



Copyright Authorship and Ownership (Including Works Made for Hire — plus Assignments, Transfers)

Copyright
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Konomark
Most rights sharable

IP PITFALL:

Not securing copyright
ownership despite
paying for it

Some important context: Transfers and licenses:

- Copyright transfers (assignments and exclusive licenses) require a signed writing.
- Non-exclusive licenses need not be in writing and can be implied.
- With works made for hire, the employer is the author, and no assignment from worker to hirer is necessary.

[Shown in class but omitted from this posted slidedeck: Photo of sculpture of homeless family with baby and shopping cart on subway grate. The pedestal says. "AND STILL THERE IS NO ROOM AT THE INN."]

Who owns the copyright?

- The general rule: The author (creator) of a copyrighted work owns the copyright.
 - Copyright can be assigned to another person, however.
- Exception: “works made for hire”
 - The copyright to a work made for hire is owned by the hiring party.
 - The hiring party is considered the author of a work made for hire.
 - Determined by 17 U.S.C. § 101.
 - Courts tend to be very strict in applying the statutory requirements.

Two ways a work can constitute a “work made for hire”

- The work is prepared by an employee within the scope of employment
- The work is specially commissioned, under certain circumstances

Employee/scope-of-employment works

- To qualify, there must be a real, bona fide employee/employer relationship.
- The agreement of the parties about the status of their relationship does not control.
- Employment status is determined under the common law of agency. (*CCNV v. Reid*)
- A few of the factors courts look at:
 - Employer's control over the work
 - Employer's control over the employee
 - Employer is in the business of producing such works
 - Indicia of employment: Taxes withheld from employee's pay check, etc.
 - *More on next slide ...*

Employment vs. Independent Contractor Under Agency Principles (*CCNV*)

- hiring party's right to control the manner and means by which the product is accomplished
 - the skill required
 - the source of the instrumentalities and tools
 - the location of the work
 - the duration of the relationship between the parties
 - whether the hiring party has the right to assign additional projects to the hired party
 - the extent of the hired party's discretion over when and how long to work
 - the method of payment
 - the hired party's role in hiring and paying assistants
 - whether the work is part of the regular business of the hiring party
 - whether the hiring party is in business
 - the provision of employee benefits
 - the tax treatment of the hired party
- No one of these factors is determinative.

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Employment vs. Independent Contractor Under Agency Principles

According to empirical work by Prof. Ryan Vacca:

Most important to courts:

- the tax treatment of the hired party
- the provision of employee benefits
- the method of payment

Next most important to courts:

- whether the hiring party has the right to assign additional projects to the hired party
- the skill required
- the source of the instrumentalities and tools

Specially commissioned works

- There must be an express written agreement saying that the work will be considered a work made for hire, signed by both parties, and
- The work must be for use as one of the following:
 - a contribution to a collective work
 - a part of a motion picture or other audiovisual work
 - a translation
 - a supplementary work (e.g., forewords, charts, tables, appendixes, indexes that would accompany the author's main text in a book)
 - a compilation
 - an instructional text
 - a test
 - answer material for a test
 - an atlas

Assignments

- Even without qualifying for work-made-for-hire doctrine, a hirer can still get the copyright through an assignment.
- An assignment requires a writing signed by the assignor with express words of assignment.
- But being an assignee is not as good as being the author under work-made-for-hire doctrine ...
 - An author/assignor can recapture copyright around 35-40 years later through 17 U.S.C. § 203.
 - But if a work is a work-made-for-hire, then there is no statutory recapture.



Question: Who owns the
copyright to wedding photos?



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Let's assume you just agree to pay the photographer \$___ for the wedding photography and there's nothing in writing.

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In this case, the photographer owns the copyright. That means they could commercially exploit your photos, selling them as stock photos.

Review

Would a photographer really sell your wedding photos as stock photography?

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Yes.

Would a photographer really sell your wedding photos as stock photography?



(Note lack of faces.
Copyright and right of
publicity are separate.)

Yes.

How can the hirer get the
copyright?



**How can the hirer end up with the
copyright to the work of the hired
person?**

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Work-for-hire + assignment provision

22.1 Title. Company and University intend this to be a contract for services and each considers the Work and any and all documentation or other products and results of the services to be rendered by Company hereunder to be a work made for hire. Company acknowledges and agrees that the Work (and all rights therein) belongs to and shall be the sole and exclusive property of University.

