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**Citation:** Bonadio, E. (2018). Street Art, Graffiti and Copyright. In: Bonadio, E. and Lucchi, N. (Eds.), *Non-Conventional Copyright – Do New and Atypical Works Deserve Protection?* (pp. 83-110). Cheltenham: Edward Elgar. ISBN 1786434067

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**Link to published version:** <http://dx.doi.org/10.4337/9781786434074.00012>

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## {cn}4. {ct}Street art, graffiti and copyright

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### {a}1. INTRODUCTION

This chapter examines to what extent street and graffiti art can be protected by copyright law. Although the focus will be on US law and to a lesser extent UK law,<sup>1</sup> a few references will also be made to how these forms of art are regulated in other jurisdictions.

Graffiti refers to a technique of painting names and letters on various urban surfaces, such as tube and railway trains as well as walls. The graffiti movement first started in Philadelphia and New York City in the late 1960s and early 1970s, evolved into a proper form of art through the 1970s, and then spread to other cities and countries in the world. The term ‘street art’ is instead used to define more elaborate forms of art, which have both evolved from the early graffiti movement by focusing on images rather than letters and developed independently by building upon, and mixing with, established artistic movements such as muralism. Street artists may nowadays use a variety of tools to paint and draw: not only spray cans, but also traditional instruments such as brushes, rollers and palettes as well as marker pens, chalks and charcoal. Ways of placing art in the street may also take forms different from painting such as attaching mosaic tiles, stickers and posters on walls as well as abandoning artworks.

Street artworks are often produced illegally, namely without the authorization of the owner of the property where they are placed, which can expose artists to serious legal consequences including jail time. Yet, as opposed to the early days of these artistic movements (especially graffiti) when most works were done illegally, many street and graffiti artists nowadays produce their pieces legally. Also, city authorities, private property owners

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\* The initial research which eventually led to this chapter was carried out at CUNY Law School in New York City in the autumn of 2016.

<sup>1</sup> I have provided an expanded legal analysis of these issues under UK law in Copyright Protection of Street Art and Graffiti under UK Law, 2 Intellectual Property Quarterly 188–220 (2017).

and businesses often make available spaces where street and graffiti art is tolerated and artworks change regularly.

Communities' interest in preserving street artworks is also growing, especially when they are created by famous artists, whose pieces are often protected by Perspex covers. The expanding interest in street art and graffiti is confirmed by the high number of magazines and websites dedicated to these forms of art; and by the many street art tours offered in several cities around the world to admire pieces which – it is often noted – end up beautifying and revamping local neighbourhoods.

Street art has also become a hot commodity. Due to their increasing popularity, works by renowned street artists such as Banksy are often offered for sale in galleries and reproduced (with or without their authorization) on products as diverse as posters, clothes, bags, mugs and home furnishing as well as on canvases and prints sold in popular street markets as well as the Internet. They are also increasingly commissioned and used as a backdrop in TV series, commercial ads and music videos or to promote products.

This graffiti and street art boom has attracted attention from advertisers and marketing gurus in their pursuit of new commercial ideas and attempt to give their products an 'aura' of street credibility; indeed, cases of unauthorized exploitation of urban creativity are increasing alarmingly, especially in certain industries, including fashion,<sup>2</sup> fast food<sup>3</sup> and entertainment.<sup>4</sup>

In the following paragraphs I will expand on whether copyright law is capable to protect street and graffiti artworks, also taking into account the (often) conflicting rights of the owners of the property upon which the works are placed. There have been thus far few reported decisions, especially by US courts, on copyright and moral rights protection of these forms of art. This is probably due to the fact that disputes in this field are usually settled out

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<sup>2</sup> See for example Donald Robbins, *Noah Daar v Oakley Inc*, Docket No [2:18-cv-05116-PA-KS](#); *H&M v Jason Williams a/k/a Revok*, Docket No. 1:18-cv-01490; *Jason Williams et al. v. Roberto Cavalli, S.p.A. et al.*, Docket No. 2:14-cv-06659 (C.D. Cal. Aug 25, 2014), Court Docket; *Joseph Tierney v. Moschino S.p.A. et al.*, Docket No. 2:15-cv-05900 (C.D. Cal. Aug 05, 2015), Court Docket; *Anasagasti v. American Eagle Outfitters, Inc.*, No. 1:14-cv-05618-ALC (S.D.N.Y. July 23, 2014).

<sup>3</sup> See amongst other cases, *Jade Berreau v. McDonald's Corporation et al.*, 2:16-cv-07394 (Central District of California).

<sup>4</sup> See for example *Franco Fasoli et al v. Voltage Pictures LLC et al.*, No. 2:15-cv-00889 (C.D. Cal. Feb 06, 2015); *Hayuk v. Sony*, No. 1:14-cv-06659 (S.D.N.Y. Aug. 19, 2014).

of court. After all, this seems to be the rule in most cases regarding art.<sup>5</sup> This chapter, in particular, will investigate to what extent certain copyright law provisions and case law apply to various types of art placed in urban environments, particularly paintings on walls and other urban surfaces. It will focus on the following selected aspects: (i) subject matter and requirements for protection; (ii) moral rights, with a particular focus on the integrity right; and (iii) illegal artworks.

## {a}2. SUBJECT MATTER AND REQUIREMENTS FOR PROTECTION

Most forms of art placed in the streets such as murals, stickers, posters, mosaics and abandoned objects certainly fall within the category of artistic works under most national laws.<sup>6</sup> They are therefore within the scope of copyrightable subject matter.

Many street artworks are created relatively quickly. Take stencil art, which is a technique for reproducing designs and patterns by passing spray-paint or ink over holes cut in cardboard or metal onto the surface to be decorated: it allows the preliminary creative activity to be carried out in studio and the actual work to be subsequently placed on the street in a relatively quick way, which also minimizes the risk of possible arrest if the piece is created illegally. Banksy himself noted that the reason why at some point in his career he started focusing on stencils was to drastically reduce the time required for placing pieces on the street and thus reduce the risk of being noticed by the police.<sup>7</sup> The fact that some street artworks may be rapidly created and placed in the chosen location (sometimes it is just a matter of a few seconds) does not stand in the way of their copyrightability. Indeed, in most jurisdictions the time taken to create the work is not relevant for copyright purposes.

### {b}2.1 Fixation

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<sup>5</sup> See Molly Torsen Stech, *Artists' Rights: A Guide to Copyright, Moral Rights and Other Legal Issues in the Visual Art Sphere* (Institute of Art & Law, 2015) xi.

<sup>6</sup> See for instance 17 U.S. Code § 102(a)(5) (providing that copyrightable works of authorship include 'pictorial, graphic, and sculptural works'); Section 4 of the Copyright, Designs and Patents Act (CDPA) 1988 (stating that the category of artistic works includes graphic works, photographs, sculptures or collages, irrespective of artistic quality. It also specifies that the category of 'graphic works' includes paintings, drawings and other visual artworks).

<sup>7</sup> Banksy, *Wall and Piece* (Century 2005) 13.

Most street and graffiti artworks are ephemeral as they disappear relatively promptly. They may be removed by the owner of the property upon which they are placed; they may be painted over by local councils that want to keep clean the neighbourhood; or they may end up being vandalized. Artworks may also deteriorate and eventually vanish just because of the passing of time and the effect of the elements.

Could the transient nature of these forms of art be an obstacle that prevents their copyright protection? One may answer in the affirmative by remembering that works should be fixated in a medium to be considered copyrightable. In the US, for example, copyright subsists in works of authorship ‘fixed in any tangible medium of expression’,<sup>8</sup> this provision being in line with the Berne Convention, which allows states to provide that works shall not be protected ‘unless they have been fixed in some material form’.<sup>9</sup> Yet, this objection would be rather weak, as such a fixation requirement only demands that the work is ‘sufficiently permanent or stable’ to allow it ‘to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration’. Although street and graffiti artworks may not last for a long time, their temporary existence appears to be sufficient to satisfy this requirement.<sup>10</sup>

A similar point could be made under UK law. Although in *Merchandising Corporation of America v. Harpbond*<sup>11</sup> it was held that the facial make-up of the pop artist Adam Ant did not constitute a painting for the purpose of copyright (‘if the marks are taken off the face there cannot be a painting. ... a painting without a surface is not a painting’), subsequent case law seems to have made the transient or permanent fixation of the work on a surface a less important issue. In *Metix Ltd v. G.H. Maughan*<sup>12</sup> for example it was suggested

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<sup>8</sup> See 17 US Code § 102; see also Section 3(2) of the UK Copyright, Designs and Patents Act 1988, which provides that literary, dramatic and musical works must have been fixed in a tangible form before copyright can subsist.

