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**IN THE UNITED STATES DISTRICT COURT  
 FOR THE SOUTHERN DISTRICT OF NEW YORK**

SHEPARD FAIREY and OBEY GIANT ART, INC.,  
 Plaintiffs,

v.

THE ASSOCIATED PRESS,  
 Defendant/Counterclaim Plaintiff,

v.

SHEPARD FAIREY, et al.,  
 Counterclaim Defendants,

And

MANNIE GARCIA,  
 Defendant, Counterclaim Plaintiff &  
 Cross Claim Plaintiff/Defendant,

v.

SHEPARD FAIREY and OBEY GIANT ART, INC.,  
 Counterclaim Defendants,

And

THE ASSOCIATED PRESS,  
 Cross Claim Plaintiff/Defendant.

Case No.: 09-CV-01123 (AKH)

ECF Case

**THE ASSOCIATED PRESS'S  
 MOTION IN LIMINE NO. 5 TO  
 PRECLUDE OBEY CLOTHING  
 FROM PRESENTING SHEPARD  
 FAIREY'S EXPERT WITNESSES  
 AT TRIAL**

The Associated Press (the “AP”) respectfully moves to exclude the testimony of Marita Sturken and Frank Cost, two witnesses previously designated as testifying experts by Shepard Fairey, Obey Giant Art, Inc., Obey Giant LLC, and Studio Number One, Inc. (collectively, “Shepard Fairey”), whom One 3 Two, Inc. d/b/a Obey Clothing (“Obey Clothing”) now seeks to call at trial as expert witnesses on its behalf.

**I. PRELIMINARY STATEMENT**

During discovery in this case, Obey Clothing disclosed three expert witnesses, all of whom focused on issues relating to damages. Obey Clothing did not identify any expert witnesses on the subjects of art appreciation, photography, or design. Just one week ago, however, Obey Clothing informed the AP that it intends to call on its behalf two witnesses who were offered as experts by Shepard Fairey, despite Obey Clothing’s failure properly to disclose those witnesses.

The Court should preclude Obey Clothing from offering these witnesses as testifying experts for two separate and independent reasons. First, Obey Clothing’s failure to disclose Ms. Sturken and Mr. Cost as expert witnesses as required by Rule 26(a)(2) within the period set by this Court for expert discovery in this case is severely prejudicial to the AP. Obey Clothing never produced an expert report for either witness, the AP was not informed of any opinions they might have regarding Obey Clothing, and was denied any opportunity to examine either witness as to any such opinions. As a result, the AP is wholly in the dark as to any opinion testimony that these experts might offer regarding Obey Clothing—precisely the outcome that Rule 26 is designed to prevent. Second, the opinions that Ms. Sturken and Mr. Cost would offer at trial are not relevant to the issues of substantial similarity, liability under the DMCA, or damages. As such, their testimony would only confuse the jury and substantially prejudice the AP.

## II. BACKGROUND

At a status conference on May 23, 2010, the Court asked the parties about the role of expert witnesses in this case. (May 23, 2010 Hr’g Tr. 31.) In response, and at the Court’s request, the parties submitted a joint submission describing the expert witnesses that each party intended to offer at trial. (Exhibit A, Aug. 22, 2010 Ltr. from W. Fisher to Judge Hellerstein 2–3.) The parties also agreed to disclose their affirmative expert witnesses by October 1, 2010 and their rebuttal expert witnesses by November 2, 2010. (*See id.* at 4.) The Court approved these deadlines at a status conference on August 23, 2010. (*See* Aug. 23, 2010 Hr’g Tr. 19.)

On October 1, 2010, Obey Clothing identified only one affirmative expert witness—an “apparel industry expert” named Gabrielle Goldaper. While the AP and Shepard Fairey offered expert witnesses on the subjects of accounting, art history, digital imaging, economics, the licensing industry, and photography, Obey Clothing disclosed that its affirmative expert case would “focus primarily on the proper measure of damages, if any, ... should the Associated Press prevail on the merits.” (Aug. 22, 2010 Ltr. 2.) Obey Clothing later identified two rebuttal experts—an accountant and an economist—whose proffered testimony also focuses on issues relating to damages. Obey Clothing never disclosed—by the deadline for expert disclosures or at any other point in discovery—that it planned to offer expert testimony on matters beyond those that it had disclosed under Federal Rule of Civil Procedure 26(a)(2).

