

# American graffiti

Today, graffiti and street art can include everything from 'tagging' to the works of world-famous street artists like Banksy. **Guy R Cohen, Sara L Edelman and Jacklyn M Siegel** consider the nuances of this art form and copyright



**Not everyone realises that, like any art form that is “fixed in a tangible medium of expression”,<sup>1</sup> original street art may be protected from unauthorised use under the US Copyright Act.**

For that reason, anyone considering using street art in commercial content must carefully evaluate whether a licence is necessary and, if it is, secure a licence from the copyright owner. Keep in mind that the owner of the copyright is, in many cases, the artist and not the owner of the artwork, ie, the building owner who authorised the painting of a mural on his property. Failure to obtain a licence can be costly because, like other artists, street artists are increasingly turning to litigation to protect their intellectual property rights. Not all unauthorised uses of street art are unlawful, however, and a number of potential defences may be – and have been – asserted. We consider several of them below.

## De minimis use

One potential defence is the *de minimis* use doctrine, which holds that certain uses of protected works are so trivial that they do not constitute copyright infringement.

That is what HBO argued in a recent case in the Southern District of New York. In *Gayle v Home Box Office, Inc.*,<sup>2</sup> an artist alleged that HBO used his graffiti – the phrase “art we all” written on a dumpster – in an episode of the television series *Vinyl* in violation of his copyright rights. HBO moved to dismiss, arguing that its use was *de minimis*. The district court agreed. Given its momentary appearance in the background, without ever being fully legible, the district court found that “the graffiti was filmed in such a manner and appears so fleetingly that... there is no plausible claim for copyright infringement here.”<sup>3</sup>

Whether or not a *de minimis* use defence will succeed is highly fact-specific. In cases involving moving images, like *Gayle*, the length of time in which a work appears will be a key consideration. But the defence is not limited to videos, and defendants should also consider whether *de minimis* use defences are viable when street art appears in static images, such as photographs.

That’s what Mercedes Benz USA (Mercedes) has argued in a trio of cases involving photographs posted to social media. The photographs depicted a Mercedes vehicle driving past several outdoor murals. In March 2019, after the muralists threatened to sue, Mercedes filed declaratory judgment actions in the Eastern District of Michigan seeking, among other things, declarations that its use of the murals was *de minimis* and thus non-infringing. In doing so, Mercedes highlighted the blurry, cropped, and obstructed natures of the murals as seen in the photographs.<sup>4</sup>

The merits of Mercedes’ *de minimis* use defence have not yet

been determined by the district court, and the artists will surely dispute Mercedes’ allegations. Should Mercedes prevail, however, it could set a useful precedent for those defending copyright infringement claims involving photographs and social media.

## Fair use

Another potential defence to a copyright infringement claim is that the use of street art constitutes a fair use. In analysing a fair use defence, courts consider: “(1) the purpose and character of the use, including whether 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 on the potential market for or value of the copyrighted work.”<sup>5</sup> In connection with this analysis, courts consider whether the use is “transformative” in that it alters the copyrighted work “with new expression, meaning, or message”.<sup>6</sup>

In the street art context, fair use arguments have emphasised the transformative nature of the allegedly infringing work and the idea that publicly displayed murals that are part of an urban environment should be afforded a reduced degree of protection.

In a recent case filed in the Central District of California, an artist objected to the appearance of his mural – a repeating pattern of the word “love” – in a social media post by the retailer Aldo.<sup>7</sup> Aldo moved to dismiss the artist’s copyright infringement claim in part by arguing that its use of the mural was a fair use. Aldo contended that because its post depicted only a small portion of the mural and focused on a model, not the mural, it transformed the work from “a mural presumably about love to a photograph about fashion”.<sup>8</sup> Aldo’s motion, which the artist opposed, has not been decided.

## Architectural works

Another potential copyright infringement defence focuses not on how the alleged infringer used the street art, but on the buildings on which the artwork appears.

The Architectural Works Copyright Protection Act of 1990 (AWCPA) added architectural works as a new category of protected works under the Copyright Act. With that protection, however, came an exception. Section 120(a) of the AWCPA provides that the copyright in a constructed architectural work “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.”<sup>9</sup> In other words, a third party may photograph or film a building that is

otherwise protected by copyright without being liable for infringement.

Defendants have sought to apply Section 120(a) to pictorial, graphic, or sculptural works that are “part of” architectural works.<sup>10</sup> In 2018, General Motors (GM) did so in the context of street art. In that case, in the Central District of California, a muralist sued GM for copyright infringement based on a social media post of a photograph depicting a GM vehicle in front of the plaintiff’s mural. GM moved for summary judgment, arguing that the mural was part of the parking garage on which it appeared and, thus, covered by Section 120(a).

