

Art Behind the Scenes: The Rights of Artists for Works of Visual Art Used in Television and Motion Picture Set Decoration

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I. Introduction

Can you picture the posters that hang in Chandler and Monica's apartment on *Friends*? Or better yet, do you remember the sculpture that comes to life in Al Pacino's penthouse in *Devil's Advocate*? Different works of art used as part of the set design often are chosen to accent part of the character's personality, but the choice of set decorations is more complicated than many people imagine. Each of the posters, prints or drawings is most likely copyrighted. The Copyright Act of 1976 [hereinafter "Act"] grants the copyright holder the exclusive right to reproduce, prepare derivative works from, distribute, and publicly display or perform their copyrighted work.¹ When the set designer makes the decision to incorporate a specific piece of work, he needs to ask permission. This copyright protection also covers the use of a recreated work that is similar to a copyrighted work, as Warner Brothers realized after it used the sculpture in *Devil's Advocate*.² The artist is entitled to license her work of art, as she desires. If the copyrighted work of visual art is displayed without the authorization of the artist, then the use qualifies as an infringement of her copyright.³

II. The Copyright Act of 1976

"Congress shall have the power to promote the Progress of Science and the useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective

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¹ 17 U.S.C.A. § 106(5) (1999).

² 17 U.S.C.A. §106(2).

³ 17 U.S.C.A. §§501(a), 106(5).

Writings and Discoveries.”⁴ The United States Constitution grants Congress the ability to legislate in the law of copyright. Copyright holders hold the monopoly over the use of their work. Section 101 of the Act defines a “work of visual art” as “a painting, drawing, print, or sculpture, existing in a single copy”⁵

Section 106 of the Act grants copyright owners the exclusive right to do several things, including the right to reproduce the copyrighted work and to prepare derivative copies.⁶ The owner of the copyright may authorize another to do the protected activities.⁷ Reproduction of a copyrighted work is defined more broadly than an actual duplicate copy. A copy is a “. . . material object[] . . . in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated”⁸ The Act says, “anyone who violates any of the exclusive rights of the copyright owner . . . is an infringer of the copyright or right of the author.”⁹ When works of visual art are incorporated into the set

⁴ U.S. CONST. art. I, § 8, cl. 8.

⁵ 17 U.S.C. § 101.

⁶ *See id* § 106. Exclusive rights in copyrighted works

Subject to sections 107 through 121, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

- (1) to reproduce the copyrighted work in copies or phonorecords;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
- (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;
- (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and
- (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

⁷ *See Id.*

⁸ 17 U.S.C.A. § 101.

⁹ 17 U.S.C.A. § 501 (a).

design of a motion picture or television, the set decorator must seek permission, because the use without authorization most likely infringes upon the artist's exclusive rights.

The courts created a two-part test to determine infringement. The copyright owner must prove that the defendant had access to the copyrighted work.¹⁰ Proving access is not easily done through direct evidence as the defendant is rarely seen with the copyrighted work.¹¹ When access cannot be proven, courts may infer access when a striking similarity exists between the copyrighted work and the infringing work.¹² “[T]he similarities must be so striking as to preclude the possibility that the defendant independently arrived at the same result.”¹³ However, striking similarity alone does not prove access, the plaintiff must “. . . meet some minimum threshold of proof which demonstrates that the inference of access is reasonable.”¹⁴ Once access is proven, the plaintiff still must show an improper appropriation by the defendant before infringement is found.¹⁵

Substantial similarity is the determining factor in finding improper appropriation.¹⁶ Courts have found difficulty in delineating where the line is drawn between substantial similarity and noninfringing similarity.¹⁷ One should examine the copyrighted work alongside the

¹⁰ 3 MELVILLE B. NIMMER, NIMMER ON COPYRIGHT §13.02(B) (2000) [hereinafter NIMMER ON COPYRIGHT].

¹¹ *Id.*

¹² *Id.* §13.02(A).

¹³ *Id.* §13.02(B).

¹⁴ 3 NIMMER ON COPYRIGHT, *supra* note 10 (quoting *Selle v. Gibb*, 741 F.2d 896 (7th Cir. 1984)).

¹⁵ 3 NIMMER ON COPYRIGHT, *supra* note 10, §13.03 (A).

¹⁶ *Id.*

¹⁷ *Id.*

defendant's work, and make a determination on that basis.¹⁸ Several tests can be used to determine if the infringing work meets the level of substantial similarity. One comes from Judge Learned Hand. In his abstractions test, Judge Hand said that at some point along the line of abstraction, a work crosses over from the copyrighted expression to the idea.¹⁹ Ideas are not protected under the copyright laws. The California Supreme Court in *Desny v. Wilder* used the following statement in describing the lack of protection given to ideas.²⁰ "The doctrine that an author has a property right in his ideas and is entitled to demand for them the same protection which the law accords to the proprietor of personal property generally finds no recognition either in the common law or in the statutes of any civilized country."²¹ "Therefore, if the only similarity between plaintiff's and defendant's works is that of the abstract idea, there is an absence of substantial similarity and hence, no infringement results."²² When a person begins using another's expression, it reaches the level of improper appropriation.²³ When an alleged infringer is sued, a few affirmative defenses are raised claiming that the use is not actionable copying.

¹⁸ *Id.*

¹⁹ *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930).

²⁰ *Desny v. Wilder* 299 P.2d 257 (Cal. 1956).

²¹ *Id.* See generally 34 Am.Jur. 402-03, s 5; 18 C.J.S., Copyright and Literary Property, s 10 e, p. 143; cf. *Golding v. R. K. O. Pictures, Inc.* 35 Cal.2d 690, 693-97, 702, 711- 12, 221 P.2d 95 (1950); *Burtis v. Universal Pictures Co., Inc.* 40 Cal.2d 823, 831, 256 P.2d 933 (1953); *Kurlan v. Columbia Broadcasting System* 40 Cal.2d 799, 256 P.2d 962 (1953).

²² 3 *Nimmer on Copyright*, *supra* note 10, § 13.03 (A)(1).

²³ See *Nichols*, 45 F.2d at 121.

