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Photography and the Work-for-Hire Doctrine

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PHOTOGRAPHY AND THE WORK-FOR-HIRE DOCTRINE

R. SCOTT MILLER, JR.† ††

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I. INTRODUCTION

Photography has enjoyed a unique niche in the history of copyright, especially in the context of the work-for-hire doctrine. In this article, I intend to trace that history, beginning with the Supreme Court case decided over 100 years ago which first extended copyright protection to photographs. I will then examine the treatment photography received under the 1909 Act and the 1976 Act and judicial interpretations of this legislation. Finally, I will look at recent legislative action in the states of New York and California and its impact on the work-for-hire doctrine as it is applied to photography, and recommend a statutory addition for Texas.

II. PHOTOGRAPHY'S ENTITLEMENT TO COPYRIGHT PROTECTION

The history of copyright protection for photography in the United States begins with the case of *Burrow-Giles Lithographic Co. v. Sarony*.¹ Sarony was a successful photographer with a large business

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†† I would like to thank Professors John Kernochan, whose seminar originally inspired this paper, Jane Ginsburg, who provided great assistance in my education in intellectual property law, and Stephen Alton, who has offered me both a sympathetic ear and rigorous criticism. In addition, I wish to thank my wife, Dyan McClimon-Miller, who is responsible for getting this article out of my office and off to press, and my parents, Robert and Theza Miller, who made it all possible.

1. 111 U.S. 53 (1884).

in New York City.² Sarony filed suit under the copyright laws when Burrow-Giles manufactured and marketed unauthorized copies of Sarony's photograph of Oscar Wilde.³ The lower court found that Sarony was the

author, inventor, designer and proprietor of the photograph . . . , that the same is 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 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 the plaintiff, he produced the picture in suit⁴

The lower court also found that Sarony had taken all the steps necessary to secure his copyright in the photograph.⁵

Burrow-Giles' challenge to the sufficiency of the copyright notice was quickly disposed of by the Court. The object of the copyright statute is notice, which was easily satisfied by the words "Copyright, 1882, by N. Sarony," which appeared on each copy of the photograph.⁶ Burrow-Giles' second line of attack gave the Court a little more trouble. Burrow-Giles argued that a photograph was neither a writing nor the production of an author. In addressing and refuting this argument, the Supreme Court relied upon the history of copyright law in both the United States and England.

The Court first looked to the Constitution and the language of Article I, Section 8, which grants 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."⁷ The Court noted that the beneficiaries of this section are authors and inventors and that their monopolies are protected under the laws of copyright and patent, respectively.⁸ While the then-existing copyright statute explicitly granted protection to photographs,⁹ Burrow-Giles argued that Congress had exceeded its powers under Article I, Section 8 because a photograph, being noth-

2. *Id.* at 54.

3. *Id.*

4. *Id.* at 54-55.

5. *Id.* at 55.

6. *Id.*

7. U.S. CONST. art. I, § 8.

8. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 56 (1884).

9. Section 4952 of the Revised Statutes granted copyright protection to "any citizen of the United States, or resident therein, who shall be the author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print, or photograph or negative thereof." Act of July 8, 1870, ch. 230, 16 Stat. 198, 212.

ing more than a reproduction of the exact features of a person or natural object, was not a writing of which the producer is the author.¹⁰

The Supreme Court then turned to the records of the first session of Congress to determine how Congress had interpreted this Constitutional mandate. Following the formation of the Constitution, the first Congress acted immediately to set forth the terms of the exclusive rights granted in Section 8 of Article I:

[T]he author or authors of any map, chart, book or books, . . . being a citizen or resident of the United States, . . . shall have the sole right and liberty of printing, reprinting, publishing and vending the same . . . for the period of fourteen years from the recording of the title thereof in the clerk's office, as afterwards directed.¹¹

In 1802, the same exclusive right was extended to prints which were invented, designed, engraved, etched or worked.¹² In 1831, musical compositions and cuts in connection with prints and engravings were granted copyright protection, and the period of protection was doubled from fourteen to twenty-eight years.¹³ The term copyright appeared for the first time in this legislation. In 1870, photographs were also extended copyright protection.¹⁴

Based on this history of copyright legislation, the Court determined that copyright protection had been extended to a number of objects other than those which could be strictly considered "writings." The Court found that an author is "he to whom anything owes its origin" and noted that the term "writing" was not limited to actual script but included printed books, engravings and etchings as well.¹⁵ According to the Court, photography was excluded from the earliest statutes for the simple reason that it did not yet exist.¹⁶ A photograph easily fit within the expansive meaning of the term "writing" as it had been applied by Congress for more than seventy years.

The Court also addressed the argument that photography was a mechanical reproduction which was entitled to no copyright protection because it involved no novelty or originality of thought.¹⁷ While the Court refused to decide this question with regard to the ordinary production of a photograph,¹⁸ the Court held that the extensive prepa-

10. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 56 (1884).

11. Act of May 31, 1790, ch. 15, 1 Stat. 124.

12. Act of April 29, 1802, ch. 36, 2 Stat. 171.

13. Act of February 3, 1831, ch. 16, 4 Stat. 436.

14. Act of July 8, 1870, ch. 230, 16 Stat. 198, 212.

15. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 57-58 (1884).

16. *Id.*

17. *Id.* at 59.

18. The Court's framing of this issue appeared to have left photographs of natural objects, or candid photographs of people, outside of the protection afforded by the copyright laws. This issue was resolved with respect to illustrations, and by analogy to photographs, in *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 248 (1903) and *Jewelers' Circular Publishing Co. v. Keystone Publishing Co.*, 274 F. 932, 934-35 (S.D.N.Y. 1921). See *infra* notes 23-28 and the accompanying text.

ration undertaken by Sarony in producing this photograph¹⁹ made it “an original work of art, the product of the plaintiff’s intellectual invention, of which plaintiff is the author.”²⁰

In deciding this case of first impression, the Court drew on an English case, *Nottage v. Jackson*, decided the previous year.²¹ In *Nottage*, an employee of the plaintiff was directed to take a photograph of an Australian cricket team. The English court found that the copyright resided in the employee, not his employer, because he was the one who “really represents, creates, or gives effect to the idea, fancy, or imagination.”²² While the *ownership* of the copyright would be decided differently now under current conceptions of the work-for-hire doctrine, as will be seen below, the Supreme Court found in this case adequate support for the notion that photographs are entitled to copyright protection.

The work-for-hire doctrine was first noted by the Supreme Court in *Bleistein v. Donaldson Lithographing Co.*,²³ where Justice Holmes stated in *dicta* that an employer owned the copyright to illustrations created by an employee in the course of his employment.²⁴ The case held that advertisements could be copyrighted,²⁵ and in doing so established the low threshold of originality required for copyright protection: “The copy is the personal reaction of an individual upon nature. Personality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible, which is one man’s alone.”²⁶

Judge Learned Hand extended this doctrine to the question of “ordinary” photographs left unaddressed in *Sarony*:

[N]o photograph, however simple, can be unaffected by the personal influence of the author, and no two will be absolutely alike. Moreover, this all seems to me quite beside the point because under section 5(j) [of the 1909 Act] photographs are protected without regard to the degree of “personality” which enters into them. At least there has been no case since 1909 in which that has been held to be a condition. The suggestion that the Constitution might not include all photographs seems to me overstrained.²⁷

19. See *supra* note 4 and the accompanying text.

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

21. 11 Q.B. Div. 627 (1883).

22. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 61 (1884).

23. 188 U.S. 239 (1903).

24. *Id.* at 248.

25. *Id.* at 251.

26. *Id.* at 250.

27. *Jewelers’ Circular Publishing Co. v. Keystone Publishing Co.*, 274 F. 932, 934-35 (S.D.N.Y. 1921). See *Pagano v. Chas. Beseler Co.*, 234 F. 963, 964 (S.D.N.Y. 1916) (“It undoubtedly requires originality to determine just when to take the photograph, so as to bring out the proper setting for both animate and inanimate objects, with the adjunctive features of light, shade, position, etc.”) and *Time, Inc. v. Bernard Geis Assocs.*, 293 F. Supp. 130, 143 (S.D.N.Y. 1968) (the requisite creativity is found in the

Thus, by 1921, there was little doubt that most, if not all photographs were entitled to copyright protection.²⁸ The question of *ownership* of the copyright in photographs was not so clear.