22.2 Copyright Assignment. If for any reason the Work would not be considered a work-for-hire under applicable law, Company does hereby sell, assign, and transfer to University, its successors and assigns, the entire right, title and interest in and to the copyright in the Work and any registrations and copyright applications relating thereto and any renewals and extensions thereof, and in and to all works based upon, derived from, or incorporating the Work, and in and to all income, royalties, damages, claims and payments now or hereafter due or payable with respect thereto, and in and to all causes of action, either in law or in equity for past, present, or future infringement based on the copyrights, and in and to all rights corresponding to the foregoing throughout the world.

Company agrees to execute all papers and to perform such other proper acts as University may deem necessary to secure for University or its designee the rights herein assigned.

(From: "Miscellaneous Sample Clauses - University of Texas System")

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Company agrees to execute all documents that the University may deem necessary to carry out the provisions of this Agreement and to designate the rights herein assigned to the University.

(From: "Miscellaneous")

FWIW, this typo is original to the UT language. I originally accessed this in 2013, and in 2022, it's still there on their website.

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This is the belt-and-suspenders approach.

Work-for-hire + assignment provision

I like to add something that speaks to a specific category of specially commissioned work, such as “collective work”:

The parties acknowledge that Photographer’s work and services hereunder have been specially ordered or commissioned by Hirer for use by Hirer as a contribution to a collective work.

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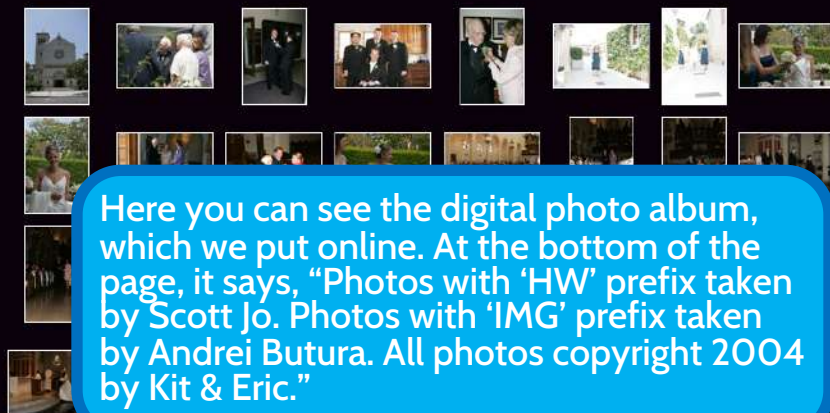
That, in fact, is what I did for my own wedding. And yes, they really were for a collective work ...

This is the belt-and-suspenders approach.

(From: “Miscellaneous System”)



Photos with "HW" prefix taken by Scott Jo. Photos with "IMG" prefix taken by Andrei Butura.
All photos copyright 2004 by Kit & Eric.



Here you can see the digital photo album, which we put online. At the bottom of the page, it says, "Photos with 'HW' prefix taken by Scott Jo. Photos with 'IMG' prefix taken by Andrei Butura. All photos copyright 2004 by Kit & Eric."

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**And now for a
bonus tidbit about
publicity rights,
waivers, and model
releases ...**

How can a hired party commercially exploit photos with faces?



Crystal Smith's Photography

WEDDING DATE: _____
Wedding Photography

Print TWO copies: fill in the following information, read and initial all pages and return. Both bride and groom must sign. The photographer is not responsible for mistakes due to missing or incorrect information.

