

# ADVISORY

## SULLIVAN & WORCESTER LLP IP LITIGATION ADVISORY

### Key Copyright Case Highlights Pitfalls of Appropriative Art

In a highly anticipated copyright decision, the U.S. District Court for the Southern District of New York has found artist Richard Prince and the Gagosian Gallery and its principal liable for copyright infringement arising out of Prince's use of photographs by Patrick Cariou, and ordered the infringing works destroyed. This decision may be used to curtail the rights of artists, museums and galleries with respect to artistic works that incorporate other copyright works, particularly those that feature objects incorporating other, copyrighted works.

#### **BACKGROUND**

Cariou is a professional photographer, who published in 2000 a book entitled *Yes, Rasta* about the six years he spent with the Rastafarian community in Jamaica. Included in the book were Cariou's photographs of individual portraits and landscape pictures of Jamaica. Prince is a well known "appropriation" artist; that is, he typically incorporates a variety of sources into his art, including the photographs or images of others.

In 2007, Prince exhibited a collage entitled *Canal Zone*, which consisted of 35 photographs torn from a copy of *Yes, Rasta* and pasted to a wooden board. Prince exhibited and sold other works through Gagosian, which showed a total of 22 of Prince's 29 *Canal Zone* series in late 2008, all of which used portions of *Yes, Rasta* images. Prince painted over some Cariou photographs, used parts of some, and all of others.

Cariou sued for copyright infringement, as the holder of the copyright in his *Yes, Rasta* photographs. He moved for summary judgment, arguing that the facts of infringement were undisputed. Gagosian and the other defendants moved for summary judgment themselves, arguing that either Cariou's work was a "mere compilation," or alternatively that Prince's work was sufficiently transformative that it fell within the Copyright Act's permitted "fair use" allowing use of otherwise copyrighted works. Fair use permits incorporation of a protected work after considering (1) the purpose and character of the use (e.g. commercial vs. educational); (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used; and (4) the effect upon the potential market for the protected work.

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## **THE DECISION**

The court found for Cariou in a stinging rebuke to Prince and the gallery. First, the court chastised the defendants for arguing that Cariou's photographs were incapable of copyright and were mere compilations of facts (which, like phonebooks, cannot be copyrighted). As the court wrote, "[u]nfortunately for Defendants, it has been a matter of settled law for well over one hundred years that creative photographs are worthy of copyright protections even when they depict real people and natural environments."

Next, the court rejected the defendants' fair use arguments. The court was dismissive of the defense, noting Prince's admitted non-interest in the original meaning of the *Yes, Rasta* photographs. Prince's intended comment, the court found, was on the work of other artists, like Picasso, Warhol, Cézanne and de Kooning, that is, a comment on the medium (collage) rather than the appropriated work. Thus, it provided no transformation of Cariou's photographs, nor did it provoke any discussion of the themes of Cariou's works in a way that could be considered fair use. The court contrasted examples where advertisements were used to comment on the role of advertising in society. Given the failure of the fair use argument, the court was particularly concerned with their adverse effect on the market for Cariou's photographs (commerciality) in finding infringement.

The court thus found all defendants liable either directly or vicariously. More severely still, the court ruled that because of the defendants' awareness of Cariou's status, their infringement was willful and in bad faith, and has set a hearing to establish multiple damages and attorneys' fees. The court took the even more extraordinary step of ordering the infringing works delivered for destruction, a fate far more common in trademark cases than copyright.

## **THE FALLOUT**

On the one hand, this case must be considered on its own facts, and the court was clearly unimpressed with the transformative argument as it related to Prince himself. Moreover, there is little question that what constitutes fair use is still in the

eye of the beholder after this decision, and is ground typically best avoided rather than defended, as it was in the dispute over artist Shepard Fairey's use of associated press photo of Barack Obama.

What is clear after *Cariou*, however, is that artists, museums and galleries involved in any appropriative art are in a more precarious position than ever before. The subjective inquiry into an artist's reason for appropriation may be a sensitive conversation, and one without a clear answer. Of particular note is the court's finding of bad faith; if an artist or museum is involved with a work whose intended commentary is rejected as insufficiently transformative, will they face punitive damages because their intent to comment reveals their awareness of the original work? More broadly, the potential for a chilling effect on such works is clear; the threat of damages of this sort may simply steer artists away from creating, and museums and galleries away from showing, anything close to the edge. Would a gallery with the chance to exhibit the newly-created still lives and collages of Picasso showing *Le Journal*, or a museum with the chance to show the contemporary work of Duchamp and its appropriation of the Western canon, have taken the chance if privy to this decision? Time will tell if this question can be answered for new works.

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