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# Photographs of Public Domain Paintings: How, If At All, Should we Protect Them?

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## Photographs of Public Domain Paintings: How, If at All, Should We Protect Them?

R. Anthony Reese\*

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### I. INTRODUCTION

An original painting that hangs in an art museum is accessible only to those who can visit the museum. A photograph of the painting that reproduces it as faithfully as possible can make the painting's image available to a much wider audience. Such art reproduction photographs can raise a number of copyright issues. Taking a photograph of a painting constitutes reproducing the painting, an act generally reserved to the owner of the painting's copyright (which in many cases is not the museum that displays the canvas). If the painting is in the public domain, though, then a photographer needs no copyright permission to photograph it. In that event, the main copyright issue is whether the

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\* Arnold, White & Durkee Centennial Professor of Law, The University of Texas at Austin; Visiting Professor, NYU School of Law, Spring 2009; Professor, UC Irvine School of Law (from 1 July 2009). Thanks to Christopher Leslie, Kevin Collins, Laura Heymann, Mark Janis, the other symposium participants, and Jane Ginsburg for their comments on earlier versions of this Article. I would also like to thank the participants in an April 2008 roundtable on the *Bridgeman* decision organized by the Committee on Art Law of the City Bar Association of New York, the College Art Association, ARTstor, and Creative Commons, for a rewarding discussion of the general topic considered here. © 2009 R. Anthony Reese.

photograph of the public domain painting is itself entitled to copyright protection.<sup>1</sup>

A decade ago, a landmark federal district court decision answered that question in the negative.<sup>2</sup> That decision, though, has been subject to some resistance from museums and art reproduction photographers. And because museums, even without any copyright protection, control access to the paintings themselves, as well as to the high-quality reproducible transparencies of any of the museum's own photographs of its paintings, the court's ruling does not necessarily mean that making, or getting access to, a usable quality photograph of a public domain painting is significantly easier or cheaper today.

In light of this controversy over copyright protection, and the practical hurdles to reproducing public domain paintings, it is worth considering anew the question of what protection, if any, should be granted to art reproduction photographs of public domain paintings. Such consideration involves, at the least, weighing the possible need for incentives to invest in producing such photographs, as well as the impediments that granting exclusive rights in them would present to using the underlying public domain work. Given the incentive and access concerns, perhaps art reproduction photographs should receive some circumscribed protection against copying, but not complete copyright protection. A *sui generis* right in such photos, tailored to the specific needs involved, might best accommodate the competing interests.

If some type of *sui generis* regime were desirable, could such a system be enacted? If art reproduction photographs come within Congress's Copyright Clause power, then Congress could likely exercise that power to adopt a *sui generis* regime. But doing so would likely run afoul of several multilateral and bilateral international copyright obligations that the United States has taken on in the past 20 years. If applicable, international copyright agreements could significantly constrain Congress's ability to protect art reproduction photographs through a *sui generis* regime that is less generous than ordinary copyright law.

On the other hand, if art reproduction photographs are not proper subjects for protection under the Copyright Clause, international copyright obligations would likely leave Congress free to grant such photos substantially less protection than it gives copyrightable works. But in that event, Congress would face the question of whether it can use some constitutional power other than the Copyright Clause to enact a law granting exclusive rights in works that do not meet the standard for protection under the Copyright Clause. Existing law remains quite unclear as to how much the Copyright Clause's limitations on Congress's power also restrict its power to enact legislation under other grants of authority. But constitutional constraints, like international ones, might perhaps preclude the adoption of a *sui generis* regime for art reproduction photographs.

Part II examines how copyright law can combine with ownership of original paintings and transparencies of art reproduction photographs to allow a museum to exert significant control over use of images of public domain paintings, and discusses the

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1. Although the focus of this Article is on paintings, a similar analysis would apply to other unique two-dimensional works of art, such as drawings. The copyright issues raised by photographs of three-dimensional works of art may be different, and are beyond the scope of this Article. See, e.g., Mitch Tuchman, *Inauthentic Works of Art: Why Bridgeman May Ultimately Be Irrelevant to Art Museums*, 24 COLUM.-VLA J.L. & ARTS 287, 313 (2001).

2. *Bridgeman Art Library, Ltd. v. Corel Corp.*, 25 F. Supp. 2d 421 (S.D.N.Y. 1998), *aff'd on reh'g*, 36 F. Supp. 2d 191 (S.D.N.Y. 1999).

current state of copyright law with respect to art reproduction photos of such paintings. Part III considers arguments for and against some grant of exclusive rights in art reproduction photos, and suggests one possible *sui generis* approach to reconciling those competing arguments. Part IV then shows that international or constitutional constraints might prevent Congress from adopting a limited, *sui generis* right in art reproduction photographs, potentially limiting Congress's choices either to providing something close to full copyright protection, or no protection at all—alternatives that may be equally unattractive options for mediating the incentive and access interests at stake in choosing a system of protection.

## II. USING COPYRIGHT AND CHATTEL OWNERSHIP TO CONTROL IMAGES OF PUBLIC DOMAIN PAINTINGS

Many paintings that hang in museums embody pictorial or graphic works that are in the public domain.<sup>3</sup> Their copyrights have expired, or copyright protection was never obtained for them. Members of the public might want to use these public domain images in many ways. A scholar might want to show them in lectures, or reprint them to accompany a scholarly article or monograph. The owner of a personal website might want to display an image of a favorite painting on her site. An artist might want to incorporate all or part of an image of the painting in a new work of her own. (Andy Warhol, for example, might have used the *Mona Lisa*, in addition to photos of Marilyn Monroe and Jacqueline Kennedy, in his works.) A publisher might want to include a copy of the painting in a coffee-table book to sell. And a merchandising company might want to put an image of the painting on notecards, umbrellas, mugs, or a whole host of merchandise.

Consider a similarly situated musical composition. When the musical work enters the public domain, the scholar can play it on the piano during a lecture or print portions of the musical notation to accompany scholarly analysis, the website owner can record it to play every time a user visits her site, a composer can incorporate all or part of the tune into her own new composition, a music publisher can include sheet music (or guitar tablature, or the printed lyrics) in a book of music, and a merchandising company can record the song to use in a greeting card or music box.

Because the pictorial work embodied in the painting, and the musical composition, are both in the public domain, copyright law would allow all of these people to make all of these uses of the painted image or the song. Indeed, copyright law encourages those uses—one rationale for the public domain is to let anyone use an unprotected work in the hope that doing so will increase the work's availability, decrease its cost, and allow it to serve as the basis for further authorial creation.<sup>4</sup>

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3. Determining with certainty when an older painting entered the public domain can be difficult because until 1978, unpublished works were protected by common-law copyright potentially forever, and the rules regarding what constituted publication of a painting were unclear. See R. Anthony Reese, *Public but Private: Copyright's New Unpublished Public Domain*, 85 TEX. L. REV. 585, 600–03 & n.83 (2007). In addition, paintings of foreign origin that may have previously entered the public domain in the United States may have had their copyright protection restored. 17 U.S.C. § 104A (2000). (A district court, however, has recently concluded that the enactment of that provision contravened the First Amendment. *Golan v. Holder*, 2009 WL 928327, 90 U.S.P.Q.2d (BNA) 1202 (D. Colo. Apr. 3, 2009).)

4. See, e.g., *Eldred v. Ashcroft*, 537 U.S. 186, 260 (2003) (Breyer, J., dissenting) (“The [Copyright]

But while copyright law permits and encourages these uses of both the painting and the song, practical realities mean that the public will more likely be able to use the song than the painting. When a musical composition goes into the public domain, a potential user will generally be able to get relatively easy access to the work in order to use it. Copies of the sheet music may be in circulation (perhaps already in the user's possession) or available at a library. Recordings of the song may exist, and capable musicians will be able to listen to the recording and then play the song or transcribe it into musical notation.<sup>5</sup> In other words, copies of the work, suitable for the user's purpose, will generally be readily available.<sup>6</sup>

The same will not usually be true of a public domain painting in a museum, because a work of fine art such as a painting is generally, by definition, a unique object.<sup>7</sup> The author of a musical work typically makes and distributes (directly or indirectly) numerous copies or phonorecords of her work during its copyright term, and many of those copies and records will remain available after that term expires. But a painter generally produces only one copy of a painting.<sup>8</sup> The museum's original painting will usually be the only original. Anyone who wants to copy the painting will generally need to copy that original, or a copy made from it.<sup>9</sup>

The practical necessity of copying (directly or indirectly) from the museum's original painting will usually make it difficult to copy (and make further use of) even a public domain painting. Three factors combine to impede copying such public domain artworks: the museum's ownership of the original painting, the museum's claim to copyright in any photographic reproduction it makes of the painting, and the museum's control over access to the negatives, or transparencies, of any such photograph.

First, the museum's ownership of the original painting may allow it to prevent others from making reproductions directly from the painting.<sup>10</sup> Even though no copyright any

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Clause assumes an initial grant of monopoly, designed primarily to encourage creation, followed by termination of the monopoly grant in order to promote dissemination of already-created works. It assumes that it is the disappearance of the monopoly grant . . . that will, on balance, promote the dissemination of works already in existence.”).

5. While the copyright in any particular sound recording of the song may not have expired, listening to a copyrighted recording in order to transcribe the public domain musical work embodied in that recording would not infringe any copyright in the sound recording.

6. This, of course, will generally be true only for works that have been published. As I have noted elsewhere, distributing works of authorship in multiple copies to the public assists in the preservation of the work for future access. R. Anthony Reese, *The First Sale Doctrine in the Era of Digital Networks*, 44 B.C. L. REV. 577, 603–10 (2003).

7. See Robert A. Baron, *Digital Fever: A Scholar's Copyright Dilemma*, 15 MUSEUM MGMT. & CURATORSHIP 49, 57 (1996) (“Art objects, however, are different from written works in that they are unique, tangible and on occasion valuable.”).

8. In some instances, there may be a number of variant versions of a single painting by the same artist that may be very similar, but even in such instances each variant will usually be unique.

