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### Copyrighting the Blues - Fair Use or Infringement?

by Robert S. Lawrence, Senior Associate, Callahan & Blaine

**R**emember *Kind of Bloop*, the 8-bit tribute to Miles Davis' *Kind of Blue* produced by Andy Baio last year? Baio went to great lengths to ensure the entire project was non-infringing, licensing all the cover songs from Miles Davis' publisher and giving all profits to the musicians who participated in the project.

However, he neglected to vet one thing no one thought would be an issue: the cover art.

After unsuccessfully attempting to create a tribute cover on his own, Baio had a friend do a pixel art recreation of the original album cover, a sort of hip rendition of the originally hip (and now iconoclastic) photograph by New York photographer Jay Maisel. If you are a fan of Miles Davis and are of an age to remember when there were such things as albums, undoubtedly the album cover will ring a bell.



Shortly after the tribute album was released, Baio was contacted by Maisel's lawyers, who asserted that the pixelated cover infringed on Maisel's copyright. They sought statutory damages of up to \$150,000 for each infringement, plus attorney's fees, or – in the alternative – actual damages and all profits attributed to the unlicensed use of the photograph. Rather than contest the issue, after extended negotiation the parties reached a settlement whereby Baio agreed to pay Maisel \$32,500 and voluntarily agreed to stop using the pixelated artwork. As is typical, the settlement agreement contains the standard recitation that neither party admits fault and thus the question of whether the pixelated tribute cover is "fair use" was never addressed nor decided.

Though one can understand why Baio would settle in the face of enormous potential damages and the certainty of significant legal fees, the settlement fails to bring any clarity to a debate that has been played out in various iterations for years between artists and copyright holders, and leaves artists involved in digital reinterpretations of copyrighted works in a state of perpetual anxiety. Is Baio's pixelated art "fair use" under the copyright laws, or infringement?

Unfortunately, there is no straightforward answer to this question. While there is an abundance of information (perhaps an overabundance) about the doctrine of "fair use" available on the web and in legal treatises, the concept itself has created significant disagreement between attorneys and jurists, who have been unable to agree on a clear definition of the phrase. The doctrine itself is intrinsically ambiguous and continually reinterpreted by new caselaw.

In determining whether an artist's rendition of an existing work constitutes "fair use," the courts consider four main factors:

- (a) The purpose and character of the use: Was the original work transformed into something new or was it copied in its entirety?
- (b) The nature of the copyrighted work;
- (c) The amount and substantiality of the portion taken;
- (d) The effect of the use upon the potential market for the original work.

The crux of the disagreement between Baio and Maisel turned on the first factor – whether the *Kind of Bloop* cover art was "transformative" or not. Stanford's Fair Use Center poses the question the artist must ask himself in this way: "Has the material you have taken from the original work been transformed by adding new expression or meaning? Was value added to the original by creating new information, new aesthetics, new insights and understandings?" Arguably, Baio's tribute to *Kind of Blue* satisfied the test of transformative use both from an objective and subjective point of view.

Taking art from one medium and repurposing it in another is a seminal type of transformative "fair use." Baio's use of Maisel's photograph arguably was transformative in the same way that Jeff Koons' use of a photo of Gucci sandals in his painting *Niagara* was found to add "something new, with a further purpose or different character, altering the first with new expression, meaning, or message." In Koons' case, he digitally scanned a photo and incorporated it into his painting *Niagara* as one of four pairs of legs depicted. He used only the legs – discarding the background of the airplane cabin and the man's lap on which the legs rested. He also inverted the orientation of the legs so that they dangled vertically downward rather than slanting upward at a 45-degree angle as they appear in the photograph. He added a heel to one of the feet, and modified the colors. The Second Circuit Court of Appeals found that the alterations to the original photograph were significant enough to constitute a "transformation," and thus deemed the use to be "fair." In Baio's case, the argument put forward is that rendition of the cover art in pixelated form is a distinct medium, and that the transformation from photograph to pixelation is inherently transformative.

The second fair use factor is the nature of the copyrighted work. Works that are factual tend to be deemed fair use (e.g., publishing a photograph in the context of criticism is fair use); works that are creative in a way that impinges on an author's derivative rights (e.g., writing an unauthorized sequel to *The Catcher in the Rye*) tend to be deemed infringing. Maisel's photograph is creative, but also primarily documentary in nature. Baio's argument was that the pixelated cover art was a sort of homage to the original that evoked it, without treading on Maisel's intellectual property rights.

With regard to the third factor, although the illustration does represent the cover of *Kind of Blue*, it does so at a dramatically reduced resolution that incorporates few of the photograph's protectable elements. While courts routinely find fair use even where the entirety of an image is used if the transformation is significant, this is the most troubling aspect of Baio's argument, as the pixelated version uses the same composition and colors, as well as other identifiable aspects of the photograph. The reduction in resolution is not so dramatic as to render the subject unrecognizable, and thus is problematic. If it had been further reduced by several factors so that it resembled not so much pointillism as modern art, Baio would have been on stronger footing.

The fourth factor analyzes the impact of the alleged copycat product on the value of the original work. In Baio's case, it is self-evident that the cover art for the tribute album does not impinge on the market for the original work. It is merely a low-resolution artistic rendering in 8-bit computer graphics that, if anything, engenders interest in the original and reminds the public of its existence. To the extent there is an aftermarket for the photograph it is difficult to conceive that this market would be affected in any meaningful way.

As a practical matter, of course, the analysis of whether the "transformative" use of someone else's work is "fair" is in many cases besides the point. If your creation is inspired by copyrighted material, even if it seems clear to you (as the creator) that the use is transformational, you run the risk of having a copyright infringement suit filed against you. If your proposed use is commercial, you would be well advised to seek permission from the original owner of the work or be prepared to defend yourself in court. You would also be well advised to have your lawyers vet your proposed project before it sees the light of day. Regardless of how strong your argument for transformative use may be, anyone can file a lawsuit and the costs of defending a copyright lawsuit are significant. In the face of vague standards and conflicting court opinions, anyone attempting to use or reference copyrighted works as part of their own art, graphics, web design or any other visual medium must consider the possible consequences of their actions prior to publication.

After publication, your arguments are likely to fall on deaf ears.

#### Robert Scott Lawrence

Robert Scott Lawrence is a senior trial attorney with Callahan & Blaine who specializes in intellectual property litigation, including copyrights, trademarks, patents, and trade secrets. Callahan & Blaine is known and respected as "California's Premier Litigation Firm." Callahan & Blaine has obtained record-breaking verdicts and settlements including a \$934 million jury verdict in a complex litigation trial. For more information, please feel free to visit the firm's website at [www.callahan-law.com](http://www.callahan-law.com) or call (714) 241-4444.



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