III. THE 1909 ACT

Under the 1909 Act, the word "author" was deemed to include an employer in the case of works made for hire.²⁹ However, neither "employer" nor "works made for hire" were defined by the Act, leaving the contours of their definitions to judicial interpretation. Up until 1966, the courts concluded that section 26 referred only to works made by employees in the regular course of their employment. With respect to commissioned works, the courts presumed that the copyright was conveyed to the hiring party along with the work itself, unless the artist expressly retained the rights in a written contract.³⁰

In the early days of photography in the United States, photographers often took pictures gratuitously and retained the right to sell them to the public for their own benefit. In these circumstances, the photographer was entitled to the copyright.³¹ However, a person or entity which employed a photographer for pay was presumed to obtain the copyright upon possession of the photograph, subject only to the photographer's right of renewal.³² All copyright privileges could be retained by the photographer if the parties expressly agreed in writing prior to the taking of the photograph.³³

selection of "the kind of camera (movies not snapshots), the kind of film (color), the kind of lens (telephoto), the area in which the photos were taken, and (after testing several sites) the spot in which the camera would be operated." See 1 M. Nimmer & D. Nimmer, *Nimmer on Copyright*, § 2.08(E)(1) (1991).

28. The protection first granted photographers in 1870, see note 9, *supra*, was carried forward in section 5(j) of the Copyright Act of 1909 and section 101 of the Copyright Act of 1976, which includes photographs within the definition of "pictorial, graphic and sculptural works." 17 U.S.C. § 101 (1988). Photographs which qualify as "a work of visual art" are also protected by the copyright laws. 17 U.S.C.A. § 101 (West Supp. 1991). Although such photographs and the issue of moral rights are beyond the scope of this paper, it should be noted that by definition, a photograph made for hire cannot be a work of visual art.

29. 17 U.S.C. § 26 (1976 ed.), *repealed by* The Copyright Act of 1976, Pub. L. No. 94-553.

30. *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 744 (1989); *Easter Seal Soc'y for Crippled Children and Adults v. Playboy Enters.*, 815 F.2d 323, 325-26 (1987), *cert. denied*, 485 U.S. 981 (1988).

31. *Cory v. Physical Culture Hotel*, 88 F.2d 411 (2d Cir. 1937) (aerial photography); *Lumiere v. Robertson-Cole Corp.*, 280 F. 550 (2d Cir. 1922) (portrait photography); *Lumiere v. Pathe-Exchange, Inc.*, 275 F. 428 (2d Cir. 1921) (same); *Press Publishing v. Falk*, 59 F. 324 (S.D.N.Y. 1894) (same).

32. *Lumiere v. Robertson-Cole Corp.*, 280 F. 550 (2d Cir. 1922); *Lumiere v. Pathe-Exchange, Inc.*, 275 F. 428 (2d Cir. 1921).

33. See cases cited at note 31, *supra*. The two cases involving the photographer Samuel Lumiere and a somewhat unsavory character named Letendre merit extended commentary. In *Pathe-Exchange*, Letendre, purportedly acting as an agent on behalf of an actress named Casselini, urged her to have photographs taken for publicity purposes. He advised her to go to Lumiere, who arranged with Letendre to take the

The presumption that the copyright transferred to the hiring party continued throughout the first half of the century. In *Avedon v. Exstein*,³⁴ Richard Avedon photographed a subject for an advertisement which was published in the *New York Times*. After Avedon received payment for the photograph, he delivered the negative to the advertising agency, which then sold the photograph with minor alterations to another client for use in their advertising. Avedon sued, claiming he owned the negative and that he retained all rights in the photograph except for the license for one-time use by the defendant agency.³⁵ However, these terms apparently did not appear within the terms of the contract between the parties,³⁶ because Avedon claimed that they were implied in fact as the prevailing custom and usage in the context of commercial photography for advertising campaigns.

The defendants countered this argument by relying on the presumption in favor of the hiring party discussed above. The court refused to distinguish commercial from portrait photography and held that a

photographs at a reduced rate in exchange for retaining the copyright. Although the actress did not understand copyright principles, the court was satisfied that Letendre acted within his authority as her agent in bargaining the copyright back to Lumiere. Thus, while Casselini was *entitled* to the copyright, she could transfer it to the photographer. Lumiere owned the copyright, but his failure to register it properly prevented him from maintaining an action for infringement.

Lumiere fared even worse in his next appearance before the Second Circuit the following year. Letendre again played a role, only this time as the agent of Lumiere. Robertson-Cole, a movie distributor, contracted with Lumiere, through Letendre, to take promotional photographs of Georges Carpentier, the French boxing champion. Robertson-Cole paid over \$800 for the photographs. Letendre attempted to retain for Lumiere the copyright in the photographs in documents presented to the representative of Robertson-Cole at the time of the sitting. While the facts are unclear, it does not appear that Robertson-Cole ever signed this agreement. However, Carpentier eventually signed several days after the photography session, even though he spoke no English and had no knowledge of the contents or effect of the letter. Based on these facts, the court had little trouble in finding that the copyright resided with Robertson-Cole and enjoined Lumiere from distributing photographs of Carpentier.

The court's decision rested in part on the unknowing "consent" given by Carpentier, who could not speak English and who did not understand the effect of the copyright agreement that he signed. However, Casselini did not understand the nuances of copyright law either, but in her case the court allowed Lumiere to retain those rights based on the agreement negotiated by her "agent" Letendre. If Robertson-Cole had been decided first, one suspects that Lumiere would not have retained the copyright to the photographs of Casselini. The court would have examined Letendre's purported agency relationship with Casselini more closely in light of his representation of Lumiere's interests with respect to Carpentier. It is likely the court would have decided that Casselini's consent with respect to her rights was no more "knowing" than that of Carpentier who spoke no English. From this perspective, the court's decisions have a decidedly, although perhaps unintended sexist result: an innocent woman with no knowledge of copyright lost her rights due to an unscrupulous agent while the innocent male with no knowledge of copyright was granted protection from the same agent's machinations.

34. 141 F. Supp. 278 (S.D.N.Y. 1956).

35. *Id.* at 279.

36. The court never specified whether the contract alleged by Avedon was oral or written.

commercial client has an interest at least as strong as that of an individual in controlling the use of the photograph. While Avedon had the power to retain the rights in his work, the court laid the burden of proof squarely on the photographer: "If in the transfer there was any limitation for the benefit of the photographer, that limitation, restriction or reservation, whatever it may be called, must have been expressed and clearly imposed. Otherwise it will not be presumed."³⁷ As the Fifth Circuit noted in *Easter Seal*, this presumptive transfer did not comport with the 1909 Act because authors had different rights from the transferees.³⁸ Thus, even though the hiring party held the copyright, the photographer as author still retained the right to *renew* the copyright.³⁹

IV. THE 1976 COPYRIGHT ACT

As is well-documented by the Supreme Court in *Community for Creative Non-Violence v. Reid*,⁴⁰ the 1976 Copyright Act represented a compromise worked out over two decades by creators, copyright-using industries, the Copyright Office and Congress.⁴¹ Throughout that process, works by employees were viewed as separate entities from commissioned works by independent contractors. Thus, photographs created by independent contractors were not treated as works for hire done within the scope of employment. Independent photographers retained authorship and renewal rights, but if the photos were not taken gratuitously, all remaining rights were presumptively transferred to the buyer.⁴² The preliminary draft bill recommended by the Copyright Office in 1963 defined "work made for hire" as "a work prepared by an employee within the scope of the duties of his employment, but not including a work made on special order of commission."⁴³ Book publishers responded by proposing language that, for the first time, expanded the work-for-hire doctrine to cover commissioned work. When representatives of authors' interests complained that publishers would use their superior bargaining power to compel authors to write everything as works for hire, a compromise was formulated: while the bill retained the "within the scope of employ-

37. *Id.* at 280, quoting *Grant v. Kellogg*, 58 F. Supp. 48, 51 (S.D.N.Y. 1944), *aff'd*, 154 F.2d 59 (2d Cir. 1946).

38. *Easter Seal Soc'y for Crippled Children and Adults v. Playboy Enters.*, 815 F.2d 323, 325 (1987), *cert. denied*, 485 U.S. 981 (1988).

39. *Id.* See, *Yardley v. Houghton-Mifflin Co.*, 108 F.2d 28 (2d Cir. 1939), *cert. denied*, 309 U.S. 686 (1940).

