

Is it original? New French decision on Mankowitz's famous portrait of Jimi Hendrix

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Abstract: This article considers a significant ruling of the Court of Appeal of Paris reversing a tribunal decision that Mankowitz's famous portrait of Jimi Hendrix was not sufficiently original to attract copyright protection and that the defendant, an e-cigarettes sales company, was therefore free to adapt the photograph for advertising purposes.

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After Mankowitz's famous portrait of world-known music legend Jimi Hendrix was diverted and distorted for commercial advertising purposes by an electronic cigarettes and accessories sales company, Mankowitz and his assignees filed a claim for copyright infringement. At first instance, the Paris tribunal of Grand Instance (TGI) controversially decided that it could not appreciate the originality embedded in Mankowitz's portrait.² Reversing the TGI decision, the Court of Appeal sheds some light as to how originality should be proven in court.³

The Mankowitz's case

The defendant, an electronic cigarettes and accessories sales company, used the well-known Mankowitz's portrait of Jimi Hendrix for commercial advertising purposes. By depicting the famous artist as smoking an *electronic* cigarette instead of a *real* cigarette, the defendant aimed at promoting its own products.

This dispute concerns the appreciation of originality as mandatory requirement for copyright to subsist in authorial works. Causing turmoil amongst practitioners and photographers, the TGI suggested that the originality criterion may be linked to the artistic merits of the work, contradicting recital 16 of the Directive 2006/116/EC on the term of protection of copyright.⁴ In the mind of the tribunal, the black & white portrait featuring the artist front-facing, waist forward, exhaling smoke while bearing

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² TGI Paris, 3rd ch, 1st section, 21 May 2015, *Societe Bowstir Ltd, G. M. v. Egotrade SARL* available at <https://www.legalis.net/jurisprudences/tgi-de-paris-3eme-chambre-1ere-section-jugement-rendu-le-21-mai-2015/> (last access date 13th July 2017).

³ Court of Appeal of Paris, pole 5, ch. 1, 13th June 2017, M.X., *Bowstir v. Egotrade*, available at <https://www.legalis.net/jurisprudences/cour-dappel-de-paris-pole-5-ch-1-arret-du-13-juin-2017/> (last access date 13th July 2017).

⁴ Directive 2006/116/EC of the European Parliament and of the Council of 12 December 2006 on the term of protection of copyright and certain related rights (codified version), *OJ L* 372, 27.12.2006, p. 12–18.

a half-smile and having his eyes half-closed, did not provide the evidence required to demonstrate that the resulting work derived from choices made by the photographer and not the artist's own personality. However, as described below, the situation is more complex than it appears.

On appeal, the Paris Court reversed the tribunal's decision and found that Mankowitz's photograph is original. Consequently, the unauthorised use constituted infringement copyright vested in the photograph.

Assessing originality...

Traditionally, a work is deemed original if it embodies the 'author's own intellectual creation'⁵. This entails a subjective assessment of originality removed from any artistic or aesthetic merits. The crucial element is that the work must be imprinted with the personal creative endeavour of its author whatever its form. This subjective assessment is combined with an objective assessment of originality, considering the creative freedom and personal choices made by the author. In relation to photographs, originality can be derived from the numerous free and creative choices made by the photographer such as the subject, positioning, background, framing, lighting, time of shooting, camera settings editing techniques, the camera used, and development techniques.⁶ This originality criterion is therefore closely linked to the idea/expression dichotomy whereby ideas remain outside the realm of copyright and only the expression of ideas may attract protection.

Given that the defendant challenged the copyright protection contained in the photograph, the onus fell on the claimant, author of the work, to explain and identify the elements stemming from his personality. This is where the situation got baffling at first instance. As the author's description focused on elements which were commonplace and could not be attributed to the photographer beyond reasonable doubt, the TGI held that it could not appreciate originality based on the evidence submitted, nor could it provide the possibility for the defendant to dispute this point.⁷

On appeal, Mankowitz focused on the choices made in preparation for, during and after the shooting. By explaining how he organised and directed the shooting of the rock star, the type of camera and lens used for the effect sought, the lightning, background, framing, and angle, the Court of Appeal of Paris was satisfied that these choices were deliberate and imprinted the photographer's own personality. The unauthorised reproduction and alteration of the copyright-protected photograph for

⁵ Amongst others: Case C-5/08, *Infopaq International A/S v Danske Dagblades Forening*, 16th July 2009, ECLI:EU:C:2009:465, at [35] and Case C-145/10, *Eva-Maria Painer v Standard VerlagsGmbH and Others*, 1st December 2011, ECLI:EU:C:2011:79, at [88].