De Minimis Defense

Defendants often allege a de minimis defense in these type of cases. “*De minimis non curat lex*” directly translated means the law does not care for trifles.²⁴ The defense as applied here claims that the use is so insignificant that it does not infringe. In *Ringgold v. Black Entertainment Television*, the Second Circuit said de minimis, as it relates to copyright, can be applied in three ways.²⁵ The first is when a right is so inconsequential that even if it is technically violated, the law will not impose legal consequences.²⁶ Judge Pierre N. Leval, in a lecture, used the example of a person placing a copy of a cartoon on a refrigerator.²⁷

De minimis, in the second circumstance, refers to an incident of copying that is so insignificant that it fails to reach the quantitative level of substantial similarity needed for infringement.²⁸ The defendants in one of the cases to be discussed argued that their use was not substantial in comparison to the whole of their work.²⁹ That argument misinterpreted the concept of substantial similarity.³⁰ The quantity copied is measured, taken in comparison to the whole of the copyrighted work, not the infringing one.³¹ Defendants argued for a finding of fair use of the copyrighted work as well.

²⁴ BLACK’S LAW DICTIONARY 431 (6th ed. 1991).

²⁵ *Ringgold v. Black Entertainment Television*, 126 F.3d 70, 74 (2d Cir. 1997).

²⁶ *Id.*

²⁷ Pierre N. Leval, *Nimmer Lecture: Fair Use Rescued*, 44 UCLA. L.REV. 1449, 1457 (1997).

²⁸ *Ringgold*, 126 F.3d at 74.

²⁹ *Woods v. Universal City Studios, Inc.*, 920 F.Supp. 62, 65 (S.D.N.Y. 1996).

³⁰ *Id.*

³¹ *Id.*

IV. Fair Use Doctrine

Fair use is the affirmative defense most likely to be asserted by defendants faced with copyright infringement under these circumstances. Fair use finds its roots in common law. The first mention of fair use of copyrighted works is thought to be *Folsom v. Marsh* from 1841.³²

The copyrighted works in this case were the papers of George Washington.³³ The plaintiff wrote a twelve volume biography incorporating Washington's private papers.³⁴ The defendants later published a two-volume biography, which included 388 pages copied word-for-word from the plaintiff's biography.³⁵ The opinion written by Justice Story mentioned that whether a copyrighted work is infringed depends "...upon a nice balance of the comparative use made in one of the materials of the other...."³⁶ Justice Story described many factors that should weigh into the determination of infringement; nearly the same factors would later be used in drafting §107 of the Act. Of these factors, Justice Story believed the most important was whether the allegedly infringing work would "...supersede the use of the original...."³⁷ Superseding the use of the original refers to the replacement of demand for the original by the infringing work.³⁸ In *Folsom*, the infringing work clearly replaced demand for the original, making the use of the plaintiff's copyrighted letters not fair.³⁹

³² *Folsom v. Marsh*, 9 F.Cas. 342 (C.C.D. Mass. 1841).

³³ *Folsom*, 9 F. Cas. at 343.

³⁴ *Id.*

³⁵ *Id.*

³⁶ *Id.* at 344.

³⁷ *Folsom*, 9 F. Cas. at 345.

³⁸ *Id.* at 344-45.

³⁹ *Id.* at 349.

The 1976 Copyright Act attempted to codify the fair use doctrine as applied since *Folsom*. Section 107 now allows use of copyrighted works without license if the use is fair.⁴⁰ “[T]he fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching, . . . scholarship, or research, is not an infringement of copyright.”⁴¹ These examples of fair use are not an exclusive list, but help to illuminate what constitutes fair use when considered with other factors determining fair use.⁴² The four factors under Section 107 are:

- (1) the purpose and character of the use, including whether the such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.⁴³

Congress did not intend to create “exact rules” for fair use; it merely wanted to codify the long-standing common law doctrine.⁴⁴

V. The Artist’s Rights

The Courts have not taken a definitive stand on where the use crosses over to infringing the artist’s rights. “Like the analysis of a fair use claim, an inquiry into the substantial similarity between the copyrighted work and the allegedly infringing work must be made on a case-by-case basis, as there are no bright-line rules for what constitutes substantial similarity.”⁴⁵ The Second

⁴⁰ 17 U.S.C. § 107 (1994).

⁴¹ *Id.*

⁴² *See Ringgold*, 126 F.3d at 78.

⁴³ 17 U.S.C. § 107.

⁴⁴ H.R. No. 94-1976, at 66 (1976).

⁴⁵ *Sandoval v. New Line Cinema Corp.*, 147 F.3d 215, 217 (2d Cir. 1998).

Circuit comes closest in two cases they decided in the last few years that help to define the artist's rights.

VI. The Ringgold Decision

A. Facts

Faith Ringgold is a contemporary artist, and included in her works of art is a piece called the "Church Picnic Story Quilt."⁴⁶ Although the High Museum of Art in



Figure 1-Church Picnic⁴⁷

Atlanta, Georgia owns the quilt and holds a non-exclusive license to reproduce the work of art as a poster; Ringgold still retains the copyright interests.⁴⁸

⁴⁶ *Id.*

⁴⁷ Faith Ringgold, *Church Picnic*, The High Museum of Art (visited February 12, 2000) at <http://www.artincontext.org/LISTINGS/IMAGES/FULL/3/K8CFJQE3.htm>.

⁴⁸ *Id.*

Sometime before 1992, the television show “ROC” made an episode in which a poster of Ringgold’s Church Picnic work appeared.⁴⁹ Ringgold happened to see a repeat showing on Black Entertainment Television (BET) in January 1995, and noticed the defendants’ use of her work of art.⁵⁰

During the episode, Ringgold’s work appeared in nine sequences of a five-minute scene.⁵¹ The time in which part of the poster is shown vary in length from 1.86 seconds to 4.16 seconds; totaling 26.75 seconds.⁵²

B. The Second Circuit Decision

The Second Circuit picked up after the District Court for the Southern District of New York granted the defendants’ motion for summary judgment and dismissed the complaint.⁵³ Ringgold asserted that the defendants violated her right to license her work of art by incorporating it as set decoration without her permission.⁵⁴ The defendants claimed no infringement occurred because their use was either de minimis or fair use.⁵⁵

The court first considered whether the use falls under de minimis.⁵⁶ The defendants contended that the quantity of observable copying falls below the level of actionable copying.⁵⁷ During the longest of the nine sequences, between four and five seconds, nearly eighty percent of

⁴⁹ *Id.*

⁵⁰ *Ringgold*, 126 F.3d at 73.