40. 490 U.S. 730, 743 (1989).

41. See also, Jessica D. Litman, *Copyright, Compromise and Legislative History*, 72 CORNELL L. REV. 857, 862 (1987).

42. See *supra* notes 26-37 and the accompanying text.

43. Preliminary Draft for Revised U.S. Copyright Law and Discussions and Comments on the Draft, 88th Cong., 2d Sess., Copyright Law Revision, Part 3, p. 15, n.11 (H. Judiciary Comm. Print 1964).

ment” language, four categories of commissioned works were classified as works for hire if the parties expressly agreed in writing.⁴⁴ Ultimately nine types of work were enumerated which merited treatment as work for hire, even though not prepared by employees, because they were typically elements of a work in which the commissioning party would have directed the work with the intent of owning the copyright.⁴⁵ The bill shifted the presumption of copyright ownership from the commissioning party to the commissioned artist. Thus artists, who typically have less bargaining power than their buyers, could not lose the copyright in their original works unless they were employees or if their work fell within one of the nine categories and they agreed in writing that the work was for hire.⁴⁶

This compromise was worked out in 1965; for unrelated reasons, the legislation was not enacted until 1976. However, between 1965 and 1976, the common law of copyright blurred the distinction between employee “work for hire” and the presumptive transfer of rights to a buyer by a commissioned artist. In *Brattleboro Publishing Co. v. Winmill Publishing Corp.*,⁴⁷ the plaintiff newspaper sued a rival newsletter for using advertising copy which had been prepared by the plaintiff for merchants who later advertised in the defendant’s newsletter. That court reviewed a number of employee/employer cases and found within them the rule that an employer is the “author” “whenever an employee’s work is produced at the instance and expense of his employer.”⁴⁸ The court then extended this rule to the employer-independent contractor relationship which existed between the merchants who purchased the ads (employer) and the newspaper who created them (independent contractor). Other courts followed suit.⁴⁹

This blurred distinction took on major significance when courts attempted to sort out the new work-for-hire language in the 1976 Act. Section 201 makes the buyer the author and initial owner if the work was made for hire:

44. S. 1006, H.R. 4347, H.R. 5680, H.R. 6835, 89th Cong., 1st Sess., § 101 (1965). The four categories included works for use “as a contribution to a collective work, as a part of a motion picture, as a translation, or as supplementary work.” *Id.*

45. *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 746 (1989); *Easter Seal Soc’y for Crippled Children and Adults v. Playboy Enters.*, 815 F.2d 323, 331 (1987), *cert. denied*, 485 U.S. 981 (1988).

46. Marci A. Hamilton, Comment, *Commissioned Works As Works Made for Hire Under the 1976 Copyright Act: Misinterpretation and Injustice*, 135 U. PA. L. REV. 1281, 1308-09 (1987); Sheila Heitke, Note, *Work for Hire after CCNV v. Reid: Adequacy of Protection for Artists and the Extent of the Doctrine’s Applicability to Software Developers*, 10 N. ILL. U. L. REV. 331, 334 (1990).

47. 369 F.2d 565 (2d Cir. 1966).

48. *Id.* at 567.

49. *Picture Music, Inc. v. Bourne, Inc.*, 457 F.2d 1213 (2d Cir.), *cert. denied*, 409 U.S. 997 (1972); *Siegel v. Nat’l Periodical Publications, Inc.*, 508 F.2d 909 (2d Cir. 1974); *Murray v. Gelderman*, 566 F.2d 1307 (5th Cir. 1978) (applying the 1909 Act).

(a) Initial Ownership— Copyright in a work protected under this title vests initially in the author or authors of the work. The authors of a joint work are co-owners of copyright in the work.

(b) Works Made for Hire— In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of this title, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright.⁵⁰

Section 201 varies from the case law as it existed prior to *Brattleboro*,⁵¹ making it explicit that if the work is for hire, whether by an employee within the scope of his employment or by an independent contractor, the “employer or other person for whom the work was prepared” is the author with all of the accompanying rights. The 1976 Act abolished the presumptive transfer of rights doctrine for independent contractors which had arisen in cases decided under the 1909 Act.

Section 101 provides the definition of work for hire:

A “work made for hire” is—

(1) a work prepared by an employee within the scope of his or her employment; or

(2) a work specially ordered or commissioned for use as a contribution to a collective work, as part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire⁵²

This language of the Act reflects the legislative compromise based on the case law as it stood in 1965 — commissioned work constituted an entity separate from work for hire done by employees. But the following ten years of judicial interpretation had merged the two concepts prior to the Act’s passage. Courts attempting to interpret the new statute were pulled in one direction by the case law and in another by a statute (1) premised on an outdated interpretation of the case law, (2) which featured a lengthy and complex legislative history and (3) which did not define key terms such as “employer,” “employee” or “scope of employment.” When the circuit courts arrived at conflicting positions in their interpretations, the Supreme Court granted certiorari to determine the proper interpretation of the work-for-hire provision of the 1976 Act.⁵³

50. 17 U.S.C. § 201 (1988).

51. *Brattleboro Publishing Co. v. Winmill Publishing Corp.*, 369 F.2d 565 (2d Cir. 1966).

52. 17 U.S.C. § 101(1)(2) (1988).

53. *Easter Seal Soc’y for Crippled Children and Adults v. Playboy Enters.*, 815 F.2d 323, 325 (5th Cir. 1987); *Brunswick Beacon, Inc. v. Schock-Hopchas Publishing Co.*, 810 F.2d 410 (4th Cir. 1987); *Evans Newton, Inc. v. Chicago Systems Software*,

V. COMMUNITY FOR CREATIVE NON-VIOLENCE v. REID

In *Community for Creative Non-Violence v. Reid*,⁵⁴ the defendant (“CCNV”) commissioned James Reid to create a sculpture of a nativity scene in which the Holy Family was depicted by contemporary homeless people huddled on a steam grate.⁵⁵ The commission covered the costs of the materials, and Reid donated his services.⁵⁶ Reid worked on the sculpture in his Baltimore studio with assistance from various CCNV staffers.⁵⁷ There was no written agreement between the parties, and the issue of copyright was never discussed.⁵⁸ After the sculpture was displayed, it was returned to Reid for minor repairs.⁵⁹ When CCNV then decided to use the sculpture on a fundraising trip, Reid refused to return it and filed a copyright registration in his own name.⁶⁰ CCNV filed a competing certificate and then sued Reid.⁶¹

The district court held for CCNV, deeming Reid to be an employee within the meaning of section 101(1) because CCNV “directed enough of [Reid’s] effort to assure that, in the end, he had produced what they, not he, wanted.”⁶² The Court of Appeals reversed and remanded, holding that Reid owned the copyright because the sculpture was not a work for hire.⁶³ The court adopted the “literal” interpretation of section 101 as articulated by the Fifth Circuit in the *Easter Seal* case,⁶⁴ and read section 101 as creating a “simple dichotomy” between employees and independent contractors.⁶⁵ Because Reid was an independent contractor as defined by agency law, he could not have been an employee under 101(1) when he made the sculpture.⁶⁶ The sculpture also failed to fall within one of the nine categories enumer-

793 F.2d 889 (7th Cir.), *cert. denied*, 479 U.S. 949 (1986); *Aldon Accessories Ltd. v. Spiegel, Inc.*, 738 F.2d 548 (2d Cir.), *cert. denied*, 469 U.S. 982 (1984); *Dumas v. Gormerman*, 865 F.2d 1093 (9th Cir. 1989); *Community for Creative Non-Violence v. Reid*, 846 F.2d 1485 (D.C. Cir. 1988), *aff’d*, 490 U.S. 730 (1989).

54. 490 U.S. 730 (1989).

55. *Id.* at 733.

56. *Id.* at 734.

57. *Id.*

58. *Id.*

59. *Id.* at 735.

60. *Id.*

61. *Id.*

62. *Community for Creative Non-Violence v. Reid*, 652 F. Supp. 1453, 1456 (D.D.C. 1987), *rev’d*, 846 F.2d 1485 (D.C. Cir. 1988).

63. *Community for Creative Non-Violence v. Reid*, 846 F.2d 1485, 1494 (D.C. Cir. 1988).

64. *Easter Seal Soc’y for Crippled Children and Adults v. Playboy Enters.*, 815 F.2d 323 (5th Cir. 1987), *cert. denied*, 485 U.S. 981 (1988).

