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# How Photographs Infringe

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# How Photographs Infringe

Terry S. Kogan\*

## ABSTRACT

*Courts and commentators have lavished attention on the question of what makes a photograph original and entitled to copyright protection. Far less attention has been devoted to the issue of how photographs infringe. This is the first Article to systematically explore the different ways in which a photograph can steal intellectual property. Photographs can infringe in two ways: by replication and by imitation. A photograph infringes by replication when, without permission, a photographer points her camera directly at a copyright-protected work—a sculpture, a painting, another photograph—and clicks the shutter. A photograph can also infringe by imitation. In such cases, the plaintiff's claim is that the infringing photograph imitates the creative expression in her own picture.*

*One type of photographic infringement by imitation has confounded courts, instances in which the plaintiff photographer stages a tableau before clicking the shutter—e.g., poses a person for a portrait or assembles fruit on a table for a still life—and the defendant imitates that tableau. Copyright law is clear that a photographer has a protected interest against others copying the tableau she staged for a picture. Nonetheless, many courts simply refuse to find infringement in such cases, even when the defendant admits to having imitated that tableau. Looking to the idea/expression dichotomy, these courts excise from consideration the staged tableau as the unprotected “idea” of the plaintiff's photograph. Having cut the heart out of that image, they inevitably find the defendant's photograph not to be infringing.*

*This Article argues that looking to the idea/expression dichotomy to ignore a plaintiff's staged tableau not only renders a nullity of an entire category of protected photographs, but profoundly misunderstands where to locate a photograph's “idea.” That idea exists not on the face of the image. Rather, it is the mental vision that a*

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photographer hopes to capture in taking a picture. If she shares that vision with other photographers, they are free to try their hand at embodying that idea in a photograph with no fear of infringement. Once a photographer clicks the shutter, however, the resulting image is expression—entirely expression.

Courts and commentators have justified applying the idea/expression dichotomy to eviscerate photographs out of a concern for protecting the scope of creativity for downstream photographers. This Article proposes that the “thin copyright doctrine” can offer a much better approach to providing such protection. It proposes a “silver platter” principle for determining when a photograph should be entitled only to thin protection.

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## I. INTRODUCTION

The world of photographic infringement is vastly underexplored. While devoting much attention to what makes a photograph original,<sup>1</sup> courts and commentators have focused far less on understanding precisely how a photograph can misappropriate expression from a copyright-protected work.<sup>2</sup>

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1. See, e.g., Teresa M. Bruce, *In the Language of Pictures: How Copyright Law Fails to Adequately Account for Photography*, 115 W. VA. L. REV. 93, 97 (2012); Christine Haight Farley, *The Lingering Effects of Copyright’s Response to the Invention of Photography*, 65 U. PITT. L. REV. 385, 392 (2004); Robert A. Gorman, *Copyright Protection for the Collection and Representation of Facts*, 76 HARV. L. REV. 1569, 1594 (1963); Justin Hughes, *The Photographer’s Copyright—Photograph as Art, Photograph as Database*, 25 HARV. J.L. & TECH. 339, 342 (2012); Terry S. Kogan, *The Enigma of Photography, Depiction, and Copyright Originality*, 25 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 869, 874 (2015); Thomas B. Maddrey, *Photography, Creators, and the Changing Needs of Copyright Law*, 16 SMU SCI. & TECH. L. REV. 501, 505 (2013); Morgan M. Stoddard, Comment, *Mother Nature as Muse: Copyright Protection for Works of Art and Photographs Inspired by, Based on, or Depicting Nature*, 86 N.C. L. REV. 572, 575 (2008); Eva E. Subotnik, *Originality Proxies: Toward a Theory of Copyright and Creativity*, 76 BROOK. L. REV. 1487, 1495 (2011); Mitch Tuchman, *Inauthentic Works of Art: Why Bridgeman May Ultimately Be Irrelevant to Art Museums*, 24 COLUM.-VLA J.L. & ARTS 287, 290 (2001); Rebecca Tushnet, *Worth a Thousand Words: The Images of Copyright*, 125 HARV. L. REV. 683, 716 (2012).

Cases have also set forth extensive discussions of photographic originality. See, e.g., *Ets-Hokin v. Sky Spirits*, 225 F.3d 1068, 1073–77 (9th Cir. 2000); *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444, 450–54 (S.D.N.Y. 2005); *SHL Imaging, Inc. v. Artisan House*, 117 F. Supp. 2d 301, 306–10 (S.D.N.Y. 2000).

2. Jeffrey Malkan, *What Is a Copy?*, 23 CARDOZO ARTS & ENT. L.J. 419, 437 (2005); Rachael Wallace, *Framing the Issue: Avoiding a Substantial Similarity Finding in Reproduced Visual Art*, 10 WASH. J.L. TECH. & ARTS 89, 90 (2014); Elisa Alcabes, Note, *Unauthorized Photographs of Theatrical Works: Do They Infringe the Copyright?*, 87 COLUM. L. REV. 1032, 1036–38 (1987). Other articles that focus on photographic originality mention the issue of photographic infringement. See, e.g., Bruce, *supra* note 1, at 121–36; L.T.C. Harms, *Copyright in Photographs: A South African Perspective*, 26 INTELL. PROP. J. 65, 65 (2013); Subotnik, *supra* note 1, at 1538–48. Several articles that consider infringement by visual works touch upon photographic infringement. See, e.g., Michael D. Murray, *Copyright, Originality, and the End of*

Consider the following: Photographer A takes a picture of the sunset over the Grand Canyon. Photographer B purchases a copy of that image and, inspired thereby, photocopies it for use in an advertisement. No court would hesitate to conclude that the second-comer has infringed on Photographer A's copyright. Slavishly reproducing a protected image is the meat and potatoes of photographic infringement cases.<sup>3</sup>

Now consider a variation. Photographer A takes a picture of the sunset over the Grand Canyon. Photographer B purchases a copy of that image and, inspired thereby, goes to the exact spot from which the first image was shot and takes a picture—one virtually indistinguishable from Photographer A's image. In such cases, courts are far more wary to declare the second-comer an infringer.<sup>4</sup>

But why? In both cases, Photographer B not only had access to and was inspired by the first photograph—he also produced an image that easily satisfies the infringement standard of substantial similarity.<sup>5</sup> One cannot begin to make sense of how courts treat such cases without first understanding the different ways in which the technology of photography can steal intellectual property, an issue that no court nor commentator has yet to explore in a systematic way.

Toward this end, Part II sets forth a taxonomy of photographic infringement.<sup>6</sup> Photographs can infringe in two different ways—by *replication* and by *imitation*. The overwhelming majority of photographic infringement occurs by replication,<sup>7</sup> instances in which, without permission, a photographer points a camera at a copyright-protected work—whether a sculpture, a painting, or another photograph—and takes a picture.

But a photograph can also infringe by imitation.<sup>8</sup> In such instances, the imitating photographer's camera is not aimed directly at a copyright-protected work. Rather, the plaintiff's claim is that the infringing photograph imitates the creative expression in her own photograph. With rare exception, virtually every case of photographic infringement by imitation involves one photograph's infringing on

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*the Scènes à Faire and Merger Doctrines for Visual Works*, 58 BAYLOR L. REV. 779, 787, 795–97 (2006).

3. See discussion *infra* Part II.B.1.

4. See discussion *infra* Part II.B.2.

5. The requirements for proving copyright infringement are actual copying (generally proven by access and probative similarity) and substantial similarity. See 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.01[B] (Matthew Bender & Co. ed. 2016); *infra* note 50 and accompanying text.

6. See discussion *infra* Part II.

7. See discussion *infra* Part II.B.1.

8. See discussion *infra* Part II.B.2.

another.<sup>9</sup> In fact, there are two subtypes of photographic infringement by imitation.

First, a plaintiff photographer takes a picture of some pre-existing object or scene in the public domain—e.g., a piece of driftwood, an apple tree, the Grand Canyon, Michelangelo's David. Inspired by that image, the imitating photographer snaps a photo of the very same object or scene and, in doing so, copies the plaintiff's camera-related choices that made the plaintiff's photograph original: angle of shot; timing of shot—e.g, time of day, atmospheric conditions; choice of camera, film, lenses, and filters; focus; use of special lighting and shading techniques, etc.<sup>10</sup> Hereinafter, this Article refers to such cases as infringement by "Imitation/Public Domain."

But infringement by imitation can occur in a second way. Prior to clicking the shutter button, a plaintiff photographer stages a tableau that she intends to photograph. For example, she poses someone for a portrait or assembles fruit on a table for a still life. She then shoots her picture. Inspired by that image, the imitating photographer attempts to restage the very tableau that appears in the plaintiff's image and then takes a picture.<sup>11</sup> This Article refers to such cases as infringement by "Imitation/Tableau."

Courts have little problem dealing with photographic infringement by replication. Irrespective of whether a plaintiff's protected work is a painting, a sculpture, or another photograph, if that work is readily recognizable in the defendant's unlicensed photograph, the plaintiff has an easy burden to prove the elements of copyright infringement—actual copying and substantial similarity.<sup>12</sup>

Courts are also adept at dealing with allegations of infringement by Imitation/Public Domain. In such cases, a plaintiff's claim cannot be based on the fact that the defendant pointed his camera at the same pre-existing object or scene that appears in the plaintiff's photograph. Copyright law could not be more clear: no

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9. A rare exception is a British case, *Turner v. Robinson*, 10 Irish Chancery 121 (1860), where a photographer slavishly re-staged the tableau depicted in a painting before shooting his picture. See *Gross v. Seligman*, 212 F. 930, 931 (2d Cir. 1914) (citing *Turner*, 10 Irish Chancery at 510 as "[a case] where indirect copying, through the use of living pictures, was held to be an infringement of copyright").

10. See, e.g., *Rogers v. Koons*, 960 F.2d 301, 307 (2d Cir. 1992) ("Elements of originality in a photograph may include posing the subjects, lighting, angle, selection of film and camera, evoking the desired expression, and almost any other variant involved."). The plaintiff photographer may also claim as original post-shutter manipulations made to her image in the darkroom or in Photoshop.

11. In so doing, the imitating photographer may also attempt to copy the first photographer's camera-related choices, most likely angle of shot. See discussion *infra* Part II.B.2.

12. See generally *NIMMER & NIMMER*, *supra* note 5; see also discussion *infra* note 50.

photographer can gain a monopoly over depicting a public domain object or scene.<sup>13</sup> Rather, the plaintiff's protected expression in her photograph is strictly limited to the camera-related choices utilized in taking her picture.<sup>14</sup>

In great contrast, courts have tremendous difficulty when confronted with allegations that one photograph has infringed on another by Imitation/Tableau.<sup>15</sup> In such cases, a plaintiff's protected expression is *not* limited to her camera-related choices. She can also claim protection over the staged scene that appears in her image. As one court explains, "if a photographer arranges or otherwise creates the subject that his camera captures, he may have the right to prevent others from producing works that depict that subject."<sup>16</sup>

Nonetheless, despite a photographer's rightful claim to copyright protection over a staged tableau, courts shy away from finding infringement in such cases *even when* the defendant concedes that he imitated the plaintiff's tableau. Commentators justify such timidity based on a concern that a photographer who has staged a mundane tableau might use infringement actions to harass downstream photographers who stage similar tableaux.<sup>17</sup>

To vindicate this concern, some courts look to the idea/expression dichotomy<sup>18</sup> and its sentinels, the merger<sup>19</sup> and *scènes*

13. See, e.g., *Tufenkian Imp./Exp. Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 135 (2d Cir. 2003) ("[C]opying is not unlawful if what was copied from the allegedly infringed work was not protected, for example, if the copied material had itself been taken from the public domain.").

14. See discussion *infra* Part II.B.2.a.

15. See cases cited *infra* at note 75.

16. *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444, 450 (S.D.N.Y. 2005).

17. Jane Ginsburg explains:

Of course, anyone is free to take her own photograph of the subject, but the more straightforward the initial photograph, the more likely is a second banal image to resemble it. Recognizing the authorship of a commonplace photograph thus may lead to *in terrorem* threats by the first photographer against genuine independent creators.

Jane Ginsberg, *The Concept of Authorship*, 52 DEPAUL L. REV. 1063, 1076–77 (2003).

18. In *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 350 (1991), the Supreme Court explained, "The most fundamental axiom of copyright law is that '[n]o author may copyright his ideas or the facts he narrates.'" Rather, "copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work. . . . This principle, known as the idea/expression . . . dichotomy, applies to all works of authorship." See *infra* note 112 and accompanying text.

19. The merger doctrine "refers to the situation in which there is only one feasible way of expressing an idea, so that if the expression were copyrightable it would mean that the idea was copyrightable, and ideas are not copyrightable." *Buckle v. Hawkins, Ash, Baptie & Co.*, 329 F.3d 923, 928 (7th Cir. 2003). Accordingly, if an idea can be expressed in only one way, then the expression of that idea is said to merge with the idea itself and the expression is not protected from copying. *Computer Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 707–08 (2d Cir. 1992). See *infra* note 118 and accompanying text.

*à faire*<sup>20</sup> doctrines. Courts rely on these doctrines to filter out from a plaintiff's photograph the elements of the staged tableau as unprotectable "ideas." Having done so, these courts then find no substantial similarity between the defendant's photograph and the meager protected expression remaining in the plaintiff's image.<sup>21</sup>

A notorious example is *Kaplan v. Stock Market Photo Agency*.<sup>22</sup> There, the defendant imitated the plaintiff's staged tableau of "a businessperson contemplating a leap from a tall building onto the bustling city street below" for use in an advertisement.<sup>23</sup> Not only did the defendant concede access to the plaintiff's image,<sup>24</sup> but a judge in a later case described the two photographs as "remarkably similar."<sup>25</sup> Nonetheless, the trial court excised as an unprotected "idea" the central features of the plaintiff's tableau—the "idea" of a businessman standing on a ledge contemplating suicide. Having stripped these features from the plaintiff's image, the court granted summary judgment to the defendant concluding that "nearly all the similarities between the works arise from non-copyrightable elements, thus rendering the works not substantially similar."<sup>26</sup>

Part III sets forth a plea against courts performing judicial surgery on photographs in the name of vindicating the idea/expression dichotomy. Utilizing that dichotomy to excise features from a photograph renders a nullity of an entire category of copyright-protected photographs—those for which the photographer staged the tableau. Moreover, dissecting a visual image into "ideas" and "expression" is an exercise in arbitrariness—there is no coherent way to separate out such aspects from a photograph.<sup>27</sup> In light of these concerns, some have argued that the distinction between idea

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20. See, e.g., Peter Lee, *The Evolution of Intellectual Infrastructure*, 83 WASH. L. REV. 39, 61 (2008) ("[T]he *scènes à faire* doctrine . . . relegates items to the public domain as they become stock and standard infrastructure. . . . [T]he doctrine generally excludes from copyright protection certain "incidents, characters or settings which are as a practical matter indispensable, or at least standard, in the treatment of a given topic."); *infra* note 122 and accompanying text.

21. See discussion *infra* Part III.B. Among cases that rely on these doctrines to filter out elements of the staged tableau as unprotectable ideas are *Bill Diodato Photography, LLC v. Kate Spade, LLC*, 388 F. Supp. 2d 382, 392 (S.D.N.Y. 2005); *Gentieu v. Tony Stone Images/Chicago, Inc.*, 255 F. Supp. 2d 838, 850–51 (N.D. Ill. 2003); and *Kaplan v. Stock Market Photo Agency, Inc.*, 133 F. Supp. 2d 317, 323 (S.D.N.Y. 2001).

22. *Kaplan*, 133 F. Supp. 2d at 317.

23. *Id.* at 318.

24. *Id.* at 320 n.4.

25. *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444, 456 (S.D.N.Y. 2005).

26. *Kaplan*, 133 F. Supp. 2d at 323.

27. See *infra* note 172 and accompanying text.



and expression simply cannot be applied to a work of visual art.<sup>28</sup> For example, in *Mannion v. Coors Brewing* the court concluded that “[i]n the context of photography, the idea/expression distinction is not useful or relevant.”<sup>29</sup> Unfortunately, that conclusion is not viable given the Supreme Court’s insistence that “the idea/expression or fact/expression dichotomy applies to all works of authorship. . . .”<sup>30</sup>

Part IV argues that the problem inherent in cases like *Kaplan* is not that the idea/expression dichotomy cannot be applied to photography. Rather, it is that courts locate an image’s idea in the wrong place. A photograph’s idea is not to be found on its face. Rather, that idea exists in the mind of the photographer; it is the mental vision she hopes to capture in taking a picture.<sup>31</sup> If she shares that vision with another photographer, the latter is free to try his hand at embodying that idea in a photograph with no fear of copyright infringement. However, once a photographer uses a camera to fix her mental vision in a tangible form, the resulting photograph is *expression—entirely* expression.<sup>32</sup> There is no “idea” for a court to excise from the image. Accordingly, the idea/expression dichotomy can provide no justification for a court’s chopping up a photograph into protected and unprotected pieces.

Part V explores an alternative approach for shielding downstream photographers from harassing infringement actions, one that relies on the doctrine of *thin* copyright protection. That doctrine holds that when a plaintiff’s work is “highly unoriginal, uncreative, or made up primarily of unprotectable material,”<sup>33</sup> then that work is protected “against only virtually identical copying.”<sup>34</sup> Though this doctrine has been applied to photography,<sup>35</sup> no court nor commentator has yet to articulate a coherent way to determine when and why certain photographs should be entitled only to thin protection.

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28. See, e.g., Bruce, *supra* note 1, at 127 (applying the fact/expression dichotomy to photographs is inevitably fraught with difficulty); Murray, *supra* note 2, at 848 (concluding that the idea/expression-related merger and *scènes à faire* doctrines cannot be applied in a meaningful way to visual art).

29. *Mannion*, 377 F. Supp. 2d at 461.

30. *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 350 (1991).

31. This insight is grounded in the Supreme Court’s decision in *Burrow-Giles Lithographic Co. v. Saroni*, 111 U.S. 53, 58, 60 (1884), in which the court established the parameters for photographic originality.

32. Assuming that the photograph satisfies *Feist*’s “minimal creativity” standard, it is subject to copyright protection. See *Feist*, 499 U.S. at 345.

33. Shyamkrishna Balganes, *The Normativity of Copying in Copyright Law*, 62 DUKE L. J. 203, 223 (2012).

34. *Ets-Hokin v. Skyy Spirits, Inc.*, 323 F.3d 763, 766 (9th Cir. 2003).

35. See *id.*; cf. *SHL Imaging, Inc. v. Artisan House, Inc.*, 117 F. Supp. 2d 301, 311 (S.D.N.Y. 2000) (applying, in effect, the thin copyright doctrine without using that term, concluding that the plaintiff’s photograph is entitled to protection only from “verbatim copying”).

Toward that end, this Article proposes the “silver platter principle”: If the camera-related choices and actions that a photographer utilizes in snapping a picture have been largely dictated by previous creative choices and actions of others or by industry conventions, then the photographer’s resulting image is entitled only to thin copyright protection against slavish replication.

In contrast to the misconceived application of the idea/expression dichotomy to photographs, the silver platter principle should provide better protection for downstream photographers. Moreover, it leads to a better understanding of why some photographs, albeit beautiful in appearance, are nonetheless entitled only to thin copyright protection.

## II. A TAXONOMY OF PHOTOGRAPHIC INFRINGEMENT

Any discussion of copyright infringement must begin with *Feist v. Rural Telephone*,<sup>36</sup> where the Supreme Court stated: “To establish infringement, two elements must be proven: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.”<sup>37</sup> Given that the vast majority of cases of alleged photographic infringement involve one photograph’s infringing on another, this Article first explores the “constituent elements” of a copyright-protected photograph that make it original. It then turns to photographic infringement—what it means for a pirating photograph to “copy” such original elements.<sup>38</sup>

### A. What Makes a Photograph Original?

In *Feist*, the Supreme Court set forth two criteria for originality: “[T]he work [must have been] independently created by the author (as opposed to copied from other works), and . . . it [must] possess[] at least some minimal degree of creativity.”<sup>39</sup> How does a photograph satisfy these criteria?

