

Excuses, Excuses

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When someone infringes your copyright, the infringer usually offers some excuse to try to avoid liability. Many of these excuses appear compelling on the surface, but they don't stand up to the law. This article identifies some of the more popular excuses and what the law provides to counter them.

1. I didn't post the photo - my website designer did.

Ignorance isn't an excuse to infringement, particularly when it's your job to hire or otherwise supervise the infringer. If you hire a website builder who copies and displays a photo on your website without permission, then you're "vicariously" liable for the infringement. The courts have held that "When a party has (1) the right and ability to supervise or control the infringing activity; and (2) a direct financial benefit from that activity, the party is vicariously liable for the infringement." See Sony Corp. of America v. Universal City Studios, Inc., 464 U.S. 417, 418, 104 S.Ct. 774, 777 (1984).

For example, in [Corbis Corp. v. Nick Starr](#), the court awarded the plaintiff more than \$100,000 for the copyright infringement and attorneys' fees. In that case, a small local business hired a web designer to build the business' website. Because the web designer used Corbis' photos without a license, the Court held that both the web designer and the business owner were jointly liable for the infringement.

2. I can't be personally liable for the infringement because the photo was posted on my company's website.

You can be personally liable for the infringement even when you're operating your business as a corporation or LLC. For example, you're Wally and you own Wally's Widgets, Inc. If you use a photo without authority, you may be held personally liable for the infringement in several ways.

First, the photographer can "pierce the corporate veil," especially if your company is owned by one or a few persons. It usually happens when you don't keep the company and your personal assets separated or you commit fraud.

For copyright infringement, you may be personally liable for your company's debts in two additional ways. As mentioned above, you may be held personally liable under the theory of vicarious liability. Alternatively, if you encouraged the infringing activity, you will be held personally liable under the theory of contributory infringement. Attorney Gina Carter defined this as acts by an officer or director such as "knowingly advertising an infringing use, instructing someone else to infringe, and actively and knowingly aiding and abetting a direct infringer in the infringement." See "IP infringement – avoiding liability for officers & directors," Jan. 04, 2007. See also, Novell, Inc. v. Unicom Sales, Inc., 2004 WL 1839117, *17 (N.D. Cal. 2004)

3. I didn't make any money from the infringement.

Making money from the use of a photo is irrelevant when determining whether the use was an infringement. If you reproduce, display, distribute and/or create a derivative work of the photo without authority of the copyright owner or the law, then you have committed infringement. See 17 USC §§ 106, 501. Once the infringement is established, then the amount of damages you must pay the copyright owner is determined by law.

If the photograph was timely registered with the U.S. Copyright Office, then the photographer is eligible for statutory damages of between \$750 and \$150,000. See 17 USC § 504(b) and (c). The photographer will get damages even if you lost money when using the image.

Making money from the use of the photo can increase the amount of statutory damages that you'll have to pay. Courts consider: (1) the expenses saved and profits reaped by the infringer in connection with the infringements; (2) revenues lost by the plaintiff; and (3) whether the infringement was willful and knowing or whether it was accidental and innocent. A&N Music Corp. v. Venezia, 733 F. Supp. 955 (E.D. Pa. 1990).

As the U.S. Supreme Court explained:

[A] rule of liability which merely takes away the profits from an infringement would offer little discouragement to infringers. It would fall short of an effective sanction for enforcement of the copyright policy. The statutory rule, formulated after long experience, not merely compels restitution of profit and reparation for injury but also is designed to discourage wrongful conduct. The discretion of the court is wide enough to permit a resort to statutory damages for such purposes. Even for uninjurious and unprofitable invasions of copyright the court may, if it deems it just, impose a liability within statutory limits to sanction and vindicate the statutory policy.

F.W. Woolworth Co. v. Contemporary Arts, Inc., 344 U.S. 228, 233 (1952). "The purpose of statutory damages is not only the restitution of the defendant's ill-gotten profits, but also to discourage wrongful conduct by imposing a high enough penalty so that defendants will realize that it is less expensive to comply with the law than to violate it." 2 William F. Patry, Copyright Law & Practice at 1172.

Additionally, regardless of any profit-making, legal fees may be recovered from the infringer. 17 U.S.C. 505. In fact, attorneys' fees in copyright actions are "the rule rather than the exception." Micro Manipulator Co. v. Bough, 779 F.2d 255, 259 (5th Cir. 1985).