⁶ Case C-145/10, *Eva-Maria Painer v Standard VerlagsGmbH and Others*, 1st December 2011, ECLI:EU:C:2011:79, at [91].

⁷ Though this outcome seems to be in contradiction with an earlier decision from the French Supreme Court in Cass. 1st Civ. 30 April 2014, n°13-15.517.

the purposes of commercial advertising fell, therefore, within the exclusive economic rights of the author.⁸

Submitting the right kind of evidence...

Even though originality does not require a specific form, it is not sufficient to establish oneself as the creator to become an author under copyright law. In essence, there is no presumption of originality for the purpose of copyright. The take-home message for practitioners and photographers trying to prove originality is to rely on the free and creative deliberate choices made by the author, refraining from merely depicting the artistic or aesthetic values vested in the photograph.⁹ Going further, a photograph resulting merely from a unique technical expertise will not be sufficient to satisfy the originality criterion.¹⁰ Despite this exercise leading to an artificial deconstruction of the image, which can be at odds with its creative process, these aspects (and these aspects only) will provide the evidence that courts need to objectively assess originality and enable the defendant to challenge it.

Additionally, French judges do not seem to be indifferent or neutral towards the standing of the author. Here, the Court of Appeal did not fear to consider the reputation of the author to determine originality. Whilst this might appear peculiar in the UK, it is not the first time that French courts appear more protective towards well-known and internationally recognised works and authors in an attempt to further protect cultural heritage.¹¹

Does the commercial context of the unauthorised use have any bearing on infringement?

Let's not forget that in this case, the use of Mankowitz's work was for the purposes of promoting the defendants' products. By appreciating the context in which the alleged infringing work was effectively used, the Court of Appeal held that the context and captions in combination with the use could have led consumers to believe that the photograph had been licensed or the products endorsed by the right-holders. Hence, the defendant should have sought permission to use the famous photograph despite the distortion made.

Conclusion

Proving originality is not a box-ticking exercise but requires careful consideration. Practitioners must ensure that the explanation submitted depicts the free and creative

⁸ L. 122-4 French Intellectual Property Code.

⁹ In relation to portrait photography, see similar reasoning in earlier decision: TGI Nanterre 1^{re} ch. A, 3 March 2004; TGI Paris 3^e ch. 1^{re} sect., 18 February 2004, *Saget v. Front National*, Légipresse, 2004, n° 212-I-79.

¹⁰ This has been decided in cases that required faithful reproduction of the subject, see TGI Paris 3^e ch. 3^e sect., 7 January 2003, RDPI, n° 155, January 2004.

¹¹ Société Moulinsart, Mm Fanny R. c/ Eric J. available at <https://www.legalis.net/jurisprudences/tribunal-de-grande-instance-de-paris-ordonnance-de-referendum-du-11-juin-2004/> (last access date 13th July 2017).

choices made by the author in the work. This derives from the very nature of the originality criterion. Firstly, the burden of proof inevitably falls onto the claimant as he or she is the best placed to identify the elements embodying his or her personality. As such, originality must be claimed. Secondly, the creative 'reflection' resulting in the image can only be substantiated by relying on the technical details surrounding the creative endeavour. This litigation confirms that the aesthetic or artistic merits in the work have no relevance in the appreciation of originality. In conclusion, the photographer must prove that he or she played a significant role in the creative process resulting in the photograph.

Additionally, once originality has been proven, it spreads to the work as a whole notwithstanding its *degree* of originality.¹² This prevents the artificial distinction between aspects of the work, which are highly original and therefore deserving protection, and other aspects that may be considered less original.

Overall, this litigation demonstrates how delicate it can be to evidence the imprint of the author's own intellectual creation in a photograph but also, it shows that the development of the originality criterion is still ongoing in copyright law.

¹² French Supreme Court Com., 19 January 2010, n° 08-15216.