

The Importance of Being Earnest: Obtaining Copyright Registrations for 20th Century U.S. and Non-U.S. Photo Collections



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IN *BURROW-GILES LITHOGRAPHIC COMPANY V. NAPOLEON SARONY*, the U.S. Supreme Court held it was within the constitutional power of Congress to extend copyright protection to photographs, specifically a photographic portrait of the infamous Victorian playwright, Oscar Wilde. Burrow-Giles argued photography was merely a mechanical process rather than an art, and could not embody an author's "idea." The Court accepted that this may be true of "ordinary" photographs, but this was not in the case of Sarony's image of Wilde. Sarony posed Wilde, suggested his expression and selected his costume, the background, and accessories to create a particular composition. Sarony's control over the subject matter showed that he was the "author" of "an original work of art" over which the Constitution intended Congress to grant exclusive rights.

Today, photo collections by non-U.S. photographers such as Napoleon Sarony, but also works by photographic luminaries such as Henri Cartier-Bresson, Helmut Newton, Man Ray, and others, enjoy enhanced legal protection against infringements in the U.S. because they have certificates of copyright registration issued by the U.S. Copyright Office. This article describes how to ensure that your client's photographs enjoy maximum legal protection by providing a detailed guide to U.S. Copyright Office rules and regulations pertaining to registering copyrights in U.S. and non-U.S. photographs using hypothetical and real-world examples.



HYPOTHETICAL

Your firm has been retained to stop infringements of a priceless collection of world-renowned photographs comprised of both published and unpublished photographs by a deceased photographer having dual U.S. and Italian citizenship whose heirs reside in Monte Carlo, and whose foundation, a French corporation, is headquartered in Berlin, Germany where the collection is located. To make matters interesting, some photos were published before 1978 under the 1909 Copyright Act and some were published after 1977 under the 1976 Copyright Act. All photos were created and published prior to the U.S. joining the Berne Convention in 1989. Although no individual photo copyright was previously registered with the U.S. Copyright Office, serial copyright registrations were filed for several magazines simultaneously published in Paris, London, Rome and New York, embodying editorial and advertising uses of some of the photos. The Board of Directors of the deceased photographer's foundation has authorized your firm to do whatever is necessary to stop the U.S. infringements. After Digital Millennium Copyright Act (DMCA)¹ notices fail to have any effect, your firm is authorized to file lawsuits and obtain injunctions to stop the infringers.

In response to infringement notices, opposing counsel says that threats of litigation are bluffs, and requests copies of the certificates

of U.S. copyright registration covering the photographs allegedly infringed, citing 17 U.S.C. § 411 as a mandatory pre-requisite to filing any lawsuit in U.S. district court. Your client asks for your advice. After reading about the benefits of registering copyrights for both U.S. and non-U.S. works, you advise your client that while registration may not be required to commence U.S. infringement litigation in many cases, statutory and practical advantages of registration make it a valuable and cost effective first step in the stewardship of the copyrights entrusted to the client by the photographer, and recommend that immediate steps should be taken to obtain U.S. copyright registrations protecting every photo in the collection.

You advise that the fastest and most cost effective method of registering copyrights in photo collections is to register the photos as a group, or if first published as a single unit of publication, as a collection, or if first published in a newspaper or magazine, as a contribution to a serial. You explain that an expedited procedure is available at the U.S. Copyright Office by which, for a special handling fee, in certain cases copyright registrations can be processed and certificates issued in five working days rather than the usual nine to twelve months.² You next sort the non-U.S. photographs into the five categories outlined below to determine the appropriate method of registration.

BENEFITS OF REGISTERING COPYRIGHTS AND AFFIXING A COPYRIGHT NOTICE

Although not a prerequisite to copyright ownership, the formality of registering a copyright with the U.S. Copyright Office provides valuable legal benefits for United States Works³ including the right to commence lawsuits for copyright infringement and the right to recover attorneys' fees and costs and statutory damages if the infringement occurred after the effective date of the registration or within three months of the first publication of the work.

Additional legal advantages applying to both United States Works and non-U.S. works include:

- ▶▶ **No Innocent Infringement Defense.** 17 U.S.C. §§ 401(d) and 402(d) provide, that if a proper copyright notice appears on the copy to which an alleged infringer had access, no weight shall be given to a defense based on innocent infringement in mitigation of actual or statutory damages.
- ▶▶ **Presumption of Ownership.** 17 U.S.C. § 410(c) states that in any judicial proceedings the certificate of a registration issued before or within five years after first publication of the work shall constitute *prima facie* evidence of the validity of the copyright and of the facts stated in the copyright registration certificate.
- ▶▶ **"Ticket to the Courthouse."** 17 U.S.C. § 411(a) prohibits filing any lawsuit for infringement of the copyright in any United States Work until preregistration or registration of the copyright claim has been made. An important excep-

tion to the pre-lawsuit registration requirement exists for non-United States Works, discussed *infra*.

