It's Jumpman at the Buzzer!

Hon. Nancy Holtz (Ret.)

The United States Court of Appeals for the Ninth Circuit recently delivered a big air ball to a photographer who was suing Nike for copyright infringement of a photograph. In *Rentmeester v. Nike, Inc.*,[1] a well-known photographer claimed that his photograph was infringed by Nike, first in a photograph utilized by Nike in advertising. Then, this Nike photograph was used to create the now iconic "Jumpman" logo adorning every pair of the millions of Air Jordans sold since the inception of this super-brand.[2]

This case is instructive because it contains a helpful discussion on two points, which the court suggests have not always been clear: First, there are two distinct components to establishing copyright infringement: (1) copying and (2) unlawful appropriation. Second, the court has used the same term, "substantial similarity," to describe the degree of similarity relevant to establish "copying," as well as when seeking to establish "unlawful appropriation." Substantial similarity has different meanings in each of these contexts. Substantial similarity for purposes of establishing copying only involves comparing the two works in their entirety and finding similarities which one would not expect if the two works were created independently. Substantial similarity for purposes of establishing unlawful appropriation requires that the similarities be substantial and relates to the protected elements of the original work as objectively compared with the allegedly infringing work.

The Procedural Background.

This copyright infringement claim did not survive Nike's Motion to Dismiss. A 2-1 panel of the Ninth Circuit agreed with the district court judge that, as a matter of law, the photographer had failed to plead adequate facts to support all of the necessary elements of a copyright infringement claim. In so finding, the court relied on the axiom of copyright law that the protection granted to a copyrighted work extends only to the particular *expression* of an idea *and never to the idea itself*. The court determined that the photographer's claim failed to pass the so-called "extrinsic test," which is part of establishing unlawful appropriation. Utilizing the extrinsic test, the court filtered out the non-protectable elements of the original photograph, engaging in an objective comparison of the selection and arrangement of various components—subject, pose, setting, camera angle, and the like—of the two photographs. The result of this objective comparison was a conclusion that the two photographs were not substantially similar under the extrinsic test; the court further ruled that the silhouetted image copied directly from the Nike-created photograph to create the Jumpman icon was even less similar and also not infringing. An air ball for the photographer's claims.

The Background.

Respected photographer, Jacobus Rentmeester was the creator of a well-known photograph of Michael Jordan, taken while Jordan was a student at the University of North Carolina. The photograph appeared in Life magazine as part of a feature on athletes participating in the 1984 Summer Olympics.

The photograph depicted Jordan in a pose not typically adopted in basketball, but well known in ballet as a "grand jeté." In ballet's grand jeté, a dancer leaps with legs extended, one foot forward and the other back, for a highly dramatic effect. The photograph was taken at an angle from below, looking up at the airborne Jordan. In a further original and creative idea, Rentmeester posed his subject outside the traditional confines of a basketball court. He instead chose a somewhat whimsical setting: an outdoor setting on a grassy knoll on which he placed a basketball hoop set at well beyond regulation height. In the photograph, Jordan is seen jumping, attempting to shoot a basket at a hoop set unattainably high. Rentmeester used powerful strobe lights and a fast shutter speed, to create a sharp image of Jordan against the sky, with the sun shining directly into the camera lens. The photograph was a hit and not long after its publication, Nike reached out to Rentmeester and entered into a licensing arrangement to use this photograph "for slide presentation only." About a year later, inspired by the famous photograph of Jordan taken by Rentmeester, Nike hired its own photographer to produce a similar photograph of Jordan. In the Nike photograph, Jordan is again striking the grand jeté pose and again set outdoors rather than on the basketball court, jumping towards a basketball hoop. The angle of the photograph, taken from the bottom looking up, is also similar to Rentmeester's choice of angle. The backdrop, however, is the Chicago city skyline, in a nod to Jordan's team, the Chicago Bulls. Further, Jordan's positioning, while still a grand jeté, is a bit different. There were also some slight differences in other photographic techniques, discussed at length by the court. This photograph was used in posters and billboards as part of Nike's marketing the emerging Air Jordan brand. Upon learning of this photograph, Rentmeester threatened litigation. This was staved off by an agreement in which Nike was to pay Rentmeester $15,000 for the right to use its photograph for a period of two years on billboards and posters. Rentmeester claimed that use by Nike continued beyond the use which began in 1984 or early 1985. Nike went further with the highly successful Jordan image, now memorialized in its photograph. In 1987, the Nike photograph was used to create the "Jumpman" logo, a solid black silhouette that tracks the outline of Jordan's figure as it appears in the Nike photograph. The Jordan brand— identifiable by the now iconic Jumpman logo— currently generates about $3.1 billion of annual revenue for Nike.[3] This logo can fairly be said to be one of Nike's most recognizable trademarks, no doubt second only to the swoosh.