In a recent article,<sup>40</sup> I looked to art theory’s concept of *depiction* to shed light on that question. To depict an object is to represent the object visually, to give meaning to the object through a picture.<sup>41</sup> As a

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36. *Feist*, 499 U.S. 340.

37. *Id.* at 361.

38. One court notes that “[t]he term ‘copying’ is really shorthand for the infringement of any of the copyright owner’s exclusive rights outlined in 17 U.S.C. § 106.” See *Tiffany Design, Inc. v. Reno-Tahoe Specialty, Inc.*, 55 F. Supp. 2d 1113, 1118 (D. Nev. 1999).

39. *Feist*, 499 U.S. at 345.

40. See Kogan, *supra* note 1.

41. *Id.* at 874.

depiction, a photograph has what Richard Wollheim described as “two folds.”<sup>42</sup> The first fold consists of the design markings on the surface of the photographic paper. The second fold consists of the object or scene that a viewer perceives in those design markings. For purposes of establishing originality under *Feist*, “in the realm of the graphic arts—painting, etching, photography, etc.—the requisite minimal creativity is based primarily on an artist’s choices and actions that result in design markings being placed on the surface of the work, the first fold of depiction.”<sup>43</sup>

Thus, a painting’s originality inheres primarily in the painter’s choices that result in brushstrokes being arrayed on the canvas’ surface. Similarly, a photograph’s originality inheres primarily in the photographer’s choices that result in design markings being arrayed on the surface of the photographic paper (or pixels on a computer screen).<sup>44</sup>

In the realm of photography, such choices are camera-related. They include a photographer’s choice of: a camera, film, lenses, and filters; angle of shot; aperture setting (*f*-stop); shutter speed; focus; ISO setting; use of special lighting and shading techniques; timing of shot—e.g, time of day, atmospheric conditions, and moment at which to depress the shutter button.<sup>45</sup>

The object or scene that a viewer perceives in the picture—the second fold of depiction—impacts photographic originality in two instances.<sup>46</sup> If a photographer first stages the tableau that she photographs, the choices associated with that staging will enhance the degree of creativity she infuses into her image.<sup>47</sup> The court in *Mannion* explains:

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42. *Id.* at 875 (discussing RICHARD WOLLHEIM, *Seeing-As, Seeing-In, and Pictorial Representation*, ART AND ITS OBJECTS 205, 213–14 (2d ed. 1980)).

43. *Id.* at 875–76.

44. *Id.* at 876.

45. *Id.* at 909 n.187. A photographer’s post-camera choices are also protected, e.g., special darkroom manipulations—dodging, burning, or masking—or computer manipulations such as “Photoshopping.”

46. *Id.* at 911. One goal of my Article was to attack the claim of some legal scholars that a photograph is inherently factual and thereby entitled to little copyright protection. Asserting that, for originality purposes, a photograph is a “fact” locates originality in the wrong place—in the object or scene that a viewer perceives in the image—rather than in the choices and actions of the photographer in placing design marks on the image’s surface. *Id.* at 873–74.

47. In *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444, 452 (S.D.N.Y. 2005), the court identified three ways in which a photograph can be original: rendition, timing, and creating the scene. In my scheme, rendition choices and timing fall within the choices related to the first fold of depiction because they impact the placement of design marking on the picture’s surface. In contrast, “creating the scene” is what I refer to as “staging the tableau.”

It sometimes is said that “copyright in the photograph conveys no rights over the subject matter conveyed in the photograph.” But this is not always true. It of course is correct that the photographer of a building or tree or other pre-existing object has no right to prevent others from photographing the same thing. . . . By contrast, if a photographer arranges or otherwise creates the subject that his camera captures, he may have the right to prevent others from producing works that depict that subject.<sup>48</sup>

If, however, a photographer slavishly copies another work, the resulting photograph will run afoul of *Feist*'s non-copying criterion and thus will not be original, irrespective of how creative her rendition choices and actions in taking the picture.<sup>49</sup>

### *B. Two Types of Photographic Infringement*

For a photograph to infringe on a copyright-protected photograph, the pirating image must copy those elements of the protected photograph that make it original, generally the camera-related choices utilized by the first photographer. In instances in which that photographer also staged the picture's tableau, the pirating photographer can also infringe by copying that tableau.

Proving that a photograph infringes is no different from proving that any other type of work is infringing: “To establish [copying, a] plaintiff must show that (1) defendants actually copied his work and (2) the copying is illegal because there is a substantial similarity between the [defendant's photograph] and the protectible elements of plaintiff's photographs.”<sup>50</sup>

But a photograph can also infringe on a protected work other than a photograph. If an unlicensed photograph depicts a copyright-protected sculpture, painting, or etching, it may also be infringing. Accordingly, understanding photographic infringement mandates that we carefully distinguish the different ways that the technology of

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48. *Id.* at 450.

49. *Id.* at 451. As an example of such slavish copying, I pointed to the work of appropriation artist Sherrie Levine, who re-photographed the images of depression-era photographer Walker Evans, onto which she signed her own name. See Kogan, *supra* note 1, at 876.

50. *Andersson v. Sony Corp.*, No. 96 CIV. 7975(RO), 1997 WL 226310, at \*2 (S.D.N.Y. May 2, 1997) (citing *Fisher-Price, Inc. v. Well-Made Toy Mfg. Corp.*, 25 F.3d 119, 122–23 (2d Cir. 1994)). With respect to actual copying, “[i]t is generally not possible to establish copying as a factual matter by direct evidence, as it is rare that the plaintiff has available a witness to the physical act of copying.” See *NIMMER & NIMMER, supra* note 5, §13.01[B]. Accordingly, a plaintiff is allowed to prove such copying by showing that the defendant had access to his work and that the defendant's contested work is probatively similar to the plaintiff's work. *Id.* The test for substantial similarity adopted by the majority of courts is “whether an average lay observer would ‘recognize the alleged copy as having been appropriated from the copyrighted work.’” *Kisch v. Ammirati & Puris, Inc.*, 657 F. Supp. 380, 382 (S.D.N.Y. 1987) (quoting *Am. Greetings Corp. v. Easter Unlimited, Inc.*, 579 F. Supp. 607, 614 (S.D.N.Y. 1983)).

photography can infringe across different genres. This Article proposes that there are two broad categories of photographic infringement: infringement by *replication* and infringement by *imitation*. It further breaks down infringement by imitation into two subtypes: infringement by Imitation/Public Domain and infringement by Imitation/Tableau.

### 1. Photographic Infringement by Replication

When a photographer points her camera directly at a copyright-protected work—whether a sculpture, a painting, or another photograph—and takes a picture without permission, the photographer infringes on that work by *replication*.<sup>51</sup> The photograph *replicates* that work in the following sense: it visually reproduces whatever makes the depicted work original and thereby copyright protected. If the protected work is a two-dimensional photograph, painting, or etching, in most instances the replicating photo will capture the entirety of the work. Where the underlying work is a three-dimensional sculpture, obviously a two-dimensional photograph can reproduce only one perspective of that work. Nonetheless, so long as the protected sculpture is recognizable in the photograph, the photograph will have captured visual aspects of that work that make it original.<sup>52</sup>

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51. See 17 U.S.C. § 106(1) (2012). I have purposely not used the term “infringement by reproduction” because a photograph can infringe by replication on a copyright holder’s derivative works right under 17 U.S.C. § 106(2). See *infra* note 66 and accompanying text (explaining infringement by replication). In such cases, a plaintiff often alleges infringement of both the reproduction right and the derivative works right. See, e.g., *Tiffany Design, Inc. v. Reno-Tahoe Specialty, Inc.*, 55 F. Supp. 2d 1113, 1119 (D. Nev. 1999).

52. Few courts have tried to articulate what features of a sculpture make it original. An important exception is *F.W. Woolworth Co. v. Contemporary Arts, Inc.*, 193 F.2d 162 (1st Cir. 1951). In that case, the plaintiff alleged that the defendant sold ceramic models of a cocker spaniel that were copied directly from her own sculptural work entitled “Cocker Spaniel in Show Position.” *Id.* at 163. In upholding the trial court’s finding of infringement, the appellate court ventured into the realm of what makes a sculptural work original. *Id.* at 164. The court first quoted from Justice Holmes in *Bleistein*: “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. That something he may copyright. . . .” *Id.* (quoting *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903)).

The court then articulated what makes a sculpture original for purposes of copyright law:

Here the ‘something irreducible’ which was ‘Jan Allen’s’ alone was certainly not a matter of subject, nor was it a matter of size or material, nor even of color, for it is well known that cocker spaniels are typically of several colors. Her ‘something irreducible’ was shape. This does not mean stance, for show position in a dog is a standardized, stylized position which anyone is free to reproduce. *It means the proportion, form, contour, configuration, and conformation, perhaps the latter in details too subtle for appreciation by anyone but a fancier, of the dog represented by the sculptured work of art.*

Applying the two-part test for illicit copying to determine photographic infringement by replication proves to be an easy task for courts. If the protected work is recognizable in the pirating photographer's image, a plaintiff has an easy time proving that the photographer *actually copied* his work. Moreover, when applying the test for substantial similarity<sup>53</sup> adopted by many courts to an unlicensed photograph that depicts a copyright-protected work, it is likely that "an average lay observer would 'recognize the alleged copy as having been appropriated from the copyrighted work.'"<sup>54</sup>

Infringement by replication is at the heart of the vast majority of photographic infringement cases.<sup>55</sup> One of the earliest such cases,

*Id.* (emphasis added).

53. The very viability of the substantial similarity test has recently been challenged by legal commentators. *See, e.g.,* Shyamkrishna Balganes, Irna D. Manta & Tess Wilkinson-Ryan, *Judging Similarity*, 100 IOWA L. REV. 267, 275 (2014) ("In practice . . . the substantial similarity analysis remains a virtual black box."); Tushnet, *supra* note 1, at 716–17 ("The substantial similarity test is notoriously confusing and confused, perplexing students and courts alike.").

54. *Kisch*, 657 F. Supp. at 382 (quoting *Am. Greetings Corp. v. Easter Unlimited, Inc.*, 579 F. Supp. 607, 614 (S.D.N.Y. 1983)).

55. Cases involving allegations of one photograph's infringing by replication on another include: *Schrock v. Learning Curve International, Inc.*, 586 F.3d 513, 515 (7th Cir. 2009) (defendant continued to use plaintiff's photographs in advertising after defendant's license agreement with plaintiff had expired); *Greenberg v. National Geographic Society*, 244 F.3d 1267, 1274 (11th Cir. 2001) (defendant's use of plaintiff's photographs on its website infringed on plaintiff's right to prepare derivative works); *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1072 (9th Cir. 2000) (plaintiff alleged that defendant copied his photographs of vodka bottle without permission); *Morris v. Young*, 925 F. Supp. 2d 1078, 1083–84 (C.D. Cal. 2013) (defendant found to have infringed in downloading plaintiff's photographs from the internet and manipulating them into new photographic artworks); *LaChapelle v. Fenty*, 812 F. Supp. 2d 434, 445 (S.D.N.Y. 2011) (actual copying of plaintiff's photographs for use on storyboards); *Custom Dynamics, LLC v. Radiantz LED Lighting, Inc.*, 535 F. Supp. 2d 542, 548 (E.D.N.C. 2010) (defendant copied photographs of motorcycle parts from plaintiff's website); *Fragrancenet.com, Inc. v. Fragrancex.com, Inc.*, 679 F. Supp. 2d 312, 320 (E.D.N.Y. 2010) (defendant slavishly copied 900 product photographs from the plaintiff's website); *Gener-Villar v. Adcom Group*, 560 F. Supp. 2d 112, 133 (D.P.R. 2008) (defendant's continued use of plaintiff's photographs after its license expired constituted direct and willful infringement); *McClatchey v. Associated Press*, No. 3:05-cv-145, 2007 WL 776103, at \*4 (W.D. Pa. Mar. 9, 2007) (defendant distributed digital copies of plaintiff's copyright-protected photograph on the internet); *Schiffer Publishing Ltd. v. Chronicle Books, LLC*, No. Civ.A. 03–4962, 2004 WL 2583817, at \*1 (E.D. Pa. Nov. 12, 2004) (defendant used copies of photographs that were in plaintiff's book/protected by copyright); *Eastern American Trio Products, Inc. v. Tang Electronic Corp.*, 97 F. Supp. 2d 395, 399 (S.D.N.Y. 2000) (defendant allegedly copied photographs from plaintiff's sales catalog); *SHL Imaging, Inc. v. Artisan House, Inc.*, 117 F. Supp. 2d 301, 318 (S.D.N.Y. 2000) (defendant's use of plaintiff's photographs in several publications went beyond the scope of the original agreement between the parties); *Tiffany Design*, 55 F. Supp. 2d at 1120 (defendant scanned plaintiff's photos and digitally altered them); *Gerig v. Krause Publications, Inc.*, 58 F. Supp. 2d 1261, 1268 (D. Kan. 1999) (plaintiff has stated a claim for infringement based on defendant's continued use of plaintiff's photographs after expiration of licensing agreement); *Playboy Enterprises v. Russ Hardenburgh, Inc.*, 982 F. Supp. 503, 513 (N.D. Ohio 1997) (court found infringement based on exact reproductions of plaintiff's photographs being available on defendant's BBS); *Epic Metals Corp. v. Condec, Inc.*, 867 F. Supp. 1009, 1012 (M.D. Fla. 1994) (defendant copied photographs from plaintiff's promotional brochure); *Curtis v. General Dynamics Corp.*, No. C89–566S, 1990

*Rossiter v. Hall*,<sup>56</sup> captures the intuition that a replicating photograph is perhaps the most obvious example of illicit copying. In that case, the defendant photographed and sold copies of plaintiff's engraving without permission. Responding to the defendant's contention that the copyright statute did not apply to photography, the court noted:

Section seven provides, that any person who shall engrave, etch or work, sell or copy the engraving, shall be an offender. The word "copy" is a general term, added to the more specific terms before used, for the very purpose of covering methods of reproduction not included in the words "engrave, etch or work," and, *if it covers anything, should cover the photographic method, which, more nearly than any other, produces a perfect copy.*<sup>57</sup>

In most cases in which a plaintiff alleges that the defendant's photograph has infringed by replication, the defendant rarely denies copying, given the futility of such a defense. Instead, the defendant asserts that the plaintiff's photograph is unoriginal and lacks copyright protection. Beginning with the seminal 1884 case, *Burrow-Giles v. Sarony*,<sup>58</sup> courts have rejected this defense and concluded that, because "[a]lmost any photograph 'may claim the necessary originality to support a copyright,'"<sup>59</sup> a slavish copy of another photograph is infringing.

In cases alleging that one photograph has infringed on another, courts have little difficulty finding infringement by replication. For example, in *Curtis v. General Dynamics*,<sup>60</sup> the defendant photocopied the plaintiff's photograph of a wheelchair on a farmhouse porch for use in a comprehensive from which an advertisement was developed. In holding the defendant liable for infringement, the court had no problem finding actual copying:

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WL 302725, at \*10 (W.D. Wash. Sept. 26, 1990) (defendant photocopied plaintiff's photographs for an ad comprehensive); *Simon v. Birraporetti's Restaurants, Inc.*, 720 F. Supp. 85, 86 (S.D. Tex. 1989) (plaintiff alleged that the defendant copied plaintiff's poster); *Jewelers' Circular Publishing Co. v. Keystone Publishing Co.*, 274 F. 932, 936 (S.D.N.Y. 1921) (defendant used copies/cuts of plaintiff's photographs (from plaintiff's jewelry trade book) in defendant's own jewelry trade book); and *Pagano v. Chas. Beseler Co.*, 234 F. 963, 963 (S.D.N.Y. 1916) (defendant slavishly re-photographed plaintiff's images of the New York Public Library).

56. *Rossiter v. Hall*, 20 F. Cas. 1253 (E.D.N.Y. 1866) (No. 12,082).

57. *Id.* at 1254 (emphasis added).

58. 111 U.S. 53 (1884). In that case, using a chromo-lithographic process, the defendant reproduced the plaintiff's photograph of Oscar Wilde and sold 85,000 copies. *Burrow-Giles* did not deny copying and selling the unauthorized reproductions. Rather it defended by arguing that the Constitution did not permit Congress to extend copyright protection to photographs. In rejecting that defense, the Supreme Court located the photograph's originality in Sarony's pre-shutter camera-related choices and in his posing the celebrity. *Id.* at 60.

59. *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444, 450 (S.D.N.Y. 2005).

60. 1990 WL 302725, at \*8.

[Defendant] testified that he made an unauthorized and unlicensed identical copy using a photostat machine of the [plaintiff's] wheelchair photograph . . . . There is no question that this direct copying . . . was a copyright infringement . . . . [T]here is no fact issue as to copying. The cropped version of the photocopies of Curtis' wheelchair photograph . . . was used in the comprehensive.<sup>61</sup>

The court also had no trouble finding substantial similarity:

There is no issue as to substantial similarity: the image is identical to the central image of the Curtis photograph. That such copying and use of images directly from a magazine are copyright infringements as well is established in this circuit.<sup>62</sup>

Even when a defendant photographer points her camera at a copyright-protected work other than another photograph, courts have little difficulty finding infringement by replication. An early such case, *Bracken v. Rosenthal*,<sup>63</sup> involved the defendant's photographing the plaintiff's sculpture without permission. The court concluded: "To hold that a piece of statuary may be infringed by a [photograph] of the statuary seems in every way in accord with the reason and spirit of the law . . ." <sup>64</sup> Moreover, photographic infringement by replication is not limited to works of visual art. In *Horgan v. Macmillan*, the Court of Appeals for the Second Circuit determined that unauthorized still photographs taken of a ballet performance of *The Nutcracker* could be found to infringe on Ballanchine's choreography.<sup>65</sup>

61. *Id.*

62. *Id.*

63. 151 F. 136 (Cir. Ct., N.D. Ill. 1907).

64. *Id.* at 137. The court explained:

The question is not whether the photograph contains artistic elements of its own but whether it also contains any of the artistic ideas and conceptions expressed in the statuary. It is clear that the infringer of a copyrighted book cannot escape liability by mixing original matter of his own with the matter pirated, and it should be equally clear that a photographer of a piece of copyrighted statuary cannot say that because his picture contains some of his own talent he is any the less an infringer of the ideas he has taken from the statuary.

*Id.* A more contemporary case involving allegations of a photograph's infringing by replication on a sculptural work is *Mattel, Inc. v. Walking Mountain Productions*, 353 F.3d 792 (9th Cir. 2003). In that case, the plaintiff alleged that the defendant infringed by taking photographs of Barbie Dolls, "which he depicted . . . in various absurd and often sexualized positions." *Id.* at 796. Though finding that plaintiff established a prima facie case of infringement, the court upheld the lower court's determination that the plaintiff's photographs were shielded by the fair use doctrine.

