

Copyright in 'Thumbnail' Images

The United States Court of Appeals for the Ninth Circuit recently held that the unauthorised creation and use of 'thumbnail' images in an internet search engine was not actionable by the owner of copyright in the images. Anthony Selleck reports on the case.

On 7 July 2003, the United States Court of Appeals for the Ninth Circuit held in *Kelly v Arriba Soft Corporation* that the unauthorised creation and use of 'thumbnail' images in an Internet search engine was not actionable by the owner of copyright in the images. The court held that, while the thumbnails were a prima facie infringement, they were nevertheless a 'fair use' under US copyright law. The court, however, remanded for further proceedings the issue of copyright infringement by in-line linking to the original full-sized images.

THUMBNAIL IMAGE SEARCH ENGINES

Arriba Soft Corporation operated an Internet search engine that displays the results of user queries in the form of small pictures, called 'thumbnails', rather than displaying text, as with conventional search engines. Arriba used software agents to trawl the Internet in search of images from which the thumbnails would be created and included in a database. The thumbnails were smaller and of lower resolution to the full sized images which were deleted from Arriba's servers once the thumbnails had been created.

The search engine also allowed a user to click onto a thumbnail to display the original full-sized image. The displayed image would be surrounded by text that included a description of the size of the image, a link to the web site from which the image was taken and advertising. This functionality was implemented via 'in-line linking', that allows a graphic from one web page to be seamlessly incorporated into another web page, giving the impression that the graphic forms part of that web page rather than being copied from another web site.

Mr Kelly sued Arriba for copyright infringement after thumbnails of his photographs were included in the Arriba database. Mr Kelly's claim was twofold, contending infringement through Arriba's creation and use of thumbnails and through the practice of in-line linking

to the original full-sized images on Mr Kelly's website. These two acts, according to Mr Kelly, infringed his exclusive rights to display, reproduce and distribute his photographs granted under section 106 of the US Copyright Act.

FAIR USE

Arriba was granted summary judgement by the District Court, which held that although Mr Kelly established a prima facie case of infringement, Arriba had successfully shown that use of the thumbnails and the in-line linking was

should also be noted that there may still be a 'fair use', notwithstanding that the use was for commercial purposes.

Past applications of this consideration have reached the following conclusions: see *Table 1*.

In each case where fair use was found, the court held that the original copyright work had been sufficiently 'transformed' from its original purpose and context.

The court then cited the following grounds to support its ruling that Arriba's database of thumbnail images was a fair

Scenario	Conclusion
Re-transmission of radio broadcasts over telephone lines	No fair use
Reproduction of audio CD into mp3 format	No fair use
Reproducing news footage without editing the footage	No fair use
Copying a religious book to create a new book for use by a different church	No fair use
Copying a photograph intended to be used in a modelling portfolio and using it instead in a news article	Fair use
Using screen shots from computer games in comparative advertising	Fair use

Table 1

'fair use' under s107 of the Copyright Act. Mr Kelly appealed to the Ninth Circuit which upheld the District Court's decision on the thumbnails but, for procedural reasons, remanded the in-line linking issue to the District Court for further consideration.

US law permitted the Ninth Circuit to apply the relevant 'fair use' principles itself, rather than being limited to reviewing the correctness of the District Court's decision.

In deciding whether a use of a copyright work is a permissible 'fair use' the court must consider, among other things, the purpose and character of the use, including whether the use is for commercial purposes. According to earlier Supreme Court authority the purpose of this consideration is to see whether the new work 'adds something new, with a further purpose or different character, altering the first with new expression, meaning or message'. It

use of the original full-sized images from Mr Kelly's web site:

- Arriba was neither using Mr Kelly's images to directly promote its website nor trying to profit by selling Mr Kelly's images;
- the smaller, lower resolution thumbnails served an entirely different function to Mr Kelly's images, as Kelly's images served an aesthetic purpose, while Arriba used the thumbnails to help index and improve access to images on the Internet;
- the public derived a benefit by enhanced information-gathering techniques on the Internet;
- Arriba's thumbnails did not harm the market for Mr Kelly's images, indeed inclusion in the database may have directed more users to Mr Kelly's website.

