessary to secure protection, it must reflect this preference in the design of the law.”²⁹² By viewing creativity across the span of a career, we can explore whether and how, through mechanisms

²⁸⁸ Rob Haggart, *Making the Break: Kevin Arnold*, APHOTOEDITOR, (June 8, 2010), <http://www.aphotoeditor.com/2010/06/08/making-the-break-kevin-arnold/> (quoting photographer Kevin Arnold).

²⁸⁹ Tim Wu, *On Copyright's Authorship Policy*, 2008 U. CHI. LEGAL F. 335, 348 (2008).

²⁹⁰ Cf. Justin Hughes, *Copyright and Its Rewards, Foreseen and Unforeseen*, 122 HARV. L. REV. F. 81, 92 (2009) (calling for copyright scholarship to better grapple with the implications on industry of proposed changes).

²⁹¹ U.S. CONST. art. I, § 8, cl. 8.

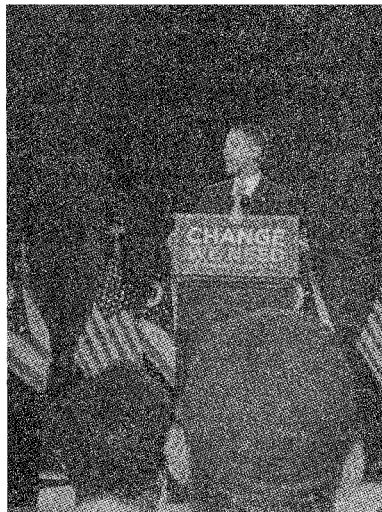
²⁹² Parchomovsky & Stein, *supra* note 17, at 1517.

such as the low originality threshold, the current law may already reflect such a preference.

CONCLUSION

This article has argued against a presumption of protectability for photography. Copyright is the grant of a limited monopoly and, therefore, where a work is challenged, copyright plaintiffs owe society an explanation or demonstration of what makes that work original. In most cases, this can be done by way of evidence that is narrative or comparative in nature. The proper application of originality principles to photography entails protection against outright copying in most cases²⁹³ but wide latitude to stage and shoot similar subject matter found in earlier photographs. Any initiatives to raise the bar for originality, however, should be carefully considered.

Turning back to the *Fairey* case, this article concludes by addressing, photographically, Luc Sante's suggestion that anyone could have taken a photographic shot equal in quality to Mannie Garcia's. Below I offer an uncropped, unmanipulated photograph that I managed to snap from the fourth row of a campaign speech. I had the access, and I took about forty shots, of which this is by far the best. I am happy to have it, but it probably would not have inspired a campaign poster.



Photograph by Eva Subotnik

²⁹³ To reiterate, this comment is offered without factoring in any applicable defenses to copying.