Even if the copyright is not timely registered, the photographer still is entitled to recover "the actual damages suffered by him or her as a result of the infringement [usually a license fee], and any profits of the infringer that are attributable to the infringement and are not taken into account in computing the actual damages." See 17 U.S.C. § 504(b). Because courts want "to prevent the infringer from unfairly benefitting from a wrongful act, [the photographer may recover] wrongfully obtained profits resulting from the infringement These profits can be direct or indirect." See Polar Bear Productions, Inc. v. Timex Corporation, 384 F.3d 700, 708 (9th Cir. 2004).

4. I didn't know it was copyrighted.

A photograph is protected by copyright at the click of the shutter. If the photographer posts a copyright notice on or adjacent to the photo, then an infringer cannot claim that the infringement was innocent. 17 U.S.C. § 401(d).

But even if the copyright notice is not posted with the photograph, then you are still liable for the infringement. In essence, copyright infringement is a strict liability regime. "The standard rationale for excluding innocence as a defense to copyright infringement is that, as between the copyright owner and the infringer, the infringer is better placed to guard against mistake"; "the strict liability rule should discipline an infringer, who might otherwise mistakenly conclude that his copying will not infringe the copyrighted work, to evaluate the legal consequences of his conduct more carefully." P. Goldstein, Copyright § 9.4 at 162 (1989).

5. The infringement was a mistake.

You didn't have to intentionally or willfully infringer to be liable for the infringement. A mistake will not only not preclude liability, it may not be reasonable and willfulness could still be found by the court. A defendant willfully infringes on the copyright of another by acting "with knowledge that the defendant's conduct constitutes copyright infringement." See Peer Intern. Corp. v. Pausa Records, Inc., 909 F.2d 1332, 1336 (9th Cir. 1990). This "knowledge standard" does not require that a defendant act with the "specific intent" to violate the copyright protection." Coogan v. Avnet, Inc., 2005 WL 2789311 (D. Ariz. 2005), quoting Atlantic Recording Corp. v. Chan, 94 Fed. Appx. 531, 533 (9th Cir. 2004).

In Coogan, the court rejected the defendant's argument that the infringement was not "willful" because it was merely the product of a mistake. In that case, the defendant published photographs beyond the term of a license agreement and in a manner specifically prohibited by the license agreement. The court reasoned that the infringement was willful because "even assuming that Defendant's mistaken belief as to the terms of the license was held in good faith, it was not reasonable." Coogan, 2005 WL 2789311 (emphasis added).

6. If it's on the web, then it's public domain unless clearly marked otherwise.

The urban myth that if it's on the web, it's free, it not true. In the United States, copyright vests in a work when it is created (17 U.S.C. 302 (a)) and "fixed in any tangible medium" (17 U.S.C. 102 (a)). While many think that an unmarked photo is in the public domain, in fact, after 1989, the copyright notice is no longer required to preserve a work's copyright protection.

Check [this blog entry](#) on the only ways that a work can be in the public domain unless expressly put there by its owner. Absent a notice such as "this work is dedicated to the public use and may be freely reproduced," it's best to assume that the work is not in the public domain.

7. I only used part of it so it's fair use.

Using a small part of a copyrighted work is one of the factors considered under the fair use doctrine, but the amount of use alone is not enough to excuse an infringing use. Instead, fair use is only when the use is "for purposes such as criticism, comment, news reporting, teaching, scholarship or research." The Copyright Statute provides four factors to determine whether the use made of a work in any particular case is a fair use:

- The purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit or for educational purposes;
- The nature of the copyrighted work;
- The amount and substantiality of the copyrighted material that is used; and
- The effect of the use upon the potential market for or value of the copyrighted work.

17 USC Section 107.

Courts look at all four factors, among things, in each case, so there is no bright line test to determine fair use. Check [this prior blog post](#) to learn more. It is always a judgment call until a court gives a final ruling whether the use of a photograph is fair. The safest thing is to get a license to use a photograph.

8. I hired the photographer so I own the photos (WMFH).

Many clients think that they own the copyrights to the photos when they hire a photographer. But, in the United States, if the photographer is not the client's employee (a w2 employee instead of a w9 independent contractor), the photographer owns the copyrights unless the photographer otherwise

agreed in writing and the work falls into one of 9 statutory categories. [Circular 9 from the U. S. Copyright Office](#) explains: a WMFH is " a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire." The Circular emphasizes that when the work is created by an independent contractor, both parts must be satisfied—that is, the agreement must be in writing AND the work must fit one of those 9 categories. All that being said, if the photos are taken by an employee within the scope of employment, then the photos are a WMFH and the employer is both the "author" and owner of the copyrights.