65. *Community for Creative Non-Violence v. Reid*, 846 F.2d 1485, 1492 (D.C. Cir. 1988), *aff’d*, 490 U.S. 730 (1990).

66. *Id.* at 1494.

ated in section 101(2) and the parties had not agreed in writing that the sculpture would be a work for hire.⁶⁷

A unanimous Supreme Court affirmed and adopted the “literal” interpretation followed by the Court of Appeals below and the Fifth Circuit. A work can qualify for work-for-hire status in two ways: (1) if it is prepared by an employee within the scope of employment, as determined by the general law of agency and (2) if the work is specially ordered or commissioned, falls within one of the nine listed categories, and the parties agree in writing that it constitutes a work for hire. Because the sculpture did not fall within the nine listed categories, the Court only had to deal with defining the employment relationship under section 101(1). The Court set forth a “nonexhaustive” list of factors derived from case law and section 220 of the Restatement of Agency, including the right to control the manner and means by which the product is accomplished; the source of the instrumentalities and tools; the location of the work; the duration of the relationship between the parties; whether the hiring party has the right to assign additional projects; the extent of the regulation of the commissioned party’s work hours; the method of payment; the hiring and payment of assistants; whether the work is part of the regular business of the hiring party; whether the hiring party is in business; the provision of employee benefits; and the tax treatment of the hired party.⁶⁸

Based on these factors, the court determined that Reid was an independent contractor. Even though CCNV members directed enough of Reid’s work to ensure that he produced a sculpture that met their specifications, every other factor indicated that he was an independent contractor rather than an employee.⁶⁹

This decision is generally a positive one for artists. Although the Court did not follow the “formal employee” test adopted by *Dumas v. Gommerman*,⁷⁰ the Court refused to adopt “conservative” interpretations of section 101 relied upon by other courts. One line of cases held that a work is prepared by an employee whenever the hiring party retains the right to control the product.⁷¹ Another closely related formulation held that work is created by an employee whenever the hiring party has actually wielded control with respect to a particu-

67. *Id.*

68. *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 751-52 (1989).

69. *Id.* at 752-53.

70. 865 F.2d 1093, 1102 (9th Cir. 1989). This test was favored by Reid and various *amicus* briefs representing creative interests. *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 739, 742 n.8 (1989). In its application, the “formal employee” test is little different from the “literal” interpretation, insofar as they both rely on common law agency principles in determining employment status. *Id.* at 742 n.8.

71. *Peregrine v. Lauren Corp.*, 601 F. Supp. 828, 829 (D. Colo. 1985); *Clarkstown v. Reeder*, 566 F. Supp. 137, 142 (S.D.N.Y. 1983).

lar work.⁷² These are denominated the conservative tests because they essentially maintained the case law interpretations which evolved under the 1909 Act.

The Court refused to follow these interpretations of the work-for-hire doctrine because they ignored the changes created by the 1976 Act. The Act draws a careful distinction between works created by employees and works commissioned from independent contractors. To rely strictly on a “right to control” or “actual control” test would transform into a work for hire almost any specially ordered or commissioned work, because the commissioning party will generally exercise control over the production of the work.⁷³ Such a construction renders superfluous the nine enumerated categories and the requirement of a writing in 101(2).⁷⁴

Had the Court adopted either of the “conservative” tests, Reid would have lost the copyright to CCNV. The Court conceded that “CCNV members directed enough of Reid’s work to ensure that he produced a sculpture that met their specifications.”⁷⁵ Although this fact standing alone showed both CCNV’s “right to control” and their “actual control,” all the other factors indicated that Reid acted as an independent contractor, and Reid retained the copyright. Thus the Court’s decision will benefit many artists who create work on a commissioned basis. The ownership of the copyright in the work will depend on the artists’ employment status or an agreement negotiated by the parties, rather than solely on the control exercised by the buyer.

VI. THE IMPACT OF CCNV ON PHOTOGRAPHY

One of the cases cited by CCNV as representing the “right to control” test involved a photographer. In *Peregrine v. Lauren Corp.*,⁷⁶ plaintiff, a professional photographer, created several pictures for an advertising brochure for defendant Lauren Corporation. When a dispute arose over the bill, Peregrine filed a copyright registration for the photographs and sued Lauren. The court cited the definition of work for hire in section 101(1) but never discussed the nine categories in 101(2) and the dichotomy between independent contractors and employees. The court relied primarily on cases decided under the 1909 Act and “the longstanding presumption that the mutual intent of parties to the creation of an artistic work . . . was to vest title to the copyright in the person at whose insistence and expense the work was

72. *Brunswick Beacon, Inc. v. Schock-Hopchas Publishing Co.*, 810 F.2d 410 (4th Cir. 1987); *Evans Newton, Inc. v. Chicago Systems Software*, 793 F.2d 889 (7th Cir.), *cert. denied*, 479 U.S. 949 (1986); *Aldon Accessories Ltd. v. Spiegel, Inc.*, 738 F.2d 548 (2d Cir.) *cert. denied*, 469 U.S. 982 (1984).

73. *Community for Creative Non-Violence*, 490 U.S. at 741-742.

74. *Id.*

75. *Id.* at 752.

76. 601 F. Supp. 828 (D. Colo. 1985).

done.”⁷⁷ Not surprisingly, the court found that the defendant commissioned the plaintiff’s services so as to create a work made for hire.⁷⁸

Applying the *CCNV* analysis probably would have led to a contrary result, although the development of the facts is so slim that it is difficult to reach a definitive conclusion. According to *CCNV*, the first question to resolve is whether Peregrine was an employee according to the general law of agency. That determination is made in reference to the list of factors set forth above.⁷⁹ If Peregrine was deemed an employee under section 101(1), then Lauren would be considered the author and owner of the photographs. But if Peregrine was found to be an independent contractor, which is quite likely, given the fact that he was described as a professional photographer who was to be paid in a manner indicating independent contractor status,⁸⁰ then the Court would need to consider the effect of 101(2). Only if the photographs fell within one of the nine enumerated categories and the parties had agreed in a signed written instrument that the work would be considered a work for hire would the defendant be deemed the author under section 201(b). Because Peregrine filed a copyright registration, presumably no such written agreement existed, and Peregrine would retain the copyright.

In a more recent case, *Marco v. Accent Publishing*,⁸¹ decided after *CCNV*, the Federal District Court for the Eastern District of Pennsylvania found that a freelance photographer retained on a part time basis by a magazine publisher was an employee of the publisher for purposes of copyright law. The Third Circuit reversed, holding that the photographer was an independent contractor and retained the copyright in the photographs.⁸² Examination of the two opinions illustrates some of the issues and biases peculiar to copyright protection for photography, and the impact of the analytical framework set forth in *CCNV*.

Marco was a professional photographer of ten years experience who owned his own studio. After showing Accent Publishing his portfolio,

77. *Id.* at 829.

78. *Id.* As a result, Lauren owned all the rights in the photographs as author and Peregrine had not been paid one nickel. Moreover, the court refused to hear Peregrine’s claim in *quantum meruit* due to lack of federal jurisdiction. Peregrine faced the expense of a second lawsuit just to collect his professional fee. The Register of Copyrights was aware of unfair decisions such as this one. “Artists and photographers are among the most vulnerable and poorly protected of all the beneficiaries of the copyright law . . .” See *infra* notes 84-85 and the accompanying text.

79. See *supra*, text accompanying note 68. This procedure was followed in another case involving a photographer, *Morita v. Omni Publications, Int’l*, 741 F. Supp. 1107 (S.D.N.Y. 1990). The court initially denied motions for summary judgment because of material questions of fact over the employment status of the photographer. The parties ultimately settled their claims, as reported at 760 F. Supp. 45 (S.D.N.Y. 1991).

80. *Peregrine v. Lauren Corp.*, 601 F. Supp. 828 (D. Colo. 1985).

81. No. CIV.A.91-2057, 1991 WL 212187 (E.D.Pa. Oct. 15, 1991).

82. *Marco v. Accent Publishing*, 969 F.2d 1547 (3rd Cir. 1992).

