

COMMENTS

Smile and Say, “We Need Not Decide”: Decoding the Federal Courts’ Nonanswers Regarding the Derivative-Work Status of Photographs

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I. INTRODUCTION

Copyright serves the dual purpose of “assur[ing] authors the right to their original expression, [while] encourag[ing] others to build freely upon the ideas and information conveyed by a work.”¹ Accordingly, copyright protection extends not only to novel works, but also to

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1. Feist Publ’ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 349-50 (1991).

creations derived from preexisting works; namely, derivative works.² The Supreme Court of the United States has long held that photographic works qualify for copyright protection.³ However, U.S. courts of appeals in multiple circuits have refused to settle whether photographs of preexisting works constitute derivative works, despite numerous opportunities to do so.

A camera's inherent ability to depict reality represents a daunting task for courts. On one hand, the potential for minimal variations between a photograph and its underlying subject risks the propagation of insufficiently original derivative works that could interfere with the original copyright holder's exclusive rights.⁴ The concern is these "slavish copies"—works lacking any independently created expression—could be so similar in appearance to the underlying work that the court in a subsequent infringement suit could have difficulty determining whether one derivative work infringed another due to the inability to separate the original elements of expression in the derivative and underlying works.⁵ Accordingly, the risk of saturating the marketplace with these "slavish copies"—and the resulting judicial confusion—deters federal courts from making sweeping rulings on the derivative-work status of photographs.⁶

On the other hand, the courts' silence on this issue has created an incongruity in copyright law that, in the words of the United States Court of Appeals for the Eleventh Circuit, "tears a gaping hole in copyright protection" that ultimately leaves original works vulnerable to photographic misappropriation.⁷ For example, Tulane Adjunct Professor Ashlye Keaton has worked to ensure that the Mardi Gras Indians' ornately designed costumes are not commercially exploited through unauthorized photographs without receiving proper compensation.⁸ Specifically, Professor Keaton asserts that photographs of the elaborate costumes⁹ are derivative works, in which the Indians could either bring

2. 17 U.S.C. §§ 103(a), 201(a) (2006).

3. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 54 (1884).

4. *Schrock v. Learning Curve Int'l*, 586 F.3d 513, 521 (7th Cir. 2009) (citing *Gracen v. Bradford Exch.*, 698 F.2d 300 (7th Cir. 1983)).

5. *Id.* at 519-21.

6. *See id.*

7. *Latimer v. Roaring Toyz, Inc.*, 601 F.3d 1224, 1235 (11th Cir. 2010).

8. *All Things Considered: Mardi Gras Indians Seek To Copyright Costumes* (NPR radio broadcast Feb. 8, 2011), available at <http://www.npr.org/2011/02/08/133600362/Mardi-Gras-Indians-Seek-To-Copyright-Costumes>.

9. Since clothing designs are generally not entitled to copyright protection, Professor Keaton instead argues that the designs are worn over clothes as nonfunctional sculptural works of art, rather than merely as costumes, and thereby qualify for copyright protection.

infringement suits against people who sell photographs of them or negotiate licensing fees with photographers either before or after the pictures are taken.¹⁰ However, Professor Keaton's derivative-works argument is currently unsettled law, and is thus not guaranteed to succeed. Ultimately, this glaring gap in the law creates uncertainty for photographers and their attorneys, and a clear judicial resolution to the issue is necessary.

First, this Comment will provide a brief history of photography's road to copyright protection and a discussion of which elements render a photograph copyrightable. Second, this Comment will provide background on what constitutes a derivative work under the Copyright Act. Third, this Comment will analyze the debate among the circuit courts on the derivative-work status of photographs. Fourth, this Comment will address the legal and equitable considerations of granting or denying derivative-work status to photographs. Finally, this Comment will conclude that by reading between the lines of the circuit courts' nonanswers on this issue, one can find adequate legal support for granting derivative-work protection for photographs in limited circumstances.

II. HISTORY OF PHOTOGRAPHS AND COPYRIGHT

A. *Background*

Photographs did not receive federal copyright protection until March 3, 1865.¹¹ Almost twenty years later, the Supreme Court addressed the constitutionality of extending copyright to photographic works in *Burrow-Giles Lithographic Co. v. Sarony*. In this landmark case, photographer Napoleon Sarony filed an infringement suit against the Burrow-Giles Lithographic Company, which had marketed and sold 85,000 unauthorized lithographs of Sarony's photograph of writer Oscar Wilde entitled "Oscar Wilde, No. 18."¹²

In challenging the copyrightability of the photographs, Burrow-Giles contended: (1) "writings" under Article I, Section 8 of the United States Constitution applied only to literary works, and (2) photographs do not involve original authorship since they are the subject of a mechanical process.¹³ Specifically, Burrow-Giles argued that a photograph is the

10. *Mardi Gras Indians Work To Copyright Costumes*, CBSNEWS.COM (Feb. 7, 2011), <http://www.cbsnews.com/stories/2011/02/07/ap/national/main7326952.shtml>.

11. *SHL Imaging, Inc. v. Artisan House, Inc.*, 117 F. Supp. 2d 301, 306 (S.D.N.Y. 2000) (citing Act of March 3, 1865, 38th Cong., 2d Sess., 16 Stat. 198 (1865)).

12. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 54 (1884).