9. See Babette Aalberts & Annemarie Beunen, *Exploiting Museum Images*, in COPYRIGHT IN THE CULTURAL INDUSTRIES 221, 227 (Ruth Towse ed., 2002). (“[E]ach [museum] is the sole supplier of images from its collection. This gives a museum a monopoly on its image material. This monopoly is in most cases not based on copyright (in conformity with the Bridgeman case) but on the fact that the museum has the ownership or custody of its collection. The control that a museum is able to exercise on this basis is restricted to the building in which the collection is housed. The museum can set its own conditions on access to its building.”).

10. Baron, *supra* note 7, at 57 (“[G]alleries and museums will often prohibit all photography within their spaces. . . .”).

longer protects the painting as an artistic work of authorship, the museum owns the personal property—the paint, canvas, etc.—that embodies the work, as well as the real property—the museum building—in which it is exhibited. Anyone who wishes to make any of the uses described above will need access to the painting in order to reproduce it. And the museum, because of its tangible property rights, can deny access to the painting to anyone who wants to copy it. With respect to photographic reproductions, most major museums do in fact restrict photography in ways that prevent visitors from making the kind of photos needed to reproduce a painting at high quality.<sup>11</sup> For example, museums may prohibit the use of a flash, relegating photographers to using only existing light in the galleries; many museums also prohibit the use of tripods, thereby making successful existing-light photography more difficult.<sup>12</sup> Museum prohibitions or restrictions on photographing public domain paintings thus make it difficult for a potential copier to obtain a usable copy of a painting by making her own photographic reproduction.

While a potential user may not be able to make her own usable photographic reproduction of a public domain painting, such a photo may already exist. Museum photographers often take photographs of public domain paintings (or of copyrighted paintings that subsequently enter the public domain)<sup>13</sup> designed to copy the painting as exactly as possible.<sup>14</sup> But museums and photographers commonly claim copyright in these photographs and assert that copyright to prevent others from using the photographs without their permission or without payment.<sup>15</sup> To the extent that these copyright claims are enforceable, they mean that while a potential user may be able to obtain a usable photographic reproduction of a public domain painting, she will often need to pay for, and comply with certain conditions on, the use of that image of the painting.<sup>16</sup> Thus, the

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11. On the quality needed for useful reproduction in many contexts, see Baron, *supra* note 7, at 52 (“[F]or many scholarly uses, higher resolution is needed. . . . [F]or many purposes, such as in manuscript, stylistic or iconographic studies, low resolution images may be entirely useless.”).

12. See, e.g., Metropolitan Museum of Art, Visitor Tips, <http://www.metmuseum.org/visit/tips/> (last visited May 12, 2009) (“The use of flash is prohibited at all times and in all galleries.”); Museum of Modern Art, Tips for Visiting, <http://www.moma.org/visit/plan/guidelines> (last visited May 12, 2009) (“No flash or tripods allowed.”); Art Institute of Chicago, Museum Guidelines, [http://www.artic.edu/aic/visitor\\_info/mus\\_gdlns.html](http://www.artic.edu/aic/visitor_info/mus_gdlns.html) (last visited May 12, 2009) (“Flashes, tripods and video cameras are prohibited.”). See also Baron, *supra* note 7, at 57 (“[G]alleries and museums will often prohibit all photography within their spaces or allow only such photography as is guaranteed to produce unpublishable results, sometimes going as far as to warn visitors that their own photographs may only be used for personal purposes.”); Peter Walsh, *Art Museums and Copyright: A Hidden Dilemma*, in XII VISUAL RESOURCES 361, 366 (1977) (“Some museums do not allow outsiders to photograph their collections at all. Others allow visitors to photograph only with restrictions, including a stipulation that they not publish or distribute them.”).

13. The issues raised by art reproduction photographs of copyrighted paintings are less troubling from the standpoint of access to the photographed works, since the copyrights in the underlying paintings already substantially restrict what uses can be made of the image.

14. See, e.g., Tuchman, *supra* note 1, at 287–88 (“Photography is ubiquitous at large art museums, many of which maintain photographic—or ‘imaging’—studios.”). Tuchman notes that some museums photograph 2500 or 5000 objects a year. *Id.*

15. Walsh, *supra* note 12, at 361 (“Typically, museums charge fees for such things as photographing works of art, renting color transparencies, providing black-and-white copy prints, and for all sorts of reproduction rights as may be applied to the publication of scholarly articles, to the covers of novels or to CD-ROMs, for instance.”).

16. Of course, not all uses of the copyrighted photographic reproduction of a public domain painting would require permission from, or payment to, the copyright owner. For example, projecting the photograph to

user may be able to make the desired use, but she will not be able to do so as freely as the painting's public domain status might suggest.

Finally, regardless of whether a museum's claim of copyright in its photographic reproduction is valid, potential users may find it difficult or impossible to obtain the transparencies necessary to reproduce the public domain painting as they wish. The museum may tightly control access to the negatives, or transparencies, of its photograph of a public domain painting, just as it controls access to the painting itself. Traditionally, many museums have tried to control access to high-quality, reproducible transparencies of photographic reproductions of works in their collections.<sup>17</sup> When such a museum allows a third party (scholar, publisher, other museum, etc.) to reproduce a painting from one of these transparencies, the museum typically lends or rents the transparency for a limited period and requires its return after the licensed use has been made. Some copies no doubt remain unreturned, and, in some cases, duplicates are no doubt made despite the museum's strictures in its loan or rental agreement against doing so, but high-quality reproducible copies will generally not be easily accessible.<sup>18</sup> While copies made from these transparencies—in scholarly monographs, coffee-table books, and on various merchandise—may be easier to find, they are likely in most cases to be of sufficient quality only for some potential reuses. As one writer noted, even though museums may not have any copyright in public domain paintings, “they do control the color transparencies that provide much higher-quality reproduction than would a post card or a photograph in an art book.”<sup>19</sup> And for many users, especially those who wish to use the work in print, higher quality reproduction is a necessity.<sup>20</sup>

Again, it helps to contrast the situation with musical works. A musician can probably perform a public domain musical composition equally well from a first-generation copy of the sheet music as from a second- or third-generation copy. Someone who wants to print a high-quality reproduction of a photo of a public domain painting, on the other hand, will likely find doing so from a second- or third-generation copy of the photo difficult or impossible. As a result, even where reproductions of a public domain painting exist, and even if they are not protected by copyright, they may only be mildly helpful to those who wish to use the image without permission from a museum that is

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the students in an art history lecture course would often be allowed under existing limitations on the copyright owner's rights. 17 U.S.C. § 110(1) (2000).

17. Tuchman notes that some museums realize that copyright claims are “immaterial” and that “[m]ore to the point are reasonable efforts to monitor and control access to the works and transparencies.” Tuchman, *supra* note 1, at 310.

18. Tuchman notes that “transparencies on loan are routinely, if illicitly, duped” and that “duping [has] become the widespread, if unacknowledged custom” when museums borrow or rent transparencies for use in producing an exhibition catalog. Tuchman, *supra* note 1, at 306 & n.99. Of course, while the copying museum might retain such duped transparencies, and thus be able to reuse them in the future, that does not mean that those dupes will become generally available to others. *See also* Walsh, *supra* note 12, at 367.

19. Ronald Alsop, *Fine Art is Now on Exhibit in Many Ads—But Critics Say Commercial Use Cheapens the Great Masterpieces*, WALL ST. J., Mar. 25, 1988, § 1, at 25.

20. *See, e.g., id.* (“Because good reproduction is so important in advertising, agencies typically won't use a certain painting unless they can get transparencies.”); Baron, *supra* note 7, at 52; Tuchman, *supra* note 1, at 314 (noting that museums need transparencies “for the translation of images to print media” though not for other functions related to mounting an exhibition, such as advance publicity, grant applications, installation design, etc.).

controlling access to the painting and to high-quality photographs of it.<sup>21</sup>

These combined practices can have a substantial practical effect on the public's ability to use an image of a public domain painting. The museum that owns the painting can usually effectively control the access to the original needed to make a high-quality photographic copy, and can deny such access to anyone other than its own (or its chosen) photographer.<sup>22</sup> Doing so leaves using the museum's photograph, in which it claims copyright, and which is reproducible at high quality only by using a transparency available from the museum, as the only readily available course for reproducing the public domain painting—whether in whole or in part, and with or without substantial adaptation.

Copyright claims in photographs of public domain paintings are thus one important factor (though not the only factor) in the ease with which images of these paintings can be used. If a museum's claim of copyright in its photograph of a public domain painting is valid, the public will generally find it quite difficult, as a practical matter, to use the image of the painting without getting permission from, and paying a license fee to, the museum for using the museum's photograph.<sup>23</sup> In 1999, however, the district court in *Bridgeman Art Library, Ltd. v. Corel Corp.*<sup>24</sup> rejected this type of claim of copyright in photographs of public domain paintings, concluding that such photographs did not meet copyright law's originality requirement.<sup>25</sup> By holding that such art reproduction photographs are not copyrightable, the decision allows the public to reproduce the image of a public domain painting embodied in a museum's photograph without permission. Obtaining access to the museum's high-quality, reproducible image may still be difficult, but if a potential user can get access to the image, copyright law, under the *Bridgeman* decision, allows the user to reproduce, adapt, and display the image.<sup>26</sup>

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21. See Baron, *supra* note 7, at 58 (noting analogously in the fair use context that “[t]he art scholar’s claim to ‘fair use’, it seems, may be only as useful as the quality of an obtainable image.”).

22. See Kathleen Connolly Butler, *Keeping the World Safe from Naked-Chicks-in-Art Refrigerator Magnets: The Plot to Control Art Images in the Public Domain through Copyright in Photographic and Digital Reproductions*, 21 HASTINGS COMM. & ENT. L.J. 55, 57 (1998) (analyzing how museums and companies copyright their reproduction of the artwork which, in turn, controls access to public domain artwork); PETER WIENAND, ANNA BOOY & ROBIN FRY, *A GUIDE TO COPYRIGHT FOR MUSEUMS AND GALLERIES* § 3.1, at 52–55 (2000) (discussing ways for museums to “secure the exclusivity” of images of items in its collection by requiring that “no person who has access to its collections . . . can be permitted to take photographs, recordings, copies or other reproductions” without specific contractual permission).

