

Art Appropriation Redux

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Art appropriation is back in the news.

Jeff Koons the appropriation artist, the auction house and the consigner of the work are being sued by photographer Mitchel Gray for the use of his photograph in an artwork without permission. This is Mr. Koons' sixth lawsuit for claims of copyright infringement based on the misappropriation of previously existing works. Mr. Koons is 1 for 5 in the previous cases. In this case, Mr. Gray took a photograph of a couple on the beach for a Gordon's Gin ad in 1986.



Later that year, as part of his series *Luxury and Degradation*, Mr. Koons reproduced the photograph in its entirety and most of the ad with some slight variations (the "Koons Artwork").



The Koons Artwork, and case, raises three issues that anyone who creates or sells art which incorporates third party intellectual property must deal with, specifically copyright claims, Right of Publicity claims and trademark claims. While the *Gray* lawsuit is limited to copyright claims other questions that are not raised are present in Koons Artwork --- did Koons also violate Gordon's trademark rights and the Right of Publicity of the two models in the photograph? The suit provides us with an opportunity to review the current state of the law in regard to the appropriation of other's copyrightable artwork, trademarks, and likenesses in a new work.

In the last few years, a review of copyright cases shows that the pendulum has swung in favor of Fair Use, particularly in New York and California. There are two cases, in the Court of Appeals

in New York - one dealing with art and one not (the Google Books case), which have taken an expansive view towards fair use. The most exciting or troubling (depending on your point of view) art law case is *Cariou v. Prince*, 714 F.3d 694 (2d Cir. 2013). In *Cariou v. Prince*, artist Richard Prince was sued for appropriating dozens of photographers by Patrick Cariou. Cariou had published black-and-white portraits and landscapes that he took while living in Jamaica. Prince tore photos from Cariou's book and incorporated them into his own artwork, altering them in varying degrees and pinning them to plywood. Prince's work was subsequently featured at a gallery, and Cariou sued. To find fair use, the Second Circuit requires the new work to be transformative that is it "must alter the original with new expression, meaning, or message." The court found Prince's work was significantly different in size, color, and distorted nature, that his works were "fundamentally different and new." The Court also found that the law imposes no requirement that a work comment on the original, or its author, in order to be considered transformative; and a secondary work may constitute a fair use even if it serves some purpose other than those (criticism, comment, news reporting, teaching, scholarship, and research) identified in the preamble to the statute. The court further held that the more transformative a new work is, the less important the other four fair use factors become. The court broke new ground in finding fair use when it stated,

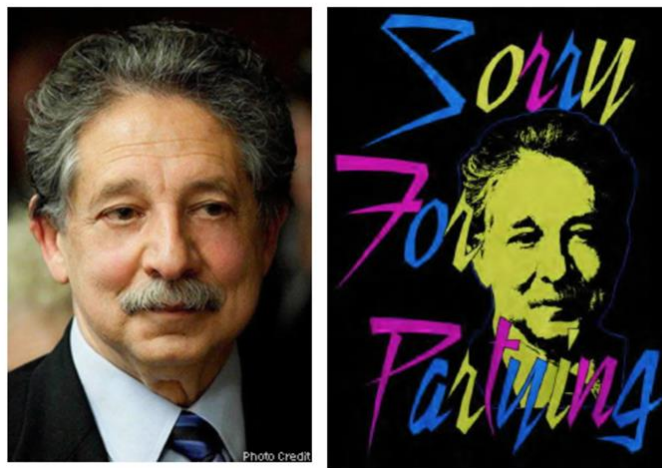
"The district court [whose decision of no fair use it over turned] based its conclusion that Prince's work is not transformative in large part on Prince's deposition testimony that he "do[es]n't really have a message," that he was not "trying to create anything with a new meaning or a new message," and that he "do[es]n't have any ... interest in [Cariou's] original intent. On appeal, Cariou argues that we must hold Prince to his testimony and that we are not to consider how Prince's works may reasonably be perceived unless Prince claims that they were satire or parody. No such rule exists, and we do not analyze satire or parody differently from any other transformative use.