⁵¹ *Id.*

⁵² *Ringgold*, 126 F.3d at 73.

⁵³ *Id.*

⁵⁴ *Id.*

⁵⁵ *Id.*

⁵⁶ *Id.*

the poster is visible.⁵⁸ The focus of the camera is aimed at the actors, making the poster slightly out of focus.⁵⁹ The court believed that the repetition of the nine shots using Ringgold's work augments the visual effect made in the four-second shot.⁶⁰

The nearly twenty-seven seconds the plaintiff's poster was visible from a quantitative view was not de minimis.⁶¹ The court recognized that "[A] visual work, though selected by the production staff for thematic relevance, or at least for its decorative value, might ultimately be filmed at such a distance and so out of focus that a typical program viewer would not discern any decorative effect that the work of art contributes to the set. But that is not this case."⁶² The court began to establish where the line dividing de minimis use and infringement stands, which will later be clarified further in *Sandoval v. New Line Cinema Corp.*⁶³

The court next discussed the fair use defense made by the defendants. It is here that the circuit court overruled the district court's analysis of two fair use factors, the first and fourth. One area the district court failed even to acknowledge was the preamble of § 107, which contains a non-exclusive list of fair uses.⁶⁴ Even though the uses listed are not exclusive, they also should

⁵⁷ *Ringgold*, 126 F.3d at 76.

⁵⁸ *Id.*

⁵⁹ *Id.*

⁶⁰ *Id.* at 76-77.

⁶¹ *Id.* at 77.

⁶² *Ringgold*, 126 F.3d at 77.

⁶³ *Sandoval*, 147 F.3d at 215.

⁶⁴ *Ringgold*. at 78.

not be ignored.⁶⁵ The Second Circuit found that none of the listed fair uses resembled that of the defendants.⁶⁶

As for the first factor in determining fair use, the court relied partly on *Campbell v. Acuff-Rose*, in stating that the use should be transformative to favor the defendant.⁶⁷ For the second work to be transformative, it should add value to the original by using the copyrighted material as “raw material” for the creation of a new and different work.⁶⁸ The district court favored the defendants because their use was not to encourage viewers to watch or to “exploit” Ringgold’s work.⁶⁹ Here, in the opinion of the circuit court, the use of Ringgold’s work is part of the purpose for its creation—decoration.⁷⁰ The use is not transformative because the defendants employed Ringgold’s work in a way that is part of its original purpose and character.⁷¹ The court compared the need for a license payment to the money paid when a member of the public wants to own a poster to decorate their home.⁷² By using it as set decoration, the defendants have superseded the original and the first factor does not favor fair use.⁷³

In deciding the fourth factor, the District Court incorrectly reasoned that the ROC episode was not likely to adversely effect Ringgold’s sales nor had Ringgold said that her licensing

⁶⁵ *Id.*

⁶⁶ *Id.*

⁶⁷ *Ringgold*, 126 F.3d at 78-79, *quoting* *Campbell v. Acuff-Rose Music*, 510 U.S. 569 (1994).

⁶⁸ Pierre N. Leval, *Commentary, Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1111 (1990).

⁶⁹ *Ringgold*, 126 F.3d at 78.

⁷⁰ *Ringgold*, 126 F.3d at 79.

⁷¹ *Id.* at 79-80.

⁷² *Id.* at 80.

⁷³ *Id.*

abilities were harmed.⁷⁴ However, no requirement exists stating that Ringgold must prove a decline in licensing requests.⁷⁵ The Second Circuit said the flaw was that the court weighed the lack of an adverse effect too strongly against the appropriation without payment of the license.⁷⁶ The plaintiff need only show a “ ‘traditional, reasonable, or likely to be developed’ market for licensing her work as set decoration.”⁷⁷ The actions of the defendants “[‘W]ould ‘result in [a] substantially adverse impact on the potential market for [licensing of the original]’ if the conduct became unrestricted and widespread’.”⁷⁸ The court meant that artists, like Ringgold, would lose money that they are entitled to by licensing their works if actions like those of the defendants continued.⁷⁹ From this reasoning, the court ruled that summary judgment is not appropriate from the evidence the defendants could prove.⁸⁰

The impact of the decision in *Ringgold* greatly favored artists. The Second Circuit marked a line where the appropriation of a work of art without authorization is infringement. It narrowed future defendants’ ability to rely on fair use, especially without a transformative use.⁸¹ However, this line leaning toward the artists was pushed back slightly by the Second Circuit a year later.

VII. The Sandoval Decision

⁷⁴ *Ringgold*, 126 F.3d at 81.

⁷⁵ *Id.*

⁷⁶ *Id.*

⁷⁷ *Id.* (quoting *Campbell*, 510 U.S. 569, at 590).

⁷⁸ *Id.*

⁷⁹ *Id.*

⁸⁰ *Ringgold*, 126 F.3d at 71-72, 81.

⁸¹ *Id.* at 78.

A. Facts

The plaintiff, Jorge Antonio Sandoval, is an artist and photographer.⁸² Sandoval over a period of three years in the early 1990s created a series of fifty-two untitled and unusual black and white self-portraits.⁸³ Sandoval never published nor publicly displayed the photographs, and owns the copyrights on them.⁸⁴

The defendants, New Line Cinema Corp., produced and released the motion picture “Seven” in 1995.⁸⁵ Over an hour into the movie, two investigators searched an apartment, in which there is a large light box with photographic transparencies on it.⁸⁶ Ten of the transparencies are reproductions of Sandoval’s self-portraits.⁸⁷

During the course of a minute and a half, portions of Sandoval’s portraits appeared in eleven camera shots.⁸⁸ The longest sequence lasts six seconds, and the total time shown is about 35.6 seconds.⁸⁹ While on-screen, the photographs are never in focus, often in the distant background, and obstructed by either actors or props.⁹⁰ Sandoval brought suit claiming the defendants used his copyrighted photographs without permission.⁹¹

B. The Second Circuit Decision

⁸² *Sandoval*, 147 F.3d 215, at 216.