65. 789 F.2d 157 (2d Cir. 1986). In *Horgan*, the appellate court remanded the case a determination of whether the defendant's still photographs were substantially similar to the choreographed dance. The court suggested how a still photograph might so infringe:

Moreover, the district judge took a far too limited view of the extent to which choreographic material may be conveyed in the medium of still photography. A snapshot of a single moment in a dance sequence may communicate a great deal. It may, for example, capture a gesture, the composition of dancers' bodies or the placement of dancers on the stage. . . . A photograph may also convey to the viewer's imagination the moments before and after the split second recorded. . . . In [one of defendants'] photograph[s], the Sugar Canes are a foot or more off the ground, holding large hoops above their heads. One member of the ensemble is jumping through a



Finally, infringement by replication can take place when, having copied the plaintiff's image, a photographer manipulates that image to create a derivative work. Such manipulation might include cropping; rotating or flipping the image; painting over the image; darkroom manipulations such as dodging, burning, and masking; or digital manipulations in Photoshop. A clear example is *Morris v. Young*,<sup>66</sup> where the plaintiff published two books of photographs of the band the Sex Pistols. Having downloaded several of plaintiff's pictures from the Internet, the defendant altered them to create his own photographic artwork.<sup>67</sup> The plaintiff sued, alleging that the defendant "engaged in copyright infringement by making, distributing, and selling derivative works from the Subject Photograph."<sup>68</sup> Determining that "the undisputed evidence shows that [defendant] copied the Subject Photograph," the court found that the defendant infringed on the plaintiff's copyright.<sup>69</sup>

There is, however, an outside limit to infringement by replication through the creation of derivative works. If the original aspects of the plaintiff's artwork are no longer recognizable in the defendant's manipulated photograph, infringement will not occur. In *Tiffany Design, Inc. v. Reno-Tahoe Specialty, Inc.*,<sup>70</sup> the defendant first copied plaintiff's photographs of Las Vegas and then manipulated them in Photoshop to create postcards. Though the court found the intermediate copying to be infringing, the court remanded the case for consideration of the "key issue," "whether Defendant's modification of things such as lighting, perspective, and shading were significant enough to render its use of the scanned images *de minimis* or unrecognizable in nature."<sup>71</sup>

In sum, photographic infringement by replication involves a photographer's aiming a camera directly at a copyright-protected work without permission and snapping a picture. Determining whether or not infringement has occurred in such cases rarely proves difficult for courts.

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hoop, which is held extended in front of the dancer. The dancer's legs are thrust forward, parallel to the stage and several feet off the ground. The viewer understands instinctively, based simply on the laws of gravity, that the Sugar Canes jumped up from the floor only a moment earlier, and came down shortly after the photographed moment. The single instance thus communicates far more than a single chord of a Beethoven symphony. . . .

*Id.* at 163.

66. 925 F. Supp. 2d 1078, 1080 (C.D. Cal. 2013).

67. *Id.* at 1081.

68. *Id.* at 1082.

69. *Id.* at 1084.

70. 55 F. Supp. 2d 1113, 1116 (D. Nev. 1999).

71. *Id.* at 1122.

## 2. Photographic Infringement by Imitation — Two Subtypes

But a photographer need not point a camera directly at a copyright-protected work to infringe. He can also infringe by *imitation*, which can occur in two different ways. Virtually every case of infringement by imitation involves the defendant's contested photograph infringing on another photograph.<sup>72</sup>

First, a plaintiff photographer takes a picture of some public domain object or scene—the sunset over the Grand Canyon, the Statue of Liberty, a tree in Central Park, a piece of driftwood. Inspired by that image, the defendant takes a picture of the very same object or scene and, in doing so, imitates the plaintiff's camera-related choices that undergird her picture's originality.<sup>73</sup> I refer to such cases as photographic infringement by Imitation/Public Domain.<sup>74</sup>

Second, prior to taking her picture, a plaintiff photographer stages the tableau to be photographed. For example, she poses someone for a portrait or assembles fruit on a table for a still life. Then she clicks the shutter. Inspired by that image, the pirating photographer attempts to copy the plaintiff's staged tableau before shooting his own picture. This Article refers to such cases as infringement by Imitation/Tableau.<sup>75</sup>

72. *But see* discussion of *Turner v. Robinson*, 10 Irish Chancery 121 (1860), *infra* note 98.

73. *See* Kogan, *supra* note 1, at 909 n.187.

74. Cases involving allegations of photographic infringement by Imitation/Public Domain include: *Harney v. Sony Pictures Television, Inc.*, 704 F.3d 173 (1st Cir. 2013); *Leigh v. Warner Bros., Inc.*, 212 F.3d 1210 (11th Cir. 2000); *Masterson Marketing, Inc. v. KSL Recreation Corp.*, 495 F. Supp. 2d 1044, 1048 (S.D. Cal. 2007); *Psihoyos v. National Geographic Society*, 409 F. Supp. 2d 268 (S.D.N.Y. 2005) (plaintiff alleged that defendant copied/used similar perspective, lighting, layout, and color(s) to plaintiff's photograph); *Sahuc v. Tucker*, 300 F. Supp. 2d 461 (E.D. La. 2004); *Caratzas v. Time Life, Inc.*, No. 92 Civ. 6346, 1992 WL 322033 (S.D.N.Y. Oct. 23, 1992).

75. Cases involving allegations of photographic infringement by Imitation/Tableau include: *Leibovitz v. Paramount Pictures Corp.*, 137 F.3d 109 (2d Cir. 1998) (alleged copying of posing and appearance of person in the tableau for plaintiff's photograph); *Gordon v. McGinley*, 99 U.S.P.Q.2d 1846 (S.D.N.Y. 2011) (alleged copying of plaintiff's staged tableaux of various people and events); *Cabell v. Sony Pictures Entertainment, Inc.*, 714 F. Supp. 2d 452 (S.D.N.Y. 2010) (alleged copying of tableau used in movie poster depicting a hairdresser using a hair dryer as a gun); *Straus v. DVC Worldwide, Inc.*, 484 F. Supp. 2d 620 (S.D. Tex. 2007) (alleged copying of the posing of Arnold Palmer from plaintiff's photographs); *Bryant v. Gordon*, 483 F. Supp. 2d 605 (N.D. Ill. 2007) (alleged imitating of the posing in plaintiff's photographs of Army Ranger sniper team); *Bill Diodato Photography, LLC v. Kate Spade, LLC*, 388 F. Supp. 2d 382 (S.D.N.Y. 2005) (alleged copying of the staging of plaintiff's photographs depicting a model's feet under a toilet stall door); *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444 (S.D.N.Y. 2005) (alleged imitating plaintiff's staged tableau of a basketball player adorned with bling bling); *Gentieu v. Tony Stone Images/Chicago, Inc.*, 255 F. Supp. 2d 838 (N.D. Ill. 2003) (alleged copying of plaintiff's staged tableau of babies); *Fournier v. Erikson*, 202 F. Supp. 2d 290 (S.D.N.Y. 2002) (alleged copying of plaintiff's staging of a businessman in casual dress walking down a street); *Kaplan v. Stock Market Photo*, 133 F. Supp. 2d 317 (S.D.N.Y. 2001) (alleged copying of staged

*a. Photographic Infringement by Imitation/Public Domain*

In instances in which a photographer points her camera at a pre-existing public domain object or scene, the law is abundantly clear: because copyright protection “extend[s] only to those components of a work that are original to the author,” “[l]iability cannot rest on use of the public domain elements alone.”<sup>76</sup> In *Harney v. Sony Pictures*,<sup>77</sup> the court explained why:

Where the photographer is uninvolved in creating his subject, that subject matter—whether a person, a building, a landscape or something else—is equivalent to an idea that the law insists be freely available to everyone. [citing *Feist*] [S]ubject matter that the photographer did not create could be viewed as “facts” that, like ideas, are not entitled to copyright protection. . . . A photograph that consists of public-domain subject matter may thus be protected from copying because it involves creative expression, but with the protection limited to the work’s original elements.<sup>78</sup>

Accordingly, in instances in which a plaintiff alleges infringement of a photograph depicting a public domain object or scene, the plaintiff must prove that the defendant photographer copied her creative camera-related choices—not merely her choice of an object or scene to depict.

Courts have a relatively easy time applying these principles to allegations of infringement by Imitation/Public Domain. In *Sahuc v.*

tableau of businessman on a ledge contemplating suicide); *Pampered Chef v. Magic Kitchen*, 12 F. Supp. 2d 785 (N.D. Ill. 1998) (alleged imitating of staging of kitchen equipment in plaintiff’s photographs for a kitchen catalog); *Andersson v. Sony Corp.*, No. 96 CIV. 7975(RO), 1997 WL 226310 (S.D.N.Y. May 2, 1997) (alleged imitating plaintiff posing of a woman lying on grass); *Sharpshooters Inc. v. Retirement Living Publishing Co.*, 932 F. Supp. 286 (S.D. Fla. 1996) (alleged imitating plaintiff’s photograph of elderly couple in retirement home); *Wallace Computer Services, Inc., v. Adams Business Forms, Inc.*, 837 F. Supp. 1413 (N.D. Ill. 1993) (alleged imitating the staged tableau that plaintiff used in photographs on covers of telephone message books); *Kisch v. Ammirati & Puris, Inc.*, 657 F. Supp. 380 (S.D.N.Y. 1987) (alleged imitating staged tableau in a NYC café); *International Biotical Corp. v. Associated Mills, Inc.*, 239 F. Supp. 511 (1964) (alleged imitating of plaintiff’s product photographs of an electric massage device); *Gross v. Seligman*, 212 F. 930 (S.D.N.Y. 1914) (alleged imitating of tableau of classical photograph of nude woman).

76. See NIMMER & NIMMER, *supra* note 5, at § 13:03[B][2][b](1999); see also *Tufenkian Imp./Exp. Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 135 (2d Cir. 2003) (“[C]opying is not unlawful if what was copied from the allegedly infringed work was not protected, for example, if the copied material had itself been taken from the public domain.”).

The subject matter of a photograph of a public object or scene, *i.e.* the object or scene actually being photographed, is not of itself copyrightable. A photographer cannot obtain an exclusive copyright in the subject matter of a particular photograph if that subject matter is public property, *e.g.*, the Washington Monument or a natural object such as Squaw Peak and the lawn of the Arizona Biltmore Resort.

*Masterson Marketing, Inc. v. KSL Recreation Corp.*, 495 F. Supp. 2d 1044, 1048 (S.D. Cal. 2007).

77. 704 F.3d 173.

78. *Id.* at 181.

*Tucker*,<sup>79</sup> the plaintiff, a well-known professional photographer, took a photograph in New Orleans of “Jackson Square with the St. Louis Cathedral shrouded in a foggy mist.” The court noted, “Indeed, this is a popular scene commonly photographed by tourists and local residents alike.”<sup>80</sup> Admitting to having seen the plaintiff’s image, the defendant also took a photograph of Jackson Square in the fog. The court found no infringement:

Actionable copying does not take place where a “photographer takes a picture of the subject matter depicted in the copyrighted photograph, so long as the second photograph does not copy original aspects of the copyrighted work, such as lighting or placement of the subject.” . . . Sahuc’s copyright . . . does not protect the appearance of Jackson Square, St. Louis Cathedral . . . or any part of the setting in the photograph from being used in the work of others.<sup>81</sup>

Considering only the plaintiff’s camera-related choices, the court did “not find these works to be ‘substantially similar’” because “it is obvious that the light and the placement of the subject are not copied.”<sup>82</sup>

*Caratzas v. Time Life, Inc.*<sup>83</sup> is another example of alleged infringement by Imitation/Public Domain. In that case, the plaintiff published two books of photographs of the ruins of Pompeii. Thereafter, defendant Time Life published a book about Pompeii for a series on lost civilizations. The plaintiff alleged that “thirty-three images used by the defendant in [its book] infringe upon the copyright in [plaintiff’s book] because these images ‘were reshot photographs of images appearing in [plaintiff’s book] substantially containing the same information.’”<sup>84</sup> In other words, the plaintiff claimed that the defendant infringed by pointing his camera at the same objects that the plaintiff had photographed. The court rejected that claim:

[N]o photographer may obtain the exclusive copyright in images of a particular public object. Thus, for example, one may photograph the Statue of Liberty without fear of infringing the copyright in an earlier photograph . . . even if both photographs are taken from the same angle with the same lighting and, consequently, appear substantially similar. Plaintiffs’ claim amounts to no more than a complaint that the defendant included in its work photographs of historic sites also pictured in [the plaintiff’s book].<sup>85</sup>

But cases of infringement by Imitation/Public Domain may involve more dynamic settings than *in situ* public buildings and

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79. 300 F. Supp. 2d 461 (E.D. La. 2004).

80. *Id.* at 463.

81. *Id.* at 465, 465 n.5.

82. *Id.*

83. No. 92 Civ. 6346 (PKL), 1992 WL 322033, at \*1 (S.D.N.Y. Oct. 23, 1992).

84. *Id.* at \*3.

85. *Id.* at \*4.

ancient ruins. In *Harney v. Sony Pictures*,<sup>86</sup> the plaintiff news photographer took a picture of a man leaving a church with his daughter on his shoulders. As it turned out, the man appearing in the image became the subject of a Federal Bureau of Investigation manhunt, and the plaintiff's photograph was used (with permission) on a wanted poster.<sup>87</sup>

In retelling the story for television, Sony Pictures recreated the FBI wanted poster, using a photograph similar to the plaintiff's image and the plaintiff sued. The Court of Appeals for the First Circuit affirmed the lower court's finding of no infringement, noting that "neither the subject matter of the earlier work nor its arrangement are attributable to the photographer."<sup>88</sup> The court found no substantial similarity between the defendant's photograph and the protectable aspects of the plaintiff's photograph—his camera-related choices.<sup>89</sup>

In cases involving allegations of infringement by Imitation/Public Domain, one might assume that courts never find infringement based solely on the plaintiff's camera-related choices. In fact, that is not the case. In *Leigh v. Warner Bros., Inc.*<sup>90</sup> the plaintiff photographer created the iconic photograph of the Bird Girl statue that appeared on the cover of the best-selling novel *Midnight in the Garden of Good and Evil*. In conjunction with a film version of that novel, Warner Brothers also used images of that statue in its promotional material and in the movie. The plaintiff sued alleging both copyright and trademark infringement.

The court first clarified the limits of the plaintiff's copyright interest in his photograph:

Leigh's copyright does not cover the appearance of the statue itself or of Bonaventure Cemetery, for Leigh has no rights in the statue or its setting. . . . Nor does the copyright protect the association of the statue with the *Midnight* story. Leigh may have been the first to think of the statue as evocative of the novel's mood and as an appropriate symbol of the book's themes, but copyright law protects only original expression, not ideas.<sup>91</sup>

The court then noted that the trial court "correctly identified the elements of artistic craft protected by Leigh's copyright as the selection of lighting, shading, timing, angle, and film."<sup>92</sup> The court

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86. 704 F.3d 173 (1st Cir. 2013).

87. *Id.* at 176–77.

88. *Id.* at 182.

89. *Id.* at 188.

90. 212 F.3d 1210 (11th Cir. 2000).

91. *Id.* at 1214 (citing *NIMMER & NIMMER*, *supra* note 5, at § 13:03[B] (1999), for the proposition that the "appearance of objects in the public domain or as they occur in nature is not protected by copyright").

92. *Id.* at 1215.

upheld the trial court's finding of no substantial similarity between the depictions of the Bird Girl statue in defendant's film and the limited protected aspects of the plaintiff's photograph.<sup>93</sup>

In shifting its attention to the defendant's promotional photographs, however, the court refused to conclude as a matter of law that there was no infringement. It found that, though there were "undeniably, significant differences between the pictures, . . . the Warner Brothers images also have much in common with the elements protected by Leigh's copyright."<sup>94</sup> In so concluding, the court noted that "[a]ll of the photographs are taken from a low position, angled up slightly at the Bird Girl so that the contents of the bowls in her hands remain hidden."<sup>95</sup> Based on a review of such similarities between the litigants' photographs, the court refused to grant summary judgment to the defendant.<sup>96</sup>

There is a curious conundrum that underlies such cases. Though the plaintiff has no protectable interest in the depicted public domain subject matter, unless the defendant's camera is pointed at the very same subject matter, a claim of infringement is a non-starter because the litigants' pictures must be substantially similar for a plaintiff to prove misappropriation. Nonetheless, what a pirating defendant misappropriates is not the plaintiff's decision to point her camera at a particular public domain object or scene, but rather her camera-related choices in taking her picture, perhaps most importantly, the angle of shot.

In sum, in determining whether a plaintiff has proven allegations of infringement by Imitation/Public Domain, courts are adept at focusing on the plaintiff's protected camera-related choices and not the public domain subject matter that appears in her photograph.

*b. Photographic Infringement by Imitation / Tableaux*

Photographic infringement by imitation can occur in a second way. Prior to taking her picture, a plaintiff photographer stages a tableau to be photographed. Inspired by the plaintiff's picture, the pirating photographer imitates that staged tableau and then shoots his own picture. Because copyright protection extends to the creative expression embodied in the plaintiff's staged tableau,<sup>97</sup> in such cases

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93. *Id.*

94. *Id.* at 1216.

95. *Id.*

96. *Id.*

97. *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444, 450 (S.D.N.Y. 2005).

the defendant will have infringed by Imitation/Tableau.<sup>98</sup> The extent of infringement is increased if the second-comer *also* attempts to replicate the plaintiff's camera-related choices.

The simplest cases involving such infringement are instances in which the defendant slavishly imitated the plaintiff's staged tableau. An early example is *Falk v. Brett Lithographing Co.*,<sup>99</sup> where the plaintiff took a photograph of a mother and child "after arranging them in good positions according to his judgment, and after the child had put its finger in her mouth, which he thought improved the position, and took advantage of, as photographers usually take photographs."<sup>100</sup> The defendant "copied the position, features, and most of the photograph by reversing it, and changing some minor details."<sup>101</sup>

The court rejected the defendant's assertion that the photograph was not copyright protected because the plaintiff was not an "author." Looking to the plaintiff's staging the tableau and to his camera-related choices, the court concluded: "[E]nough was done here by placing the persons in position, and using the position assumed by the child at the proper time to produce this photograph. . . . He is, and

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98. Virtually every case of infringement by Imitation/Tableau involves one photograph's infringing on another. The one rare instance of such infringement not involving two photographs is the British case, *Turner v. Robinson*, 10 Irish Chancery 121 (1860). In *Turner*, the plaintiff owned the copyright in a painting that was exhibited at the Royal Academy in Dublin. The Royal Academy's regulations prohibited photographing pictures appearing in any exhibition. In addition, at the outset of the exhibition the plaintiff published the following advertisement in a local newspaper:

CAUTION TO PHOTOGRAPHERS

Mr. Turner hereby intimates to Photographic Artists and others, that proceedings at law will be immediately instituted against anyone infringing upon his copyrights, by means of Photography or otherwise.

Because the defendant was not permitted to photograph the painting while visiting the exhibition, upon returning to his studio he staged live models and scenery to imitate the painting. He then took stereoscopic photographs of that tableau which he sold. *Id.* at 125. The plaintiff alleged that "the pictures sold by [Robinson] were piratical imitations and copies of the subject of the said picture. . . ." *Id.* The defendant "admitted that he had visited the picture during its exhibition in Dublin, and had arranged the figure and scenery from his recollection of the attitude and arrangements in the painting, with a view of presenting a stereoscopic photograph of the same subject. . . ." *Id.* at 126. In upholding the injunction against the defendant, the Lord Chancellor observed:

Mr. Robinson did not pretend to say that he did not take the idea of that scene, which he arranged in his own house, from the picture; on the contrary he admits that he did so. . . . I feel fully warranted in concluding that Mr. Robinson must have known that he had no right to make those photographs and that he cannot be permitted to use for profit what he has thus taken without the permission of the possessor of the picture.

*Id.*

99. 48 F. 678 (S.D.N.Y. 1891).

100. *Id.* at 679.

101. *Id.*

no one else can be, the author of this.”<sup>102</sup> The court found the defendant to have infringed, in effect by Imitation/Tableau: “The defendants have not merely copied the woman and child, as they might have done with their consent, but they have used the plaintiffs production as a guide for making others, and have thereby substantially copied it as he produced it and infringed upon his exclusive right of copying it.”<sup>103</sup>

But courts have also found such infringement in instances in which the tableau imitated by the defendant is substantially similar to, but not a slavish imitation of, the plaintiff’s staged tableau.<sup>104</sup> A case in point is *Curtis v. General Dynamics*.<sup>105</sup> Before shooting a picture, the plaintiff photographer staged a tableau involving a wheelchair on the back porch of his home.<sup>106</sup> Directed to create a photograph to honor President Franklin Roosevelt, the defendant went to the President’s Hyde Park home and used the President’s actual wheelchair to stage a photograph. In so doing, he admitted to looking at the plaintiff’s photograph. Despite having been shot in an entirely different location, nonetheless the court found that the defendant’s photograph too closely imitated the plaintiff’s staged

102. *Id.*

103. *Id.* Another well-known case involving slavish copying of a tableau is *Gross v. Seligman*, 212 F. 930 (2d Cir. 1914). In that case, a photographer staged a classical tableau involving a nude model. He sold both the photograph and its copyright to the plaintiff. Two years later, the photographer imitated the staged tableau of his earlier work using the same model in an identical pose in a virtually identical setting. *Id.* at 931. When the plaintiff sued, the court had no difficulty concluding that the defendant’s later photograph infringed on the earlier not only by imitating the staged tableau but also by copying the camera-related choices utilized in taking the first picture. The court explained:

The identity of the artist and the many close identities of pose, light, and shade, etc., indicate very strongly that the first picture was used to produce the second. Whether the model in the second case was posed, and light and shade, etc., arranged with a copy of the first photograph physically present before the artist’s eyes, or whether his mental reproduction of the exact combination he had already once effected was so clear and vivid that he did not need the physical reproduction of it, seems to us immaterial. The one thing, viz., the exercise of artistic talent, which made the first photographic picture a subject of copyright, has been used not to produce another picture, but to duplicate the original.