<sup>9</sup> Section 2(2) of the Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, as revised at Paris on July 24, 1971, and amended in 1979, S. Treaty Doc. No. 99-27 (1986) [hereinafter ‘Berne Convention’].

<sup>10</sup> See also Chapter 6 ‘Copyright in Culinary Presentations’, authored by Cathay Smith (making a similar point in relation to food creations, and noting that despite contrary case law such creations are fixed for a period more than a transitory duration when they are first made).

<sup>11</sup> *Merchandising Corp. of America Inc. & ors v. Harpbond Ltd & Ors* [1983] FSR 32 (CA).

<sup>12</sup> *Metix (UK) Ltd v. G.H. Maughan (Plastics)* [1997] FSR 718.

that an ice sculpture, although obviously not permanent, should in principle be protected as a three-dimensional work made by an artist's hand.<sup>13</sup> What *Metix* entails is that not just a permanent materialization, but also an ephemeral fixation, of the tangible medium would suffice for copyright subsistence purposes. And what has been suggested in this case may easily apply to most street art and graffiti scenarios, even more so in light of the recent judicial developments at European Union (EU) level.<sup>14</sup> Indeed, under EU law and in particular in light of the *Infopaq* decision,<sup>15</sup> anything that constitutes an intellectual creation should be protected by copyright.

But even if it is eventually accepted that a permanent fixation is required to attract copyright, it could still be argued that taking photographs of street art and graffiti (which is common practice, within these communities, to 'preserve' the relevant artworks) could help in meeting this requirement.<sup>16</sup>

## **{b}2.2 Originality**

All copyrightable works must be original.<sup>17</sup> There is no doubt that many, if not most, street and graffiti pieces satisfy the originality requirement, whether we apply the originality test

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<sup>13</sup> See also Lionel Bently and Brad Sherman, *Intellectual Property Law*, 4th edn (OUP, 2014) 92.

<sup>14</sup> It is not unlikely that even after the UK leaves the EU in March 2019, several pieces of EU legislation, including copyright-related directives, and CJEU decisions may still be applicable and relevant in the UK (directly or indirectly) for several years.

<sup>15</sup> Case C-5/08, *Infopaq Int'l A/S v. Danske Dagblades Forening*, 2009 E.C.R I-6569).

<sup>16</sup> Marta Iljadica, *Copyright Beyond Law: Regulating Creativity in the Graffiti Subculture* (Bloomsbury, 2016) 103. For a contrary opinion on whether photographed works satisfy the fixation requirement, see Megan M. Carpenter & Steven Hetcher, *Function Over Form: Bringing the Fixation Requirement into the Modern Era*, 82 *Fordham L. Rev.* 2221 (2014) (noting that the photographed work remains unfixed for copyright purposes and that any 'fixation of the piece ... is merely representational of the piece rather than the piece itself').

<sup>17</sup> See 17 U.S. Code § 102, which provides that 'Copyright protection subsists ... in original works of authorship'. Similarly, Section 1(1)(a) of the UK Copyright, Designs and Patents Act 1988 states that 'Copyright is a property right which subsists ... in the following descriptions of work – (a) *original* literary, dramatic, musical or artistic works ...' (emphasis added).

under US law (as affirmed in the seminal case *Feist v. Rural*),<sup>18</sup> the UK ‘skill, labour and judgment’ standard,<sup>19</sup> or other originality requirements, such as the EU ‘intellectual creation’ test.<sup>20</sup> A quick look at the many pieces painted on our cities’ walls is enough to confirm that.

While most street and graffiti artworks are certainly original, one may note that the so-called tags and throw-ups lack a sufficient level of originality, and in general are too trivial to attract copyright protection.

What are tags? Tags are street signatures painted or drawn by graffiti writers on walls and other urban surfaces, and may be executed in condensed calligraphic form (see Figure 4.1). They represent the writer’s chosen name, and epitomize a strong desire to be recognized and appreciated within the subculture.



Source: Photograph by Serk.

Figure 4.1 Tag by Serk (New York City, 2003)

In graffiti jargon the term throw-up – which also represents the artist’s name – refers to a one colour outline and one layer of fill-colour, painted in bubble style letters: it is basically an evolution of the tag (see Figure 4.2).

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<sup>18</sup> In *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991) the US Supreme Court explained that the requirement of originality is not particularly stringent and is comprised of two elements: that the work be independently created by the author (as opposed to copied from other works) and that it possesses at least some minimal degree of creativity.

<sup>19</sup> See for example *Ladbroke v. William Hill* [1964] 1 All E.R. 465, 469 (Eng.).

<sup>20</sup> See also Marta Iljadica, *Graffiti and the Moral Right of Integrity*, 3 *Intell. Prop. Q.* 266, 268 (2015).



*Source:* Photograph by Serk.

*Figure 4.2 Tag throw-up by Serk (New York City, 2005)*

As mentioned, one may have doubts about the originality of tags and throw-ups, and point to the regulations of the US Copyright Office which clarify that ‘words ... such as names ... lettering’ are examples of works not protected by copyright and that applications for registration of such works cannot be entertained.<sup>21</sup> And indeed the graffiti-style words ‘Skate Key’ designed by the famous Bronx-based writer Tracy 168 were denied registration by the copyright office.<sup>22</sup>

What if tags or throw-ups are made in a highly stylish way? Indeed, many writers develop and perfect over the years their own lettering style: a style which derives from countless hours of perfecting the image, even if the final image may appear to members of the

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<sup>21</sup> US Copyright Office 37 C.F.R.

<sup>22</sup> As pointed out by Judge Mukasey in *Tracy v. Skate Key, Inc.*, 697 F. Supp. 748 (S.D.N.Y. 1988).

general public less than perfect.<sup>23</sup> Even tags and throw-ups which to an untrained eye and those outside the graffiti subculture happen to seem banal, meaningless and always similar may be considered sufficiently original instead.<sup>24</sup> As has been correctly noted, the assessment of their originality should be carried out by taking into account a specialized audience, namely the graffiti community, whose members are able to distinguish and appreciate differences and peculiarities, which people outside the scene cannot do.<sup>25</sup>

Also, the support on which tags and throw-ups are inserted and viewed (for example, a rubbish bin) may influence our assessment of their originality. Instinctively (and perhaps wrongly) one may be more inclined to recognize the same graffiti signature as being artistic if one sees it on a canvas or a print. Yet, such assessment would be biased as it would be based on a prejudice, namely that only certain objects can be the support of artistic outputs. That does not seem correct, also taking into account that the medium on which works are placed is not, and should not be, conclusive for the purposes of copyright subsistence.

But what is copyright judges' stance when it comes to the originality of graffiti-based lettering? An interesting US case has dealt with this issue, namely *Reece v Mark Ecko Unlimited*.<sup>26</sup> The artist Reece sued a videogame producer over the use of a stylish version of the word 'Dip' in a graffiti-inspired game. The work was created in 1972 by Reece and also

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<sup>23</sup> Mark Halsey & Alison Young, 'Our Desires Are Ungovernable': Writing Graffiti in Urban Space, 10 *Theoretical Criminology* 275, 294 (2006).

<sup>24</sup> After all, legal actions to react against the misappropriation of graffiti lettering are increasingly being considered: see for example the recent suit brought by the partner of the deceased graffiti artist Dash Snow against the fast food chain McDonald that had reproduced the artist's throw-up on the walls of hundreds of their restaurants (*Jade Berreau v. McDonald's Corporation*, complaint filed on 3 October 2016 at the US District Court Central District of California, Western Division). The legal action, however, was not successful on procedural grounds.