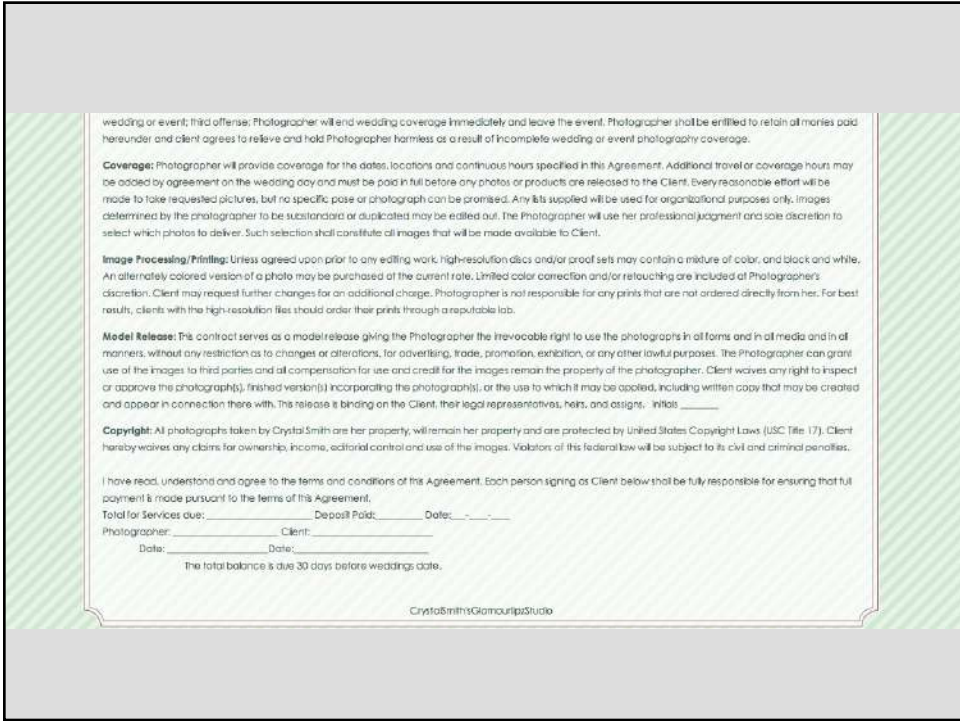
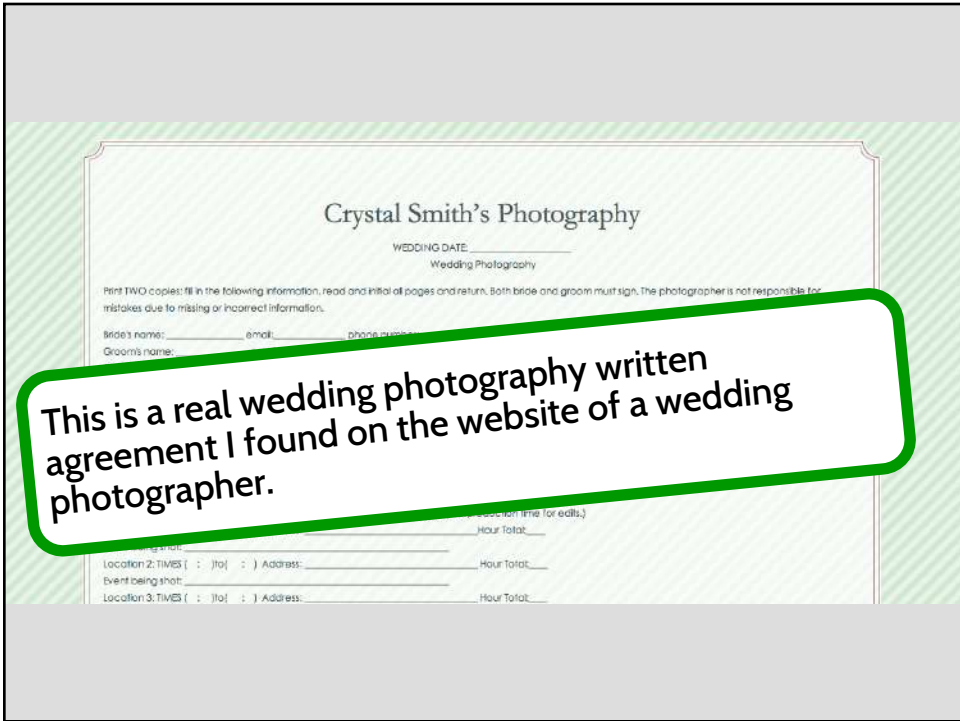
Bride's name: _____ email: _____ phone number: _____
Groom's name: _____ email: _____ phone number: _____
Ceremony time and date: _____
Name of venue: _____
Address: _____
Reception time and date: _____
Name of venue: _____
Address: _____
Color Scheme: _____

