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## Framing the Issue: Avoiding a Substantial Similarity Finding in Reproduced Visual Art

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FRAMING THE ISSUE: AVOIDING A SUBSTANTIAL  
SIMILARITY FINDING IN REPRODUCED VISUAL ART

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ABSTRACT

*Copyright issues are litigated in the United States every day. Yet attorneys representing visual artists settle suits more often when those suits involve the potential of a copyright infringement, partly because of the relatively few decisions on the matter. In Harney v. Sony Pictures, Inc., the First Circuit found that a copyrighted photograph could be copied to look nearly the same as the original because the copied elements were each unprotectable under the copyright. The copyright protected only those elements of the photo that were the result of the photographer's choices in depicting the subject. The court held that the placement of the subjects in the frame of the photo was the only protected feature shared by the recreation, and this was insufficient to establish "substantial similarity" necessary for the court to find a copyright violation. This Article puts forth an organizational scheme based on existing cases to help attorneys defend their clients' work. By explaining how attorneys have avoided substantial similarity findings in the past and how courts treat different approaches, this Article will provide attorneys with guidance on avoiding a substantial similarity finding in their clients' works, focusing specifically on photographs.*

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## INTRODUCTION

As photography becomes an increasingly popular medium, photographers and visual artists who wish to recreate some aspects of a photo are susceptible to copyright suits against them. Attorneys representing artists face mounting confusion over copyright infringement in their clients’ work. For an attorney representing an artist who has referenced or recreated another’s copyrighted art, the law is unclear as to which elements of the reproduction are copyrightable and which elements are unprotectable. Courts have never explicitly listed the features of a photo that are copyrightable and instead apply a series of tests to determine if infringement occurred. While the refusal to create any per se rules can be frustrating to a visual artist toeing the line and to that artist’s attorney, courts are wise to avoid a per se rule that

might stifle creativity. Partly because copyrightable features are not clearly explained, many parties in these kinds of copyright disputes end up settling out of court, thereby perpetuating the confusion.

While it would be impossible to create a list of “off-limits” features that cannot be recreated in a photo, circuit courts tend to protect the creative decisions a photographer or artist would consciously make in order to create an original work. An attorney should identify any intentional creative decisions that the original artist made and distinguish those creative decisions from the client’s work. Copyright infringement by recreated photographs can be particularly difficult to prove because the subject matter itself is not copyrightable. An attorney can avoid a “substantial similarity” finding—and thereby avoid a copyright infringement finding—by showing that the client did not copy creative decisions of the original artist and instead copied only subject matter. Defining which elements are not substantially similar can guide attorneys and help avoid settling meritless suits out of fear or confusion.

### I. EXPANSION OF COPYRIGHT TO PHOTOGRAPHS

The U.S. Constitution governs copyright law. Article I, Section 8, Clause 8 of the Constitution provides that Congress shall have the exclusive power “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”<sup>1</sup> For many years, copyright law applied only to literal writings and discoveries, but over time Congress expanded the definition of “writings” to include “maps, charts, dramatic or musical compositions, engravings, cuts, prints, paintings, drawings, statues, statuary, and models or designs intended to be perfected as works of the fine arts.”<sup>2</sup> But the United States Supreme Court faced a dilemma in *Burrow–Giles Lithographic Co. v. Sarony*.<sup>3</sup> There, Napoleon Sarony, a famed photographer,

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<sup>1</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>2</sup> *Burrow–Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 56 (1884).

<sup>3</sup> *Id.* at 52.

sued Burrow–Giles Lithographic Company for marketing unauthorized lithographs of a famous photograph Sarony had taken of Oscar Wilde.<sup>4</sup>