<sup>25</sup> Iljadica, *supra* note 16, at 152 (also proposing a comparison between graffiti and engineering drawings: the decision on whether the latter are to be considered original or not – Iljadica stresses – should depend on their significance to the category of persons to whom such drawings are addressed, namely engineers, as confirmed by the UK case *Billhofer Maschinenfabrik GmbH v. T H Dixon & Co Ltd* [1990] FSR 105).

<sup>26</sup> *Reece v. Mark Ecko Unlimited*, 2011 U.S. Dist. Lexis 102199 (2011), fn. 1.

registered with the US copyright office (which seems to confirm that stylish lettering may be considered sufficiently original and thus copyrightable).<sup>27</sup> Judge Debra Freeman confirmed that “DIP” was Reece’s “tag” as a graffiti artist; in other words, that he used it as his personal identifying mark’. Also, even though the judge did not find infringement in light of some differences between the tag and the image used in the videogame, she nonetheless made some interesting points that could be relied on to support the argument that stylish tags and throw-ups can be considered as sufficiently original and therefore copyrightable. Judge Freeman in particular noted:

{quotation}the form of the lettering at issue is arguably central to the artistic expression of particular words. In this unusual context, aspects of the lettering shown in the Reece art, such as the degree of abstraction of the letters, the connectivity of the letters, the relative size of the letters ... may reveal the artist’s personal style and strongly influence the ‘total concept and feel’ of the subject works.{/quotation}

{quotation}... although the words ‘Dip’ and ‘Dipism’ are not themselves subject to copyright protection, the original manner in which Reece expressed these words is protectable.{/quotation}

UK courts have not decided copyright cases expressly dealing with graffiti lettering. They have instead dealt with lettering style in general, and in some cases found that the rendition was sufficiently original. For example, in *IPC Magazines Ltd v. MGN Ltd*<sup>28</sup> it was found that the claimant’s stylized version of the word ‘Woman’ in white on a red background was arguably copyrightable. Also, in *Future Publishing v. Edge Interactive Media*<sup>29</sup> the judge expanded on the lettering style of the word ‘Edge’ and confirmed that the latter was artistic and original.<sup>30</sup>

What the above points and findings seem to confirm is that lettering renditions (including stylish tags and throw-ups) can be considered works of art. So why should we deny

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<sup>27</sup> Reg. no VAu001035632/2010-06-01.

<sup>28</sup> *IPC Magazines Ltd v. MGN Ltd* [1998] FSR 431.

<sup>29</sup> *Future Publishing Ltd v. Edge Interactive Media Inc.* [2011] EWHC 1489 (Ch.).

<sup>30</sup> For a similar finding see *R Griggs Group v. Evans* [2003] EWHC 2914 (Ch), para 18 (holding that ‘if an artist uses his skill and labour to draw a word or a phrase in a stylised way, as in the case of a logo, his drawing is capable of being an original work, protected by copyright law’).

them copyright protection? After all, the concept of artistic works, and of art more generally, is a broad one. Much material depicted visually with a modicum of creativity, by whatever means, may be nowadays interpreted as artistic.<sup>31</sup>

### **{c}2.2.1 The ‘typeface’ comparison**

The point could also be made that tags and throw-ups are comparable to typefaces,<sup>32</sup> namely sets of letters and numbers which are all in the same style and are used in printing. Yet, under US law typefaces are not copyrightable because – it is often noted – they perform the function of building blocks of language and their aesthetic element cannot be conceptually separated from their functional element, which in this case is to graphically represent the letters of the alphabet.

The non-copyrightability of typefaces in the US has been criticized, however. Typeface designers may indeed exercise significant creativity and come up with highly artistic letters;<sup>33</sup> and this can occur despite the constraints of the design process, which does not just dictate the function of creating letters, but also leaves room for a significant dose of artistic genius. Making copyright available for such non-functional aspects of the letter, therefore, does not seem heretical. That typefaces may have (copyrightable) artistic elements in addition to (uncopyrightable) functional features is confirmed by international law. The Vienna Agreement for the Protection of Typefaces and their International Deposit, signed in 1973 by 12 countries including UK, Germany, France, Italy and the Netherlands (but never entered into force) requires typefaces to be protected by either copyright or industrial design law, or a sui generis right; and it clarifies that what cannot be protected are just typefaces of a

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<sup>31</sup> Catherine Colston & Jonathan Galloway, *Modern Intellectual Property Law* 305, 3rd edn (Routledge, 2010).

<sup>32</sup> See Nicole A. Grant, *Outlawed: Finding a Home for Graffiti in Copyright Law*, *Selected Works of Nicole A. Grant* (2012) 24, available at <http://ssrn.com/abstract=2030514> (last visited June 20, 2018). On copyright protection of typefaces in general see Chapter 13 of this book, authored by Arul George Scaria and Mathews P. George.

<sup>33</sup> Jacqueline D. Lipton, *To © or Not to ©? Copyright and Innovation in the Digital Typeface Industry*, 43 U.C. Davis L. Rev. 143, 155 (2009).

form dictated by purely technical requirements.<sup>34</sup> UK law also considers typefaces as copyrightable, as is indirectly confirmed by Sections 54 and 55 of the CDPA, which assume and take for granted such protection.<sup>35</sup>

As with typefaces, also letters painted by graffiti artists (so as to form their names) often have strong non-functional and artistic elements, which go beyond serving the neutral function of representing the letters themselves. Such artists develop and practise their style by individualizing and transforming the alphabet, and frequently making the letters and the entire word unreadable to people outside the subculture. As has been correctly pointed out, copyright should be made available when the graffiti lettering does not only consist of alphanumeric elements, but it is also elaborate, personalized and extravagant enough to be perceived and appreciated as an artistic endeavour.<sup>36</sup>

### **{b}2.3 Single Words and Short Phrases**

Issues of originality may also be raised by a specific category of street artworks, namely those which consist of just a written word or short phrases. Such works are popular with several street artists. Take for instance John Fekner, a street and multimedia artist, who in the late 1970s and early 1980s created hundreds of environmental, social, political and conceptual works consisting of stencilled words spray painted outdoors; or again Banksy who is known for stencilling sarcastic and anti-conformist phrases on walls and other surfaces.<sup>37</sup>

In the US these works are not copyrightable, presumably because they are not considered original enough. The regulations of the US Copyright Office Code are clear in this regard: ‘The following are examples of works not subject to copyright and applications for

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<sup>34</sup> Article 2(i)(c) of the Vienna Agreement for the Protection of Type Faces and Their International Deposit and Protocol Concerning the Term of Protection, June 12, 1973, Records of the Vienna Diplomatic Conference on the Protection of Typefaces 1973, at 10 (W.I.P.O. 1980).

<sup>35</sup> Section 54 exempts from copyright infringement certain activities in relation to what is defined as ‘an artistic work consisting of the design of a typeface’. Section 55 uses an identical wording.

<sup>36</sup> Grant, *supra* note 32, at 23.

<sup>37</sup> Take Banksy’s iconic phrase ‘This is not a photo opportunity’, stencilled on several places such as the Palace of Westminster in London, the Eiffel Tower in Paris and the Sydney Opera House. See Banksy, *supra* note 7, at 122–3.

registration of such works cannot be entertained: (a) Words and short phrases such as ... titles, and slogans'.<sup>38</sup>

Not only doubts about a sufficient level of originality could be raised when it comes to street words or messages: for example, in the UK relevant case law on the *de minimis* rule<sup>39</sup> could also stand in the way of their copyrightability. Yet, in light of the more recent *NLA v. Meltwater* case<sup>40</sup> (where the court found that newspapers' headlines could be considered as original literary works and thus copyrightable), it could now be argued that certain sentences can also attract copyright in the UK.

### {a}3. MORAL RIGHTS

I now proceed to analyse whether and to what extent moral rights, in particular the integrity right, can be invoked by street and graffiti artists.

#### {b}3.1 Paternity Right

The paternity right allows authors to claim to be recognized as the creators of their works. It seems this right fits well into street and graffiti art scenarios, as within these subcultures there is a strong bond between the artist and her work: the former strongly identifies herself within the latter. The tag, the character, the sticker, the poster or the whole piece of art created and placed in the street often represent a projection of the artist herself. This bond is confirmed by the frequent inclusion of the artist's name next to, or in, the work.

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<sup>38</sup> US Copyright Office 37 C.F.R.

