G. Trouble on Set

G.1. Lead-in

Here we look at two cases that might look okay when posing solo, but paired together, they don't look like a happy couple. Both concern set decoration in the film and television industry.

G.2. Faith Ringgold v. Black Entertainment TV (2d Cir. 1997)

Pre-reading notes:

Airing for three seasons on cable network BET (Black Entertainment Television) in the early to mid 1990s, *Roc* was a sitcom starring Charles S. Dutton as garbage-truck worker Roc. The straight-arrow Roc shares his brick Baltimore row house with his wife Eleanor, his widowed father Pop, and his ever-underemployed musician brother Joey.

In Season One, Episode 16, "No Notes Is Good Notes," the church pastor comes by Roc's home, and the talk turns to the salubrious effect on youth of learning music. Roc subsequently pushes Joey to teach trumpet to kids as a way of earning some money. Joey objects that giving lessons would mean being a sell-out as a jazz artist. Eventually, Joey relents and takes the gig, but he's a slacker as an instructor, and his pupils learn nothing. All is revealed when Joey is cornered into having the kids play at a celebration in the newly remodeled church hall.

Every sitcom's remodeled church hall is a newly constructed set on a sound stage. And this one – with wide expanses of featureless gray wall – looked too bare to bear. A hastily added framed art poster provided the needed visual garnish. Then the scene was shot.

The work happened to be a poster reproduction of "Church Picnic," a story quilt in the collection of Atlanta's High Museum of Art. When artist Faith Ringgold found her framed work in-frame, she filed suit against BET for copyright infringement. This case is valuable as an infringement-analysis touchstone because it deals neither with the question of actual copying nor fair use. Instead, the analysis is focused on whether BET's reproduction of the artwork through the video component of the episode constituted substantial appropriation. The Second Circuit held that it did.

In ruling for plaintiff Ringold, the circuit court reversed the district court's grant of summary judgment and remanded for the plaintiff's continued pursuit of her infringement claim.

Opinion

{Edit by EEJ. Some short footnotes were retained by inserting into the regular text, at the point of the footnote mark, the footnote text set off by parentheses and a superscript angle bracket. <(Like this.)> Otherwise, footnotes worthy of inclusion are set off in a narrowed block of text with numbered footnote marks. Many footnotes omitted without notation. Superscript curly brackets indicate an addition; a superscript tilde indicates a deletion; a superscript hash mark indicates a deletion limited to a citation. Portions of citations were omitted without notation, including a nearby "id." where the citation reference is clear from the regular text. Whole endogenous citations (e.g., parties' briefs, the district court's opinion) removed without notation where the material cited is clear from context without the formal citation itself. Punctuation may have been moved to accommodate the deletion of citation material.}

Ringgold v. Black Entertainment TV, Inc.

U.S. Court of Appeals for the Second Circuit
126 F.3d 70 (1997)

FAITH RINGGOLD, Plaintiff-Appellant, v. BLACK ENTERTAINMENT TELEVISION, INC., HOME BOX OFFICE, INC., Defendants-Appellees. Argued May 1, 1997. Decided September 16, 1997. Docket No. 96-9329. Appealed from the U.S. District Court for the Southern District of New York (John S. Martin, Jr., J.), which granted to defendant summary judgment on copyright infringement claim. Counsel for plaintiff-appellant: Barbara Hoffman, New York, N.Y. For defendants-appellees: Kim J. Landsman, New York, N.Y. (David M. Levin, Patterson, Belknap, Webb & Tyler, New York, N.Y., on the brief). Amici curiae briefs submitted for The Artists Rights Society, Inc. and The Picasso Administration. Before Circuit Judges MESKILL and NEWMAN, and Chief District Judge McAVOY. Opinion by JON O. NEWMAN.

JON O. NEWMAN, *Circuit Judge*:

This appeal primarily concerns the scope of copyright protection for a poster of an artistic work that was used as set decoration for a television program. Faith Ringgold appeals from the˜ summary judgment {grant dismissing} her copyright infringement suit against Black Entertainment Television, Inc. ("BET") and Home Box Office, Inc. ("HBO"). The District Court sustained defendants' defense of fair use. We conclude that summary judgment was not warranted, and we therefore reverse and remand for further consideration of plaintiff's claim.

Background

1. *The copyrighted work*. Faith Ringgold is a successful contemporary artist who created, and owns the copyright in, a work of art entitled "Church Picnic Story Quilt" (sometimes hereafter called "Church Picnic" or "the story quilt"). "Church Picnic" is an example of a new form of artistic expression that Ringgold has created. She calls the form a "story quilt design." These designs consist of a painting, a handwritten text, and quilting fabric, all three of which Ringgold unites to communicate parables. The painting is a silk screen on silk quilt. "Church Picnic" is an example of this unusual art form, conveying aspects of the African-American experience in the early 1900's. The painting component of the work depicts a Sunday school picnic held by the Freedom Baptist Church in Atlanta, Georgia, in 1909. Above and below the painting are twelve numbered panels containing a text written in the idiomatic African-American dialect of the era.