It is not surprising that, when transformative use is at issue, the alleged infringer would go to great lengths to explain and defend his use as transformative. Prince did not do so here. However, the fact that Prince did not provide those sorts of explanations in his deposition — which might have lent strong support to his defense — is not dispositive. What is critical is how the work in question appears to the reasonable observer, not simply what an artist might say about a particular piece or body of work. Prince's work could be transformative even without commenting on Cariou's work or on culture, and even without Prince's stated intention to do so. Rather than confining our inquiry to Prince's explanations of his artworks, we instead examine how the artworks may "reasonably be perceived" in order to assess their transformative nature... The focus of our infringement



In ruling for Green Day, the court emphasized that the band's use was sufficiently transformative because different colors, contrast, a brick background, and a superimposed red crucifix were added to the artwork. Moreover, the video's message of religious hypocrisy had nothing to do with the Scream Icon's original meaning. Even though the Scream Icon was concurrently used with the band's concerts, this was only "incidentally commercial," because it was not used to promote the concerts or merchandise. Because Green Day's use conveyed "new information, new aesthetics, new insights, and understandings," it was transformative and fair.

In Wisconsin there is another case, *Kienitz v. Sonnie Nation LLC*, 766 F.3d 756 (7th Cir. 2014), where the court took a different approach to fair use than did the *Cariou* and *Green Day* courts. In *Kienitz*, the Seventh Circuit openly criticized the Second Circuit's interpretation of the Fair Use Doctrine in *Cariou*. Here, Michael Kienitz photographed Madison, Wisconsin mayor Paul Soglin, and subsequently posted that photograph on the city's website. Apparel company Sonnie Nation, LLC ("Sonnie Nation") downloaded the Mayor's photograph from the website, altered its color and details, and printed the new image onto t-shirts with the phrase "Sorry for Partying."



Relying in part on *Cariou*, the district court ruled in favor of Sonnie Nation based on the t-shirt's transformative nature. The Seventh Circuit affirmed, but on different grounds. It warned

that the Second Circuit's interpretation of fair use compromises, and possibly eliminates, a copyright holder's statutory right to prevent others from making derivative works. Instead, the Seventh Circuit opted to "stick with the statutory list, of which the most important usually is the fourth [factor] (market effect)" to find fair use. The court did find fair use but looked at all four factor in the statue to arrive at its conclusion. The take away is if one is going to appropriate someone's artwork New York and California are the places to be sued in.

In terms of the use of an individuals' likenesses, we deal with the Right of Publicity, which unlike copyright, is at least supposed to be uniform across the country. The Right of Publicity is governed under individual state statutes or common law. Generally speaking, the courts have favored artists in this area, although not universally. It is important to note that courts have often found distinctions between the use of a celebrity's likeness in fine art when used on an original, limited edition or print versus licensing the same artwork found on commercial products. Certain courts do not find a distinction, once they find the use to be a fair use under the Right of Publicity for the underlying art it doesn't matter on what product it is put on. Others courts have taken a more "First Amendment" expressive speech approach and have carved out exceptions to the Right of Publicity but only for fine arts not for licensed goods. Below is a review of four of the leading cases in the area.

In *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387 (Cal. 2001) the Supreme Court of California ruled against artist Gary Saderup for producing lithographs and T-shirts bearing the likeness of The Three Stooges.

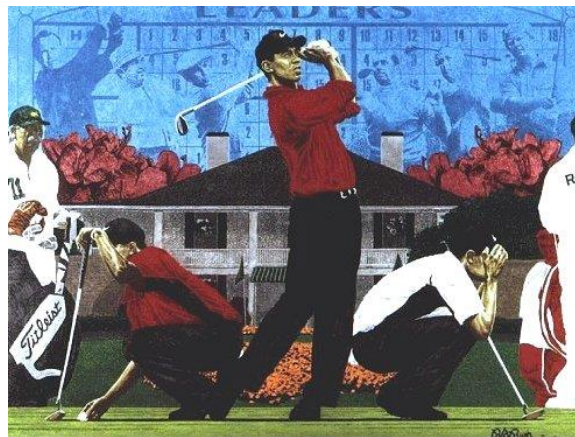


For 25 years, Saderup has been making realistic charcoal drawings of celebrities. These drawings were then used to create lithographs and silkscreen masters for reproduction. The court held that Saderup violated the Stooges' publicity rights because his drawings employed "no significant transformative or creative contribution," and only had the "overall goal of creating literal, conventional depictions of *The Three Stooges* so as to exploit their fame." "...that when an artist's skill and talent is manifestly subordinated to the overall goal of creating a conventional portrait of a celebrity so as to commercially exploit his or her fame, then the artist's right of free expression is outweighed by the right of publicity". So, when do the artist's right in free expression prevail? When the celebrity image is simply the raw material for