- ▶▶ **Statutory Damages, Attorneys' Fees.** 17 U.S.C. § 412(2) provides that no award of "statutory damages" (17 U.S.C. § 504) or attorney's fees shall be made for any infringement of copyright in an unpublished work *commenced before the effective date of its registration* or any infringement of copyright commenced after first publication of the work and before the effective date of its registration, unless such registration is made within three months after the first publication of the work.
- ▶▶ **Avoidance of Orphan Works Treatment.** An "orphan work" is an original work still protected within its term of copyright, but the author or copyright owner cannot be located by someone who wants to use the work and is seeking to contact the holder for permission. The best way to avoid works from becoming orphaned is to attach a copyright notice to all copies of an image, both physical affixation and electronic, by water marking, inserting of meta-data or by other means.⁴

REGISTERING COPYRIGHTS IN PHOTO COLLECTIONS COMPRISED OF UNITED STATES WORKS

There are three basic steps to registering copyrights with the U.S. Copyright Office: 1) completing and filing the copyright registration application ("Application"); 2) depositing the required number of the correct form of copies of the works being registered with the Copyright Office ("Deposit") discussed below; and 3) paying the applicable filing fee ("Fee").

Copyright Registration Application Requirements

Before beginning to complete the Application, counsel should know: 1) the name of each individual author (photographer) corresponding to 2) each individual title of each work in the collection, 3) the year in which any such author died, 4) the correct name of the copyright owner ("Claimant"), if different from the author, 5) the manner in which the copyright was transferred or otherwise acquired by the Claimant, 6) the date of first publication of each individual photo, and 7) whether a copyright notice ("Notice") was affixed to every photo when published and distributed.

The U.S. Copyright Office provides three different methods and forms for registering copyrights in photo collections:

- 1) Electronic filing and electronic deposit (Form eCO)
- 2) Electronic Filing with mailed deposit (Form CO)
- 3) Paper filing with mailed deposit (Form VA or Form TX for automated databases consisting of groups of published photographs)

The following classes of works may be registered electronically with electronic deposit copies:

- 1) Unpublished works;
- 2) Works published only electronically;
- 3) Published works for which the deposit requirement is Identifying Material (ID)⁵
- 4) Published works for which special agreements require hard copy deposits to be sent separately to the Library of Congress.

All other classes of works may be registered via eCO (application and fee payment) but require depositing hard copies of the work(s) being registered. An application and payment may be submitted electronically in eCO. A shipping slip may be printed from the Copyright Office website to be attached to the hard copy(ies) of the work for delivery to the Copyright Office via mail/courier. The shipping slip includes the correct mailing address and zip code for the class of work(s) being registered. To avoid misrouting, the shipping slip should be attached directly to each work or set of works submitted.

To avoid damage to deposit material due to Capitol Hill security measures, the following items should be packaged in boxes rather than envelopes before mailing to the Copyright Office:

- 1) Electronic media such as audiocassettes, videocassettes, CDs and DVDs;
- 2) Microfilm;
- 3) Photographs;
- 4) Slick advertisements, color photocopies and other print items that are rubber- and vegetable-based;
- 5) CDs/DVDs packaged in standard full-sized jewel boxes are more likely to survive the mail radiation process than those packaged in slim-line case.

Great care should be taken in completing the copyright registration application. Notwithstanding the Copyright Office's stated policy of liberally correcting errors on application forms, infringement actions based on incomplete or erroneous applications have been dismissed and registrations invalidated. For example, when Corbis, a photo library, acted as a registration agent for its member photographers, several group registrations it had obtained failed to include the names of every photographer or the titles of the works being registered. As such, the registrations were rejected as improper and incomplete, and were invalidated by at least two different district courts, leaving the photographers without valid registrations.⁶

In other cases, district courts have ruled registrations of collections of published works invalid and dismissed infringement actions because of errors on the copyright registration application forms, and for violating the "single unit of publication" rule.⁷

Copyright Notice Requirements

Since the United States joined the Berne Convention on March 1, 1989, copyright notice is no longer required for copyright protection. Prior to 1978, omission of a proper copyright notice on a published work could result in loss of copyright protection. Omission of a copyright notice on works published between 1978 and 1989 was correctable and generally not fatal to copyright protection. Today, although not mandatory, affixing a proper copyright notice has the legal benefit of increasing the possibility of recovering additional damages for intentional infringement and overcoming a claim of innocent infringement. On the practical side, a copyright notice serves as a form of authorship credit, tells the world the owner takes copyright ownership seriously, and provides the owner's name to contact for licensing rights to use the work. Berne notwithstanding, prominent copyright notices have strong deterrent effect and together with registration give valuable statutory benefits.

