

## 2 Copyright Rulings Reveal Evolving Protection For Street Art

By **Bobby Ghajar, Marcus Peterson and Alexander Galicki** (May 12, 2020, 5:08 PM EDT)

While street art has taken strides from the underground to the mainstream as a celebrated form of expression, artists are learning that they still have a long way to go to protect their rights fully.

One issue that has arisen for street artists is whether the pictorial representation exception to the Copyright Act, which was added as part of the Architectural Works Copyright Protection Act of 1990, allows others to freely photograph works that are incorporated into buildings — without infringing the artists' copyrights.

Two recent court decisions that have addressed this question in the context of street art have considered it differently. The *Falkner v. General Motors LLC* decision from California and the *Mercedes Benz USA LLC v. Lewis* decision from Michigan both concern street artworks displayed in Detroit, Michigan, one of the meccas of the street art world.

But while the *Falkner* court denied a defendant's summary judgment motion seeking to prevail on the pictorial representation exception as a matter of law, the *Mercedes* court found that a declaratory judgment could proceed under the same argument without analyzing any of the factual allegations. The cases illustrate the evolving and unsettled case law involving street artists and their rights.

### **The Pictorial Representation Exemption to the Copyright Act**

There is little dispute whether a painting on a canvas would qualify for protection under the Copyright Act, provided it meets the requirements of originality and authorship. There is an open question, though, as to whether that same painting, on the side of a building, is entitled to protection and, if so, exactly how far that protection extends.

The Copyright Act protects eight categories of original works of authorship, including pictorial, graphic and sculptural, or PGS, works.[1] In 1989, the United States joined the Berne Convention for the Protection of Literary and Artistic Works, which required signatories to protect completed architectural works. The Berne Convention prompted Congress to pass the AWCPA in 1990, which extended American copyright protection for the first time to architectural works that are not otherwise works of art.[2]

Prior to the AWCPA, only portions of buildings featuring original artistic work that were not part of a functional, utilitarian or useful role in the architecture could be protected as a PGS work. This was referred to as the doctrine of conceptual separability.

Although the AWCPA granted architectural works protection generally under Section 102, that protection was limited by Title 17 of U.S. Code Section 120(a) — the pictorial representation exemption. It provides:

The copyright in an architectural work that has been constructed does not include the right to prevent the making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations of the work, if the building in which the work is embodied is located in or ordinarily visible from a public place.

Thus, a person can freely take a photograph of a building without infringing a copyright. What remains unclear is the impact of that exception where the photograph of a building captures a mural, painting or street art on the exterior. In other words, did the AWCPA intend to both provide architectural works with copyright protection and repeal protection for a PGS works even if it is "conceptually separable from the building of which it was a part"?

### **Los Angeles: Falkner v. General Motors**

In 2014, graffiti artist Adrian Falkner (also known as Smash 137) created an outdoor mural throughout a parking garage in Detroit. Photographer Alex Bernstein later took several photographs of General Motors vehicles in or near the parking structure, one of which captured part of Falkner's mural. GM posted them to its social media accounts to promote the new Cadillac XT5.

Falkner filed suit in the U.S. District Court for the Central District of California, alleging, among other claims, copyright infringement. GM moved for summary judgment, arguing that "[b]ecause [Falkner's] mural [was] painted onto an architectural work it falls squarely within the 'pictorial representation exemption'" of Title 17 of U.S. Code Section 120(a).[3]

The court denied GM's motion for summary judgment on the copyright infringement claim. It focused its analysis on an earlier Ninth Circuit decision: *Leicester v. Warner Bros. Entertainment Inc.*[4] There, an artist had designed a courtyard space — Zanja Madre — built adjacent to and concurrent with the 801 Tower in downtown Los Angeles. The artist sued Warner Brothers after his work appeared in the film "Batman Forever."

At trial, the district court conducted a fact-specific analysis of the relationship between the Zanja Madre and the 801 Tower, concluding that Zanja Madre was a part of the architectural work under Section 102(a)(8) and that therefore, Section 120(a) applied, allowing the pictorial representations made by Warner Bros.