*Id.*

104. In *LaChappelle v. Fenty*, 812 F. Supp. 2d 434, 441–42 (S.D.N.Y. 2011), the court noted the possibility of infringement by Imitation/Tableau in instances not involving slavish copying of the tableau:

[T]he Second Circuit has recognized that “the defendant may infringe on the plaintiff’s work not only through literal copying of a portion of it, but also by parroting properties that are apparent only when numerous aesthetic decisions embodied in the plaintiff’s work . . . are considered in relation to one another.”

105. *Curtis v. Gen. Dynamics Corp.*, No. C89–566S, 1990 WL 302725, at \*8 (W.D. Wash. Sept. 26, 1990).

106. *Id.* at \*1 (“[T]he wheelchair was moved to obtain a dramatic photograph where the balustrade of the porch and the relationships of the upright porch posts created a perspective view which draws the viewer’s eye to the central image of the empty wheelchair.”).



tableau and thereby infringed.<sup>107</sup> It found substantial similarity because the defendant's "image is identical to the central image of the [plaintiff's] photograph."<sup>108</sup> Finding that "the visual impact of the defendant's photograph of the Roosevelt wheelchair at Hyde Park leaves no conclusion other than one of obvious copying," the court explained:

Here, of the fifty-seven photographs taken by [defendant], the core of the images are simply representative of the efforts of the photographer . . . to move the wheelchair into the juxtaposition where the identical elements of expression found in the [plaintiff's] photograph are copied exactly.<sup>109</sup>

*Curtis v. General Dynamics* is a rare case in which, despite the absence of slavish copying, a court nonetheless found infringement based on the defendant's imitating the plaintiff's staged tableau. In light of the critique set forth in Part III below of other cases that deal with staged tableaux, it is important to point out what the *Curtis* court did *not* do in finding infringement. It did *not* look to the idea/expression dichotomy to excise the rocking chair or the porch from the photograph as merely the "idea" or "subject matter" of the plaintiff's image. It did *not* excise those central features of the tableau as *scènes à faire*—"unprotectable elements or themes that flow predictably from the underlying subject matter."<sup>110</sup> Finally, the court did *not* employ the merger doctrine to declare plaintiff's photograph unprotectable based on the argument that "[a]ll aspects of [plaintiff's] particular expression follow necessarily from the idea of taking a [rocking chair on a porch] photograph."<sup>111</sup> Rather, the court kept plaintiff's photograph intact in determining that the defendant's image was substantially similar to it.

Unfortunately, in many cases involving allegations of photographic infringement by Imitation/Tableau, the court performs judicial surgery on the plaintiff's image, excising the central features

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107. *Id.* at \*5:

Each of the photographs taken on the sun porch of Roosevelt's Hyde Park home, to one degree or another, reflect an effort to place the Roosevelt wheelchair in the same juxtaposition to the balustrade, and with the same compositional or structural elements of expression as are found in Curtis' wheelchair photograph. Each of the structural elements for expressing the ideas of the Curtis photograph are present in the photograph of the Roosevelt wheelchair selected by defendants for the wheelchair advertisement. The extent of the similarities between the Curtis wheelchair image and Reuben photograph selected by defendants for the wheelchair advertisement is shown by the fact that even a number of important proportional measurements are virtually identical for the two photographs.

108. *Id.* at \*9.

109. *Id.*

110. Kaplan v. Stock Mkt. Photo Agency, Inc., 133 F. Supp. 2d 317, 324 (S.D.N.Y. 2001).

111. See *Gentieu v. Tony Stone Images/Chicago, Inc.*, 255 F. Supp. 2d 838, 850 (N.D. Ill. 2003) ("All aspects of [plaintiff's] particular expression follow necessarily from the idea of taking a baby photograph.").

of the staged tableau before considering whether the defendant infringed. These cases are considered in Part III below.

### III. A PLEA AGAINST COURTS' PERFORMING JUDICIAL SURGERY ON PHOTOGRAPHS

A central thesis of this Article is that, in considering allegations of photographic infringement by Imitation/Tableau, it is improper for courts to utilize the idea/expression dichotomy and related doctrines to excise the staged tableau from a plaintiff's photograph before considering whether the defendant has infringed. In so doing, courts render a nullity of an entire category of copyright-protected photographs—those in which the plaintiff staged a tableau before snapping her picture. I begin by introducing the idea/expression dichotomy and its sentinels, the merger and *scènes à faire* doctrines.

#### A. *The Idea/Expression Dichotomy and its Sentinels, the Merger and Scènes à Faire Doctrines*

Copyright law protects only expression, not ideas or facts. In *Feist*, the Supreme Court explained, “The most fundamental axiom of copyright law is that “[n]o author may copyright his ideas or the facts he narrates.”<sup>112</sup> Facts are not copyrightable because “the *sine qua non* of copyright is originality,” and “[n]o one may claim originality as to facts.”<sup>113</sup> Rather, ideas and facts “may not be copyrighted and are part of the public domain available to every person.”<sup>114</sup> In setting forth this fundamental principle, *Feist* acknowledged the centrality of the idea/expression dichotomy:

[C]opyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work. . . . This principle, known as the idea/expression or fact/expression dichotomy, applies to all works of authorship.<sup>115</sup>

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

113. *Id.* at 347.

114. *Id.* at 348. Paul Goldstein points out that “[t]he idea-expression distinction embodies one of the few universal truths about copyright, and is a feature of every developed copyright system in the world.” I GOLDSTEIN ON COPYRIGHT § 2.3 (3d ed. 2015).

115. *Feist*, 499 U.S. at 344–45, 350. This principle is embodied in the Copyright Act of 1976, 17 U.S.C.A. § 102(b) (Westlaw through Pub. L. No. 114–254): “In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”

Accordingly, a later author is free to copy the ideas or facts that appear in a copyright-protected work, but not the author's unique expression of those ideas or facts.<sup>116</sup> Articulating a clear test to distinguish a work's ideas from its expression has remained elusive.<sup>117</sup>

Two doctrines have emerged to assist in drawing this line—merger and *scènes à faire*. These doctrines mandate, albeit in different ways, that prior to determining whether a defendant's work infringes, a court must filter out aspects of the plaintiff's otherwise protected work that fall within the rubric of "idea" or "fact." Infringement can occur only with respect to those aspects of the work deemed protected expression.

The merger doctrine "refers to the situation in which there is only one feasible way of expressing an idea, so that if the expression were copyrightable it would mean that the idea was copyrightable, and ideas are not copyrightable."<sup>118</sup> If an idea can be expressed in only one way,<sup>119</sup> then the expression of that idea is said to merge with the idea itself.<sup>120</sup> Courts justify the merger doctrine as necessary to "prevent an author from monopolizing an idea merely by copyrighting a few expressions of it."<sup>121</sup> Accordingly, if the merger doctrine applies, a downstream author is free to copy the *expression* in an earlier author's work.

The *scènes à faire* doctrine also polices the idea/expression dichotomy by withholding protection from stock or standard literary devices.<sup>122</sup> As one court explains, "[A] copyright owner can't prove infringement by pointing to features of his work that are found in the defendant's work as well but that are so rudimentary, commonplace,

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116. *Feist*, 499 U.S. at 349 (quoting Jane Ginsburg, *Creation and Commercial Value: Copyright Protection of Works of Information*, 90 COLUM. L. REV. 1865, 1868 (1990) ("[N]o matter how much original authorship the work displays, the facts and ideas it exposes are free for the taking . . . . [T]he very same facts and ideas may be divorced from the context imposed by the author, and restated or reshuffled by second comers, even if the author was the first to discover the facts or to propose the ideas.")).

117. See, e.g., *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444, 457–58 (S.D.N.Y. 2005).

118. *Bucklew v. Hawkins, Ash, Baptie & Co.*, 329 F.3d 923, 928 (7th Cir. 2003).

119. Some courts apply the doctrine even if there are only a limited number of ways to express an idea. See, e.g., Douglas Lichtman, *Copyright as a Rule of Evidence*, 52 DUKE L.J. 683, 735 (2003) ("The merger doctrine supplements this basic distinction between idea and expression. It states that copyright protection will be denied in instances where there are only a few ways to express a given idea.").

120. See, e.g., *Comput. Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 707–08 (2d Cir. 1992); *Concrete Mach. Co. v. Classic Lawn Ornaments, Inc.*, 843 F.2d 600, 606 (1st Cir. 1988).

121. *Toro Co. v. R & R Prods. Co.*, 787 F.2d 1208, 1212 (8th Cir. 1986).

122. The doctrine's name is borrowed from the French. See *Schwarz v. Universal Pictures Co.*, 85 F. Supp. 270, 275 (S.D. Cal. 1945) ("The French use a very expressive phrase in dramatic literature: '*scènes à faire*' that is, scenes which 'must' be done.").

standard, or unavoidable that they do not serve to distinguish one work within a class of works from another.”<sup>123</sup> The *scènes à faire* doctrine is justified based on the fact that “it is virtually impossible to write about a particular historical era or fictional theme without employing certain ‘stock’ or standard literary devices.”<sup>124</sup> Rather, such “stock themes and conventions belong in the public domain.”<sup>125</sup>

Courts utilize these doctrines in two different ways.<sup>126</sup> Some courts conclude that, if either doctrine applies to a work, that work is not copyrightable.<sup>127</sup> Other courts view the doctrines merely as a bar to a plaintiff’s infringement claim.<sup>128</sup> In the latter case, when either the merger or the *scènes à faire* doctrine applies to a plaintiff’s otherwise protected work, courts excise unprotectable elements from that work before determining whether the defendant has misappropriated the remaining protected expression.<sup>129</sup>

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123. *Bucklew*, 329 F.3d at 929. The court elaborated:

Every expressive work can be decomposed into elements not themselves copyrightable—the cars in a car chase, the kiss in a love scene, the dive bombers in a movie about Pearl Harbor, or for that matter the letters of the alphabet in any written work. The presence of such elements obviously does not forfeit copyright protection of the work as a whole, but infringement cannot be found on the basis of such elements alone; it is the combination of elements, or particular novel twists given to them, that supply the minimal originality required for copyright protection.

*Id.*

[T]he *scènes à faire* doctrine . . . relegates items to the public domain as they become stock and standard infrastructure. . . . [T]he doctrine generally excludes from copyright protection certain “incidents, characters or settings which are as a practical matter indispensable, or at least standard, in the treatment of a given topic.”

Peter Lee, *The Evolution of Intellectual Infrastructure*, 83 WASH. L. REV. 39, 61 (2008).

124. *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 979 (2d Cir. 1980).

125. *Subotnik*, *supra* note 1, at 1543.

126. *See* Andrew B. Hebl, *A Heavy Burden: Proper Application of Copyright’s Merger and Scènes à Faire Doctrines*, 8 WAKE FOREST INTELL. PROP. L.J. 129 (2007) (analyzing the treatment of these doctrines across the circuits).

127. *See, e.g., Oriental Art Printing v. Goldstar Printing Corp.*, 175 F. Supp. 2d 542, 546, 547 n.3 (S.D.N.Y. 2001) (holding that “this is the rare case where the photographs contained in plaintiffs’ work lack the creative or expressive elements that would render them original works subject to protection under the Copyright Act”); *Schrock v. Learning Curve Int’l, Inc.*, 586 F.3d 513, 522 n.5 (7th Cir. 2009) (defendant arguing that the plaintiff’s photos fell “within the *scènes à faire* or merger doctrines and therefore [were] not copyrightable”). William Patry has criticized applying these doctrines to determine copyrightability. *See* 2 PATRY ON COPYRIGHT § 4:24 (2016).

128. *See, e.g., 4 NIMMER & NIMMER, supra* note 5, at § 13.03[B][3][e] (“It is not always clear whether the merger doctrine is deemed a bar to copyright protection itself, rather than simply a defense to the charge of infringement via substantial similarity. . . . [T]he better view construes it as the latter, evaluating the inseparability of idea and expression in the context of a particular dispute, rather than attempting to disqualify certain expressions from protection *per se*. . . . [T]he [*scènes à faire*] doctrine does not limit the subject matter of copyright; instead, it defines the contours of infringing conduct.”).

129. *Id.* at § 13.03[B][4].

*B. Applying the Idea/Expression Dichotomy and Related Doctrines to Photography*

Commentators have expressed concern that, when it comes to photographs of commonplace objects and scenes, the potential arises for one photographer to harass downstream photographers. Eva Subotnik explains: “One argument sometimes proffered against protecting photographs of common scenes or mundane items is that the copyright holder will then be in a position to harass others who independently photograph similar subjects. . . .”<sup>130</sup> She suggests that, “[g]iven the highly representational nature of photography, the notion that the average snapshot in front of the Statue of Liberty might theoretically infringe a similar photograph seen elsewhere by the snap-shooter would not be an ideal copyright policy.”<sup>131</sup>

To police this concern, Subotnik approves of applying the idea/expression dichotomy and the related merger and *scènes à faire* doctrines to photography:

At their core, the ideal/expression, merger, and *scènes à faire* doctrines are useful tools in assessing the scope of protection to which an earlier photograph is entitled. . . . [G]iven the likely similarity between two photographs of the same subject matter, reliance on these doctrines is essential to ensuring . . . that successive photographers are free to try their hands at similar material.<sup>132</sup>

This concern cannot be lightly dismissed. Two photographs of the same public domain object or scene have a reasonable likelihood of appearing similar, even substantially similar, irrespective of whether or not the downstream photographer actually copied the earlier photographer’s image.<sup>133</sup> Nonetheless, utilizing the idea/expression

130. Subotnik, *supra* note 1, at 1538–39.

131. *Id.* at 1539. This argument grows out of a debate over whether photographs that depict pre-existing works should be considered derivative works, discussed in *Schrock*, 586 F.3d at 513. Looking to an earlier Seventh Circuit case, *Gracen v. Bradford Exchange*, 698 F.2d 300 (7th Cir. 1983), *Schrock* explains:

The concern expressed in *Gracen* was that a derivative work could be so similar in appearance to the underlying work that in a subsequent infringement suit brought by a derivative author, it would be difficult to separate the original elements of expression in the derivative and underlying works in order to determine whether one derivative work infringed another. The opinion offered the example of artists A and B who both painted their versions of the Mona Lisa, a painting in the public domain. . . . “[I]f the difference between the original and A’s reproduction is slight, the difference between A’s and B’s reproductions will also be slight, so that if B had access to A’s reproductions the trier of fact will be hard-pressed to decide whether B was copying A or copying the Mona Lisa itself.”

*Schrock*, 586 F.3d at 521. In reliance on this argument, the defendant in *Schrock* insisted that, as a derivative work, a photograph should be subject to a higher level of originality. While admitting that *Gracen’s* “concern is valid,” the *Schrock* court concluded that “the originality requirement for derivative works is not more demanding than the originality requirement for other works.” *Id.* at 521.

132. Subotnik, *supra* note 1, at 1547.

133. See, e.g., *Ty Inc. v. GMA Accessories, Inc.*, 132 F.3d 1167, 1170 (7th Cir. 1997).

dichotomy and the merger and *scènes à faire* doctrines to police this concern discounts an entire category of copyright-protected photographs—those in which the photographer staged the tableau. To demonstrate this, this Article examines two cases, *Kaplan v. Stock Photo Agency, Inc.*<sup>134</sup> and *Bill Diodato Photography v. Kate Spade*.<sup>135</sup>

In *Kaplan*, the court was faced with “two photographs . . . which depict a frequently portrayed metropolitan scene: a businessperson contemplating a leap from a tall building onto the bustling city street below.”<sup>136</sup> Plaintiff Peter Kaplan was a professional photographer whose image, “Wing Tips Over the Edge,” was published in an annual compilation of photographs.<sup>137</sup> Defendant Stock Market Photo Agency represented the defendant photographer, Bruno Benvenuto, with respect to licensing rights in his photograph. The plaintiff alleged that Bevenuto’s “photograph ‘closely imitates,’ and thereby ‘infringes the copyright’” in his own image.<sup>138</sup>

Kaplan’s copyright in his photo was unchallenged.<sup>139</sup> Moreover, the defendant conceded access to that image.<sup>140</sup> The only issue before the court was misappropriation—whether the defendant’s photograph was substantially similar to the plaintiff’s image. Though not reproduced in *Kaplan*, the two pictures are appended to the *Mannion* case,<sup>141</sup> where Judge Lewis Kaplan described the photographs as “remarkably similar.”<sup>142</sup>

Before examining the court’s justification for granting summary judgment to the defendants, consider the plaintiff’s most compelling argument in favor of the court’s finding infringement in light of the taxonomy set forth in Part II. The most important aspect of the plaintiff’s protected expression is the staged tableau—placing a man dressed in a business suit and winged-tipped shoes on a

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[T]wo works may be strikingly similar—may in fact be identical—not because one is copied from the other but because both are copies of the same thing in the public domain. In such a case—imagine two people photographing Niagara Falls from the same place at the same time of the day and year and in identical weather—there is no inference of access to anything but the public domain, and, equally, no inference of copying from a copyrighted work.

*Id.*

134. *Kaplan v. Stock Mkt. Photo Agency, Inc.*, 133 F. Supp. 2d 317, 320 (S.D.N.Y. 2001).

135. *Bill Diodato Photography, LLC v. Kate Spade, LLC*, 388 F. Supp. 2d 383, 384 (S.D.N.Y. 2005).

136. *Kaplan*, 133 F. Supp. 2d at 318.

137. *Id.* at 319.

138. *Id.* at 320.

139. *Id.* at 321.

140. *See id.* at 320 n.4 (“Because defendants have conceded (or at least assumed) access to Kaplan’s photograph, this factual disagreement is not material for the purposes of the instant motions.”); *see also id.* at 321 n.9 (“For purposes of the instant motions, The Stock Market and Benvenuto have conceded that they had access to Kaplan’s photograph. . . .”).

141. *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444, 464–68 (S.D.N.Y. 2005).

142. *Id.* at 456.

building's ledge overlooking a busy street. The plaintiff also has a protected interest in his camera-related choices in photographing that tableau, most importantly in the angle of shot looking down from the businessman's perspective over his shoes to the street below, dotted with cars and pedestrians. The plaintiff admittedly has no claim of protection with respect to the model or his clothing depicted in the picture, the building's ledge on which the model stands, or the street below with its cars and people. All of these are public domain objects or scenes. Rather, it is the *configuration* of all of these unprotected elements that constitute the staged tableau, and it is that configuration that copyright law protects.<sup>143</sup> Justin Hughes, perhaps the greatest legal skeptic of photographic originality,<sup>144</sup> readily accepts that:

creating the scene or subject captured in the photograph, should be the first category of originality in a photograph because it occurs before any photographic processes and is independent of any decisions concerning photographic equipment. Also . . . composing and posing can form a significant basis for copyright.<sup>145</sup>

Unfortunately, the *Kaplan* court saw it otherwise, ignoring the plaintiff's creative expression in the staged tableau. The court's first step in the wrong direction began when it made the seemingly unobjectionable statement, "It is a fundamental principal of copyright law that a copyright does not protect an idea or concept but only the expression of that idea or concept."<sup>146</sup> Applying that precept to photography, the court set forth the doctrinal rule that would govern the remainder of the opinion:

With regard to photographs . . . a copyright derives from "the photographer's original conception of his subject, *not the subject itself*." . . . Protectable elements 'may include posing the subjects, lighting, angle, selection of film and camera, [and] evoking the desired expression,' along with other variants.<sup>147</sup>

Were the plaintiff to have alleged infringement by Imitation/Public Domain, this doctrinal statement would be correct. No one can claim a monopoly over depicting public domain objects or scenes, the "subject" of such photographs. But given that this case involves allegations of infringement by Imitation/Tableau, this

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143. In a sense, every visual work is a configuration of unprotected elements. For example, a painting is composed by the artist configuring color chemical pigments on a blank canvas—colored pigments that are in the public domain and available for use by any artist. Moreover, no artist can claim copyright protection in having chosen to paint on canvas, wood, or any other substance. Protected expression arises only after these unprotected elements have been creatively configured.