⁸³ *Id.*

⁸⁴ *Id.*

⁸⁵ *Id.*

⁸⁶ *Id.*

⁸⁷ *Sandoval*, 147 F.3d at 216.

⁸⁸ *Id.*

⁸⁹ *Id.*

⁹⁰ *Id.*

⁹¹ *Id.*

The District Court found fair use in favor of the defendants.⁹² The Second Circuit affirmed the outcome, but found that the use was de minimis.⁹³ The court relied substantially on the de minimis analysis applied in *Ringgold*.⁹⁴ The observability of the work is key in determining de minimis use.⁹⁵ The work of art in this case does not reach the quantitative level needed for substantial similarity.⁹⁶ Sandoval's photographs are not displayed clearly and with enough detail that the typical viewer would recognize them, as the viewer would in *Ringgold*.⁹⁷ The court discussed how this case is exactly what it predicted in *Ringgold* when it said that other instances using the work of art would equal de minimis.⁹⁸ Accordingly, New Line's use was found to be de minimis.⁹⁹

VIII. Comparison of *Ringgold* and *Sandoval*

The Second Circuit began defining how far potential defendants can go in using works of art without permission in these cases. Although *Ringgold* and *Sandoval* differ in outcome, both establish the same principles.

Ringgold laid the groundwork in its decision. It started to define what quantity of use was too much.¹⁰⁰ *Sandoval* later clarified that quantity.¹⁰¹ Both works of art were on-screen for

⁹² *Id.*

⁹³ *Sandoval*, 147 F.3d at 217.

⁹⁴ *Id.*

⁹⁵ *Id.*

⁹⁶ *Sandoval*, 147 F.3d at 218.

⁹⁷ *Id.*

⁹⁸ *Sandoval*, 147 F.3d at 218.

⁹⁹ *Id.*

¹⁰⁰ *Ringgold*, 126 F.3d at 76.

over twenty-five seconds.¹⁰² In fact, Sandoval's work was on-screen for 35.6 seconds.¹⁰³ The difference between the two is not the quantity of time in the use, but the observability of its reproduction on screen. On the surface, the two different outcomes do not seem appropriate since the time used was similar, but their observability is where the differences lie. The Second Circuit attempted to differentiate between featured use and background use.

In *Ringgold*, the Church Picnic poster hung on a wall at a church featured in a five-minute scene.¹⁰⁴ During the nine times it appeared in the episode, actors often framed it.¹⁰⁵ The longest segment of over four seconds in which the poster was eighty percent visible, placed it essentially in the middle of the scene with actors on either side.¹⁰⁶ The court believed that an observer, from that four-second shot, could discern a work of art "depicting a group of African-American adults and children with a pond in the background."¹⁰⁷ The work is clearly meant to be seen in the scene.

None of the shots in *Sandoval* can come close to this level of identification. The best segment displaying Sandoval's photographs is equal in time (less than the longest view of six seconds, but at a closer distance), but the figures are barely discernable.¹⁰⁸ An observer would not be able to describe in any detail, let alone with the specificity seen in *Ringgold*. The work in

¹⁰¹ *Sandoval*, 147 F.3d at 217.

¹⁰² *Ringgold*, 126 F.3d at 73.

¹⁰³ *Id.* at 216.

¹⁰⁴ *Ringgold*, 126 F.3d at 72-73.

¹⁰⁵ *Id.* at 76.

¹⁰⁶ *Id.*

¹⁰⁷ *Id.*

¹⁰⁸ *Sandoval*, 147 F.3d at 216.

Sandoval is part of the background; it is inconsequential. Yet, it still seems at odds with *Ringgold* since the use in nine sequences was not de minimis, but here in eleven, it is.

The decision in *Sandoval* enhanced and expanded *Ringgold*. The two decisions are at different ends of the dividing line between de minimis and not. *Ringgold* established that if the work of art is clearly observable to the typical viewer, it is featured, the use cannot be de minimis while *Sandoval* reinforced that the work of art must be observable for the line to be crossed.¹⁰⁹ The de minimis use by New Line gave the Second Circuit an example in which to find a use that does not cross the line.¹¹⁰ New Line incorporated *Sandoval*'s photographs as part of the background; their presence is fleeting.¹¹¹ On ROC, the use of *Ringgold*'s work reinforced its presence.¹¹² The Second Circuit used *Sandoval* to clarify that the artist may not always have a claim for infringement.¹¹³

IX. Recreated Works Infringement in Motion Pictures

A somewhat different, but related aspect within the use of copyrighted works of visual art in motion pictures and television does not concern an unlicensed display. It involves a separate work that owes its inspiration to a copyrighted work. When the new work is clearly derived from previous creations, then an infringement occurred.¹¹⁴ Three recent cases involve this variation on the topic.

¹⁰⁹ *Id.* at 218; *Ringgold*, 126 F.3d at 77.

¹¹⁰ *Sandoval*, 147 F.3d at 218.

¹¹¹ *Id.*

¹¹² *Id.*; *Ringgold*, 126 F.3d at 77.

¹¹³ *Sandoval*, 147 F.3d at 218.

¹¹⁴ 17 U.S.C. § 106(2).

X. The Woods Decision

A. Facts

In 1987, artist Lebbeus Woods completed a drawing with a graphite pencil entitled “Neomechanical Tower (Upper) Chamber”¹¹⁵ (“Chamber”). The drawing showed “a chamber with a high ceiling, a chair mounted on a wall and a sphere suspended in front of the chair.”¹¹⁶ The drawing was then published in Germany in a catalog called *Lebbeus Woods/Centricity*.¹¹⁷ Later, Woods colored the black and white drawing of Chamber, and published this version in a compilation of Woods’ work entitled *Lebbeus Woods/The New City*, which was published in the United States in 1992.¹¹⁸

Universal Studios released *Twelve Monkeys* in December of 1995.¹¹⁹ In the beginning of the movie, the main character, portrayed by Bruce Willis, is brought into a room and told to sit in a chair attached to a vertical rail on a wall.¹²⁰ While the character is seated, the chair rises up the wall so that the chair is suspended several feet above the floor.¹²¹ Willis’s character returns to the chair three times throughout the movie.¹²²

¹¹⁵ *Woods*, 920 F. Supp. 62, at 63.

