



Expression
Copyright

Works Made for Hire, Assignments, Transfers

Eric E. Johnson

ericejohnson.com



Konomark
Most rights sharable

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 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.
- 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-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 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?



Question: Who owns the copyright to wedding photos?

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

Employee/scope-of-employment works

Review

- 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

Review

Specially commissioned works

- There must be an express written agreement saying that the work will be considered a work made for hire.

- The work must be one of the following:
 - a work of art, photograph, drawing, engraving, or sculpture
 - a work of architecture, including a design for a building
 - a literary work, including a book, article, or manuscript
 - a musical composition, including a score or lyrics
 - a motion picture or other audiovisual work
 - a sound recording, including a recording of a performance
 - a computer program or other software
 - a database or other information collection
 - a compilation of materials, including a collection of articles or photographs
 - a table, calendar, or other similar work
 - an instructional text, including a manual or textbook
 - a test
 - answer material for a test
 - an atlas

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?

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?**

Employee/scope-of- employment works

Review

- 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 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")



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

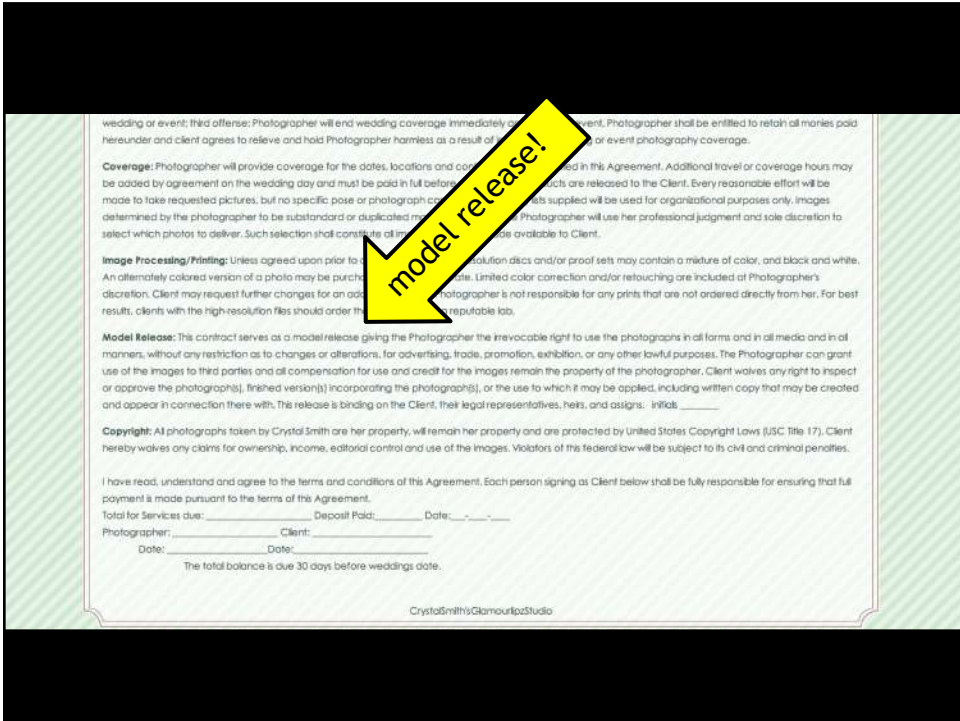


© 2004 Kit & Eric

Bonus tidbit about publicity rights, waivers, and model releases ...

How can a hired party commercially exploit photos with faces?





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

But would a photographer
really sell your wedding
photos showing your faces as

Yes.

The screenshot shows a Shutterstock image page. 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 'Sign In' button. The image title is 'Bride and groom drinking wine at an outdoor cafe' with image ID 526725579. The release information states 'Signed model release filed with Shutterstock, Inc.' and 'Copyright: MNSStudio'. A table shows license options: Standard License JPE, License TIFF, Small (500 x 333, 198 KB), Med (1000 x 666, 595 KB), and Large (4928 x 3280, 10.1 MB). A yellow arrow points to the 'Signed model release' text. Below the main image is a 'Same Model' section with a grid of similar photos.

License	Resolution	File Size
Small	500 x 333	198 KB
Med	1000 x 666	595 KB
Large	4928 x 3280	10.1 MB