

No. 18-728

IN THE
Supreme Court of the United States

JACOBUS RENTMEESTER,
Petitioner,

v.

NIKE, INC.,
Respondent.

*On Petition for a Writ of Certiorari to
the United States Court of Appeals
for the Ninth Circuit*

REPLY BRIEF FOR PETITIONER

ERIC B. FASTIFF
DEAN M. HARVEY
KATHERINE C. LUBIN
LIEFF, CABRASER, HEIMANN
& BERNSTEIN, LLP
275 Battery Street, 29th Floor
San Francisco, CA 94111
(415) 956-1000

DEEPAK GUPTA
Counsel of Record
JOSHUA MATZ
GUPTA WESSLER PLLC
1900 L Street, NW, Suite 312
Washington, DC 20036
(202) 888-1741
deepak@guptawessler.com

Counsel for Petitioner
(continued on the inside cover)

February 20, 2019

CODY HOESLY
LARKINS VACURA KAYSER LLP
121 SW Morrison Street
Suite 700
Portland, OR 97204
(503) 222-4424

Counsel for Petitioner

TABLE OF CONTENTS

Table of authorities ii

Reply brief for petitioner1

I. The Ninth Circuit created a circuit split.1

 A. Nike does not deny that the decision below held the individual elements of a photograph wholly unprotected.2

 B. The decision below conflicts with decisions of the First, Second, and Eleventh Circuits.3

II. This case is an ideal vehicle to address a question of national importance.9

Conclusion11

TABLE OF AUTHORITIES

Cases

<i>Boisson v. Banian, Ltd</i> , 273 F.3d 262 (2d Cir. 2001)	8
<i>Burrow-Giles v. Lithographic Co. v. Sarony</i> , 111 U.S. 53 (1884)	4
<i>Feist Publications, Inc. v. Rural Telephone Service Co.</i> , 499 U.S. 340 (1991)	1, 2, 8, 9
<i>Harney v. Sony Pictures Television, Inc.</i> , 704 F.3d 173 (1st Cir. 2013)	5, 9
<i>Leibovitz v. Paramount Pictures Corp.</i> , 137 F.3d 109 (2d Cir. 1998)	6, 7
<i>Leigh v. Warner Bros.</i> , 212 F.3d 1210 (11th Cir. 2000)	7, 8
<i>Mannion v. Coors Brewing Co.</i> , 377 F. Supp. 2d 444 (S.D.N.Y. 2005)	6, 7
<i>Matthew Bender & Co. v. West Publishing Co.</i> , 158 F.3d 674 (2d Cir. 1998)	9
<i>MiTek Holdings, Inc. v. Arce Engineering Co.</i> , 89 F.3d 1548 (11th Cir. 1996)	9
<i>Rogers v. Koons</i> , 960 F.2d 301 (2d Cir. 1992)	5, 6
<i>Sheldon v. Metro-Goldwyn Pictures Corp.</i> , 81 F.2d 49 (2d Cir. 1936)	10

Other authorities

1 *Nimmer on Copyright* § 2A.08[E][1].....1, 4

2 *The Law of Copyright* § 14:28.....1

Justin Hughes,

*The Photographer's Copyright—Photograph As
Art, Photograph As Database*, 25 *Harv. J.L. &*

Tech. 339 (2012)4

REPLY BRIEF FOR PETITIONER

This case presents a clear circuit split on the question whether copyright law protects the elements of a photograph that express original artistry by the photographer. Nike works hard to cast a veneer of uniformity over the cases cited in the petition, but in the end these efforts only highlight the depth of the disagreement on the question presented. That split, moreover, divides the nation's two busiest copyright circuits. And it concerns a question that is both practically important in general and outcome-determinative in this case. The Ninth Circuit's erroneous decision warrants review and reversal.

I. The Ninth Circuit created a circuit split.

Nike maintains that the federal courts are in agreement when it comes to analyzing copyright protection for photographs. In Nike's view, this case "simply involves the context-specific application" of settled law "to the works at issue." BIO 15; *but see* 1 *Nimmer on Copyright* § 2A.08[E][1] ("[C]onfusion and disagreement among courts and scholars continues to arise."); 2 *The Law of Copyright* § 14:28 ("It is hard to say there is any overwhelming consistency in this area.").