The text relates the thoughts of a parishioner who attended the picnic and is waiting to tell her daughter about it when the daughter comes home.˜

Although Ringgold has retained all rights in the copyright in "Church Picnic," the work itself is owned by the High Museum of Art (the "High Museum") in Atlanta, Georgia. Since 1988 the High Museum has held a non-exclusive license to reproduce "Church Picnic" as a poster ("'Church Picnic' poster" or "the poster"), and to sell those reproductions. The "Church Picnic" poster sells for $ 20.00 a copy and was not produced as a limited edition.˜

2. *The alleged infringing use*. HBO Independent Productions, a division of HBO, produced "ROC," a television "sitcom" series concerning a middle-class African-American family living in Baltimore. Some time prior to 1992, HBO Independent Productions produced an episode of ROC in which a "Church Picnic" poster, presumably sold by the High Museum, was used as part of the set decoration.

The title character of "ROC" lives with his wife, Eleanor, his adult brother, Joey, and his father. In the episode in question, Roc pressures Joey, a jazz trumpeter, into giving trumpet lessons to some children in the church congregation, so that Joey, a perpetually unemployed gambler, can earn money to repay a debt he owes to Roc. After the children have taken some

lessons, the minister of the church suggests that they give a recital in the newly-remodeled church hall. A five-minute scene of the recital concludes the episode. The "Church Picnic" poster was used as a wall-hanging in the church hall.

As the church audience waits to hear the recital, Roc and Eleanor are standing in the background of the scene, next to the audience and slightly to the left of the poster. The minister is also standing in the background, slightly to the right of the poster. The children play very poorly, and it is evident to Roc and Eleanor that Joey has not taught them anything. The scene and the episode conclude with parents of some of the children thanking Joey for the lessons, each set of parents believing that their child played on key but was drowned out by the other children.

In the scene, at least a portion of the poster is shown a total of nine times. In some of those instances, the poster is at the center of the screen, although nothing in the dialogue, action, or camera work particularly calls the viewer's attention to the poster.˜

A broadcast television network first televised the episode in 1992, and in October 1994 BET aired the episode for the first time on cable television. In January 1995, Ringgold happened to watch the episode on BET (apparently a repeat showing), and at that time became aware of the defendants' use of the poster as part of the set decoration.

3. *District Court proceedings*. Ringgold sued the defendants, alleging infringement of her copyright in "Church Picnic Story Quilt," in violation of 17 U.S.C. § 106, because of the unauthorized use of the poster as part of the set decoration for the episode of "ROC."˜

Prior to discovery, the defendants moved for summary judgment˜.

The District Court˜ dismissed the complaint. Apparently accepting, or at least assuming, that the plaintiff had sufficiently alleged a claim of copyright infringement, Judge Martin rejected her infringement claim on the ground that undisputed facts established the defendants' fair use defense.˜

Discussion

The Copyright Act grants certain exclusive rights to the owner of a copyright, *see* 17 U.S.C. § 106, including the right to make and distribute

copies and derivative works based on the copyrighted work, and the right to display the copyrighted work publicly. In the absence of defenses, these exclusive rights normally give a copyright owner the right to seek royalties from others who wish to use the copyrighted work. *See American Geophysical Union v. Texaco*, 60 F.3d 913, 929 (2d Cir. 1995); *see also DC Comics v. Reel Fantasy*, 696 F.2d 24, 28 (2d Cir. 1982) (noting that one benefit of owning a copyright is the right to license its use for a fee). Ringgold contends that the defendants violated this licensing right by using the "Church Picnic" poster to decorate the set of their sitcom without her authorization.

The caselaw provides little illumination concerning claims that copyright in a visual work has been infringed by including it within another visual work. *Compare Woods v. Universal City Studios*, 920 F. Supp. 62 (S.D.N.Y. 1996) (film infringed architectural drawing), *with Monster Communications v. Turner Broadcasting*, 935 F. Supp. 490 (S.D.N.Y. 1996) (preliminary injunction denied to bar showing of film that included copyrighted film clips). The Nimmer treatise posits the problem of a motion picture in which an actor is reading a magazine of which the cover picture is observable, and acknowledges that "the answer is by no means certain." *See* 4 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 13.05[D][3], at 13-229. The treatise observes, with uncharacteristic ambivalence, that a fair use defense might be supported on the ground that "the entire work does not supplant the function of the plaintiff's work," yet also points out that "ordinarily" the copying of a magazine cover into another medium "will constitute infringement, and not fair use."

HBO and BET defend their use of the poster on two separate, though related grounds: (a) that their use of the poster was de minimis, and (b) that, as Judge Martin ruled, their use of the poster was a permissible "fair use," *see* 17 U.S.C. § 107.

I. De minimis

A. The *de minimis* Concept in Copyright Law

The legal maxim "*de minimis non curat lex*" (sometimes rendered, "the law does not concern itself with trifles") insulates from liability those who

cause insignificant violations of the rights of others. In the context of copyright law, the concept of *de minimis* has significance in three respects, which, though related, should be considered separately.