17 U.S.C. § 401 provides that if a work protected by U.S. copyright is published anywhere by authority of the copyright owner, a "notice of copyright" may be placed on publicly distributed copies from which the work can be visually perceived. If a notice appears on the copies, it shall consist of three elements: (1) the symbol © (the letter C in a circle), or the word "Copyright," or the abbreviation "Copr.;" (2) the year of first publication of the work; and (3) the name of the owner of copyright in the work. For example, a proper copyright notice may look like either of the following: "© 2013 Jane Shutterbug" or "Copyright 2013 Jane Shutterbug."⁸ 17 U.S.C. § 401(c) requires that the notice shall be affixed to the copies in such manner and location as to give reasonable notice of the claim of copyright. For sound recordings, 17 U.S.C. § 402 says that the notice shall be placed on the surface of the phonorecord, or on the phonorecord label or container, in such manner and location as to give reasonable notice of the claim of copyright.⁹

Copyright Deposit Requirements

For *single photos first published in books or magazines*, the copyright to which magazines or books have not already been registered with the U. S. Copyright Office, the Copyright Office generally requires deposit of originals or photocopies¹⁰ of:

- 1) The page on which the copyright notice appears;
- 2) The masthead page (if different from the notice page);
- 3) The cover of the magazine or book; and
- 4) The page on which the photo appears.

Copies of each magazine and book in which any photo was first published should be located and acquired, as well as copies of each photo first as published.

For a *single registration of a group of photos by the same individual author*, all first published as contributions to periodicals, on a single

application, Copyright Office deposit rules in 17 U.S.C. § 408(c)(2) (A) require depositing one copy of the entire issue of the periodical, (or the entire section in the case of a newspaper in which each contribution was first published. Months or years after the original publication, difficulties of locating copies of old magazines and natural deterioration of newsprint containing acid may make this requirement difficult if not impossible to satisfy.

Registering Single Published Photographs and Collections of Photos First Published as a “Single Unit of Publication”

A single published photograph or an entire unit or package of published photographs; for example, photos in a calendar, a set of baseball cards, or illustrations in a book, can be registered with one application and filing fee using the electronic filing system, eCO, or using paper Form VA.¹¹ Published and unpublished photographs cannot be registered on the same application.

It is important to distinguish procedures for registering copyrights in a “group” of published photos (and the Copyright Office’s pilot program for electronic registration of groups of photographs¹²), from the procedures for registering a “collection” of multiple works, including a collection of photos, on a single registration form. Registration and deposit requirements for a “group” of photographs are different and less strict than the registration and deposit requirements for a “collection” of photographs first published as a single unit of publication, such as in a calendar, a collection of baseball cards, or photos in a book.

Unlike “group” registration procedures for published photographs, registrations of copyrights in “collections” of multiple works (including photos) on a single registration form, (for example a set of playing cards, a collection of greeting cards, or a catalogue,) conceivably consisting of published photographs, are subject to the strict and arcane “single unit of publication” rule.¹³

An explanation of the rules governing registering multiple works on a single application as a collection, together with examples, are found on the Copyright Office’s website.¹⁴

Registering Unpublished Photographs

A single unpublished photograph or an unpublished collection of photographs can be registered with one application and filing fee using eCO or paper Form VA.

For collections of unpublished photographs, the photographs must be neatly assembled, a collection title must be provided, the same party must be the copyright claimant for all the photos and one author must have either created or contributed to all the photos.

Regardless of publication status, a title must be assigned to each photograph deposited. The titles must be specified on both the application form and the deposit itself. Do not use “untitled” as a title. If using eCO, the “contents” title field (not the “alternative titles” field) should be used to list the individual titles. If paper Form VA is being

used, continuation Form CON can be attached to include as many photographs as necessary.

Registering Groups and Collections of Published Photographs

A group of published photographs can be registered on a single form with a single fee if a) all the photographs are by the same photographer (if an employer for hire is named as author, only one photographer’s work can be included); b) all the photographs are published in the same calendar year; and c) all the photographs have the same copyright claimant.¹⁵

Form GR/PPh/CON, which includes Form VA (visual arts application), should be used to register groups of published photographs. Form GR/PPh/CON can be used to register up to 750 photographs on a single application. More than 750 photographs can be registered with a single filing fee using Form VA if the date of publication for each photograph on the images deposited with the application is clearly identified.

Unlike the rules for registering published *collections* of multiple works, (including certain types of collections of photographs) special rules applicable to registering groups of *published photographs* found in 37 C.F.R. § 202.3(b)(10)(i) – (xi) do *not* require all photos in a group registration to have been first published as a “single unit of publication,” only that each photograph in the group was published *within the same calendar year*.¹⁶

Registering Published Contributions to Periodicals

Photographs published in periodicals (newspapers or magazines) in any twelve-month period can be combined on Form GR/CP, which includes Form VA, and submitted with a single filing fee. Form GR/CP is available at the Copyright Office’s website. Special rules apply: 1) the same individual author must have created all the photos; 2) no employer for hire can be named as author; 3) all the photos must have been published as contributions to periodicals within a twelve-month period; and 4) all the photos must have the same copyright claimant.