¹¹⁶ *Id.*

¹¹⁷ *Id.*

¹¹⁸ *Id.*

¹¹⁹ TWELVE MONKEYS (Universal 1995).

¹²⁰ *Id.*

¹²¹ *Id.*

¹²² *Id.*

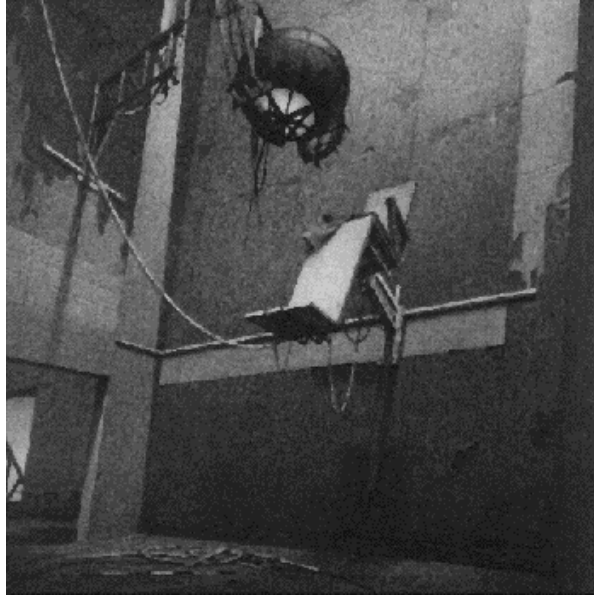


Figure 2-“Neomechanical Tower (Upper) Chamber”¹²³

Woods learned of the use when two colleagues told him that they believed *Twelve Monkeys* was using his work.¹²⁴ Woods saw the movie on January 18, 1996, and on January 24 he notified Universal of his claim seeking a preliminary injunction.¹²⁵

B. District Court Decision

The Court found that Universal clearly infringed Woods’ work because a contention that Chamber was not copied in the film was without merit.¹²⁶ In fact, the director of *Twelve Monkeys* acknowledged that he consulted the drawing along with the film’s production designer.¹²⁷

Comparing the film and the drawing, the court found that the movie copied Woods’ drawing “in striking detail.”¹²⁸ Both are composed primarily out of rectangular shapes.¹²⁹ Both

¹²³ *Twelve Monkeys*, (visited Feb. 16, 2000) <<http://www.benedict.com/visual/12monkeys/12monkeys.html>>.

¹²⁴ *Woods*, 920 F. Supp. at 64.

¹²⁵ *Woods*, 920 F. Supp. at 64.

¹²⁶ *Id.*

¹²⁷ *Id.*

¹²⁸ *Twelve Monkeys*, <http://www.benedict.com/visual/12monkeys/12monkeys.html>. (quoting *Woods*, 920 F. Supp. at 64, *supra*, note 119).

have a “horizontal shelf and apron near the top of the vertical rail to which the chair is attached.”¹³⁰ In both works, a sphere is hanging in front of the chair.¹³¹

The defendant argued that the use was *de minimis* because the footage involving the infringing scene comprised less than five minutes in a two-hour long movie.¹³² Universal’s argument was flawed, as the Court points out, because *de minimis* is not based on the quantity involved in the infringing work; rather, it is found in the amount taken from the copyrighted work.¹³³ The court granted the injunction to Woods because Universal failed to prove it would suffer irreparable harm as a result.¹³⁴ Two weeks after the Court decision, Universal settled with Woods for an undisclosed figure.¹³⁵

XI. The Hart Case

The introduction referenced *Devil’s Advocate* and the sculpture in Al Pacino’s penthouse. This reference was not incidental. Warner Brothers and Time Warner, the companies responsible for the film, recently were at the receiving end of a lawsuit alleging an infringement of artist Frederick Hart’s work.¹³⁶ *Ex Nihilo*, Hart’s work, is a bas-relief sculpture over the main

¹²⁹ *Woods*, 920 F. Supp. at 64.

¹³⁰ *Id.*

¹³¹ *Woods*, 920 F. Supp. at 65.

¹³² *Id.*

¹³³ *Id.*

¹³⁴ *Id.*

¹³⁵ *Universal Settles Suit Claiming 12 Monkeys Infringed Set Drawing*, THE ENTERTAINMENT LITIGATION REPORTER, June 30, 1996, available in LEXIS, News Library, ALLNWS File.

¹³⁶ Lawrence Siskind, *The Devil’s Advocate*, LEGAL TIMES, March 23, 1998, at 23, available in LEXIS, News Library, ALLNWS File.

