

Appropriation Artist Guilty of Copyright Infringement

By Joel L. Hecker

In the case of first impression, Judge Deborah Batts, United States District Judge sitting in the Southern District of New York, has found Richard Prince, the well known appropriation artist, his gallery, Gagosian Gallery, Inc. (Gallery), and Lawrence Gagosian (Gagosian), the gallery's principal, all guilty of copyright infringement arising out of Prince's paintings based upon Patrick Cariou's photographs of Rastafarians in Jamaica. The case is *Patrick Cariou v. Richard Prince et al.*¹ The decision was dated and filed on March 18, 2011.²

Background Facts

Cariou is a professional photographer who spent time with Rastafarians in Jamaica over the course of six years, gaining their trust and taking their photographic portraits. In 2000, he published a book of his photographs taken of Rastafarians during his time in Jamaica. The book, titled *Yes Rasta*, was released by PowerHouse Books and contained both portraits of Rastafarian individuals and landscape photos.

During discovery in the case, Cariou testified at length about the creative choices he made, including which equipment to use, how to stage and compose the individual photos, and the techniques and processes he used when developing the photos. He was also heavily involved in the layout, editing, and printing of the book. The book lists Cariou as the sole copyright owner of the photos appearing in it.

Prince is a well known and highly successful "appropriation artist" who has had his work shown at numerous museums and other institutions, including a solo show at the Guggenheim Museum in New York City.

The Gallery is an art dealer and gallery that represents Prince and markets his art. Gagosian is the president, founder, and owner of the Gallery.

Between December 2007 through February 2008, Prince showed some of his artwork at the Eden Rock Hotel in St. Barts. The work included a collage entitled *Canal Zone (2007) (Canal Zone)*, which consisted of a collage of 35 photographs literally torn from Cariou's book and attached to a wooden backer board. Prince had painted over some portions of the 35 photographs, used some of them in their entirety and some partially. Although the *Canal Zone* collage was not sold, portions of it were reproduced in a magazine article about Prince's show at the Gagosian Gallery.

Prince ultimately completed 29 paintings in his contemplated *Canal Zone* series, 28 of which included images taken from *Yes Rasta*. Some of the paintings consisted

almost entirely of images from the book, albeit collaged, enlarged, cropped, tinted, and/or over-painted, while others used only portions of the *Yes Rasta* photos. In total, Prince admitted using at least 41 photos from *Yes Rasta* as elements of his *Canal Zone* paintings.

The Gallery showed 22 of the 29 *Canal Zone* paintings from November 8, 2008 to December 20, 2008 at one of its Manhattan locations. It also published and sold an exhibition catalogue from the show, which included reproductions of many of these paintings, as well as actual photographs of *Yes Rasta* photos as they appeared in Prince's studio.

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Cariou has never sold or licensed use of his photos other than for the *Yes Rasta* book and private sale to individuals he knew and liked. However, he was negotiating with gallery owner Christiane Celle (Celle) who had planned to show and sell his prints at her Manhattan gallery prior to the *Canal Zone* show's opening. Cariou also intended to issue artist editions of the photos which would be offered for sale to collectors.

Celle originally planned to exhibit between 30 and 40 of the photos at her gallery with multiple prints of each to be sold for prices ranging from \$3,000 to \$20,000 depending on size. She also planned to have the *Yes Rasta* book reprinted for a book signing. When Celle became aware of the Gallery exhibition of the *Canal Zone* images, she canceled Cariou's show because she did not want to seem to be capitalizing on Prince's success and notoriety and because she did not want to exhibit work which had been "done already" at another gallery.

Copyright Infringement

To prevail on a copyright infringement claim, the copyright owner must prove two elements: ownership of a valid copyright and copying of constituent elements of the work that are original.³

Judge Batts found that Cariou's ownership of a valid copyright in the photos was undisputed. She dismissed out of hand the defendant's argument that such photos were mere compilations of facts, finding that settled law for over 100 years conclusively determined that creative

photographs are worthy of copyright protection even when they depict real people and natural environments.

As to the second point, copying of constituent elements, the court found that such copying was admitted by Prince and was undisputable.

Fair Use Analysis

The primary defense raised by the defendants was that Prince's use of the photos was a fair use under the Copyright Act and therefore entitled to protection.