REGISTERING COPYRIGHTS IN PHOTO COLLECTIONS OF NON-U.S. WORKS

Two important exceptions to the general copyright registration and notice requirements apply to works first published outside the U.S.

Exception to Pre-Lawsuit Registration Requirement

The mandatory requirement in 17 U.S.C § 411 that copyrights be registered with the Copyright Office before filing suit does not apply to photographs and other works which are not “United States Works.” This important exception is of particular importance to non-U.S. authors and motion picture and television companies whose headquarters are located outside the U.S.

Published works, which are exempt from the § 411 registration requirement because they are not “United States Works,” would include:

- ▶ Works first published in a treaty party nation and not simultaneously published¹⁷ in the U.S., regardless of author's citizenship, nationality or habitual place of residence; and
- ▶ Joint works, or corporate-authored audio-visual works, where not all of the joint authors are nationals, domiciliaries or habitual residents of, or in the case of audio-visual works, legal entities with a headquarters in the United States.

Unpublished works, which are exempt from the § 411 registration requirement, include:

- ▶ Joint works, or corporate-authored audio-visual works, where not all of the joint authors are nationals, domiciliaries or habitual residents of, or in the case of audio-visual works, legal entities with a headquarters in the United States; and
- ▶ Pictorial, graphic or sculptural works incorporated in a building which is not located in the United States.

Exception to Notice Requirement: Restoration of Non-U.S. Works in Public Domain for Publication without Proper Copyright Notice

Copyright Office Regulation 202.2, under the 1909 U.S. Copyright Act, provided that copies of photos and other works published in the U. S. or abroad without a copyright notice automatically lost eligibility for copyright protection in the U. S. After 1996, for photos and other works which were not United States Works which lost copyright protection for failing to comply with U. S. copyright formalities, the Uruguay Round Agreements Act ("URAA") restored and revived these copyrights. Under 17 U.S.C. § 104A, U.S. copyright protection which was lost due to a failure to comply with U.S. copyright formalities in a work which was not a United States Work, such as for publication of the work without affixing a copyright notice to every copy published, or a failure to timely file a renewal registration, was restored. Although restoration was automatic, the copyright owner must file a Notice of Intent to Enforce the Restored Copyright with the Copyright Office in order to enforce rights against reliance parties.

Under the URAA, restoration of copyright in works from so-called "eligible countries"¹⁸ occurred automatically on January 1, 1996. However, to be restored, a work must meet certain other requirements:

- ▶ It is not in the public domain in its source country through expiration of the term of protection;
- ▶ It is in the public domain in the United States due to non-compliance with formalities imposed at any time by United States copyright law, lack of subject matter protection in the case of sound recordings fixed before February 15, 1972, or lack of national eligibility;
- ▶ It has at least one author or rightholder who was, at the time the work was created, a national or domiciliary of an eligible country;
- ▶ If published, it was first published in an eligible country and was not published in the United States during the 30-day period following publication in such eligible country.

One example of a registration of a restored copyright under URAA is the May Ray film: *L'etoile de Mer* ("Star of the Sea"). Copies of the film were first publically distributed, (and thus published under U.S. law) in France in 1928 without a proper copyright notice. As a result, pursuant to Copyright Office Regulation 202.2 then in effect, the publication of the film automatically disqualified it for copyright registration in the U.S. and the film entered the public domain in the United States. May Ray died in 1976. Notwithstanding that he was an American citizen, his film was not a United States Work, because the film was first published in France and not published simultaneously in the U.S. Even though the film passed into the public domain in the U.S. in 1928, because it was still protected under the copyright laws of the source nation (France) it qualified for restoration and automatically on January 1, 1996, the deceased copyright in his film was resurrected and "restored" under 17 U.S.C. § 104A. The restored copyright was registered with the U.S. Copyright Office in 2000 using Form GATT which is described below.

HYPOTHETICAL CONTINUED

In order to properly register the photographs described in our hypothetical, you need to first create a schedule tracking the year and country when and where each photo in the collection was first published. Your results are as follows:

| <u>PUBLICATION SCHEDULE FOR HYPOTHETICAL NON-U.S. PHOTO COLLECTION</u> | | | | |
|---|-----------------|-----------------|-----------------|--|
| United States | France | Germany | Italy | Simultaneous Publication in UK, Germany, U.S., France |
| 1972: 10 photos | 1976: 23 photos | 1979: 25 photos | 1981: 11 photos | 1974: 5 photos |
| 1975: 10 photos | 1979: 27 photos | | | 1978: 5 photos |
| 1978: 25 photos | 1980: 29 photos | | | 1986: 11 photos |
| 1980: 15 photos | 1981: 16 photos | | | |
| 1983: 25 photos | 1988: 14 photos | | | |
| 1984: 19 photos | | | | |

You next need to analyze how copyrights of the deceased non-U.S. author are treated under the copyright laws of the author's country of origin. In the hypothetical example above one first must research the duration and formalities (if any) of the country where the author holds citizenship and the particular circumstances of each publication, to confirm each photo is still protected by copyright in the author's country of origin. Use the five categories described below to further sort the photographs and to determine the appropriate method of registration.