The district court further held that the conceptual separability doctrine as applied to PGS works embedded as part of a building did not survive the 1990 amendments to the Copyright Act. It therefore concluded that the film's visual representations of the Zanja Madre did not constitute copyright infringement. The U.S. Court of Appeals for the Ninth Circuit affirmed the trial court's judgement.[5]

The Falkner court reasoned that, under *Leicester*, for the pictorial representation exemption to apply to a PGS work, the work must be part of an architectural work, which is a fact-specific inquiry. Falkner also concluded that *Leicester* left open whether the conceptual separability doctrine survived the 1990 amendments.

On the first question — whether the work was part of an architectural work under Section 102(a)(8) —

the court held that unlike in Leicester, there was "undisputed evidence that [Mr. Falkner] was afforded complete creative freedom with respect to the mural, and that the design of the mural was inspired by Plaintiff's prior work." The parking garage was already constructed by the time the mural was painted. And Falkner was not instructed that the mural should play a functional role with respect to the parking garage or that the design should match elements of the garage.

The court held that the facts established — if anything — "the lack of a relevant connection between the mural and the parking garage." The court therefore held that it could not conclude as a matter of law that the pictorial work was part of an architectural work and, as such, could not reach whether Section 120(a) applied to the mural to permit photographs of it.

The court therefore denied GM's motion for summary judgment on the copyright claim, and the ruling gave a strong indication that GM would likely not prevail on the argument at trial. After the opinion was issued, the case ultimately settled.

### **Detroit: Mercedes Benz v. Lewis**

Around the time that the Falkner case was litigated in Los Angeles, Mercedes Benz[6] posted a number of pictures on Instagram of its G 500 series vehicle in Detroit with buildings visible in the background. The sides of the buildings included murals painted by four international muralists as part of Detroit's Murals in the Market festival.

The artists sent letters to Mercedes objecting to the use of their art in the photographs and claiming copyright infringement. Mercedes then sought declaratory judgment in the U.S. District Court for the Eastern District of Michigan that the paintings were exempt from protection pursuant to the ACWPA (under Section 120(a)) and that its advertisements did not infringe the artists' copyrights.[7]

The artists moved to dismiss for failure to state a claim, which the court denied. Interestingly, the Mercedes court did not discuss (or even cite to) Falkner. It first addressed defendants' argument that Section 120(a) did not apply to protect Mercedes' photos because the murals were a PGS work.

In contrast to Falkner, the Mercedes court did not look closely at the factual allegations of the complaint and consider whether they sufficiently alleged the murals were part of the buildings for the purposes of Section 120(a). Instead, it briefly summarized Leicester, which it said rejected the artists' argument.

The court next addressed the artists' argument that applying Section 120(a) would be unjust because it would allow "anyone to distribute copies of an otherwise copyrightable PGS work," which would wipe out all copyright protection for street art murals. The court observed that Leicester rejected this same policy argument. It held that nothing in Leicester supported the artists' argument that Mercedes did not have a claim under the ACWPA.[8]

The court therefore held that Mercedes had alleged a plausible claim that Section 120(a) of the ACWPA protected Mercedes' right to photograph publicly visible buildings which contained defendants' murals, and its declaratory relief case survived defendants' motion to dismiss. That case is pending.

### **Analysis and Conclusion**

The Falkner and Mercedes cases illustrate several important lessons for the artists who produce street artworks, the companies that seek to capitalize on them and the lawyers who litigate disputes.

First, regardless of their different approaches and outcomes, the Mercedes and Falkner courts issued their decisions at different procedural stages. Falkner was deciding a putative defendant's motion for summary judgment, which was defeated due to the need in that case to conduct a fact-intensive determination of whether the artwork was part of the building.

The Falkner court concluded that the evidence of record established — if anything — that the mural was not part of the architectural work under Section 102(a)(8) and that it therefore could not reach the question of whether Section 120(a) applied to the mural to permit photographs of it.

In contrast, the Mercedes court dealt with a Federal Rule of Civil Procedure 12(b)(6) motion to dismiss Mercedes' declaratory lawsuit, rather than the merits of a developed factual record relating to the circumstances surrounding the creation of the artwork. Even so, the Mercedes court seemed unconcerned with the specific factual allegations.