The purpose of fair use was and is to address the inevitable tension between the property rights established under copyright's purpose "to promote the Progress of Science and useful Arts" as contained in the U.S. Constitution⁴ and the ability of authors to express themselves by referencing the work of others. The doctrine of fair use is now codified in Section 107 of the 1976 Copyright Act and consists of a four-factor test.

Factor One—Purpose and Character of the Use

a. Transformative Use

This part of the test is the most important one in applying the fair use analysis. Its purpose is to determine "whether the new work merely supersede[s] the objects of the original creation or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is 'transformative.'"⁵ The more transformative the new work, the less significance will be given to the other factors.

Judge Batts found that Prince's uses of Cariou's photos was not transformative, since they did not recast, transform or adopt an original work into a new mode of presentation. This conclusion was supported by Prince's testimony that he had no interest in the original meaning of the photographs he uses, and that he does not really have any message he attempts to communicate when making art. Moreover, Prince testified that he did not intend to comment on any aspects of the original works or on the broader culture. His intent was to pay homage or tribute to other painters. For example, he testified that his message with regard to the paintings in which he collaged guitars onto portraits of Rastafarian men taken from *Yes Rasta* related to the fact that the men had become guitar players. ("[H]e's playing the guitar now, it looks like he's playing the guitar, it looks as if he's always played the guitar, that's what my message was."⁶)

Prince also testified that he chooses the photographs he appropriates for what he perceives to be their truth. To the court, this suggested that his purpose in using Cariou's portraits was the same as Cariou's original purpose in taking them, which was a desire to communicate

to the viewer core truths about Rastafarians and their culture.

On these facts, Judge Batts concluded that it was apparent Prince did not intend to comment on Cariou's photos, or on aspects of popular culture closely associated with Cariou or the photos, when Prince appropriated Cariou's photos. Furthermore the court found that Prince's own testimony showed that his intent was not transformative within the meaning of Section 107.

The court also declined the defendants' invitation to find that appropriation art as a medium of art is *per se* fair use regardless of whether or not the new artwork in any way comments on the original work appropriated.

b. Commerciality

The second prong of the first fair use factor concerns whether the otherwise infringing work serves a commercial purpose or nonprofit education purpose. In this situation, Prince's *Canal Zone* show at the Gallery was advertised in seven different newspapers, five of which included reproductions of Cariou's photos as altered by Prince. The Gallery and Gagosian also sent some 7,500 invitation cards to clients of the Gallery, featuring a reproduction of a Prince work containing a Cariou photo, and sold the leftovers to a poster company. As a result of these and other marketing efforts, the Gallery sold eight of the *Canal Zone* paintings for a total of \$10,480,000, 60 percent of which went to Prince and 40 percent to the Gallery. Seven other *Canal Zone* paintings were exchanged for art with an estimated value between \$6,000,000 and \$8,000,000.

The court recognized the inherent public interest and public value of public exhibition of art and of an overall increase of public access to artwork. However, the court found that the defendants' use and exploitation of the photos was substantially commercial, and, given the overall low transformative content of Prince's paintings, found that this prong of the first factor weighed against a finding of fair use.

c. Bad Faith

The courts consider the propriety of a defendant's conduct as an integral part of the character of the use under this first factor. In this case, Prince testified that he appropriates an image for his use simply based upon the fact of whether he likes the image.

In addition, Prince's employee contacted the publisher of *Yes Rasta* to purchase copies of the book, apparently for purposes of tearing pages out for use in the collages. Neither Prince nor his employee ever asked the publisher about licensing or otherwise sought permission to use the photos for a legitimate purpose. In addition, Prince failed to contact Cariou by email to inquire about usage rights, even though the book clearly identified Cariou as the sole copyright holder, and even though Cariou's publicly accessible website included his email address.

The record also established that the Gallery and Gagosian were both aware that Prince was an habitual user of copyrighted work of other artists without permission, and that they never inquired as to whether Prince had obtained permission to use Cariou's photos nor ceased their commercial exploitation of Prince's paintings after receiving Cariou's cease and desist notice. Therefore, the court found that the bad faith of each defendant was clear and unequivocal.

In summary, since Prince's use was at most minimally transformative, because the use was substantially though not exclusively commercial, and because the defendants acted in bad faith, the court found that the first fair use factor analysis weighed heavily in favor of Cariou.

Factor Two—The Nature of the Copyrighted Work

This factor is of lesser importance than the others in the fair use analysis. The key distinction in evaluation of this factor is whether the original work is expressive or creative, such as a work of fiction, or more factual, in which event there is a greater leeway allowed to a claim of fair use. The court found that Cariou's photos were highly original and creative artistic works. Consequently, Judge Batts weighed this factor against a finding of fair use.