13. *See id.* at 55; *see also* U.S. CONST. art I, § 8, cl. 8.

result of “mere mechanical reproduction of the physical features or outlines of some object [that] involves no originality of thought or any novelty.”¹⁴ Since the creative spark that produced the photograph derived from a machine, not man, Burrow-Giles asserted that a photograph is “not a writing nor production of an author” that can qualify for copyright under the Constitution.¹⁵

The Supreme Court rejected Burrow-Giles’s analysis, holding that “authors” and “writings” were broad enough terms to include photographers and photographs, respectively.¹⁶ The Court broadly interpreted “author” to mean “he to whom anything owes its origin; originator; maker.”¹⁷ Additionally, the Court noted that the original Copyright Act of 1790, drafted by the First Congress (in which many of the congressmen had also helped draft the original Constitution), interpreted “writings” to include not just literary works, but also nonscript creations like maps and charts.¹⁸ In addition, an 1802 amendment to the Copyright Act of 1790 extended copyright to works that were “designed,” “engraved,” and “etched,” indicating Congress’s expansive interpretation of “writings” to include a wide range of tangible media through which “the ideas in the mind of the author are given visible expression.”¹⁹ Thus, the Court concluded that Congress exercised valid authority in extending copyright to photographs.²⁰

In upholding Sarony’s copyright, the Court highlighted the author’s various creative contributions to the photograph, such as Oscar Wilde’s specific poses, the selection of his costume, the calibration of light and shade, and the combination of these elements to “sugges[t] and evok[e] the desired expression.”²¹ While the Court acknowledged that in some occasions the “ordinary production of a photograph” would lack the requisite originality for copyright, the Court held that photographs in general are protectable as long as they are the “original intellectual conceptions of the author.”²² Thus, *Burrow-Giles* established the guiding principle that a photograph must visibly reflect the author’s creative choices in order to qualify for copyright protection.²³

14. See *Burrow-Giles Lithographic*, 111 U.S. at 59.

15. *Id.* at 56.

16. See *id.* at 58.

17. *Id.*

18. *Id.* at 56-57.

19. *Id.* at 57-58.

20. *Id.* at 58.

21. *Id.* at 60.

22. *Id.* at 58-59.

23. See *id.*

B. What's in a Copyright Anyway?

The Copyright Act grants copyright protection to “*original* works of authorship fixed in any tangible medium of expression . . . from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”²⁴ Thus, a work must be original to the author in order to qualify for copyright.²⁵ The Supreme Court has long established a low threshold for originality, in which a work need only to have been “independently created by the author (as opposed to copied from other works), and [possess] at least some minimal degree of creativity.”²⁶ The Court distinguishes originality from novelty, declaring, “a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying.”²⁷

While there is no uniform test to determine the copyrightability of photographs, courts have long recognized that photographs contain some inherent elements of originality, such as the posing of the subjects, lighting, angle, selection of film and camera, evoking the desired expression, and almost any other variant involved.²⁸ On the other hand, courts and commentators have also stated “[T]he mere reproduction of a work of art in a different medium should not constitute the required originality for the reason that no one can claim to have independently evolved any particular medium.”²⁹ Thus, photographs are not copyrightable by virtue of creation.

In an oft-cited opinion, the United States District Court for the Southern District of New York in *Mannion v. Coors Brewing Co.*

24. 17 U.S.C. § 102(a) (2006) (emphasis added).

25. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

26. *Id.*

27. *Id.*

28. *See, e.g., Burrow-Giles Lithographic*, 111 U.S. at 60 (considering pose, selection and arrangement of costumes, draperies and other accessories, lighting and shading); *Rogers v. Koons*, 960 F.2d 301, 307 (2d Cir. 1992) (emphasizing photographer's “inventive efforts” in posing couple holding numerous puppies between them); *Gross v. Seligman*, 212 F. 930, 931 (2d Cir. 1914) (considering pose, background, light, and shade); *E. Am. Trio Prods., Inc. v. Tang Elec. Corp.*, 97 F. Supp. 2d 395, 417-18 (S.D.N.Y. 2000) (considering “lay-out”, angles, lighting, and computer enhancements); *Kisch v. Ammirati & Puris*, 657 F. Supp. 380, 382 (S.D.N.Y. 1987) (considering selection of lighting, shading, positioning, and timing).

29. *See L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 491 (2d Cir. 1976) (quoting 1 MELVILLE NIMMER, *THE LAW OF COPYRIGHT* § 20.2, at 93 (1975)); *Durham Indus. v. Tomy Corp.*, 630 F.2d 905, 910 (2d Cir. 1980) (“[T]he mere reproduction of the Disney characters in plastic, even though the adaptation of the preexisting works to this medium undoubtedly involved some degree of manufacturing skill, does not constitute originality as this Court has defined the term.”).

describes three nonexclusive respects in which a photograph may be original: (1) rendition, (2) timing, and (3) the creation of the subject.³⁰

First, the court defines “originality in rendition” to encompass the originality that derives from the specific use of photographic techniques such as the “angle of shot, light and shade, exposure, effects achieved by means of filters, [and] developing techniques.”³¹ As a result, originality in the rendition protects “not *what* is depicted, but rather *how* [the scene] is depicted,” along with the subsequent effect the photograph produces.³² Moreover, unless a photograph replicates another work with total or near-total fidelity, a court will likely find at least some originality in the rendition.³³

Second, the court defines “originality in timing” as the “creat[ion of] a worthwhile photograph by being at the right place at the right time.”³⁴ The copyright derived from original timing is limited to the uniqueness of that particular moment in time, as copyright in a photograph ordinarily confers no exclusive rights over the subject matter.³⁵ The court cites as an example Thomas Mangelsen’s *Catch of the Day*, which depicts a salmon that appears to be jumping into the open mouth of a brown bear at Brooks Falls in Katmai National Park, Alaska.³⁶ The copyright in *Catch of the Day* does not protect against future photographs of bears eating salmon in the same location; nor does *Catch of the Day* exclude another photographer from copyright protection of his own should he be skilled and lucky enough to photograph a salmon at the precise moment that the fish appears to be leaping into a bear’s mouth.³⁷ Thus, even if Mangelsen had inspired the future photographer, his subsequent photograph would not have necessarily infringed upon *Catch of the Day* because “Mangelsen’s copyright does not extend to the natural world he captured.”³⁸

30. 377 F. Supp. 2d 444, 452-54 (S.D.N.Y. 2005). The United States District Court for the Southern District of New York is frequently cited as a persuasive authority given the high volume of copyright cases that are litigated in that district each year. *See id.*

31. *Id.* at 452 (citing 1 HUGH LADDIE ET AL., THE MODERN LAW OF COPYRIGHT AND DESIGNS § 4.57, at 229 (2000)).

32. *Id.*

33. *Id.*; *see also* Bridgeman Art Library, Ltd. v. Corel Corp., 25 F. Supp. 2d 421, 426-27 (S.D.N.Y. 1998) (holding that photographic transparencies that created exact reproductions of public domain works of art lacked requisite individual creation to be copyrightable).