<sup>39</sup> The principle *de minimis non curat lex* means that the work is so insignificant and trivial that it does not deserve copyright protection, and in general that the law does not concern itself with trifles. For example, in *Synamide v. La Maison Kosmeo* (1928) 139 LT 265 it was held that to quote the slogan 'Beauty is a social necessity, not a luxury' was too small a matter on which to ground a copyright infringement action. Moreover, in *Francis Day & Hunter v. Fox* [1940] AC 112, it was held that the song title 'The Man Who Broke the Bank at Monte Carlo' was not sufficiently substantial for copyright purposes. After all, doubts about whether short sentences or words can be protected by copyright have also been expressed in relation to traditional paintings on canvases: see Anne Barron, *Copyright Law and the Claims of Art*, 4 *Intell. Prop. Q.* 368, 388 (2002).

<sup>40</sup> *Newspapers Licensing Agency v. Meltwater Holding* [2010] EWHC 3099 (Ch) [72]; *Newspapers Licensing Agency Ltd. v. Meltwater Holding BV* [2012] RPC 1 (CA).

The paternity right could be relied on by street artists and writers, for instance, to make a complaint against the publication of their works in a photographic book where their authorship is not acknowledged. Such unauthorized uses are increasingly common, with artists being more and more willing to come out and complain. This occurred for example in the US in 2007, when a group of street and graffiti artists objected to the publication of a photographic book on New York City murals (entitled *Tattooed Walls*) and a related exhibition, because pictures of their pieces had been included without their authorization, and many artworks were misidentified, misinterpreted or misattributed.<sup>41</sup> The case was subsequently settled out of court.

### **{b}3.2 Integrity Right**

The integrity right allows authors and artists to oppose treatments of their works, particularly when they are prejudicial to their honour or reputation. The challenge here lies in verifying whether this right may be asserted by street and graffiti artists to oppose the destruction of their works or other unwelcome treatments, including their removal for the purposes of being exhibited and/or offered for sale in indoor environments such as galleries, museums or auction houses (so-called ‘de-contextualization’).

Two conflicting interests are at stake here: the interest of property owners in disposing of the tangible object they have become owner of, and the interest of artists in preserving their pieces. Who should the law protect more strongly? A broad interpretation of the integrity right, so as to give street artists the possibility to prevent the above treatments of their artworks, would strongly protect their interests. Yet, it would take away the power of private property owners to fully control their space.<sup>42</sup>

#### **{c}3.2.1 Destruction**

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<sup>41</sup> See David Gonzalez, Walls of Art for Everyone, but Made by Not Just Anyone, *The New York Times*, June 4, 2007, <http://www.nytimes.com/2007/06/04/nyregion/04citywide.html> (last visited June 20, 2018).

<sup>42</sup> Jamie Griffin, Illegal Graffiti: a Copyright Perspective, (2010) 22 *Intell. Prop. L. Bull.* 123, 124 (2010). See also Stina Teilmann, Framing the Law: The Right of Integrity in Britain, 27 *Eur. Intell. Prop. Rev.* 19, 23 (2005). (noting that courts, faced with such a dilemma, may tend to favour physical ownership of property owners over incorporeal ownership of artists).

Can street artists rely on the right of integrity to prevent the owner of the tangible object incorporating their piece (eg, a wall) from destroying or anyway damaging it? Several artists seem indeed increasingly interested in their street works being preserved; and some of them have taken action against property owners with a view to either preventing the destruction or mutilation of their pieces, or asking for damages after such treatment has occurred. Most of these suits have been brought in the US.<sup>43</sup>

### {c}3.2.2 The *5Pointz* case

The recent decision of the US District Court for the Eastern District of New York in the so-called *5Pointz* case is of seminal importance, as for the first time graffiti artists have been protected under the Visual Artists Rights Act (VARA), the piece of legislation introduced in the US in 1990 to offer artists' moral rights, including the right to prevent destruction of their works.<sup>44</sup>

*5Pointz* was a thriving New York mural point, also known as the 'Mecca' of graffiti, which was knocked down in August 2014 by the property owner, Mr Wolkoff, to build luxury condos. Judge Frederic Block awarded a total of \$6.7 million damages to 21 graffiti and street artists who had sued the owner of the complex, with the biggest award of \$1.3 million being given to *5Pointz's de facto* curator Meres One.<sup>45</sup> The year before the demolition the artists had tried to oppose the warehouse's destruction, but the court refused to issue an injunction to prevent the Mr Wolkoff from knocking down the site. The owner had been approving the art on his building for many years, and also profiting from it, as the value of the complex went up from \$40 million to \$200 million as soon as the variance and the green light to build the condos were obtained. Destroying *5Pointz* – the judge interestingly stressed – permitted Wolkoff to realize that gain.

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<sup>43</sup> In the UK instead there has been no reported legal action aimed at objecting to destruction of artworks placed in the street. This is also probably due to the fact that the right to prevent destruction of works is not expressly provided under the CDPA provision on integrity right.

<sup>44</sup> Visual Artists Rights Act of 1990, Pub. L. No. 101-650, 104 Stat. 5130 (codified as amended in various sections of 17 U.S.C. (West Supp. 1992)).

<sup>45</sup> *Cohen et al. v. G&M REALTY L.P. et al.*, Case No. 13-CV-05612(FB) (RLM), decision of 12 February 2018.

The judge accepted that because the 45 artworks had ‘recognized stature’ they must receive protection under VARA. That artworks must have ‘recognized stature’ to be protected against destruction is an explicit VARA requirement.<sup>46</sup> The judge found in particular that the 5Pointz artworks met the test affirmed in *Carter v. Helmsley-Spear Inc.*, the leading case that had clarified that this requirement is a sort of gate-keeping mechanism, being protection (against destruction) available just to those pieces that art experts, the art community or society in general considers as having stature.<sup>47</sup> But in the 5Pointz case Judge Block embraced a more generous interpretation of the *Carter* test. He indeed cited and endorsed *Martin v. City of Indianapolis* (which had affirmed that the *Carter* test “may be more rigorous than Congress intended”);<sup>48</sup> and recalled that in *Martin* the requirement was satisfied by merely relying on newspaper and magazine articles and various letters including a letter from an art gallery director.<sup>49</sup>

That said, Judge Block found that all the categories mentioned in *Carter* (art experts, the art community and society at large) had recognised the stature of 5Pointz artworks. The artists had indeed shown their professional achievements, including evidence of the placement of their works in movies, TV, and the Internet, letters from art professors around the country, letters and email from visitors to 5Pointz as well as media coverage and social media presence and followers. The judge also stressed that all the 45 artworks had received sufficient academic recognition, having been appreciated by university professors, art teachers and other art experts.<sup>50</sup>

Judge Block also carefully examined Mr Wolkoff’s behaviour. The artworks – even those that could be easily removed as they had been placed on plywood panels – had been whitewashed by the property owner without giving artists the 90 days’ notice required by VARA. And he did so – the judge stressed – being aware that the artists were pursuing a VARA-based legal action. Such a wilful disrespect of an important legal provision pushed the judge to award the artists the maximum amount of damages. Indeed, although he did not grant the injunction asked by the artist in 2013, the judge had warned Wolkoff that he would be

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<sup>46</sup> 17 U.S.C. § 106A(a)(3).

<sup>47</sup> *Carter v. Helmsley-Spear Inc.* (861 F Supp 303 (SDNY 1994) and 71 F.3D 77 (2nd Cir 1995)).

<sup>48</sup> 192 F.3d 608, 612 (7th Cir. 1999).

<sup>49</sup> See pp. 28-29 of the decision.

<sup>50</sup> See the Appendix of Judge Block’s decision of 13 June 2018, rejecting a motion by 5Pointz owner to set aside the Court’s findings of fact and conclusions of law and grant a new trial.

exposed to potentially high damages if the artworks were finally considered of ‘recognized stature’. But the property owner was apparently unconcerned by this warning, and proceeded to paint over all artworks displayed at 5Pointz without giving artists any notice. Such behaviour – the judge concluded – was not acceptable.<sup>51</sup>

The court took also into account that 5Pointz had become an attraction for New York City visitors, with busloads of tourists, school children and weddings constantly heading to the site. Also due to Meres One’s brilliant curation for more than a decade, not only was the complex regularly painted by talented graffiti and street artists from all over the world, but it also frequently attracted movie producers and singers as well as advertisers interested in using the art as a backdrop.