144. See Justin Hughes, *The Photographer's Copyright—Photograph as Art, Photograph as Database*, 25 HARV. J.L. & TECH. 339, 374 (2012) ("[A] large percentage of the world's photographs are likely not protected by American copyright law because the images lack even a modicum of creativity.").

145. *Id.* at 402.

146. *Kaplan v. Stock Mkt. Photo Agency, Inc.*, 133 F. Supp. 2d 317, 322 (S.D.N.Y. 2001).

147. *Id.* at 323 (emphasis added).

statement is simply wrong. The plaintiff *does* have a protected claim over the “subject” perceived in the image—certain objects configured in relation to a background, all of which constitute the staged tableau.<sup>148</sup>

Nonetheless, the *Kaplan* court relied on the above-quoted doctrinal statement as license to excise from consideration under the rubric of “subject matter” the plaintiff’s staged tableau:

Turning to the two photographs in the instant case, the Court finds that nearly all the similarities between the works arise from noncopyrightable elements, thus rendering the works not substantially similar. The *subject matter* of both photographs is a businessperson contemplating a leap from a tall building onto the city street below. As the photograph’s central idea, rather than Kaplan’s expression of the idea, this subject matter is unprotectable in and of itself.<sup>149</sup>

By equating the photograph’s “subject matter” to its unprotected “central idea,” the court invokes the idea/expression dichotomy. In so doing, this sleight of hand virtually assures that a court will *never* recognize a photograph’s staged tableau—its “subject matter”—as protected expression.

The court then turns to the *scènes à faire* doctrine to further justify filtering out the staged tableau:

Moreover, as the situation of a leap from a tall building is standard in the treatment of the topic of the exasperated businessperson in today’s fast-paced work environment, especially in New York, the subject matter of the photographs is also rendered unprotectable by the doctrine of *scènes à faire*. . . . Kaplan . . . has chosen to express a businessperson’s frustration with the world by portraying him at the top of a building; his contemplation of a leap from the edge of that building is the necessary sequence of events that follows from the chosen setting.<sup>150</sup>

There is nothing “standard” nor “necessary” about the plaintiff’s staging. Given the plaintiff’s mental vision—his “idea”—that he sought to embody in a photograph, there were innumerable ways he could have arranged the tableau.<sup>151</sup> The court then turns to the merger doctrine (without naming it as such) to further support its reasoning:

Both photographs depict him standing on the roof or ledge of a tall building, with his shoes partially extended over the edge. However, such positioning is essential to the businessperson’s contemplation of a suicide leap; it would be impossible to depict the photograph’s subject matter without portraying him in this pose.<sup>152</sup>

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148. He also has a protected claim over the camera-related choices utilized to depict that tableau.

149. *Kaplan*, 133 F. Supp. 2d at 323 (emphasis added).

150. *Id.*

151. I will argue in Part IV below that a photograph’s “idea” is the mental vision that the photographer seeks to embody in his vision *before* he clicks the shutter. The photograph that results is expression, entirely expression.

152. *Kaplan*, 133 F. Supp. 2d at 324. Elsewhere, the court also invokes the merger doctrine:



As to the impossibility of depicting the photograph's subject matter in any other way, a simple search in Google Images of "businessperson contemplating suicide" brings up many different photographs, *not one of which* depicts a man looking down over his shoes to the street below. As the *Mannion* court suggests, the *Kaplan* court stacked the deck in favor of invoking the *scènes à faire* doctrine by narrowly describing the image's subject matter as "a businessperson contemplating a leap from a tall building onto the city street below."<sup>153</sup>

The court's designating certain objects or aspects of the scene that appear in the plaintiff's photograph as the image's "subject matter" is sheer judicial fiat. Why is the subject matter of the plaintiff's photograph suicide in the first place? Why is that subject matter not better described as a study of vertigo, in which case a court should have excised from consideration as *scènes à faire* the miniscule cars and people seen on a street far below—leaving as protected expression a businessman on a ledge contemplating his feet?

Having removed the heart of the photograph—the staged tableau—from consideration, the court shifts its attention to the plaintiff's camera-related choices—elements that "courts have traditionally highlighted as protectable."<sup>154</sup> Addressing the fact that "both photographs are taken from a similar angle or viewpoint, namely, that of the businessperson looking down at the street below,"<sup>155</sup> the court has little difficulty finding "substantial differences" between the images:

[T]he photographs are taken from different locations, depicting different building, roads and vehicles. . . . An examination of the photographs' background, perspective, lighting, shading, and color, which courts have traditionally highlighted as protectable elements . . . supports the Court's conclusion [to grant summary judgment to the defendants].<sup>156</sup>

Beginning from the wrongheaded premise that a court can excise objects that appear in a photograph as unprotected "ideas" or "subject matter," the *Kaplan* decision effectively renders a nullity of

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[I]n order to most accurately express the idea of a businessperson's contemplation of a leap, the photograph must be taken from the "jumper's" own viewpoint. . . . Thus, the angle and viewpoint used in both photographs are essential to, commonly associated with, and naturally flow from the photograph's unprotectable subject matter.

*Id.* at 326. Again, the notion that there is only one "angle and viewpoint" from which to stage a photograph meant to depict a person about to commit suicide by jumping from a building is groundless.

153. See *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444, 456 (S.D.N.Y. 2005),

154. *Kaplan*, 133 F. Supp. 2d at 326.

155. *Id.*

156. *Id.*

an entire category of protected photographs, those in which the photographer has staged the tableau.

*Diodato v. Kate Spade*<sup>157</sup> also involved allegations of photographic infringement by Imitation/Tableau. The plaintiff, a fashion accessory photographer, took a picture through the bottom of a bathroom stall revealing “a woman’s feet, astride a toilet, in stylish, colorful shoes, her underwear hanging above her ankles, and a handbag resting on the floor.”<sup>158</sup> He submitted the photograph to the defendant for an ad campaign. The defendant, however, hired a different photographer who took a similar photograph “of a woman’s feet, astride a toilet, in stylish, colorful shoes, with a handbag on the floor.”<sup>159</sup> The plaintiff sued for copyright infringement.

Let us again step back and consider what the plaintiff can claim as copyright protected in his photograph. As was true in *Kaplan*, the most important aspect of Diodato’s creative expression is the staged tableau. With respect to that tableau, he admittedly has no copyright protection with respect to: the model; the toilet; the toilet stall; or the model’s clothes, shoes, and handbag. He does, however, have a protected interest in the staged tableau—the way that he has configured all of these features in relation to one another.

The judge in *Diodato* later admitted that “[t]he two photos were remarkably similar.”<sup>160</sup> Nonetheless he granted the defendant’s motion for summary judgment “[e]ven assuming there was copying. . . .”<sup>161</sup> Following a path parallel to that taken in *Kaplan*, the court began with the premise that, “[e]ven assuming the two photographs share substantial similarities, there is no infringement unless protectable elements were copied.<sup>162</sup> It then proceeded to “distinguish between the protectable and unprotectable elements” of the plaintiff’s image:<sup>163</sup>

To the extent that aspects of the [plaintiff’s] Photograph are derived from the idea of the photograph, or naturally flow from that idea, they are not protectable. As a result, the vast majority of elements in the [plaintiff’s] Photograph that are similar to those in the [defendant’s] Photograph are not protectable. The idea in the [plaintiff’s] Photograph is the depiction of a woman’s feet as she sits on the toilet, used as a striking device to highlight fashion accessories.<sup>164</sup>

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157. Bill Diodato Photography, LLC v. Kate Spade, LLC, 388 F. Supp. 2d 383, 384 (S.D.N.Y. 2005).

158. *Id.*

159. *Id.*

160. Hon. Denny Chin, *Litigating Copyright Cases: A View from the Bench*, 59 J. COPYRIGHT SOC’Y U.S.A. 185, 189 (Winter, 2012).

161. *Diodato*, 388 F. Supp. 2d at 384.

162. *Id.* at 392.

163. *Id.*

164. *Id.* The court pays particular attention to how the plaintiff posed the woman’s feet in his photograph, noting that “in cases involving photographs, a ‘plaintiff’s copyrights cannot

The response to this assertion should now be obvious: “[A] woman’s feet as she sits on the toilet” is not an unprotected idea. Rather it is the heart of the configured tableau that is protected by copyright law. Nonetheless, based on the faulty claim as to the image’s “idea,” the court excised from consideration all features of that staged tableau.<sup>165</sup>

Like *Kaplan*, the court then turned to the *scènes à faire* doctrine to support its ignoring the tableau: “Under the doctrine of *scènes à faire*, elements of an image that flow naturally and necessarily from the choice of a given concept cannot be claimed as original.”<sup>166</sup> Relying on this doctrine, the court not only declared element by element of the tableau unprotectable, but also found several of plaintiff’s camera-related choices to be unprotected.<sup>167</sup> It ultimately concluded:

The scene created by [plaintiff] as a whole was not original, even if the technical choices he made in rendering the photograph were. . . . Each photograph of this type—women’s feet astride a toilet, fashion accessories highlighted—is rendered in a distinct way, but the [plaintiff’s] Photograph is, ultimately, one of many. [Plaintiff’s] idea, and elements that naturally flow from it, cannot be protected.<sup>168</sup>

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monopolize the various poses used,’ and ‘can protect only plaintiff’s particular photographic expression of these poses and not the underlying ideas therefore. . . .’ The pose is common and predictable in such a photograph, and thus not protectible.” *Id.* at 393 (citing *Kisch v. Ammirati & Puris Inc.*, 657 F. Supp. 380, 382 (S.D.N.Y. 1987)).

Other courts that have invoked the idea/expression dichotomy to excise features of a photograph’s staged tableau also stressed that no photographer can own the pose used in his image. For example, in *Gentieu v. Tony Stone Images*, 255 F. Supp. 2d 838, 849 (N.D. Ill. 2003), the plaintiff photographer claimed copyright protection over the unique way that she posed babies for portraits using diffused lighting against a “high white” background. *Id.* Granting summary judgment to the defendant, the court relied on *Kaplan v. Stock Mkt. Photo Agency, Inc.*, 133 F. Supp. 2d 317 (S.D.N.Y. 2001) to conclude: “It may well be true that, as Gentieu claims, capturing a baby’s pose is a skill that has served her well. But the poses themselves (e.g., a baby’s smile or a baby putting up its arms) are inseparable from the unprotectible idea of a baby photograph.” *Id.* at 320 n.5.

What these cases fail to appreciate is that the way a photographer poses a person for a picture is but one aspect of a staged tableau. A photographer’s claim for copyright protection is never based on a pose alone, but rather on the way that the posed person is configured in relationship to the remaining elements of the staged tableau.

165. *Id.* at 392 (“Accordingly, the following elements are not protectible: the dominant shapes of the woman’s legs and the toilet base in the [plaintiff’s] Photograph; the inclusion of fashionable shoes and underwear; and the bathroom walls in the background. The bathroom as a setting is also not protectible.”).

166. *Id.*

167. The court concluded that “the legs and handbags are framed by the floor and the bathroom walls is not protectable.” *Id.* at 392. The camera-related choice to take the photograph near the floor was unprotected, *id.* (“Likewise, it is standard for the photographer to take such a photograph from or near the floor, and it follows that a portion of the floor closest to the camera might be out of focus. A natural consequence of that positioning is also, often, a head-on view of the toilet.”); the “positioning of the model’s feet” was unprotected because “numerous images in popular culture with similar premises pose women on toilets, usually in high heels, their toes pointed slightly inward,” *id.*

168. *Id.* at 393.

Looking to plaintiff's few camera-related choices that were subject to copyright protection, the court had little problem concluding that the litigants' photographs were not substantially similar.<sup>169</sup>

Decided after *Mannion*, the *Diodato* court felt obliged to address Judge Kaplan's insight that a photograph could be original by virtue of the "creation of the subject"—i.e., staging of the tableau:

Here . . . the creation of the subject was not original to [plaintiff]. The [plaintiff's] Photograph was certainly rendered in an original way—the technical aspects of the photograph were [plaintiff's] own—but the scene depicted in the [plaintiff's] Photograph is a concept that has appeared often in popular culture. The elements that are arguably copied in the [defendant's] Photograph are nonoriginal, unprotectible elements.<sup>170</sup>

As in *Kaplan*, in *Diodato* there were innumerable ways that the plaintiff's mental vision that he hoped to capture in his photograph—his "idea"—could have been configured in the tableau. Though the court has expressed a valid concern that no photographer be given a monopoly over depicting a "concept" that regularly appears in popular culture, use of the idea/expression dichotomy to vindicate that concern undermines the jurisprudence of photographic originality. In Part V below, this Article explores an alternative way to assure that downstream photographers have a broad scope for creative expression, one that does not involve the evisceration of photographs.<sup>171</sup>

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169. *See id.*

The elements that are unique to [plaintiff's] expression of the idea—and thus protectible—in fact distinguish it from the allegedly infringing photograph. For example, [plaintiff] uses an abundance of negative grey space; the [plaintiff's] Photograph is brightly lit; and the selected accessories give the photograph an airy and provocative feel. The model and her accessories are highlighted by their color and seem almost planted into the backdrop of a toilet stall. In the [defendant's] Photograph, the mood, colors, lighting, and depth of objects are distinct, and the view is tightly cropped.

*Id.*

170. *Id.* at 394.

171. Other courts that have invoked the idea/expression dichotomy and/or the *scènes à faire* doctrines to excise the staged tableau from the plaintiff's photograph include: *Gentieu v. Tony Stone Images*, 255 F. Supp. 2d 838, 849 (N.D. Ill. 2003) ("Gentieu cannot claim a copyright in the idea of photographing naked or diapered babies or in any elements of expression that are intrinsic to that unprotected idea"); *Custom Dynamics, LLC v. Radiantiz LED Lighting, Inc.*, 535 F. Supp. 2d 542, 548 (E.D. N. Car. 2008) ("If Custom is claiming a copyright in the ability to show product-description photographs and technical details of aftermarket motorcycle lights in general, Custom's claim is weak because it is essentially an attempt to copyright an idea."); *Psihoyos v. National Geographic Society*, 409 F. Supp. 2d 268, 275 (S.D.N.Y. 2005) ("In both the Psihoyos and Finnin Photos, the Fossil is laying in a bed of sand. Because the Fossil was found in the desert sand and the matrix is made of sand (or sandstone), the use of sand by Psihoyos merges with the 'idea' of showing the Fossil in its 'natural setting.' . . . The sand is also *scène à faire* because it is the obvious choice of background for the Fossil."); *Yankee Candle Co. v. Bridgewater Candle Co., LLC*, 259 F.3d 25, 36 (1st Cir. 2001) ("Because the merger doctrine applies, the copyright on Yankee's labels does not prevent Bridgewater from using the same

*C. The Difficulty of Applying the Fact/Expression Dichotomy and Related Doctrines to Visual Images*

Courts and commentators have recognized the difficulty of applying the fact/expression dichotomy, developed in the literary realm, to visual works. Professor Rebecca Tushnet flatly states that “copyright’s core doctrines don’t work for images.”<sup>172</sup> Similarly, in *Harney v. Sony Pictures Television*, the court noted “that copyright concepts developed for written works imperfectly fit the visual arts, including photography.”<sup>173</sup>

In a section of the *Mannion* opinion entitled “The Idea/Expression Difficulty,” Judge Lewis Kaplan directly challenged the *Kaplan* court’s reliance on the fact/expression dichotomy and its related doctrines as “unpersuasive.”<sup>174</sup> He then considered how the idea/expression dichotomy gets applied by courts to visual images. Noting that the dichotomy “arose in the context of literary copyright,”<sup>175</sup> he observed:

In the visual arts, the distinction breaks down. For one thing, it is impossible in most cases to speak of the particular “idea” captured, embodied, or conveyed by a work of art because every observer will have a different interpretation. Furthermore, it is not clear that there is any real distinction between the idea in a work of art and its expression. An artist’s idea, among other things, is to depict a particular subject in a particular way.<sup>176</sup>

Turning to photography, Judge Kaplan concluded that nothing is achieved by “attempting to distinguish an unprotectible ‘idea’ from its protectible ‘expression’ in a photograph or other work of visual art. . . . In the context of photography, the idea/expression distinction

subject matter on its labels, even if the genesis for Bridgewater’s choice of subject matter was Yankee’s labels.”).

172. Tushnet, *supra* note 1, at 740. More particularly, Professor Tushnet has challenged the application of the idea/expression dichotomy to visual images:

Application of the idea/expression dichotomy to images fails because [visual] styles are neither true nor false, neither fact nor expression. . . . Conventional applications of the idea/expression divide to images fail to account for the variety of ways to represent what “is” in the world, and courts should generally not be in the business of elevating one form of realism over another.

*Id.* at 724; *cf.* Hon. Jon O. Newman, *New Lyrics for an Old Melody: The Idea/Expression Dichotomy in the Computer Age*, 17 CARDOZO ARTS & ENT. L.J. 691, 703 (1999) (“[W]hat we must strive for is a recognition that the differences among modes of expression oblige us to eschew anything like ‘tests’ that can yield answers across all fields.”).

173. *Harney v. Sony Pictures Television, Inc.*, 704 F.3d 173, 189 (1st Cir. 2013); *see also Franklin Mint Corp. v. Nat’l Wildlife Art Exch. Inc.*, 575 F.2d 62, 65 (3d Cir. 1978) (“Isolating the idea from the expression and determining the extent of copying required for unlawful appropriation necessarily depend to some degree on whether the subject matter is words or symbols written on paper, or paint brushed onto canvas.”).

174. *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444, 456 (S.D.N.Y. 2005).

175. *Id.* at 458.

176. *Id.*

is not useful or relevant”<sup>177</sup> Though Judge Kaplan’s observations about photography are among the most insightful in case law,<sup>178</sup> I will challenge this conclusion in Part IV below.

Professor Michael Murray also harshly criticizes applying the merger and *scènes à faire* doctrines to visual works. He notes that these doctrines are “perfectly well adapted to verbal and literary works” because of the limited number of words and phrases available for describing commonplace plotlines and characters types.<sup>179</sup> In contrast, in the realm of the visual arts, the “merger and *scènes à faire* doctrines are a great curse . . . because their application rests on a fallacy.”<sup>180</sup>

That an idea of a visual work and the expression of the idea can merge, or that artists must copy a standard image in order to depict an idea. No one captures an idea by being the first to depict it visually. There is never a single way to depict some thing visually—object, creature, or idea. Another depiction is always possible.<sup>181</sup>

Murray argues that because “there are myriad possible ways to express ideas visually . . . a new author need only refrain from copying one [idea]”<sup>182</sup>—the plaintiff’s “single and original design.”<sup>183</sup> Accordingly, he proposes that courts simply stop applying either the merger or the *scènes à faire* doctrine to visual works.<sup>184</sup>

177. See also *id.* at 461.

It is nonsensical to speak of one photograph being substantially similar to another in the rendition and creation of the subject but somehow not infringing because of a shared idea. Conversely, if the two photographs are not substantially similar in the rendition and creation of the subject, the distinction between idea and expression will be irrelevant because there can be no infringement. The idea/expression distinction in photography, and probably the other visual arts, thus achieves nothing beyond what other, clearer copyright principles already accomplish. . . .