The more interesting question is how the Mercedes court will rule at the summary judgment stage, once it has a more fully developed factual record. The court denied a motion for reconsideration filed by the defendants, but noted that Mercedes' success on a motion to dismiss was not an indication that the claim would survive further scrutiny. What is clear from both cases is that a determination of the pictorial representation exemption will depend on the facts of the case and likely will not be decided as a matter of law.

Second, there is an important public relations and crisis management component to disputes involving street artists, and for that reason in part, they tend to settle. Regardless of whether a company is on the right side of copyright law, taking an aggressive position against a street artist can often be detrimental to a brand in the sphere of public opinion. The public tends to harshly judge brands perceived as infringing works by street artists without seeking permission or payment.

For example, Swedish fashion house H&M sued Los Angeles-based artist Revok after the artist's lawyer sent the company a cease-and-desist letter for an ad that featured his artwork.[9] The letter prompted H&M to seek a declaration that the work was painted illegally and therefore could not be subject to copyright protection. The suit led to a backlash from the street art community and the public more generally. H&M eventually settled the case and, as part of the settlement, agreed to fund several Detroit art institutions and charities.[10] Even if a company might prevail on the merits, vigorously litigating a case may do more harm than good.

Third, because street art cases often settle, there is a dearth of case law on many of the important legal issues. The H&M case, and others, have raised an important legal question — whether illegal or unauthorized works are entitled to copyright protection — but the issue has never been decided. The pictorial representation exemption is no exception. Lawsuits will continue to hit the courts, though quick resolutions continue the cycle.

For example, on Feb. 15, 2019, artists Curtis Kulig and Darren and Emmelene Mate sued footwear company The Aldo Group Inc. for copyright infringement after the company allegedly posted promotional materials on social media in which the artists' love murals appeared as backdrops.[11] The case was voluntarily dismissed by the artists without prejudice.

Street artist Chris Williams sued grocery store chain Hy-Vee for using an image of his mural in an advertising campaign, including a Super Bowl commercial.[12] Again, the case was voluntarily dismissed

by Williams without prejudice, perhaps as a result of settlement.

Undoubtedly, regardless of what happens in the Mercedes case, other courts will weigh in on the scope of the pictorial representation exemption to the AWCPA. In the meantime, street artists and companies must understand the legal and public relations implications of using and protecting street art.

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[1] 17 U.S.C. § 102(a)(5).

[2] 17 U.S.C. § 102(a)(8).

[3] Falkner v. General Motors LLC, 393 F.Supp.3d 927 (C.D. Cal. 2018).

[4] Leicester v. Warner Brothers, 232 F.3d 1212 (9th Cir. 2000).

[5] All three judges on the Ninth Circuit panel unequivocally agreed that, for Section 120(a) to apply to a PGS work that is not itself an architectural work, the PGS work must be "part of" an architectural work. Leicester, 232 F.3d at 1219. Leicester seemed to leave open the question of how, if at all, courts should apply the doctrine of conceptual separability to PGS works that are part of architectural works.

[6] The American subsidiary of the German car company.

[7] Mercedes Benz, USA, LLC v. Lewis, 2019 WL 4302769 (E.D. Mich. Sept. 11, 2019).

[8] The court also rejected defendants' reliance on the Supreme Court's decision in *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017), a case about the protectability of designs on cheerleading uniforms. It also rejected several other ancillary arguments advanced by defendants.

[9] <https://www.washingtonpost.com/news/arts-and-entertainment/wp/2018/03/16/hms-battle-with-the-artist-revok-shows-how-street-art-is-being-taken-seriously/>.

[10] <https://www.freep.com/story/news/local/michigan/detroit/2018/09/06/revok-and-h-m-pledge-donations-detroit-arts-groups/1206836002/>.

[11] Kulig v. The Aldo Group, Inc., Case No. 2:19-cv-01179 (C.D. Cal. 2019); see also <https://www.artsy.net/news/artsy-editorial-street-artists-suing-shoemaker-aldo-copyright-infringement>.

[12] Williams v. Hy-Vee, Inc., Case No. 2:19-cv-06671 (C.D. Cal. 2019).