the art and it is purchased primarily for the art not the celebrity image. The court uses Warhol portraits as an example, “*On the other hand, we do not hold that all reproductions of celebrity portraits are unprotected by the First Amendment. The silkscreens of Andy Warhol, for example, have as their subjects the images of such celebrities as Marilyn Monroe, Elizabeth Taylor, and Elvis Presley. Through distortion and the careful manipulation of context, Warhol was able to convey a message that went beyond the commercial exploitation of celebrity images and became a form of ironic social comment on the dehumanization of celebrity itself... Such expression may well be entitled to First Amendment protection. Although the distinction between protected and unprotected expression will sometimes be subtle, it is no more so than other distinctions triers of fact are called on to make in First Amendment jurisprudence.*”



Unlike *Comedy III*, the Sixth Circuit, in *ETW Corp. v. Jireh Publ'g*, 332 F.3d 915 (6th Cir. 2003) ruled in favor of artist Rick Rush, who portrayed golfer Tiger Woods in a painting entitled “*The Masters of Augusta.*” The painting was a collage of images depicting historic sporting events and featured one image of Woods. Woods sued Rush for violating his Right of Publicity. The court held that Rush's work was protected by the First Amendment because it had “significant transformative elements”—it was a collage of images and was used to celebrate the significance of Wood's achievement.



In *Doe v. TCI Cablevision*, 110 S.W.3d 363 (Mo. 2003) hockey player Tony Twist sued a production company for its use of Twist's name as a comic book character. In assessing whether the production company's use of Twist's name was entitled to First Amendment protection, the court created the Predominant Purpose test. Under this test, there is no First Amendment protection if the marketed products' predominate purpose is to exploit the commercial value of an individual's identity, even if there is some “expressive” content. The court ruled for Twist and concluded that the use of his name was “predominantly a ploy to sell comic books and related products rather than an artistic or literary expression,” and that it was

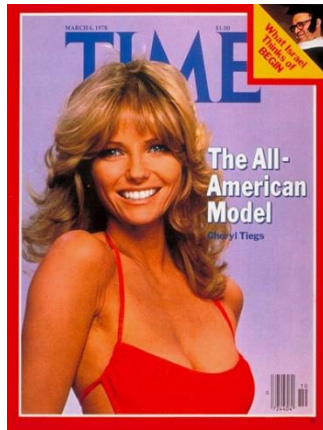
not entitled to First Amendment protection. In so finding, the court upheld the jury's \$15 million award.



New York artists can breathe easy due to the Cheryl Tiegs case, 110 S.W.3d 363 (Mo. 2003). Ms. Tiegs, the famous model is also an animal activist who volunteered to have herself cast to test out a casting method that was going to be used on animals in the creation of a sculpture for the United Nations to make sure it would not harm the animals. Happily for all concerned, the casting process went well and it was approved for animals.



The sculptor, who cast Ms. Tiegs, Mihail Simeonov, and who also owned the molds, thought that he had something of value, the ability to make and sell limited edition sculptures of Ms. Tiegs. So, he sent the mold to Ms. Tiegs' apartment for her to consider the idea. But, a workman at Ms. Tiegs' apartment shattered the mold. The artist then sued for the money he claimed he would have made from selling the sculptures made from the mold. Ms. Tiegs' defense was that she did not agree, nor would she ever have agreed, to allow him to create limited edition sculpture of her, therefore, he was not damaged



The court found that he would not have needed Ms. Tiegs' permission to create and sell, in New York, a limited edition for fine arts purposes, "*[the New York Rights of Publicity laws] do not apply to plaintiff's actual and intended acts. An artist may make a work of art that includes a recognizable likeness of a person without her or his written consent and sell at least a limited number of copies thereof without violating [the New York Rights of Publicity laws].*

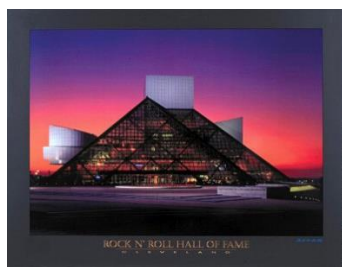
Using one's trademarks in artwork is a little trickier because you have two different concerns. The first, that you cannot use a trademark to identify the source of origin of the goods, the traditional trademark usage nor can you improperly create the impression of an association between the art(ist) and the trademark owner. However, simply having a trademark in an artwork generally has not been found to be infringing.