34. *Mannion*, 377 F. Supp. 2d at 452 (quoting 1 LADDIE ET AL., *supra* note 31, § 4.57, at 229).

35. *Id.* at 453.

36. *Id.*

37. *Id.*

38. *Id.*

Third, the court defines “originality in the creation of the subject” as the copyright in the particular scene or subject that the photographer himself has staged and created.³⁹ Originality in the creation of the subject is a key limitation to the principle that copyright generally confers no right over subject matter.⁴⁰

As an example, the court cites *Rogers v. Koons*, where the United States Court of Appeals for the Second Circuit held that the copyright of the plaintiff’s photograph *Puppies*—which depicted an arranged scene of a man and his wife on a park bench with eight puppies on their laps—prevented the defendants from replicating precisely the content of the photograph in a three-dimensional sculpture.⁴¹ While *Puppies* was original in rendition through the photographer’s particular use of his camera and natural light, the Second Circuit reasoned that the more salient original elements in the photograph derived from the photographer’s particular staging of the subject and scene.⁴² Specifically, the Second Circuit highlighted how the photographer’s individual artistic choices created a scene that was undeniably the author’s own original expression, including the selection of light, the location, the bench on which the owners would sit, and the arrangement of the puppies in their laps.⁴³

To summarize, for photographs that are original in rendition or timing, copyright protects the image but does not prevent others from photographing the same scene. In contrast, photographs that are original in the creation of the subject extend a copyright to that subject as well. Thus, Sarony’s original rendition of “Oscar Wilde, No. 18” could not enjoin others from photographing Oscar Wilde, just as the copyright in the original timing of *Catch of the Day* would not prevent future photographs of salmon-eating bears at any particular moment.⁴⁴ However, Sarony’s copyright in his original creation of the subject does grant him the right to prevent an artist from replicating his precise scene as depicted in “Oscar Wilde, No. 18” through a new photograph or another medium.⁴⁵

39. *Id.* (citing 1 LADDIE ET AL., *supra* note 31, § 4.57, at 229).

40. *Id.*

41. *Id.* at 454 (citing *Rogers v. Koons*, 960 F.2d 301, 304 (2d Cir. 1992)).

42. *Id.* (citing *Rogers*, 960 F.2d at 304).

43. *Rogers*, 960 F.2d at 304 (noting the photographer decided against a suggestion to photograph the puppies alone, instead opting to create his own original vision including humans).

44. *See Mannion*, 377 F. Supp. 2d at 454.

45. *See id.* (noting in a footnote that the court’s analysis focused on traditional print photography, and a different analytical framework may be required for digital photography).

III. DERIVATIVE WORKS AND THE COPYRIGHT ACT

The Copyright Act defines a derivative work as “a work based upon one or more preexisting works [which can] be recast, transformed, or adapted.”⁴⁶ The copyright holder has the exclusive right to authorize the creation of derivative works based upon her underlying work.⁴⁷ Thus, a party without a valid license from the copyright owner to prepare a derivative work is generally guilty of infringement.⁴⁸

Like independent creations, a derivative work requires only a “minimal creative spark” to meet the constitutional threshold of originality for copyright protection.⁴⁹ However, the copyright protection afforded to derivative works is subject to two key limitations. First, the author’s original contributions to a derivative work must be “more than trivial.”⁵⁰ Second, the scope of protection afforded to a derivative work “must reflect the degree to which it relies on preexisting material and must not in any way affect the scope of any copyright protection in that preexisting material.”⁵¹ The creator of a derivative work is only entitled to copyright protection in the “non-trivial, original” contributions to the derivative work, but not the preexisting elements derived from the underlying work.⁵² Moreover, copyright in the derivative work does not affect the copyright or public domain status of the preexisting material on which it is based.⁵³ In other words, a derivative work cannot be so similar to the underlying work such that the derivative work would interfere with the ability of the copyright holder in the underlying work to authorize subsequent derivative works.⁵⁴

46. 17 U.S.C. § 101 (2006).

47. See *Stewart v. Abend*, 495 U.S. 207, 220 (1990) (citing 17 U.S.C. § 106 (1988)).

48. *Id.* at 223; see also 17 U.S.C. § 103(a) (“[P]rotection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.”).

49. See *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

50. *Durham Indus. v. Tomy Corp.*, 630 F.2d 905, 909 (2d Cir. 1980).

51. *Id.* (citing 17 U.S.C. § 103(b)).

52. *Id.*; see also *Stewart v. Abend*, 495 U.S. 207, 223 (1990) (citing *Russell v. Price*, 612 F.2d 1123, 1128 (9th Cir. 1979)).

53. See 17 U.S.C. § 103(b). A derivative-works copyright is “independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.” *Id.*

54. *Entm’t Research Grp. v. Genesis Creative Grp.*, 122 F.3d 1211, 1220 (9th Cir. 1997) (citing *Gracen v. Bradford Exch.*, 698 F.2d 300, 305 (7th Cir. 1983)) (noting that to grant copyright to virtually identical derivative works would give the first derivative copyright holder a de facto monopoly on the creation of subsequent derivative works from the same underlying work, thus restricting the exclusive right of the copyright holder in the underlying work to authorize derivative works).

While the circuit courts have affirmed this low threshold of originality for derivative works, courts have not been hesitant to deny copyright protection to insufficiently original derivative works. In *L. Batlin & Son, Inc. v. Snyder*, the Second Circuit found that a plastic rendition of a cast iron Uncle Sam mechanical bank was insufficiently original to qualify for a copyright.⁵⁵ In order to copyright a reproduction of a work of art, the Second Circuit held, “the work [must] contain some substantial, not merely trivial originality.”⁵⁶ The word “substantial” does not create a higher standard of originality for derivative works, but instead requires the author to “contribut[e] something more than a ‘merely trivial’ variation, something recognizably ‘his own.’”⁵⁷ Consequently, the Second Circuit denied copyright protection to the plastic bank, reasoning that most of the changes—such as alterations to the bank’s size and the change in medium from cast iron to plastic—were “not perceptible to the casual observer” and amounted to “[no] significant alteration” of the original work.⁵⁸ The court warned that to extend copyright to trivial variations of a preexisting work would undermine the public interest by creating “a weapon for harassment” for “mischievous copiers” sufficient to interfere with copyright in a preexisting work.⁵⁹

The United States Court of Appeals for the Seventh Circuit has defined originality in derivative works to mean little more than a “prohibition of actual copying,” reasoning that any more demanding of a requirement would be burdensome to enforce and would require judges to make aesthetic judgments that, in the court’s view, judges are unqualified to make.⁶⁰ The Seventh Circuit held in *Bucklew v. Hawkins, Ash, Baptie & Co.*, “the only ‘originality’ required for the new work to be copyrightable . . . is enough expressive variation from public-domain or other existing works to enable the new work to be readily distinguished from its predecessors.”⁶¹ Thus, a derivative work is entitled to copyright as long as there are sufficient differences between the

55. 536 F.2d 486, 487-88 (2d Cir. 1976).