178. See also *Bridgeman Art Library v. Corel Corp.*, 25 F. Supp. 2d 421 (S.D.N.Y. 1998), modified 36 F. Supp. 2d 191 (S.D.N.Y. 1999).

179. Murray, *supra* note 2, at 784 (noting that these doctrines assure that “[p]ublic domain elements of literary works such as standard themes, stock plot devices, standard character types, and cliched phrases cannot be appropriated by any author”).

180. *Id.* at 848.

181. *Id.*

182. *Id.* at 787.

183. *Id.* at 793.

184. See *id.* at 858.

The most satisfactory solution is for courts to advance the law by finding that the merger and *scènes à faire* doctrines do not apply to visual works. The merger doctrine should not apply in situations where an idea can be depicted in innumerable ways either through original creation or by original combinations of otherwise unprotected elements. Visual works are a classic example of a situation where ideas can be depicted visually in innumerable ways which should preclude application of the merger doctrine. Furthermore, authors of visual works on the whole do not copy a stock image in the way that literary works adopt and express a stock scene or situation. There is no set of images that must be copied in order to depict the idea of the image.

In Part IV below, this Article offers a meaningful, albeit limited, way to apply both the idea/expression dichotomy and the *scènes à faire* doctrine to photography. In contrast, the merger doctrine makes no sense when applied to photography

#### IV. IDEA/EXPRESSION DICHOTOMY AND PHOTOGRAPHY

Though the *Mannion* court raises valid concerns with respect to applying the idea/expression dichotomy to visual works, the court's ultimate conclusion that "[i]n the context of photography, the idea/expression distinction is not useful or relevant" is simply not viable. Like it or not, in *Feist* the Supreme Court left no doubt that some way must be found to apply that distinction to photography: "[T]he idea/expression or fact/expression dichotomy applies to all works of authorship. . . ." <sup>185</sup>

##### *A. The Proper Way to Apply the Idea/Expression Dichotomy to Photography*

In fact, there is a meaningful way to apply that dichotomy to photography. To understand this we need to return to *Burrow-Giles v. Sarony*<sup>186</sup> where the Supreme Court formulated the foundations for photographic originality. In concluding that a photograph falls within the realm of a "writing" for purposes of the Constitution's Copyright Clause, the court stated:

By writings in that clause is meant the literary productions of those authors, and congress very properly has declared these to include all forms of writing, printing engravings, etchings, etc., by which *the ideas in the mind of the author are given visible expression*. . . . We entertain no doubt that the constitution is broad enough to cover an act authorizing copyright of photographs, so far as they are representatives of *original intellectual conceptions* of the author.<sup>187</sup>

*Burrow-Giles* teaches that the *idea* behind a photograph is the "intellectual conception" of the photographer, the mental vision that she hopes to embody in her image. As explained by Professor Paul Goldstein, it is the "animating concept . . . that gives rise to the work."<sup>188</sup> That idea is located "in the mind of the author," not on the face of the photograph. In contrast, the resulting photograph, the "writing," is the "visible expression" of that idea.

A photographer's *idea* for a potential image is unprotectable. Other photographers with whom she shares that idea are free to try

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

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

187. *Id.* (emphasis added).

188. See GOLDSTEIN, *supra* note 114, at § 2.3.1.1.

their hands at embodying it in their own photographs. In contrast, once she clicks the shutter, the photograph that results is *expression*, entirely expression. Unless it fails to meet *Feist's* minimal creativity criterion for originality—rare indeed<sup>189</sup>—it is subject to copyright protection.

Let us explore this understanding of how the idea/expression dichotomy can be applied to photographs. Imagine that a group of photographers have established an Internet blog on which they exchange observations, news, photo hints, etc. Photosnap, a well-known photographer, regularly posts on the blog.

**Posting #1 by Photosnap:** “They’ve just installed Jeff Koon’s 40-foot tall sculpture, *Puppy*, in Rockefeller Plaza. I think a great photograph could be taken from the rear of that work, looking upward toward the dog’s head.”

**Analysis:** Photosnap has posted an *idea* for a photograph. There are innumerable camera-related choices that could be utilized to take such a photograph, including most importantly the angle of shot. If another photographer takes a photograph from behind the sculpture looking up, it is doubtful that Photosnap would have a viable claim that the second photographer infringed on protected expression. On the other hand, given that the sculpture is copyright protected, Jeff Koons might well have a claim for infringement by replication against any photographer who snaps an unlicensed photograph of his sculpture.

**Posting #2A by Photosnap:** “They’ve just opened a new scenic overlook in the Grand Canyon, *Sunset Overlook*. I think a beautiful picture of the sunset could be taken from that site.”<sup>190</sup>

**Analysis:** Again, Photosnap has posted an *idea* for a photograph. There are innumerable camera-related choices that could be utilized to take such a picture. If inspired by Photosnap’s idea, another photographer were to take a photograph of the sunset from the scenic overlook, it is doubtful that Photosnap would have a viable claim that the second photographer infringed on protected expression. Moreover, because the subject matter for the proposed image is in the public domain, were such a photograph to be posted on the blog, at most that image would be protected only with respect to the photographer’s camera-related choices. No one can claim a monopoly over photographing the public domain subject matter depicted in the image.

**Posting #3 by Photosnap:** “I have a great idea for a photograph that can *express a businessperson’s frustration with the world*. Take a picture of a *businessperson contemplating a leap from a tall building onto the city street below*.”<sup>191</sup>

**Analysis:** Yet again, Photosnap has posted an *idea* for a photograph, the same idea that is behind the plaintiff’s photograph in *Kaplan*.

189. See *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444, 450–54 (S.D.N.Y. 2005) (“Almost any photograph ‘may claim the necessary originality to support a copyright.’”) (citing *NIMMER & NIMMER*, *supra* note 5, at § 2.08[E][1]).

190. This hypothetical scenario is discussed at length in Part V.B below.

191. *Kaplan v. Stock Mkt. Photo Agency, Inc.*, 133 F. Supp. 2d 317, 318 (S.D.N.Y. 2001).



There are innumerable ways in which that idea could be staged in a tableau. Moreover, once staged, there are innumerable camera-related choices that could be utilized to take a photograph of that tableau. Were another photographer to stage a tableau based on Photosnap's idea and snap a picture, it is doubtful that Photosnap would have a viable claim that the second photographer infringed on protected *expression*.

**But:** Were Photosnap to actually stage that tableau and snap a picture, the resulting image would contain protected expression with respect to both his staged tableau and his camera-related choices. If a second photographer, inspired by Photosnap's image, were to imitate that staging and take a picture, a factfinder would have to determine whether the second comer's photograph was substantially similar to Photosnap's image with respect to its protected expression. In doing so, *there is nothing to be excised from that image as an unprotected idea*. The *Kaplan* court failed to appreciate that the plaintiff's photograph was entirely expression. As such, it should have been submitted to the factfinder intact for consideration of substantial similarity.

Finally, consider one additional blog posting, a variation of Posting #2A above.

**Posting #2B by Photosnap:** "They've just opened a new scenic overlook in the Grand Canyon, Sunset Overlook. I went to the overlook last week, arriving shortly before sunset on a cloudless day. I thought a lot about the best way to take a photograph of the sunset. I used a Canon Mark III digital camera. I set up a tripod in front of the bronze plaque at the very center of the overlook's stone wall. I tilted the tripod to a 35° angle. I attached a 20 mm wide-angle lens, onto which I placed a polarizing filter. I set the ISO to 100. I set the aperture to *f*.8 and the shutter speed to 1/100 sec. I then focused the camera on the opposite ridge and, when the sun was halfway down behind the ridge, I clicked the shutter button. The resulting picture is beautiful. (Please note: I would appreciate your asking permission before you take a picture from the same location using these camera settings.)"

**Analysis:** Assume that, without permission, someone did take such a picture using these exact camera-related settings. Would Photosnap have a claim for infringement?

One might argue that copying another photographer's camera settings cannot possibly be infringing because what is copied is a mere "procedure, process, . . . [or] method of operation," unprotected under §102(b) of the Copyright Act of 1976.<sup>192</sup> Courts have consistently held, however, that the protected expression in a photograph of a public domain scene inheres in the photographer's creative camera-related choices.<sup>193</sup> Accordingly, to conclude that a second-comer's slavishly

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192. 17 U.S.C. § 102(b) (2012) ("In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.")

193. See *supra* Part II.A.

utilizing another photographer's detailed listing of such choices without permission is not infringement would cast doubt on the entire jurisprudence of photographic originality.

What Posting #2B illustrates is Professor William Patry's assertion that the idea/expression distinction is "not a dichotomy or a test . . . but rather a continuum."<sup>194</sup> The difference between Posting #2A (an unprotected idea) and Posting #2B (protected expression) provides an exemplar as to how Learned Hand's abstraction analysis in *Nichols v. Universal Pictures Corp.* can properly be applied to photography.<sup>195</sup> When it comes to that technology, the levels of abstraction concern the degree of detail in a photographer's proposal for taking a photograph. With respect to a proposal for a picture of a public domain scene, a photographer's unprotected ideas move into protected expression as the details concerning camera-related choices become more specific. With respect to a proposal for a photograph involving a staged tableau, in addition to the degree of detail concerning camera-related choices, the degree of detail concerning how to stage the tableau will impact whether the proposal is merely an unprotected idea or protected expression. As should be obvious, in the realm of photography as in the realm of literature, there is no bright line indicating when an idea transforms into expression. As Learned Hand noted in *Nichols*, "Nobody has ever been able to fix that boundary, and nobody ever can."<sup>196</sup>

What is critical is that, whether considering a picture of a public domain object or a picture of a staged tableau, the *idea* behind a photograph is in the photographer's mind. The photograph that results from that mental vision is *expression*, entirely expression. There is no residual idea on the face of a photograph to be excised in the name of vindicating the idea/expression dichotomy.

A case that astutely applies the idea/expression dichotomy to photography is *Wallace Computer Services, Inc. v. Adams Business Forms, Inc.*<sup>197</sup> In that case, both litigants designed and sold telephone message books. Among other design features on the covers of plaintiff's products were a series of photographs staged by the plaintiff:

Each photograph depicts two hands on either side of an open message book which is laid out at an angle. The right hand is about to write upon the blank message book, and there is a corner of a telephone in the upper left corner of each photo.<sup>198</sup>

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194. See PATRY, *supra* note 127, at § 4:36.

195. *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930).

196. *Id.* at 121.

197. 837 F. Supp. 1413, 1415 (N.D. Ill. 1993).

198. *Id.* at 1415.

The defendant began selling message books long after the plaintiff. Alleging that the covers of defendant's message books contained "substantially identical photo layouts,"<sup>199</sup> the plaintiff sued for infringement. In the parlance of this Article, the plaintiff sued for photographic infringement by Imitation/Tableau.

Acknowledging that the idea/expression dichotomy applies to photography,<sup>200</sup> the court confronted the defendant's argument "that the only similarities between the two sets of photographs are their subject matter" and that "no copying of expression has taken place."<sup>201</sup> In response, the court made clear that the tableau staged by the plaintiff's was protected: "The question at bar is whether the entire set-up of the copyrighted photograph, including the hand, the writing instrument, the phone, and the background, constitutes a protectible expression of an idea."<sup>202</sup>

Finding that the plaintiff's photograph was protectable, the court carefully delineated the distinction between the idea behind a photograph, and the expression of that idea:

The idea consists of a hand with a pen over an open message book. The expression of that idea consists of the way the photographer decided to lay-out the items in the photographs. The defendant incorrectly asserts that there are very limited ways to express its idea. There are countless different layouts which could have been used by the photographer of the defendant to make photos which look different from those of the plaintiff. . . . The creative minds in charge of the defendant's advertising and marketing certainly could have opted for a photo layout that did not so closely resemble that of its competitor.<sup>203</sup>

The court refused to adopt the defendant's suggestion that it "dissect[] the photograph into nonprotectible elements (i.e., a pen, a hand writing on a message book, a phone, etc.," and thereby conclude that "any copying that occurred was solely of nonprotectible elements."<sup>204</sup> Rather the court noted:

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199. *Id.* at 1416.

200. *Id.* at 1417. "Copyright protection does not extend to ideas—only to specific expressions of an idea. 17 U.S.C. § 102(b). As applied to paintings and photographs, this means that while the subject matter of a work cannot be protected by a copyright, the artist's or photographer's expression of an idea may be protected." *Id.*

201. *Id.* The defendant also argued that the merger doctrine disallowed finding the plaintiff's photograph to be copyright protected—an argument rejected by the court:

The defendant argues that, '[t]here are a very limited number of ways to express, *in a photograph*, the idea of a hand writing on a phone message book.' . . . Here, the defendant is trying to assert a theory of idea-expression unity, whereby the expression provides nothing new or additional over the idea. . . . Idea-expression unity is not present here.

*Id.* at 1418.

202. *Id.* at 1418.

203. *Id.*

204. *Id.*

Many courts . . . have ruled that this is not the correct way to approach the issue of copyright protection. Rather, a proper analysis requires that all of the elements be considered as a whole. . . . “It is the combination of many different elements which may command copyright protection because of its particular subjective quality.”<sup>205</sup>

Unlike the courts in *Kaplan* and *Diodato*, the court in *Wallace Computer* clearly understood that the plaintiff had a protected copyright interest in the simple tableau staged for his photographs. Accordingly, the court did not accept the defendant’s invitation to engage in judicial surgery on the plaintiff’s photographs, but rather properly “considered [them] as a whole.”<sup>206</sup>

*B. The Scènes à Faire and Merger Doctrines Applied to Photography.*

If the idea/expression dichotomy cannot justify excising features from a photograph before determining whether a defendant has infringed, what remains of the *scènes à faire* and the merger doctrines in the realm of photography?

There is an unobjectionable use of the *scènes à faire* doctrine in cases of alleged infringement by Imitation/Tableau, one illustrated by *Pampered Chef, Ltd. v. Magic Kitchen, Inc.*<sup>207</sup> In that case, both litigants produced catalogs of kitchen-related products. The plaintiff alleged that certain photographs of kitchen equipment in the

205. *Id.* at 1418–19 (quoting *McCulloch v. Albert E. Price, Inc.*, 823 F.2d 316, 320 (9th Cir. 1987)).

206. *Id.* at 1418. Other courts have refused to apply the *scènes à faire* doctrine to excise features from a plaintiff’s staged tableau before comparing the litigants’ images for substantial similarity. In *Bryant v. Gordon*, 483 F. Supp. 2d 605, 609 (N.D. Ill. 2007), the court refused to apply that doctrine to excise features from the plaintiff’s staged tableau of an Army Ranger sniper team. “None of the particular compositional elements of the [plaintiff’s] photo as it is expressed necessarily flows from, nor is required by, the idea of capturing a sniper team in prone position dressed in Ghillie suits. In other words, a wide range of possibilities are available to a photographer when choosing to depict a sniper team in that position.” *Id.* at 615.

In *Sharpshooters, Inc. v. Retirement Living Publishing Co., Inc.*, 932 F. Supp. 286 (S.D. Fla. 1996), the plaintiff alleged that the defendant had imitated the tableau he staged of a wife serving breakfast to her husband in a retirement home. Though tipping its hat to the *scènes à faire* doctrine, the court refused to excise any elements from the plaintiff’s picture as “events which naturally flow from a common theme.” *Id.* at 289. Rather the court found enough in common between the tableaux staged by the litigants for their photographs to let the case go to trial for a determination of substantial similarity. *See id.*

In *Fournier v. Erickson*, 202 F. Supp. 2d 290 (S.D.N.Y. 2002), the defendant engaged the plaintiff to take photographs for an advertisement of a casually dressed businessperson walking down a street. Thereafter, the defendant hired a different photographer to shoot pictures for its ad campaign. When plaintiff saw the ads, he sued for infringement. Looking to *Kaplan*, the defendant urged the court to apply the *scènes à faire* doctrine to conclude that the plaintiff “cannot assert copyright protection . . . over the expression of businessmen in traditional dress on their way to work, an idea. . . .” *Id.* at 295. The court refused to excise any features from the plaintiff’s photograph based on that doctrine before considering substantial similarity. Based on similarities between the tableaux staged in the litigants’ images, the court denied the defendant’s motion for summary judgment.

207. 12 F. Supp. 2d 785 (N.D. Ill. 1998).

defendant's catalog infringed on those in its own catalog.<sup>208</sup> In response, the defendant asserted that the contested images were "beyond the reaches of copyright protection because they are '*scènes à faire*,' or images which must necessarily appear in a certain manner when being used for a certain purpose. . . ."<sup>209</sup>

The court agreed with the defendants claim "that when putting together a kitchen supply catalog there are certain core ideas that must be logically represented: fruit cutters must appear with fruit, cookie trays with cookies, cake pans with cake. . . ."<sup>210</sup> Nonetheless, though accepting the policy behind the *scènes à faire* doctrine, the court determined that the doctrine could not justify excising elements from the plaintiff's photographs. Rather, it recognized that "[t]here must . . . be an infinite number of ways to arrange those things even while keeping the logical pairing of like-with-like."<sup>211</sup> The court stated:

that although the placing of a pie in a pie tin may be a "*scènes à faire*" in that as a concept every kitchen supply catalog logically must do the same thing because the two ideas are inextricably linked, it is clear that the type of pie, the crust pattern, the angle, the garnish and the nature and placement of things surrounding the pie are by no means fixed. . . .<sup>212</sup>

The court consequently held "that the pictures in Pampered Chef's catalogs are not '*scènes à faire*,'" and that the plaintiff could look to the images in its catalogs to support an infringement action.<sup>213</sup>

As discussed in Part II.B.2.a above, in cases involving allegations of infringement by Imitation/Public Domain, copyright law has a long-established doctrine that a photographer can gain no ownership over depicting public domain objects or scenes: "The subject matter of a photograph of a public object or scene, *i.e.* the object or scene actually being photographed, is not of itself copyrightable."<sup>214</sup> This doctrine acts as a kind of admonition to plaintiffs who have photographed public domain objects or scenes not to overreach in alleging copyright infringement.

The *scènes à faire* doctrine can be viewed as performing a parallel function in the realm of infringement by Imitation/Tableau. The doctrine serves as an admonition to photographers who stage tableaux not to overreach by claiming a monopoly over using particular objects or locations that appear in their tableaux. Because

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208. *Id.* at 793. The plaintiff also alleged infringement of its exclusive right to use the trade dress of its catalog under the Lanham Act, 17 U.S.C. § 1125(a).

209. *Id.* at 790.

210. *Id.* at 791.

211. *Id.*

212. *Id.*

213. *Id.*

214. *Masterson Mktg., Inc. v. KSL Recreation Corp.*, 495 F. Supp. 2d 1044, 1048 (S.D. Cal. 2007).

copyright protection in such cases is limited to the unique configuration of those objects in relationship to the background, other photographers are free to use the same objects or settings in their own tableaux. They simply cannot copy the plaintiff's unique configuration. Understood in this way, applying the *scènes à faire* doctrine to photography is unobjectionable.

In great contrast, there is never a justification for applying the merger doctrine to photography. If the idea of a photograph is located in the mind of the photographer and if its expression is located on the face of the resulting image, it is a logical impossibility for the two to merge. As such, the merger doctrine should not be applied to photography . . . period.

#### V. PROTECTING DOWNSTREAM PHOTOGRAPHERS THROUGH THE THIN COPYRIGHT DOCTRINE – THE “SILVER PLATTER” PRINCIPLE

As an alternative to the misconceived use of the idea/expression dichotomy to protect the scope of creativity for downstream photographers, this Article looks to the doctrine of thin copyright protection. That doctrine comes into play in applying the substantial similarity test to determine whether a defendant's work is infringing. Professor Balganesch explains:

When the plaintiff's work in question is highly unoriginal, uncreative, or made up primarily of unprotectible material, courts adopt an even more stringent approach to substantial similarity, occasionally referred to as “super-substantial similarity.” Here, the copying is thought to be problematic only when the works in question are “virtually identical” and the duplication of protectible materials is shown to have happened in its entirety.<sup>215</sup>

Though the doctrine has been applied to photography,<sup>216</sup> no court or commentator has yet to articulate a coherent approach for determining when a photograph should be entitled only to thin copyright protection.<sup>217</sup> To fill the void, this Article proposes the “silver platter” principle.