9. I gave credit to the photographer.

Many mistakenly assume that they may use a photo so long as they acknowledge the photographer or otherwise provide the source of the photo. But, as far back as 1938, courts held that "[t]he fact that the defendant acknowledged the source from which this matter was taken does not excuse the infringement. While the acknowledgment indicates that it did not intend unfair competition, it does not relieve the defendant from legal liability for the infringement." Henry Holt & Co. v. Liggett & Myers Tobacco Co., 23 F.Supp. 302, 304 (D.C.Pa. 1938).

10. I took it down when asked.

It's a good thing to stop using a photo when asked, especially because continued use after notice constitutes willful infringement. See Pye v. Mitchell, 574 F.2d 476 (9th Cir.1978) (finding defendants liable for higher statutory damages because defendants had actual notice of the infringement in the form of a written release of liability, yet defendants continued to infringe); and Peer Int'l Corp. v. Pausa Records, Inc., 909 F.2d 1332 (9th Cir.1990), cert. denied, 498 U.S. 1109 (1991) (holding that licensee willfully infringed copyright by continuing to make recordings of copyrighted works after receiving written notice of termination from the copyright owners). But stopping the use when caught doesn't address the past infringement for which the photographer may recover. This lame excuse also doesn't work when caught stealing the t-shirt from the store. While you may offer to give it back, you're still on the hook for the theft.

11. I got the image from Google.

Many infringers claim that they didn't know that the photograph was protected by copyright because they copied it from a Google Images search. But [Google itself explains](#) that:

The images displayed in a Google Image Search may be protected by copyright, so we can't grant you the right to use them for any purpose other than viewing them on the web. If you'd like to use images from our image search, we suggest contacting the site's webmaster to obtain permission.

Well, that's mostly right. The webmaster likely doesn't own the copyright, but hopefully the webmaster will direct the potential client to who does!

12. I didn't post the photo on my website so I'm protected by the DMCA.

Many websites allow users to submit photos to be posted or to post them directly. So a website owner often will rely on the Digital Millennium Copyright Act (DMCA) for protection when accused of copyright infringement.

Enacted in 1998, the DMCA implemented treaties signed at the 1996 [World Intellectual Property Organization](#) (WIPO) Geneva conference. It addresses many issues, one of which is applicable here.

The DMCA states that a service provider (website owner) is not liable for the storage of a copyrighted work on a system or network controlled or operated by or for the service provider that was caused by a user of the website if the service provider removes the material from the website after it receives proper notice. Also, to avoid liability for the infringement, the DMCA requires that the service provider:

- (A) (i) does not have actual knowledge that the material or an activity using the material on the system or network is infringing;
- (ii) in the absence of such actual knowledge, is not aware of facts or circumstances from which infringing activity is apparent; or
- (iii) upon obtaining such knowledge or awareness, acts expeditiously to remove, or disable access to, the material;
- (B) does not receive a financial benefit directly attributable to the infringing activity, in a case in which the service provider has the right and ability to control such activity; and
- (C) upon notification of claimed infringement, responds expeditiously to remove, or disable access to, the material that is claimed to be infringing or to be the subject of infringing activity.

In addition, and where many website owners fail to get the protection of the DMCA, the service provider must have a designated agent to receive notifications of claimed infringement, by making available through its service, including on its website in a location accessible to the public, and by providing to the Copyright Office, substantially the following information:

- (A) the name, address, phone number, and electronic mail address of the agent.
- (B) other contact information which the Register of Copyrights may deem appropriate.

The Register of Copyrights maintains a current directory of agents available [on its website](#).

If the website owner doesn't meet all of the above conditions, then the website owner is not eligible for the DMCA's protection and is liable for the copyright infringement.

Conclusion

So when the infringer of your work claims no liability for the infringement, don't be too quick to accept the excuse. Talk with an attorney so that you know your rights.

Carolyn E. Wright is a licensed attorney dedicated to the legal needs for photographers. Get the latest in legal information at Carolyn's website, www.photoattorney.com. These and other legal tips for photographers are available in Carolyn's book, *The Photographer's Legal Guide*, available on her website.

NOTE: The information provided here is for educational purposes only. If you have legal concerns or need legal advice, be sure to consult with an attorney.