December 2004

Questions & Answers -- Copyright Column

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Recommended Citation

Gasaway, Laura N. (2004) "Questions & Answers -- Copyright Column," *Against the Grain*: Vol. 16: Iss. 6, Article 19.

DOI: <https://doi.org/10.7771/2380-176X.4446>

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Questions & Answers — Copyright Column

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QUESTION: *A speaker at a conference permitted the conference organizers to videotape her presentation. Later she wanted a copy of the presentation to show to a class. Who owns the copyright in the video recording?*

ANSWER: The general rule is that the person or entity creating the work owns the copyright. If the speaker simply granted permission to be videotaped, she did not transfer the copyright in her presentation. But since the conference organizers created the videotape, the conference would hold the copyright in the video recording while the presenter would own the rights in the presentation itself, assuming that it was fixed other than by the videotape.

When granting permission to be videotaped, it is important to specify what can be done with that tape while reserving any rights that the presenter may want. For example, it would have been very easy to specify in the written agreement that the speaker reserves the rights to: (1) have a copy of the videotape and (2) use it in her classes (or however else she may want to use the video). The conference might want the right to sell the videotape or to put it in the conference archives.

QUESTION: *How does a library obtain public performance rights for films that it acquires?*

ANSWER: It is far easier to obtain performance rights at the time the film is acquired rather than afterwards. On the purchase order one can request the public performance rights. The rights may be in-

cluded in the cost of the video or may require a separate royalty. Some video distributors have been licensed by film producers to provide the public performance right. The library should specify the types of performances that it might offer; for example, just in an nonprofit educational institution without any admission charge or as a ticketed performance with an admission fee. One can obtain rights for a single performance or for performances over a period of time.

There are several sources for obtaining public performance rights. **Swank Motion Pictures, Inc.**, (www.swank.com) is a comprehensive licensing agency for films. **Movie Licensing USA** (www.movieic.com) is a division of Swank that provides licenses for K-12 schools and public libraries. The **Motion Picture Licensing Corporation** can provide the public performance rights through a variety of types of licenses (www.mplc.com). **Criterion USA** (www.criterionpicusa.com) is a non-theatrical distributor of feature films licensed for public performance in the United States. For classics and foreign language art films, a good source for public performance rights is **Kino International** (www.kino.com), although some of the films are for theatrical performance only. Another source for foreign films is **New Yorker Films** (www.newyorkerfilms.com).

QUESTION: *A library is sponsoring a book talk by a famous author. In order to advertise the event, the library wants to scan the book jacket from the*

author's latest book and use it on flyers and posters. Does this infringe copyright?

ANSWER: Yes, reproducing the book jacket without permission is copyright infringement. The publisher holds copyright in the book jacket although it may simply have a license to use the artwork on the cover. It is often possible to obtain permission to use a book jacket at no charge for the purpose of advertising the author and even offering his books for sale at the event. The library should contact the publisher to obtain permission to use the book jacket in advertisements for the event.

QUESTION: *If a library has a licensed database, may a reference librarian use that database for answering a question from a non-affiliated user? What about supplying that individual user with a copy of an article from that database? Does it matter that the database has an email option to forward articles to users?*

ANSWER: Certainly, the reference librarian may use the database to answer a reference question for anyone. However, the license agreement controls, and if the license says that articles in the database may be accessed and reproduced only by students, faculty and staff of the institution or registered borrowers, then supplying the article to someone who is not covered violates the license agreement. What one can do is answer the question, provide a citation to the article and explain that under the library's license agreement, it cannot provide a copy of the article to someone who is not covered. With the citation, the user might be able to access the article in a local public library with a different type of license agreement or obtain it from a printed source through interlibrary loan.

The email option does not mean that the library may ignore the license agreement. The email option is there so that one may email an article to an authorized user of the database. So, a librarian could forward an article to a student, faculty member in the institution, etc., but not to an outside patron.

QUESTION: *If a copyright is held by two or more people, must all of the owners agree to allow someone to post the material on the Web?*

ANSWER: No, the general rule is that joint ownership of copyright means that the owners are "tenants in common." This means that each owner holds an undivided interest in the copyrighted work. One owner may transfer the copyright to another without consulting other owners, license others to use the work, etc. That owner is required to account to the other owner or owners and to share the proceeds of any license or transfer on an equal basis. It is possible to own a copyright on a different basis but this requires a different

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material for a test, or 9) an atlas.¹⁸ If the work falls into one of these categories, the parties can have a written agreement to treat the product as a work for hire.

Even if the work of an independent contractor does not fall into one of the categories in the statute, you still may be able to include a valid transfer of ownership provision in a contract. The **Copyright Act** says: "ownership of a copyright may be transferred in whole or in part by any means of conveyance."¹⁹ For example, suppose that the contract between **CCNV** and **Reid** had included the following provision:

James Earl Reid (hereinafter, "Seller"), a sculptor with principal place of business in Baltimore Maryland, for valuable consideration, the receipt and sufficiency of which is hereby acknowledged, hereby sells, transfers, assigns, conveys, and delivers to Community for Creative Non-

Violence (hereinafter, "Purchaser") all of Seller's right, title, and interest in and for the work of visual art described in this agreement, including its frame, mounting, base, or support, and including Seller's copyright interest therein (hereinafter, the "Property"), to have and to hold the Property unto Purchaser, its successors and assigns, forever.²⁰

Had the contract between **CCNV** and **Reid** included such a clause, there would have been no need whatsoever for litigation. The rights of the parties would have been clear from the beginning. It is important to remember that the copyright of an object and the physical ownership of the object are two different things, and "may be transferred... and owned separately."²¹

If you are working with an independent contractor, make sure that your agreement always specifies who receives copyright. You may have to pay more to receive both the object and the intellectual property rights, but in the end it will be worth it. After all, the best way to win a lawsuit is to avoid it entirely.