Factor Three—The Amount and Substantiality of the Portion Used

This factor is examined in context with the inquiry focusing on whether the extent of the copying is consistent with or more than necessary to further the purpose and character of the use. Normally, the amount and substantiality factor would weigh in favor of the copyright holder where the portion used was essentially the heart of the copyrighted work. However, an insubstantial taking in and of itself is not excused merely because of that fact. This principle was cogently set forth by Judge Learned Hand, who stated, "no plagiarist can excuse the wrong by showing how much of his work he did not pirate."⁷

Since Prince appropriated entire photos in a number of his paintings and appropriated the central figures depicted in Cariou's photos in a majority of his paintings, all of which going to the very heart of Cariou's work, the court found that this factor weighed heavily against a finding of fair use.

Factor Four—Market Harm

This factor requires the court to consider the extent of market harm caused by the infringement as well as whether there is a substantial adverse impact on the potential market for the original. That is, actual harm as well as potential future harm. Actual harm was evident in the fact that Celle, Cariou's gallery owner, discontinued plans

to show the *Yes Rasta* photos and to offer them for sale to collectors and not to republish the book because Prince's paintings had usurped the market.

As to potential harm, Cariou had indicated that he had intended to issue artists' editions of his photos for sale to collectors.

The court had no problem finding that Prince had unfairly damaged both the actual and potential markets for Cariou's work as well as the potential market for derivative use licenses of his original work. Accordingly, this fourth factor also weighed against the finding of fair use.

Liability of Gagosian Defendants

The court found uncontroverted evidence that the Gallery and Gagosian copied original constituent elements of Cariou's copyrighted photos when they published the *Canal Zone* exhibition catalogue, created and distributed the invitation cards, and otherwise distributed reproductions of Cariou's work, as appropriated by Prince. In addition, they exhibited and sold Prince's unauthorized works. As a result, the court found that these defendants had infringed Cariou's exclusive copyright rights to reproduce, prepare derivative works based upon, distribute, sell, and display Cariou's photographs. Accordingly, they were liable for direct copyright infringement.

In addition, the court found them to also be liable as vicarious and contributory infringers since they were handling everything in connection with the marketing of the *Canal Zone* paintings. As a result, they had the right and ability to supervise Prince's work, or at the very least, the right and ability to ensure that Prince obtained licenses to use the photos before they made Prince's paintings available for sale.

Injunctive Relief

The court enjoined and permanently restrained the defendants from infringing the copyright in Cariou's photographs. The court also took the extraordinary step, as part of the remedy granted, in ordering, within 10 days of the date of the order, that Prince's infringing paintings be delivered up "for impounding, destruction, or other disposition, as Plaintiff determines, all infringing copies of the Photographs, including the Paintings and unsold copies of the *Canal Zone* exhibition book, in their possession, custody, or control...."⁸

Furthermore, the court ordered that the defendants notify in writing any future or current owners of Prince's paintings of whom they are or become aware, that such paintings infringe Cariou's copyright and that the paintings were not lawfully made and cannot be lawfully displayed.

Conclusion

Appropriation art has long been a hot topic in the copyright and artistic communities with copyright owners challenging the concept that an artist can simply infringe creative work under the name of “appropriation,” while many artists believe that “appropriation” is a legitimate exercise in artistic freedom. Judge Batts has now come down squarely on the side of infringement against one of the principal and most successful appropriation artists. Given the scope and breadth of the decision, and in particular the injunctive relief granted, the defendant’s notice of appeal is not surprising. We therefore have probably not heard the last word concerning appropriation art.

Endnotes

1. No. 08 Civ. 11327 (DAB), 2011 U.S. Dist. LEXIS 29070, at *1 (S.D.N.Y. Mar. 18, 2011).
2. *Id.*
3. *Id.* at *10-*11.
4. U.S. Const. art. 1, §8, cl.8.
5. *Cariou*, 2011 U.S. Dist. LEXIS 29070, at *16-*17 (citing to *Salinger v. Colting*, 641 F.Supp.2d 250, 256 (*rev’d versed on other grounds* 607 F.3d 68 (2d Cir. 2010))). It should be noted that Judge Batts also wrote the District Court opinion in the *Salinger* case.

6. *Id.* at *21.
7. *Id.* at *31.
8. *Id.* at *41.

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