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. 6 TO EXCLUDE EVIDENCE OF CEASE AND DESIST COMMUNICATIONS

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I. INTRODUCTION

Given the popularity of Shepard Fairey's art and One 3 Two, Inc. ("One 3 Two")'s merchandise, including the iconic portrayal of President Barack Obama (the "Obama Image"), third parties have sought to profit off Fairey's and One 3 Two's intellectual property rights. For example, the Obama Image was used by numerous third parties for gain as opposed to support for Obama's candidacy. To curb these uses, in addition to enforcing its intellectual property rights, Fairey and One 3 Two monitored such uses and, on occasion, sent cease and desist letters to curb such uses ("cease and desist communications").

As set forth herein, this evidence has no role in this case. Accordingly, One 3 Two moves *in limine* to preclude Plaintiff The Associated Press ("the AP") from mentioning or introducing evidence or argument[1] regarding Fairey's and/or One 3 Two's cease and desist communications. This evidence is inadmissible for two reasons:

First, this evidence is irrelevant under Federal Rule of Evidence 402. What Fairey and One 3 Two thought about, or how they acted in response to, third parties using their intellectual property without authorization has no bearing whatsoever on the core issues of this case: whether to the layperson the Obama Image is substantially similar to the Garcia Photo, and whether One 3 Two is liable under the Digital Millennium Copyright Act ("DMCA") for alleged removal of copyright management information.

Second, this evidence should be excluded under Federal Rule of Evidence 403. This evidence, if admitted during trial, would unfairly prejudice One 3 Two by allowing the AP to argue

[1] At this time, the Parties have not exchanged pretrial disclosures, so One 3 Two cannot identify which trial exhibits are inadmissible as argued herein. The basis for this Motion is the AP's inappropriate use of such evidence in its Motion for Summary Judgment. One 3 Two will amend and supplement this Motion, as appropriate, once it ascertains trial exhibits and evidence proposed by the AP.

that One 3 Two sought to enforce copyrights on the one hand but infringed them on the other. That result is both impermissible and unworkable. The jury would be misled and confused about the issues central to the case. That One 3 Two enforces its own rights says nothing about what rights the AP may have to enforce against One 3 Two. Additionally, were the AP to introduce this evidence, One 3 Two would necessarily offer rebuttal evidence and argument—which would only compound confusion and unduly delay trial about collateral issues. These concerns substantially outweigh the non-existent probative value of this evidence and warrant exclusion.

II. EVIDENCE OF CEASE AND DESIST COMMUNICATIONS IS INADMISSIBLE AND SHOULD BE EXCLUDED

A. Evidence Regarding "Cease and Desist Communications" Is Irrelevant

Evidence is relevant if it has "any tendency to make the . . . determination of the action more [or less] probable than it would be without the evidence." Fed. R. Evid. 401. "Evidence which is not relevant is not admissible." Fed. R. Evid. 402.

In its Motion for Summary Judgment, the AP relied on evidence of Fairey's and One 3 Two's internal and external communications about unauthorized third-party use of their intellectual property, including the Obama Image.[2] By way of example, the AP relied on a "Cease and Desist Report" used by Olivia Perches (a business manager for Fairey) in furtherance of its argument that One 3 Two cannot rely on the First Amendment as a defense to copyright infringement. *See, e.g.*, the AP's Reply at 54-56. The AP also offered evidence about One 3 Two's informing Fairey about alleged third-party misuse of the Obama Image. *See, e.g.*, Ex. 135 to Ray Decl. filed in support of the AP's Reply.

[2] This evidence includes Exhibits 134-140 of the Declaration of Claudia Ray ("Ray Decl.") submitted in support of the AP's Reply in support of its Motion for Summary Judgment ("Reply").

This evidence is irrelevant because it in part deals with conduct of parties (*i.e.*, Fairey) who are no longer involved in this litigation. This evidence is doubly irrelevant because, according to the AP, it concerns fair use and the First Amendment—issues that the Court has already disposed in the AP's favor in its recent summary judgment ruling. The only issues viable for trial are substantial similarity between two images and One 3 Two's liability under the DMCA. The "cease and desist communications" with respect to the Obama Image involves conduct that occurred well after any copyright infringement or DMCA violation allegedly took place, and "cease and desist communications" with respect to any of One 3 Two's other intellectual property would not even involve the Obama Image. In sum, this evidence does not have "any tendency to make the . . . determination of [the claims in this case] more [or less] probable than it would be without the evidence." *See* Fed. R. Evid. 401.

B. The Risk of Unfair Prejudice to One 3 Two, Jury Confusion, and Waste of Time Also Warrant Exclusion of Evidence of Cease and Desist Communications

Rule 403 excludes evidence whose "probative value is substantially outweighed by the danger of unfair prejudice, confusion of the issues, or misleading the jury, or by considerations of undue delay, waste of time, or needless presentation of cumulative evidence." *See* Fed. R. Evid. 403.

All the factors and considerations underlying Rule 403 compel exclusion of the "cease and desist" evidence. For reasons set forth above, the probative value of this evidence is minimal at best. Rather, evidence and argument about the "cease and desist communications" pose a significant risk of unfair prejudice for One 3 Two. The jury may impermissibly interpret the evidence precisely the same way the AP (incorrectly) presented it in its summary judgment briefing—that One 3 Two is liable because it hypocritically infringed copyrights of the AP while

vigilantly enforcing its own against others. If such evidence were admitted, One 3 Two would have to spend significant time rebutting these arguments, including explaining its reasons for sending communications to third parties, its knowledge (or lack thereof) of Fairey doing the same, and how the situations were different. This evidence and testimony would undoubtedly result in jury confusion and prolong the trial. This effect is immeasurable in that no limiting instruction could limit the harm to One 3 Two or accommodate considerations of judicial economy; accordingly, the Court should exclude all argument and evidence of "cease and desist communications."

III. CONCLUSION

For the reasons stated herein, the Court should exclude all evidence and argument at trial relating to "cease and desist communications."

Dated February 25, 2011
Los Angeles, California

Respectfully Submitted,

By: /s/ Robyn C. Crowther

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