Marco entered into an oral contract with Accent to photograph jewelry for several issues of Accent Magazine. Pursuant to this contract, Marco was hired as a “staff photographer.”⁸³ Accent supplied the jewelry, sketched out the shots and retained the right to final approval over the photographs.⁸⁴ Accent’s art director, as found by the trial court, “directed, supervised and provided artistic contribution to the photographic work.”⁸⁵

Marco placed a copyright notice on the invoices for his photographs, which read as follows: “All photographs copyright Ed Marco. Photographer reserves all rights. All photographs for one time publication only and are not to be otherwise reproduced in anyway [sic] shape or form. Full amount of billing must be paid before any publication of photographs.”⁸⁶ When representatives for Accent saw the notice, they called Marco and indicated that the copyright restrictions were not acceptable. After negotiations, Marco agreed to allow Accent to reproduce the photographs with Marco’s consent.⁸⁷ However, a dispute later arose concerning the reuse of the photographs, and Marco wrote Accent claiming that Accent had violated the Copyright Act. Both Marco and Accent filed applications for copyright protection in the photographs.⁸⁸

In its discussion of the copyright issue, the trial court turned first to *CCNV*. The court repeated the list of factors outlined in *CCNV* and cited two quotations in support of the proposition that actual control or the right to control do not transform an independent contractor into an employee.⁸⁹ However, having correctly established this analytical framework, the trial court then veered off course:

These factors strongly favor finding a master-servant relationship in the present case. While it is true that Accent withheld no taxes from the plaintiff, and that Marco owned his photography equipment, every other factor listed in the Restatement criteria favors the

83. No. CIV.A.91-2057, 1991 WL 212187 (E.D.Pa. Oct. 15, 1991) at 2, Finding #10, *id.* at 10, Conclusion of Law 15 (“Marco was not a [sic] independent contractor, but was hired as the staff photographer for the magazine.”) Although the term “staff photographer” was never clearly defined, the district court seems to have used it as a synonym for the term “employee.” 969 F.2d at 1548, n.1.

84. No. CIV.A.91-2057, 1991 WL 212187 (E.D.Pa. Oct. 15, 1991) at 2.

85. *Id.*, Finding #18.

86. *Id.*, Finding #27.

87. *Id.* at 3, Findings 31-33.

88. *Id.* at 3-4, Findings 36-39.

89. *Id.* at 5 (“Transforming a commissioned work into a work by an employee on the basis of the hiring party’s right to control or actual control of the work is inconsistent with the language, structure, and legislative history of the work for hire provisions.”) (citing *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 750 (1989)); *id.* at 6 (“ ‘Actual control’ or the ‘right to control’ are relevant, but alone they cannot make and [sic] other wise independent contractor into an employee.”) (quoting *Easter Seal Soc. for Crippled Children and Adults, Inc. v. Playboy Enterprises*, 815 F.2d 323, 334-35 (5th Cir. 1987)).

master-servant relationship. *The control exercised by the hirer over the hired party is an important consideration.*⁹⁰

The duty of the trial court was to examine all of the evidence in light of each of the factors it had cited. But instead of making a separate finding with respect to each factor, the court abruptly concluded that every factor but two favored the master-servant relationship. The trial court then distinguished *CCNV*, noting that the sculptor Reid was skilled, his employment was of short duration, and that he was retained to work on only a single creation. In contrast to Reid, Marco was found not to be a skilled worker, and the term of his employment was open-ended, covering several months and numerous photographs.⁹¹ The court then compounded its error by placing an inordinate emphasis on the control factor, notwithstanding its purported reliance on the language in *CCNV* that control does not transform commissioned work into work of an employee.⁹² Paragraph 14 of the Conclusions of Law reverts to the control test explicitly rejected by the Supreme Court in *CCNV*:

14. The important distinction between an independent contractor and a servant is that the servant provides service in which his physical activities and his time are surrendered to the control of the master; the independent contractor provides service under an agreement to accomplish results or to use care and skill in accomplishing results. Thus, those rendering service but retaining control over the manner of doing it are not servants. Restatement (Second) of Agency § 220, Comment e., 487-488.⁹³

The trial court placed itself in this contradictory position as a result of sloppy research. The “nonexhaustive list” of factors compiled by the Supreme Court in *CCNV* was based in part on Restatement of Agency 2d § 220 and in part on case law.⁹⁴ Subsection 1 of section 220 defines a servant as follows: “A servant is a person employed to perform services in the affairs of another and who with respect to the physical conduct in the performance of the services is subject to the other’s control or right to control.” Comments (a) through (g) apply

90. No. CIV.A.91-2057, 1991 WL 212187 (E.D.Pa. Oct. 15, 1991) at 6. (Emphasis supplied).

91. *Id.*

92. The trial court addressed the various factors in one paragraph, beginning with the sentence, “In the present case, Accord exercised control over Marco.” *Id.* at 7. The paragraph briefly touches on factors from the *CCNV* list that favor Accent — control, assigning additional work, the imposition of deadlines, reimbursement for expenses, and Accent’s status as a regular business. However, the opinion ignores other factors from the same list that favored Marco, including the location of the work in Marco’s own studio, payment by the job rather than wages or salary, and Accent’s failure to provide any employee benefits. 969 F.2d 1547, 1550. *See infra* note 97, and accompanying text. The underlying theme in this paragraph is Accent’s control, rather than an independent evaluation of each factor.

93. No. CIV.A.91-2057, 91 WL 212187 at 10.

94. 490 U.S. 730, 751-52.

to subsection 1. Subsection (2)⁹⁵ lists ten factors to be used in “determining whether one acting for another is a servant or an independent contractor.” Comments (h) through (m) supplement that list of factors.

The district court quoted directly from Comment (e) to support its conclusion that Marco did not retain control over the work, and therefore was a servant and not an independent contractor. However, Comment (e) merely restates the black letter law that a servant is subject to another’s control. Like subsection (1), Comment (e) says nothing about how to *measure* whether a person is either an independent contractor or a servant. That determination is reserved for subsection (2), which makes clear that the “extent of control” is but one of many factors which enters into the ultimate determination of whether a person is a servant or an independent contractor.

On appeal, the Third Circuit reversed the trial court.⁹⁶ Where the lower court found that only two factors favored independent contractor status — Marco used his own equipment and paid his own taxes — the Third Circuit found that four other factors ignored by the district court also weighed in favor of Marco. Marco supplied his own studio, received no employee benefits, was paid by the job, and worked in a distinct occupation as a professional photographer.⁹⁷

In addition to these six factors, the Third Circuit identified four additional grounds favoring Marco which the district court had erroneously considered to favor Accent. First, the district court held that

95. (2) In determining whether one acting for another is a servant or an independent contractor, the following matters of fact, among others, are considered:

(a) the extent of control which, by the agreement, the master may exercise over the details of the work;

(b) whether or not the one employed is engaged in a distinct occupation or business;

(c) the kind of occupation, with reference to whether, in the locality, the work is usually done under the direction of the employer or by a specialist without supervision;

(d) the skill required in the particular occupation;

(e) whether the employer or the workman supplies the instrumentalities, tools and the place of work for the person doing the work;

(f) the lengths of time for which the person is employed;

(g) the method of payment, whether by the time or by the job;

(h) whether or not the work is a part of the regular business of the employer;

(i) whether or not the parties believe they are creating the relation of master and servant;

(j) whether or not the principal is or is not in business.

In *CCNV*, the Supreme Court lists thirteen factors — seven of the ten factors listed in section 220(2) — and six other factors culled from the case law. The Court emphasized that its list is nonexhaustive. 490 U.S. 730, 752 (1989).

96. *Marco v. Accent Publishing*, 969 F.2d 1547 (3rd Cir. 1992).

97. *Id.* at 1550. The first three of these factors appeared in the list relied upon by the district court. The “distinct occupation” factor, which appears in section 220(2)(b) of the Restatement, was not cited by the Supreme Court in its “nonexhaustive” list in *CCNV*, and was not considered by the trial court.