To support that claim, Nike recounts a number of undisputed points. It opens with a detailed explanation of the idea-expression dichotomy. *See* BIO 13-15; *see also* *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 344-45 (1991). So far, so good. Nike then summarizes the familiar rule that "in comparing works for substantial similarity, courts must distinguish between protected versus unprotected elements, and focus on the former." BIO 16. Correct. Finally, Nike reiterates the lower court's conclusion that the idea underlying Mr. Rentmeester's photo is unprotected. *See* BIO 17-19; *accord*

App. 14a (Rentmeester “cannot prohibit other photographers from taking their own photos of Jordan in a leaping, *grand jeté*-inspired pose”). Again, we agree: only Rentmeester’s original artistry, as expressed in the photograph he created, is protected.

The wheels come off, though, when Nike insists there is a consensus on how to define the protectable elements of a photograph. The Ninth Circuit’s decision marked a clear departure from the holdings of the other circuits to have considered that question. And it is an *important* departure, since the identification of protected elements is often outcome-determinative (as it is here).

A. Nike does not deny that the decision below held the individual elements of a photograph wholly unprotected.

To start, Nike embraces the Ninth Circuit’s holding that a photograph’s individual elements are categorically unprotectable as a matter of law. *See, e.g.*, BIO 19, 21, 25. On this view, photographs are little more than “factual compilations” like phonebooks, consisting of craftily arranged (but unprotected) facts. *See* App. 11a. It is black-letter law that factual compilations receive thin protection for their selection and arrangement of unprotected elements. *See Feist*, 499 U.S. at 349. This explains why the Ninth Circuit effectively required near-virtual identity between Mr. Rentmeester’s photo and the Nike photo. *See* App. 13a-14a. It also explains why the Ninth Circuit did not even consider the possibility that Nike violated Rentmeester’s copyright by pirating individual, original elements of the photograph.

In defending this reasoning, Nike emphasizes that the Ninth Circuit afforded Rentmeester’s photo “the broadest protection a photograph can receive.” BIO 2, 9,

12. But the key here is the qualifier. The Ninth Circuit expressly *refused* to afford standard copyright protection to photographs. It offered only as much as a “factual compilation” can receive. App. 11a. In other words, very little—and none whatsoever for the photo’s individual elements. This is particularly striking given the Ninth Circuit’s recognition that Rentmeester meticulously staged the tableau for his photo in a highly original and counter-intuitive manner. *See* App 2a. The Ninth Circuit also remarked upon the many techniques that Rentmeester employed while taking the photo to express particular effects in the final photograph—including his manipulations of the “pose, lighting, camera angle, [and] depth of field.” App. 9a.

Notwithstanding all of the originality that went into the elements comprising the photograph, Nike concedes that the Ninth Circuit held that each and every element is wholly unprotected, measuring infringement only against their selection and arrangement. In effect, the court treated photography as junior-varsity art.

B. The decision below conflicts with decisions of the First, Second, and Eleventh Circuits.

Nike denies it, but the individual elements of the Rentmeester photograph expressing artistic judgment would be protected as a matter of law in the First, Second, and Eleventh Circuits. This does not mean that every case involving a photograph goes to a jury. *See* BIO 3. Nor does it mean that photographers are permitted to copyright “ideas.” *Id.* It simply means that when a photographer makes creative decisions, and those decisions are expressed in a photograph, the law protects that original expression from piracy.

Broadly speaking, courts have protected the individual elements of photographs in two circumstances: where the photographer staged an original tableau, and where the photographer made original choices with respect to light, film, angle, and other technical elements.