One week ago, on February 18, 2011, Obey Clothing disclosed for the first time that it intends to call as trial witnesses two of Shepard Fairey’s experts—Marita Sturken, a self-described “specialist in the study of visual culture,” and Frank Cost, a professor of digital imaging and publishing. By that point, the AP had long since deposed both Ms. Sturken and Mr. Cost based on the expert reports they had submitted on behalf of Mr. Fairey. Obey Clothing was

present at the depositions but asked no questions and provided no indication that it might try to call either witness as its own expert at trial. To this day, Obey Clothing has not served any of the required Rule 26(a)(2)(B) disclosures with respect to these two witnesses. Nor has Obey Clothing explained its purported basis for trying to call Mr. Fairey's proffered experts as its own affirmative witnesses, despite having failed to designate these witnesses during discovery.

It bears emphasis that the proffered testimony of these witnesses is not relevant to the remaining issues in this case. On January 11, 2011, the Court entered an order dismissing claims Mr. Fairey's claims against the AP and the AP's counterclaims against him. As a result, Shepard Fairey is no longer a party to this lawsuit. These witnesses' expert reports—as might be expected of litigation experts retained by Mr. Fairey—focus exclusively upon placing Mr. Fairey's work in cultural context and describing the process Mr. Fairey allegedly used to make the Obama Poster, without even mentioning Obey Clothing. Furthermore, on February 15, 2011, the Court granted the AP's motion for summary judgment with respect to Obey Clothing's fair use defense. Ms. Sturken offers opinions about whether the Obama Image “has acquired iconic status,” and Mr. Cost offers opinions about Mr. Fairey's creation process in making the Obama Poster, including whether Mr. Fairey used Rubylith.<sup>1</sup> These opinions are not relevant to the questions of substantial similarity, Obey Clothing's liability under the DMCA, or damages, which are the only issues left in this case.

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<sup>1</sup> As set forth in the AP's Motion in Limine No. 3 to exclude evidence of Rubylith, Mr. Fairey's alleged use of Rubylith is unsupported by the evidence, irrelevant, and tainted by Mr. Fairey's spoliation in this case, and should therefore be excluded.

### **III. ARGUMENT**

The Court should preclude Obey Clothing from offering Ms. Sturken and Mr. Cost as testifying experts for two separate and independent reasons. First, Obey Clothing failed to disclose Ms. Sturken and Mr. Cost as expert witnesses until just one week ago, long after the Court's deadline for identifying experts under Rule 26(a)(2) and months after the close of expert discovery in this case. Second, the opinions that Ms. Sturken and Mr. Cost would offer at trial are not relevant to the issues of substantial similarity, liability under the DMCA, or damages. As such, their testimony would only confuse the jury and substantially prejudice the AP.

#### **A. Obey Clothing May Not Call As Experts At Trial Witnesses Whom It Did Not Properly Disclose During Discovery Under Rule 26(a)(2)(B).**

Obey Clothing made the tactical decision to designate only one affirmative expert witness and two rebuttal experts during pretrial discovery in this case. It should not now be permitted—less than one month before the final pretrial conference—to try to pass off Shepard Fairey's experts as its own. Under Rule 26(a)(2)(B) of the Federal Rules of Civil Procedure, Obey Clothing was required to “disclose to the other parties the identity of any witness it may use at trial to present evidence under Federal Rule of Evidence 702, 703, or 705.” FED. R. CIV. P. 26(a)(2)(B). Under the Court's pretrial schedule, Obey Clothing was required to make that disclosure several months ago, no later than October 1, 2010. Obey Clothing decided not to designate any expert witnesses to testify about “visual culture” or design technology at that time.