IN-LINE LINKING

The Ninth Circuit remanded the issue of the in-line linking to the District Court for further consideration. It is interesting to note that the District Court's original decision was that the in-line linking was also a fair use of Mr Kelly's images. This ruling seems to be in spite of the fact that at least on the last 3 grounds noted above arguably would not apply to in-line-linking to full-sized images, as opposed to creating and using thumbnails of those images. A further appeal to the Ninth

Circuit may be imminent if the District Court reaches the same conclusion in the further proceedings.

THE AUSTRALIAN POSITION

Australia has limited 'fair use' defences to copyright infringement when compared to the more general 'fair use' doctrine of United States jurisprudence. The creation of a thumbnail from a full-sized image would be reproduction in a material form, and the delivery of that thumbnail over the Internet in response to a search query would be a

communication to the public. Thus, to avoid infringement, a specific defence would need to be raised. As many of the grounds relied on by the US court to find 'fair use' would not be relevant to defences under Australian copyright law, the case provides an example of where Australian copyright law may be more beneficial to copyright owners than in the United States.

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The Price of Fame : Protection of Personality Rights in Australia

David Bowman examines the current status of personality rights in Australia and argues for reform

An association of some desirable character with the product proceeds more subtly to foster favourable inclination towards it, a good feeling about it, an emotional attachment to it. No logic tells the consumer that boots are better because Crocodile Dundee wears them for a few seconds on the screen ... but the boots are better in his eyes, worn by his idol (Emphasis in original) ¹.

INTRODUCTION

According to the Honourable Justice Peter Heerey, Lord Horatio Nelson was probably the first celebrity in the modern sense ². Since that time the value of celebrity has grown exponentially due, in part, to the advent of television, the influence of Hollywood and the globalisation of sport. There has been a concomitant growth in the merchandising of celebrity for the reasons expressed so eloquently by Justice Burchett above.

It has been reported that Michael Jordan's endorsements have earned \$8 billion for Nike³ but as the value of celebrity has grown so too has its cost. The creation and maintenance of the modern celebrity usually involves considerable time, expense and expertise often involving personal trainers, dieticians, spin-doctors, make-up artists, and plastic surgeons just to name a few. Given the investment required in creating and maintaining a celebrity persona, and its enormous potential value, should Australian law formally acknowledge and protect so called

"personality rights" in a manner similar to the laws of the USA and Canada?

In addressing this issue one must first consider the current state of Australian law in this regard. Australia has no equivalent to the right of publicity that exists in the USA⁴. There are however a number of different legal mechanisms that have been used, with varying degrees of success in an attempt to prevent the unfair appropriation of a personality for commercial advantage.

The following is a review of each of the different mechanisms that have been used and those that might be used in order to protect personality rights in Australia. The intention is not to provide an in-depth analysis of each area but rather to provide an overview which will make apparent the inadequacy of the present system of inappropriately extended law.

PASSING OFF

For the sake of brevity this section considers actions under s52 of the *Trade Practices Act 1974* (Cth) as essentially the same as actions for passing off. While there are important distinctions between

the two, these do not arise in a personality rights action as considered below.

The common law tort of passing off was originally developed to protect a trader from rivals who seek to untruthfully purport that their goods are the goods of the trader⁵. Traditionally passing off actions have required a plaintiff to show three things⁶:

- that they have established a reputation or goodwill in the community;
- that as a result of some misrepresentation or deception on the part of the defendant;
- they have suffered damage to their reputation or goodwill.

The traditional role of the tort of passing off was extended in the *Henderson* case⁷ to protect a person who was not, at least in the traditional sense, a trader. The case involved two professional ballroom dancers who sued in respect of an unauthorised photograph which was used on record covers. The dancers were successful in spite of the fact that they were not in the business of endorsing record covers, the NSW Supreme Court ruling