

USING PHOTOGRAPHS OF COPYRIGHTED WORKS **and Trademarks**

An advertising photographer sets up a photo shoot for a toy company. Her photographs feature a young boy in t-shirt and jeans playing with toys in a park. He is artfully arranged in front of a sculpture of a dog, which is temporarily on display in the park. But when the photos are published, both the photographer and the toy company who used her photos in their advertising find themselves facing accusations of copyright infringement. Where did they go wrong?



Photographing a copyrighted work may constitute an unauthorized reproduction.

This article provides an overview of some general legal principles applicable to taking photographs – for commercial or non-private purposes – which feature in them copyrighted works or trademarks. As most lawsuits are filed against the *users* of photographic material, this is as relevant to businesses who use photographs in their advertising, company literature, catalogues etc., as it is to photographers themselves. Though most countries have similar laws in the area of photog-

raphy, important national differences exist. These cannot be covered in a general article of this sort, which is not a substitute for advice from a competent local lawyer.

Advertising, fashion and interior design photographs frequently feature some kind of artistic work, such as a painting on a background wall. Many photographers are unaware, however, that including such a work in a photograph for non-private use without permission from the copyright owner may constitute an **unauthorized reproduction of the work**. As such, it could in some circumstances leave the photographer or publisher of the image liable to judicial pursuit for infringement of the copyright in that work. So when is permission required to photograph copyrighted objects? The response is somewhat complicated. It depends on a number of questions about the *subject* or *object* to be photographed, and about the intended *use* of the photograph.

What is protected?

First, it is worth briefly recalling what sort of objects may be protected by copyright. Most photographers are aware that literary, artistic and photographic works benefit from copyright protection. But how many know that the same protection also extends to maps, globes, charts, advertisements or labels? And that it may also extend to “works of applied art” such as jewelry, wallpaper, carpets, furniture, toys and fabrics? It is all too easy to incorporate such items in a photograph without giving a second thought to the question of whether there may be rights involved which need to be cleared.

Of course, even if an object does fall within the scope of copyright protection, no permission is required to photograph it if the term of copyright protection has already expired. In most countries, copyright protection covers the lifetime of the author (artist) plus 50 years after his death. In a number of countries, this period extends to 70, 90 or 95 years after death. If several authors are involved, then the term of protection is calculated from the death of the last surviving author.

Whether or not permission is required also depends on **how much of the work** appears in the photograph. Generally, prior consent is needed to reproduce a *substantial part* of the work. But there are, and can be, no general rules on this. Often, the *quality* of what is used may be more important than how much is used. For example, “The Son of Man,” a painting from René Magritte, depicts a man whose face is obscured by an apple. If a photographer reproduces only the face with the apple, permission would still be required, though it is only a small part of the total

Tips for photographers

- The best way to protect oneself against lawsuits – when feasible and appropriate – is to get a prior **written permission** from the owner of copyright and other rights in any object or property to be photographed. Even when it is lawful to photograph without authorization, it may be advisable to get permission.
- If a photo is **licensed** to a client for purposes of manufacture, sale or publicity, the licensee should be required to **indemnify** the photographer for any liabilities arising out of the licensed use (this is more a contract law than IP question).
- If written consent has not been obtained for a particular photograph, it may be a good idea to add a **disclaimer** on the back of the picture. This may limit liability should someone make unauthorized use of the photograph.

painting, as it is a vital or recognizable part of Magritte's work. Determining what constitutes a substantial part is done on a case-by-case basis. If in doubt, it is always best to ask prior permission from the copyright owner.

Fair use

The above, if unqualified, would place significant restrictions on the photographer's choice of subject. But a number of important legal exceptions to copyright aim to strike a just balance between, on the one hand, protecting the rights of the copyright holder and, on the other hand, the wider public interest. These exceptions often enable photographers to reproduce copyrighted works without permission. They are enshrined in the concepts of *fair use* or *fair dealing*, in common law, or *limitations* or *exceptions*, specifically mentioned in national copyright law. They vary from country to country, and specific facts and circumstances will determine each case. But common exceptions from copyright protection, in simplified terms, include the following:

Buildings

Architectural works are protected by copyright to some degree, but in most countries a building may be freely photographed if located in – or visible from – a public place. The photo may also be published and distributed without permission.

Copyright works in public places

In some countries, permission is not required to photograph certain artistic works displayed in a public place, such as a park. These photos may also be published and sometimes even commercialized without infringing copyright. However, this exception applies only to

- *works of certain types* (usually works of art or even only three-dimensional works of art);
- *works displayed in public* (permission may on the other hand be required to photograph a sculpture in a private home);
- *works displayed permanently* (whereas permission may be required to photograph a sculpture that is only temporarily sited in a public place, such as the dog sculpture in the park above).

Important legal exceptions to copyright aim to strike a just balance

Photos to accompany news reports

Copyrighted works may be photographed to report the news, although there is generally an obligation to identify its creator and the title of the work. For example, a photograph of a work that won a prize in an art competition can be used in a news report announcing the results of the competition.



Photos to accompany a review or critique

In most countries, copyrighted material may be used to illustrate critiques or reviews, for example, publishing photos of cartoons in a book that reviews or critiques those cartoons. Again, the name of the artist and the work must be indicated.

Photos of a work to advertise its sale

Photographing an artistic work for the sole purpose of advertising its sale, for example, in an auction or sale catalogue, will usually not need prior authorization.

aesthetic purpose or commercial reason, then there is probably no need for permission.