In *University of Alabama Board of Trustee v. New Life Art, Inc.*, 683 F.3d 1266 (11th Cir. 2012), the Eleventh Circuit considered whether the University of Alabama could prevent an artist from selling prints, paintings, and calendars with the University's football players wearing the school's iconic white and crimson uniforms. The court weighed the University's rights in its uniform's marks against the artist, Daniel Moore's, right to free expression, and found for Moore. It held that the uniforms' depictions were needed for the expressive underlying work to portray realistic famous scenes from Alabama football history and in assessing whether Moore's work would cause consumer confusion, the court found none because he never marketed his work as being "endorsed," "sponsored," or otherwise affiliated with the University. Moore's work was held to be a clear embodiment of artistic expression entitled to the First Amendment's protection.



In *Teter v. Glass Onion*, 723 F. Supp. 2d 1138 (W.D. Mo. 2010), artist Gary Teter painted pictures depicting the American frontier and sold his work to gallery owner Glass Onion. Glass Onion subsequently displayed images of Teter's work on its website. Teter uses the mark "LEE TETER" to identify his art, often in the form of his signature. Teter sued for trademark infringement because use of his mark [his name] created the impression that the gallery was an authorized dealer of his art. The court, on summary judgment, held that there was evidence to find Glass Onion's use of the mark could create a likelihood of confusion, especially when it was used in conjunction with a watermark of the gallery's street address.

Additionally, there is the use of buildings in artworks and the building has acquired trademark status. In those cases, the building owners have not fared well. The leading case deals with the Rock and Roll Hall of Fame (*Rock & Roll Hall of Fame & Museum v. Gentile Prods.*, 134 F.3d 749 (6th Cir. Ohio 1998)) where the museum which tried to stop a photographer, Charles Gentile, who took a picture of their building, which is used as a trademark, for making posters.



Gentile Poster



Museum Print



Museum Trademark

The court found that while a specific rendition of a building could be a trademark that does not make all images of the museum infringing, *"To be more specific, we cannot conclude on this record that it is likely that the Museum has established a valid trademark in every photograph which, like Gentile's, prominently displays the front of the Museum's building..."*

Another area we see a lot of activity in is trying to prevent the use of animals in artwork. Animals do not enjoy Right of Publicity. Including a depiction of an animal, whether well-known or not, in an artwork will not be infringing. However, you have to be careful. Although putting a racehorse into a picture, which the horse may not have a Right of Publicity, the stable may have a trademark in the horse's name, or in their colors. Further, the jockey has a Right of Publicity in his image. So, if a jockey is riding a racehorse in an artwork a claim could be made by the jockey for a Right of Publicity violation. Also, the stable could make a claim for the use of their trademarked colors or, in some cases, in the manner the horse's name is used (that applies to other animals as well, not just horses).



The other area in trademark law that is always problematic is the Lanham Act Section 43(a), which states that you cannot have a likelihood of confusion as to an association, affiliation or sponsorship—where none exists. Therefore, if an artwork contains a trademark in such a dominant manner that the viewing public might think the trademark must have been licensed by the trademark owner, it could be a violation of the Lanham Act. A street scene of Times Square, which contains scores of trademarks, not a problem, as no one will think the artist was affiliated with the scores of trademark owners captured in the art work.



But a close up of a store may have a different outcome. It is a completely subjective test.



Art appropriation cases are by their nature decided on a case by case basis. One must look at the artwork and determine how the incorporated third party artwork, or the celebrity image or trademark, are used in order to determine whether an infringement or fair use is present. In this area of art and law tread carefully and get expert advice. It's better to be safe than sorry.