In the first category—original tableaus staged and posed by the photographer—courts afford protection to the subject matter as expressed in the image because it would not have existed without the photographer’s artistic intervention. *See* Amicus Brief of Prof. Terry S. Kogan 2-8. Nike disagrees, asserting that the subject matter of a photograph can *never* be protected. BIO 19-24. But Nike is mistaken. *See* 1 *Nimmer on Copyright* § 2A.08[E][3][a][i] (copyright protection may attach “when the author of the photograph creates original subject matter (*e.g.*, a sculpture, or distinctly posing individuals) that is then incorporated into the photograph.”); Justin Hughes, *The Photographer’s Copyright—Photograph As Art, Photograph As Database*, 25 Harv. J.L. & Tech. 339, 402 (2012) (“[C]omposing and posing can form a significant basis for copyright.”).

In refusing to afford any protection to Mr. Rentmeester’s meticulously staged tableau, the Ninth Circuit departed from *Burrow-Giles v. Lithographic Co. v. Sarony*, 111 U.S. 53, 60 (1884), which held that a photograph possessed originality where the photographer had, among other things, “arrang[ed] the subject so as to present graceful outlines” and “suggest[ed] and evok[ed] the desired expression.” Nike retorts that *Burrow-Giles* decided *only* “whether a photograph was copyrightable at all,” BIO 23, but this reading is too narrow. *Burrow-Giles* identified elements that made the photo original.

The First Circuit followed the same path in *Harney v. Sony Pictures Television, Inc.*, 704 F.3d 173 (1st Cir. 2013). Nike seeks to distinguish *Harney* on the ground that it considered a combination of elements, rather than any element individually. BIO 28. Yet *Harney* did so only because the photographer had snapped a candid shot. See 704 F.3d at 182. “Subject matter that the photographer did not create could be viewed as ‘facts’ that, like ideas, are not entitled to copyright protection.” *Id.* at 181. In contrast, *Harney* held that different analysis is required “when the photographer does not simply take her subject ‘as is,’ but arranges or otherwise creates the content by, for example, posing her subjects or suggesting facial expressions.” *Id.* at 181-82. Unlike the Ninth Circuit here, *Harney* thus held that an original tableau “create[d]” by a photographer and expressed in an image must be treated differently than unprotectable facts. *Id.* at 181.

The Second Circuit echoed this view in *Rogers v. Koons*, holding that “posing the subjects” and “evoking the desired expression” may qualify as “[e]lements of originality in a photograph.” 960 F.2d 301, 307 (2d Cir. 1992). *Koons* added that a photographer’s “inventive efforts in *posing the group for [a] photograph*, taking the picture, and printing [it]” satisfied the requirement of originality. *Id.* (emphasis added). Based on that reasoning, it concluded that a 3-D color sculpture with a different background and several differences in facial expression infringed a 2-D, black-and-white photo of a couple sitting with puppies. This holding turned largely on the fact that the sculptor had pirated the “placement” and “expressions of the subjects.” *Id.* at 308.

Faced with such a clear split, Nike has little to say. It merely asserts that *Koons* protected only the “photographer’s selection and arrangement of elements.” BIO 29. But that is an incorrect reading of *Koons*. See *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444, 453 (S.D.N.Y. 2005) (explaining, in a section entitled “protectible elements of photographs,” that “[a] photograph may be original to the extent that the photographer created ‘the scene or subject to be photographed,’” and discussing *Koons* as a leading case for this proposition). In addition, *Koons* held that copyright law protects the “*components of the work* that are original to the creator.” 960 F.2d at 307. Such “elements of originality in a photograph may include posing the subjects, lighting, angle, selection of film and camera, evoking the desired expression, and almost any other variant involved.” *Id.* Nike insists that *Koons* allowed protection only for unprotected elements in combination, BIO 25, but *Koons* says the opposite.

Nike’s error is confirmed by *Leibovitz v. Paramount Pictures Corp.*, 137 F.3d 109 (2d Cir. 1998). There, while addressing a fair use defense, the court concluded that the “basic pose of a nude, pregnant body” belonged to the public domain. *Id.* at 116. However, the court then held that “Leibovitz is entitled to protection for *such artistic elements* as the particular lighting, the resulting skin tone of the subject, and the camera angle that she selected.” *Id.* For this proposition, the court cited *Koons*.

Nike seeks to distinguish *Leibovitz* as a fair-use case, BIO 29, but that doesn’t get Nike anywhere. Fair-use analysis requires identification of a photo’s protected elements, *Leibovitz*, 137 F.3d at 116, which is the question at issue here.