In 2015, Rentmeester brought the present action, alleging that both the Nike photograph and the Jumpman logo infringe upon the copyright of his 1984 photograph of Jordan. Rentmeester claimed copyright infringement and violation of the Digital Millennium Copyright Act.[4] Mindful of the thirty-year delay in bringing suit and no doubt wanting to avoid a likely laches defense being raised, Rentmeester only sought damages for acts of infringement occurring since January 2012.

The Elements of the Copyright Infringement Were Not All Met.

To state his claim, Rentmeester needed to allege that (1) he owned a valid copyright of his photograph of Jordan and (2) Nike copied protected aspects of the photograph's expression.[5]

As to the second element, the copying of protected aspects of the photograph's expression, Rentmeester fell short in establishing the second component of this element, unlawful appropriation. The Ninth Circuit noted that "[a] lthough our cases have not always made this point explicit, the second element has two distinct components: 'copying' and 'unlawful appropriation.'"[6]

As to the first component, copying, Rentmeester's allegation that he provided color transparencies of his photograph to Nike's creative director short-

ly before production of the Nike photograph was sufficient to establish that Nike had access to Rentmeester's photograph. Further, comparison of the two photographs showed substantial similarity between the two. The allegation related to Nike's access to Rentmeester's photograph, combined with the obvious conceptual similarities between the two photographs, were sufficient to create a presumption that the Nike photograph was the product of copying rather than independent creation. The adequacy of the allegations of this copying component did not appear to be a subject of any dispute.

The Second Component: Unlawful Appropriation.

Merely establishing copying, however, is not enough. To infringe, Rentmeester needed to plausibly allege that Nike copied enough of the protected expression from his photograph to establish unlawful appropriation. The United States Copyright Act does not extend protection to "any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in [the copyrighted] work."[7]

Limits have been set to protect the expression of ideas and concepts. These limits are necessary to strike a balance between the dueling social interests of rewarding an individual's creativity and effort, while at the same time allowing the public to enjoy the benefits and progress from use of the same subject matter. The courts have long recognized that an overly expansive application of copyright laws, and placing ideas under lock and key, will not protect, but rather stifle creativity.

What more is needed beyond alleging copying? Nike must have copied enough of Rentmeester's expression of Rentmeester's ideas or concepts to render the two works "substantially similar."[8] The challenge for courts is determining what is protected and what is not. The Ninth Circuit relied on the words of Judge Learned Hand in this regard, stating that "[t]he best we can do is borrow from the standard Judge Learned Hand employed in a case involving fabric designs: The two photographs' selection and arrangement of elements must be similar enough that 'the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them.'"[9]

With the issue of a valid copyright and copying being disposed of, the sole task at hand for the Rentmeester court was to determine substantial similarity for purposes of ascertaining whether or not there has been unlawful appropriation. One might ask: "If substantial similarity has been adequately pled in the copying component of the claim, why isn't this enough?" It is not enough, because while substantial similarity is used as part of establishing copying, it is not the same test for establishing ***illicit*** copying, that is, unlawful appropriation. The kind of substantial similarity for purposes of establishing copying is not adequate to establish unlawful appropriation. As the court noted, "[u]nfortunately, we have used the same term—'substantial similarity'—to describe both the degree of similarity relevant to the proof of copying and the degree of similarity necessary to establish unlawful appropriation."[10]

What Constitutes "Substantial Similarity" to Establish Unlawful Appropriation?

Again, to prove copying, the similarities between the two works need not be extensive. Further, the similarities do not need to involve only the protected elements of the plaintiff's work. The similarities simply need to be similarities one would not expect to arise if the two works had been created independently. It is a fairly low bar.

However, the *Rentmeester* court observed that while exact duplication is not necessary, the photographer would need to prove that the Nike photograph contained enough of the Rentmeester photograph's protected expression to render the Nike photograph substantially similar.[11]

The Ninth Circuit applies a two-part analysis to determine substantial similarity for purposes of unlawful appropriation: the "extrinsic test" and

the "intrinsic test." The extrinsic test assesses the objective similarities of the two works, focusing only on the protectable elements of the plaintiff's expression.[12] In order to engage in this extrinsic test, the first step is for the court to "filter out" the unprotectable elements of the plaintiff's work. The unprotectable elements would consist primarily of ideas and concepts, material in the public domain, and scènes à faire (stock or standard features that are commonly associated with the treatment of a given subject).[13]

What is left remaining, the protectable elements, are then compared to the allegedly infringing work to assess the similarities in the objective details of the work.