23. Copyright law will, of course, allow some uses of the copyrighted art reproduction photograph, such as showing a copy of the photo in the classroom and uses that qualify as fair use. 17 U.S.C. §§ 110(1), 107 (2000).

24. *Bridgeman Art Library, Ltd. v. Corel Corp.*, 25 F. Supp. 2d 421 (S.D.N.Y. 1998), *aff’d on reh’g*, 36 F. Supp. 2d 191 (S.D.N.Y. 1999).

25. *Id.* at 426–27.

26. Tyler Ochoa, *Bridgeman Art Library v. Corel Corporation: Three Possible Responses*, SPECTRA, Fall 2001, at 32, 34.

If a person wants to use a museum image, and a low-resolution image will suffice, they will simply reproduce the image from any available source. *Bridgeman* allows them to do this. But if a publisher wishes a high-quality image suitable for publication in a book, he or she will still contact the museum, because they know that only the museum can provide them with such high-quality images.

*Id.*

Nonetheless, there are indications that many museums essentially reject the *Bridgeman* decision and attempt to minimize its impact on their photography and their reproduction permissions practices.<sup>27</sup> After all, advocates of this approach will say, the decision is only that of one district judge, and is not binding on any other court.<sup>28</sup> Evidence suggests that museums continue to assert copyright in art reproduction photographs of public domain paintings in their collections and to require potential users to obtain permission and pay fees in order to reprint or adapt those photographs.<sup>29</sup>

One can understand the museums' motivation to take this position. As one author has pointed out:

If [*Bridgeman* is] correct, the decision has potentially severe consequences for photographic libraries, art galleries and museums, for whom an important source of income is the licensing fees obtained for use of photographs of works of art, particularly, of course, where access to the original work of art for photographic purposes is restricted.<sup>30</sup>

On the other hand, allowing copyright in art reproduction photographs of public domain paintings "has serious implications for the fidelity of the copyright term, and opens the door to undermining the vitality and significance of the public domain" and thus "raises questions not just about copyright law, but, more generally, concerns the issue of meaningful access to public domain works of national and international cultural significance."<sup>31</sup>

In the face of this ongoing controversy over the copyright status of art reproduction

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27. See Colin T. Cameron, *In Defiance of Bridgeman: Claiming Copyright in Photographic Reproductions of Public Domain Works*, 15 TEX. INTELL. PROP. L.J. 31, 32 (2006) ("Although the decisions sparked a brief academic discussion, *Bridgeman* has subsequently been ignored. Museums and art libraries alike persist in claiming copyright in uncopyrightable photographic reproductions of public domain works.").

28. See, e.g., Robin J. Allan, *After Bridgeman: Copyright, Museums, and Public Domain Works of Art*, 155 U. PA. L. REV. 961, 965 (2007) (arguing that "the *Bridgeman* decision should not be a model for other courts" and that adverse consequences would result if other courts were to follow the decision).

29. See Cameron, *supra* note 27, at 52.

If a false claim to copyright can bully potential authors away from using uncopyrightable reproductions of public domain images, no museum need ever pursue an infringement action, nor even acknowledge the *Bridgeman* decision. The threat alone may be enough to maintain control of the collection, as though valid copyright indeed subsisted in a museum's precise photographic reproductions of public domain paintings.

*Id.*; Rachele V. Browne & Maria Pallante-Hyun, *To License or Not To License: A Look at Artists' Rights, Museum Practices, and Institutional Risk*, SJ049 ALI-ABA 511 n.19 (2004) ("[M]any museums routinely assert a copyright in transparencies and digital formats of public domain images.").

30. Kevin Garnett, *Copyright in Photographs*, 22 EUR. INTELL. PROP. REV. 229, 229 (2000); see also Allan, *supra* note 28, at 982 ("[I]n 2004, the Philadelphia Museum of Art reported over five million dollars in sales from wholesale and retail operations, more than thirteen percent of the Museum's revenue that year.").

Of course, the *Bridgeman* decision would only directly affect licensing revenues in art reproduction photographs of public domain paintings. The use of photographs of paintings still protected by copyright could be restricted by means of the copyright in the underlying painting, though in some cases the museum might not own that copyright, or might be obliged by agreement to share revenues with the painting's author (and initial copyright owner).

31. Ronan Deazley, *Photographing Paintings in the Public Domain: A Response to Garnett*, 23 EUR. INTELL. PROP. REV. 179, 184 (2001).

photographs of public domain paintings under U.S. law, it may be useful to step back and consider the various interests and issues at stake in order to think about how the law ought to treat such photographs and to deal more generally with the public's ability to use public domain works of art. To some extent, the controversy plays out the same set of concerns about incentives and access that are widely thought to animate copyright law generally.<sup>32</sup> The next Part considers both the incentive and access concerns, and then suggests one possible way to reconcile them.

### III. WHAT PROTECTION, IF ANY, IS APPROPRIATE FOR ART REPRODUCTION PHOTOS OF PUBLIC DOMAIN PAINTINGS?

#### *A. The Need for Incentives*

We should want reproductions of public domain paintings to be made by capable photographers who can produce excellent copies that portray the original painting as exactly as possible in the photographic medium. In most cases, of course, viewing a photograph of a painting is not as good as looking at the real thing. But in most situations, people do not have the option to choose between viewing a photographic copy or the original canvas. And in such situations—including when teaching or attending an art history course, reading a scholarly monograph about an artist, looking at an artwork in the privacy of one's home, or creating a new work of art that incorporates an earlier one—looking at a photographic copy is better than nothing, which would be the likely alternative if no photograph were available, since people engaged in these activities rarely have the option of conducting them in front of the original painting in the museum where it hangs.<sup>33</sup>

So art reproduction photography seems to benefit the public significantly enough that we should be concerned if such photographs were not produced. But creating this kind of photograph requires some investment of resources, resources such as a skilled art photographer,<sup>34</sup> cameras and other equipment; the time, labor, and security needed to move a painting from its gallery to a photo studio; and so forth. The precise cost of producing any particular photographic copy of a painting may vary, but it is unlikely in any case to be zero.

And yet, if the investment is made and an art reproduction photo is produced, and if the resulting photo becomes freely available for use with no legal impediment to its copying, then copiers could market copies of the photograph in competition with the photographer and museum who created the photo. And the copiers could presumably

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32. Guy Pessach, *Museums, Digitization and Copyright Law: Taking Stock and Looking Ahead*, 1 J. INT'L MEDIA & ENT. L. 253, 278–79 (2007) (“Once framing the *Bridgeman Art Library* case within a broader range of initiatives for the production and management of digital artifacts, there seems to be one main policy question at stake: how to achieve a balance between the need to provide enough incentives for the investment of considerable resources in the production of digitized collections, on one hand, and, on the other hand, the no less compelling need in securing the public's access rights to cultural heritage, especially when what is at stake are works that have already fallen into the public domain.”).

33. See, e.g., Butler, *supra* note 22, at 59–60 (stating that photography democratized art by making it available to the masses).

34. See generally SHELDAN COLLINS, *HOW TO PHOTOGRAPH WORKS OF ART* (1992) (describing art reproduction photography techniques in detail).

supply the photo at a lower price, since they need not bear any of the cost of creating the photograph.<sup>35</sup> This price competition would likely force the price that the museum could charge down to the cost of copying and marketing the image, perhaps leaving the museum unable to recover its investment in creating the photo in the first place.<sup>36</sup>

Even in the face of competition from copiers, though, the museum might be able to charge a supracompetitive price, and thereby recoup some of the investment it made to create the photograph. For example, the museum may be able to vouch more substantially than any competitor for the image's accuracy and authenticity, and some users (such as, for example, art historians) may be willing to pay a premium for authenticity and accuracy. In addition, as noted above, the museum may, even in the absence of copyright, be able to retain much of its position as the sole source of high-quality transparencies for reproduction purposes, if it follows a policy of only renting or lending transparencies, prohibiting users from copying the transparencies, and requiring users to return the transparencies once they have finished using them.<sup>37</sup>

Museums might invest in creating art reproduction photographs even if they did not have an opportunity to recoup that investment through charging supracompetitive prices for licensing the use of such photos. For example, they might view the advertising benefits of such reproductions as justifying their costs: "[A]rt reproductions promote the institution and its collections by sparking public interest in seeing the original painting on the wall or seeking out more work by a particular artist."<sup>38</sup> In some cases, they might be willing to shoulder the costs themselves because they need usable reproductions to produce their own exhibition catalogs, museum guides, merchandise, and so forth. They might therefore be prepared to subsidize the cost of producing reproductions out of their general revenues or out of the revenues to be earned from sales of the resulting publications and merchandise. And the museum may have some advantages in such sales over competitors who copy the museum's images (without paying for their use) and offer competing products. For example, trademark law will likely allow a museum to be the

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35. See William M. Landes, *Copyright, Borrowed Images, and Appropriation Art: An Economic Approach*, 9 GEO. MASON L. REV. 1, 13 (2000) (noting that copyright for high-quality reproductions of public domain paintings could be justified because creating those photographs "is a time consuming process that requires considerable skill on the part of the photographer or copyist" and therefore is likely to lead to free-riding by those who find it "significantly cheaper" to copy from the art reproduction photograph than to create a new reproduction from the original work).

36. Of course, if the museum could charge a high enough price to cover the cost of creating the photo when it authorizes the first use of the photograph that makes the image available for others to copy, then the subsequent price competition would not deprive the museum of the ability to recoup the creation cost of the photo. It seems unlikely in most cases, however, that the museum could charge a sufficiently high price for the first use of the image in order to completely recover its costs. The museum might instead cover the cost of its photography by charging higher admission prices, but that would in essence require many visitors who will never use any of the museum's photographs to subsidize their production.

37. Of course, the contractual prohibitions on users making and retaining copies of the transparencies may be harder to enforce than a copyright prohibition on such conduct, so in the absence of copyright, museums might have a more difficult time retaining their "sole source" position. Museums might also attempt to use contracts with users of transparencies to substitute for unavailable copyright protection by barring any further use of the transparencies. A full discussion of that approach is beyond the scope of this Article, but for a discussion of whether similar contractual restrictions by owners of public domain materials would be enforceable, see Reese, *supra* note 3, at 617-33.