Accent's power to impose deadlines on the completion of Marco's work outweighed Marco's discretion over his work hours. The Third Circuit disagreed, noting that while a strict deadline for completion also existed in *CCNV*, the sculptor in that case was still found to be an independent contractor. The imposition of a deadline specifying a completion date does not alter an independent contractor's discretion to choose at what time during the day or night she works in her studio.⁹⁸ Second, the trial court found in Accent's right to final approval a right to assign more work to Marco. The Third Circuit also reversed this finding. While Accent could require Marco to reshoot unsatisfactory photographs, Accent could not assign more work to Marco without Marco's consent. Marco had agreed to be paid at the rate of \$150 per photo used in advertisements, and \$450 for all photographs used in articles. In the words of the Third Circuit, Accent could order Marco to produce a satisfactory photograph for its magazine — it could not require Marco to photograph Accent's employee of the month.⁹⁹

Third, the trial court held that Marco was an employee because his craft did not rise to the level of skill required of an independent contractor. "Marco was not a skilled worker. The position of staff photographer did not have an educational requirement or [require] more than a minimal knowledge of photography."¹⁰⁰ The Circuit Court disagreed again, finding that the trial court's low estimation of Marco's abilities was contradicted by the evidence. Far from being unskilled, Marco had a Bachelor of Fine Arts in Photography and ten years of professional experience. Moreover, Accent retained Marco based on his experience and skill, contracting with him only after viewing his portfolio. Accent's art director also attested to Marco's professional expertise. "[Marco is] the person that makes the shot work technically That's why I hire a professional photographer, I'm not a professional photographer, I'm an art director."¹⁰¹ Contrary to the opinion of the trial court, Accent sought out and retained a person with more than a "minimal knowledge of photography."

Finally, the district court considered the six month long relationship of the parties as indicative of Marco's status as an employee. However, the Third Circuit disagreed, noting that the duration of a relationship indicates employee status only when the work is scheduled and periodic, or is full-time. Here, Marco worked on his own schedule and on a part time basis, providing "weak evidence, if any, of an employment relationship."¹⁰²

98. *Id.* at 1550-51.

99. *Id.* at 1551.

100. *Id.* at 1550.

101. *Id.* at 1551.

102. *Id.*

The Third Circuit identified only three factors which favored an employment relationship: (1) Accent is in business, which increases the possibility that it would employ people; (2) Accent regularly publishes photographs of its own conception, making it likely that Accent would engage an artist as an employee; and (3) Accent exercised control over the details of the work, supplying jewelry, props, models, sketches and at some sessions, an Art Director. However, the Third Circuit questioned the amount of control exercised by Accent over Marco's work. Marco controlled the majority of the work, including "light sources, filters, lenses, camera, film, perspective aperture setting, shutter speed, and processing techniques." Any supervision by the Art Director was limited to "subject matter, composition and 'mood.'"¹⁰³

The Third Circuit's reversal of the district court in *Marco* correctly interprets *CCNV*. The court carefully examined the factors concerning the relationship between Marco and Accent and found that the indicators for an employer-employee relationship were very weak. Although Accent did exercise some control over Marco's work, the trial court had placed a disproportionate amount of emphasis on that factor.¹⁰⁴

Although the Third Circuit ostensibly counted the control factor in favor of Accent, the court also emphasized the amount of control exercised by Marco. According to the Third Circuit, Accent controlled three elements: subject matter, composition and mood. On the other hand, Marco controlled nine elements, including light, filters, lenses, cameras, film, perspective, aperture setting, shutter speed and processing. The unspoken implication is that Marco's control equalled or exceeded that of Accent. This quantification of control strays down a dangerous path. Such lists are susceptible to manipulation and arguments over tallying — one can combine the elements of filters, lenses and cameras into the broad category of equipment while breaking down subject matter to include jewelry, props and models. The more important point here, as noted by the court, is that control is just one in a lengthy list of factors which the trier of fact must consider, and is not independently dispositive. That point is highlighted by the Third Circuit's comparison of Accent's control with the control exercised by *CCNV*.

Accent's control of the product was thus no greater than the control exercised by the charity in *CCNV*, who articulated the subject and composition, who supplied models, who occasionally supervised

103. *Id.* at 1552. The court also identified three additional factors which were indeterminate in assessing Marco's status. No evidence was offered concerning industry custom, or the parties' understanding of the contractual relationship. The Third Circuit, unlike the trial court, refused to include models and stylists as assistants.

104. *Id.* at 1551.

the work, who constructed part of the sculpture and who was *still* not an employer.¹⁰⁵

The Third Circuit's painstaking analysis of all of the factors, and the conclusion that they overwhelmingly favor Marco's status as an independent contractor, makes the decision of the district court difficult to rationalize. However, a closer look at some of the trial court's findings reveals some basic misunderstandings of copyright law, and help explain the initial decision.

First, the trial court made two especially notable findings of fact:

40. While Marco was taking photographs for and delivering photographs to Accent, he never requested the return of any of the photographs he took, and never stated, either orally or in writing, that these photographs had to be returned.

41. None of Marco's invoices contained any statement stating that the photographs remained the property of plaintiff or had to be returned to the plaintiff.¹⁰⁶

These two findings betray a very confused notion of what constitutes copyright protection. Findings 40 and 41 emphasize possession, not ownership, i.e. "Marco never requested the return of the photographs." Copyright protection extends to ownership of an image, and all of the rights to reproduce that image, even when a reproduction of the image is in the possession of another.

Section 202 of the copyright laws provides:

Ownership of a copyright, or of any of the exclusive rights under a copyright, is distinct from ownership of any material object in which the work is embodied. Transfer of ownership of any material object, including the copy or phonorecord in which the work is first fixed, does not of itself convey any rights in the copyrighted work embodied in the object; nor, in the absence of an agreement, does transfer of ownership of a copyright or of any exclusive rights under a copyright convey property rights in any material object.¹⁰⁷

The fact that the photographs ("material objects") were possessed ("owned") by Accent did not convey any rights to Accent. Moreover, the district court erred in Finding 41 when it stated that Marco's invoices did not state that the photographs remained the property of Marco. Although the copyright notice did not specifically state that the photographs were the property of Marco, the sentence, "photographer reserves all rights," which Marco placed on every invoice, carries that precise meaning. Reservation of all rights obviously includes the right to ownership and copyright protection, even if the photographs were in the possession of Accent.

105. *Id.* at 1552.

106. *Marco v. Accent Publishing*, No. CIV.A.91-2057, 1991 WL 212187 (E.D.Pa. Oct. 15, 1991) at 4.

107. 17 U.S.C. § 202 (1988).

The lower court's interpretation of copyright law seems to be more in tune with the 1909 statute than with the revisions made in 1976. By emphasizing that Marco failed to request the return of the photographs or that they remained his property, the trial court presumed that ownership rights resided in Accent, the hiring party. While that was true according to the cases decided under the 1909 Act, the 1976 enactment shifted the presumption of ownership to the commissioned party.¹⁰⁸

Second, the lower court found that Marco was not skilled, notwithstanding the record evidence that Marco (1) had earned a Bachelor of Fine Arts degree in photography; (2) had ten years of experience as a professional photographer; and (3) owned his own studio.¹⁰⁹ The trial court, in finding that "the position of staff photographer did not have an educational requirement or [require] more than a minimal knowledge of photography,"¹¹⁰ also ignored the testimony of Accent's own art director, who said, "[Marco is] the person that makes the shot work technically That's why I hire a photographer, I'm not a professional photographer, I'm an art director."¹¹¹ Finally, as pointed out by the Third Circuit, Accent did not hire Marco off the street, but retained him only after reviewing his portfolio. While he may not possess the skills of the noted nature photographer Ansel Adams, "Marco is certainly skilled in the sense that Reid, the sculptor in the *CCNV* case, was skilled."¹¹² The trial court's attitude is reminiscent of the argument that photographs do not reflect the creativity required for copyright protection. This argument was first rejected in *Burrow-Giles* in 1884,¹¹³ and has made no headway in the intervening 110 years.¹¹⁴

Perhaps the trial court's denigration of Marco's obvious skills constitutes nothing more than an attempt to shore up the questionable conclusion that Marco was an employee of Accent. However, the trial court's opinion betrays a more fundamental lack of understanding of copyright principles. In its analysis, the trial court emphasized that Accent commissioned, supervised, paid for and possessed reproductions of the images created by Marco, but never addressed the underlying rationale of copyright protection or why copyright distinguishes between commissioned works and works made for hire. The opinion ignores completely the legislative history recounted in detail in

108. See *supra* notes 40-46 and accompanying text.

109. 969 F.2d 1547 at 1551.

110. No. CIV.A.91-2057, 1991 WL 212187 (E.D.Pa. Oct. 15, 1991) at 6.

111. 969 F.2d at 1551.

112. *Id.* *Jeweler's Circular Publishing Co. v. Keystone Publishing Co.*, 274 F. 932, 934-35 (S.D.N.Y. 1921)("[N]o photograph, however simple can be unaffected by the personal influence of the author, and no two will be absolutely alike.") See *supra* note 27 and accompanying text.