56. *Id.* at 490 (internal quotation marks omitted).

57. *Id.* (citing *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 103 (2d Cir. 1951)).

58. *Id.* at 488-89.

59. *Id.* at 492.

60. *Bucklew v. Hawkins, Ash, Baptie & Co.*, 329 F.3d 923, 929 (7th Cir. 2003) (quoting *Alfred Bell*, 191 F.2d at 103).

61. *Id.* (citing *Alfred Bell*, 191 F.2d at 102-03).

derivative work and the underlying work to meet the statutory threshold of originality.⁶²

IV. PHOTOGRAPHS AND THE DEBATE OVER DERIVATIVE-WORK PROTECTION

A. *How Have the Courts Managed To Avoid Resolving This Issue?*

Courts have repeatedly avoided unambiguous rulings as to whether photographs of preexisting works constitute derivative works, despite multiple opportunities to resolve the issue. Instead, most courts facing this question have decided their cases on alternate grounds without providing a definitive answer.⁶³

In a derivative-work analysis, a court must first resolve whether the copyright owner of the underlying work granted a license to create a derivative work before having to resolve the more difficult query of whether the photograph qualifies as a derivative work.⁶⁴ If the copyright holder has granted the photographer a license, the classification as a derivative work would not affect the key inquiry of whether the photographer has a valid copyright in his work.⁶⁵ As long as the party has a license to create a derivative work, he does not require a second license from the copyright holder in the underlying work in order to copyright his derivative work.⁶⁶ Rather, the artist's copyright in a noninfringing derivative work arises automatically by operation of law, thus rendering a derivative-works determination irrelevant in cases where the copyright holder has granted a license.⁶⁷

In contrast, the copyright in a derivative work is “only defeated when the underlying work has been misappropriated.”⁶⁸ Thus, only unlicensed photographs of preexisting works would require the courts to definitively resolve the derivative-works question.⁶⁹ As will be seen in the discussion in the next Section, the vast majority of courts that have faced this issue of photographs as derivative works have usually found that the artist had an express or implied license to photograph the

62. *Gracen v. Bradford Exch.*, 698 F.2d 300, 302 (7th Cir. 1983).

63. *See* 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 303[C][1], at 3-20.3 (2011).

64. *Latimer v. Roaring Toyz, Inc.*, 601 F.3d 1224, 1235 (11th Cir. 2010).

65. *Schrock v. Learning Curve Int'l*, 586 F.3d 513, 518 (7th Cir. 2009).

66. *Liu v. Price Waterhouse L.L.P.*, 302 F.3d 749, 755 (7th Cir. 2002) (quoting 1 NIMMER ON COPYRIGHT, *supra* note 63, § 3.06, at 3-34.26 & n.26(1) (2002)).

67. *Id.* (quoting 1 NIMMER ON COPYRIGHT, *supra* note 63, § 3.06, at 3-34.26 & n.26(1) (2002)) (noting that parties may alter this default rule by contract).

68. *Latimer*, 601 F.3d at 1235.

69. *Id.*

preexisting works. One recent exception is the Seventh Circuit case of *Ty, Inc. v. Publications International, Ltd.*, where the defendant conceded that its photographs of “Beanie Babies” were unauthorized derivative works in order, to support a fair use defense.⁷⁰ As a result, the Seventh Circuit was able to sidestep the derivative-works question.⁷¹

While courts have not definitively resolved whether a photograph can be a derivative work, their elaborate dance to avoid answering this question has left various clues as to how they may rule if presented with such an issue. Thus, the following discussion will consist of two parts: (1) courts of appeals and their lower district courts that have indicated potential support for the classification of photographs as derivative works, and (2) courts that have suggested opposition to the classification of photographs as derivative works.

B. Case Law Sympathetic Towards (but Without Deciding) Derivative-Work Protection for Photographs

In *Ets-Hokin v. Skyy Spirits, Inc.*, the United States Court of Appeals for the Ninth Circuit addressed whether a professional photographer—who took pictures of a Skyy vodka bottle for use in an advertisement but whose photos were ultimately rejected—could claim copyright infringement when he alleged that other photographers “mimicked” his original photographs for the final advertisement.⁷²

The district court classified Ets-Hokin’s photographs as derivative works, reasoning that the Skyy vodka bottle on which the photographs were based was a preexisting work full of protected trade dress (the blue bottle, gold label, etc.) and copyrighted material (the label and all nonutilitarian features of the bottle).⁷³ Applying the Second Circuit’s *Durham Industries Inc. v. Tomy Corp.* test for determining copyright eligibility in derivative works, the district court held that (1) the photos lacked requisite originality because the differences between the photos and the bottle were not “more than trivial,” and (2) a copyright in the photos would interfere with Skyy’s right to create works based upon its own bottle.⁷⁴

70. 292 F.3d 512, 515 (7th Cir. 2002).

71. *See id.* at 519.

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

73. *Id.* at 1078.

74. *Id.* at 1073 (applying *Durham Indus. v. Tomy Corp.*, 630 F.2d 905 (2nd Cir. 1980) (as adopted by *Entm’t Research Grp. v. Genesis Creative Grp.*, 122 F.3d 1211, 1220-21 (9th Cir. 1997))).