First, *de minimis* in the copyright context can mean what it means in most legal contexts: a technical violation of a right so trivial that the law will not impose legal consequences. Understandably, fact patterns are rarely litigated illustrating this use of the phrase, for, as Judge Leval has observed, such circumstances would usually involve "questions that never need to be answered." Pierre N. Leval, *Nimmer Lecture: Fair Use Rescued*, 44 UCLA L. Rev. 1449, 1457 (1997).˜ In *Knickerbocker Toy Co. v. Azrak-Hamway International*, 668 F.2d 699, 703 (2d Cir. 1982), we relied on the *de minimis* doctrine to reject a toy manufacturer's claim based on a photograph of its product in an office copy of a display card of a competitor's product where the display card was never used.

Second, *de minimis* can mean that copying has occurred to such a trivial extent as to fall below the quantitative threshold of substantial similarity, which is always a required element of actionable copying. *See Nimmer* § 13.03[A], at 13-27. In applying the maxim for this purpose, care must be taken to recognize that the concept of "substantial similarity" itself has unfortunately been used to mean two different things. On the one hand, it has been used as the threshold to determine the degree of similarity that suffices, once access has been shown, as indirect proof of copying; on the other hand, "substantial similarity" is more properly used, after the fact of copying has been established, as the threshold for determining that the degree of similarity suffices to demonstrate actionable infringement. *See Laureyssens v. Idea Group*, 964 F.2d 131, 139-40 (2d Cir. 1992); *Nimmer* § 13.01[B]. Professor Latman helpfully suggested that when "substantial similarity" is used to mean the threshold for copying as a factual matter, the better term is "probative similarity," and that "substantial similarity" should mean only the threshold for actionable copying. *See* Alan Latman, *"Probative Similarity" as Proof of Copying: Toward Dispelling Some Myths in Copyright Infringement*, 90 Colum. L. Rev. 1187, 1204 (1990). The Nimmer treatise endorses and has implemented the Latman taxonomy, as has this Court, *see Lauryssens* at 140.

In the pending case, there is no dispute about copying as a factual matter˜. What defendants dispute when they assert that their use of the poster was *de minimis* is whether the admitted copying occurred to an extent sufficient to constitute actionable copying, *i.e.*, infringement. That requires "substantial similarity" in the sense of actionable copying, and it is that sense of the phrase to which the concept of *de minimis* is relevant. {This} requires that the copying is quantitatively and qualitatively sufficient to support the legal conclusion that infringement (actionable copying) has occurred. The qualitative component concerns the copying of expression, rather than ideas, a distinction that often turns on the level of abstraction at which the works are compared.# The quantitative component generally concerns the amount of the copyrighted work that is copied, a consideration that is especially pertinent to exact copying#. In cases involving visual works, like the pending one, the quantitative component of substantial similarity also concerns the observability of the copied work – the length of time the copied work is observable in the allegedly infringing work and such factors as focus, lighting, camera angles, and prominence. Thus, as in this case, a copyrighted work might be copied as a factual matter, yet a serious dispute might remain as to whether the copying that occurred was actionable. Since "substantial similarity," properly understood, includes a quantitative component, it becomes apparent why the concept of *de minimis* is relevant to a defendant's contention that an indisputably copied work has not been infringed.#

Third, *de minimis* might be considered relevant to the defense of fair use. One of the statutory factors to be assessed in making the fair use determination is "the *amount* and substantiality of the portion used in relation to the copyrighted work as a whole," 17 U.S.C. § 107(3) (emphasis added). A defendant might contend, as the District Court concluded in this case, that the portion used was minimal and the use was so brief and indistinct as to tip the third fair use factor decisively against the plaintiff.[4]

> [4] Whether a use of a copyrighted work that surpasses the *de minimis* threshold of "substantial similarity" for purposes of actionable copying can nevertheless be *de minimis* for purposes of the third fair use factor is an inquiry in the class of angelic terpsichore on heads of pins. Perhaps that is why the Supreme Court has quoted approvingly Professor Latman's

> reference to "the partial marriage between the doctrine of fair use and the legal maxim *de minimis non curat lex*." *See Sony v. Universal Studios*, 464 U.S. 417, 451 n.34 (1984).

Though the concept of *de minimis* is useful in insulating trivial types of copying from liability (the photocopied cartoon on the refrigerator) and in marking the quantitative threshold for actionable copying, *see*, *e.g.*, *Vault Corp v. Quaid Software*, 847 F.2d 255, 267 (5th Cir. 1988) (30 characters out of 50 pages of source code held *de minimis*), the concept is an inappropriate one to be enlisted in fair use analysis. The third fair use factor concerns a quantitative continuum. Like all the fair use factors, it has no precise threshold below which the factor is accorded decisive significance. If the amount copied is very slight in relation to the work as a whole, the third factor might strongly favor the alleged infringer, but that will not always be the case. *See*, *e.g.*, *Iowa State University Research Foundation v. American Broadcasting Companies*, 621 F.2d 57, 59, 61-62 (2d Cir. 1980) (television program's copying of portions of copyrighted film, including an eight second segment {not fair use}). More important, the fair use defense involves a careful examination of many factors, often confronting courts with a perplexing task. If the allegedly infringing work makes such a quantitatively insubstantial use of the copyrighted work as to fall below the threshold required for actionable copying, it makes more sense to reject the claim on that basis and find no infringement, rather than undertake an elaborate fair use analysis in order to uphold a defense.