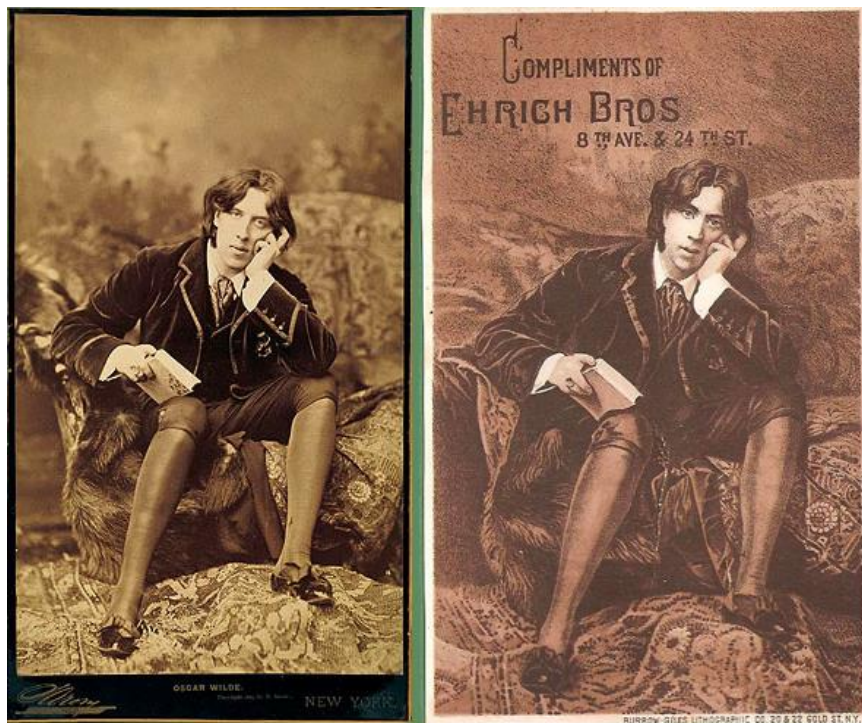


Figure 1: *Left*, Napoleon Sarony’s lithograph. *Right*, Burrow–Giles Lithographic Company’s advertisement.

Congress had not specifically included photographs as protected by copyright law, yet photographs concern the same type of artistic expression as other items included under “writings.”<sup>5</sup> The Court struggled with the scope of Clause 8, but concluded that, because Congress protected “literary productions . . . by which the ideas in the mind of the author are given visible expression,” photographs should also be protected by copyright law.<sup>6</sup> The Court explained:

<sup>4</sup> *Id.* at 54–55.

<sup>5</sup> *Id.* at 56.

<sup>6</sup> *Id.* at 58.

The only reason why photographs were not included in the extended list in the act of 1802 is, probably, that they did not exist, as photography, as an art, was then unknown, and the scientific principle on which it rests, and the chemicals and machinery by which it is operated, have all been discovered long since that statute was enacted.<sup>7</sup>

Because photographs combine a snapshot of reality and an artist's expression of that reality, copyright suits involving photographs are particularly difficult and amount to an extensive sorting assignment between elements of the photograph that the copyright protects and elements that a court would find unprotected.

## II. *HARNEY V. SONY PICTURE TELEVISION, INC.*

In January 2013, the First Circuit handed down a curious decision in *Harney v. Sony Picture Television, Inc.*<sup>8</sup> The court held that, despite the remarkable similarities between two photographs, the publication of the second, nearly identical photograph did not infringe on the copyright of the first.<sup>9</sup> The First Circuit's ruling changed no substantive law. Instead, the court determined whether the protectable elements were "substantially similar" in the second photograph.<sup>10</sup>

The case concerned an original photograph taken by Donald Harney, a freelance photographer. Harney took the photograph during an idyllic Palm Sunday service in the Beacon Hill section of Boston.<sup>11</sup> The photograph features a young girl riding on her father's shoulders. A church stands in the distance.<sup>12</sup> The photograph became widely disseminated in the media after it was discovered that the father depicted in the photograph was actually a German serial imposter who had abducted his daughter during a

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<sup>7</sup> *Id.*

<sup>8</sup> 704 F.3d 173 (1st Cir. 2013).

<sup>9</sup> *Id.* at 186.

<sup>10</sup> *Id.* at 182.

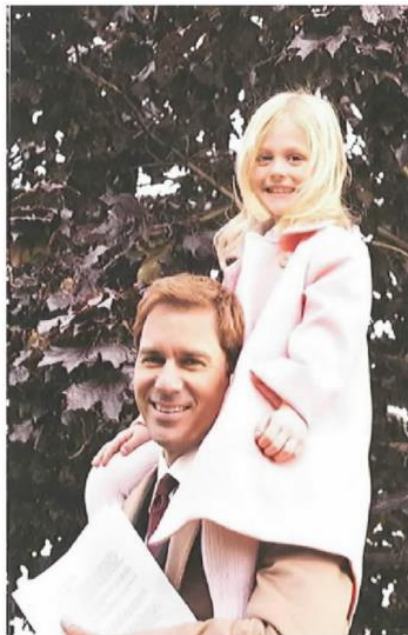
<sup>11</sup> *Id.* at 176.