38. Allan, *supra* note 28, at 982.

sole authorized seller of, say, coffee mugs and tote bags that bear an image from the museum's collection and the museum's name or logo. No doubt many buyers—particularly those who buy the mug or tote bag as a souvenir of a visit to the museum—would prefer to buy (and would pay a slight premium for) the branded version, even if the same item featuring the same image was available without the museum name or logo. Similarly, an image of a public domain painting in an exhibition catalog, produced by the museum's curators who organized the exhibition, would be more valuable to many prospective purchasers than a copier's simple reproduction of the image, since the catalog will include images of other works in the exhibition, as well as essays and other textual material, and that material will be protected by copyright law against copying by the museum's competitors.<sup>39</sup>

While museums *might* produce just as many art reproduction photographs of public domain paintings without having any exclusive rights in those photos, whether the level of production would be the same as it would be with such rights seems likely to depend on factors that will be difficult to quantify. A lack of exclusive rights might instead reduce the number of art reproduction photographs created, or might skew production of such photos toward only those paintings that are most popular or most widely commercially viable. If art reproduction photographs can be freely copied, we may be concerned that, in the long run, we will see less investment in producing such photos than we think would be desirable, and many people who cannot get to the museum to see the original will not have access to an image of the public domain work.<sup>40</sup>

In sum, it seems uncertain whether, in the absence of any exclusive rights in art reproduction photographs of public domain paintings, museums and others would make sufficient investment to produce as many, and as good, art reproduction photographs as they would if they enjoyed a period of exclusive use of such photos, during which they could attempt to recoup their investment.<sup>41</sup>

#### *B. The Need for Access*

At the same time, if we grant exclusive rights in art reproduction photographs, those exclusive rights may impede the public's ability to have access to those photos. While this concern arises with all grants of exclusive rights under copyright (or other IP regimes), the concern about restrictions on access may be particularly heightened in the case of art reproduction photographs (as compared to more typical copyrighted works). After all, the subject of the museum's art reproduction photo is an artwork that is already in the public domain under copyright law. Everyone is therefore now entitled to use that artwork freely, without consent or cost, as a matter of copyright law. In many cases, of course, the painter (and her successors, including, in some instances, the museum in

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39. For a discussion of avenues for making money by publishing public domain materials in the absence of the ability to stop others from copying them, see Reese, *supra* note 3, at 654–59.

40. It is unclear whether any other entities, such as artists or their estates, collective rights organizations, or commercial publishers, would have sufficient incentive to produce such photos in the absence of some exclusive right in art reproduction photographs. See Allan, *supra* note 28, at 983 (questioning whether anyone has an incentive to reproduce art in light of the *Bridgeman* holding).

41. Further empirical evidence on museums' practices, before and after the *Bridgeman* decision, in producing and exploiting photographs of public domain paintings, and other works of visual art, could obviously be extremely useful in evaluating the need, if any, for additional incentives.

which the painting hangs) will already have enjoyed a relatively long period of exclusive control during which she (and they) had the opportunity to charge for uses of the painting. But that period of exclusivity is now over, and in return for having been excluded during the copyright term, the public is now supposed to be able to use the work free of any claims of exclusive control.<sup>42</sup> And yet, as noted above, in many instances, if a museum holds exclusive rights in its art reproduction photo of a public domain painting in its collection, those rights will pose a significant practical bar to the public using the painting depicted in the photo, since the museum may be the sole source for high-quality images of the painting.<sup>43</sup>

While we may want the museum to have some opportunity to recover its investment in producing its photograph, much of the price it is able to charge for the photo's use will be due to demand for the underlying painting depicted in the photo.<sup>44</sup> But users will generally have few, if any, other photographs of the painting from which to choose, since the museum's ownership of the original painting will typically allow it to restrict others from making high-quality photographic reproductions. As a result, those who want to use an image of the public domain painting will generally have to pay a higher price than they otherwise would have in a competitive market for use of the museum's photograph. That higher price means that, in at least some cases, the potential use will not be made. Some teachers will forego showing a slide of the painting in their classes, some art historians or critics will choose not to include an image of the painting in their monographs on the artist or her movement, and so forth.<sup>45</sup>

Copyright in art reproduction photographs may also impede use of an image of the underlying painting for far longer than the ordinary copyright term. As Ronan Deazley suggests, such copyright protection:

practically speaking, . . . provides galleries . . . with the means to exert a *de facto* perpetual monopoly over the commercial reproduction of publicly owned works of art. After all, if the copyright in the photograph of the painting is nearing exhaustion, then why not simply remove or destroy that photograph

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42. See, e.g., Butler, *supra* note 22, at 57–58; Pessach, *supra* note 32, at 279 (noting the especially compelling need for public access to works of art that have entered the public domain); Eldred v. Ashcroft, 537 U.S. 186, 260–62 (2003) (Breyer, J., dissenting) (discussing the Copyright Clause's basic assumption that "the disappearance of the monopoly grant . . . will, on balance, promote the dissemination of works already in existence").

43. Lower-quality images may be available, such as printed versions of the art reproduction photograph or amateur photos taken by visitors. But, as noted above, in many cases these will not be of sufficient quality for the use being made (e.g., a slide to accompany an art history lecture, or an illustration in a scholarly monograph, or a coffee-table book). See *supra* text accompanying notes 18–20.

44. Some fraction of the photograph's value to users may no doubt stem from the contributions of the museum's photographer in producing an excellent photographic image.

45. Patricia Taylor notes that one college, "[w]hen informed . . . that permissions to show the images [from the slides used in its standard art history survey course in a televised course] were prohibitively expensive" decided "to commission its faculty artists to draw images to be used in the course." Patricia Taylor, *By Line Drawings Ye Shall Know Them: Consequences of Barriers to Digital Reproduction*, XII VISUAL RESOURCES 333, 340 (1997). See also Baron, *supra* note 7, at 53–54 (discussing impact of costs for image access on scholarship).

and take a new one, creating a fresh, commercially exploitable, copyright term?<sup>46</sup>

Indeed, given the advances in reproduction technologies likely to be made over the course of a 95-year copyright term, a museum might not even need to make any efforts to restrict use of older art reproduction photographs whose term of copyright has expired, since those older photos would probably no longer be particularly useful for making high-quality reproductions. How many art publishers today would find it adequate to use a 1915 photograph of a painting to illustrate a scholarly monograph (in print or digital form) involving close analysis of the painting?

Granting a museum photographer (or her museum employer) exclusive rights in an art reproduction photograph may also impede use of the public domain painting in nonmonetary ways, again to the detriment of the principle of free use of public domain works. At least some museums attempt to exert curatorial control over how their art reproduction photos can be used. These museums may condition reproduction of their photos of works in their collection on accompanying credit information identifying the work, the artist, the museum, and perhaps the museum's donor.<sup>47</sup> They may also decide whether to grant permission based, for example, on their own evaluation of the kind of merchandise that a potential user wants to produce.<sup>48</sup> And museums may prohibit any alterations to the image: "Often, they prohibit cropping, the use of details, graphic effects such as overprinting, and any other alteration to the image they have provided."<sup>49</sup> As one attorney involved in art licensing put it, "[t]he stewards of certain creative properties do not want their Matisse painting complemented by a 2LiveCrew tune."<sup>50</sup>

These museums may have understandable motives as curators and art historians for imposing such restrictions on users. Perhaps they seek to ensure that reproductions of a painting are as faithful to the original as technology will allow, and that their own connection with the work is made known.<sup>51</sup> Nonetheless, giving museums the ability to exercise that kind of control over the use of the image of a work of art seems entirely inappropriate in the case of public domain works.

That level of control over the attribution and integrity of an artwork is not provided even to living artists in connection with reproductions of their works of visual art that are still protected by the Visual Artists Rights Act, the portion of the federal copyright statute

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46. Deazley, *supra* note 31, at 183.

47. *See, e.g.*, Tuchman, *supra* note 1, at 313 (noting that the motivations for museums to assert copyright in art reproduction photographs include the desire to prevent "overprinting text on images or reproduction of images without proper credit to named donors").

48. *See, e.g.*, Butler, *supra* note 22, at 68–70 (noting that some museums will not license works for use in any advertisements, others will not license advertising uses for certain products (such as alcohol or toilets), or in ways the museum finds "flip and disrespectful" (such as by inserting a product into an image)); Alsop, *supra* note 19 (noting museums that "refuse to deal with advertisers").

49. Walsh, *supra* note 12, at 362. *See also id.* at 369; Alsop, *supra* note 19 ("Museum executives most resent advertisers who alter paintings, usually by inserting their products into the pictures."); Butler, *supra* note 22, at 68–70 (noting museum concerns over quality of reproduction).

50. *Roundtable on Electronic Rights*, 20 COLUM.-VLA J.L. & ARTS 605, 618–19 (1996).

51. In some instances, museums may simply be motivated by their own views as to what uses are and are not appropriate. For example, one museum official found the use of a Matisse painting in an ad for toilets, sinks, and bidets to be "a slur on Matisse" and said she did not "agree with the premise that you can use anything to sell anything." Alsop, *supra* note 19.

that expressly offers limited protection to the interests in attribution and integrity that many legal systems typically protect as moral rights of the author.<sup>52</sup> And that level of control certainly does not extend to public domain works of authorship generally. For example, Samuel Beckett may not have wanted anyone, at any time, to ever be able to perform his play *Waiting for Godot* with an all-female cast.<sup>53</sup> But once the copyright in his play expires, his view that such casting would interfere with the integrity of his play will be, under U.S. law, irrelevant. Once the work enters the public domain, an all-female *Godot* will be entirely legal under copyright law. No one will need to seek permission to publicly perform the play at all, regardless of the casting choices made, since the copyright owner's right to exclude others from publicly performing the play will have expired.<sup>54</sup> Similarly, Shakespeare scholars may raise literary historical objections to all manner of productions of some of the Bard's plays, but one of the prime benefits of the public domain is that unauthorized and uncontrolled uses are allowed. Perhaps an innovative staging of the work will allow us to see things in the play that we had not seen before, or perhaps we will agree with the author or the scholars that the producers have violated the author's intent in the work. The work's public domain status, however, means that the audience gets to see the performance and decide for itself.