B. The *de minimis* Concept Applied to Defendants' Copying

Defendants contend that the nine instances in their television program in which portions of the poster were visible, individually and in the aggregate, were *de minimis*, in the sense that the quantity of copying (or at least the quantity of observable copying) was below the threshold of actionable copying. The parties appear to agree on the durational aspects of the copying. The segments of the program in which the poster was visible to any degree lasted between 1.86 and 4.16 seconds. The aggregate duration of all nine segments was 26.75 seconds.

The parties differ, at least in emphasis, as to the observability of what was copied. Our own inspection of a tape of the program reveals that some

aspects of observability are not fairly in dispute. In the longest segment, between 4 and 5 seconds, nearly all of the poster, at least 80 percent, is visible. The camera is positioned to the right of about eight members of the audience seated on the left side of the center aisle (facing the stage), and the poster is on the wall immediately to the left of the end of the rows of two or three spectators. The minister stands to the right of the poster, partially obscuring the lower right quadrant, and a member of the audience stands to the left, partially obscuring the lower left quadrant. Roc and his wife stand farther to the left of the poster. The very top edge of the poster is not within the camera's "framing" of the scene. Since the camera focuses precisely on the members of the audience, the poster, hung to their left, is not in perfect focus, but it is so close to them that the poster is plainly observable, even though not in exact focus. An observer can see that what is hung is some form of artwork, depicting a group of African-American adults and children with a pond in the background. The brevity of the segment and the lack of perfect focus preclude identification of the details of the work, but the two-dimensional aspect of the figures and the bold colors are seen in sufficient clarity to suggest a work somewhat in the style of Grandma Moses. Only the painting portion of the poster is observable; the text material and the bordering quilting cannot be discerned.

All the other segments are of lesser duration and/or contain smaller and less distinct portions of the poster. However, their repetitive effect somewhat reenforces the visual effect of the observable four-to-five-second segment just described.

A helpful analogy in determining whether the purpose and duration of the segments should be regarded as *de minimis* is the regulation issued by the Librarian of Congress providing for royalties to be paid by public broadcasting entities for the use of published pictorial and visual works. *See* 37 C.F.R. § 253.8 (implementing 17 U.S.C. § 118(b)). The Librarian appoints the Register of Copyrights, who serves as the director of the Copyright Office.[#] The Librarian's regulation distinguishes between a "featured" and a "background" display, setting a higher royalty rate for the former. Obviously the Librarian has concluded that use of a copyrighted visual work even as "background" in a television program normally requires

payment of a license fee. Moreover, the Librarian has defined a "featured" display as "a full-screen or substantially full screen display for more than three seconds" and a "background" display as "any display less than full-screen or substantially full-screen, or full-screen for three seconds or less." If defendants' program were to be shown on public television, plaintiff would appear to be entitled to a "background" license fee for a "less than full-screen" display.

From the standpoint of a quantitative assessment of the segments, the principal four-to-five-second segment in which almost all of the poster is clearly visible, albeit in less than perfect focus, reenforced by the briefer segments in which smaller portions are visible, all totaling 26 to 27 seconds, are not *de minimis* copying.

Defendants further contend that the segments showing any portion of the poster are *de minimis* from the standpoint of qualitative sufficiency and therefore not actionable copying because no protectable aspects of plaintiff's expression are discernible. In defendants' view, the television viewer sees no more than "some vague stylized [sic] painting that includes black people" and can discern none of Ringgold's particular expression of her subjects. That is about like saying that a videotape of the Mona Lisa shows only a painting of a woman with a wry smile. Indeed, it seems disingenuous for the defendant HBO, whose production staff evidently thought that the poster was well suited as a set decoration for the African-American church scene of a ROC episode, now to contend that no visually significant aspect of the poster is discernible. In some circumstances, a visual work, though selected by 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. The painting component of the poster is recognizable as a painting, and with sufficient observable detail for the "average lay observer,"[#] to discern African-Americans in Ringgold's colorful, virtually two-dimensional style. The *de minimis* threshold for actionable copying of protected expression has been crossed.