<sup>12</sup> *Id.*

custodial visit.<sup>13</sup> Sony Pictures later recreated the photo for its dramatic film on the underlying story.<sup>14</sup> Harney then sued Sony Pictures for copyright infringement.<sup>15</sup>



Harney Photo



Sony Image

**Figure 2: Left, Donald Harney's photograph. Right, Sony's promotional recreation.**

The First Circuit affirmed the district court's grant of summary judgment in favor of Sony Pictures, holding that "it is permissible to mimic the non-copyrightable elements of a copyrighted work."<sup>16</sup> Though the two photographs looked nearly identical, the court explained: "[c]opyright protection 'extend[s] only to those components of a work that are original to the author,' and a work that is sufficiently 'original' to be copyrighted may nonetheless contain unoriginal elements."<sup>17</sup> Because Sony Pictures copied only

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<sup>13</sup> *Id.*

<sup>14</sup> *Id.* at 177.

<sup>15</sup> *Id.* at 176.

<sup>16</sup> *Id.* at 178.

<sup>17</sup> *Id.* (quoting *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340,

unprotected elements, including the subject matter and pose, the photographs shared “factual content . . . but not Harney’s expressive elements.”<sup>18</sup>

*Harney* provides guidance to attorneys defending a copyright suit involving visual art and photographs. If an attorney can successfully argue that the client only copied unprotected elements from the original work—no matter how many of those unprotected elements were copied—the attorney may defeat a copyright violation claim.

### III. ELEMENTS OF COPYRIGHT INFRINGEMENT

In 1991, the Supreme Court held that a person alleging a copyright infringement must show: “(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.”<sup>19</sup> The second element typically is contested among parties in a copyright suit, and can be further broken down into two prongs: (1) actual copying and (2) copying of original elements.

#### *A. Actual Copying*

A plaintiff can prove actual copying through direct evidence.<sup>20</sup> In *Rogers v. Koons*, the visual artist Jeff Koons provided his employees with a photograph of a couple holding puppies, taken by the plaintiff Art Rogers.<sup>21</sup> Koons directed the employees to copy “the very details of the photograph that embodied plaintiff’s original contribution—the poses, the shading, the expressions . . .”<sup>22</sup>

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348 (1991)).

<sup>18</sup> *Id.* (quoting *Harney v. Sony Pictures Television, Inc.*, CIV.A. 10-11181-RWZ, 2011 WL 1811656, at \*2 (D. Mass. May 12, 2011), *aff’d*, 704 F.3d 173 (1st Cir. 2013)).

<sup>19</sup> *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991).

<sup>20</sup> *Rogers v. Koons*, 960 F.2d 301, 307 (2d Cir. 1992).

<sup>21</sup> *Id.* at 305.

<sup>22</sup> *Id.* at 307.





Figure 3: *Left*, Art Rogers' photograph. *Right*, Jeff Koons' sculpture.

In granting summary judgment to the plaintiff, the Second Circuit explained that the “undisputed direct evidence of copying is sufficient to support the district court’s granting of summary judgment.”<sup>23</sup> Moreover, “proof of actual access or strong likelihood of access to copyrighted works increases exposure to liability for copyright infringement.”<sup>24</sup> Thus, while a plaintiff can show infringement by proving actual copying, the vast majority of cases lack sufficient evidence to prove actual copying, and to succeed a plaintiff must make an adequate showing that the challenged work is “substantially similar.”

### *B. Substantial Similarity*

When a visual work of art has not been literally copied and no direct evidence of copying exists, courts must determine whether, despite some differences in works of art, one work has infringed on the copyright of another. Not all copying constitutes copyright infringement.<sup>25</sup> The copyright only protects original elements.<sup>26</sup> Courts look to whether the two works of art are “substantially similar,” focusing only on the elements of the first item that are protected by a valid copyright. However, courts have struggled to define “substantial similarity” when evidence of actual copying is

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<sup>23</sup> *Id.*

<sup>24</sup> ANN BARTOW, COPYRIGHTS AND CREATIVE COPYING 83 (2004).

<sup>25</sup> *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991).

