

Works Made for Hire, Assignments, Transfers

Eric E. Johnson ericejohnson.com



IP PITFALL:

Not securing copyright ownership despite paying for it

Transfers and licenses:

- Copyright transfers (assignments and exclusive licenses) must be in 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.

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 are <u>very strict</u> 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-ofemployment 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.
- Factors courts look at:
 - Employer's control over the work
 - Employer's control over the employee
 - Employer is in the business of producing works.
 - Indicia of employment: Taxes withheld from employee's pay check, etc.

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-forhire 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 an assignment 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?



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.
- Factors courts look at:
 - Employer's control over the work
 - Employer's control over the employee
 - Employer is in the business of producing works.
 - Indicia of employment: Taxes withheld from employee's pay check, etc.

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



How can the hirer get the copyright?



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

Employee/scope-of-

- 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.
- Factors courts look at:
 - Employer's control over the work
 - Employer's control over the employee
 - Employer is in the business of producing works.
 - Indicia of employment: Taxes withheld from employee's pay check, etc.

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

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 an 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")

Work-for-hire + assignment provision

22.1 Title. Company and University intend this to be a contract for services and <u>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.</u> 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 an 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")

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 an 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.

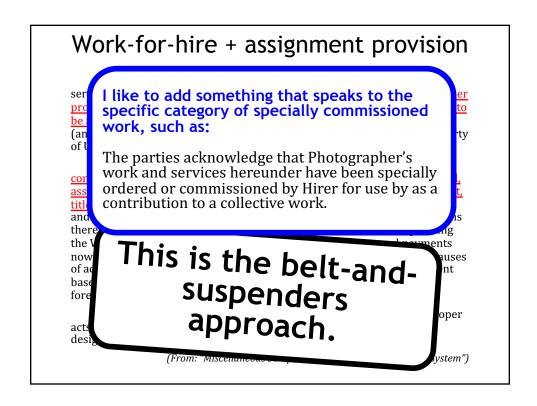
Company agrees to execute all papers and to perform such other proper acts as University may deem necessary to secure for University or its designee the rights herein assigned.

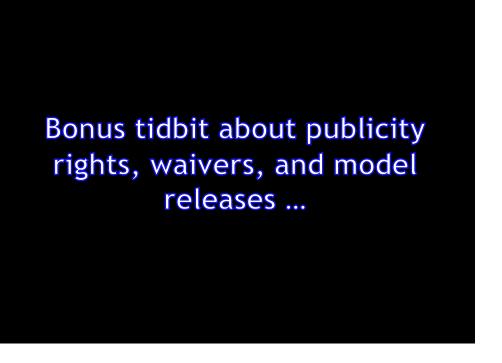
(From: "Miscellaneous Sample Clauses - University of Texas System")

Work-for-hire + assignment provision

22.1 Title. Company and University intend this to be a contract for services and <u>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.</u> 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 sed upon, derived from, or incorporating there This is the belt-andthe now of ac base suspenders fore approach. oper act (From: "Miscenaneous ystem")





How can a hired party commercially exploit photos with faces?



wedding or svent; third offense: Photographer will end wedding coverage imm hereunder and client agrees to relieve and hold Photographer hormiess as a re-	ediately of vent, Photographer shall be entitled to retain all monies paid. suit of vent photography coverage.
	gar even priorography coverage.
Coverage: Photographer will provide coverage for the dates, locations and co	led in this Agreement. Additional travel or coverage hours may
be added by agreement on the wedding day and must be paid in full before	Jucts are released to the Client. Every reasonable effort will be
made to take requested pictures, but no specific pose or photograph co	sts supplied will be used for organizational purposes only. Images
determined by the photographer to be substandard or duplicated my	Photographer will use her professional judgment and sole discretion to
select which photos to deliver. Such selection shall constitute all im	de available to Client.
Image Processing/Frinting: Unless agreed upon prior to a	solution discs and/or proof sets may contain a mixture of color, and black and while.
An alternately colored version of a photo may be purchallous	Limited color correction and/or retauching are included at Photographer's
discretion. Client may request further changes for an add	rapher's not responsible for any prints that are not ordered directly from her. For best
results, clients with the high-resolution files should order the	rtable lab.
Model Release: This contract serves as a model release alving the Photographs	er the irrevocable right to use the photographs in all forms and in all media and in all
H 1962 - 구기 (1) 및 120 (2) (1) (2) (2) (2) (2) (2) (2) (2) (2) (2) (2	de, 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 Clent, their le	igal representatives, hers, and assigns, initials
Control of the Contro	
	er property and are protected by United States Copyright Laws (USC Title 17). Client is images. Violators of this federal law will be subject to its civil and criminal penalties.
netecy waives dry claims for ownersing, income, editorial control and use of the	a mages. Violators of this rederation will be subject to the civil and criminal periodies.
I have read undersland and coree to the terms and conditions of this Agreeme	ent. Each person signing as Client below shall be fully responsible for ensuring that full
powerf is made pursuant to the terms of this Agreement.	The same particular of the same same same same same same same sam
Total for Services due: Deposit Pola: Date:	
Photographer: Client:	
Dote: Dote:	
The total balance is due 30 days before weddings date.	
	GlamourlipzStudio