Once the legal effect of the publication of each photo under the laws of the photographer's country of origin is understood, the manner in which U.S. Copyright Office treats such foreign copyrights and current U.S. Copyright Office regulations and procedures, filing fees, and forms for registering the copyrights must be understood and followed.

Registration Procedure for Hypothetical Non-U.S. Photo Collection

Registering the copyrights in the hypothetical photo collection is accomplished in three steps:

First, ascertain which of the collection photos were first published with a copyright notice which would be either affixed to the photo itself (for example, in connection with a photo exhibition where copies of the photos were offered or distributed to the public), on the masthead (or elsewhere) of the particular issue of each magazine where the photo was originally published, or on the title page (or elsewhere) of each book where the photo was first published.

Next, sort the collection photos into *five categories*:

Category 1: *Photos First Published by a U.S. Author or a Non-U.S. Author before 1978 in the United States (or Abroad) without an Adequate Copyright Notice.*

Under the 1909 U.S. Copyright Act, copies published in the U.S. "or abroad" without a copyright notice automatically lost eligibility for copyright protection in the U.S. unless subject to automatic copyright restoration under the URRRA. These 'Category 1' photos cannot now be registered. In the hypothetical, any of the ten photos published in the U.S. in 1972 and any of the ten photos published in the U.S. in 1975 which were published as individual photos without a copyright notice, and were not published as editorial content in a book, magazine or other publication with a proper copyright notice, would fall into this category.

Category 2: *Photos First Published by a Non-U.S. Author, Outside the United States, in an Eligible Country¹⁹ without an Adequate Copyright Notice, and Not Published Simultaneously, or Published Within 30 Days Thereafter, in the U.S. Any Time Prior to March 1, 1989.*

Even though photos in this category that were published prior to 1978 entered the public domain, under 17 U.S.C. § 104A, U.S. copyright protection for these photos was restored automatically on January 1, 1996. These photos may be registered using Form GATT, requiring a filing fee of U.S. \$65. It doesn't matter *when* the work was

first published, so long as it is still protected in its "source country" (nation of first publication). However, the author must have been a national or domiciliary of an eligible country when the work was created. All of the photos first published in France, Germany and Italy (but not those published simultaneously in the U.S.), which did not contain a proper copyright notice fall into this category.

Category 3: *Photos First Published by a Non-U.S. Author, Outside the United States, in an Eligible Country with an Adequate Notice before 1978.*

These photos may be registered using Form RE and an RE Addendum, requiring two filing fees: U.S. \$115 (Form RE) + \$220 (Form RE Addendum) = U.S. \$335. The practice of affixing a copyright notice to published copies is uniquely American and thus rarely seen on works published outside the U.S. We will assume for the sake of hypothesis that only three of the twenty-three photos first published in France in 1976 fall into this category.

Category 4: *Photos First Published by a Non-U.S. Author, Outside the United States, in an Eligible Country with an Adequate Notice after 1977.*

These photos can be registered using Form VA, requiring a filing fee of U.S. \$65. A hypothetical 1981 calendar of French fashion models distributed in the U.S. containing sixteen photos first published as a single unit of publication fall into this category and can be registered as a collection with a single registration form and single fee.

Category 5: *Photos First Published by a Non-U.S. Author, Outside the United States, in an Eligible Country with an Adequate Notice, before or after 1978, in a Magazine or Book which was Previously Registered with the U.S. Copyright Office.*

For photos where the copyright in the magazine or book where the photo was first published has already been registered with the U.S. Copyright Office, the RE Addenda form would not be required, just the Form RE, a fee of \$115, and no deposit copy would be required.²⁰ Of the 109 total photos published in France between 1976 and 1988, we will assume ten photos were published in the French magazine *Paris Match*, five in an editorial context and five in advertisements; twelve were published in an editorial in Germany in *der Stern*, and of the eleven photos published in Italian *Vogue*, ten were editorial and one was part of an advertisement. To the extent that the issues of *Paris Match*, *der Stern* and Italian *Vogue* contained a copyright notice on the magazine masthead and were registered with the U.S. Copyright Office, the photos published in an editorial context fall into this category. The photos published in advertisements do not. The same rule applies to the twenty-one photos simultaneously published in the UK, Germany, U.S. and France between 1974 and 1986. Simultaneous publication in London, Paris, Rome and New York is customary for many international fashion magazines such as *Vogue*.

Appropriate forms should be completed and combined with the necessary deposit materials. Applicable filing fees should be calculated and a complete registration package should be transmitted to

the U.S. Copyright Office for processing via Federal Express or other courier service providing proof of delivery.