<sup>26</sup> ROBERT C. OSTERBERG & ERIC C. OSTERBERG, SUBSTANTIAL SIMILARITY IN COPYRIGHT LAW 1–1 (Practising Law Institute, 2011).

missing. While substantial similarity is not one of the elements of copyright infringement, courts factor whether two works are substantially similar to “adjudicate whether copying of the ‘constituent elements of the work that are original’ actually occurred when an allegedly infringing work appropriates elements of an original without reproducing it *in toto*.”<sup>27</sup>

Attorneys who represent a client charged with copyright infringement need to dissect each element of the work of art and decide at what point (if any) infringement has occurred. “The problem, then, is one of line drawing. Somewhere between the one extreme of no similarity and the other of complete and literal similarity lies the line marking off the boundaries of ‘substantial similarity.’”<sup>28</sup> Circuit courts complicate the matter by applying different “substantial similarity” tests in different ways.

#### IV. AVOIDING LIABILITY FOR INFRINGEMENT

For a copyright violation to be present, the plaintiff must prove that the traits of the defendant’s work “that he or she alleges are infringing are: (1) *similar to* (2) *elements* in the plaintiff’s work that reflect or constitute the *plaintiff’s original expression*, (3) which, when viewed in the context of the plaintiff’s work as a whole, are *substantial*, both qualitatively and quantitatively.”<sup>29</sup>

Several paths are available for an attorney to shield clients from copyright infringement liability. As an initial matter, an attorney should know which test the circuit court will use to determine substantial similarity.

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<sup>27</sup> Range Rd. Music, Inc. v. E. Coast Foods, Inc., 668 F.3d 1148, 1154 (9th Cir. 2012).

<sup>28</sup> 4–13 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT: A TREATISE ON THE LAW OF LITERARY, MUSICAL AND ARTISTIC PROPERTY, AND THE PROTECTION OF IDEAS § 13.03 (M. Bender, 1978) (citation omitted).

<sup>29</sup> Joshua M. Dalton & Sara Cable, *The Copyright Defendant’s Guide to Disproving Substantial Similarity on Summary Judgment*, LANDSLIDE, July/Aug. 2011, at 29.

## 1. Circuit Tests for “Substantial Similarity”

Circuit courts in copyright infringement cases use different tests to determine whether substantial similarity exists and infringement occurred. Typically, most “courts use one of two tests: the more discerning ordinary observer test associated with the Second Circuit or the extrinsic/intrinsic test associated with the Ninth Circuit.”<sup>30</sup> The Tenth Circuit’s abstraction-filtration-comparison test is also popularly used. While these tests are similar and will not drastically change the analysis an attorney must do for the client, an attorney must be aware that different courts choose to use slightly different tests that bring the jury into the analysis at different points. Because a jury may view a work through a different lens, an attorney should keep in mind when the court will rely on a jury and which test will be used.

### a. The Second Circuit’s “More Discerning Ordinary Observer Test”

The Second Circuit typically uses the “ordinary observer test” to decide whether substantial similarity exists. “The ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same.”<sup>31</sup> However, in copyrightable photographs, both protectable and unprotectable elements exist.<sup>32</sup> Because not all of the elements in a photograph can be copyrighted, the Second Circuit abides by a slightly different rule that takes into account unprotectable elements. For these works of art, the Second Circuit uses the “more discerning ordinary observer test”: “where we compare products that contain both protectible [sic] and unprotectible [sic] elements, our inspection must be ‘more discerning’; we must attempt to extract the unprotectible [sic] elements from our consideration and ask whether the *protectible* [sic] *elements, standing alone*, are

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<sup>30</sup> OSTERBERG & OSTERBERG, *supra* note 26, at 3.

<sup>31</sup> *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).

<sup>32</sup> *Feist Publications, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 361 (1991).

substantially similar.”<sup>33</sup> Thus the Second Circuit, and any court that follow its test, first separates the unprotectable from the protectable, and only *then* does the court apply its “more discerning ordinary observer test” to find substantial similarity. The First Circuit, Third Circuit, Fifth Circuit, and Seventh Circuit frequently apply the “ordinary observer test.”

b. The Ninth Circuit’s “Intrinsic/Extrinsic Test”

The Ninth Circuit departed from the Second Circuit and its followers to determine substantial similarity in *Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp.*<sup>34</sup> Initially, the Ninth Circuit created a two-part test: the “extrinsic test,” to be determined by the judge, and the “intrinsic test,” to be determined by the jury.<sup>35</sup> The court went on to refine the difference between the extrinsic and intrinsic test. The extrinsic test “depends not on the responses of the trier of fact, but on specific criteria which can be listed and analyzed.”<sup>36</sup> The criteria can “include the type of artwork involved, the materials used, the subject matter, and the setting for the subject. Analytic dissection and expert testimony are appropriate. Moreover, this question may often be decided as a matter of law.”<sup>37</sup> If the court finds similarity exists under the “extrinsic test,” it moves on to the second part of the test.