The Ninth Circuit narrowed the district court's discussion to whether Ets-Hokin could copyright photos containing the Skyy Vodka label, noting that a party generally cannot claim a copyright for "a print or label consisting solely of trademark subject matter and lacking copyrightable matter."⁷⁵ However, the Ninth Circuit avoided deciding whether photographs could be derivative works by ruling on technical grounds that the district court mistakenly classified the disputed photos as derivative works.⁷⁶ The Ninth Circuit held that because Ets-Hokin's photos were based on the *bottle as a whole*, instead of the Skyy label, the entire bottle could not qualify as a "preexisting work" under the Copyright Act.⁷⁷ The court reasoned that the Skyy bottle is not eligible for copyright protection because the bottle is a utilitarian object that lacks any special features that could exist independently as a work of art.⁷⁸ Because the Skyy bottle did not qualify as a "preexisting work" that would be eligible for copyright, the court concluded that photos of the bottle could not constitute derivative works.⁷⁹ Thus, while the Ninth Circuit ultimately sidestepped the derivative-works question, the court appeared receptive to the argument (or at least did not outwardly condemn the district court's conclusion) that photographs can be derivative works.

While the Seventh Circuit has provided some hints as to whether photographs are derivative works, the court has never properly resolved the issue. In *Schrock v. Learning Curve International*, the Seventh Circuit addressed whether photographer Daniel Schrock could obtain copyright protection for photographs of "Thomas & Friends" train toys when the copyright holders, HIT Entertainment and Learning Curve, used Schrock's photos on promotional materials without his permission.⁸⁰

The district court classified the photographs as derivative works on the grounds that Schrock's photographs "recast, transformed, or adapted" the three-dimensional "Thomas & Friends" toys into a different, two-dimensional medium.⁸¹ By classifying the photos as derivative works of the "Thomas & Friends" characters, the district court concluded that Schrock required Learning Curve's permission not only to take the

75. *Id.* at 1080 (quoting 37 C.F.R. § 202.10(b)).

76. *Id.* at 1081.

77. *Id.*

78. *Id.* at 1080.

79. *Id.* at 1081.

80. *Schrock v. Learning Curve Int'l*, 586 F.3d 513, 516 (7th Cir. 2009) (noting that some of Schrock's work invoices to Learning Curve included "usage restrictions" purporting to limit Learning Curve's use of his photos to two years).

81. *Id.* at 518.

photos, but also to copyright them.⁸² Thus, the district court granted summary judgment for the defendants, holding that Schrock had no copyright in his photos because he did not have Learning Curve's permission to copyright them.⁸³

On appeal, the Seventh Circuit reversed the district court's decision and affirmed Schrock's copyright in his photos.⁸⁴ However, the court sidestepped the question of whether the photographs of "Thomas & Friends" were derivative works.⁸⁵ The court noted that a derivative-work determination does not affect the applicable legal standard for assessing copyrightability, but rather, only the scope of copyright protection afforded to a work.⁸⁶ Furthermore, because Schrock's cause of action only concerned the copyrightability of the photos, and not the scope of protection, the Seventh Circuit could assume (without deciding) for the purposes of the decision that each of Schrock's photos qualified as a derivative work under the Copyright Act.⁸⁷

In light of *Schrock*, it is not entirely clear whether the Seventh Circuit would classify photographs of preexisting works as derivative works if given the opportunity. On one hand, the Seventh Circuit disputed the district court's analysis, noting that none of the relied-upon cases had definitively resolved whether photographs of a preexisting work are derivative works.⁸⁸ Specifically, the Seventh Circuit highlighted that *Gracen v. Bradford Exchange* involved a painting of a photograph, not a derivative photographic work; and that the Ninth Circuit avoided the derivative-works question in *Ets-Hokin* by ruling on alternative grounds.⁸⁹ In addition, while the Seventh Circuit had classified unauthorized photographs of "Beanie Babies" as derivative works in *Ty*, the court only did so because the defendant had conceded this point for its fair use defense.⁹⁰

On the other hand, the Seventh Circuit provides a cogent analysis of how photographs could obtain derivative-work protection.⁹¹ The court explained that the original contribution in photographs derives from the

82. *Id.* at 515.

83. *Id.*

84. *Id.*

85. *Id.* at 518.

86. *Id.* at 515, 518.

87. *See id.* at 515.

88. *Id.* at 518.

89. *Id.*

90. *See id.*; *see also* *Ty, Inc. v. Publ'ns Int'l*, 292 F.3d 512, 515, 519 (7th Cir. 2002) (noting that Ty could seek to exploit photos of Beanie Babies for commercial purposes, in which the disputed photos would then infringe upon Ty's copyrights).

91. *Schrock*, 586 F.3d at 519-22.

“rendition” of the subject matter as described in *Mannion v. Coors Brewing Co.*, namely, “the effect created by the combination of [the photographer’s] choices of perspective, angle, lighting, shading, focus, lens, and so on.”⁹² Noting that federal courts have historically applied a generous standard of originality in evaluating photographic works for copyright, the Seventh Circuit reasoned that even works that closely resemble other works require only “independent creation plus a modicum of creativity” to receive protection.⁹³ Accordingly, only photos amounting to “slavish copies” of a preexisting work—in which the photographer’s objective is to minimize individual expression—lack the requisite originality for copyright.⁹⁴

In affirming a derivative-work copyright in the photographs, the court highlighted Schrock’s particular camera and lighting techniques that made the toys look more “life like, personable, and friendly” and gave the toys “a little bit of dimension.”⁹⁵ While a mere shift in medium is generally insufficient to satisfy the originality requirement, the court reasoned that Schrock’s artistic and technical choices to turn three-dimensional “Thomas & Friends” toys into two-dimensional images were “subtly but nonetheless sufficiently his own.”⁹⁶ In light of these specific elements of independent creation, the court concluded that Schrock’s photos were not “slavish copies,” and therefore possessed sufficient originality to qualify for a limited derivative-work copyright.⁹⁷ Even though the Seventh Circuit did not definitively resolve whether photographs can be derivative works, the court certainly provided the requisite legal rationale to argue in favor of derivative-work protection.

C. *Case Law Leaning Against (but Without Deciding) Derivative-Work Protection for Photographs*

While most courts have neglected to rule definitively on this issue, *SHL Imaging, Inc. v. Artisan House, Inc.* contains the most forceful legal rationale against granting derivative-work protection for photographs of preexisting works.⁹⁸ In *SHL Imaging*, the United States District Court for

92. *Id.* at 519.