CONCLUSION

Hopefully the foregoing elucidates ‘the importance of [lawyers] being earnest,’ in advising clients regarding the benefits and complexities of registering copyrights in 20th Century U.S. and non-U.S. photo collections. For more information specifically pertaining to registering collections of published and unpublished photographs, refer to the Code of Federal Regulations and the U.S. Copyright Office’s collection of publications.²¹

AFTERWORD

The Importance of Being Earnest, a Trivial Comedy for Serious People, a play by Oscar Wilde, premiered at London’s St. James Theatre on Valentine’s Day, February 14, 1895. The auspicious occasion was a theatrical success, but marked the beginning of the end of Wilde’s career. The Marquess of Queensberry’s son, Lord Alfred Douglas, was publicly reputed to be Wilde’s lover, an embarrassing situation for the Marquess, famously known for his gentlemanly, yet macho rules for fisticuffs, particularly during the hypocritical and repressed Victorian era, when homosexual relationships were a violation of criminal law. To retaliate against Wilde, the Marquess devised a plan to publicly humiliate Wilde by presenting him with a bouquet of rotten vegetables on the opening night of the play. An assistant tipped Wilde off, and the Marquess’s scheme was foiled when he was refused admittance to the theatre. Undeterred, the Marquess sent Wilde a hand-delivered note in an envelope addressed to “Oscar Wilde, Posing Sodomite,” implying Wilde’s homosexuality. Wilde soon thereafter sued the Marquess for libel. But Wilde’s quick wit proved to be his undoing, when Wilde, on cross-examination was asked why he did not kiss the delivery boy who handed Wilde the defamatory note. Wilde quipped, “He was a very ugly boy,” revealing his homosexual double life. An offer of evidence of Wilde’s meetings with male prostitutes convinced Wilde to drop the criminal libel action. Soon after he was convicted and sentenced to prison, prematurely ending his brilliant career. After his release, he published the play from exile in Paris, wrote no further dramatic work and died soon thereafter.

After years of copyright protection, the Wilde photographic image is now in the public domain in the United States. ◀◀

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Endnotes

1. The Digital Millennium Copyright Act (DMCA) is a United States copyright law that implements two 1996 treaties of the World Intellectual Property Organization. It criminalizes production and dissemination of technology, devices or services intended to circumvent measures that control access to copyrighted works. It also criminalizes the act of circumventing an access control, whether or not there is actual infringement of copyright itself. The DMCA’s principal innovation in the field of copyright is the exemption from direct and indirect liability of internet service providers and other intermediaries.
2. “Special handling” is the expedited processing of an online or paper application to register a copyright. Subject to the Copyright Office’s current workload, special handling is only granted 1) where there is pending or prospective litigation, 2) in customs matters, or 3) when contract or publishing deadlines necessitate the expedited issuance of a certificate. A cover letter explaining the circumstances for the request is sufficient. For most filings, it is best to register online <http://www.copyright.gov/eco/>. For filings that must be mailed, use one of the following addresses: Special Handling, Copyright RAC Division, P.O. Box 71380, Washington, DC 20024-1380. Packages exceeding 12” x 18” x 4” should be sent to: Special Handling, Dept. 100, Washington, D.C. 20540. Deliveries should be via U.S. Postal Service rather than by a private carrier. Express, registered or certified mail options that have tracking capability are recommended. Special handling requires a special handling fee in addition to the registration fee. Copyright Office fees are subject to change. For current fees, check the Copyright Office website at www.copyright.gov. For more information, see Circular 10, Special Handling or 37 C.F.R. § 201.15.
3. 17 U.S.C § 101 defines a work as a “United States Work” only if:
 - (1) in the case of a published work, the work is first published—
 - A) in the United States;
 - B) simultaneously in the United States and another treaty party or parties, whose law grants a term of copyright protection that is the same as or longer than the term provided in the United States;
 - C) simultaneously in the United States and a foreign nation that is not a treaty party; or
 - D) in a foreign nation that is not a treaty party, and all of the authors of the work are nationals, domiciliaries, or habitual residents of, or in the case of an audiovisual work legal entities with headquarters in, the United States;
 - (2) in the case of an unpublished work, all the authors of the work are nationals, domiciliaries, or habitual residents of the United States, or, in the case of an unpublished audiovisual work, all the authors are legal entities with headquarters in the United States; or
 - (3) in the case of a pictorial, graphic, or sculptural work incorporated in a building or structure, the building or structure is

located in the United States.”

4. The pending Orphan Works Act of 2008 (H.R. 5889) would permit both non-profit and for profit organizations to use in any manner without compensation or liability for copyright infringement, any so-called orphan work, including for example, photographs, illustrations, stories, movies, music, written works, etc.

If the copyright owner of a work cannot be located, has moved, has an unlisted address or telephone, has not kept the Copyright Office records of contact information current, is deceased, his or her heirs cannot be located or determined, is a defunct or non-existent publisher, corporation, studio, or if the owner cannot be located because the author is unidentified, anonymous or pseudonymous, the work may be considered to be an orphan work, free for the taking.