The same freedom to innovate extends to public domain paintings. Some potential uses that would involve alteration of the public domain image may be educational. Digital technology would allow "[i]nstructors [to] produce analytic diagrams superimposed on [an image of] the original work, or [to] morph one image to another to illustrate a relationship."<sup>55</sup> Other transforming uses might involve artistic reinterpretation. Andy Warhol, for example, might have wished to give the same treatment to an image of the *Mona Lisa* that he gave to photos of Marilyn Monroe and Jacqueline Kennedy. Copyright law should encourage him to do so, regardless of whether curators at the Louvre would have approved of his proposed use. As one art historian put it, "just as the public has the right to produce terrible (as well as excellent) performances of Shakespeare at will, so it should have the right to use and misuse the works of Rembrandt, Raphael, and Monet."<sup>56</sup> But giving a museum exclusive rights over its

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52. The Visual Artists Rights Act, 17 U.S.C. § 106A (2000), provides broad rights of attribution and integrity in works that meet the statutory definition of a "work of visual art." 17 U.S.C. § 101 (2000). But, as Professor Paul Goldstein explains, the Act's limitations (particularly those in § 106A(c)(3)) "effectively [exempt] from liability virtually all significant commercial uses of artistic works, including their reproduction in books, magazines, newspapers, [and] motion pictures." 2 PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 7.12, at 7:276 (3d ed. 2005). The sections also expressly exclude from the scope of an artist's attribution and integrity rights any reproduction or use of a work of visual art in or upon "any merchandising item or advertising, promotional, descriptive, covering, or packaging material or container." 17 U.S.C. §§ 106A(c)(3), 101 (2000) (defining a "work of visual art"). Of course, during a work's copyright term, the copyright owner could generally use her right to exclude unauthorized reproductions of the copyrighted painting to prevent its use in advertising or on merchandise, in cropped or altered form, or without some attribution.

53. See, e.g., Belinda McKeon, *In Godot We Trust: Beckett Was Drawn Back to Godot*, IRISH TIMES, available at <http://www.irishtimes.com/focus/beckett/p8.htm> (last visited May 12, 2009).

54. See, e.g., *Golan v. Gonzales*, 501 F.3d 1179, 1192–93 (10th Cir. 2007) ("[W]orks in the public domain belong to the public. . . . [E]ach member of the public—'anyone'—has a non-exclusive right . . . to use material in the public domain.") (citation omitted); *Dastar v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 33–34 (2003) ("[O]nce the . . . copyright monopoly has expired, the public may use the . . . work at will. . . .").

55. Taylor, *supra* note 45, at 336.

56. Walsh, *supra* note 12, at 370–71.

photograph of a public domain painting may give the museum effective, but inappropriate, control over the public's ability to use that public domain work in ways that visually alter it.<sup>57</sup>

For all of these reasons, then, we might be more concerned than in the ordinary copyright context about giving a museum exclusive rights over its art reproduction photographs. Those rights will not only limit access to the museum's photograph, but in many cases, as a practical matter, will also limit access to, and reduce use of, the underlying public domain work depicted in the photo. As noted above, some period of exclusivity might result in more and better art reproduction photographs being created than would otherwise be the case. But it also seems clear that such exclusivity could unduly interfere with use of the public domain paintings depicted in such photos.

### *C. Reconciling the Competing Interests: A Sui Generis Approach*

Given these competing incentive and access concerns, how ought we to answer the question of whether we should grant exclusive rights in precise photographic reproductions of public domain paintings? The far ends of the spectrum of possible answers seem equally unattractive. If we never allow any exclusive rights in such photos, we may get fewer art reproductions made, especially of less popular or less famous works, than we think would be socially desirable.<sup>58</sup> On the other hand, if we allow a museum to obtain an ordinary full copyright over such photos, we may get too few uses made of the underlying public domain works reproduced in those photos.<sup>59</sup> As Robert Cooter and Thomas Ulen have noted in a broader context, “[p]ut succinctly, the dilemma is that without a legal monopoly not enough information will be produced but with the legal monopoly too little of the information will be used.”<sup>60</sup> And, of course, neither of these approaches deals with the issue of a museum's use of physical control over its transparencies as an impediment to public use of a public domain painting.

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57. Of course, if an art reproduction photograph were protected by copyright, some or all of these uses might be allowed, without permission from the copyright owner, as fair uses. Unfortunately, the uncertainty about whether any particular use would qualify as a fair use would likely deter at least some potential users who would be confident enough to use the photograph if it were not copyrighted.

58. See *supra* text accompanying notes 34–40.

59. These are perhaps not the most extreme ends of the spectrum of possibilities. With respect to protection, we might imagine granting museums a perpetual right to control, or at least charge for, any use of the public domain painting's image, regardless of who created the photograph of the painting. Such a system might resemble in some respects a “paying public domain” or “domaine public payant,” in which works in which copyright has expired are available for anyone to use, but such use requires paying a fee—not to any copyright owner, but to a collecting entity that then uses such fees to support specified artistic or cultural activities. See, e.g., JOHN HENRY MERRYMAN & ALBERT E. ELSEN, *LAW, ETHICS, AND THE VISUAL ARTS* 301 (2002); U.N. Educ. Scientific & Cultural Org. [UNESCO] & World Intellectual Prop. Org. [WIPO], Comm. of Non-Governmental Experts on the ‘Domaine Public Payant,’ *Analysis of the Replies to the Survey of Existing Provisions for the Application of the System of ‘Domaine Public Payant’ in National Legislation*, UNESCO/WIPO/DPP/CE/1/2 (1982), available at <http://unesdoc.unesco.org/images/0004/000480/048044EB.pdf>.

At the other end of the spectrum, we could imagine a mandate that required every museum to allow any qualified photographer access to any public domain work in the museum's collection for the purpose of making an art reproduction photo of the painting. Neither extreme seems likely to address the competing concerns involved.

60. ROBERT COOTER AND THOMAS ULEN, *LAW AND ECONOMICS* 135 (2d ed. 1997).

An intermediate approach of a sui generis system of limited protection for art reproduction photos might best reconcile the competing interests involved.<sup>61</sup> Such a system could give photographers some exclusive rights in their photos, providing some incentive to invest the resources necessary to create them. But the rights could be more limited than those currently granted to authors under U.S. copyright law, and certain kinds of formalities could be imposed, in order to reduce the extent to which the photographer's rights would interfere with use of the public domain works depicted in the photograph.

What might such a sui generis system for art reproduction photographs look like? First, the term of protection for art reproduction photographs ought to be much shorter than the ordinary copyright term.<sup>62</sup> Museums seem highly unlikely to need anything close to 95 years in which to attempt to recoup their investment in creating these photos, and in any event that seems far too long to allow exclusive rights in such photos to hamper use of the underlying public domain work of art. Any term of protection that is chosen would only be an approximation of an optimal term, but a term in the range of 5 to 25 years might come closer to giving a museum sufficient opportunity, on average, to recover its investment.

Second, the scope of rights granted in the photograph should perhaps be narrower than those ordinarily granted in copyrighted works under section 106 of the current Copyright Act. In particular, any rights might be limited only to uses that actually recapture part or all of the museum's particular photograph of the public domain artwork, and not any uses that are similar to the museum's photograph but independently produced (even in conscious imitation of the museum's photo). Such an approach would be similar to the protection given to sound recordings under U.S. copyright law today. The reproduction and derivative work rights in a sound recording extend only to reproductions or adaptations that actually recapture the sounds of the copyrighted sound recording, and not to those that closely imitate or simulate the sound recording, even consciously so.<sup>63</sup>

In addition, it might be appropriate to limit rights in the photo to uses that reproduce the photo, in whole or substantial part, without any substantial expressive alteration on the part of the user. This would allow the museum to earn a return on its investment from ordinary reproductive uses (selling slides of the painting; printing the photo of the painting in a textbook, exhibition catalog, or coffee-table book; selling posters of the

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61. See Simon Stokes, *Photographing Paintings in the Public Domain: A Response to Garnett*, 23 EUR. INTEL. PROP. REV. 354 (2001) ("There may well be an argument for a shorter, 'neighbouring rights' type protection for such photographs—indeed this might well achieve the balance between granting museums a limited monopoly and allowing access to images of their treasures. But this is not in the United Kingdom copyright tradition."). Other intermediate approaches are possible. For one proposal focusing specifically on the digitization of images of works of art, see generally Pessach, *supra* note 32. For a suggestion that, in Europe, the sui generis database right would allow a museum to produce a compilation of its images and prevent others from reusing any "substantial part" of the database, see Aalberts & Beunen, *supra* note 9, at 229.

62. For photographs taken by a photographer who is an employee of a museum, the museum would own any copyright in the photo as a work made for hire, and the copyright in the photo would last for 95 years from its publication, or 120 years from its creation, whichever is shorter. 17 U.S.C. § 101 (2000) (defining "work made for hire"); *Id.* § 201(b) (2000); *Id.* § 302(c) (2000).

63. 17 U.S.C. § 114(b) (2000). See also 2 GOLDSTEIN, *supra* note 52, § 7.2.1.a, at 7:32–7:33 (discussing the scope of copyright in audio recordings).

photo of the painting; etc.) while not inhibiting expressive derivative uses that alter the painting as part of the user's creation of her own work of authorship, such as in the example of a Warholesque treatment of the *Mona Lisa*.<sup>64</sup>

Finally, any grant of rights in art reproduction photographs might be conditioned on fulfillment of a deposit requirement. The museum or photographer claiming protection for such a photograph should be obliged to deposit an original, high-quality, reproducible master transparency of the photograph in a designated, centralized, not-for-profit, publicly accessible repository. This would ensure that when the term of *sui generis* protection for the photograph expires, the public would be able to get access to the photograph without having to deal with the museum as the sole source of the image—or to agree to any conditions that the museum might seek to impose on using the image.<sup>65</sup> As a result, even if, after the expiration of the *sui generis* protection, the museum were to continue to condition access to its copies of the image on the payment of a license fee or the permission of its curatorial staff, those who wished to use the image without paying royalties or seeking permission would be able to do so. Those users would simply need to obtain a copy of the reproducible master from the repository.<sup>66</sup> Such a deposit requirement as a condition to protection under a *sui generis* system would help overcome the problem created by a museum's inevitable ability to control access to the original work needed to create photos, and its practical ability in many cases to limit the circulation of reproducible masters of the photos it creates.