For example: A newspaper publishes a photograph to illustrate a report on a meeting of world leaders. The photograph incidentally shows a copyright-protected sculpture in the meeting room. Authorization would not normally be required as the sculpture adds no meaning to the main subject matter. On the other hand, our photographer in the photo-shoot scenario above deliberately posed the boy in front of the dog sculp-

Changing a Copyrighted Work

It is a common practice for graphic artists and others to download images from the Internet and modify or adapt them by using graphics software. The altered images are often used in magazines, books or advertisements. One of the exclusive rights of a copyright owner is the right to exclude others from creating *derivative works* from his work – that is, new works based upon or adapted from the original work. Care should therefore be taken if digitally manipulating images of other's works, as this is likely to be a copyright infringement unless prior permission has been obtained from the copyright owner.

In the *Mendler v. Winterland Production, Ltd.* case, a photographer granted a textile company a license to use his photographs on t-shirts. The textile company scanned one of the photos and then digitally altered it: the image was flipped, some details were reconstructed and colors were changed. The photographer sued for copyright infringement. The court concluded that this use of the photograph constituted copyright infringement.

See: laws.lp.findlaw.com/9th/9816061.html.

Incidental background

In most countries, permission is not needed to include a copyrighted work in a photograph if it is merely an incidental part of the background, or is otherwise incidental to the principle object/subject represented in the photograph. It may, however, be difficult to assess what is incidental. The photographer should ask himself: Why do I want to include that particular work? If it is essential to the purpose of the photograph, then it cannot be said to be "incidental." Conversely, if it is not in the photograph for any

purpose for aesthetic reasons. As such, the inclusion of the copyrighted work in the background was not incidental. It should be noted that courts are typically much more reluctant to accept free incidental use of works in cases of commercial and advertising use than in connection with the reporting of news and current affairs.

Obtaining permission

If, after consideration of all the above, it transpires that permission is required to reproduce a copy-

righted work in a photograph, the photographer needs to obtain permission from the copyright owner of the work. In addition, permission from the owner of the work itself may be required. Obtaining permission(s) may therefore sometimes be difficult. A gallery or agent, representing the artist, may be able to assist. Some collective management societies also grant copyright permission on behalf of artists.

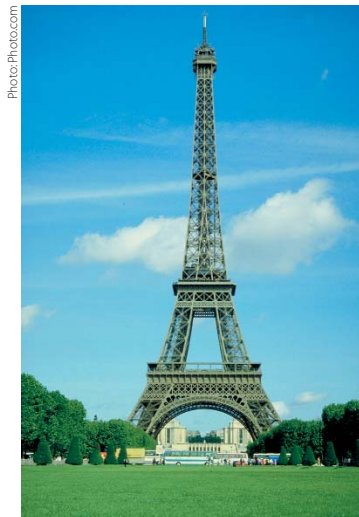
Copyright law also provides authors with **moral rights** to protect their reputation and their works against certain abuses. An important moral right is that of authorship or paternity, which is the right to be named as the author of the work. If a photo including copyrighted works is to be exposed to the public, then the author's name must appear on or in relation to the work, whenever feasible and considered reasonable, unless prior permission to omit the name is obtained from the author or artist.

Photos of trademarks

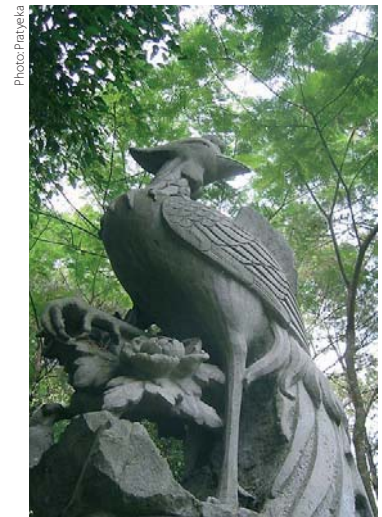
Unlike copyright law, trademark law as such does not restrict the use of a trademark in a photograph. What it does forbid is the use of a trademark in a way that can cause *confusion* regarding the affiliation of the trademark owner to the image. If consumers are likely to mistakenly believe that the trademark owner sponsored a photograph, then there may be trademark infringement. For example, if a Nike logo was visible on the t-shirt worn by the boy in our photo-shoot scenario, this could be seen as an attempt to appropriate consumer goodwill associated with the Nike trademark. So, caution is required if photographing someone wearing or consuming a trademarked product.

Conclusions

A number of fairly complex questions determine when a photographer does – or does not – need to clear rights before photographing copyrighted materials and trademarks for non-private use, and the legal provisions vary from country to country.



The design of the lighting used to illuminate the Eiffel Tower at night is considered a work of art in itself. The Tower's official website states: "There are no restrictions on publishing a picture of the Tower by day. Photos taken at night when the lights are aglow are subjected to copyright law, and fees for the right to publish must be paid to the Société Nouvelle d'exploitation de la Tour Eiffel."



Phoenix near Nanning city, China. Rights would not normally need to be cleared to use a photograph of a copyrighted sculpture on permanent display in a public park.

Photographers need to be aware of the most common legal restrictions as well as of the scope allowed by "fair use" exceptions. But each situation should be evaluated on a case-by-case basis. Similarly, businesses that use images created by photographers need to familiarize themselves with the potential legal liabilities. It is a good practice to require a warrant from the photographer, guaranteeing that the photographer owns or has permission to use all materials provided, and that the contents do not violate any law or regulation.