93. *Id.*

94. *Id.* (citing *Bridgeman Art Library, Ltd. v. Corel Corp.*, 25 F. Supp. 2d 421, 427 (S.D.N.Y. 1998) (finding no originality in transparencies of public domain paintings where the goal was to reproduce those works exactly and thus minimize or eliminate any individual expression)).

95. *Id.* (internal quotation marks omitted).

96. *Id.* at 519.

97. *Id.* at 519-20.

98. 117 F. Supp. 2d 301, 306 (S.D.N.Y. 2000).

the Southern District of New York held that photographs that merely *depict* a preexisting work are not derivative works eligible for copyright.⁹⁹ The court reasoned that a mere photographic depiction—regardless of the author’s creative choices of light and shadows—is not derived from the preexisting work, but instead exists independently of the preexisting work.¹⁰⁰ As an example, the court explained that a photograph of a copyrighted sculpture is not derivative because such a photograph, “merely *depicts* that sculpture; it does not *recast, transform, or adapt*” the sculptural authorship.¹⁰¹ The court concluded that authorship in such a photographic work is “entirely different and separate from the authorship of the sculpture,” and therefore is not derivative of that preexisting work.¹⁰²

Nevertheless, the court in *SHL Imaging* suggested that some photographs could be capable of derivative authorship.¹⁰³ The court cited as potential examples the cropping of an earlier photograph, in addition to the “re-shooting of an earlier photographic work with some alteration of the expressive elements.”¹⁰⁴ The court qualified that in both instances the nature of photographic authorship would have been recast, adapted, or transformed, rather than merely depicted.¹⁰⁵

While the cropping of a photograph is not particularly relevant to this Comment, the re-shooting of a prior photographic scene indicates that even a skeptical court views at least one narrow path to derivative-work protection for photographs of preexisting works. In contrast to the Seventh Circuit’s analysis in *Schrock*, the Southern District Court’s analysis suggests that originality in rendition does not usually “recast, transform, or adapt” a preexisting work as to be classified as derivative. Therefore, the plaintiff’s creative use of light and shadows in photographing picture frames would not constitute a derivative work under the *SHL Imaging* framework.¹⁰⁶

However, originality in the creation of the subject may provide the least contentious avenue for derivative photographic works. Copyright ordinarily does not confer any rights over the subject matter in photographs, except for works that are “original in the creation of the

99. *Id.*

100. *See id.* at 306, 310-11.

101. *Id.* at 306 (emphasis added); *see also* 17 U.S.C. § 101 (2006) (stating that a derivative work must “recast, transfor[m], or adap[t]” a preexisting work to receive copyright protection).

102. *SHL Imaging*, 117 F. Supp. 2d at 306.

103. *Id.*

104. *Id.*

105. *Id.*

106. *See id.* at 306, 310-11.

subject.”¹⁰⁷ As the Southern District Court described in *Mannion*, five years after *SHL Imaging*, originality in the creation of the subject exists in a photograph inasmuch as the photographer has manipulated or staged the scene or subject to be photographed.¹⁰⁸ Applying the *Mannion* framework to the court’s reasoning in *SHL Imaging*, the only preexisting works of which photographs could be derivative works would be other preexisting photographic scenes. For example, recreating “Oscar Wilde, No. 18” from *Burrow-Giles* with different expressive elements could be derivative of Sarony’s original work, while photographs of “Thomas the Tank Engine” toys in *Schrock* or Beanie Babies in *Ty* would likely not qualify as derivative works.¹⁰⁹ Thus, the combined reasoning in *Mannion* and *SHL Imaging* suggest that even a court skeptical of the derivative-works classification of photographs can envision scenarios in which photographs of preexisting works could conceivably attain derivative-work status.

The Eleventh Circuit (while not resolving the issue definitively) appears to lean against derivative-work protection for photographs in general.¹¹⁰ In *Latimer v. Roaring Toyz, Inc.*, the Eleventh Circuit addressed whether Todd Latimer’s photographs of customized motorcycles constituted an unauthorized derivative work under the Copyright Act.¹¹¹ In the case, Roaring Toyz, Inc. (“Roaring Toyz”), a Florida based company that specializes in customizing sport motorcycles and manufacturing special parts, hired Todd Latimer to photograph various custom motorcycles for use in a Roaring Toyz catalog and eventually to promote Roaring Toyz motorcycles at trade shows.¹¹² The disputed photographs depicted customized Kawasaki ZX-14 motorcycles, which contained custom paint graphics by Ryan Hathaway, an independent painter commissioned by Roaring Toyz.¹¹³ For those photographs, Latimer made all of the creative decisions regarding lighting, appropriate camera equipment and lens, camera settings, and the use of a white background.¹¹⁴ In addition, Latimer registered the

107. *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444, 454 (S.D.N.Y. 2005).

108. *Id.* at 453.

109. *See Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884); *Schrock v. Learning Curve Int’l*, 586 F.3d 513 (7th Cir. 2009); *Ty, Inc. v. Publ’ns Int’l*, 292 F.3d 512 (7th Cir. 2002).

110. *Latimer v. Roaring Toyz, Inc.*, 601 F.3d 1224, 1227-41 (11th Cir. 2010).

111. *Id.*

112. *Id.* at 1228.

113. *Id.* at 1228-29.