As a fallback, Nike insists that *Leibovitz* held “artistic elements” to be protectible collectively, not individually. BIO 30. That is wrong. *Leibovitz* made clear that it was addressing the elements individually by parsing out a single element, the pose, as unprotected because this particular pose belonged to the public domain. *See* 137 F.3d at 116. *Leibovitz* also referred to “*such* artistic elements,” indicating that it had in mind a series of protectable and discrete elements—the list from *Koons*, which it quoted. *Id.* (emphasis added).

Surveying relevant Second Circuit precedent, Judge Kaplan described them as protecting “originality in the rendition.” *Mannion*, 377 F. Supp. 2d at 452. He reasoned that “to the extent a photograph is original in this way, copyright protects not *what* is depicted, but rather *how* it is depicted.” *Id.* A photograph may thus contain original elements involving “such specialties as angle of shot, light and shade, exposure, effects achieved by means of filters, developing techniques etc.” *Id.*

Hewing to the maxim that the best defense is a good offense, Nike insists that *Mannion* proves “there is no split.” BIO 30. Nike states that, in comparing the protectible elements of the two photos, Judge Kaplan noted “that those elements *are not to be viewed in isolation.*” BIO 31 (quoting *Mannion*, 377 F. Supp. 2d at 462 (emphasis added by Nike)). But Nike doesn’t explain why that’s relevant. Unprotected elements are filtered out in substantial-similarity analysis. So it still matters a great deal which elements are protected—and *that* is the point on which the Ninth Circuit created a split.

That same point of divergence also set the Ninth Circuit at odds with *Leigh v. Warner Bros.*, 212 F.3d 1210 (11th Cir. 2000). There, the Eleventh Circuit identified

the “elements of artistic craft protected by Leigh’s copyright [in a photograph] as the selection of lighting, shading, timing, angle, and film.” *Id.* at 1215.

In response, Nike asserts that “the court found that defendant’s photographs could be substantially similar because they used the same selection and arrangement of elements, as they depicted the same statute, in the same cemetery, using the same background elements, lighting, and colors, unlike the works at issue here.” BIO 32. This misses the point. Our argument is not that *Leigh*, on its facts, “requires the conclusion that the Nike Photo . . . is substantially similar to the Rentmeester Photo.” BIO 32. Rather, our argument is that *Leigh* articulates a legal rule that would protect key elements of Rentmeester’s photo, thus requiring a finding of substantial similarity, whereas the Ninth Circuit treated those elements as unprotected. *See Leigh*, 212 F.3d at 1216 (“Although it may be easy to identify differences between the Warner Brothers still shots and Leigh’s photograph . . . the Warner Brothers images also have much in common *with the elements protected by Leigh’s copyright.*” (emphasis added)).

More broadly, Nike argues that there is no split because every original work can be reduced to elements lacking copyright protection. *See* BIO 25-26. That is both true and irrelevant. “[O]riginal works broken down into their composite parts would usually be little more than basic unprotectible elements like letters, colors and symbols.” *Boisson v. Banian, Ltd*, 273 F.3d 262, 272 (2d Cir. 2001). But that does not mean that every element of a work is necessarily unprotected. “Copyright protection may extend . . . to those components of a work that are original to the author.” *Feist*, 499 U.S. at 348. Thus,

original “elements of a work . . . are entitled to copyright protection.” *Matthew Bender & Co. v. W. Pub. Co.*, 158 F.3d 674, 681 (2d Cir. 1998). “Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity.” *Feist*, 499 U.S. at 345. And where individual elements of a work evince originality and are thus protected, they may not be pirated. *See, e.g., Harney*, 704 F.3d at 188; *MiTek Holdings, Inc. v. Arce Eng’g Co.*, 89 F.3d 1548, 1554 (11th Cir. 1996). That rule requires protection of original elements in a photograph.