In the “intrinsic test,” the fact finder decides whether the works are substantially similar “by the observations and impressions of the average reasonable reader and spectator.”<sup>38</sup> Recognizing that district courts were analyzing intrinsic items under the extrinsic test, the Ninth Circuit later clarified that the extrinsic test is an objective analysis of expression, while the intrinsic test could be described as a subjective analysis of expression.<sup>39</sup> As part of the

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<sup>33</sup> *Knitwaves, Inc. v. Lollytogs Ltd. (Inc.)*, 71 F.3d 996, 1002 (2d Cir. 1995).

<sup>34</sup> 562 F.2d 1157 (9th Cir. 1977).

<sup>35</sup> *Id.* at 1164.

<sup>36</sup> *Id.*

<sup>37</sup> *Id.*

<sup>38</sup> *Id.* (quoting *Twentieth Century-Fox Film Corp. v. Stonesifer*, 140 F.2d 579, 582 (9th Cir. 1944)).

<sup>39</sup> *Shaw v. Lindheim*, 919 F.2d 1353, 1357 (9th Cir. 1990).

extrinsic test, a court is to identify protected and unprotected elements.<sup>40</sup> The Fourth Circuit and the Eight Circuit also follow the “intrinsic/extrinsic” test.

c. The Tenth Circuit’s “Abstraction-Filtration-Comparison Test”

The Tenth Circuit uses the “abstraction-filtration-comparison test,” which initially was used solely for computer copyright infringements.<sup>41</sup> The abstraction level dissects the work into varying levels of generality, typically filtering “ideas” from “expressions.”<sup>42</sup> The court then “examine[s] each level of abstraction in order to filter out those elements of the program which are unprotectable.”<sup>43</sup> Finally, the court compares the “remaining protectable elements with the allegedly infringing program to determine whether the defendants have misappropriated substantial elements of the plaintiff’s program.”<sup>44</sup> The Tenth Circuit’s test is chiefly derived from the Second Circuit’s “more discerning ordinary observer test.”<sup>45</sup>

2. Filtering Unprotected Elements

As a general matter, most courts first decide which elements of the original photograph are *not* copyrightable and then move through the remaining elements and compare those with the work of art in question.<sup>46</sup> This process can severely burden or lighten the workload of the defense attorney. The attorney can mitigate damage by showing the court that additional elements are unprotected in the plaintiff’s work. A failure to address which

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<sup>40</sup> *Mattel, Inc. v. MGA Entm’t, Inc.*, 616 F.3d 904, 913 (9th Cir. 2010).

<sup>41</sup> *Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, 9 F.3d 823, 834 (10th Cir. 1993).

<sup>42</sup> *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 120 (2d Cir. 1930).

<sup>43</sup> *Gates Rubber Co.*, 9 F.3d at 834.

<sup>44</sup> *Id.*

<sup>45</sup> *See Mitel, Inc. v. Iqtel, Inc.*, 124 F.3d 1366, 1370 (10th Cir. 1997); *Country Kids ’N City Slicks Inc. v. Sheen*, 77 F.3d 1280, 1284 (10th Cir. 1996).

<sup>46</sup> *See Gates Rubber Co.*, 9 F.3d at 833; *Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp.*, 562 F.2d 1164 (9th Cir. 1977); *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).

elements are unprotected may cause traditionally unprotected elements to evade filtration, thereby subjecting the client to further liability if substantial similarity is found in the remaining protected elements.