The judge finally did not attach much importance to the fact that several artworks at 5Pointz were not meant to be permanent, an argument which had instead been relied on by the property owner to claim that the pieces could not be protected. The Court reminded the parties that VARA protects both permanent and temporary art. This is an important point, especially – the judge added – when all that makes a work transient is the site owner’s expressed intention to remove it.

### {c}3.2.3 Other US cases

The *5Pointz case* was not the first successful VARA case involving art placed on public spaces. In *Hanrahan v Ramirez*<sup>52</sup> a group of young artists had painted a mural carrying an anti-drug message on the side of a liquor store with the authorization of the property owner. After the store owner whitewashed half of the mural three years later, the artists took legal action. The court held in 1998 that the piece had recognized stature because it had won a national prize, received the local community’s support and had been displayed in a government building as a photograph. The judge awarded the artists £48,000 as compensation and ordered the restoration of the mural.<sup>53</sup>

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<sup>51</sup> In the decision of 13 June 2018 (see supra fn. 51), Judge Block clarified: “I found out at the trial that Wolkoff had misled me at the preliminary injunction hearing. ... I was misled that the demolition of the buildings was imminent when there was not even an application for a demolition permit extant” (pp. 7 and 14).

<sup>52</sup> *Hanrahan v. Ramirez*, No. 2:97-CV-7470, 1998.

<sup>53</sup> Another case where the recognized stature requirement has been debated was *Henderson v. Ziman*, No 2:14-cv-03042-SJO-AS (E.D. Cal. Apr. 21, 2014). In April 2014, the artist Victor Henderson started a legal action

The VARA 90-day notice rule has been at the centre of several legal actions started by muralists against property owners, with the former complaining about the failure to serve such a notice. The following cases, most of which settled out-of-court, are noteworthy.

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- (i) In 1986 the artist Jesus Campusano painted a mural on a building in San Francisco, being assisted by three painters and his partner. After the building's owner covered it in 1998, his partner and children sued under VARA in the California Northern District Court. They claimed the owner had not notified them about the decision to cover the mural. The case was then settled for \$200,000.<sup>54</sup>
- (ii) In 2006 the mural 'Edward Ruscha', made by muralist Kent Twitchell over the course of nine years in Los Angeles, was painted over with no preliminary notice being given to the artist. The latter sued the US government, which owned the building, and 11 other defendants for damages under VARA in the California Central District Court.<sup>55</sup> Almost two years later the case settled for \$1.1 million.
- (iii) Muralist Dan Fontes painted an artwork on the side of an Oakland building in 1987. In 2015 he filed a suit in the California Northern District Court against the owners of the building after the tenant had whitewashed the mural without notifying the artist as required by VARA, and asked damages for \$400,000.<sup>56</sup> The case was later settled.
- (iv) In 2017 muralist Monte Thrasher sued several individuals and corporate defendants in the Central District of California, claiming that they had painted over his Six Heads mural, without the artist's permission, and substituted it with another

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under VARA over the destruction of the mural 'Brooks Avenue Painting' which he had co-created in 1969. Henderson claimed that his artwork had major historical significance. While Henderson seemed to have strong evidence showing that his mural was of recognized stature, the artist voluntarily abandoned the case.

<sup>54</sup> See University of Missouri-St Louis hand-out from 'The Artist as Entrepreneur' lessons, published at <http://www.umsl.edu/continuinged/artist/artist-lesson-VARA-ho2.htm> (last accessed Nov. 30, 2017).

<sup>55</sup> *Kent Twitchell v. West Coast General Corp et al.*, 06-cv-04857. (C.A.C.D. 2006).

<sup>56</sup> *Fontes v. Autocom Networks, Inc.*, C 15-02044 CRB (N.D. Cal. 2015).

mural. The case is about the alleged violation of Thrasher's integrity and paternity rights and at the time of writing is still pending.<sup>57</sup>

### **3.3 De-contextualization**

What we have also witnessed in recent years is the 'surgical' removal of street artworks from walls or other urban surfaces and their resurfacing in galleries or other indoor venues for the purposes of being exhibited and offered for sale. Such removals obviously bother and frustrate street and graffiti artists as they are perceived as unacceptable attempts to not only distort the message conveyed by the original art; but also to profit from pieces which are placed in urban environments with the aim of being freely enjoyed by members of the public. Also, many of these (removed) street artworks are often site-specific, which entails that the pieces maintain their artistic meaning as long as they are kept in their original environment.

Yet, it appears domestic laws protecting the integrity right in the UK and US, as they stand now, cannot be invoked by street and graffiti artists to oppose attempts to remove and de-contextualize their artworks. In the UK the CDPA wording seems to preclude the integrity right being invoked to prevent uses of the work in contexts different from those chosen by the artist.<sup>58</sup> Section 80(2)(a) of the CDPA, indeed, just targets addition to, deletion from, alteration and adaptation of works. The same goes under US law, as the relevant VARA provision only speaks about 'intentional distortion, mutilation, or other modification' of a work.<sup>59</sup> According to current US case law, not even site-specific street artworks could be

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<sup>57</sup> *Thrasher v. Siegel*, No. 2:17-cv-03047 (C.D. Cal. April 24, 2017). Another (apparently still pending) case is the one started by muralist Katherine Craig, who sued in January 2016 a real estate developer, Princeton Enterprises, after the latter allegedly threatened to destroy her iconic watercolor work named 'The Illuminated Mural'. According to the complaint, the artist entered into an agreement with the previous owner, specifying that the artwork would remain on the building for at least 10 years (see <http://www.crainsdetroit.com/article/20160105/NEWS/160109914/detroit-artist-sues-princeton-enterprises-over-bleeding-rainbow> (last accessed June 20, 2018)).

<sup>58</sup> Gillian Davies & Kevin Garnett, *Moral Rights* (Sweet & Maxwell, 2010) 238–40; Gerald Dworkin, The Moral Right of the Author: Moral Rights and the Common Law Countries, 19 Colum.-Vla. J.L. & Arts 229, 245–63 (1995); W.R. Cornish, Moral Rights Under the 1988 Act, 11 Eur. Intell. Prop. Rev. 449, 450 (1989) Hugh Laddie, Peter Prescott & Mary Vitoria, *The Modern Law of Copyright and Designs* (4th edn, LexisNexis, 2011) § 13.18).

<sup>59</sup> 17 U.S. Code § 106A.

saved from removals and de-contextualization. Indeed, in two seminal cases – *Phillips*<sup>60</sup> and *Kelley*<sup>61</sup> – courts have confirmed that VARA does not cover, and cannot be invoked to prevent the removal of, site-specific works.

The UK and US provisions regulating the moral right of integrity are thus at odds with Article 6-bis(1) of the Berne Convention, which does contain a general clause allowing artists also to object to any ‘other derogatory action in relation to a work’. This part of the provision was added at the Brussels Conference in 1948 with the specific aim of covering uses different from the categories of modifications already mentioned in the provision.<sup>62</sup> It is believed that by adding such a general clause, this provision of the Berne Convention can be interpreted as permitting artists to object to their works being placed and exhibited in different contexts.<sup>63</sup> Some civil law jurisdictions have followed this approach. Case law from the Netherlands,<sup>64</sup> Greece,<sup>65</sup> Spain,<sup>66</sup> Switzerland<sup>67</sup> and Israel<sup>68</sup> confirms that in these countries the removal and

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<sup>60</sup> *Phillips v. Pembroke Real Estate, Inc.*, 459 F.3d 128 (1st Cir. 2006). The ruling relied on the ‘public presentation’ exception of VARA (17 U.S. Code § 106(A)(c)(2)), which provides that ‘the modification of a work of visual art which is the result of conservation, or of the public presentation, including lighting and placement, of the work is not a destruction, distortion, mutilation, or other modification’. On this case see also Chapter 1 ‘Copyright in the Expanded Field’ by Xiyin Tang in this volume.

<sup>61</sup> *Kelley v. Chicago Park Dist.*, 635 F.3d 290 (7th Cir. 2011).