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

114. See *supra*, notes 17-27 and accompanying text.

CCNV, which emphasized that “artists and photographers are among the most vulnerable and poorly protected of all the beneficiaries of the copyright law . . . and they were not intended to be treated as employees.”¹¹⁵ It seems that the trial court could not grasp the counterintuitive notion that Marco retained ownership rights in photographs commissioned, supervised, paid for and possessed by Accent. When the court failed to recognize, either unintentionally or by design, that Marco had a legitimate interest in ownership rights, the conclusion that Accent was entitled to the copyright on the photographs followed quite naturally.

In applying the *CCNV* analysis, the first question to resolve is whether the hired party is an independent contractor. However, a finding that the hired party is an independent contractor does not necessarily end the inquiry. Under the work-for-hire definition of section 101(2), if a photograph falls within one of the nine enumerated categories¹¹⁶ and the parties had agreed in a signed written instrument that the work would be considered a work for hire, then the hiring party could be deemed the author pursuant to section 201(b). If Marco had wished to transfer his rights to Accent and had executed a written contract, could Accent be considered the author? The answer would depend on whether Marco’s photographs fell within one of the nine enumerated categories. Advertisements can be copyrighted,¹¹⁷ and for the purpose of copyright registration, fall within class VA if they are primarily pictorial and class TX if they consist mainly of text.¹¹⁸ A print advertisement containing a photograph and advertising copy arguably fits the broad definition of a compilation, which is “a work formed by the collection and assembly of pre-existing materials or of data that are selected, coordinated or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.”¹¹⁹ Thus, if an advertisement includes a photograph commissioned from an independent contractor, the advertisement and photograph might fall within the work-for-hire definition of section 101(2) as a compilation.

Similarly, the advertisement could be considered a “supplementary work,” which is defined as:

a work prepared for publication as a secondary adjunct to a work by another author for the purpose of introducing, concluding, illustrat-

115. 490 U.S. 730, 747 n.13 (citing Second Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law: 1975 Revision Bill, Chapter XI, pp. 12-13).

116. 17 U.S.C. § 101(2) (1993).

117. *Raffoler, Ltd. v. Peabody & Wright, Ltd.*, 671 F. Supp. 947, 950 (E.D.N.Y. 1987); *Fabrica, Inc. v. El Dorado Corp.*, 697 F.2d 890, 894 (9th Cir. 1983); *Brattleboro Publishing Co. v. Winmill Publishing Corp.*, 319 F.2d 565 (2d Cir. 1966); *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 248 (1903).

118. 37 C.F.R. § 202.3(b) (1991).

119. 17 U.S.C. § 101 (1988).

ing, explaining, revising, commenting upon, or assisting in the use of the other work, such as forewords, afterwords, pictorial illustrations, maps, charts, tables, editorial notes, musical arrangements, answer material for tests, bibliographies, appendixes, and indexes.¹²⁰

Although photographs are not specifically mentioned in the definition of “supplementary work,” a photograph accompanying advertising copy illustrates and assists in the use of the copy, like a pictorial illustration, and could be considered a supplementary work. These are the only two categories which might include Marco’s photographs for Accent.¹²¹

On the other hand, even if Marco had transferred his rights in a signed writing, he might still be able to argue that photographs are excluded by definition from the definition of work made for hire appearing in section 101. The Senate version of the 1976 bill included within its categories of work for hire “a photographic or other portrait of one or more persons.”¹²² This effort failed when the Register of Copyrights objected:

The addition of portraits to the list of commissioned works that can be made into “works made for hire” by agreement of the parties is difficult to justify. Artists and photographers are among the most vulnerable and poorly protected of all the beneficiaries of the copyright law, and it seems clear that, like serious composers and choreographers, they were not intended to be treated as “employees” under the carefully negotiated definition in section 101.¹²³

One can argue from this omission and the comments of the Copyright Office that Congress intended that no photographs could be made into works for hire by agreement of the parties. The failure to include any specific mention of photographs within the nine categories recognizes the vulnerable status of photographers *vis a vis* advertising agencies and their clients.

120. 17 U.S.C. § 101(2) (1993).

121. This is not to say that photographs commissioned in other contexts could not fit into these other categories. A photograph submitted as a part of a collective work, defined as a “periodical issue, anthology, or encyclopedia, in which a number of contributions constituting separate and independent works in themselves, are assembled into a collective whole,” would be a work made for hire. 17 U.S.C. § 101(2) (1993).

122. S. REP. NO. 94-473 94th Cong., 1st Sess. 6 (1975). Similar language was also proposed for inclusion in the 1909 Act, defining an author as including “any person who employs a photographer to make a photographic portrait.” *Id.* See Borge Varmer, *Works Made for Hire and on Commission*, in Studies Prepared for the Subcommittee On Patents, Trademarks, and Copyrights of the Senate Committee on the Judiciary, Study No. 13, 86th Cong. 2d Sess., 128 (Comm. Print 1961). The provision was never adopted and no legislative history explains its demise. *Id.* at 128. In the absence of any statutory guidance, case law evolved in which the photographer remained the author but presumptively transferred all rights other than the right of renewal to the commissioning party.

123. Second Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law: 1975 Revision Bill, Chapter XI, pp. 12-13; see, *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 747 n.13 (1989).

Conversely, one might argue that the omitted provision applied only to portraits, photographic or otherwise, and did not apply to commercial photographs for advertising layouts. Moreover, even if the omitted language is read expansively to cover commercial photography, it is superfluous because a photograph made part of an advertisement is already covered by the work-for-hire definition as a contribution to a compilation, or as a supplemental work. In any event, even if photographs are not subject to work-for-hire status, the copyright in them can be transferred to the commissioning party.¹²⁴

Can a portrait ordered or commissioned from an independent contractor which is neither a compilation nor a supplementary work be construed as a work for hire? The language of the statute appears to answer this question in the negative. A portrait would not fall within any of the other categories, and the work-for-hire classification is limited by definition in section 101 to these categories and work done by an employee within the scope of employment.¹²⁵ The *Easter Seal* court explained the nine categories of section 101(2) in the following terms: “[T]hey are statutory permission to allow certain kinds of independent contractors to sign away their authorship to their buyers.”¹²⁶ Consequently, even if a photographer wanted to sign a work-for-hire contract for portrait work, where, for example, a customer insisted on retaining the negatives, the photographer could not do so consistently with the copyright law. Whether a court would actually void that contractual provision is an open question.¹²⁷ Portrait photographers can avoid this dilemma by assigning all of the rights to the customer while retaining authorship and the author’s right to terminate the transfer pursuant to section 203.

VII. STATE LAW

A. *New York*

New York’s response to a photographer’s rights in copyright is quite instructive in light of *Marco*. A bill introduced on March 5, 1991 provided:

124. 17 U.S.C. § 201 (1988). Because the transfer can be terminated under the conditions set forth in 17 U.S.C. § 203 (1988), a transfer of rights under this section conveys rights narrower than if one authored the work.

125. See, H.R. Rep. No. 1476, 94th Cong., 2d Sess. 121, reprinted in 1976 U.S. Code Cong. & Ad. News 5659, 5737 (“The definition now provided by the bill represents a compromise which, in effect, spells out *those specific categories of commissioned works that can be considered “works made for hire” under certain circumstances.*”) (Emphasis supplied).

126. *Easter Seal Soc’y for Crippled Children and Adults of La., Inc. v. Playboy Enters.*, 815 F.2d 323, 335 (5th Cir. 1987), *cert. denied*, 485 U.S. 981 (1988).

127. Applying the work-for-hire rule to a contract which falls outside of the nine enumerated categories is arguably pre-empted by 17 U.S.C. § 301 (1988). See *infra* notes 90-93 and the accompanying text.