Courts have consistently held that copyright protection does not 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.”<sup>47</sup> Additionally, “[t]wo photographs are not substantially similar . . . merely because they capture the same object or subject, or even because they capture a similar subject in a similar pose, if that pose is part of the subject’s natural movement or is otherwise common or predictable.”<sup>48</sup> A mere copying of a subject is also unprotectable because it is an uncopyrightable idea.<sup>49</sup>

For example, in *Kaplan v. Stock Mkt. Photo Agency*, the Southern District of New York described unprotectable elements of a photograph.<sup>50</sup> In that case, two photographs depicted a scene in which a businessperson contemplated leaping from a tall building onto the bustling city street below. The court held that “nearly all the similarities between the works arise from noncopyrightable elements, thus rendering the works not substantially similar. . . . As the photograph’s central idea, rather than Kaplan’s expression of the idea, this subject matter is unprotectable in and of itself.”<sup>51</sup> The pose of the subject, the clothes, and the viewpoint were also found to be unprotectable, as none of these elements were unusual to the subject matter of the photo.<sup>52</sup>

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<sup>47</sup> 17 U.S.C.A. § 102 (West 2014).

<sup>48</sup> OSTERBERG & OSTERBERG, *supra* note 26, at 10-3.

<sup>49</sup> *Id.*

<sup>50</sup> *Kaplan v. Stock Mkt. Photo Agency, Inc.*, 133 F. Supp. 2d 317, 323 (S.D.N.Y. 2001).

<sup>51</sup> *Id.*

<sup>52</sup> *Id.*

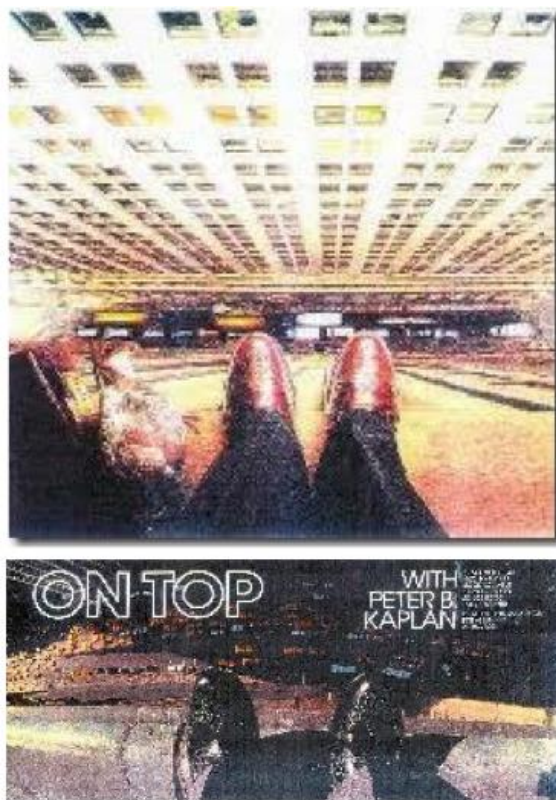


Figure 4: *Top*, defendant's image. *Bottom*, plaintiff's image.

Additionally, filtering can put a client in the same positions as those defendants in *Harney*. An attorney may try to show the court that every similar element is actually unprotectable, leaving the peculiar situation where the works look exceptionally similar but the court decides no infringement has occurred. The bulk of an attorney's work should go toward proving that the similar elements in the two works are unprotected elements, and thus subject to copying without infringement. Indeed, Sony's attorneys took this course in *Harney*, urging the court to recognize that all of the copied elements were unprotectable.<sup>53</sup>

Some circuits have held that when enough unprotectable elements are used in the same manner as in the original work,

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<sup>53</sup> Brief for Appellees at 14, *Harney v. Sony Pictures Television, Inc.*, 704 F.3d 173 (1st Cir. 2013) (No. 11-1760).

copyright infringement will be found. This caveat is likely to be unhelpful in the copyright of visual artists because it is typically applied to the copyright of information and computer programs.<sup>54</sup>

When advocating for a client, an attorney should lump elements together in broad unprotectable categories. An attorney may do so by taking one of the unprotectable filters (“ideas” or “subject”) and show how the plaintiff attempts to copyright that unprotectable element:

While the dividing line between an (unprotectable) idea and (protectable) expression is notoriously vague, a defendant should attempt to extrapolate the concepts within the plaintiff’s work as broadly as possible, and recast the similarities alleged as extending to those high level concepts only, and not to the plaintiff’s specific expression of those concepts.<sup>55</sup>

By recasting an element as unprotectable, the attorney no longer needs to focus on that portion of the art. Additionally, the more elements declared unprotectable, the more difficult it becomes for a court to find copyright infringement on the remaining elements. A defense attorney’s best argument is to show that all the similarities in the photo are of unprotected elements.