Because Obey Clothing failed to designate Marita Sturken or Frank Cost (or any proposed experts on the subjects of their testimony for that matter) as testifying experts under Rule 26(a), Obey Clothing “is not allowed to use that information or witness to supply evidence on a motion, at a hearing, or at trial, unless the failure was substantially justified or is harmless.” See FED. R. CIV. P. 37(c)(1). Judges of this District have described Rule 37(c)(1) as establishing

a principle of “mandatory preclusion” that is “the required sanction in the ordinary case” of non-disclosure. *See Zahler v. Twin City Fire Ins. Co.*, No. 04-cv-10299(LAP), 2007 WL 4563417, at \*1 (S.D.N.Y. Dec. 21, 2007) (quoting *Primus v. United States*, 389 F.3d 231, 234–35 (1st Cir. 2004) (internal quotation omitted)). Judge Keenan, for instance, has observed that the “result is ‘self executing’ and is an ‘automatic sanction’ that is designed to provide a strong inducement for disclosure of relevant material that the disclosing party expects to use as evidence.” *In re Motel 6*, 161 F. Supp. 2d 227, 243 (S.D.N.Y. 2001) (citation omitted).

Obey Clothing has no plausible argument that its failure to comply with Rule 26(a)(2) is substantially justified in this case. As noted above, Obey Clothing decided during discovery not to put forward any expert witness on visual culture or design technology. If Obey Clothing had intended to rely on Ms. Sturken or Mr. Cost (or any of Shepard Fairey’s other experts at trial), then it should have disclosed that arrangement to the AP before the deadline for designating experts under Rule 26(a)(2)(A). That disclosure at least would have allowed the AP to depose Ms. Sturken and Mr. Cost with the awareness that they were Obey Clothing’s witnesses as well.

Nor can Obey Clothing claim that its failure to comply with Rule 26(a)(2) is harmless. For one thing, the expert reports that Ms. Sturken and Mr. Cost submitted in this matter are focused entirely on Shepard Fairey. Their trial testimony will not make sense unless Obey Clothing modifies the opinions disclosed in the expert reports—a change in their proffered testimony that necessarily prejudices the AP. Moreover, the AP had no reason to raise questions during Ms. Sturken’s and Mr. Cost’s depositions that the AP would have asked had it known that the witnesses were part of Obey Clothing’s case. The AP’s discovery would have included questions relating to the witness’s credibility (*e.g.*, the terms of their retention by Obey Clothing, and the compensation they expected as a result of testifying), the integrity of their opinions (*e.g.*,

the involvement of Obey Clothing and its counsel in developing the expert reports), and the substance of their opinions (*e.g.*, how the mass-marketing and merchandising of t-shirts might have affected the supposedly “iconic” status of the Obama Image). But the AP was deprived the opportunity to raise these questions during discovery because Obey Clothing failed to disclose that Ms. Sturken and Mr. Cost might appear as their experts at trial.

**B. The Court Should Exclude Ms. Sturken And Mr. Cost Because Their Testimony Is Not Relevant To The Remaining Issues In This Case.**

The Court should exclude Ms. Sturken and Mr. Cost for the separate and independent reason that their testimony is simply not relevant here.

*1. Ms. Sturken’s opinions on “visual culture” are not relevant.* Ms. Sturken describes herself as “a specialist in the study of visual culture.” (Exhibit B, Oct. 1, 2010 Expert Rpt. of M. Sturken ¶ 5.) Ms. Sturken notes that her “expertise is focused on the cultural and political meaning of images, rather than their legal status.” (*Id.* ¶ 6.) Shepard Fairey offered Ms. Sturken as a witness who would testify that the Obama Photograph “was transformed in this poster into an image that has acquired iconic status.” (*Id.* ¶ 2.) Ms. Sturken described her method as having been derived “from the humanistic approaches of semiotics and discourse analysis (analyzing images as meaningful texts, how they circulate and are talked about, and how their meanings can change in difference contexts).” (*Id.* ¶ 5.) In the end, Ms. Sturken opined in her expert report that the Obama Poster “did create hope” and therefore “formed a vital component in American public culture at this moment in history.” (*Id.* ¶ 70.)