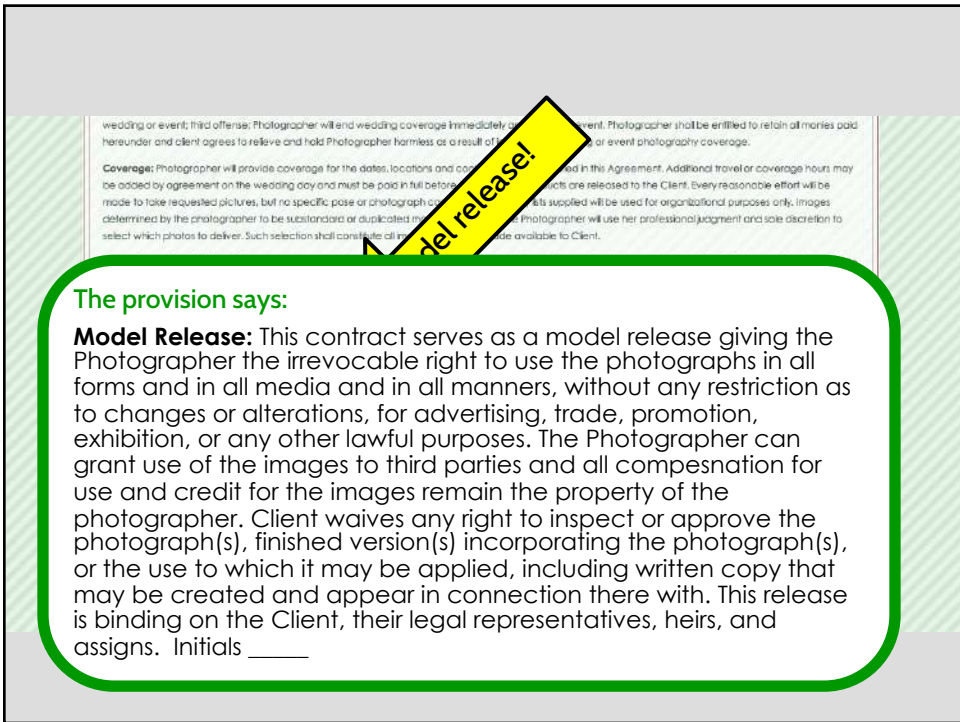
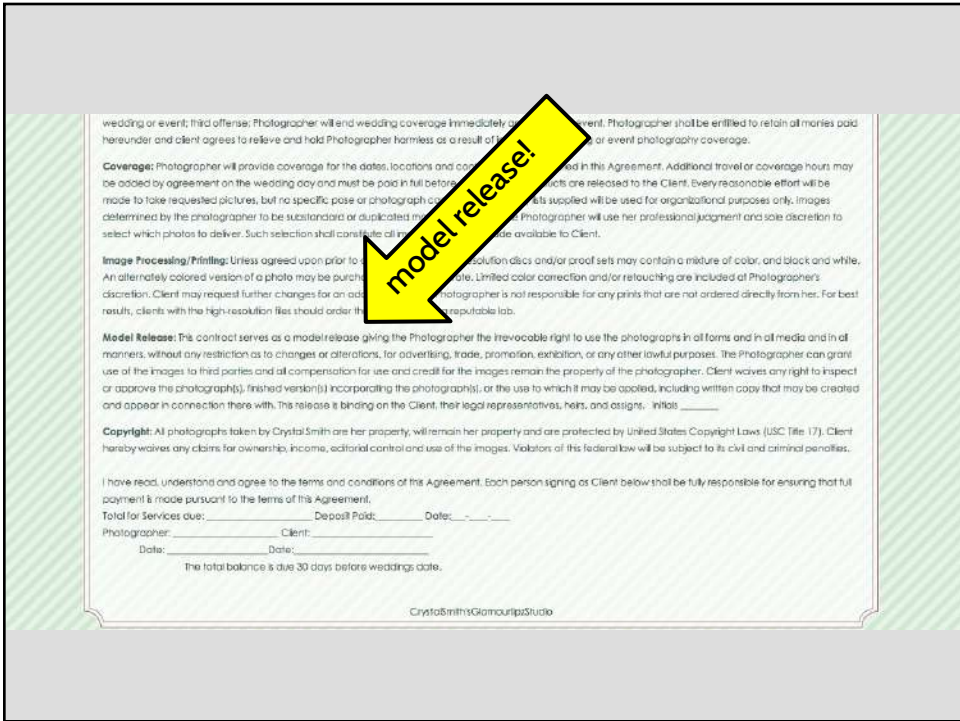
Coverage (\$120 per hour)
(2 hour minimum. Go by 30 minute intervals. I don't charge for the 10 hours postproduction time for edits.)