### 3. Distinguishing Protected Elements

Once unprotectable elements have been sorted out of an infringement claim, the remaining elements are left open to a substantial similarity accusation. “The copyrightable elements of a photograph have been described as the photographer’s ‘original’ ‘conception’ of his subject, not the subject itself.”<sup>56</sup>

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<sup>54</sup> Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345 (1991).

<sup>55</sup> Dalton & Cable, *supra* note 29, at 26–29.

<sup>56</sup> Kisch v. Ammirati & Puris Inc., 657 F. Supp. 380, 382 (S.D.N.Y. 1987).





Figure 5: *Left*, plaintiff’s photograph. *Right*, defendant’s photograph.

Courts have agreed that “the copyrightable elements include such features as the photographer’s selection of lighting, shading, positioning and timing.”<sup>57</sup> In *Kisch v. Ammirati & Puris Inc.*, the court denied summary judgment to defendants and “conclude[d] that a rational trier of fact could find sufficient similarities to prove ‘copying.’”<sup>58</sup>

While the court recognized differences between the two photos, it identified “many similarities.” For example, the two photographs were taken from the same location, the “same small corner of the Village Vanguard nightclub” in New York City. The lighting and camera angle were similar. In both photographs the subjects are seated and holding a musical instrument, and “[t]he same striking mural appears as the background for each photograph.”<sup>59</sup> But ultimately, though the subject matter (unprotectable) was dissimilar from the original photo, these protected elements showed substantial similarity.

<sup>57</sup> *Id.*

<sup>58</sup> *Id.* at 384.

<sup>59</sup> *Id.*

*Mannion v. Coors Brewing Co.*<sup>60</sup> has provided attorneys and artists with some direction in defining “substantial similarity.” In *Mannion*, the United States District Court for the Southern District of New York concluded “[a] photograph may be original in three respects:” rendition, timing, and creation of the subject.<sup>61</sup> The court clarified: “First, ‘there may be originality which does not depend on creation of the scene or object to be photographed . . . and which resides [instead] in such specialties as angle of shot, light and shade, exposure, effects achieved by means of filters, developing techniques etc.’”<sup>62</sup> The court referred to this type of originality as “originality in the rendition because, to the extent a photograph is original in this way, copyright protects not *what* is depicted, but rather *how* it is depicted.”<sup>63</sup> A photograph may be original in a second respect. “[A] person may create a worthwhile photograph by being at the right place at the right time.” *Mannion* classifies these protected elements into clear categories, which can be helpful for an attorney trying to show the client did not infringe. In order to do so, an attorney will try to distinguish the protected elements in the client’s work from the protected elements in the plaintiff’s work.

Copyright infringement, not surprisingly, cannot be avoided by changing the medium. “The governing principle is that despite differences in appearance that result from a change in the medium, if the ordinary observer familiar with the photograph would recognize the new work as having been taken from the expressive elements of the photograph, the works are substantially similar.”<sup>64</sup> Thus, while a change in medium can add ammunition to an argument that the protected elements are too dissimilar to show substantial similarity, an attorney must go beyond this argument and show why other protected elements in the plaintiff’s work are so different that substantial similarity cannot be shown.

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<sup>60</sup> 377 F. Supp. 2d 444 (S.D.N.Y. 2005).

<sup>61</sup> *Id.* at 452.

<sup>62</sup> *Id.*

<sup>63</sup> *Id.*

<sup>64</sup> OSTERBERG & OSTERBERG, *supra* note 26, at 10-3.

#### 4. Raising Affirmative Defenses

If an attorney is unable to persuade the court that unprotected elements of the disputed piece are dissimilar, the attorney can raise a number of affirmative defenses. The most common defense is one of fair use, though many defenses are available under copyright law. Two doctrines are particularly relevant to infringement of photos: merger and *scenes a faire*.

##### a. Merger

Ideas are not copyrightable. In some cases, the expression of a certain idea is so close to the idea itself, the expression “merges” with the idea, and is not copyrightable.<sup>65</sup> Merger is a judicially created rule and recognizes that some ideas can only be expressed in a limited number of ways. Thus, if an idea can only be expressed in a few different ways, a court will likely rule that expression is unprotected. To rule otherwise may prohibit expression of the idea. An attorney using “filtering” may apply the doctrine of merger to elements where the expression is limited by the idea itself.