This is only a brief sketch of what a *sui generis* system of protection for art reproduction photographs might look like. I do not wish to argue here that the particular system I have sketched out, or any *sui generis* system, is normatively the most desirable way to address the question of art reproduction photographs of public domain paintings. This sketch, though, suggests that we might be able to tailor any rights and limitations in such photos in ways that would provide some incentive to invest in creating them, and that would also reduce, to a substantial degree, the impediments that exclusive rights would pose to using public domain works. It also suggests that such tailoring may be better achieved outside of standard copyright law, and may be a better alternative than a simple binary choice between either ordinary copyright protection for art reproduction photographs, or no protection for them at all.

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64. Such an approach might pose challenges at the margins, such as when dealing with appropriation art, which might involve detailed, substantially unaltered reproduction of the museum's photograph of the original painting. Similar questions can, of course, arise regarding copyrighted images, particularly in determining whether an unauthorized use of the image is a fair use. See, e.g., Randy Kennedy, *If the Copy Is an Artwork, Then What's the Original?*, N.Y. TIMES, Dec. 7, 2007, at E1; Jane C. Ginsburg, *Exploiting the Artist's Commercial Identity: The Merchandizing of Art Images*, 19 COLUM.-VLA J. L. & ARTS 1, 21 (1994).

65. Such a deposit requirement would have parallels in the deposit requirements in the current copyright statute (and its predecessors). 17 U.S.C. §§ 407, 408(b) (2000). The requirement would also resemble in some ways patent law provisions that recognize that, in some instances, a patent applicant will need to deposit biological materials in order to satisfy the statutory requirements of patentability. 37 C.F.R. §§ 1.801–1.809 (2008); see also Mark D. Janis and Jay Kesan, *Designing an Optimal Intellectual Property System for Plants: A U.S. Supreme Court Debate*, 19 NATURE/BIOTECHNOLOGY 981 (2001). Indeed, to the extent that the provisions on deposit of biological materials require public accessibility of deposits, they provide a closer analog to the transparency deposit requirements.

66. Prospective users would presumably need to pay the repository for the labor and materials needed to make a copy for the user, but would not need to pay any royalty for their subsequent use of the image from the copy.

## IV. INTERNATIONAL AND CONSTITUTIONAL CONSTRAINTS: COULD CONGRESS ADOPT THE SUI GENERIS APPROACH?

*A. Sui Generis Protection as Copyright Law: International Constraints*

If we were to decide that such a sui generis system was the appropriate way to protect art reproduction photographs, the next question would be whether Congress had the power to adopt such a system.<sup>67</sup> The most obvious constitutional grant of authority that might permit Congress to enact such a sui generis regime is the Copyright Clause.<sup>68</sup> Although the particular details of protection would vary significantly from the general copyright regime in effect in the current title 17 of the U.S. Code, Congress seems to have the ability to exercise its copyright power in very different ways with respect to different subject matter. And many of the features of the sui generis system would resemble features of laws that Congress has enacted under its Copyright Clause power in the past.<sup>69</sup>

But can Congress protect art reproduction photographs using the power given to it in the Copyright Clause to grant “Authors” exclusive rights for limited times in their “Writings”? The *Bridgeman* decision raises some doubt. Recall that the *Bridgeman* court ruled that art reproduction photographs were not copyrightable because they were not “original” as required for copyright protection.<sup>70</sup> The requirement that a work be “original” is both a statutory requirement—in section 102(a), Congress has extended copyright protection only to “original works of authorship”<sup>71</sup>—and a constitutional requirement, since the Supreme Court has, most recently in the *Feist* decision, interpreted the “Writings” of “Authors” to encompass only original works.<sup>72</sup> But the *Bridgeman*

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67. Since the market for art reproduction photographs of public domain paintings seems likely to be principally national (or even international), a uniform federal sui generis system would likely be preferable to state-by-state adoption of such protection.

68. U.S. CONST. art. 1, § 8, cl. 8 (giving Congress the power “[t]o Promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries”).

69. As noted above, a deposit requirement has parallels in existing copyright and patent laws, and a limitation of rights to exact duplication would be similar to the “dubbing” limit on copyrights in sound recordings. Indeed, Congress could likely enact the substance of the sui generis regime outlined here by tailoring copyright protection rather than by creating a separate form of protection. Existing law already grants different rights and limitations to different types of works, 17 U.S.C. §§ 106–122 (2000), and the nature of the material required to be deposited currently varies by type of work, 37 C.F.R. pt. 202 app. B (2008). A truncated scope of rights in art reproduction photographs, and a deposit requirement specific to such photos, would be consistent with existing variation within copyright law. As to limited duration, Congress has certainly in the past enacted much shorter terms of protection than exist under current copyright law, though it has not generally enacted a shorter term of protection for one type of subject matter than for others.

70. *Bridgeman Art Library, Ltd. v. Corel Corp.*, 36 F. Supp. 2d 119, 195–97 (S.D.N.Y. 1999). For an extensive discussion of the law prior to *Bridgeman* as to whether art reproduction photographs are sufficiently “original” to be protected, see Butler, *supra* note 22, at 78–103. For a debate over whether such photos meet the originality standard under United Kingdom law, see Garnett, *supra* note 30; Ronan Deazley, *supra* note 31; Stokes, *supra* note 61; and Ronan Deazley, *In Response to Simon Stokes*, 23 EUR. INTEL. PROP. REV. 601 (2001). For varied continental views on the question, see Jane C. Ginsburg, *The Concept of Authorship in Comparative Copyright Law*, 52 DEPAUL L. REV. 1063, 1083–84 (2003).

71. 17 U.S.C. § 102(a) (2000).

72. *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 351–54 (1991).

opinion is somewhat ambiguous as to whether the court concluded that art reproduction photographs do not meet the statutory standard of originality, or that the photographs are not original in the constitutional sense, or both.<sup>73</sup>

Of course, there may be no difference between the two requirements. Congress may have chosen to treat as original under the statute any work that is original under the Constitution.<sup>74</sup> But since the Copyright Clause never uses the term “original,” and since Congress has never expressly stated that, in using the term “original” in section 102(a), it intended to encompass the exact same test of independent creation and minimal creativity that the Supreme Court announced in *Feist*, it is at least possible that the standards may differ. If art reproduction photographs are not original in the constitutional sense, then Congress could not protect them with a sui generis system using its copyright power. However, if *Bridgeman* concluded only that these photographs do not meet a higher statutory standard of originality (or if the Supreme Court were to conclude that *Bridgeman* was incorrectly decided as to the constitutional question) then Congress would appear to have the power under the Copyright Clause to enact the kind of sui generis system sketched above.<sup>75</sup>

Adopting such a sui generis system as a matter of copyright, however, may run afoul of international copyright obligations that the United States has taken on. One obvious potential conflict involves the term of protection. The Berne Convention, in Article 7(1), requires member states generally to grant protection for the life of the author plus 50 years, and the sui generis system obviously would not do so.<sup>76</sup> But the Berne Convention also contains a separate provision, Article 7(4), that allows member states to determine for themselves the term of protection for “photographic works,” as long as the term lasts at least 25 years from the photo’s creation.<sup>77</sup> So a sui generis grant of protection in art

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73. *Bridgeman*, 36 F. Supp. 2d at 195–97 (discussing originality cases involving both constitutional and statutory standards).

74. On the other hand, it appears that when Congress referred to the subject matter of copyright as the “writings of authors” in the 1909 Act, it may have intended a category narrower than that defined by those terms as used in the Copyright Clause.

In using the phrase ‘original works of authorship,’ rather than ‘all the writings of an author’ now in section 4 of the statute [the 1909 Act], the committee’s purpose is to avoid exhausting the constitutional power of Congress to legislate in this field . . . . Since the present statutory language is substantially the same as the empowering language of the Constitution, a recurring question has been whether the statutory and the constitutional provisions are coextensive. . . . The [1976 Act] avoids this dilemma by using a different phrase—‘original works of authorship’—in characterizing the general subject matter of statutory copyright protection.

H.R. Rep. No. 94-1476, at 51 (1976).

75. This assumes, of course, that art reproduction photographs would in fact meet the lower, constitutional originality standard, if indeed the standards were determined to be different. Of course, the Supreme Court might eventually take the view that some art reproduction photographs of two-dimensional paintings meet the constitutional originality standard and others do not. In that case, Congress could presumably use its Copyright Clause power only to protect original art reproduction photographs. A full analysis of how such a view of the originality of art reproduction photographs would affect Congress’s ability to enact a sui generis regime of the type described here, either under the Copyright Clause or under the Commerce Clause, is beyond the scope of this Article.

76. Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, as revised at Paris on July 24, 1971 and amended in 1979, S. TREATY DOC. No. 99-27 (1986) [hereinafter Berne Convention].

77. *Id.* art. 7(4).

reproductions for only 25 years would comply with Berne Convention obligations as to term.<sup>78</sup>

But while the Berne Convention would allow a shorter term for photographs, our international copyright obligations extend beyond the provisions of Berne. In 1996 the United States entered into the WIPO Copyright Treaty.<sup>79</sup> This treaty is most familiar for its provisions on technological protection measures. But it also addresses photographs, and requires that treaty signatories (such as the United States) “not apply the provisions of Article 7(4)” of the Berne Convention with respect to photographic works.<sup>80</sup> So, although Berne would permit a 25-year term, the United States has, in another treaty, restricted its freedom under the Berne Convention to provide photos with a shorter duration of protection than other works. In addition, the United States has entered into bilateral free-trade agreements with provisions that further limit its freedom to set the term of protection for copyrightable photographs. For example, the free-trade agreement between the United States and Australia requires that each member state set “the term of protection of a work (*including a photographic work*)” at either the life of the author plus 70 years or at least 70 years from the creation or publication of the work.<sup>81</sup> Thus, if we were to grant protection to art reproduction photographs as copyrightable works for only 25 years, we would likely be in violation of both multilateral and bilateral international copyright obligations with respect to copyright term.