In comparison, the intrinsic test is a subjective comparison, a more "holistic" look in which two works are compared to determine if the entire concept and feel is substantially similar. Rentmeester needed to plead adequate facts to prevail under both tests.[14] This is a question of fact, which is not addressed by the court. But given that both tests, extrinsic and intrinsic, must be met to establish unlawful appropriation, whether or not Rentmeester could establish that the two photographs meet the intrinsic test was irrelevant.

The Extrinsic Test May Be Decided as a Matter of Law.

Because the extrinsic test focuses on similarities in the objective details of the compared works, as opposed to being dependent on the responses of the trier of fact, only the extrinsic test "may often be decided as a matter of law."[15]

While dissenting in part, one member of the Ninth Circuit's panel took issue with engaging in a comparison of the two photographs as a matter of law. That justice was of the view that there ought to have been an opportunity for discovery and that this decision ought not be made even at summary judgment let alone at such a preliminary stage. This justice opined that the majority had substituted its own judgment for that of a jury. However, on the subject of the Jumpman logo, this justice concurred that the mere image of Jordan engaged in a grand jeté pose was a human pose. As such, Rentmeester could not own a broad copyright over the particular pose itself reflected in the Jumpman logo (much like a piggyback pose could not be copyrighted.)

Photographs are Not Dissected as Easily as Novels, Plays, and Motion Pictures.

The court noted that certain types of works, such as novels, plays, and motion pictures lend themselves more readily to being filtered. Items such as ideas, scènes à faire, and the like, are more easily removed in order to see the remaining expression revealed in things like plot, dialogue, mood, setting, pacing, characters, and sequencing. However, with photographs, it is more difficult. Like authors and playwrights, photographers certainly make various creative choices when composing the desired image. These choices can range from subject matter, the lighting, the pose, camera angle, and so on. However, each of these, viewed in isolation, is not subject to copyright protection. Even if a photographer uses a very original camera angle, that photographer does not "own" that angle and cannot prevent other photographers from doing likewise. Another photographer would certainly be free to solicit Jordan to strike the exact same pose and photograph it.

The *Rentmeester* court suggested that for photographer's works, the focus should be on the *selection and arrangement* of the photographer's otherwise unprotected elements. This could include things like the combination of subject matter, camera angle and effects, pose, etc., rather than looking at each individual element standing alone. The *Rentmeester* court suggested that a photograph could be likened to factual compilations. In other words, while the author of a factual compilation cannot own copyright protection for the underlying facts, that author can seek protection if the selection and arrangement of those facts is sufficiently original. So it should be with photographs: the analysis and focus should be on the selection and arrangement of what might otherwise be unprotected. Therefore, a second photographer —in this case, on be-

half of Nike—is free to borrow any of the individual elements originally featured in the Rentmeester photograph, as long as the new photograph does not copy the selection and arrangement of the elements utilized by the Rentmeester photograph.

The Extrinsic Test Applied.

The following are the key factors which supported the court's ultimate conclusion that Rentmeester had not pled plausible facts to establish substantial similarity in this context:

The subject matter: The court noted that both photographs depicted Jordan in a leaping pose, evocative of ballet's grand jeté. This was a very clever and original idea. But it was just that—an idea, and thus not protectable. Michael Jordan would be free to pose for any other photographer in this grand jeté pose.

Also, on the subject matter, the court noted that in the Nike photograph, the subject was situated differently in the frame of the photograph, and the general "propulsion" of his body is vertical in the Nike photograph rather than horizontal as in the original.

The setting: Here again, the court noted that Rentmeester was the originator of the idea of having the basketball hoop situated in an almost fanciful outdoor setting rather than on a conventional basketball court. But while the Rentmeester photograph made it look as if Jordan is attempting to jump toward an impossibly high basketball hoop, the Nike photograph depicted an in-command Jordan jumping to make what appears to be a very doable basket.

Both photographs utilize an angle in which the viewer is looking up at Jordan. The court noted that this is a fairly standard technique of photographers and can hardly be considered original. While Rentmeester placed the hoop on a grassy knoll against the sky, the Nike photograph depicted Michael Jordan leaping across the backdrop of the Chicago skyline.

Finally, the court determined that the arrangement of the elements within the photographs was also materially different in other further respects: the positioning of Jordan's arms and legs in the frame of the photograph, and the positioning and lighting of the hoops.