The district court found otherwise. Given the lack of evidence that the mural was an architectural feature of the garage or designed to be part of the building or serve a related functional purpose, the district court could not find that the mural was part of an architectural work and could not reach the application of Section 120(a).<sup>11</sup> Shortly thereafter, the parties settled.

**“Some argue that because the street art was painted illegally, the artist has no enforceable copyright in their work.”**

To date, the question of whether Section 120(a) encompasses street art that is “part of” an architectural work remains unresolved. It may be decided soon, as Mercedes has also invoked Section 120(a) as a basis for non-infringement in its declaratory judgment actions, which the artists moved to dismiss.<sup>12</sup> The district court’s decisions, still pending, should shed light on how this defence applies to cases involving street art.

### Illegality

Street art is sometimes painted without authorisation from the owners on whose property the artwork appears. Some argue that because the street art was painted illegally, the artist has no enforceable copyright in their work.

To our knowledge, no US court has decided the merits of such defence, although one district court appears to have assumed the defence was available.<sup>13</sup> The retailer H&M invoked the defence in 2018 in a declaratory judgment action it filed in the Southern District of New York. In that case, an H&M promotional video included images of graffiti painted without authorisation on a handball court in a public park. H&M sought a declaration that because the graffiti was created illegally, it was not entitled to copyright protection, and therefore H&M’s use of the graffiti was not infringing.<sup>14</sup>

Public backlash from certain corners of the arts community was swift and severe. Some critics called the lawsuit an “assault on artists’ rights”, worrying that if H&M’s position prevailed, street artists would potentially lose all copyright rights in their artwork.<sup>15</sup> Some even called for a boycott of H&M. Faced with this vocal outcry, H&M withdrew its complaint.

Whether unauthorised street art is entitled to copyright protection remains an unanswered question. But H&M’s experience reminds us that although a defence may be available, one should always be mindful of the possible public relations implications when addressing claims relating to street art.

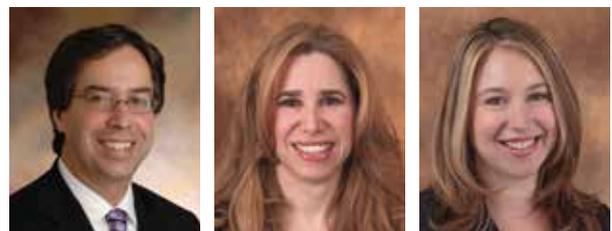
### Summary

As the cases demonstrate, original street art can be protected from unauthorised copying under the Copyright Act, and like artists in any other medium, street artists can and do turn to the courts to protect their intellectual property rights. Resolving those disputes can be time-consuming and costly. As a result, those considering using a third party’s street art in a commercial context should consult with intellectual property counsel before proceeding to evaluate whether a licence to use the work is necessary. But should a dispute arise, counsel can advise whether any of the possible defences discussed here may be available in light of the facts of the case.

### Footnotes

- 17 USC § 102(a).
- 17-CV-5867 (JMF), 2018 US Dist LEXIS 73254 (SDNY 1 May 2018).
- Id at \*7–8 (quotations and citation omitted).
- Complaint, *Mercedes Benz USA LLC v Soto*, Case No 2:19-cv-10949 (ED Mich 29 Mar 2019); Complaint, *Mercedes Benz USA LLC v Bombardier*, Case No 2:19-cv-10951 (ED Mich 29 Mar 2019); Complaint, *Mercedes Benz USA LLC v Lewis*, Case No 2:19-cv-10948 (ED Mich 29 Mar 2019).
- 17 USC § 107.
- Campbell v Acuff-Rose Music, Inc*, 510 US 569, 579 (1994).
- Complaint, *Kulig v Aldo Grp Inc*, Case No 2:19-cv-01181-SVW (CD Cal 15 Feb 2019).
- Reply Brief at 3, *Kulig*, Case No 2:19-cv-01181-SVW.
- 17 USC § 120(a).
- Leicester v Warner Bros 232 F.3d 1212* (9th Cir 2000).
- Falkner v GM, LLC*, 2:18-cv-00549-WWW-JPR, 2018 US Dist. LEXIS 225991, at \*23 (CD Cal 17 Sept 2018).
- See, eg, Complaint at paragraphs 50–51, *Soto*, Case No 2:19-cv-10949; Motion to dismiss, *Soto*, Case No 2:19-cv-10949.
- See *Villa v Pearson Education, Inc*, 03 C 3717, 2003 US Dist LEXIS 24686 (ND Ill 9 Dec 2003).
- Complaint at para 30, *H&M Hennes & Mauritz GBC AB v Williams*, Case No 1:18-cv-01490-ENV-PK(EDNY 9 Mar 2018).
- Sonia Rao, H&M’s battle with the artist Revok shows how street art is being taken seriously, *The Style Blog, WashingtonPost.com*, 16 Mar 2018 (available at <https://wapo.st/2LH1CPx>)

### Authors



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