II. Fair Use

The District Court upheld the defendants' fair use defense after considering the four non-exclusive factors identified in 17 U.S.C. § 107. It relied primarily on two district court opinions, *Amsinck v. Columbia Pictures Industries, Inc.*, 862 F. Supp. 1044 (S.D.N.Y. 1994), and *Mura v. Columbia Broadcasting System, Inc.*, 245 F. Supp. 587 (S.D.N.Y. 1965).[8]

> [8] Whether or not the cases relied on by the District Court were correctly decided, a matter we need not determine, they are distinguishable in important respects. First, both *Mura* and *Amsinck* held that televising or filming the copyrighted items (hand puppets and a teddy bear mobile, respectively) did not constitute making a copy. However, *Mura* was decided before the 1976 Act afforded copyright proprietors a display right, *see* 17 U.S.C. § 106(5), and *Amsinck*, though decided under the 1976 Act, did not consider a display right. Second, both decisions discussed the fair use defense as dictum, after finding lack of copying. *See Mura*, 245 F. Supp. at 590; *Amsinck*, 862 F. Supp. at 1048 ("defendants might still be entitled to a fair use defense"). Third, at least in *Mura*, the puppets were used functionally and for a somewhat educational purpose in the Captain Kangaroo television program. By contrast, Ringgold's work was used by defendants for precisely the decorative purpose that was a principal reason why she created it. Finally, both decisions regarded the fourth fair use factor as of primary importance and weighted the factor heavily against the plaintiffs. However, the erstwhile primacy of the fourth factor, *see*, *e.g.*, *Harper & Row*, 471 U.S. 539 at 566, has been considerably modulated by the requirement announced by the Supreme Court in *Campbell v. Acuff-Rose Music*, 510 U.S. 569 (1994), that "all [four factors] are to be explored, and the results weighed together, in light of the purposes of copyright," and we have recently recognized the existence of a licensing market as relevant to the fourth factor analysis, *see American Geophysical*, 60 F.3d at 929-31.

Concerning the first factor – purpose and character of the use – the Court acknowledged that defendants' use was commercial, but thought this circumstance was "undercut" by the fact that the defendants did not use the poster to encourage viewers to watch the ROC episode and did not try to "exploit" Ringgold's work. The Court acknowledged that the second factor – nature of the copyrighted work – favored Ringgold in view of the imaginative nature of her artwork.

The Court considered the third factor – amount and substantiality of the portion used in relation to the entire work – to favor the defendants because the segments of the program in which the poster is visible are brief, in some only a portion is seen, and in those showing nearly all the poster, it is not in exact focus.

The Court considered the fourth factor – effect of the use upon the potential market for the work – also to favor the defendants. Noting that the television episode cannot be considered a substitute for the poster, Judge Martin predicted "little likelihood" of any adverse impact on poster sales. In addition, he observed that Ringgold did not claim that her ability to license the poster "has been negatively impacted by the defendants' use in the four years" since the episode was aired. Concluding that defendants' use "had little or no effect on Ringgold's potential market for her work," he granted summary judgment in their favor, sustaining their fair use defense.

In reviewing the grant of summary judgment, we note preliminarily that the District Court gave no explicit consideration to whether the defendants' use was within any of the categories that the preamble to section 107 identifies as illustrative of a fair use, or even whether it was similar to such categories. Though the listed categories – criticism, comment, news reporting, teaching, scholarship, and research, *see* 17 U.S.C. § 107 – have an "'illustrative and not limitative'" function," the illustrative nature of the categories should not be ignored. As the Supreme Court's recent and significant fair use opinion in *Campbell* observes, "The enquiry [concerning the first fair use factor] may be guided by the examples given in the preamble to § 107, looking to whether the use is for criticism, or comment, or news reporting, and the like ... ."

1. *First factor*. Considering the first fair use factor with the preamble illustrations as a "guide[]," we observe that the defendants' use of Ringgold's work to decorate the set for their television episode is not remotely similar to any of the listed categories. In no sense is the defendants' use "'transformative,'" *id.* at 579 (quoting Pierre N. Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105, 1111 (1990)). In *Campbell*, Justice Souter explained a "transformative" use that would tip the first factor toward a defendant:

> The central purpose of this investigation is to see, in Justice Story's words, whether the new work merely "supersedes the objects" of the original creation, *Folsom v. Marsh*, [9 F. Cas. 342, 348 (C.C.D. Mass. 1841) (No. 4,901)]; accord, *Harper & Row* ("supplanting" the original), or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message ... .

510 U.S. at 579.

The defendants have used Ringgold's work for precisely a central purpose for which it was created – to be decorative. Even if the thematic significance of the poster and its relevance to the ROC episode are not discernible, the decorative effect is plainly evident. Indeed, the poster is the only decorative artwork visible in the church hall scene. Nothing that the defendants have done with the poster "supplants" the original or "adds something new." The defendants have used the poster to decorate their set to make it more attractive to television viewers precisely as a poster purchaser would use it to decorate a home.