Location 1: TIMES (:)to(:) Address: _____ Hour Total: _____
Event being shot: _____

Location 2: TIMES (:)to(:) Address: _____ Hour Total: _____
Event being shot: _____

Location 3: TIMES (:)to(:) Address: _____ Hour Total: _____





The provision says:

Model Release: This contract serves as a model release giving the Photographer the irrevocable right to use the photographs in all forms and in all media and in all manners, without any restriction as to changes or alterations, for advertising, trade, promotion, exhibition, or any other lawful purposes. The Photographer can grant use of the images to third parties and all compensation for use and credit for the images remain the property of the photographer. Client waives any right to inspect or approve the photograph(s), finished version(s) incorporating the photograph(s), or the use to which it may be applied, including written copy that may be created and appear in connection there with. This release is binding on the Client, their legal representatives, heirs, and assigns. Initials _____

But would a photographer *really* sell your wedding photos showing your faces as stock photography?

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The screenshot shows a Shutterstock product page for a wedding photo. The main image is a bride and groom sitting at an outdoor cafe table, drinking wine. The page includes a search bar, navigation tabs for 'PHOTOS' and 'FOOTAGE', and a 'Start Downloading' button. The image title is 'Bride and groom drinking wine at an outdoor cafe' with image ID 126725579. Release information states 'Signed model release filed with Shutterstock, Inc.' and copyright 'MNSudle'. There are two license options: 'Standard License JPEG' and 'Enhanced License TIFF'. The JPEG options are: Small (500 x 333, 6.0" x 4.0" [75dpi], 198 KB), Med (1000 x 666, 3.3" x 2.2" [300dpi], 595 KB), and Large (4928 x 3294, 16.4" x 10.8" [300dpi], 10.1 MB). A 'Download' button is visible. Below the main image are links for 'Save to a lightbox', 'Find similar images', and 'Share'. A 'Same Model' section shows a grid of related wedding photos with captions like 'happy bride and gr...', 'bride and groom at...', 'bride and groom dr...', 'groom sampling his...', 'bride and groom in...', 'happy bride and gr...', 'adjusting presents ...', and 'beautiful bride appl...'.

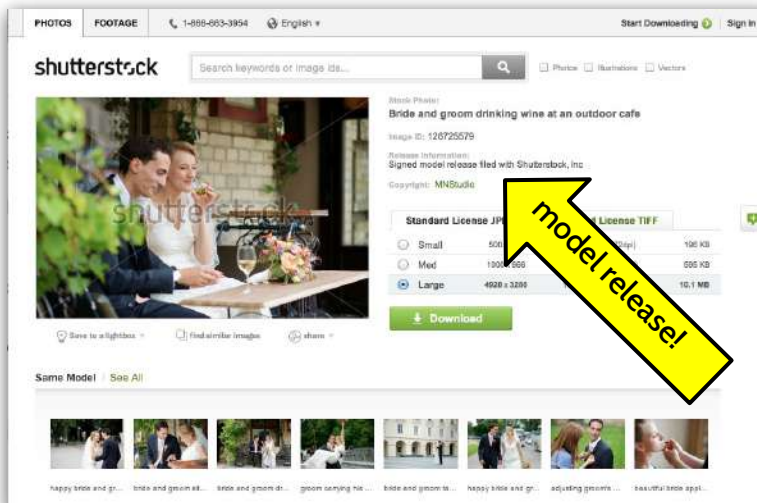
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Note: I don't know the circumstances of this photo. It's possible that this was staged and was not a real wedding, but based on the context of all the other photos of these two people, that seems unlikely. Regardless, with the way U.S. copyright law works regarding ownership, and with the commonness of model releases, it's very plausible that wedding photographers could try to commercially exploit any given couple's wedding photos.

