UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

SHEPARD FAIREY AND OBEY GIANT ART, INC.,

Plaintiffs,

v.

THE ASSOCIATED PRESS,

Defendant and Counterclaim Plaintiff,

v.

SHEPARD FAIREY, OBEY GIANT ART, INC., OBEY GIANT LLC, STUDIO NUMBER ONE, INC., and ONE 3 TWO, INC. (d/b/a OBEY CLOTHING),

Counterclaim Defendants.

ECF

Case No. 09-01123 (AKH)

COUNTERCLAIM DEFENDANT ONE 3 TWO, INC.'S MOTION IN LIMINE NO. 3 TO PRECLUDE PLAINTIFFS FROM RELYING ON ALTERED IMAGES AT TRIAL

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I. INTRODUCTION

The Associated Press (the "AP") cannot prevail on its copyright infringement claim against Defendant One 3 Two, Inc. ("One 3 Two") unless it can show that the graphical image of Barack Obama featured on One 3 Two's clothing and other merchandise (the "Obama Image") infringes the *protectible* elements of its 2006 photo of then-Senator Barack Obama (the "Garcia Photo"). Key among these elements are background, composition, lighting, angle, and depth of field. *See Kaplan v. The Stock Market Photo Agency, Inc.*, 133 F. Supp. 2d 317, 323-27 (S.D.N.Y. 2001). Throughout this case, however, the AP has consistently relied on a cropped version of the Garcia Photo that alters the Photo's protectible elements in an effort to make the two works look more alike than they are, rather than the *actual* Garcia Photo to which the artist Shepard Fairey referred in creating the Obama Image. *See, e.g.*, the AP's Motion for Summary Judgment at 29.

It is well established that a plaintiff may not demonstrate substantial similarity (and thus infringement) by manipulating to enhance the similarities to the alleged infringing work. *See, e.g.*, *Feder v. Videotrip Corp.*, 697 F. Supp. 1165, 1171 (D. Colo. 1988) (finding such conduct "completely disingenuous"). Instead, the burden is on the AP to show that the Obama Image infringes the Garcia Photo through an "overall comparison" of the protectible elements of the two works as they were presented to the public, *see Walker v. Time Life Films, Inc.*, 615 F. Supp. 430, 434 (S.D.N.Y. 1985), a test that would be rendered meaningless if the AP could rely on only those portions of the Garcia Photo that most resemble the Obama Image. *See* 4 *Nimmer on Copyright* § 13.03[E][3][a][i] at 13-106 (providing that a plaintiff may not alter its work "in order to achieve a juxtaposition that makes for greater similarity with [the] defendant's work").

This Court should reject the AP's efforts to mislead the jury and issue an order *in limine* preventing the AP from manipulating the Garcia Photo in a manner that highlights the

similarities with the Obama Image, on the ground that only the actual image itself, and not the AP's altered version, is relevant to the question of One 3 Two's alleged infringement. *See, e.g., Arnstein v. Twentieth Century Fox Film Corp.*, 52 F. Supp. 114, 115 (S.D.N.Y. 1943) (finding that similarity cannot be established "[b]y ingenious manipulation" of the plaintiff's work). In addition, because allowing the AP to rely on the cropped image would both mislead the jury and result in undue prejudice to One 3 Two, this Court should also exclude the altered image pursuant to Fed. R. Evid. 403.

II. THIS COURT SHOULD PRECLUDE THE AP FROM RELYING ON A CROPPED VERSION OF THE GARCIA PHOTO

A. The Jury Should Compare the Obama Image to the Garcia Photo as It Was Offered to the Public

As this Court is well aware, this case concerns Shepard Fairey's iconic graphical image of President Barack Obama, as it appeared on apparel and other merchandise produced and sold by One 3 Two through its license with Fairey's company, Obey Giant Art. There is no dispute that Fairey used a 2006 photograph taken by AP photographer Mannie Garcia of then-Senator Obama as a visual reference in creating the Obama Image. The question for the jury to determine is whether that image infringes the *protectible elements* of the Garcia Photo.

"A copyright in a photograph derives from the photographer's original conception of his subject, not the subject itself." *See Psihoyos v. Nat'l Geographic Soc.*, 409 F. Supp. 2d 268, 275 (S.D.N.Y. 2005) (citations and quotation marks omitted). Accordingly, the mere fact that the Obama Image and the Garcia Photo both portray an image of President Obama (or even the fact that both works show Mr. Obama looking "presidential") does not constitute infringement. *See, e.g., Straus v. DVC Worldwide, Inc.*, 484 F. Supp. 2d 620, 638 (S.D. Tex. 2007) ("The idea of taking a portrait of Arnold Palmer is not protectible . . ."). Rather, the AP can only prevail if the

jury determines that the works are substantially similar after performing a "careful assessment of the 'total concept and feel' of the works at issue, after the non-protectible elements have been eliminated from consideration." *See Psihoyos*, 409 F. Supp. 2d at 274 (citations and quotation marks omitted); *see also Shine v. Childs*, 382 F. Supp. 2d 602, 612 (S.D.N.Y. 2005) (noting that "total concept and feel" is the "dominant standard used to evaluate substantial similarity between artistic works" in the Second Circuit).