114. *Id.* at 1230.

copyright in his photographs of the customized motorcycles prior to bringing a suit of copyright infringement.¹¹⁵

Defendants argued that Latimer's photographs did not qualify for copyright protection because they were "unauthorized derivative works" based on Hathaway's custom motorcycle artwork.¹¹⁶ The district court, relying exclusively on *SHL Imaging*, concluded that "Latimer has not 'recast, transform[ed], or adopt[ed]' [sic] Hathaway's artwork," as required under the Copyright Act, and thus the photographs did not constitute derivative works.¹¹⁷ Although not derivative works, the district court granted summary judgment to the defendants on Latimer's infringement claims on the grounds that Latimer had granted Kawasaki an implied license to use the photographs in its press release materials.¹¹⁸

On appeal, the Eleventh Circuit also appeared to lean against classifying the photographs as derivative works, emphasizing that, "courts have been reluctant to find that photographs of a preexisting work are derivative works."¹¹⁹ In addition to citing the negative treatment of classifying photographs as derivative works in *SHL Imaging*, the Eleventh Circuit highlighted that the defendant-appellees failed to offer any "precedential support for the assertion that photographs of preexisting works are derivative works."¹²⁰ However, the court also expressed concern that foreclosing derivative-work status for photographs entirely could put photographs of preexisting works into a copyright limbo at the expense of another's copyright.¹²¹ The Eleventh Circuit opined that photographs with requisite originality for copyright, but which did not sufficiently "recast, transform, or adapt an underlying work," risked making all original works "vulnerable to misappropriation by the photographer's lens."¹²²

Ultimately, the court declined to resolve the derivative-works question, reasoning that the ZX-14 motorcycles—useful articles not subject to copyright protection—were the primary focus and subject matter of the photographs, while Hathaway's original artwork appears only incidentally.¹²³ The Ninth Circuit also advanced this "useful article"

115. *Id.* at 1231.

116. *Id.*

117. *Id.* at 1234 (omissions and sic in original).

118. *Id.* at 1234-36.

119. *Id.* at 1234 (citing *Schrock v. Learning Curve Int'l*, 586 F.3d 513, 518 (7th Cir. 2009); *Ty, Inc. v. Publ'ns Int'l Ltd.*, 292 F.3d 512, 519 (7th Cir. 2002); *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068 (9th Cir. 2000)).

120. *Id.*

121. *See id.*

122. *Id.*

123. *Id.* at 1234-35.

argument in *Ets-Hokin* to avoid resolving the photographs-as-derivative-works question.¹²⁴ Ultimately, the court in *Latimer* reasoned that even if Latimer's photographs were derivative works, Latimer's copyright in his photographs would only be defeated if he had misappropriated Hathaway's art to create an unauthorized derivative work.¹²⁵ The court then concluded that Hathaway had indeed granted Kawasaki and Roaring Toyz an implied license to copy and distribute his original work, and that implied license extended to Latimer's photograph of Hathaway's artwork.¹²⁶ Consequently, Latimer's photographs were held as noninfringing copyrightable works, but the court nevertheless sidestepped the derivative-works question.¹²⁷

V. LEGAL AND EQUITABLE CONSIDERATIONS

Copyright serves two primary, yet seemingly contradictory, objectives: to protect the rights of authors to their original expression, while simultaneously encouraging others to build freely upon those existing ideas through authorized derivative works.¹²⁸ Federal courts are reluctant to expand derivative work copyright protection if such an extension could disproportionately affect the scope of the copyright in the underlying work, or could hinder the creation of future derivative works.¹²⁹ Courts have warned that an overly liberal originality standard for derivative works could impede the original copyright holder's exclusive right to authorize derivative works.¹³⁰ In the end, courts do not wish to reward the author of a derivative work at the expense of the creator of the preexisting work.

The unique ability of photography to accurately reflect reality, coupled with the generous standard of originality applied by federal courts in evaluating photographic works, raises two conflicting concerns for courts when considering whether to extend derivative-work protection to photographs of preexisting works.

124. 225 F.3d 1068 (9th Cir. 2000) (holding that a vodka bottle is a useful article and thus does not qualify as a preexisting work subject to copyright protection).

125. *Latimer*, 601 F.3d at 1235.

126. *Id.* at 1236.

127. *Id.*

128. See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349-50 (1991).

129. See, e.g., *Durham Indus. v. Tomy Corp.*, 630 F.2d 905, 910-11 (2d Cir. 1980) (denying derivative work protection to plastic renditions of Disney figures to prevent the derivative work from undermining the copyright in the preexisting works).

130. See *Gracen v. Bradford Exch.*, 698 F.2d 300, 305 (7th Cir. 1983). Courts seek to avoid granting the "first creator [of a derivative work] considerable power to interfere with the creation of subsequent derivative works from the same underlying work." *Id.*

On one hand, photography has an inherent capacity to depict reality, which risks the propagation of “slavish copies” that can supersede the preexisting works from which they are derived.¹³¹ Extending copyright protection to derivative works that are “virtually identical” to the underlying work could greatly interfere with the original copyright holder’s exclusive right to create future derivative works, as there could be confusion between which work was the true “original” work.¹³² Under this framework, photographs that merely depict the subject would be “virtually identical” to the preexisting work, except for a change in medium, and courts have repeatedly held that a change in medium alone is insufficient to create a new copyrightable work.¹³³

However, the risk of “slavish copies” supplanting preexisting works is a more pressing concern for two-dimensional works of art than photographs of three-dimensional objects. The Seventh Circuit noted in *Ty* that an original photograph of a Beanie Baby could never replace the need for an actual Beanie Baby.¹³⁴ In contrast, a photograph that precisely duplicates a two-dimensional work of art could more easily act as a market replacement for the underlying work and consequently risk interfering with a preexisting copyright.¹³⁵ As a result, a derivative-work classification for the photographs in *Schrock* would arguably be less likely to weaken Learning Curve’s copyright in the “Thomas & Friends” toys—or its right to produce subsequent derivative works—than would a photograph of a two-dimensional copyrighted work, such as the photographs of artworks in *Bridgeman Art Library, Ltd. v. Corel Corp.*¹³⁶

On the other hand, the failure to grant derivative-work protection to photographs of preexisting works that are themselves independently

131. See *Bridgeman Art Library, Ltd. v. Corel Corp.*, 25 F. Supp. 2d 421, 427 (S.D.N.Y. 1998) (“[A] photograph which is no more than a copy of the work of another as exact as science and technology permit lacks originality.”).

132. See *Entm’t Research Grp., v. Genesis Creative Grp.*, 122 F.3d 1211, 1220 (9th Cir. 1997) (citing *Gracen*, 698 F.2d at 305).

133. See *Durham*, 630 F.2d at 910; *SHL Imaging, Inc. v. Artisan House, Inc.*, 117 F. Supp. 2d 301, 306 (S.D.N.Y. 2000) (“Since plaintiff’s photographs merely depict defendants’ frames and do not recast, adapt or transform any authorship that may exist in the frames, they are not derivative works.”).