If passed, (the bill is opposed by the Association of Media Photographers) the proposed law could be damaging to photographers and other visual artists and authors, shifting the burden of protecting copyrights from the user to the owner, rewarding unauthorized users, and having a disparate adverse effect on creators and non-U.S. authors who have followed the law but have failed to affix a copyright notice to every copy of their work, or failed to register the title of the work with the U.S. Copyright Office.

5. “Identifying material” or “ID material” generally consists of two-dimensional reproduction(s) or rendering(s) of a work in the form of photographic prints, transparencies, photocopies or drawings that show the complete copyrightable content of the work being registered. See the Special Deposit Requirements section of Circular 1 for more on ID material.
6. As administered between approximately 1995 and February 2008, Corbis’ group copyright registration program was rejected as legally deficient and copyright registrations granted through the program were ruled void and invalid in at least two federal district court cases. *Muench v. Houghton Mifflin Harcourt*, 712 F.Supp.2d 84 (2010) [registration failed to identify photographer by name]; and *Bean v. Houghton Mifflin Harcourt*, No. 10-CV-8034, 2010 U.S. LEXIS 83676 (D. Ariz. August 9, 2010) [registrations failed to include titles of works or photographer’s names and failed to identify which photos were by which photographers]. See also, *Alaska Stock v. Houghton Mifflin Harcourt Pub. Co.*, No. 3:09-CV-0061, 2010 U.S. Dist. LEXIS, 108041 (D. Alaska, September 21, 2010.)

Under the terms of Corbis’ program, photographers were asked to assign their copyright temporarily to Corbis for the express purpose of the bulk registrations. Corbis then registered the images as a compilation under its own name, without listing the individual photographers whose images made up the compilation, and then transferred copyright ownership back to the photographers. The company’s decision to forego naming each photographer was based upon an “advisory letter” from the U.S. Copyright Office.

When Muench brought suit against Houghton Mifflin Harcourt for copyright infringement, alleging that HMH exceeded copy limits on over 100 Corbis-issued licenses, the federal district court in New York dismissed the claims. The Corbis registration program registrations were stricken because not every photographer was named on Corbis’ registration application forms. The court gave no weight to the “advisory letter” from the Copyright Office advising Corbis it need not name each photographer. The court also did not excuse the defects under a 2008 provision of

the Copyright Act providing that inaccurate information on an application should not invalidate a registration certificate.

7. *Olander v. Spencer Gifts*, 812 F. Supp. 2d 1070 [reversed on appeal] and *L.A. Printex Industries vs. Aeropostal*, 676 F.3d 841 (9th Cir. 2012). At least one of these actions resulted in a legal malpractice suit against the law firm that prepared and filed the deficient registration applications, *Olander Enterprises vs. Klein, O’Neill & Singh, LLP*, Case No. 30-2012- 00559680 (Orange County Sup. Ct. dismissed May 30, 2013 pursuant to confidential settlement.)
8. See Copyright Office Information Circular 3.
9. For more specific information on the proper placement of the copyright notice on different forms of works see Copyright Office Information Circular 3.
10. In satisfaction of the registration requirement of depositing two copies of the ‘best edition’ of books, in lieu of depositing original publications, the U.S. Copyright Office will accept photocopies of the works as originally published, as well as photocopies of the cover, masthead and copyright notice of magazines and books where photos were first published. Actual books and magazines need not be deposited.
11. See Copyright Office Information Circular 1, “Copyright Basics,” or informational letter SL 35, “Registering a Copyright with the U.S. Copyright Office” for further details.
12. For information about the Copyright Office’s pilot program for electronic registration of groups of published photographs, see Copyright Office publication SL-39.
13. 37 C.F.R. § 202.3(b)(3)(A) provides: “[w]orks that are otherwise recognizable as self-contained may be registered on a single application and upon payment of a single fee, **if they are first published in a single unit of publication** and the copyright claimant of all works in the unit is the same” (emphasis added). 37 C.F.R. § 202.3(b)(4)(i)(A), provides: “Registration as a single work. (i) For the purpose of registration on a single application and upon payment of a single registration fee, the following shall be considered a single work: (A) In the case of published works: all copyrightable elements that are otherwise recognizable as self-contained works, that are included in a **single unit of publication**, and in which the copyright claimant is the same” (emphasis added). A published collection of works must be “sold, distributed or offered for sale concurrently.” *United Fabrics Int’l, Inc. v. C&J Wear, Inc.*, 630 F.3d 1255, 1259 (9th Cir. 2011).
14. The website is www.copyright.gov/eco/help-type.html#collection1 and entitled “*Collection of Published Works: Registration of Multiple Individual Works Contained in the Same Published Work.*” To register multiple individual works contained in the same unit of publication with a single application, the following requirements must be met:

This publication must represent first publication of all the works included in the registration. The registration must exclude any previously published work.

Ownership of every work included in the registration must be the same. This means that if the authors of each work are not the same, they must have transferred copyright to each other or to a common claimant. If any works have different owners, one or more separate applications must be filed to cover all of the works to be registered.

Each application requires a separate fee.