In considering whether a visual work has been "supplanted" by its use in a movie or a television program, care must be taken not to draw too close an analogy to copying of written works. When all or a substantial portion of text that contains protectable expression is included in another work, solely to convey the original text to the reader without adding any comment or criticism, the second work may be said to have supplanted the original because a reader of the second work has little reason to buy a copy of the original. Although some books and other writings are profitably reread, their basic market is the one-time reader. By contrast, visual works are created, and

sold or licensed, usually for repetitive viewing. Thus, the fact that the episode of ROC does not supplant the need or desire of a television viewer to see and appreciate the poster (or the original) again and again does not mean that the defendants' use is of a "purpose and character" that favors fair use. Indeed, unauthorized displays of a visual work might often increase viewers' desire to see the work again. Nevertheless, where, as here, the purpose of the challenged use is, at a minimum, the same decorative purpose for which the poster is sold, the defendants' use has indeed "superseded the *objects*" of the original, *see Folsom*, 9 F. Cas. at 348 (emphasis added), and does not favor fair use. Of course, no one would buy a videotape of the ROC episode as a substitute for the poster, but the challenged use need not supplant the original itself, only, as Justice Story said, the "objects" of the original.

It is not difficult to imagine a television program that uses a copyrighted visual work for a purpose that heavily favors fair use. If a TV news program produced a feature on Faith Ringgold and included camera shots of her story quilts, the case for a fair use defense would be extremely strong.[11]

> [11] We hesitate to say "conclusive" because even existing technological advances, much less those in the future, create extraordinary possibilities. For example, if the news program included a direct shot of an entire story quilt (whether original or poster reproduction), well lit and in clear focus, a viewer so inclined could tape the newscast at home, scan the tape, and with digital photographic technology, produce a full size copy of the original, thereby securing an attractive "poster"-like wall-hanging without paying the $ 20 poster fee. A news program that recommended this technique would be a weak candidate for fair use.

The same would be true of a news feature on the High Museum that included a shot of "Church Picnic." *See Italian Book Corp. v. American Broadcasting Cos.*, 458 F. Supp. 65 (S.D.N.Y. 1978) (fair use defense upheld for TV newscast of street festival that included copyrighted song).[12]

> [12] The Patry treatise on fair use suggests that this case is better grounded, not on fair use, but as an example of "excused innocent infringement." *See* William F. Patry, *The Fair Use Privilege in Copyright Law* 484 (2d ed. 1995). Perhaps the

> author prefers to defeat such claims on the threshold ground that no actionable infringement occurred, rather than subject the news-gathering defendant to the vagaries of the fair use defense.

However, it must be recognized that visual works are created, in significant part, for their decorative value, and, just as members of the public expect to pay to obtain a painting or a poster to decorate their homes, producers of plays, films, and television programs should generally expect to pay a license fee when they conclude that a particular work of copyrighted art is an appropriate component of the decoration of a set.

The District Court's consideration of the first fair use factor was legally flawed in its failure to assess the decorative purpose for which defendants used the plaintiff's work. Instead, the Court tipped the first factor against the plaintiff because the presence of the poster was "incidental" to the scene and the defendants did not use the poster to encourage viewers to watch the ROC episode. The first point could be said of virtually all set decorations, thereby expanding fair use to permit wholesale appropriation of copyrighted art for movies and television. The second point uses a test that makes it far too easy for a defendant to invoke the fair use defense.

2. *Second factor*. The District Court accepted the plaintiff's contention that the second fair use factor weighs in her favor because of the creative nature of her work.

3. *Third Factor*. Though we have earlier noted that the *de minimis* concept is inappropriate for a fair use analysis, since a copying that is *de minimis* incurs no liability, without the need for an elaborate fair use inquiry, the third fair use factor obliges a court to consider the amount and substantiality of the portion used, whenever that portion crosses the *de minimis* threshold for actionable copying. The District Court properly considered the brevity of the intervals in which the poster was observable and the fact that in some segments only a portion of the poster and the nearly full view was not in precise focus. Our own viewing of the episode would incline us to weight the third factor less strongly toward the defendants than did Judge Martin, but we are not the fact-finders, and the fact-finding pertinent to each fair use factor, under proper legal standards, is for the District Court,

although the ultimate conclusion is a mixed question of law and fact,# subject to *de novo* review#.

Even if the third factor favors the defendants, courts considering the fair use defense in the context of visual works copied or displayed in other visual works must be careful not to permit this factor too easily to tip the aggregate fair use assessment in favor of those whom the other three factors do not favor. Otherwise, a defendant who uses a creative work in a way that does not serve any of the purposes for which the fair use defense is normally invoked and that impairs the market for licensing the work will escape liability simply by claiming only a small infringement.

4. *Fourth factor*. The fourth fair use factor is "the effect of the use upon the *potential* market for or value of the copyrighted work." 17 U.S.C. § 107(4) (emphasis added). "It requires courts to consider not only the extent of market harm caused by the alleged infringer, but also 'whether unrestricted and widespread conduct of the sort engaged in by the defendant ... would result in substantially adverse impact on the potential market for the original.'" *Campbell*, 510 U.S. at 590 (quoting *Nimmer* § 13.05[A][4]). Ringgold contends that there is a potential market for licensing her story quilts, and stated in an affidavit that in 1995 she earned $ 31,500 from licensing her various artworks and that she is often asked to license her work for films and television. Specifically, she avers that in 1992 she was asked to license use of the "Church Picnic" poster by the producers of another TV sitcom and declined because of an inadequate price and inadequate artist's credit.