##### b. *Scenes a Faire*

Under the doctrine of *scenes a faire*, “courts will not protect a copyrighted work from infringement if the expression embodied in the work necessarily flows from a commonplace idea.”<sup>66</sup> *Scenes a faire* differs from merger in that *scenes a faire* refers to the most common way to express an idea, while merger may refer to the *only* way to express an idea.

In *Reece v. Island Treasures Art Gallery, Inc.*, a photographer sued an art gallery for copyright infringement, alleging that the art gallery was displaying an unauthorized stained-glass reproduction of a photograph of a hula dancer.<sup>67</sup>

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<sup>65</sup> See *CCC Info. Servs., Inc. v. Maclean Hunter Mkt. Reports, Inc.*, 44 F.3d 61, 64 (2d Cir. 1994).

<sup>66</sup> *Ets-Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1082 (9th Cir. 2000).

<sup>67</sup> *Reece v. Island Treasures Art Gallery, Inc.*, 468 F. Supp. 2d 1197, 1199

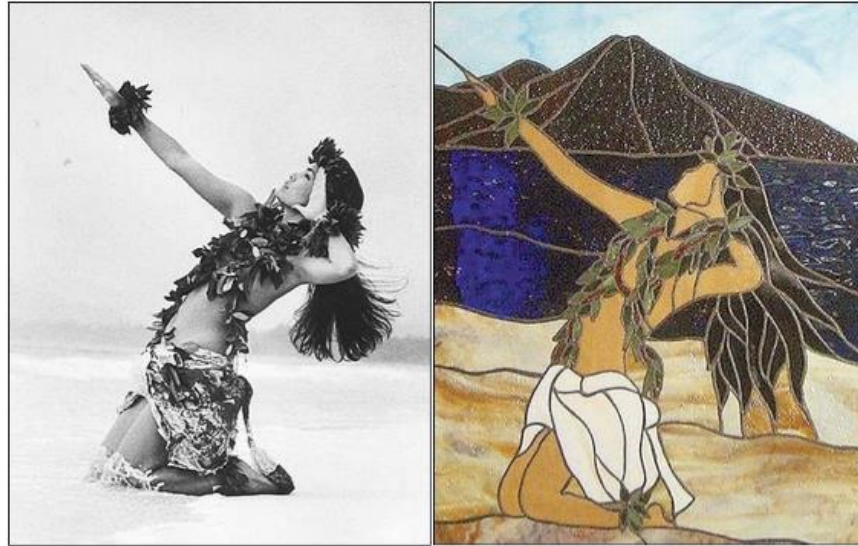


Figure 6: *Left*, plaintiff’s photograph. *Right*, defendant’s stained glass artwork.

After the court “separate[d] the protectable from the unprotectable elements,” it found “[e]lements particular to the hula kahiko tradition are *scenes a faire*.”<sup>68</sup> Specifically, the court held that the positions and features were “indispensable, naturally associated with the motion,” and the “dancer’s hula kahiko dress” was “required.”<sup>69</sup> Because these elements were *scenes a faire*, they were not protected by copyright.<sup>70</sup>

#### CONCLUSION

Despite the different tests that circuit courts use when determining copyright infringement, most courts follow the same general path. An attorney advocating for a client charged with copyright infringement should try to prove (1) the similar elements are unprotectable; (2) the protected elements that remain are

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(D. Haw. 2006).  
<sup>68</sup> *Id.* at 1207.  
<sup>69</sup> *Id.*  
<sup>70</sup> *Id.*

dissimilar and therefore the works cannot have “substantial similarity;” and (3) the defendant had the right to use the material under affirmative defenses. In dissecting the original copyrighted image into protectable and unprotectable elements, defending attorneys should attempt to recast those elements of the original image that are seemingly protected into elements that are unprotectable as a matter of law. Attorneys can do so by broadening the scope of the protected element.

#### PRACTICE POINTERS

- Apply filtration extensively to eliminate as many elements as possible from the protected category.
- Analogize protected elements broadly to unprotected elements.
- After all unprotected elements have been filtered and defenses have been raised, argue that any similarity in the remaining elements is minimal and does not constitute substantial similarity.
- Dissect each element into the smallest parts possible.
- After filtering unprotected from protected elements, apply defenses and use merger and *scenes a faire* to move more elements out of the protected category.