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215. See Balganesch, *supra* note 33, at 223.

216. See, e.g., *Ets-Hokin v. Skyy Spirits, Inc.*, 323 F.3d 763, 766 (9th Cir. 2003); cf. *SHL Imaging Inc. v. Artisan House, Inc.*, 117 F. Supp. 2d 301, 311 (S.D.N.Y. 2000) (effectively applies the thin copyright doctrine without using that term, and concludes that the plaintiff's photograph is entitled to protection only from “verbatim copying”).

217. Commentators have contrasted between “thick” and “thin” protection. See, e.g., Jeffrey L. Harrison, *Rationalizing the Allocative/Distributive Relationship in Copyright*, 32 HOFSTRA L. REV. 853, 884 (2003–04) (“[I]t is useful to understand that an entry barrier [to copyright protection] has two components. The first is the breadth of the protection. By this I mean how “thick” or “thin” the protection is with respect to the substance of the work or how close another author would have to come to the original to be viewed as infringing.”).

### A. The Thin Copyright Doctrine

The thin copyright doctrine was first introduced by the Supreme Court in *Feist* to determine when compilations of facts, such as directories and databases, are subject to copyright protection.<sup>218</sup> The Court explained that the doctrine grows out of two seemingly conflicting cornerstones of copyright law. On the one hand, facts cannot be copyrighted.<sup>219</sup> On the other hand, compilations of facts may embody the requisite degree of originality, and the Copyright Act explicitly extends protection to such compilations.<sup>220</sup> To reconcile these seemingly inconsistent axioms, the court introduced the “thinness” doctrine:

No matter how original the format, however, the facts themselves do not become original through association. This inevitably means that the copyright in a factual compilation is thin. Notwithstanding a valid copyright, a subsequent compiler remains free to use the facts contained in another’s publication to aid in preparing a competing work, so long as the competing work does not feature the same selection and arrangement.<sup>221</sup>

Applying the thinness doctrine to directories and databases is relatively straight forward. Unprotected facts can generally be separated from the protectable selection and arrangement of those facts. Assuming that the selection and arrangement is infused with minimal creativity, the compilation is subject to thin protection.

Some have argued that most photographs should be viewed as factual compilations and therefore entitled to, at most, thin copyright protection. The strongest advocate for this view is Professor Justin Hughes, who has argued that:

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218. The court in *Ets-Hokin*, 323 F.3d at 766, traced the doctrine back to *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930): “This principle has long been a part of copyright law. Indeed, as Judge Learned Hand observed in the context of stock dramaturgy: ‘The less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly.’”

219. See *Feist Publ’ns v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 347 (1991): “No one may claim originality as to facts.” [quoting NIMMER] This is because facts do not owe their origin to an act of authorship. The distinction is one between creation and discovery:

The first person to find and report a particular fact has not created the fact; he or she has merely discovered its existence. . . . The same is true of all facts—scientific, historical, biographical, and news of the day. ‘[T]hey may not be copyrighted and are part of the public domain available to every person.’

*Id.* (quoting *Miller v. Universal City Studios, Inc.*, 650 F.2d 1365,1369 (5th Cir. 1981).

220. See *Feist*, 499 U.S. at 348.

Factual compilations, on the other hand, may possess the requisite originality. The compilation author typically chooses which facts to include, in what order to place them, and how to arrange the collected data so that they may be used effectively by readers. These choices as to selection and arrangement, so long as they are made independently by the compiler and entail a minimal degree of creativity, are sufficiently original that Congress may protect such compilations through the copyright laws.

221. *Id.* at 349.

the problem of copyright protection for photographs is really the same problem as copyright protection for compilations of fact because photographs are, from one perspective, databases. At the practical level, copyright protects far fewer photographs than is commonly understood and, as with the thin copyright of a database, offers less protection to those photographs that are copyrighted.<sup>222</sup>

In fact, Hughes goes even further. While granting thin protection to photojournalistic photographs,<sup>223</sup> he believes that “the vast majority of the world’s photographs cannot be protected under copyright’s originality standard.”<sup>224</sup> Under Hughes’ approach, downstream photographers should have little concern that their photographs infringe on earlier photographs unless their images are “slavish, reprographic cop[ies].”<sup>225</sup>

I have devoted significant attention to refuting Hughes’ arguments aimed at limiting photographic originality, and I will not repeat those arguments here.<sup>226</sup> Suffice it to say that Hughes’ approach is premised on viewing photographic originality as grounded in the subject matter that a viewer perceives in a photograph—real world objects that for Hughes amount to no more than “uncreative facts.”<sup>227</sup> I argue that, in so doing, Hughes “locates photographic originality in the wrong place. . . . If, instead, a photograph’s originality depends primarily on a photographer’s creative choices in placing surface design markings,” then his analogizing a photograph to a factual compilation fails.<sup>228</sup>

There is a similar line of argument that relies on the thinness doctrine to cast into question the originality of many photographs. One commentator summarizes this view: “Unless a photograph is actively staged, it is lacking in originality on the ground that it simply duplicates that which exists in nature.”<sup>229</sup> This argument can be traced to the Ninth Circuit decision in *Satava v. Lowry*, where the court had to “decide whether an artist’s lifelike glass-in-glass sculptures of jellyfish are protectable by copyright.”<sup>230</sup> Having seen the plaintiff’s works, the defendant created similar sculptures.<sup>231</sup> The

222. Hughes, *supra* note 1, at 342.

223. *See id.* at 425 (“Even when there is copyright in a photograph, the copyright may be quite thin and effectively protect the photographic work only from slavish copying — this is particularly true with images that emerge from modern photojournalism.”).

224. *Id.* at 342.

225. *See id.* at 390. In arguing that the vast majority of photographs are entitled to, at most, “a very thin copyright,” Hughes explains that “[t]he nature of this thin copyright may mean that the photograph is effectively protected from slavish, reprographic copying, but has little protection against unauthorized copying of most elements in a derivative work.” *Id.*

226. *See Kogan, supra* note 1, at 920–36.

227. *Id.* at 869.

228. *Id.* at 869–70.

229. Roberta R. Kwall, *Originality in Context*, 44 HOUS. L. REV. 871, 880 (2007).

230. *Satava v. Lowry*, 323 F.3d 805, 807 (9th Cir. 2003).

231. *Id.* at 808.



trial court issued an injunction against the defendant's "making sculptures that resemble Satava's."<sup>232</sup>

Relying on the idea/expression dichotomy, the Ninth Circuit reversed stating that "no copyright protection may be afforded to the idea of producing a glass-in-glass jellyfish sculpture or to elements of expression that naturally follow from the idea of such a sculpture."<sup>233</sup> The court explained that the plaintiff "may not prevent others from copying aspects of his sculptures resulting from either jellyfish physiology or from their depiction in the glass-in-glass medium."<sup>234</sup> Accordingly, it concluded:

Satava's glass-in-glass jellyfish sculptures, though beautiful, combine several unprotectable ideas and standard elements. These elements are part of the public domain. They are the common property of all, and Satava may not use copyright law to seize them for his exclusive use.<sup>235</sup>

The court did grant that the unique way in which an artist depicts a public domain object may be protected expression: "It is true, of course, that a *combination* of unprotectable elements may qualify for copyright protection."<sup>236</sup> Had the court stopped at this point, the decision could be read for the unobjectionable principle that no artist can claim a monopoly over depicting a real world public domain object. This applies irrespective of whether that object is part of nature or man-made—whether a jellyfish or the Washington Monument. Moreover, that principle has nothing to do with the thin copyright doctrine.

Unfortunately, the court goes on to suggest that *any* realistic depiction of an object in nature is necessarily entitled only to thin copyright protection: "We do not hold that realistic depictions of live animals cannot be protected by copyright. . . . We recognize, however, that the scope of copyright protection in such works is narrow."<sup>237</sup>

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232. *Id.* at 809.

233. *Id.* at 810.

234. *Id.* The court set forth the unprotected ideas in the plaintiff's sculpture:

Satava may not prevent others from depicting jellyfish with tendril-like tentacles or rounded bells, because many jellyfish possess those body parts. He may not prevent others from depicting jellyfish in bright colors, because many jellyfish are brightly colored. He may not prevent others from depicting jellyfish swimming vertically, because jellyfish swim vertically in nature and often are depicted swimming vertically. . . . Satava may not prevent others from depicting jellyfish within a clear outer layer of glass, because clear glass is the most appropriate setting for an aquatic animal. . . . He may not prevent others from depicting jellyfish "almost filling the entire volume" of the outer glass shroud, because such proportion is standard in glass-in-glass sculpture. And he may not prevent others from tapering the shape of their shrouds, because that shape is standard in glass-in-glass sculpture.

*Id.*

235. *Id.* at 811.

236. *Id.*

237. *Id.* at 812.

Applying the thin copyright doctrine, the court states that, “[b]ecause the quantum of originality *Satava* added in combining these standard and stereotyped elements must be considered ‘trivial,’ . . . *Satava* possesses a thin copyright that protects against only virtually identical copying.”<sup>238</sup>

Here the court goes seriously wrong. Of course another artist must be allowed to depict jellyfish with all of their anatomical details, including their bright colors and “tendrill-like tentacles.”<sup>239</sup> But there are innumerable ways in which these bodily features can be combined in a sculpture. What a sculptor cannot do is too closely imitate the way in which another sculptor has expressed those details in his own sculpture—the gist of *Satava*’s infringement action.<sup>240</sup>

Despite the court’s hyperbolic statement that depictions of the “ideas of animals in their natural surroundings . . . are the common heritage of humankind,” it does not follow that thin copyright necessarily applies to all realistic depictions of objects in nature. Rebecca Tushnet has forcefully made this point in criticizing a case involving paintings of birds and flowers: “At the core of the court’s reasoning was the untheorized, and untrue, idea that there is only one mode of realistic representation, and thus one inevitable or necessary depiction.”<sup>241</sup>

Unfortunately, other courts have relied on *Satava* for the principle that realistic depictions of nature are necessarily entitled only to thin protection.<sup>242</sup> Among such cases is *Dyer v. Napier*,<sup>243</sup> a case involving photography. In that case, the plaintiff photographer first assisted a wildlife tamer in “manipulating” a mother mountain lion into holding her cub in her mouth, carefully staged the picture, and snapped the photograph.<sup>244</sup> Admitting that he saw the plaintiff’s photo, the defendant created a series of bronze sculptures that also depicted a mother mountain lion holding her baby in her mouth. The plaintiff sued.

238. *Id.* at 811.

239. *Id.*

240. *Id.* at 808 (“Lowry’s sculptures look like *Satava*’s, and many people confuse them.”).

241. Tushnet, *supra* note 1, at 724–25 (commenting on *Franklin Mint Corp. v. National Wildlife Art Exchange, Inc.*, 575 F.2d 62 (3d Cir. 1978)).

242. *See, e.g., Diamond Foods v. Hottrix*, No. 14-cv-03162-BLF, 2016 WL 3880797 (N.D. Cal. 2016) (relies on *Satava* to conclude that “no copyright protection may be afforded to the idea of producing an app with popcorn popping on a mobile device screen or to elements of expression that ‘naturally follow’ from such an idea.”); *Alpi Int’l v. Anga Supply*, No. 13-cv-04888-HSG, 2015 WL 2170040 (N.D. Cal. 2015) (applies *Satava* to deny plaintiff protection in toy animals); *Sportsmans Warehouse v. Fair*, 576 F. Supp. 2d 1175 (D. Col. 2008) (looks to *Satava* for the principle that “while realistic depictions of live animals may be protected by copyright, the protection afforded is “thin and extends only to those original expressions that are not dictated by nature”).

243. No. CIV 04–0408–PHX–SMM, 2006 WL 2730747 (D. Ariz. 2006).

244. *Id.* at \*1.

Rejecting the testimony of the plaintiff's expert witness,<sup>245</sup> the court ultimately concluded that the defendant's sculptures were not substantially similar to the photograph.<sup>246</sup> Had it limited itself to that determination, the decision would be commonplace. To reach that result, however, the court looked to *Satava*:

Applying *Satava* here, it is clear that the image of a mother mountain lion perched on a rock with a kitten in her mouth is an idea 'first expressed by nature' that is 'the common heritage of humankind, and no artist may use copyright law to prevent others from depicting [it].' . . . As a result, Plaintiffs cannot prevent Defendants from any copying aspect of the mother mountain lion or kitten that naturally result from the physiology of mountain lions.<sup>247</sup>

More particularly, the court found that the plaintiff had "not demonstrated that the poses struck by both the mother mountain lion and the kitten are original and were created by Plaintiff Dyer, rather than naturally occurring poses created and displayed by nature."<sup>248</sup>

The court concluded that the appearance of the animals in the photograph did not embody "original expression contributed by Plaintiff," but rather were "expressions and features displayed by mountain lions in nature for all observers."<sup>249</sup> Accordingly, following *Satava*, the court applied the thin copyright doctrine to the photograph: "Plaintiffs' original contributions to the Mother Mountain Lion Photo enjoy a 'thin' copyright that comprises 'no more than his original contribution to ideas already in the public domain.'"<sup>250</sup>

Applying *Satava's* wrong-headed notion that realistic depictions of objects in nature are entitled only to thin protection is particularly confusing when applied to photography. Given that every photograph, not intentionally distorted by the photographer, will inevitably depict a real world object or scene in a realistic manner, *Satava's* reasoning leads to the same result proposed by Professor Hughes—virtually every photograph is entitled only to thin protection.

The criticism directed at Hughes' argument also applies to *Dyer v. Napier*. A photograph's originality turns on the photographer choices and actions in placing design markings on the image's surface,

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245. The plaintiff's expert witness asserted that the defendant's bronze sculpture was "a 'direct rip off' of the [plaintiff's] Photograph because 'the focal point on the photograph is the mother and her baby and obviously that is the focal point of the sculpture, that is the essence of what this sculpture is about.'" *Id.* at \*6.

246. *Id.* at \*4.

247. *Id.* at \*7. The court further stated: "Moreover, Plaintiffs may not prevent Defendants from depicting a mother mountain lion perched on a boulder with a kitten in her mouth, because . . . mother mountain lions in nature instinctively carry their kittens with their mouths." *Id.* at \*8.

248. *Id.* at \*9.

249. *Id.*

250. *Id.* (quoting *Satava v. Lowry*, 323 F.3d 805, 811–12 (9th Cir. 2003)).

not on the object or scene that a viewer perceives in the image.<sup>251</sup> It is generally irrelevant to a photograph's originality what the photograph depicts, whether a scene in nature or a man-made object. The depiction of a natural object is entitled to no more or no less copyright protection than a depiction of a man-made public domain object, whether the Statue of Liberty or a sailing ship on the water.

*B. Photographic Infringement by Imitation/Public Domain—Photographs Served Up on a Silver Platter*

The challenge is clear. In rejecting the view that virtually all photographs are entitled only to thin copyright protection, this Article must identify criteria for determining which subset of photographs *are* so limited. Let us begin by considering how the thin copyright doctrine might apply in instances of alleged infringement by Imitation/Public Domain, and consider a critique of that doctrine raised by Professor Patry. As previously noted,<sup>252</sup> many courts and commentators suggest that if a plaintiff's work is entitled only to thin protection, then infringement will occur only if a defendant's work is "virtually identical" (or "super-substantially similar") to the plaintiff's work.<sup>253</sup> Patry criticizes this approach as "misapprehend[ing] the basic issue of infringement."<sup>254</sup>

When *Feist* spoke of "thin" copyrights, it was referring to determining the amount of protectible material, not to the level of similarity required to prove infringement of that material for originality purposes. The level of similarity required to prove infringement is the same for every class of work—namely, substantial similarity of expression.<sup>255</sup>

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251. See discussion *supra* at note 223.

252. See discussion *supra* at note 218 and accompanying text.

253. See NIMMER & NIMMER, *supra* note 5, at § 13.03[A].

The measure of how substantial a "substantial similarity" must be made vary according to the circumstances. For many, copyrights represent significant creative effort, and are therefore reasonably robust, whereas others reflect only scant creativity; the Supreme Court labels the latter "thin." It would seem to follow analytically that the more similarity is required when less protectible matter is at issue. Thus, if substantial similarity is the normal measure required to demonstrate infringement, "supersubstantial similarity" must pertain when dealing with "thin" works.

*Id.*

254. See PATRY, *supra* note 127, at § 9:95.

255. PATRY explains:

If a defendant has copied nonprotectible material only, or a *de minimis* amount of expression, there is no infringement. On the other hand, if a defendant has copied a substantial amount of expression from a work having a "thin" copyright, infringement occurs. The error in the supersubstantiality test is that it confuses copyrightability with infringement and in the process misleads courts into requiring a higher level of similarity in expression.

*Id.*

He continues:

According to Patry, “[t]he error in the supersubstantiality test is that it confuses copyrightability with infringement and in the process misleads courts into requiring a higher level of similarity in expression.”<sup>256</sup> His critique is of particular importance in considering photographic infringement. As discussed below, there may be instances in which a downstream photographer’s image *is* virtually identical to a plaintiff’s thinly protected photograph and, nonetheless, that image should not be deemed infringing absent slavish replication—where the defendant has effectively pointed a camera at the protected work and snapped a picture.<sup>257</sup>

To explore when a photograph should be entitled only to thin protection, I offer the following hypothetical:

Assume there is a ridge in the Grand Canyon that offers a vivid view of the sunset. Because of its inaccessibility no photographs have ever been taken from this location. To enable the public to enjoy this view, the National Park Service builds a new scenic overlook that it appropriately names “Sunset Overlook.”

One month before the public opening, a Park Ranger invites his friend Photopro to visit Sunset Overlook. Photopro stands at the rock wall that edges the overlook and takes a photograph at the moment of sunset. The next day she contracts with a graphic arts company to create a wall poster from her image and then persuades the Grand Canyon Gift Shoppe to sell her poster.

Fast forward one month. Shortly before sunset on the day of the public opening, Sunset Overlook is swarming with both amateur and professional photographers. Camerapro, a professional, drives directly to the new overlook. Another professional photographer, Imagepro, first stops at the Gift Shoppe to get coffee. He notices Photopro’s poster on the wall and, *finding it inspiring*, asks the sales clerk about the picture. When told that it was taken from Sunset Overlook, Imagepro smiles and says that he is headed to that very location. At the moment of sunset, Camerapro, Imagepro, and hundreds of others stand along the rock wall and snap pictures. The vast majority of photographs taken at that moment are virtually indistinguishable from one another.

Thereafter, Camerapro and Imagepro each contract with a graphic arts company to create posters from their respective photographs. In addition, both convince the Grand Canyon Gift Shoppe to sell their

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Regardless of the relative creativity of the work, the test for all works is substantial similarity. While works having a “thin” copyright due to a minimal amount of creative material may indeed only be infringed by close copying, this is because the majority of the work is unprotectible. The test for appropriation of the expression in such a work is still that of substantial similarity.

*Id.*

256. *Id.*

257. See JANE M. GAINES, CONTESTED CULTURE: THE IMAGE, THE VOICE, AND THE LAW 67 (1991) (“[T]wo different men may very well produce identical photographs using the same apparatus identically positioned.”).

posters. Upon seeing these posters, Photopro sues both Camerapro and Imagepro for copyright infringement. Should she prevail?

Camerapro will be able to undermine Photopro's *prima facie* case of infringement by proving independent creation.<sup>258</sup> He never saw Photopro's picture before snapping his own. Imagepro will not be so lucky. Relying on the Gift Shoppe clerk's testimony, Photopro can establish that Imagepro had access to and was inspired by her work—the requirements for proving actual copying.<sup>259</sup> Given that the images are virtually indistinguishable, proving substantial similarity should be a breeze.