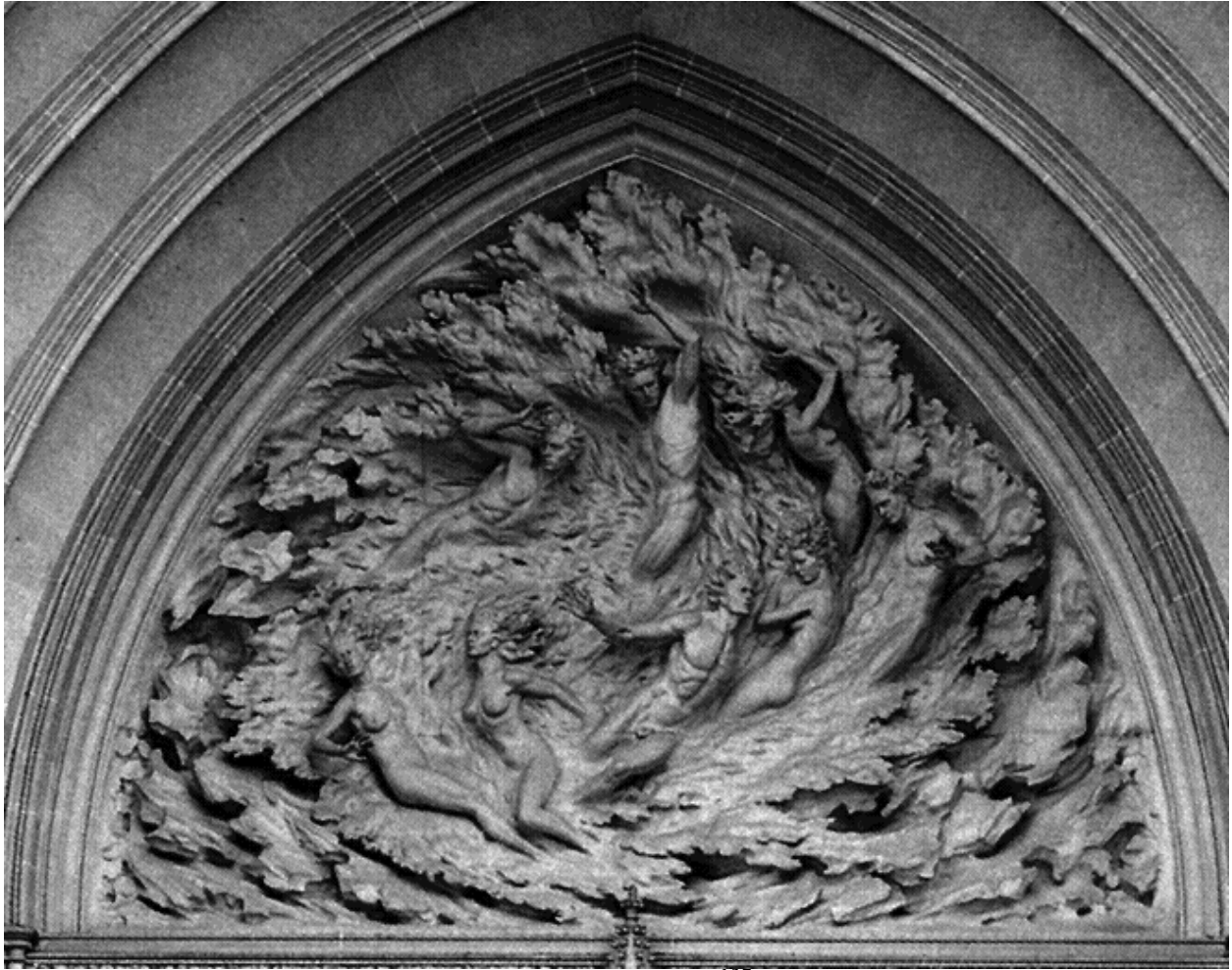


Figure 3-Ex Nihilo¹³⁷

entrance of the Washington National Cathedral.¹³⁸ The movie's work is very similar, and Hart, along with Washington National Cathedral, filed a case in the federal court for the Eastern District of Virginia.¹³⁹ The case settled early, and a facet of the settlement was a gag order preventing the public dissemination of court documents from the case.¹⁴⁰ However, enough information exists that a discussion of the case is possible.

¹³⁷ *Central Tympanum* (visited February 29, 2000) <<http://www.goodart.org/fhxence.jpg>>

¹³⁸ *Id.*

¹³⁹ *Id.*

¹⁴⁰ Siskind, *supra* note 137, at 23.

Hart won an international competition to design the entrance to the Cathedral.¹⁴¹ Over the course of thirteen years, Hart worked on *Ex Nihilo* while converting to Catholicism.¹⁴² The result portrays “the creation of mankind out of chaos.”¹⁴³ It shows four male and four female life-size figures emanating from a cloud with their eyes closed.¹⁴⁴ The expression is to represent the “majesty of the Divine Will.”¹⁴⁵

The film does not represent the same expression. *Devil’s Advocate* is about a young, small town lawyer who is lured to the big city by wealthy firm.¹⁴⁶ Al Pacino portrays the devil, hiding in the persona of the firm’s managing partner.¹⁴⁷ During the movie’s climax, a sculpture covering a wall of the Devil’s penthouse comes to life and the figures contained begin to move erotically.¹⁴⁸ The sculpture used in the film is also a bas-relief sculpture. Much like *Ex Nihilo*, the movie’s sculpture has an even number of male and female figures with eyes closed emerging from a cloud.¹⁴⁹ When the characters first enter the office, the camera slowly pans over the sculpture.¹⁵⁰

¹⁴¹ *The Devil’s Advocate* (visited Feb. 16, 2000) <<http://www.benedict.com/visual/devil/devil.html>>.

¹⁴² Siskind, *supra* note 137, at 23.

¹⁴³ *Id.*

¹⁴⁴ *Id.*

¹⁴⁵ *Id.*

¹⁴⁶ *Id.*

¹⁴⁷ *Id.*

¹⁴⁸ *Id.*

¹⁴⁹ *Id.*

¹⁵⁰ *The Devil’s Advocate* (visited Feb. 16, 2000) <<http://www.benedict.com/visual/devil/devil.html>>.

Hart called the film sacrilegious, and claimed that the film “desecrates” his work.¹⁵¹ His lawsuit alleges violations of both his trademark and copyright rights.¹⁵² The copyright claims are the only subject of this analysis.

The defendants could not claim viably that they did not have access to Hart’s work. The sculpture adorns one of the most visited cathedrals in the country, with over one million visitors each year.¹⁵³ Prior to the case, Warner Brothers’ general counsel admitted to an attorney for the National Cathedral that the movie designer consulted a picture of Hart’s *Ex Nihilo*.¹⁵⁴ If Warner Brothers had taken the case to trial, a denial of copying would have been pointless because both the access and substantial similarity prongs are clearly met.

Siskind hypothesized in his article that perhaps Warner Brothers could have won under a fair use defense by claiming the sculpture was a parody.¹⁵⁵ As demonstrated in *Campbell v. Acuff-Rose*, parodies are allowed as part of fair use.¹⁵⁶ In creating *Devil’s Advocate*, the movie studio aimed to show the evil of the devil, and to illustrate his evilness, the devil would desecrate something considered sacred.¹⁵⁷ “The movie profaned *Ex Nihilo* the way a satirist might parody a respected literary work. Just as parody must conjure up some serious underlying work in order

¹⁵¹ Siskind, *supra* note 137, at 23.

¹⁵² *Id.*

¹⁵³ *Id.*

¹⁵⁴ *Id.*

¹⁵⁵ *Id.*

¹⁵⁶ *Campbell* 510 U.S. 569, at 593.

