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HENRY McMASTER
ATTORNEY GENERAL

March 16, 2006

The Honorable Chip Huggins
Member, House of Representatives
308 Wayworth Court
Columbia, South Carolina 29212

Dear Representative Huggins:

We received your letter requesting an opinion of this Office regarding an issue raised in a letter you received from Ted Simpson, which you attached to your opinion request. According to Mr. Simpson's letter, he attempted to sell copies of a photograph he took in October of 2005 of Tillman Hall, located on Clemson University's campus, to a frame shop in Clemson, South Carolina. Mr. Simpson stated: "I was told by the owner that before he could buy my prints, I would have to obtain a license from Clemson." From Mr. Simpson's letter, he indicated you referred him to the Assistant Staff Counsel to the South Carolina House Judiciary Committee. Mr. Simpson stated: "after [Assistant Staff Counsel] researched the matter he could find no legal basis for Clemson's position." Mr. Simpson added, Assistant Staff Counsel also spoke with the Director of Licensing at Clemson, who informed him that "Clemson's policy was to require a licensing fee in exchange for their implied consent." Thus, you request an opinion of this Office addressing Mr. Simpson's concerns.

Law/Analysis

As Mr. Simpson concluded in his letter, Clemson's basis for requiring a licensing fee in exchange for their implied consent is unclear. In our analysis of Mr. Simpson's concerns, we were unable to uncover a basis under South Carolina law for Clemson's alleged licensing requirement. Thus, we presume Clemson's position on this matter is rooted in federal copyright or trademark law, and we will attempt to analyze the issue presented under such law. We are unaware of whether Clemson maintains copyright or trademark protection with respect to Tillman Hall, however, we will make such a presumption for purposes of this opinion.

Initially, we are compelled to note as we did in an opinion of this Office dated March 24, 1989, "While it is always true that an opinion of the Attorney General is advisory only and may simply comment upon the law as it presently exists, it is especially important to emphasize this fact here where the question you raise is a federal one and will thus have to be resolved ultimately by the United States Supreme Court." Therefore, we will attempt to provide you guidance on this issue,

Request Letter

while keeping in mind only a federal court can make a final determination on issues of federal law.

Copyright Protection

Title 17 of the United States Code contains the federal copyright laws. Under this title, section 102(a) lists eight categories of works afforded copyright protection. Included in this list are “architectural” works. 17 U.S.C.A. § 102(a)(8). Section 120 under title 17 deals with the scope of copyright protection for architectural works. This section specifically allows pictorial representations of architectural works. “The copyright in an architectural work that has been constructed does not include the right to prevent the making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations of the work, if the building in which the work is embodied is located in or ordinarily visible from a public place.” 17 U.S.C.A. § 120(a).

The United States Court of Appeals for the Ninth Circuit examined section 120(a) in Leicester v. Warner Brothers, 232 F.3d 1212 (2000). In that case, a designer of a streetwall and courtyard brought copyright action claiming Warner Brothers infringed on his copyrights for such “sculptural works” when it filmed a movie depicting a portion of the streetwall. The Ninth Circuit determined the streetwall was an architectural work and Congress, in its enactment of the Architectural Works Copyright Protection Act of 1990, “did not afford architectural works full copyright protection; rather, it exempted the making of pictorial representations of architectural works from copyright infringement.” Id. at 1217. Furthermore, that Court recited the following excerpt from the House Report explaining the reason for exempting pictorial representations of architectural works from copyright protection:

Architecture is a public art form and is enjoyed as such. Millions of people visit our cities every year and take back home photographs, posters, and other pictorial representations of prominent works of architecture as a memory of their trip. Additionally, numerous scholarly books on architecture are based on the ability to use photographs of architectural works.

These uses do not interfere with the normal exploitation of architectural works. Given the important public purpose served by these uses and the lack of harm to the copyright owner’s market, the Committee chose to provide an exemption, rather than rely on the doctrine of fair use, which requires ad hoc determinations.

Id. (quoting H.R. Rep. No. 101-735, at 22). Thus, presuming Clemson has a valid copyright on Tillman Hall as an architectural work, we find this copyright does not include “the right to prevent the making, distributing, or public display of . . . photographs” 17 U.S.C.A. § 120(a).

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Although federal copyright law does not appear to prohibit individuals from photographing Tillman Hall, we must note another provision under the federal copyright law that may restrict Mr. Simpson's activities. Section 102(a) of title 17 of the United States Code provides: "Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device." Photographs, like architectural works, are specifically included in the list of eight categories of works afforded copyright protection. Id. "To establish infringement, two elements must be proven: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original." Feist Publ'n. Inc. v. Rural Tel. Serv., 499 U.S. 340, 361 (1991). "The plaintiff can prove copying either directly or indirectly, by establishing that the defendant had access, and produced something 'substantially similar,' to the copyrighted work." Leigh v. Warner Bros., Inc., 212 F.3d 1210, 1214 (11th Cir. 2000). Although the Eleventh Circuit Court of Appeals in Leigh v. Warner Brothers, Inc., 212 F.3d 1210 (11th Cir. 2000), held the ultimate determination of whether photographs are substantially similar is a question of fact for the jury, it provided some guidance in making this determination. That Court found neither the subject matter nor the setting alone entitles a photograph to copyright protection. Id. at 1214. Rather, the Court concluded such protection is found in "the elements of the photographers craft," such as "lighting, shading, timing, angle, and film" and "the overall combination of these protected elements as well as the mood they convey." Id. at 1214-15.