Cases of Note — Lanham Act Preempts State Claims — Ultra Sheen Model Falls Off the Legal Runway

by **Bruce Strauch** (The Citadel) <strauchb@citadel.edu>

June Toney v. L'Oreal, The Wella Corporation, and Wella Personal Care of North America United States Court of Appeals for the Seventh Circuit, 2004 U.S. App. LEXIS 19576 (2004).

June Toney is a model — print, T.V. and runways — who authorized **Johnson Products Corp** to use her likeness for “Ultra Sheen Supreme,” a “hair relaxer” product. The term ran from November 1995 to November 2000.

Johnson sold Ultra Sheen to **Carson Products** which sold it to **L'Oreal** which sold to **Wella Corporation**. And in the process they used her photo beyond Nov. 2000.

Toney sued these companies in state court for using her likeness beyond the contract term relying on the **Illinois Right of Publicity Act**, 765 Ill. Comp. Stat. 1075/1, *et seq.* (2003) (**IRPA**), and the **Lanham Trademark Act** of 1946, 15 U.S.C. § 1125(a).

Fatally, she did not allege breach of contract. And this is where those law review brains in the big defense firms will outsmart and out-civil-procedure you in a flurry of motions.

First, defendants moved the case to federal court where the judge held the **Lanham** claim preempted the state one. Then defendants moved to dismiss Under Rule 12(b)(6) of the Federal Rules of Civil Procedure. **Toney** didn't take the pictures and didn't own the copyright!

Toney dropped her **Lanham** claim with prejudice and “the case was closed.” She appealed the preemption decision in a desperate bid to get back into state court where she could claim a cause of action under **IRPA**.

So what's up with IRPA?

IRPA as you've no doubt guessed gives Illinois the “right to control and to choose whether and how to use an individual's identity for commercial purposes.” 765 Ill. Comp. Stat. 1075/10. Anyone wanting to use your identity for commercial purposes must obtain written consent. 765 Ill. Comp. Stat. 1075/30.

But then there's this preemption thing.

Yes, indeed. **The Copyright Act** preempts

under § 301 if (1) the work is in tangible form, and it falls into the subject matter of copyright under § 102; AND (2) the state rights are the same as the federal ones under § 106.

Curiously, if the work is too minimal in its originality to qualify for federal protection, the states may not protect the right either. See *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 676 (7th Cir. 1986).

Which sounds like pretty thorough preemption.

§ 102

“Original works of authorship fixed in any tangible medium” are the subject matter of copyright. 17 U.S.C. § 102(a). It's fixed when “sufficiently permanent ... to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.” 17 U.S.C. § 101.

So, hair relaxer photos meet the requirement, but ... what do not? A hypnotic vision produced by a magician? Smoke signals? Morse code?

And if that isn't enough, § 101 flat says that photos are “pictorial works” covered by **Lanham**.

Toney gets creative.

Realizing she was up the creek without authority, **Toney's** lawyer got creative, arguing her **IRPA** claim is directed at Defendants' use of her “identity” rather than her likeness in the negatives and photo prints. But **Toney** had not stated this in her complaint, and in her response to Defendants' motion to dismiss she had stated the claim was limited to use of the

likeness. She can't just raise this on appeal. *Bell v. Duperrault*, 367 F.3d 703, 708 n.1 (7th Cir. 2004) (citing *Williams v. REP Corp.*, 302 F.3d 660, 666 (7th Cir. 2002)).

And *Baltimore Orioles supra* held no distinction between publicity rights and art — in this case, players playing a game and photos or broadcast of the same. Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 2.09[F] (1999).

Footnote 24 in *Baltimore Orioles* did say the question would not be preempted if a company used a player's **name** to advertise a product. But that's not what's going on here. The public doesn't know **Toney's** name and it wasn't used anyhow. It was a photo.

§ 106

For preemption, **IRPA's** rights must be the equivalent of any rights under § 106 which has six rights of which four are on point: (1) to reproduce in copies, (2) to prepare derivative works, (3) to distribute copies, (4) to display.

These were all **Toney's** rights under **IRPA**.

And **Toney** didn't hold copyright. That belonged **Carson Products**. Which as you recall was why **Toney's** case got dismissed.

The court rounds out by saying she should have brought a breach of contract action which would have avoided the preemption issue.

Ouch!

But of course now she can't because you're supposed to plead all theories that are available in the one action.

Adventures in Librarianship — A Passion for Public Television

by **Ned Kraft** (Ralph J. Bunche Library, U.S. Department of State)
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Voice over with still shot of town square: WETT 62 — Your Public Television. Bringing high school orchestral concerts, pictures of far away cities, our local poets, and what-not to the greater Farmington area.

Scroll: Two Minutes in the Library.

SA: Hello, I'm **Stratford Avon** bringing you Two Minutes in the Library.

[Music with montage of happy readers, young and old]

SA: Today we're going to talk to **Helen Bacque**, the children's librarian. Welcome, **Helen**. And, may I say, that's a lovely dress

you have on. And your shoes look incredibly comfortable.

HB: Well, thank you **Mr. Avon**.

SA: Tell me **Helen**... may I call you **Helen**?

HB: Certainly, **Stratford**, if I may be so bold.

SA: Indeed you may, **Helen**. Did I mention your lovely dress and comfy shoes?

HB: You did, **Stratty**. Thank you.

SA: Well... yes, then.... Tell me, **Helen**, is

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written agreement among copyright holders; the default is tenants in common.

A library should contact one author or his or her heirs to seek permission to put the work on the Web. Often joint owners are considerate of each other and will not grant permission without contacting the other owner, however.