¹⁵⁷ Siskind, *supra* note 137, at 23.

to succeed in its humorous purpose, profanation must conjure up a sacred underlying work in order to succeed in its blasphemous end.”¹⁵⁸

Warner Brothers did not wish to take this stand in court. Instead the presiding judge, U.S. District Judge T.S. Ellis III, enjoined the video release of *Devil's Advocate* for forty-eight hours so the parties could reach a settlement.¹⁵⁹ In doing so, Judge Ellis stated that he believed a “very substantial likelihood” exists that a jury would find infringement.¹⁶⁰ “There is evidence that collectors of [Hart’s] art now connect his art to the *Devil's Advocate* and the connection negatively affects the sale of his artwork,” said Judge Ellis.¹⁶¹ Insider estimates predicted that

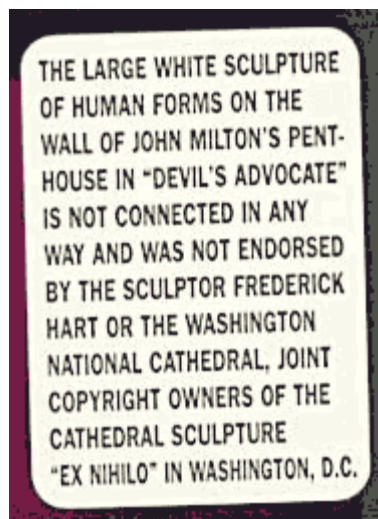


Figure 4-Sticker placed on videos of *Devil's Advocate*¹⁶²

Warner Brothers might have lost as much \$23.4 million and video retailers \$17.6 million.¹⁶³

Hart and the Cathedral originally sought the destruction of all copies of the movie.¹⁶⁴

¹⁵⁸ *Id.*

¹⁵⁹ Brooke A. Masters, *Va. Judge Tells Filmmakers to Settle Suit or Halt Video; Sculptor and National Cathedral Say Artist's Work Appears in Movie 'Devil's Advocate'*, WASH. POST, February 11, 1998, at BO2.

¹⁶⁰ *Id.*

¹⁶¹ *Id.*

¹⁶² *The Devil's Advocate* (visited Feb. 16, 2000) <<http://www.benedict.com/visual/devil/devil.html>>.

On February 14, 1998, Warner Brothers agreed to place stickers disclaiming any connection or endorsement by Hart or the Washington National Cathedral on the nearly half-million tapes already prepared for distribution.¹⁶⁵ They also agreed to re-edit the film for any future distributions and any television broadcasts, requiring producers to work on over twenty minutes of the film.¹⁶⁶ Warner Brothers digitally altered the cable and succeeding video releases by “removing the images of the people from the sculpture in the early scenes and significantly changing the presentation in the climax.”¹⁶⁷

XII. The Leicester Case

A. Facts

Andrew Leicester is an artist who was hired to develop and build the required artistic portion of an office building in Los Angeles, California.¹⁶⁸ R & T, a developer, purchased property from the Los Angeles Community Redevelopment Agency (CRA). CRA policies require a “percent for art” expenditure, meaning that R & T had to construct some form of public art in connection with the building.¹⁶⁹ R & T hired Leicester to fulfill that prerequisite.¹⁷⁰

¹⁶³ MASTERS, *supra* note 159, at BO2.

¹⁶⁴ *Id.*

¹⁶⁵ *The Devil’s Advocate* (visited Feb. 16, 2000) <<http://www.benedict.com/visual/devil/devil.html>>.

¹⁶⁶ *Id.*

¹⁶⁷ *Id.*

¹⁶⁸ Leicester v. Warner Brothers, 47 U.S.P.Q.2d (BNA) 1501, 1503 (1998).

¹⁶⁹ *Id.*

¹⁷⁰ *Id.*



Figure 5-Towers of *Zanja Madre*¹⁷¹

Leicester's work was confined to the courtyard space of the property, and his plan had to be approved by both R & T and CRA.¹⁷² The approved work became known as *Zanja Madre*.¹⁷³ Leicester's development included several other works intended to tell an allegorical story.¹⁷⁴ *Zanja Madre*, translated means "*mother ditch*," consisted of a fountain and towers.¹⁷⁵ The water flowed through a channel symbolizing the main water ditch that brought water to early Los Angeles.¹⁷⁶ Five towers were included, two had lanterns at the top and the other two had a

¹⁷¹*Batman Forever* (visited February 15, 2000) <<http://www.benedict.com/visual/batman/batman.html>>.

¹⁷² *Id.*

¹⁷³ *Id.*

¹⁷⁴ *Leicester*, 47 U.S.P.Q.2d (BNA) at 1503.

¹⁷⁵ *Id.*

¹⁷⁶ *Id.*

metalwork design on top that showed “smoke flattening out under an inversion layer in Los Angeles.”¹⁷⁷ The last tower was shorter with a vampire figure on its top.¹⁷⁸

Warner Brothers, in the course of production for the film *Batman Forever*, approached R & T to ask permission to use its property in movie scenes.¹⁷⁹ Without contacting Leicester, R & T signed a contract allowing Warner Brothers to photograph and make replicas of the property in *Batman Forever*.¹⁸⁰ R & T’s building is used in the film as the “Second National Bank of Gotham City.”¹⁸¹ The lantern towers and the smoke towers, to which the hand in Figure 5 points, appeared in the movie as well.¹⁸² Warner Brothers also made a model of the building and the *Zanja Madre*, which may have been used in the film.¹⁸³ Finally, Warner Brothers developed promotional items for the film, including posters, tee shirts and a comic book, some of which show the two lantern towers and two smoke towers with the building.¹⁸⁴

Leicester filed suit against Warner Brothers in 1995.¹⁸⁵ He claims that he is copyright owner of *Zanja Madre*, as a whole.¹⁸⁶ The contract Leicester signed in 1990 with R & T granted the artist all rights under the Copyright Act of 1976.¹⁸⁷ However, another clause said that “the

¹⁷⁷ *Id.*

¹⁷⁸ *Id.*

¹⁷⁹ *Id.* at 1503-04.

¹⁸⁰ *Id.* at 1504.

¹⁸¹ *Id.*

¹⁸² *Id.*

¹⁸³ *Batman Forever* (visited February 15, 2000) <<http://www.benedict.com/visual/batman/batman.html>>.