Both Fairey and Garcia testified at their depositions that the Garcia Photo, as it was originally presented to the public, portrays President Obama with an American flag in the background, with approximately the top one-quarter of the image displaying only the flag and its pole.

While the AP acknowledges that this image is the "true and correct" Garcia Photo, *see* the AP's Motion for Summary Judgment at 26, in arguing similarity to this Court, the AP has relied on an altered version of the Garcia Photo that omits the flag and flag pole.

By cropping the Garcia Photo to eliminate the background and the composition, the AP has eliminated much of what makes the Photo protectible, *see, e.g.*, *Kaplan,* 133 F. Supp. 2d at 326 (S.D.N.Y. 2001) (describing "background, perspective, lighting, shading, and color" as elements "courts have traditionally highlighted as protectible"), thus creating a false comparison with the Obama Image.[1] The actual Garcia Photo and the Obama Image differ in both background and perspective:

[1]The accuracy of the comparison is particularly important in this case, given the relative weakness of the AP's copyright in the Garcia Photo. *See Psihoyos*, 409 F. Supp. 2d at 275 (noting that "a copyright on a work which bears practically a photographic likeness to the natural article, as here, is likely to prove a relatively weak copyright") (citations and quotation marks omitted).

Under the AP's formulation, the images appear much more similar. It is for precisely this reason that this Court and others have held that any comparison between works must be done using the works "as they are presented to the public"—not after manipulation by the plaintiff. *See Walker*, 615 F. Supp. at 434; *see also Warner Bros. Inc. v. American Broadcasting Cos., Inc.*, 654 F.2d 204, 211 (2d Cir. 1981) (disapproving of plaintiff's attempt to demonstrate similarity by altering its work to achieve a greater similarity with the defendant's work); *Arnstein*, 52 F. Supp. at 115 (finding that similarity cannot be established "[b]y ingenious manipulation" of the plaintiff's work). To allow otherwise would be to give the AP—or any copyright plaintiff—an advantage, by allowing it to set the rules by which the jury's analysis is performed. The AP cannot, however, simply leave out elements of the Garcia Photo in order to enhance its similarity with the Obama image. *Cf. Feder v. Videotrip Corp.*, 697 F. Supp. 1165, 1171 (D. Colo. 1988) (finding such manipulation "completely disingenuous"). This Court should therefore issue an order requiring the AP to rely solely on the uncropped Garcia Photo at trial.

B. Use of the Cropped Photo Would Be Unduly Prejudicial

Even if the cropped Garcia Photo were relevant to the similarity analysis, which, as described above, it is not, *see Walker*, 615 F. Supp. at 434 (providing that the comparison between works must be done "as they are presented to the public"), it should still be excluded pursuant to Federal Rule of Evidence 403. Rule 403 gives this Court broad discretion to balance probative value and prejudice, *see Sprint/United Mgmt. Co. v. Mendelsohn*, 552 U.S. 379, 384 (2008), and to exclude evidence where, among other things, the evidence may "confuse the issues" or "mislead the jury." *See* Fed. R. Evid. 403. At trial, the jury will be called upon to assess the similarity between the "total concept and feel" of the Garcia Photo and the Obama Image, after filtering out the unprotectible elements, *see Psihoyos*, 409 F. Supp. 2d at 274—a task that will be made nearly impossible if the jury is given more than one version of the Garcia Photo to compare. *See Loussier v. Universal Music Group, Inc.*, No. 02 Civ. 2447, 2005 WL 5644439 at * 6 (S.D.N.Y. August 24, 2005) (excluding additional version of alleged infringed recording pursuant to Fed. R. Evid. 403 on grounds that jurors would be "confused as to why they are listening to a second version" of plaintiff's work). Moreover, because the AP's alterations are designed to make the works look *more* similar, any minimal probative value of the cropped Garcia Photo would be far outweighed by the risk of unfair prejudice to One 3 Two. *See* Fed. R. Evid. 403 adv. comm. note (defining "unfair prejudice" to mean "an undue tendency to suggest decision on an improper basis"); *cf. Kargo Global, Inc. v. Advance Magazine Publishers, Inc.*, No. 06 Civ. 550, 2007 WL 2258688 at *10 (S.D.N.Y. August 06, 2007) (applying Rule 403 to exclude consumer survey in trademark action that relied on "stimuli that differ from what a consumer is actually likely to see in the marketplace"). This Court should therefore exercise its discretion to exclude the cropped Garcia Photo pursuant to Fed. R. Evid. 403.

III. CONCLUSION

For the reasons stated herein, the Court should issue an order *in limine* to preclude the AP from relying on any cropped or otherwise modified version of the Garcia Photo at trial.

Dated February 25, 2011
Los Angeles, California

Respectfully Submitted,

By: /s/ Robyn C. Crowther

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