We have recognized the danger of circularity in considering whether the loss of potential licensing revenue should weight the fourth factor in favor of a plaintiff. *See American Geophysical*, at 929 n.17, 931. Since the issue is whether the copying should be compensable, the failure to receive licensing revenue cannot be determinative in the plaintiff's favor. *See id.* at 931. We have endeavored to avoid the vice of circularity by considering "only traditional, reasonable, or likely to be developed markets" when considering a challenged use upon a potential market. *See id.* at 930#. Ringgold's affidavit clearly raises a triable issue of fact concerning a market for licensing her work as set decoration. She is not alleging simply loss of the revenue she would have

earned from a compensated copying; she is alleging an "exploitation of the copyrighted material without paying the *customary* price." *See Harper & Row*, 471 U.S. at 562 (emphasis added). <(The *amicus curiae* brief for the Artists Rights Society, Inc. and the Picasso Administration strongly indicates evidence of licensing of artistic works for film and television set decoration, evidence that plaintiff is entitled to present at trial.)>

The District Court's assessment of the fourth factor in favor of the defendants was legally flawed. The Court relied primarily on the fact that the ROC episode had little likelihood of adversely affecting poster sales and that Ringgold had not claimed that her ability to license the poster had been "negatively impacted." The first consideration deserves little weight against a plaintiff alleging appropriation without payment of a customary licensing fee. <(Even if the unauthorized use of plaintiff's work in the televised program might increase poster sales, that would not preclude her entitlement to a licensing fee. *See DC Comics*, 696 F.2d at 28.)>

The second consideration confuses lack of one item of specific damages with lack of adverse impact on a potential market. *See Nimmer* § 13.05[A][4], at 13-187. Ringgold is not required to show a decline in the number of licensing requests for the "Church Picnic" poster since the ROC episode was aired. The fourth factor will favor her if she can show a "traditional, reasonable, or likely to be developed" market for licensing her work as set decoration. Certainly "unrestricted and widespread conduct of the sort engaged in by the defendants ... would result in substantially adverse impact on the potential market for [licensing of] the original." *Campbell*, 510 U.S. at 590 (internal quotation omitted). Particularly in view of what Ringgold has averred and is prepared to prove, the record on the fourth fair use factor is inadequate to permit summary judgment for the defendants. *See id.* at 593-94. ~

The judgment of the District Court is reversed, and the case is remanded.

-|-|-|-

G.3. Gottlieb Development LLC v. Paramount Pictures (S.D.N.Y. 2008)

Pre-reading notes

This case involves the romantic comedy *What Women Want* (Paramount Pictures, 2000) in which actor Mel Gibson plays Nick, an advertising executive who is a seemingly incurable male chauvinist pig. Nick's sexist bent suddenly becomes a liability when he must come up with an ad campaign that will appeal to a female demographic.

Owing to a concatenation of improbable circumstances, mild household electrocution, and a powerful bolt of plot energy, Nick undergoes a magical transformation. (You know, like getting bit by a radioactive spider or having a moment of jinxed exasperated pique which causes a parent/child body switch.) In this particular flash of character-arcing voltage, Nick obtains the sudden superpower to hear women's private thoughts. The remainder of the movie is unswervingly dedicated to making audiences think this is not quite so horrifyingly creepy as it so obviously is. Sadly, Nick and his cohort never fully succeed in this quest – at least, that is, judging by the 53% on Rotten Tomatoes.

At any rate, in one of his first outings with his newfound single-gender-channel telepathic audio feed, Nick enters a pitch meeting with his new female boss Darcy, played by Helen Hunt. The conferencing space is whimsically and lavishly decorated to juice ad-exec creativity with vivid wall flair and an assortment of arcade amusements. As Nick goes about the delicate task of stealing ideas from his female colleagues so he can win the account without hitting the red line of creepitude, Nick stands up, sits down, leans forward and leans back, all in front of a pinball machine.

The pinball machine – a "Silver Slugger" by Gottlieb – is resplendently graphic-wrapped up one side and down the other in sparklingly copyrightable expression. So Gottlieb pulls back the plunger and sues – and in the Second Circuit no less, where the district court would be bound by *Ringold v. BET*. But to Gottlieb's button-mashing disbelief, their silvery copyright claim rolls straight between their fitfully flailing flippers.

Opinion

Edited opinion by James Grimmelmann. *Credit and licensing notes:* This edited version of the following judicial opinion, not including the text preceding the judge's words, is by James Grimmelmann, obtained from James Grimmelmann, Patterns of Information Law: Intellectual Property Done Right (version 1.1, August 2017). I understand the correct copyright notice to be: © 2017 James Grimmelmann. The book is licensed under the Creative Commons Attribution International License 4.0 (CC-BY 4.0) license, available at https://creativecommons.org/licenses/by/4.0/. That license contains a disclaimer of warranties and a statement of limitation of liability. The original work is available at https://james.grimmelmann.net/ipbook/. I made formatting changes, including to typography, pagination, paragraph styling, etc. Italicization may differ. I appended the court's appendices.

Gottlieb Development LLC v. Paramount Pictures Corp.