The limited term of the *sui generis* regime is not the only feature that might contravene our international copyright obligations. If art reproduction photographs are copyrightable artistic works, the Berne Convention would on its face require that we grant the author of such a photo the exclusive rights to reproduce the work in any manner or form, to broadcast or communicate the work to the public, to adapt or alter the work, and to make cinematographic adaptations of the work.<sup>82</sup> The limited scope of rights under the *sui generis* regime would clearly fall short of these Berne minima. It might be possible, though, to argue that such a truncated *sui generis* right, limited to art

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78. The Universal Copyright Convention similarly requires that members provide only a ten-year term of protection for photographs. Universal Copyright Convention art. IV(3), Sept. 6, 1952, as revised at Paris on July 24, 1971, 25 U.S.T. 1341, 943 U.N.T.S. 178 [hereinafter UCC]. In addition, a 25-year term for photographs would not violate the World Trade Organization Agreement on Trade-Related Aspects of Intellectual Property (TRIPs). Although TRIPs contains a provision requiring that any copyright term not measured by the life of the author last for at least 50 years from the work’s publication (or, if the work is not published, 50 years from the work’s creation), that provision expressly does not apply to any “photographic work.” General Agreement on Tariffs and Trade: Multilateral Trade Negotiations Final Act Embodying the Results of the Uruguay Round of Multilateral Negotiations art. 12, Apr. 15, 1994, 33 I.L.M. 1125.

79. World Intellectual Property Organization Copyright Treaty, Dec. 20, 1996, S. TREATY DOC. No. 105-17 (1997), 36 I.L.M. 65 [hereinafter WIPO Copyright Treaty].

80. *Id.* art. 9; see Daniel J. Gervais, *The Compatibility of the “Skill and Labour” Originality Standard with the Berne Convention and the TRIPs Agreement*, 26 EUR. INTELL. PROP. REV. 75, 77 & nn.29–30 (2004) (discussing how the Berne Convention limits the duration of protection for photographic works to 25 years from production).

81. US-Australia Free Trade Agreement, U.S.-Austl., art. 17.4(4), Mar. 3, 2004, available at [http://www.ustr.gov/assets/Trade\\_Agreements/Bilateral/Australia\\_FTA/Final\\_Text/asset\\_upload\\_file148\\_5168.pdf](http://www.ustr.gov/assets/Trade_Agreements/Bilateral/Australia_FTA/Final_Text/asset_upload_file148_5168.pdf) (emphasis added). The agreement also requires that both parties ratify the WIPO Copyright Treaty, with its provision against applying Berne’s shorter term of protection for photographs. *Id.* art. 17.1(4).

82. See Berne Convention, *supra* note 76, arts. 9, 11*bis*, 12, 14 (listing rights that member states must provide to authors).

reproduction photographs, is Berne compatible. Article 2(3) of the Berne Convention states that protection for “[t]ranslations, adaptations, arrangements of music and other alterations of a literary or artistic work” are to be protected “without prejudice to the copyright in the original work.”<sup>83</sup> This article arguably applies to art reproduction photographs, which, like other “alterations” of an “artistic work” are based on a preexisting work of authorship. If article 2(3)’s language requires protection without prejudice to the copyright, *or the absence of copyright*, in the preexisting work, then arguably the scope of rights that a member state must grant to an art reproduction photograph of a public domain painting might permissibly be limited in order to avoid prejudice to the ability of others to make use of the underlying public domain work.<sup>84</sup> Whether that argument would find favor as an acceptable interpretation of the Berne Convention, and whether it would justify a grant of rights as narrow as that of the proposed *sui generis* regime, is not certain. But the argument does at least suggest that a *sui generis* regime that granted art reproduction photographs a narrower scope of protection than the ordinary full panoply of Berne rights might not necessarily violate our obligations under the convention.

Conditioning protection under the *sui generis* regime on compliance with a deposit requirement would pose yet another conflict with international copyright obligations. The Berne Convention requires that an author’s “enjoyment and the exercise” of copyright rights “not be subject to any formality.”<sup>85</sup> Granting *sui generis* protection to art reproduction photographs only if the photographer or museum deposits a high-quality reproducible master for access once the term of protection has expired would clearly contravene this ban on formalities.<sup>86</sup>

Thus, even if Congress has the Constitutional power to enact a *sui generis* regime of protection for art reproduction photographs as copyrightable works, international copyright agreements would present significant obstacles to doing so. The narrow exclusive right granted by the *sui generis* system might arguably comply with the Berne Convention, given the need to avoid prejudice to the use of the public domain painting, and a 25-year term of protection would comply with the special Berne provisions on duration for photographic works. But that shorter term would violate international copyright obligations under the WIPO Copyright Treaty and bilateral free trade agreements, and the deposit requirement would contravene the Berne Convention’s ban on formalities.<sup>87</sup>

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83. Berne Convention, *supra* note 76, art. 2(3).

84. Thanks to Jane Ginsburg for suggesting this line of argument.

85. Berne Convention, *supra* note 76, art. 5(2).

86. The “without prejudice” clause of Berne article 2(3) seems less likely to justify a departure from the Convention’s ban on formalities than, as discussed in the preceding paragraph, to justify some departure from the scope of rights that would otherwise have to be granted. A parallel argument could be made as to all copyrighted works—that a member state can condition copyright protection on deposit of a copy so as to ensure that once a work’s copyright expires, a copy will be available in a central depository for the public to use. It seems fairly certain, though, that this argument would not allow member states to impose a deposit requirement in the face of the Berne Convention’s prohibition of formalities.

87. Importantly, the Berne Convention imposes obligations on the United States only as to foreign works. Thus, Congress could, consistent with Berne, adopt the *sui generis* regime outlined here for works whose country of origin is the United States. Such an approach would, of course, be politically problematic, since it would treat U.S. art photographers less well than foreign ones. A domestic-only *sui generis* regime would also

*B. Sui Generis Protection Outside of Copyright: Constitutional Constraints*

If art reproduction photographs do not meet the constitutional standard of originality, then Congress cannot use its Copyright Clause power to grant rights in them. In that case, however, since Congress would not be enacting a copyright law, whatever system Congress adopted would presumably not be subject to the restraints of international copyright obligations.<sup>88</sup> That would free Congress to adopt a sui generis system that need not conform to the rules prescribed by international copyright agreements. But it would raise the question of whether Congress could enact such a system under some grant of power other than the Copyright Clause. The most likely candidate would be the Commerce Clause, given that the vast majority of the uses of art reproduction photographs licensed by museums (such as sales of merchandise, books, posters, slides, etc.) would likely be in interstate commerce.

The question of whether Congress can use the Commerce Clause power to enact a law that the Copyright Clause would not authorize is a controversial one at the moment.<sup>89</sup>

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not deal with problems of foreign-made art reproduction photographs, of which there are likely to be many, and might also give U.S.-based creators an incentive to try to manipulate the country of origin of their work (typically by first publishing the work abroad) in order to avoid receiving lesser protection granted to domestic works. *See, e.g.*, 17 U.S.C. § 101 (2000) (defining “United States work” largely by reference to place of publication).

88. Even if art reproduction photos are not “original” and therefore are not the “Writings” of “Authors” for constitutional purposes, they might be held to be copyrightable “artistic” works for purposes of the Berne Convention, the TRIPs Agreement and the WIPO Copyright Treaty. *See, e.g.*, 1 SAM RICKETSON & JANE C. GINSBURG, *INTERNATIONAL COPYRIGHT AND NEIGHBOURING RIGHTS: THE BERNE CONVENTION AND BEYOND* para. 8.05, at 406 (2d. ed. 2006) (“[A]lthough the Berne Convention leaves the precise contours of originality to national determination, it also implies some limitations on member states’ freedom to define those bounds.”). If so, the United States would thus be obligated under its international copyright obligations to grant copyright in these photographs, at least to foreign authors, but would be unable to do so under the federal copyright power. This would likely squarely present the question of whether Congress’s Treaty Power would enable it to enact legislation that it could not enact under the Copyright Power. On that question, see Graeme B. Dinwoodie, *Copyright Lawmaking Authority: An (Inter)Nationalist Perspective on the Treaty Clause*, 30 *COLUM. J.L. & ARTS* 355, 360–61, 385–94 (2007) (reviewing scholarly literature on the question and proposing a standard of review in such cases).

By contrast, art reproduction photographs might also be deemed to be sufficiently “original” as a matter of U.S. constitutional law that Congress could protect them using its Copyright Clause power, but at the same time those photographs might be found not to be covered by the provisions of the international copyright instruments to which the U.S. is a party. Although the international agreements refer to “photographs,” they do not expressly identify art reproduction photographs as necessarily being within their subject matter, and the standard of originality required by the agreements is unclear. *See, e.g.*, Gervais, *supra* note 80, at 76–80 (discussing the “originality” requirements of the Berne Convention and TRIPs); Ginsburg, *supra* note 70, at 1082–83 & n.83 (noting that “[c]opyright protection of photographic reproductions of artworks goes back to the nineteenth century and was urged in early drafts of the Berne Convention”). In that case, it would appear that as a constitutional matter Congress would be free to enact any system of sui generis protection compatible with the Copyright Clause without needing to adhere to any of the requirements of the Berne Convention. The situation would then resemble that of sound recordings, which qualify as “Writings” of “Authors” subject to protection by U.S. copyright law, *Goldstein v. California*, 412 U.S. 546, 561 (1973), but which are not included among the types of works to which the strictures of the Berne Convention apply (though other international agreements do govern treatment of sound recordings).

89. A full review of the scholarly literature on the topic is beyond the scope of this Article. For two prominent examples, see Paul J. Heald & Suzanna Sherry, *Implied Limits on the Legislative Power: The Intellectual Property Clause as an Absolute Constraint on Congress*, 2000 *U. ILL. L. REV.* 1119; Thomas B.