<sup>62</sup> Sam Ricketson & Jane Ginsburg, *International Copyright and Neighbouring Rights: The Berne Convention and Beyond* (2nd edn, OUP, 2006) (2 volumes) §10-11. See also the first edition of this book: Sam Ricketson, *The Berne Convention for the Protection of Literary and Artistic Works: 1886–1986* (Sweet & Maxwell, 1987) 469–70; Irini A. Stamatoudi, Moral Rights of Authors in England: The Missing Emphasis on the Role of Creators, 4 *Intell. Prop. Q.* 478, 504–5 (1997).

<sup>63</sup> Ricketson, *supra* note 63, at 469–70; Cornish, *supra* note 59 at 450.

<sup>64</sup> Even a minimum de-contextualization of an artwork was considered by a Dutch Court as infringing the integrity right: see Quentin Byrne-Sutton, The Owner of a Work of Visual Art and the Artist: Potential Conflicts of Interest. In Norman Palmer & Ewan McKendrick, eds, *Interests in Goods* (Informa Law, 1993) 281, 294 (mentioning a court decision finding that a large mural painting which had been specifically designed to hang in a particular building at a height of 90 centimetres could not be hung at the height of 2.20 metres instead).

<sup>65</sup> The integrity right has been held as infringed in Greece when an artwork was placed in a location which contradicted its purpose and spirit, or where the work was unjustifiably transferred to a venue different from its original one: see Counsel of State, Decision No. 1465/1954, Themis, 1955, 174; Court of Appeal, Dodoni, Decision No. 47/1956, 861. See also *Antonia-Belika Koubareli v. Evangelos Volotas* [2003] ECDR 19, a

de-contextualization of street artworks may in certain circumstances infringe the right of integrity and could thus be opposed.

#### {a}4. CAN ILLEGAL STREET ART BE PROTECTED BY COPYRIGHT?

We have seen that creating artworks in the street without authorization from the owner of the property on which such works are placed can expose artists to serious legal consequences, including jail time. Although nowadays artists increasingly seek and obtain permission to place their pieces in urban environments, much street art and graffiti are still created illegally. Can such illegally produced art be protected by copyright? US and UK laws do not give a precise answer.<sup>69</sup>

The issue was tangentially dealt with by a US court in *Villa v. Pearson Education*.<sup>70</sup> Hiram Villa, a Chicago-based street artist, took legal action against Brady Publishing for publishing a picture of his work in its strategy guide for a videogame without the artist's permission. The defendant asked to dismiss the complaint, arguing that the work in question could not be protected by copyright because the piece had been created illegally. The court denied the motion, yet it also noted that the claim that the work was not copyrightable due to

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decision enabling an author to rely on her moral rights to prevent the publication of her work in an offensive environment on the Internet.

<sup>66</sup> In January 2013, the Spanish Supreme Court held that the relocation of a work by the Spanish sculptor Andrés Nagel violated the author's moral right. See Stech, *supra* note 5 at 153.

<sup>67</sup> Swiss case law has confirmed that a violation of the integrity right under Article 119 of the Swiss Copyright Act of 9 October 1992 may occur indirectly, namely when the work itself remains unchanged, but where the surroundings of the work are modified in a way that affects the author's interests. See Jaques de Werra, *Treatment of Moral Rights in Other Jurisdictions – Switzerland*, in Davies and Garnett, *supra* note 59 at 586–7.

<sup>68</sup> Israeli courts have been willing to accept claims against types of use that damaged the author because of the context in which the artwork was placed. See Gadi Oron, *Treatment of Moral Rights in Other Jurisdictions – Israel*, in Davies and Garnett, *supra* note 59 at 754.

<sup>69</sup> For an overview of how British courts have dealt with the issue of copyright protection of illegally created works as well as works showcasing immoral content in old and recent cases, see Bonadio, *supra* note 1, at 215–17. For an analysis of the copyrightability of illegal works in general, see Chapter 19 of this volume, authored by Eldar Haber.

<sup>70</sup> See *Villa v. Pearson Educ., Inc.*, 2003 WL 22922178 (N.D. Ill. Dec. 9, 2003).

its illicit origin would require investigating the circumstances under which the work was created (the case was then settled out of court). Such obiter led some commentators to argue that judges may value an argument based on the artwork's illegality as a defence to copyright infringement, or anyway as a factor which affects its copyrightability. This defence may be considered as a specific application of the so-called unclean hands doctrine, an equitable defence in which the defendant claims that the plaintiff should not obtain a remedy and profit when the latter has acted unethically or in bad faith, or has anyway carried out an illegal activity.

Such a defence is quite popular amongst defendants accused of appropriating and profiting from street artworks that have been created illegally. It has been raised, for example, by the fashion company Moschino in *Joseph Tierney v. Moschino*, a copyright infringement case started by the graffiti artist Rime as he claimed that various elements of his Detroit mural 'Vandal Eyes' had been copied onto a Moschino dress which was subsequently worn by the pop-star Katy Perry at a 2015 glamorous event.<sup>71</sup>

As mentioned, whether illegally produced artworks can be considered copyrightable, or whether any existing copyright could be enforced in court, is not entirely clear. In other words, this is still a grey area of the (copyright) law in several jurisdictions, including the US and UK. Having said that, in some street-art- and graffiti-related cases courts did not in fact bother to enquire whether the relevant work had been produced without the authorization of the property owner. In the already mentioned *Reece v. Marc Ecko Unlimited* case, for example, the court did not refer to any illegality-related issue when rejecting the copyright infringement case brought by Reece against the producer of a graffiti-inspired game which had incorporated some bits of his graffiti art. Another relevant case is *Mager v. Brand New School*.<sup>72</sup> Stylish eyeball stickers had been placed by an artist named Damien Mager on many billboards of New York City. The stickers however also appeared on a TV commercial for a few seconds, without the authorization of the artist. Mager took action and asked for compensation, with the court accepting that the stickers could have been placed on the streets without authorization. Although damages were not awarded as the copyright had been

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<sup>71</sup> *Joseph Tierney v. Moschino S.p.A. et al.*, Docket No. 2:15-cv-05900 (C.D. Cal. Aug 05, 2015), Court Docket. I also mentioned this case supra at note 2.

<sup>72</sup> *Mager v. Brand New School*, 78 USPQ 2d 1389 (2004).

registered after the alleged infringement occurred, the judge did not focus on, nor was interested in, any illegality-related aspect of the artworks when deciding the case.<sup>73</sup>

It is also worthwhile mentioning the UK case *Creative Foundation v. Dreamland*,<sup>74</sup> the first decision by a British judge to expressly consider the ownership of walls on which artworks are placed. The judge, Arnold J., held that a mural painted by Banksy and cut from the wall by a tenant was a chattel that belonged to the landlord. Yet, he also noted obiter that there is no doubt the copyright belongs to the famous British street artist. The judge stressed such a point despite recognizing that the artwork had been created without the prior knowledge or the consent of the leaseholder and tenant (although Creative Foundation, that in the meantime had acquired the rights to the piece, later impliedly approved the work). It thus seems that the judge was not concerned with whether the work had been created legally or not.

Let's go back to the unclean hands doctrine. What makes it particularly unsuitable to govern cases of the misappropriation of street and graffiti art is the lack of connection between the illegal act committed by the artist (for example, painting an unauthorized mural on a wall) and the merit of these disputes, namely the reproduction, adaptation and (often) communication and making available to the public of the work by third parties, frequently for commercial purposes. In simpler words, the illegal behaviour of the street or graffiti artist does not have a negative impact on the individual or organization which has misappropriated the illegally placed art (it instead negatively affects the owner of the property upon which the work is placed, which however is not party to the proceeding). After all, that the doctrine in question cannot be invoked in cases where the plaintiff's misconduct is not linked to the merit of the litigation between the parties has been confirmed by US courts in several cases.<sup>75</sup>

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<sup>73</sup> See also Danwill D. Schwender, Does Copyright Law Protect Graffiti and Street Art? In Jeffrey Ian Ross, ed., *Routledge Handbook of Graffiti and Street Art* (Routledge, 2016) 456.

<sup>74</sup> *Creative Foundation v. Dreamland & Others* [2015] EWCH 2556 (Ch), 11 September 2015.