There is no avoiding the circuit split presented by this petition. The First and Second Circuits hold that an original tableau staged by a photographer and expressed in a photograph is protectable. The First, Second, and Eleventh Circuits hold that other original elements of a photograph, including the lighting, camera angle, and shading, are entitled to protection as expressed in the photograph. The Ninth Circuit split with all three circuits when it held that none of these elements can ever be protected. And, remarkably, it did so even though these very artistic innovations are what led Nike to obtain a copy of the original film from Rentmeester, and ultimately led Nike to pirate its defining attributes.

II. This case is an ideal vehicle to address a question of national importance.

Nike never denies that the question presented is outcome determinative here. That is, Nike doesn’t argue that it would prevail under a legal standard that treats the original elements of a photograph as protectible.

Instead, Nike rehashes its substantial-similarity arguments on the merits. *See* BIO 33-38. As is customary in

defending a copyright case, Nike pores over the two photos, seeking every slight difference and describing each as vital. But “no plagiarist can excuse the wrong by showing how much of his work he did not pirate.” *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 56 (2d Cir. 1936) (Hand, J.). For the reasons set forth in our petition for certiorari, and by Judge Owens in his dissent, we disagree with Nike. *See* Pet 13-18, 38-40, 23a-26a.

At this stage, however, the key issue is not who would prevail on the merits; it is whether this case *actually* turns on the question presented. It does. The sole issue is whether copyright law protects elements of a photograph that express original creative judgments by the photographer. The parties disagree on that question, which the Ninth Circuit squarely decided and which other courts have resolved differently. If this Court answers the question presented in the affirmative, it could either perform substantial-similarity analysis itself or remand for a correct application of such analysis to both the photo and the logo. *See* Pet. 23 n.2. Given that the Ninth Circuit panel split 2-1 under an incorrect legal standard, there can be little doubt that properly protecting the original elements of Mr. Rentmeester’s photo would preclude a dismissal of this case on the pleadings.

Finally, Nike has no response to our arguments—or those of the *amici*—concerning the obvious real-world importance of this case and the question presented. *See* Am. Soc’y of Media Photographers Br. 4 (“Leaving this area of law jumbled and confused with conflicting opinions would chill the creation of new works and give the green light to infringers the world over.”); Digital Justice Found. Br. 4 (“Allowing copyright to go in the Ninth Circuit’s direction would prove inadequate to

protect these technical creators who currently dominate the field of photography—and the even more innovative creators following in their wake.”).

At times, Nike asserts that the decision below shows no disrespect to photography. *See* BIO 2-3. But the experts disagree. *See* Digital Justice Found. Br. 3 (“It is essential that the Court take this case to reinforce photography’s proper place within the constellation of artistic creation.”); Am. Soc’y of Media Photographers Br. 5 (“In industries other than photography, creative elements, and the selection and arrangement of those elements, are protected much more fiercely . . .”).

That reaction is understandable. In describing Rentmeester’s creative tableau and photographic artistry as unprotected “facts,” the Ninth Circuit denigrated his craft. *See* Am. Soc’y of Media Photographers Br. 14 (“Mr. Rentmeester did not ‘select’ Mr. Jordan’s pose, in the same manner as would a compiler of phone numbers select what numbers to include in a phone book. The artist here created Mr. Jordan’s pose, and he created the tangible expression of that pose in the photograph.”). This decision thus gives renewed life to a centuries-old view of photography as an inferior art—a misperception that this Court rightly rejected in *Burrow-Giles*, and that the Court is once again called upon to repudiate here.

CONCLUSION

The petition for a writ of certiorari should be granted.

-12-

Respectfully submitted,

DEEPAK GUPTA
Counsel of Record
JOSHUA MATZ
GUPTA WESSLER PLLC
1900 L Street, NW, Suite 312
Washington, DC 20036
(202) 888-1741
deepak@guptawessler.com

ERIC B. FASTIFF
DEAN M. HARVEY
KATHERINE C. LUBIN
LIEFF, CABRASER, HEIMANN &
BERNSTEIN, LLP
275 Battery Street, 29th Floor
San Francisco, CA 94111
(415) 956-1000

CODY HOESLY
LARKINS VACURA KAYSER LLP
121 SW Morrison Street
Suite 700
Portland, OR 97204
(503) 222-4424

February 20, 2019

Counsel for Petitioner