Thus, assuming Clemson holds a valid copyright on an existing photograph, Mr. Simpson is prohibited pursuant to federal copyright laws from producing a photograph substantially similar to the copyrighted photograph. But, this restriction according to the Eleventh Circuit, is not invoked simply because the subject matter is the same.

Trademark Protection

In addition to the protection provided under the federal copyright statutes, Clemson may claim Tillman Hall's building design is protected under the Lanham Trade-Mark Act, providing protection from trademark infringement. 15 U.S.C.A. § 1051 et seq. Section 1127 of title 15 of the United States Code defines "trademark" as "any word, name, symbol, or device, or any combination thereof-- (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter" Section 1114(1) of title 15 provides for a civil cause of action against:

Any person who shall, without the consent of the registrant--

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in

connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

In Rock and Roll Hall of Fame and Museum, Inc. v. Gentile, 134 F.3d 749 (6th Cir. 1998), the Rock and Roll Hall of Fame and Museum (the "Museum") brought an action under 15 U.S.C.A. § 1114 against the publisher of a poster depicting the Museum claiming the publisher infringed on a trademark the Museum held on its building's design. The Sixth Circuit Court of Appeals recognized "a photograph which prominently depicts another person's trademark might very well, wittingly or unwittingly, use its object as a trademark," but in this case the Court was "not persuaded that the Museum uses its building design as a trademark." Id. at 754. In reaching this conclusion, the Sixth Circuit stated: "in order to be protected as a valid trademark, a designation must create 'a separate and distinct commercial impression, which . . . performs the trademark function of identifying the source of the merchandise to the customers.'" Id. at 753 (quoting In re Chem. Dynamics, Inc., 839 F.2d 1569, 1571 (Fed. Cir. 1988)).

[W]hether alleging infringement of a registered trademark, pursuant to 15 U.S.C. § 1114(1), or infringement of an unregistered trademark, pursuant to 15 U.S.C. § 1125(a)(1), it is clear that a plaintiff must show that it has actually used the designation at issue as a trademark, and that the defendant has also used the same or a similar designation as a trademark. In other words, the plaintiff must establish a likelihood that the defendant's designation will be confused with the plaintiff's trademark, such that consumers are mistakenly led to believe that the defendant's goods are produced or sponsored by the plaintiff.

Id. at 753-54 (citations omitted). Based on these determination, the Court found:

[W]hen we view the photograph in Gentile's poster, we do not readily recognize the design of the Museum's building as an indicator of source or sponsorship. What we see, rather, is a photograph of an

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accessible, well-known, public landmark. Stated somewhat differently, in Gentile's poster, the Museum's building strikes us not as a separate and distinct mark on the good, but, rather, as the good itself.

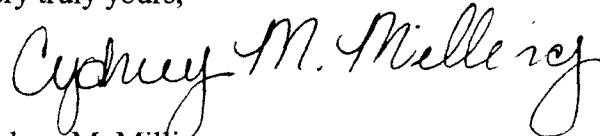
Id. at 754.

Given the Sixth Circuit's holding, if Clemson holds a valid trademark on the building design of Tillman Hall, it could restrict Mr. Simpson from reproducing such a trademark. However, for Clemson to invoke such a restriction, Mr. Simpson's photograph of Tillman Hall must be of the type that serves source-identifying function, which may cause consumers to mistakenly believe Mr. Simpson's photograph was produced or sponsored by Clemson.

Conclusion

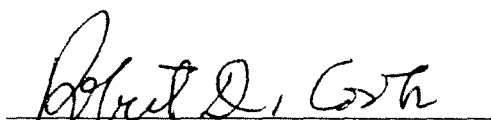
The federal copyright law, in an effort to protect architecture as a public art form, specifically excluded pictorial representations from the copyright protection afforded to architectural works. 17 U.S.C.A. § 120(a). Thus, assuming Clemson holds a copyright on Tillman Hall as an architectural work, it may not prevent individuals from taking photographs of the building. Nevertheless, if Clemson holds a copyright on a photograph, it may claim copyright protection on such photograph if Mr. Simpson's photograph is substantially similar, beyond simply containing the same subject matter, to the copyrighted photograph. In addition, under the auspices of Rock and Roll Hall of Fame and Museum, if Clemson holds a trademark on the building design of Tillman Hall, it may prevent Mr. Simpson from reproducing such a trademark in a way that consumers would believe Clemson produced or sponsored the photograph. However, again we note, whether or not Clemson is afforded protection under the federal copyright or trademark laws involves questions of federal law, and only a federal court may make such determinations.

Very truly yours,



Cydney M. Milling
Assistant Attorney General

REVIEWED AND APPROVED BY:



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