Contracts for Photographic Services. Every contract for the services of a photographer shall require that upon full payment of the charges for the photographer's services, all negatives of photographs produced as a result of such contract shall be the property of the person contracting with such photographer. Furthermore, a photographer shall not, under any circumstances, release any negative or photograph, produced pursuant to such contract, to any person other than the person contracting for the photographic services without the written consent of the person contracting for such services.¹²⁸

That photographers own the rights in their photographs and negatives was made clear in the *Sarony* case decided over 100 years ago.¹²⁹ If this legislation had ever been enacted law in New York, it probably would have been pre-empted by the 1976 Act. Section 301 of the Act provides, in pertinent part:

On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright . . . are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.¹³⁰

Although this bill failed,¹³¹ it is interesting nevertheless because Congress considered such legislation in connection with the 1909 and the 1976 Acts and omitted it on both occasions. The long-simmering dispute over portrait photography may be attributable to the fact that the average person cannot understand why he does not own the negatives and prints when he enters into a contract with a photographer.¹³² This lack of understanding appears to be the root cause of the proposed legislation. According to an article in a trade newspaper,¹³³ the bill apparently grew out of a dispute involving a relative of New York Assemblyman Robert D'Andrea. She tried to order reprints of her portfolio but felt the price was too high. When she asked for the

128. S. 3702, A. 6292, 1991-1992 Regular Session, New York.

129. See *supra* notes 1-22 and accompanying text.

130. 17 U.S.C. § 301 (1988). The legislative history leaves no doubt as to the purpose of this section. "The intention of section 301 is to pre-empt and abolish any rights under the common law or statutes of a State that are equivalent to copyright and that extend to works coming within the scope of Federal copyright law." H.R. Rep. No. 94-1476, p. 130 (1975).

131. Telephone interview with Richard Weisgrau, Executive Director of the American Society of Magazine Photographers (February 10, 1994). The bill was withdrawn in September, 1991 following lobbying by photographers who pointed out that the bill would in all likelihood be pre-empted by 17 U.S.C. § 301 (1988).

132. This view is represented by the title of a recent law review article. Alan S. Wernick, *The Work Made for Hire and Joint Work Copyright Doctrines After CCNV v. Reid: "What! You Mean I Don't Own It Even Though I Paid in Full for It?"*, 13 *HAMLIN L. REV.* 287 (1990).

133. David Walker, *Sponsors Revising NY Photo Law*, *PHOTO DISTRICT NEWS*, November 1991.

negatives in order to have less expensive reprints made elsewhere, the photographer refused.

This proposed legislation also reflects the mindset of the district court in *Marco*. That court focused on Accent's control over Marco, Accent's payment for the photographs, and Marco's possession of the photographs when it found Accent to be their author. The common sense notion that one who pays for and possesses creative work may do with that work what he pleases is apparently alive and well in state legislatures and at least one federal court, notwithstanding the statutory protections afforded by Title 17 of the United States Code.

B. California

Unlike New York, which has seen efforts to reduce copyright protection for photographers, California has enacted legislation to provide even greater protection for creative artists who enter into contracts governed by California law. One commentator has described these statutes as comprising an "artist's bill of rights."¹³⁴ Three statutes have a direct impact in the work-for-hire area.

Section 686 of the California Unemployment Insurance Code defines "employer" with specific reference to the 1976 Copyright Act:

"Employer" also means any person contracting for the creation of a specially ordered or commissioned work of authorship when the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire, as defined in section 101 of Title 17 of the United States Code, and the ordering or commissioning party obtains ownership of all of the rights comprised in the copyright in the work. The ordering or commissioning party shall be the employer or the author of the work for the purposes of this part.¹³⁵

Similarly, section 621 defines "employee" with reference to this section: "Employee means . . . (d) any individual who is an employee pursuant to section 686."¹³⁶ Thus, whenever an artist works on a work-for-hire status, the artist becomes an employee for unemployment insurance purposes. The "employer" is required to pay insurance premiums based on the "employee's" wages, and deduct from those wages state Disability Insurance Fund withholdings.¹³⁷ The "employee" would qualify for unemployment compensation benefits, assuming she fulfills the other statutory eligibility requirements.¹³⁸ No decisions have been reported in California under sections 686 or 621

134. Peter H. Karlen, *Artists' Rights Today*, 4 CALIFORNIA LAWYER, March 1984, at 23.

135. Cal. Unemp. Ins. Code § 686 (West 1989).

136. *Id.* at § 621(d).

137. *Id.* at §§ 926, 936.

138. *Id.* at §§ 1251-1265.9.

concerning the extension of unemployment benefits to independent contractors who create works for hire.

California also extends worker's compensation benefits to independent contractors who create works for hire:

"Employee" includes . . . (c) Any person while engaged by contract for the creation of a specially ordered or commissioned work of authorship in which the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire, as defined in Section 101 of Title 17 of the United States Code, and the ordering or commissioning party obtains ownership of all the rights comprised in the copyright in the work.¹³⁹

Employers using work-for-hire contracts are obligated to maintain worker's compensation insurance on these "employees,"¹⁴⁰ who could collect benefits if they were injured in the course of their employment.¹⁴¹ An employer who fails to obtain such insurance could be subject to property attachment to secure payment of a judgment obtained by an injured employee,¹⁴² or the imposition of a lien for claims paid by the Uninsured Employer Fund.¹⁴³ Like the companion provisions in the unemployment insurance area, there are no reported cases addressing these issues in the work-for-hire context. If any of these statutes are challenged, California courts will not have the benefit of looking to other states' laws. No other state has extended "employee" benefits to persons who create commissioned works under the work-for-hire provision of the 1976 Copyright Act.

Many California employers will want to obtain copyright interests without the added expense, risk and paperwork associated with granting independent contractors "employee" status through work-for-hire agreements. One commentator suggests that clients purchase the copyright by written assignment and avoid any mention of work for hire.¹⁴⁴ Under such an approach, the artist retains authorship, can terminate the transfer and subsequently reacquire the copyright.¹⁴⁵ This commentator also suggests that artists who want to secure the benefits provided by California work-for-hire statutes should insist on a written contract spelling out the conveyance of copyright benefits and the payments and benefits to which they are entitled under California law. While such a written contract is always desirable as an expression of the intent and interests of the parties, the protections offered by the

139. Cal. Lab. Code § 3351.5 (West 1989).

140. *Id.* at §§ 3700-3709.5.

141. *Id.* at §§ 3600-3605.

142. *Id.* at § 3707.

143. *Id.* at § 3720.

144. Gregory T. Victoroff, *Poetic Justice: California "Work Made for Hire" Laws Invite State Regulation of Parties to Copyright Contracts*, 12 HASTINGS COMM. & ENT. L.J. 453, 460 (1990).

145. 17 U.S.C. § 203 (1988).

California statutes do not require any instrument other than the work-for-hire agreement.

C. Texas

Like most states, Texas has not passed any legislation with respect to photography or the work-for-hire concept as it relates to copyright. However, the experiences in New York and California demonstrate the divergent paths states can follow in regulating intellectual property rights. While New York legislators were rebuffed in their attempt to limit the intellectual property rights of artists, California moved in the opposite direction. By requiring employers who contract on a work-for-hire basis to treat artists as employees, in the form of unemployment and worker's compensation protections, California has recognized the value of authorship rights to artists. Texas legislators may want to consider a similar statutory scheme.

VIII. CONCLUSION

Photography has not had an easy time in the history of copyright law in the United States. A challenge to an early copyright statute required the Supreme Court to uphold photography as an art form worthy of copyright protection in 1884. Early versions of both the 1909 and 1976 Acts attempted to place portrait photography in the work-for-hire category, but neither time did the provision become law. Absent any Congressional guidance in the area, the case law presumptively transferred rights in commissioned photographs to the buyer. By 1966, authorship was transferred as well. The legislation recently introduced in New York echoed the failed Congressional attempts to bring portrait photography back within the area of work for hire.

The 1976 Act establishes a new presumption that copyright remains with the photographer unless she (1) is an employee, as determined by agency law or (2) she is an independent contractor who agrees in writing that the photograph is a work for hire *and* the photograph falls within one of nine categories. While this presumption helps independent contractors, as demonstrated in *CCNV*, the balance of economic power is still weighted heavily against most artists who work independently. Given the choice of executing a written work-for-hire agreement or not working at all, most artists will sign, thereby giving up their statutory authorship and the benefits accorded them under the copyright law with little to show in return. The California statutes attempt to balance this economic inequity. Buyers of creative work must consider the economic costs in using work-for-hire contracts, including unemployment and workers' compensation insurance premiums as well as potential benefit payments. By requiring buyers to pay more for authorship rights in the form of employee benefits, Califor-

nia has recognized the value of copyright in creative works and has given teeth to the creative artists' presumption of ownership. Perhaps Texas should move in the same direction.