Examples of published collections:

Example 1: CD entitled TORTURED contains nine songs, all published for the first time. Songs 1–8 are by Al and song 9 is by Sue. As each author owns the copyright only in his or her own song(s), use separate applications. Songs 1–8 can be registered with a single application, giving TORTURE as the Title of the Work Being Registered and listing the eight songs as Contents Titles. Song 9 must be registered separately with a separate application, fee, and copy.

Example 2: CD entitled GAME PLAY contains ten songs. Songs 1–4 are by Al & Bill, songs 5 and 6 are by Mike, and songs 7–10 are by Linda. Song 9 appeared in a previously published CD. All authors signed agreements transferring the copyrights in their songs to Merry Songs Company.

As the copyright ownership is the same for all songs in the collection, use a single application. Give GAME PLAY as the Title of the Work Being Registered and list all of the songs except Song 9 as Contents Titles. Song 9 should be excluded because it was previously published. It may be registered separately based on the facts of first publication.

See also, *Compendium of Copyright Office Practices*, (“*Compendium II*”), Rule 607.01: www.copyrightcompendium.com/#607.01.

15. 37 C.F.R. § 202.3(b)(9).

16. 37 C.F.R. § 202.3(b)(10) is as follows: “Group registration of published photographs. Pursuant to the authority granted by 17 U.S.C. 408(c)(1), the Register of Copyrights will accept a single application (on Form VA), deposit and filing fee for registration of a group of photographs if the following conditions are met:

(i) The copyright claimant in all of the photographs must be the same.

(ii) The photographer who photographed each of the photographs submitted for registration as part of the group must be the same person.

(iii) The photographs in the group must have been published within the same calendar year.

(iv) If the photographs in a group were all published on the same date, the date of publication must be identified in space 3b of the application. If the photographs in a group were not all published on the same date, the range of dates of publication (e.g., February 15–September 15, 2004) must be provided in space 3b of the application, and the date of publication of each photograph within the group must be identified either:

(A) On each deposited image;

(B) In a text file on the CD-ROM or DVD that contains the deposited photographic images;

(C) On a list that accompanies the deposit and provides the publication date for each image; or

(D) On a special continuation sheet (Form GR/PPh/CON) provided by the Copyright Office. Dates of publication must be provided in a way that clearly identifies the date of publication for each individual photograph in the group.

(v) If the applicant chooses to identify the date of publication for each photograph in the group on a continuation sheet, the application may include no more than 50 continuation sheets identifying no more than 750 photographs. For these purposes, the applicant must use the special continuation sheet (Form GR/PPh/CON) for registration of a group of photographs made available by the Copyright Office.

(vi) If each photograph within the group was first published within three months before the date on which an acceptable application, an acceptable deposit, and the applicable fee are received in the Copyright Office, the applicant may, in lieu of the procedure set forth in paragraph (b)(10)(iv) of this section, simply state the range of dates of publication (e.g., February 15–May 15, 2001) in space 3b of the application, without specifically identifying the date of publication of each photograph in the group either on the deposited image or on a continuation sheet.

(vii) The deposit(s) and application must be accompanied by the fee set forth in § 201.3(c) of this chapter for a basic registration.

(viii) The applicant must state “Group Registration/Photos” and state the approximate number of photographs included in the group in space 1 of the application Form VA under the heading “Previous or Alternative Titles” (e.g., “Group Registration/Photos; app. 450 photographs”).

(ix) If the photographs in the group are works made for hire, the applicant must note, as part of the applicant’s entry in space 2 of the application Form VA for “Name of Author,” both the name of the employer for hire and the name of the photographer who photographed the works in the group (e.g., “XYZ Corporation, employer for hire of John Doe”).

(x) As an alternative to the best edition of the work, one copy of each photograph shall be submitted in one of the formats set forth in § 202.20(c)(2)(xx).

(xi) Instead of using Form VA, an applicant may submit an electronic application for group registration of published photographs after consultation and with the permission and under the direction of the Visual Arts Division.”

17. Publication is considered “simultaneous” if the work was published in the U.S. within thirty days after first publication in a non-U.S. country.
18. An eligible country is a nation, other than the United States, that is a member of the Berne Convention, or a member of the World Trade Organization, or is the subject of a presidential proclamation declaring its eligibility.
19. France, Germany, Italy and UK are all eligible countries.
20. Special registration rules apply to photos first published as advertisements. If the publication of this photo (or any other photos) was as part of an “advertisement,” a general copyright notice in the front of the magazine is not sufficient.
21. 1) Electronic Registration of Groups of Published Photographs U.S. Copyright Office Pub. No. SL-39 04/2011;
2) Registration of Claims to Copyright, Interim Rule, 37 C.F.R. Part 202, effective 1/24/2011;
3) Registration of Published Photographs, U.S. Copyright Office Pub. No. FL-107, 9/2012; and
4) Group Registration of Published Photographs, U.S. Copyright Office Pub. No. FL-124.