<sup>75</sup> For example, in *Mitchell Bros. Film Group v. Cinema Adult Theater*, 604 F.2d 852, 863 (1979), a case on enforcement of copyright over obscene pornographic content, the US Court of Appeals for the Fifth Circuit held that, when the plaintiff's wrongdoing does not relate to the defendant, the unclean hands doctrine cannot be relied on. See also *Keystone Driller Co. v. General Excavator Co.*, 290 U.S., 245 (1933) (holding that this doctrine can be invoked only where the wrongful acts 'in some measure affect the equitable relations between the parties in respect of something brought before the court for adjudication'); *NLRB v. Fickett-Brown Mfg. Co.*, 140 F.2d 883, 884 (CA5, 1944) (noting that the plaintiffs' alleged wrongful conduct has not changed the equitable relationship between plaintiffs and defendants and has not injured the defendants in any way); *Lawler*

Another reason why making copyright available for unauthorized street and graffiti artworks seems to make perfect sense lies in the fact that here the illegal aspects do not even concern the content of the work<sup>76</sup> – rather they pertain to the processes of creation of the piece. In my opinion, the way (legal or illegal) art is created should not affect the analysis related to copyright subsistence and enforceability. The copyright system should be neutral towards,<sup>77</sup> and blind about,<sup>78</sup> the way eligible subject matter is produced. After all, this line of reasoning has been shared by a German court in a copyright-related case involving an artwork painted on the Berlin Wall: ‘it is not in principle relevant ... that the way in which it [the artwork] was produced is evidently unlawful – in this case by virtue of an act of damage to property subject to civil and criminal sanctions ...’.<sup>79</sup>

This argument sounds logical. If I steal a pen which I then use to draw a wonderful piece of art, why should I be denied the right to enforce a valid copyright and tolerate that someone else copies and takes economic advantage of my work? The same could be arguably claimed where a person takes a picture of a minor without the parent’s permission or where a paparazzo takes photographs of celebrities in private locations without authorization.<sup>80</sup> It is simply unfair to allow persons other than the artist to rely on the illegal nature of a street

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*v. Gilliam*, 569 F.2d 1283, 1294 (CA4, 1978) (holding that the unclean hands doctrine does not purport to search out or deal with the general moral attributes or standing of a litigant). See also the more recent case *Dream Games of Arizona, Inc. v. PC Onsite*, 561 F.3d 983 (9th Cir. 2009), where the court found that an electronic bingo game was still protected by copyright when it was distributed in violation of state gaming laws.

<sup>76</sup> It should also be remembered that in several jurisdictions, such as the US, not even the possibly legal or obscene content of a work affects subsistence of copyright, or its enforceability (see again *Mitchell Bros. Film Group v. Cinema Adult Theater*, 604 F.2d 852, 863 (1979)).

<sup>77</sup> See Celia Lerman, *Protecting Artistic Vandalism: Graffiti and Copyright Law*, 2 NYU J. Intell. Prop. & Ent. L. 295, 316 (2013).

<sup>78</sup> Owen Morgan, *Graffiti – Who Owns the Rights?*, Univ. of Auckland Bus. Sch. Working Paper 5, 16, 21 (2006); available at SSRN: <http://ssrn.com/abstract=929892> (last accessed Nov. 30, 2017).

<sup>79</sup> *Re Pictures on the Berlin Wall* (Case I ZR 68/93) [1997] ECC 553.

<sup>80</sup> See Lerman, *supra* note 78, at 317, citing the US case *Mavrix Photo Inc. v. Allieiswired.com et al.*, No 10-7591, complaint filed, C.D. Cal. Oct. 12 2010 (where a photographer filed for copyright infringement on his picture of pregnant actress Penelope Cruz, which he had taken without permission). See also Danwill Schwender, *Promotion of the Arts: An Argument for Limited Copyright Protection of Illegal Graffiti*, 55 J. Copyright Soc’y U.S.A. 257, 274 (2008).

artwork to copy and exploit it for their own commercial purposes,<sup>81</sup> for example by using it in advertising messages or as a decoration element of fashion products. As has been noted, '[f]ailing to recognize a copyright in [illegal] graffiti could then have the effect of legitimizing its co-option but not its creation'.<sup>82</sup> This result would also be absurd as it would reward blatant imitations by individuals or corporations that have nothing to do with either the perpetrator of the illegal act (the artist) or the victim (the owner of the property).

One may however argue that making copyright and enforcement rights available to street and graffiti artists that have placed works without the authorization of the property owner would be useless and not really convenient for them. Many artists indeed would find it risky to come out and start a legal action against imitators as this would entail revealing their identity and being exposed to serious legal consequences. Yet, such risks would be lower, if not totally absent, where a copyright suit is brought against alleged infringers at some point after the street artwork has been illegally created, namely after the statute of limitation has expired: in these cases artists or their heirs may nurture a strong interest in bringing legal actions.<sup>83</sup>

#### **{b}4.1 Illegal Street Artworks and Moral Rights**

What about moral rights? Could street and graffiti artists rely on the rights of paternity and integrity in relation to works produced illegally? Again, this is a grey area of the law in the US and UK, as no express provisions within the copyright statutes deal with these issues.

As far as the paternity right is concerned, it could be argued that those who create artworks in the street illegally should be able to claim such a right. It would be (again) unfair to deny artists the right to be recognized as authors of their works just because they have been placed without the authorization of the property owner. Such denial would, once more, bring

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<sup>81</sup> See also Maribeth A. Smith, *Tagging the Lanham Act: Protecting Graffiti Art from Willful Infringement* 81 *Brooklyn L. Rev.* 813,834 (2016); Grant, *supra* note 32, 26.

<sup>82</sup> Jamison Davies, *Art Crimes? Theoretical Perspectives on Copyright Protection for Illegally-Created Graffiti Art*, 65 *Me. L. Rev.* 27, 51 (2013).

<sup>83</sup> For example, in the above mentioned *Jade Berreau v. McDonald's Corporation* (*supra* note 24), the partner of the deceased graffiti artist Dash Snow - who in the 90s had been illegally tagging his signature extensively in New York - took action against McDonald's for an alleged violation of the copyright over such work.

about an absurd result, namely that any member of the public would be able to present himself as the father of the artwork and possibly receive recognition and fame for a piece of art that actually was not be his own creation.<sup>84</sup> Also, enforcing such right would bring no harm to the owner of the surface (for example, a wall) where the piece has been illegally placed.

The other delicate issue regards the destruction of illegally created street works, and the extent to which the artists who produced them are able to rely on the integrity right to prevent such destruction or anyway ask for compensation in case their pieces are unlawfully destroyed, mutilated or damaged. On the face of it, it appears fair not to give street and graffiti artists a chance to complain about such destruction. Property owners may understandably dislike works placed on their space without their consent, no matter how artistic they might be. Their decision to destroy or remove such pieces may thus look reasonable, and obviously justified on property rights' grounds.<sup>85</sup> If instead the work has been authorized or commissioned by the property owner, one may argue that such an authorization or commission may affect in some circumstances the property owners' ability to rely on a defence of reasonableness should they later decide to get rid of the surface incorporating the work.<sup>86</sup>

The US case *Ron English et al. v. BFC & R. 11th Street LLC*<sup>87</sup> dealt with these issues. It involved a group of related artworks installed in a community garden. A redevelopment of the site was planned that would entail moving the sculptures but leaving the murals intact, although the new construction would obstruct the view of the murals. The artists claimed under VARA that the work was conceived as a unified environmental work and that therefore removing the sculpture would destroy the whole work. It was held that VARA was

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<sup>84</sup> Yet, it is likely that artists who illegally create street artworks want to remain anonymous to avoid criminal prosecution and therefore may not be interested in asserting the paternity right. See Grant, *supra* note 32, at 35. Yet, the interest in invoking this right – it should be stressed again – may arise after the statute of limitation has expired.

<sup>85</sup> See Griffin, *supra* note 42, at 124. As opposed to cases where unauthorised street artworks are misappropriated for commercial purposes (where artists' behaviour does not jeopardize the alleged infringer), the placing of illegally created works on the street here directly harms the other party of the dispute, namely property owners.

<sup>86</sup> Griffin, *supra* note 42, at 125.