In other words, while the idea of a leaping Michael Jordan soaring through the air towards a basket in an unusual pose and setting was that of Rentmeester's, each photographer expressed that idea differently. While kudos properly go to Rentmeester for originating this idea, he does not and cannot own it under copyright law. To permit Rentmeester to claim that he owns the general idea and concept of Michael Jordan attempting to shoot a basket in a ballet inspired grand jeté, outdoors in a silhouetted style against the sky, would mean withdrawing these ideas from the "stock of materials" available to artists.[16]

Utilizing the same reasoning, the court found that the solid black Jumpman logo which merely outlines the Nike photograph is even less similar to the Rentmeester photograph. In concurring on the conclusion that the Jumpman logo was not substantially similar, the justice observed that Rentmeester could no more copyright the Jordan pose than someone could copyright the Vulcan salute of Spock, Fonzi's double thumbs up gesture, or John Travolta's *Saturday Night Fever* dance pose. These gestures cannot be "owned" by anyone.

The conclusion of the court was that the photographs were not substantially similar because Rentmeester's copyright is limited to the particular selection and arrangement of the elements as expressed in his copyrighted image. This is why the two photographs, when compared with each other, passed the substantial similarity test for purposes of establishing that there was copying. But upon decoding what was protectable under copyright, the Ninth Circuit did not find that the Nike photograph and logo were substantially similar to the particular selection and arrangement of the elements of the Rentmeester photograph.[17]

Takeaway Thoughts.

Practitioners should take care not to conflate the two separate concepts of what is substantially similar for purposes of establishing copying as compared to establishing unlawful appropriation. In the former, a comparison may be made of the entire photographs. In the latter, only those protected components will be compared, after unprotected items have been filtered out from consideration. Overall, while specific choices such as angle, lighting, and other techniques might be standard and not protected, when assembled together, that particular selection and arrangement can be protectable. While the two photos are very similar to the casual observer, as a matter of law, the Ninth Circuit concluded that they reflected two expressions of the same idea. And the logo was an even stronger example of "same idea, different expression."

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Endnotes

1. 2018 U.S. App. LEXIS 4817 (9th Cir. Feb. 27, 2018)
2. The reader is strongly encouraged to view the three images: the original photograph, Nike's photograph, and the Jumpman logo, all of which are included at the end of the opinion itself.
3. Jonathan Stempel, *Nike defeats appeal over iconic Michael Jordan photo, Jumpman logo,* Reuters, Feb. 27, 2018, **https://www.reuters.com/article/us-nike-lawsuit-jordan/nike-defeats-appeal-over-iconic-michael-jordan-photo-jumpman-logo-idUSKCN1GB2R7.**
4. 17 U.S.C. § 1202.
5. *See, e.g. Feist Publications, Inc. v. Rural Telephone Service Co.,* 499 U.S. 340, 361 (1991).
6. *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.,* 562 F.2d 1157, 1164–65 (9th Cir. 1977); *Arnstein v. Porter,* 154 F.2d 464, 468 (2d Cir. 1946); 4 Melville B. Nimmer & David Nimmer, Nimmer on Copyright § 13.01[B] (2017).
7. 17 U.S.C. § 102(b).
8. *Mattel, Inc. v. MGA Entertainment, Inc.,* 616 F.3d 904, 913–14 (9th Cir. 2010).
9. *See Peter Pan Fabrics, Inc. v. Martin Weiner Corp.,* 274 F.2d 487, 489 (2d Cir.1960).
10. *Rentmeester* at *8. The Ninth Circuit noted that to avoid this ongoing confusion, some other jurisdictions use a different term—"probative similarity"—when determining if copying has been established. See, e.g. *Peter Letterese & Associates, Inc. v. World Institute of Scientology Enterprises, International,* 533 F.3d. 1287, 1301 & n.16 (11th Cir. 2008); *Positive Black Talk, Inc. v. Cash Money Records, Inc.,* 394 F. 3d 357, 368 & n.7 (5th Cir. 2004); *Laureyssens v. Idea Group Inc.,* 964 F.2d 131, 140 (2d Cir. 1992).
11. *Rentmeester,* citing *Mattel* at 913-14.
12. *Cavalier v. Random House, Inc.,* 297 F.3d 815, 822 (9th Cir. 2002).
13. *Id.* at 822–23.
14. *Funky Films, Inc. v. Time Warner Entertainment Co.,* 462 F.3d 1072, 1077 (9th Cir. 2006).
15. *McCulloch v. Albert E. Price, Inc.,* 823 F.2d 316, 319 (9th Cir. 1987).
16. 4 Nimmer on Copyright § 2A.08[E][3][c]; Justin Hughes, *The Photographer's Copyright—Photograph as Art, Photograph as Database,* 25 Harv. J. L. & Tech. 339, 350–51 (2012).
17. The Ninth Circuit majority took the view that no discovery or further fact finding was necessary for it to engage in an objective analysis of the various features of the two photographs, and to a lesser extent, the Jumpman logo.