134. 292 F.3d 512, 518-19 (7th Cir. 2002).

135. See *Bridgeman*, 25 F. Supp. 2d at 427-28 (stating that while the works of art in this case were in the public domain, the court’s finding against originality for exact photographic replications of public domain artworks would be applicable to exact photographic replications of copyrighted artworks).

136. See *Schrock v. Learning Curve Int’l*, 586 F.3d 513 (7th Cir. 2009); *Bridgeman*, 25 F. Supp. 2d at 427-28. *But see SHL Imaging*, 117 F. Supp. 2d at 306 (holding that a photograph of a copyrighted sculpture “does not recast, transform, or adapt” the original work sufficient to justify derivative work protection).

copyrightable risks transforming photography into a user-friendly tool for misappropriation. Courts fear that to extend copyright to trivial variations of preexisting works would undermine public interest by creating “a weapon for harassment” for “mischievous copiers” that would ultimately subvert the copyright in the preexisting work.¹³⁷ This concern is particularly apt given the “generous standard of originality” applied by federal courts in evaluating photographic works for copyright protection.¹³⁸

The Eleventh Circuit opined in *Latimer* that to grant a copyright in a photograph of a preexisting work that satisfies the originality requirement, yet does not “recast, transform, or adapt” the underlying work sufficient to be classified a derivative work, could ultimately make all original works, “vulnerable to misappropriation by the photographer’s lens.”¹³⁹ In other words, the failure to extend a derivative-work copyright to photographs has plunged photography into a “copyright limbo,” where photographers can freely create original photographs of preexisting works while circumventing the copyright holder in the underlying work by not obtaining a license.

The Mardi Gras Indians’ legal battle against unauthorized photographs of their costumes demonstrates the need for judicial resolution of this issue. Given that the derivative-work status of photographs remains unsettled law, Professor Keaton’s efforts to classify photographs of the costumes as derivative works are not guaranteed to succeed.¹⁴⁰ As a result, this current “copyright limbo” hinders Professor Keaton’s quest to protect the Mardi Gras Indians’ costumes from unauthorized photographs and secure them proper compensation from the photographers.¹⁴¹ Accordingly, the federal courts’ deliberate avoidance of this issue has, in the words of the Eleventh Circuit, “[orn] a gaping hole in copyright protection” that leaves original works vulnerable to massive photographic misappropriation.¹⁴²

Ultimately, the Supreme Court, should it choose to weigh in on this issue, must resolve a difficult legal dilemma: can photographic derivative works successfully coexist with the preexisting works on which they are based, or will they inundate the marketplace with slavish copies such that they undermine preexisting copyrights? The answer

137. See *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 492 (2d Cir. 1976).

138. *Schrock v. Learning Curve Int’l*, 586 F.3d 513, 519 (7th Cir. 2009).

139. 601 F.3d 1224, 1235 (11th Cir. 2010).

140. See *All Things Considered*, *supra* note 8.

141. See *id.*

142. See *Latimer v. Roaring Toyz, Inc.*, 601 F.3d 1224, 1234 (11th Cir. 2010).

shall determine whether photographs of preexisting works deserve derivative work copyright protection.

VI. CONCLUSION

Ample legal precedent exists to conclude that photographs of preexisting works can receive derivative-works protection in limited circumstances. The Supreme Court could follow the *Schrock* framework indicating that the original contribution in a photograph (and by extension the derivative-work copyright) originates not from the mere *depiction* of a subject, but rather the expressive *effect* created by the photographer's choice of lighting, angles, shading, and other variants.¹⁴³ Furthermore, even skeptical courts, such as the Southern District Court of New York in *SHL Imaging*, have recognized the potential for photographic derivative works by reshooting a copyrighted photograph through the "alteration of the expressive elements."¹⁴⁴ Thus, photographs that merely depict a preexisting work with minimal expressive contributions would be denied protection as "slavish copies," while photographs that transform a preexisting work through the artist's unique individual expressive contributions could and should be protected. This, in turn, would allow the Supreme Court to distinguish between photographs that "recast, transform, or adapt" preexisting works, while denying protection to "virtually identical" derivative works in order to ensure that "slavish copies" do not inundate the marketplace and interfere with another's copyright.¹⁴⁵

By granting derivative-work protection to photographs of preexisting works, the Supreme Court could bring photographs out of their copyright limbo and into the proverbial light. Currently, a photograph of a preexisting work could be independently original yet not a derivative work, and thus enable the misappropriation of the underlying work without the copyright holder's authorization.¹⁴⁶ If photographs could be classified as derivative works, copyright holders would be empowered—through their exclusive right to authorize derivative works—to combat the misappropriation of their preexisting works by unauthorized photographs.¹⁴⁷ As a counterbalance, photographers could

143. See *Schrock*, 586 F.3d at 519.

144. 117 F. Supp. 2d 301, 306 (S.D.N.Y. 2000).

145. See *Entm't Research Grp., v. Genesis Creative Grp.*, 122 F.3d 1211, 1220 (9th Cir. 1997) (citing *Gracen v. Bradford Exch.*, 698 F.2d 300, 305 (7th Cir. 1983)).

146. See *Latimer*, 601 F.3d at 1234 ("If a photograph, which satisfies the originality requirement for copyright protection, does not recast, transform, or adapt an underlying work, then all original works are vulnerable to misappropriation by the photographer's lens.").

147. See 17 U.S.C. § 106 (2006).

freely take pictures of preexisting works so long as the photographs fall under the statutory definition of fair use.¹⁴⁸ Under this framework, the Supreme Court (1) would resolve a contentious issue for the circuit courts, (2) create certainty for would-be photographers, and (3) strike an appropriate balance between the rights of authors to their original expression while encouraging others to build freely upon those existing ideas.

148. See *Ty, Inc. v. Publ'ns Int'l*, 292 F.3d 512, 517-24 (7th Cir. 2002) (“[C]opying that is complementary to the copyrighted work . . . is fair use, but copying that is a substitute for the copyrighted work . . . or for derivative works from the copyrighted work is not fair use.” (citations omitted)).