<sup>87</sup> *Ron English v. BFC & R East 11th St. LLC*, No. 97 Civ. 7446, 1997 WL 746444 (S.D.N.Y. Dec. 3, 1997).

inapplicable as the works had been illegally created. The court held in particular that protecting these illegal pieces ‘could effectively freeze redevelopments of vacant lots by placing artwork there without permission. Such a construction of the statute would be constitutionally troubling, would defy rationality and cannot be what Congress intended in passing VARA’. Similarly, in *Botello v. Shell*,<sup>88</sup> where a gas station developer bulldozed a mural in violation of the California Preservation Act (which provides legal protection for artists’ moral rights), the court noted obiter that ‘the statute does not apply to [illegal] graffiti, which ... is hardly classifiable as “fine art”, and which is the subject of several criminal laws’.

Yet, in the subsequent case *Pollara v. Seymour*,<sup>89</sup> where an unauthorized work installed in the Empire State Building plaza in New York City was removed from its frame and significantly damaged, the court clarified that the ruling in *Ron English* only applied to illegal works that could not be removed without destroying them, therefore suggesting that in the case of illegal works that can be removed without harm (and many street and graffiti artworks belong to this category) VARA does apply.<sup>90</sup> Although it was concluded that the artwork was for the purpose of advertisement and therefore could not be protected under VARA, the court added that ‘there is no basis in the statute to find a general right to destroy works of art that are on property without the permission of the owner’. This point confirms that US courts have not taken a clear stance when it comes to interpreting the integrity right for illegally produced artworks.

Finally, we should wonder whether street and graffiti artists can rely on the integrity right to oppose the removal of artworks illegally placed in the public environment, and their subsequent exhibition in an indoor setting (this is what I labelled earlier ‘de-contextualization’). We have already seen that the US and UK provisions on the integrity right do not expressly allow artists to object to this treatment of their works, which casts serious doubts as to whether such a right could be invoked in these circumstances. Other

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<sup>88</sup> *Botello v. Shell Oil Co.*, 280 Cal. Rptr. 535 (Ct. A 1991).

<sup>89</sup> *Pollara v. Seymour*, 206 F.Supp.2d 333 (N.D.N.Y. 2002), aff’d on different grounds, 344 F.3d 265 (2d Cir. 2003).

<sup>90</sup> This would entail that street and graffiti artists that illegally place their pieces would be able to rely on VARA protection unless (1) the building owner has made a diligent, good faith but unsuccessful attempt at notification of the artist of his removal intent, or (2) the building owner did provide notice, but the artist either failed to remove the work or to pay for its removal within 90 days after receiving notice (see VARA, Section 113(d)(2)).

jurisdictions – we have also seen – are in this regard less strict towards artists. As a general remark, I note that, while the property owners’ decision to destroy illegal art placed in its own location may look reasonable,<sup>91</sup> their position appears less strong when they deliberately remove, or have someone remove, the artwork for the purpose of exhibiting and/or offering for sale the carved-out piece in an indoor location. After all, in these circumstances it could be argued that, if property owners do this, that means they also impliedly approve of and ‘legalise’ ex post the piece.<sup>92</sup>

## {a}5. CONCLUSION

Street art and graffiti are considered by many as the most important forms of artistic expression in present times. Often stimulated by a highly competitive and creativity-based environment, more and more artists use urban spaces as raw material and canvas for their works.

Obstacles may stand in the way of copyright and moral rights protection of (at least, some) street and graffiti art. As we have seen, provisions on copyrightable subject matter and requirements for protection could be interpreted by courts in a way which may close the (copyright) door to certain street artworks, including tags, throw-ups and street messages, which members of the general public as well as judges may not consider art. Such an outcome would probably be the result of a widespread lack of knowledge about the creative processes which characterize these artistic subcultures. As society’s perception of these creative communities is however slowly and progressively changing and becoming more appreciative and tolerant, so could and should – I believe – our (copyright) laws.

Street art and graffiti deserve, and need, copyright and moral rights protection. These forms of art are indeed vulnerable to both corporate appropriation and physical destruction, mutilation or other kind of damages. The prospect of relying on copyright and moral rights laws may not be the main motivation that pushes artists to place works in the street, as several

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<sup>91</sup> Yet, see again *Pollara v. Seymour*, where the US District Court for the Northern District of New York, which seems to suggest that in the case of illegal works that can be removed without harm (like many street and graffiti pieces) VARA does apply.

<sup>92</sup> See also Alison Young, *Street Art World* (Reaktion Books, 2016) 40, 41.

scholars that have developed the IP negative space theory would argue.<sup>93</sup> Yet, many street and graffiti artists are increasingly interested in protecting their pieces, as is confirmed by the growing number of legal actions or objections by such artists against who appropriates or damages their works.

Once it is accepted that street and graffiti art can and should be considered copyrightable, all artists within these artistic communities obviously need to accept the rules of the game. That means they may lose the copyright infringement cases they bring against alleged infringers. This happened for example in 2011 in *Seltzer v. Green Day, Inc.*,<sup>94</sup> where the artist took legal action against the pop band Green Day as the latter had incorporated in a video backdrop (used at live concerts) an adapted version of one of Seltzer's posters ('Scream Icon') placed on a Los Angeles wall. The Californian federal district and Circuit judges rejected the artist's claims as the use of the artwork was found to be 'transformative and not overly commercial' and therefore fair.

Street and graffiti artists may also be condemned for copyright infringement. This occurred, for instance, in *Morris v. Guetta* (Guetta is a famous street artist, also known as Mr Brainwash), where the judge ruled that seven of Guetta's works (including a mural), based on photographer Dennis Morris' iconic 1977 picture of Sid Vicious, deceased lead singer of punk band The Sex Pistols, were not protected by fair use as they were not transformative.<sup>95</sup> A similar fate would have probably awaited the famous street artist Shepard Fairey if he had not reached a settlement agreement with Associated Press, which had sued him arguing that his use of Associated Press imagery depicting Barack Obama (that resulted in the iconic poster

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<sup>93</sup> See Elizabeth L. Rosenblatt, A Theory of IP's Negative Space, 34 Colum. J.L. & Arts 317, 365 (2011); Kal Raustiala & Christopher Sprigman, The Piracy Paradox: Innovation and Intellectual Property in Fashion Design, 92 Va. L. Rev. 1687, 1778 (2006). For an application of the IP negative space theory to street art, see Cathay Y.N. Smith, Street Art: An Analysis Under U.S. Intellectual Property Law and Intellectual Property's 'Negative Space' Theory, 24 DePaul J. Art, Tech. & Intell. Prop. L. 259, 293 (2014).

<sup>94</sup> *Seltzer v. Green Day, Inc.*, 725 F.3d 1170, 1173–4 (9th Cir. 2013).

<sup>95</sup> *Dennis Morris v. Thierry Guetta, et al.*, No. LA CV12-00684. See also *Friedman v. Guetta*, No. CV 10-00014 DDP (C.D. Cal. May 27, 2011), a case started in 2011 by photographer Glen Friedman against Thierry Guetta. The Central District of California granted summary judgment for Friedman, finding that Guetta's work (in this case, not a street artwork, but a canvas) was substantially similar to Friedman's famous photograph of the rap group Run DMC, and that Guetta's use of the photograph could not be considered fair use.

'Hope' which came to represent the former US president presidential campaign) did not constitute fair use.

All in all, making sure that street and graffiti artists are able to assert and enforce copyright and moral rights against whoever appropriates or damages their works does seem to make sense. Certainly, artists' moral rights need to be properly balanced with the rights of property owners, so that such owners do not have to accept passively an excessive limitation of rights over their tangible possessions. This is particularly true of property owners that follow the correct procedures when removing artworks from their spaces (this did not happen, for example, in the above commented *5Pointz* case). Several factors could be taken into account when striking a fair balance between these two rights, including the existence of any agreement between the artist and the property owner, the length of time the artwork has been allowed to stay, the advantages obtained by the property owner from the piece and the public interest served by the proposed new use of the property once the street artwork is removed.<sup>96</sup>

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<sup>96</sup> See Timothy Marks, *The Saga of 5Pointz: VARA's Deficiency in Protecting Notable Collections of Street Art*, 35 *Loy. L.A. Ent. L. Rev.* 281, 310 (2015), at 313–14.