The leading appellate court decisions on that question involve a 1994 addition to the copyright statute that protects unfixed live musical performances, which may not constitute “Writings” covered by the Copyright Clause.<sup>90</sup> Two circuit courts have treated these performances as outside the scope of the Copyright Clause, but have upheld the criminal provisions of the 1994 law as valid under the Commerce Clause. These judicial endorsements of congressional recourse to the Commerce Clause for laws that the Copyright Clause does not empower may suggest that Congress could enact a *sui generis* system for unoriginal art reproduction photos, but the opinions are less than entirely clear on the full nature of the interaction between the two clauses.<sup>91</sup>

In *United States v. Moghadam*,<sup>92</sup> the Eleventh Circuit concluded that the Commerce Clause does give Congress the power to enact some legislation that the Copyright Clause does not. But it also concluded that, in some instances, Congress cannot use the Commerce Clause power to get around limitations in the Copyright Clause. The court suggested that if a law purportedly authorized by the Commerce Clause were “fundamentally inconsistent with the particular limitations in the Copyright Clause,” then the law would not be a valid exercise of the Commerce Clause power.<sup>93</sup> In the case before it, the court concluded that the Copyright Clause did not affirmatively forbid Congress from granting rights in works that did not meet the clause’s fixation requirement. As a result, even if live musical performances did not meet that requirement, granting rights in them was not inconsistent with the Copyright Clause.<sup>94</sup>

Enacting the *sui generis* protection described above would obviously present a question, under the Eleventh Circuit’s approach, regarding originality. The Copyright Clause limits Congress to protecting only “original” works, and the proposed *sui generis* regime enacted under the Commerce Clause would, by hypothesis, protect unoriginal photographs. Would such a *sui generis* right therefore be “fundamentally inconsistent” with a Copyright Clause limitation? The *Moghadam* decision offers little explanation as to how to determine what the limitations of the Copyright Clause are, or how to decide whether a particular law is fundamentally inconsistent with one of those limitations.<sup>95</sup> The court did note, though, that the subject matter of the law before the court in that case—live musical performances—“clearly satisfies the originality requirement” of the Copyright Clause.<sup>96</sup> This might imply that the court viewed the originality requirement as a fundamental limitation of the Copyright Clause, and that a law granting rights in

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Nachbar, *Intellectual Property and Constitutional Norms*, 104 COLUM. L. REV. 272 (2004).

90. 17 U.S.C. § 1101 (2000). In the two cases discussed below, the government apparently conceded that the unfixed recordings did not constitute “Writings” within the scope of the Copyright Clause, or else the court assumed that proposition without deciding it. *But see* 3 GOLDSTEIN, *supra* note 52, § 17.6.1, at 17:56 (3d ed. 2005) (“There is little doubt that the performances subject to protection are ‘writings’ in the constitutional sense for, beyond literalism, there is nothing in the mechanical act of fixation to distinguish writings from nonwritings.”).

91. If Congress has the power to enact a *sui generis* regime under the Commerce Clause, that regime might be subject to First Amendment challenge as a restriction on speech. Whether a *sui generis* statute of the kind outlined here would survive First Amendment scrutiny is beyond the scope of this Article.

92. *United States v. Moghadam*, 175 F.3d 1269 (11th Cir. 1999).

93. *Id.* at 1280 n.12.

94. *Id.* at 1280.

95. *Id.* at 1277–81.

96. *Id.* at 1280.

unoriginal works might be inconsistent with such a limitation. If so, a sui generis system for art reproduction photographs might not be a permissible exercise of the Commerce Clause power.

In *United States v. Martignon*,<sup>97</sup> the Second Circuit took a somewhat different approach to the constitutionality of the same statute. Like the Eleventh Circuit, it recognized that limitations in the Copyright Clause may, to some extent, limit Congress's power to legislate under the Commerce Clause.<sup>98</sup> But it concluded that Congress, under the Commerce Clause, can enact a statute that regulates in ways that Congress could not regulate under the Copyright Clause, *unless* "the statute at issue is a copyright law."<sup>99</sup> So Congress can exceed the scope of its Commerce Clause power by enacting a law that transgresses a limitation of the Copyright Clause, but only if the law is actually an exercise of Congress's Copyright Clause power.<sup>100</sup>

Under the Second Circuit's approach, the primary question appears to be one of classification. Is the law enacted by Congress in fact a copyright law, even if enacted under the Commerce Clause power?<sup>101</sup> Only then need we inquire as to whether it violates some limit of the Copyright Clause. Unfortunately, the Second Circuit has offered little guidance on how to determine whether a law is a copyright law. The court made clear that a statute may be a copyright law if it creates, bestows, allocates, grants, or establishes property rights in expression (apparently whether or not that expression is original).<sup>102</sup> Establishing property rights in expression is, in the court's view, a necessary, but not sufficient, condition for a law to be a copyright law.<sup>103</sup> But because the criminal statute covering live musical performances that was at issue in the *Martignon* case did not allocate property rights, the court concluded that it did not meet the necessary condition for being a copyright law, and therefore the court did not need to offer any further details on what additional conditions would be sufficient to make a law a copyright law.<sup>104</sup>

The *Martignon* approach leaves uncertain whether Congress could adopt the sui generis system discussed above to protect art reproduction photographs that do not meet the constitution's originality requirement. This sui generis system would fairly clearly grant property rights in expression, albeit unoriginal expression. So the statute would meet the Second Circuit's necessary condition for being a copyright law, leaving the question of whether the statute had other characteristics that would lead the court to classify it as a copyright law. And if the sui generis statute is a copyright law, that would then raise the question of whether it violates any limitation of the Copyright Clause.<sup>105</sup> The language of the Copyright Clause, as interpreted by the Supreme Court, clearly requires that a work be original in order to be protected. Is that requirement a "limitation"

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97. *United States v. Martignon*, 492 F.3d 140 (2d Cir. 2007).

98. *Id.* at 145–49.

99. *Id.* at 149.

100. *Id.*

101. *Id.* at 149–52.

102. *Martignon*, 492 F.3d at 150–51.

103. *Id.*

104. *Id.* at 150–52.

105. The *Martignon* opinion did not discuss whether the statute in that case violated any limit of the Copyright Clause, since it had decided that the statute was not an exercise of the Copyright Clause power. *Id.*

on Congress's power under the Copyright Clause? The *Martignon* decision never says, though it notes the difficulty in figuring out where the Copyright Clause's affirmative grant of power to Congress ends and where the Clause's limitations on that power begin.<sup>106</sup> The opinion does hint fairly strongly that not every law that grants property rights in unoriginal expression and is enacted pursuant to the Commerce Clause violates the Copyright Clause's limitations. In an aside, the court defended as constitutional the federal trademark statute,<sup>107</sup> enacted under the Commerce Clause power, which it characterized as "allocat[ing] property rights in (unoriginal) expression."<sup>108</sup> But the court expressly declined to say why that statute does not violate the Copyright Clause. So the *Martignon* opinion provides little guidance on how the court would view a statute such as the *sui generis* one contemplated here.

The fundamental issue in evaluating such inter-Clause conflicts may be whether the objectives of a statute adopted under the Commerce Clause are incompatible with, or in harmony with, the objectives of the Copyright Clause. If that statute's objectives are consonant with those of the Copyright Clause, holding that the Constitution, by failing to give Congress the power to enact the law under the Copyright Clause, also prohibits Congress from enacting the law under any of its other powers may make little sense. That fundamental question, though, may not provide any clear answer as to whether Congress can use its commerce power to adopt a *sui generis* system of protection for art reproduction photographs. One might describe that system's objectives—providing some incentives for creating photographs that would otherwise not be created while trying to minimize restrictions on using those photos once they are created—as entirely consistent with the Copyright Clause objective of providing incentives for creating works of authorship while trying to maximize access to those works. On that view, the *sui generis* regime would not offend the basic policies of the Copyright Clause. On the other hand, if one views a significant objective of the Copyright Clause as leaving free for public use any work that does not qualify for Copyright Clause protection, a *sui generis* exclusive right, enacted under the Commerce Clause, in unoriginal art reproduction photographs would directly clash with that objective. On that view, the *sui generis* regime could be seen as an attempt to undermine an important policy goal of the Copyright Clause. Because the Copyright Clause supports multiple interpretations as to its objectives (and as to the ordering of its potentially conflicting objectives), the inquiry into a *sui generis* system's compatibility with the policies of the Copyright Clause seems unlikely to yield an easy, definitive answer.

Congress may have the power to grant photographers (or their museum employers) a *sui generis* right to exclude other people from reproducing constitutionally unoriginal art reproduction photographs that Congress could not protect by copyright. Two modern appellate decisions address how the Copyright Clause's limitations affect Congress's power to enact legislation pursuant to its other enumerated powers. But neither decision provides much guidance on whether Congress could grant such a right. Thus, if Congress were to enact a *sui generis* regime for art reproduction photographs, the constitutionality

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106. *Id.* at 145 ("It is not clear from the wording of the Copyright Clause where the grant of power ends and where the limitation(s) begin(s).").

107. *Martignon*, 492 F.3d at 150 n.5.

108. *Id.* at 150 n.6.

of that legislation would likely be subject to challenge and require further judicial interpretation.

#### V. CONCLUSION

Legal and practical obstacles can make it difficult today to foster wide access to images of public domain paintings by means of art reproduction photographs. Even though the *Bridgeman* decision denied copyright protection to such photos, museum control over access to public domain paintings and to the museum's own art reproduction photographs may effectively limit the public's ability to make and use reproductions of paintings that are no longer protected by copyright. A sui generis system of protection for art reproduction photographs might best accommodate the various interests at stake in providing incentives for making such photos, while not giving effective exclusive control over public domain works of art.

Enacting such a system, however, may prove difficult. The last few decades have witnessed a substantial expansion in the international copyright obligations of the United States and an accompanying expansion of domestic copyright law. That expansion has also led to significant court challenges to the scope of Congressional power to expand copyright and copyright-like protections. As a result of these developments, both international obligations and constitutional interpretation tie Congress's hands in ways that could put a sui generis system of protection for art reproduction photos out of reach.

The drive to create a uniformly high level of protection for all works of authorship throughout the world may have bound the United States to grant such photographs the very substantial protections it grants other, more genuinely creative works of authorship, even if that level of protection has substantial costs that would not be justified by any compensating benefits. On the other hand, if such photographs are in fact not copyrightable works by virtue of their lack of originality, our international obligations would leave us free to grant them a more modest scope of protection than we grant original works under copyright law. However, the emerging understanding of the scope of the constitution's Copyright Clause might disable Congress from enacting even a modest sui generis system.