Ms. Sturken’s opinions are simply not relevant to this case. While Shepard Fairey might have offered Ms. Sturken as witness in support of his fair use defense, her views on the “iconic status” of the Obama Image are of no help to the jury on the issues of substantial similarity,

violation of the DMCA, or damages. Indeed, under longstanding Second Circuit precedent, it would be improper to allow Ms. Sturken to opine on the issue of substantial similarity. The Second Circuit recognizes that “the test of copyright infringement is whether the similarity between [two] products would lead ‘the average lay observer . . . [to] recognize the alleged copy as having been appropriated from the copyrighted work.’” *Herbert Rosenthal Jewelry Corp. v. Honora Jewelry Co.*, 509 F.2d 64, 66 (2d Cir. 1974) (quoting *Ideal Toy Corp. v. Fab-Lu, Ltd.*, 360 F.2d 1021, 1022 (2d Cir. 1966)). Based on the “average lay observer” standard, the Second Circuit consistently holds that—with certain exceptions that are plainly not applicable here—“dissection and expert testimony” are not relevant for resolving substantial similarity. *Laureyssens v. Idea Group, Inc.*, 964 F.2d 131, 140 (2d Cir. 1992). Accordingly, the courts of this District routinely exclude experts who offer opinions on the similarities between two works. *See, e.g., Price v. Fox Entm’t. Grp., Inc.*, 499 F. Supp. 2d 382, 389 (S.D.N.Y. 2007).

This Court recognized this principle during the hearing on the parties’ motions for summary judgment. When Obey Clothing’s counsel argued that the Obama Photograph and the Obama Image were not substantially similar because the latter is “for lack of a better term, propaganda,” (Feb. 15, 2011 Hr’g Tr. at 18:11–18:12), the Court provided this correction:

It’s a difference without a distinction. It doesn’t make any difference. Does the viewer look the same? Whether it’s propaganda or a news photo is meaningless. A news photo before it became a news photo was a photograph. Propaganda before it became propaganda was a picture. The question is whether the photograph and the picture are substantially the same. The euphemisms or the pejoratives blind thought; they don’t help thought.

(*Id.* at 18:14–18:21.) Ms. Sturken’s expert testimony would involve nothing more than affixing labels to the Obama Photograph and the Obama Image that are meaningless in the context of resolving substantial similarity. Her testimony would only obscure the real issues in the case and

would likely confuse the jury instead of assisting it. Accordingly, Ms. Sturken's testimony should be excluded under Rules 403 and 702 of the Federal Rules of Evidence.

2. *Mr. Cost's opinions about Shepard Fairey's techniques are not relevant.* Mr. Cost is an associate dean at the Rochester Institute of Technology College of Imaging Arts & Sciences. (Exhibit C, Oct. 1, 2010 F. Cost Expert Rpt. ¶ 3.) Mr. Cost reviewed various computer files and materials that were provided by Mr. Fairey's counsel, (*see id.* ¶ 5), and he offered the opinion that "a central step in Fairey's creative process" was hand-cutting a Rubylith copy of the Obama Image before re-scanning the image and making further edits using computer software, (*see id.* ¶¶ 24–25). As the AP notes in its Motion in Limine No. 3, Mr. Fairey has never produced the digital image of a Rubylith that he supposedly scanned into his computer, and the AP is seeking to exclude such evidence and for an instruction from the Court that the jury should therefore presume that Mr. Fairey did not use Rubyliths at all. Mr. Cost does not address this missing file in his report.

In all events, Mr. Cost's opinions about how Shepard Fairey may have made the Obama Image are not relevant to the issue of whether the Obama Image is substantially similar to the Obama Photograph. Under the Second Circuit's standard, the impression that a copy leaves with the ordinary lay observer—not the process that resulted in the creation of the work—is the touchstone for determining infringement. *See Laureyssens*, 964 F.2d at 140. Nor is Mr. Cost's testimony relevant to Obey Clothing's liability under the DMCA. Shepard Fairey has acknowledged that there may have been an AP watermark on the Obama Photograph, (*see* Exhibit D, S. Fairey Dep. (July 30, 2010) Ex. 336 (bottom of page 3)), and Mr. Cost does not (and cannot) offer an opinion disputing Mr. Fairey's own statements on that subject. Because Mr. Cost has no relevant information to offer concerning any of the remaining issues in this case,

he should not be permitted to offer opinion testimony under Rules 403 and 702 of the Federal Rules of Evidence.

**IV. CONCLUSION**

For the reasons stated above, the AP respectfully requests that the Court preclude Marita Sturken and Frank Cost from offering opinion testimony on behalf of Obey Clothing.

Date: February 25, 2011

Respectfully submitted,

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