¹⁸⁴ *Leicester*, 47 U.S.P.Q.2d at 1504.

¹⁸⁵ *Id.*

¹⁸⁶ *Id.*

¹⁸⁷ *Id.*

Artist grants to the Owner . . . and to the Owner's assigns a perpetual irrevocable license to make reproductions of the work including but not limited to reproductions used in advertising, brochures, media publicity, and catalogs of similar publications.”¹⁸⁸ It also stated that the artist would not duplicate the work for any other project or another client.¹⁸⁹

B. District Court Decision

The Central District Court of California determined that the contract between R & T and Leicester is exclusive in granting R & T license to make three-dimensional reproductions.¹⁹⁰ The Court further decided that R & T was within its exclusive license to sublicense the three-dimensional reproductions grant to Warner Brothers.¹⁹¹

The majority of reproductions involved here are two-dimensional.¹⁹² The Leicester-R & T contract expressly gives R & T the right to make two-dimensional reproductions, but Leicester also retains this right as well.¹⁹³ R & T does not have the ability under Copyright law to sublicense to a third party in a non-exclusive license.¹⁹⁴ The Court denied the defendant's claim that R & T was able to sublicense the right to make photographic copies of *Zanja Madre*.¹⁹⁵

¹⁸⁸ *Leicester*, 47 U.S.P.Q.2d at 1504

¹⁸⁹ *Id.*

¹⁹⁰ *Id.* at 1504.

¹⁹¹ *Id.* at 1504-05.

¹⁹² *Id.* at 1505.

¹⁹³ *Id.*

¹⁹⁴ *Leicester*, 47 U.S.P.Q.2d at 1504.

¹⁹⁵ *Id.*

Another question the Court faced was who is the author of the work.¹⁹⁶ During production, Leicester worked with the architect and his company.¹⁹⁷ The Court decided that Leicester is a co-author with the architect for several reasons, such as, the materials used in *Zanja Madre* duplicated the ones the architect created for the building, Leicester and the architect conferred on their respective projects, and it was the architect that decided where to position the towers.¹⁹⁸ The Court further ruled that the towers are both an artistic and architectural creation.¹⁹⁹ Since the work has joint authors, the Court had to determine whether the architect granted his license to R & T.²⁰⁰ The Court said that even if the architect did grant license to R & T, the license would be non-exclusive, which does not allow sublicenses as shown in Leicester's license.²⁰¹

The defense claimed that *Zanja Madre* is an architectural work under Section 102(a)(B) of the Copyright Act, which means that the work may be photographed and reproduced under Section 120(a).²⁰² The Court decided that based on a preponderance of the evidence that the towers and *Zanja Madre* are considered an architectural work.²⁰³ The Court reached this decision because they believed that the towers also serve a functional aspect of the building

¹⁹⁶ *Leicester*, 47 U.S.P.Q.2d at 1504.

¹⁹⁷ *Id.*

¹⁹⁸ *Id.*

¹⁹⁹ *Leicester*, 47 U.S.P.Q.2d at 1506.

²⁰⁰ *Id.*

²⁰¹ *Id.*

²⁰² *Id.*

²⁰³ *Leicester*, 47 U.S.P.Q.2d at 1507.

plan.²⁰⁴ Having ruled that the towers used by Warner Brothers in *Batman Forever* are an architectural work, the Court ruled in favor of the defendant, since Section 120(a) allows pictorial representations and effectively negates the plaintiff's claim of infringement.²⁰⁵

XIII. Comparison of *Woods*, *Hart* and *Leicester*

Although the three cases are different, *Woods*, *Hart*, and *Leicester* help to advance the rights of artists. *Woods* laid the groundwork that effected the outcome in *Hart*. Movie studios, as a result, are becoming nervous in pursuing these cases and in the selection of set decorations.

The court in *Woods*, when granting the injunction against Universal City Studios, distinctly stated that the "copyright notification and registration put potential infringers on notice that they must seek permission to copy a copyrighted work or risk the consequences."²⁰⁶ The studio felt the message contained in the ruling because it settled quickly. *Hart* and *Devil's Advocate* followed almost the same pattern. The studio attempted to fight the infringement, but soon realized it was a losing battle.²⁰⁷

A trend toward protecting artists' rights is being felt in Hollywood. *Daily Variety* printed an article in 1999 concerning the threat of potential lawsuits, thus making the job of the set decorator more difficult.²⁰⁸ Rosemary Brandenburg, the former chairwoman of the board of the Set Decorators Society in Los Angeles says the new cases involving these copyright claims have "mushroomed."²⁰⁹ "Producers have to know which works you need legal clearance on, and the

²⁰⁴ *Id.*

²⁰⁵ *Id.* at 1508-09.

²⁰⁶ *Woods*, 920 F.Supp. at 65.

²⁰⁷ *Masters*, *supra* note 157, at B02.

²⁰⁸ Robert Hofler, *Onscreen Art a Legal Land Mine*, DAILY VARIETY, May 28, 1999, available in LEXIS, News Library, ALLNWS File.

²⁰⁹ *Id.*

tremendous effort involved in securing it. And certainly set decorators can't be held legally reliable," Brandenburg stated.²¹⁰ The impact from these cases is clear and Hollywood is still reacting to it.

Even though *Leicester* did not rule in favor of the artist, its decision cannot be used to discount the trend. *Leicester* revolved around a very unique and complicated set of contracts and working conditions; had the work not been deemed architectural it may very well have followed *Woods*. That decision by the court allowed *Zanja Madre* to fall under a specific exception that otherwise would not have permitted Warner Brothers to use it. Based on *Woods* and *Ringgold*, the court might very well have made a completely different decision.

The reproduction of works of art, even though different from the original, follows the same rationale as in *Ringgold*; if it is substantially similar to the original, permission from the artist is needed. The court's message is that artists' rights are not something to be ignored.

XIV. Conclusion

Next time you watch television or see a movie, look at the visual art incorporated into the film and think about the work needed to place the work on screen. Artists have rights. All the cases have illustrated in some form that an artist is entitled to copyright protection when a set designer decides to use their work. The cases may not all rule in the same manner, but the message from them is clear. Before you hang that poster or build a sculpture, ask the artist for a copyright license.

²¹⁰ *Id.*