590 F. Supp. 2d 625 (S.D.N.Y. 2008)

In the motion picture "What Women Want," released by defendant Paramount Pictures Corporation in 2000, Mel Gibson plays an advertising executive who acquires the ability to "hear" what women are thinking. In one scene, Gibson and his co-star Helen Hunt brainstorm with other employees to develop ideas for marketing certain consumer products to women. At various points during the scene, a pinball machine – the "Silver Slugger" - appears in the background. The Silver Slugger is distributed by plaintiff Gottlieb Development LLC, and Paramount used the pinball machine in the scene without Gottlieb's permission.

The Silver Slugger features three original designs (the "Designs"): (1) a depiction of a baseball diamond on the backglass, which is the upright back portion of the pinball machine; (2) another baseball diamond on the playfield, which is the playing surface of the machine; and (3) the layout of the parts of the playfield. The Designs are copyrighted, and Gottlieb has owned the copyrights since 1998.

The legal maxim "*de minimis non curat lex*" – "the law does not concern itself with trifles" – applies in the copyright context. For example, if the copying is *de minimis* and so "trivial" as to fall below the quantitative threshold of substantial similarity, the copying is not actionable.

There is no plausible claim of copyright infringement here. Although Gottlieb has sufficiently pled unauthorized copying of its Designs, the

use of the Silver Slugger was *de minimis* as a matter of law. Hence, no reasonable juror could find substantial similarity in the legal sense, and thus the copying is not actionable.

The scene in question lasts only three-and-a-half minutes, and the Silver Slugger appears in the scene sporadically, for no more than a few seconds at a time. More importantly, the pinball machine is always in the background; it is never seen in the foreground. It never appears by itself or in a close-up. It is never mentioned and plays no role in the plot. It is almost always partially obscured (by Gibson and pieces of furniture), and is fully visible for only a few seconds during the entire scene. The Designs (on the backglass and playfield of the pinball machine) are never fully visible and are either out of focus or obscured. Indeed, an average observer would not recognize the Designs as anything other than generic designs in a pinball machine.

Gottlieb cites to *Ringgold v. Black Entertainment Television, Inc.* in support of its claim, but the facts of that case are inapposite. *Ringgold* involved the unauthorized use of a copyrighted poster in an episode of a HBO television series. The poster was shown, in whole or in part, nine times during a five-minute scene at the end of the episode. The poster (or a portion thereof) was seen for 1.86 to 4.16 seconds at a time, for a total of 26.75 seconds. In some instances, the poster appeared at the center of the screen. As the Second Circuit held, the poster was "plainly observable."

More importantly, there was a qualitative connection between the poster and the show. The poster included a painting depicting a Sunday School picnic held by the Freedom Baptist Church in Atlanta, Georgia, in 1909, and was intended to convey "aspects of the African-American experience in the early 1900s." The show was "ROC," a television "sitcom" series about a middle-class African-American family living in Baltimore, and the scene in question was of a gathering in a church hall with a minister. The Second Circuit noted that HBO's production staff "evidently thought that the poster was well suited as a set decoration for the African-American church scene of a ROC episode." The Second Circuit concluded:

> From the standpoint of a quantitative assessment of the segments, the principal four-to-five second segment in which almost all of the poster is clearly visible, albeit in less than perfect focus, reenforced by the briefer segments in which smaller portions are visible, all totaling 26 to 27 seconds, are not *de minimis* copying. The painting component of the poster is recognizable as a painting, and with sufficient observable detail for the "average lay observer" to discern African-Americans in Ringold's colorful, virtually two-dimensional style. The *de minimis* threshold of actionable copying of protected expression has been crossed.

In the present case, the "average lay observer" would not be able to discern any distinctive elements of Gottlieb's Designs - the baseball players clad in stylized, futuristic gear. The best that the average lay observer could make out in the background is a typical home-plate layout with baseball players arrayed around it. The unique expressive element of the Designs is not discernable in those brief moments when the backglass is visible. The only other protected element of the backglass is the "Silver Slugger" logo in the upper left hand corner, which is glimpsed fleetingly, and in poor focus, during the scene. The camera sweeps past the logo without dwelling or focusing on it. The average lay observer would not discern the stylized aspects of the logo attributable to Gottlieb based on the way the logo appears in the background of the scene.

Moreover, while use of a copyrighted work in the background may still be a basis for an infringement claim, where the use is *de minimis*, the copying will not be actionable, even where the work was chosen to be in the background for some thematic relevance. As the Second Circuit explained in *Ringgold*, "in some circumstances, a visual work, though selected by production staff for thematic relevance, or at least for its decorative value, might ultimately be filmed at such 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." Here, undoubtedly the Silver Slugger was chosen by the production staff because it fit in with the "sporty" theme of the background in the scene; but the Silver Slugger was one of numerous

background items, and it was filmed in such a manner and appears so fleetingly that I conclude there is no plausible claim for copyright infringement here. Accordingly, Gottlieb's copyright infringement claim is dismissed

–|–|–|–