But something seems terribly unfair about this result. The only difference between Imagepro and the dozens of other photographers who took near-identical photographs is that Imagepro was *unlucky* enough to have first seen and admired the plaintiff's image. Had he not stopped for coffee, in all likelihood he would still have achieved a picture virtually identical to the one he actually took. South African jurist L.T.C. Harms elaborates on this concern:

The first issue . . . is whether one “copies” a photograph by photographing the same object or scene or by drawing it. The idea that every photograph of the Union Buildings in Pretoria is a reproduction of any earlier photograph tends to rattle the senses. Most scenes have an optimum point for photographing . . . . Every photographer has seen a prior photo of the scene, and to suggest that when he or she is trying to catch a similar moment on film or in digital form the earlier photograph is being reproduced does simply not appear to be right . . . .<sup>260</sup>

Harms captures the bind that copyright law imposes on a photographer like Imagepro, who happened to see and even be inspired by another's image of a commonly photographed site:

Courtesy demands that the next visitor gets access to the same spot. Can it be that the second photograph infringes the first? . . . The justification for the extended meaning of “reproduction” appears to be the assumption that once there is a causal connection between two photographs and they are similar the second is a reproduction of the first. The problem is due to the looseness of terminology. *The fact that one work inspires another* and that the two are in that sense causally connected does not mean at the same time that the second, independently created, is a reproduction.<sup>261</sup>

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258. See PATRY, *supra* note 127, at § 3:30 (“Where the defendant in an infringement suit is able to prove that his or her work, although substantially similar (or even identical) to plaintiff's work was created without copying from that work, independent creation constitutes a complete defense to the infringement claim.”).

259. See NIMMER & NIMMER, *supra* note 5, at § 13.01[B] (“[T]here is the factual question whether the defendant, in creating its work, used the plaintiff's material as a model, template, or even inspiration. If the answer is “yes,” then one can conclude, as a factual proposition, that copying may have occurred.”) Similarly, Paul Goldstein describes the actual copying requirement as follows: “To prove copying, the plaintiff must show directly or by inference that the defendant . . . had the plaintiff's work in mind when he composed the allegedly infringing work.” See GOLDSTEIN, *supra* note 114, at § 9.1.

260. Harms, *supra* note 2, at 75–76.

261. *Id.* (emphasis added).

The thin copyright doctrine is a prime candidate for shielding Imagepro from Photopro's infringement claim. The challenge is to explain why Photopro's image should be entitled only to thin protection.

It would be foolhardy to commit *Satava's* mistake and suggest that every photograph of a natural public domain object or scene is protected only by a thin copyright. Professional photographers travel miles up the Amazon River to photograph snakes and lakes, all of which are in the public domain. In so doing, they make subtle camera-related choices, choices that imbue their images with thick copyright protection. Moreover, criteria for thinness cannot turn on the fact that Photopro's image is somehow "straight forward" or "banal."<sup>262</sup> A photograph of a sunset over the Grand Canyon may well appear beautiful and unique, irrespective of how easy or hard it was to achieve.<sup>263</sup>

Accordingly, criteria for thinness must turn on an assessment of a photographer's creative input into her image, not on what appears in the image. In virtually every case in which a plaintiff photographer alleges infringement by Imitation/Public Domain, she will be relying on three camera-related choices to support her claim: the choice of an object or scene at which to point the camera; the angle of shot utilized to take that picture; and the time of day or atmospheric conditions existing when she snapped her picture. Few second-comers intent on copying a plaintiff's photograph will have the technical knowledge to glean more subtle camera-related choices—*f*-stop, ISO, shutter speed—from simply looking at an image.

With this in mind, this Article proposes the "silver platter" principle for determining when a photograph should be entitled only to thin copyright protection: If the camera-related choices and actions that a photographer utilizes in snapping a picture have been largely dictated by previous creative choices and actions of others or by industry conventions, then the photographer's resulting image is entitled only to thin copyright protection against slavish replication.

To appreciate how this principle operates, let us return to the hypothetical. Photopro's success in achieving a poster-quality photograph of the sunset was largely attributable not to her own

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262. See Ginsberg, *supra* note 17, at 1077.

263. In other words, in photography beauty can result irrespective of the extent of a photographer's creative input. Justin Hughes notes:

[W]ith a photograph of a great mountain or waterfall, the thing before you can be both a human product and a thing of natural beauty. In this way, photographs can "give the impression of artistic creations" without the photographer making any deliberate effort to be creative.

See Hughes, *supra* note 1, at 400–01.

creativity, *but rather to the creative choices and actions of the National Park Service*. Her decision to take a picture standing along the rock wall, to aim her camera at the opposite ridge, and to snap the shutter at the moment of sunset were, in effect, parasitic on creative choices and actions previously made by Park Service architects and designers. Moreover, the very name of the location to which she travelled conveys the clear message that *Sunset Overlook* is a good site from which to take a particular type of photograph at a particular time of day—sunset over the Grand Canyon. In sum, Photopro’s image was served up to her on a “silver platter” by virtue of creative choices and actions of others, not her own.

Assuming that a plaintiff has proven actual copying and substantial similarity between a defendant’s image and her own, the downstream defendant photographer should be allowed to introduce evidence to prove that the plaintiff’s image is entitled only to thin protection. Among such evidence might be the relative accessibility of the site from which the plaintiff took her photograph; whether tourists and others commonly take photographs from that site of the object or scene that appears in the plaintiff’s image; whether there are clear indicators (architectural or otherwise) as to the best place(s) to stand to take such photographs; and perhaps most importantly, whether independently created photographs of the same subject matter taken from the same location tend to appear substantially similar to the plaintiff’s image.<sup>264</sup>

### *C. Applying the Silver Platter Principle to Infringement by Imitation/Tableau*

Things get more complicated when considering how the silver platter principal might apply to allegations of infringement by Imitation/Tableau. So long as a photographer’s staged tableau is commonplace, the proposed principle serves the goal of protecting the scope of downstream creativity. Once one considers cases like *Kaplan* and *Diodato* involving more complex tableaux, however, the silver platter principle is no longer useful.

#### 1. Commonplace Tableau

If the tableau staged by a plaintiff is truly commonplace, the silver platter principle can shield a defendant in cases involving

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264. Google Images may prove to be a significant resource for defendants in this regard.



allegations of infringement by Imitation/Tableau. Imagine a professional photographer posing a child on a bench in front of the Alice in Wonderland sculpture in New York City's Central Park and snapping a picture from which a poster is made. Though she cannot claim a monopoly over depicting that public domain sculpture, she can claim protection over staging the child on the bench as well as the camera-related choices utilized in taking the picture. Assume that another professional photographer sees that poster, admires it, and poses a child on the same bench in front of the same sculpture. When the first photographer sees the second-comer's photograph, she sues for infringement. Should she win?

Applying the silver platter principle, a strong argument can be made that the plaintiff's poster should be entitled only to thin protection. The plaintiff's achieving her image was heavily reliant on the preexisting sculpture and the placement of the bench, creative choices of others. Additional evidence relevant to determining thinness might include the fact that thousands of near-identical photographs are taken annually from the same location. Unless the plaintiff's poster depicts the child in an unusual pose (which the defendant then imitated), most such photographs will be virtually identical to one another. Such evidence suggests that the plaintiff's photograph should be entitled only to thin protection against slavish replication.

There is an important addendum that must be added to the silver platter principle when considering allegations of infringement by imitation/tableau. On occasion a photographer will pose a tableau based on commonly accepted industry conventions. This often occurs in creating a product shot for an advertisement. If one photographer follows the same conventions, his image will in all likelihood appear substantially similar to another photographer's image of the same product. In such cases, the camera-related choices utilized by a professional photographer following industry conventions should be considered served up to him on a silver platter and, accordingly, the resulting image is entitled only to thin copyright protection from slavish copying.

This addendum to the silver platter principle is well illustrated by *Ets-Hokin v. Skyy Spirits Inc.*<sup>265</sup> In that case, the defendant hired the plaintiff to take product shots of a blue Vodka bottle. Thereafter, the defendant hired a different photographer to photograph its bottle, and used these later images in advertisements. The plaintiff sued claiming that "Skyy used photographs taken by the other

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265. *Ets-Hokin v. Skyy Spirits Inc.*, No. C 96-3690 SI, 1998 WL 690856 (N.D. Cal. 1998), *rev'd*, 225 F.3d 1068 (9th Cir. 2000), *appeal after remand*, 323 F.3d 763 (9th Cir. 2003).

photographers that mimicked his own photos; specifically, he claimed that these photographers improperly used his photographs to produce virtually identical photos of the vodka bottle.”<sup>266</sup> The trial court determined that the plaintiff’s photographs were not copyright protectable and granted the defendant’s motion for summary judgment.<sup>267</sup>

On appeal, the Court of Appeals for the Ninth Circuit reversed<sup>268</sup> and remanded for a determination of “the scope of Ets-Hokin’s copyright in the photographs vis-a-vis the claimed infringement.”<sup>269</sup> In a dissent, Judge Nelson argued that the action should have been dismissed on appeal because “as a matter of law, legal defenses such as *scènes à faire* and the merger doctrine prevent Ets-Hokin from prevailing on his copyright infringement claims.”<sup>270</sup>

On remand, the district court looked to those very doctrines to grant summary judgment for the defendant.<sup>271</sup> The Court of Appeals affirmed that determination, limiting its consideration to the question of “the scope of Ets-Hokin’s copyright within the limited landscape of commercial product shots.”<sup>272</sup> Relying on the *scènes à faire* and merger doctrines, the court determined that Ets-Hokin’s photographs were entitled only to thin protection:

Though the Ets-Hokin and Skyy photographs are indeed similar, their similarity is inevitable, given the shared concept, or idea, of photographing the Skyy bottle. When we apply the limiting doctrines, subtracting the unoriginal elements, Ets-Hokin is left with only a “thin” copyright, which protects against only virtually identical copying.<sup>273</sup>

Given the thin copyright doctrine, the court concluded that “the range of protectable expression is constrained by both the subject-matter idea of the photograph and the conventions of the

266. *Ets-Hokin*, 225 F.3d at 1072.

267. *Ets-Hokin*, 1998 WL 690856, at \*6. Having first determined that the blue Vodka bottle depicted in plaintiff’s photograph was a protected work, the trial court concluded that the plaintiff’s photographs were unoriginal derivative works because they lacked the “non-trivial differences [with the bottle] and sufficient originality” necessary to warrant copyright protection for a derivative work.

268. The court stated that “[g]iven the low threshold for originality under the Copyright Act, as well as the longstanding and consistent body of case law holding that photographs generally satisfy this minimal standard, we conclude that [plaintiff’s] product shots of the Skyy vodka bottle are original works of authorship entitled to copyright protection.” *Ets-Hokin*, 225 F.3d at 1073. Secondly, the court concluded that the plaintiff’s photographs were not derivative works because the Skyy Vodka bottle was not a work. The dissent challenged this conclusion: “The majority opinion overlooks the Skyy bottle’s copyrightable elements—its non-utilitarian features (such as the color and shape of the bottle) and its label.” *Id.* at 1084.

269. *Id.* at 1077.

270. *Id.* at 1083.

271. *Ets-Hokin*, 323 F.3d at 764.

272. *Id.* at 765.

273. *Id.* at 766.

commercial product shot.”<sup>274</sup> But the court hedged its bets by determining that, in fact, the defendant’s product shots were not substantially similar to the plaintiff’s images.<sup>275</sup>

The silver platter principle offers a far simpler way to reach the same result, one that does not enmesh the court in having to distinguish between fact and expression. Because the plaintiff’s creative choices in photographing the Vodka bottle were tightly constrained by advertising industry conventions, his image is entitled only to thin protection against slavish re-photographing—which the defendant did not do. Applying the silver platter principle to *Ets-Hokin*, it matters not whether the defendant’s images were in fact *virtually identical* to those of the plaintiff. Given that the plaintiff’s images were entitled only to thin protection, the defendant’s photographs were not infringing—assuming they were not slavish replications.<sup>276</sup>

## 2. Complex Tableau

When one moves from commonplace to more complex tableaux such as those involved in *Kaplan v. Stock Photo* and *Diodato v. Kate Spade*, the silver platter principle ceases to provide a viable defense to infringement. In such cases, the plaintiff photographer’s creative choices were *not* handed to him on a silver platter.

Nonetheless, hidden within these cases is a possible basis for arriving at the same result reached by each court—that the respective defendant did not infringe. In *Kaplan*, in support of its assertion that the staged tableau of a businessperson leaping from a building is an unprotectable idea, the court made the following observation:

Kaplan, like other artists before and after him, has chosen to express a businessperson’s frustration with the world by portraying him at the top of a building; his contemplation of a leap from the edge of that building is the necessary sequence of events that follows from the chosen setting.<sup>277</sup>

To support this statement, Footnote 11 states:

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274. *Id.*

275. *Id.* (“Skyy’s photographs are not virtually identical to those of Ets-Hokin. Indeed, they differ in as many ways as possible within the constraints of the commercial product shot. The lighting differs; the angles differ; the shadows and highlighting differ, as do the reflections and background. The only constant is the bottle itself. The photographs are therefore not infringing.”)

276. Of course, if a photographer defies industry conventions in taking a product shot, then the silver platter principle becomes irrelevant. In such cases, if a downstream photographer closely imitates the plaintiff’s camera-related choices or staged tableau, his photographs may well infringe.

277. 133 F. Supp. 2d 317, 323 (S.D.N.Y. 2001).

The Court's conclusion in this regard is supported by photographic exhibits submitted by both sides, which depict the same scene: a businessperson on the edge of a building apparently contemplating a leap to the street below. . . .<sup>278</sup>

In other words, the court took seriously the possibility that, in staging the tableau, the plaintiff may have copied existing photographs taken by others.

Similarly, in *Diodato*, the court had more than a sneaking suspicion that the staging of a woman on a toilet to showcase fashion was not original to the plaintiff. In support of its conclusion that the plaintiff's staged scene was an unprotectable idea, the court pointed out that the defendant's photographer had taken a similar photograph a year before the plaintiff shot his picture.<sup>279</sup> The court then notes:

The idea of a woman's feet at the base of a toilet to showcase shoes and other fashion accessories has been used often in popular culture. Kate Spade attaches to its papers copies of photographs of this type, culled from image banks of stock photography agencies. . . .<sup>280</sup>

In a later lecture, the judge deciding *Diodato* stated:

I was persuaded that the concept of a photo of someone's feet showing beneath the door of a toilet stall was just not original. The defendants submitted numerous similar photographs, including a number of fashion shots, taken by other photographers over the years.<sup>281</sup>

Lurking beneath both *Kaplan* and *Diodato* is a suspicion that each plaintiff copied the tableau he staged from third party creations. In such cases, the law limits a plaintiff's copyright protection over the borrowed expression. Patry explains: "Where defendant alleges plaintiff did not independently create its work, but instead copied from a third party, defendant must establish facts sufficient to support the allegation, that is, plaintiff had access to the third party work and that plaintiff's work is substantially similar to it."<sup>282</sup>

The problem with this defense is that, under current law, a defendant must prove that the plaintiff actually copied from a particular third party image, a hard burden indeed. Perhaps in the

278. *Id.* at 323 n.11.

279. *See, e.g.*, *Bill Diodato Photography, LLC v. Kate Spade, LLC*, 388 F. Supp. 2d 383, 387 (S.D.N.Y. 2005).

According to Kate Spade, ideas for potential images were discussed at the meeting, and Kate Spade officials referenced photographs in Craig Martin's portfolio as exemplifying what they wanted. Among those photographs was one taken by Craig Martin in 2000 from the floor of a bathroom, featuring a side view of the feet and gold shoes of two women in bathroom stalls. . . . In that photograph, one of the women is wearing fishnet stockings and bright light reflects from the women's shoes and the floor. The 2000 Craig Martin Photograph has been exhibited publicly and distributed as a postcard, and copies of the photograph have been sold.

*Id.*

280. *Id.* at 388.

281. Chin, *supra* note 160, at 189.

282. *See* PATRY, *supra* note 127, at § 328.

realm of photographic infringement, however, this rigorous requirement should be eased up. Given the ubiquity of photographic images in contemporary culture, a defendant should be able to introduce into evidence third party images that display tableaux similar to that appearing in the plaintiff's photograph. In the face of such evidence, a defendant should be able to avoid a determination of infringement if he can show that a photographer in the plaintiff's professional community was likely to have had access to such images.

Eliminating the requirement that a defendant prove that the plaintiff actually had access to third party images portraying a similar tableau obviously will lessen the degree of copyright protection accorded to some photographers. Nonetheless, if such evidence actually tends to sway courts against finding infringement—as it appears to have done in both *Kaplan* and *Diodato*—this approach is superior to applying the idea/expression dichotomy to excise features of a staged tableau from a plaintiff's photograph.

A case involving an allegation of infringement by Imitation/Tableau that adopts this approach is *International Biotical Corp. v. Associated Mills, Inc.*<sup>283</sup> There the plaintiff claimed that the defendant infringed on its copyright in three photographs used in connection with advertising a deep heat massager. In each image, the plaintiff posed the “application of a unit to the head, leg, and back of the body.”<sup>284</sup> When the defendant staged similar photographs to market its own massager, the plaintiff sued.

Finding no infringement, the court noted that photographs of body parts in conjunction with selling heat massagers well predated either party's use of such images:

Plaintiff's copyrights cannot monopolize the various poses used in these photographs. . . . [T]he use of the head, leg and back poses for a combined infra-red heat and massage device was old long prior to its use by either party hereto, as evidenced by the 'Therm-Massage' advertisement of Sibert & Co., which was published in the Chicago Sun-Times on January 29, 1948.<sup>285</sup>

The court never considered whether the plaintiff actually saw the 1948 advertisement. It merely assumed that he was aware of the longstanding convention utilized in earlier photographs to market the product. Accordingly, when images of a tableau staged in a particular way are common in a plaintiff's professional community, a defendant photographer should not have to prove that the plaintiff actually saw such images to avoid a finding of infringement.

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283. 239 F. Supp. 511 (1964).

284. *Id.* at 513.

285. *Id.* at 514.

## VI. CONCLUSION

In setting forth a taxonomy of photographic infringement, this Article clarifies the different ways in which the technology of photography can steal intellectual property: by *replication* and by *imitation*. In general, courts have an easy time identifying instances of infringement by replication and one subtype of infringement by imitation—infringement by Imitation/Public Domain.

Courts have struggled, however, in dealing with allegations of infringement by Imitation/Tableau. Despite a photographer's clear claim to copyright protection over the tableau staged prior to taking a picture, many courts refuse to find infringement even when a defendant admits to imitating that tableau. Looking to the idea/expression dichotomy and its sentinels, the merger and *scènes à faire* doctrines, these courts excise from a plaintiff's image the staged tableau as constituting unprotectable "ideas." Having done so, they then find no substantial similarity between the defendant's photograph and the meager protected expression remaining in the plaintiff's image.

This Article argues that performing judicial surgery on photographs in the name of vindicating the idea/expression dichotomy renders a nullity of an entire category of copyright-protected images—those involving a staged tableau. Perhaps more seriously, this approach locates the idea behind a photograph in the wrong place. That idea is not located on the face of the image. Rather, that idea exists in the mind of the photographer; it is the mental vision that she hopes to capture in taking a picture. Once she snaps the shutter, the resulting photograph is expression—entirely expression. There is no idea for a court to excise from the picture.

A major justification for excising the idea from a plaintiff's photograph has been to shield downstream photographers from harassing infringement actions. This Article suggests an alternative approach to accomplishing that goal, one that relies on the thin copyright doctrine. If a plaintiff's copyright interest in a photograph is thin, then a defendant infringes only by slavishly replicating that image. I propose the "silver platter" principle as a way to identify which photographs should be entitled only to thin protection, one that recognizes instances in which a plaintiff's protected expression in a photograph was effectively dictated by the creative choices and actions of others.