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

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I. INTRODUCTION

The Associated Press (the "AP")'s motion to preclude One 3 Two, Inc. d/b/a Obey Clothing ("One 3 Two") from offering at trial testimony of two experts who were designated by Shepard Fairey should be denied. First, there is nothing extraordinary or untoward in calling an expert who has been designated by another party, as long as the testimony is limited to opinions that the expert has previously expressed. *See Penn Nat. Ins. Co. v. HNL Corp*., 245 F.R.D. 190, 193-95 (M.D. Penn. 2007). That is precisely what One 3 Two intends to do. Before the AP settled its claims with Shepard Fairey and his entities (collectively, "Fairey"), all Parties anticipated that Fairey would call these experts to express the opinions detailed in their reports and as to which the experts were deposed. Now those same opinions will be offered in response to questions from One 3 Two instead of Fairey. That causes no prejudice to the AP whatsoever. One 3 Two notified the AP of its intention to call these experts—Professors Marita Sturken and Frank Cost—before the 30-day limit prescribed for pretrial disclosures, and there is nothing procedurally improper in One 3 Two's conduct. Fed. R. Civ. P. 26(e)(2) and 26(a)(3).

Alternatively, the AP contends that the opinions of Professor Sturken and Professor Cost are not relevant to the issues to be tried, primarily copyright infringement, and whether Shepard Fairey's poster of Barack Obama (the "Hope Poster") is substantially similar to the protected elements in the photograph taken by the AP's staff photographer of Obama in 2006 (the "Garcia Photo"). The AP's position is fairly ironic, given its reliance on expert testimony to establish substantial similarity in its motion for summary judgment on copyright infringement. While expert testimony is not appropriate on the issue of whether the protected elements of one work are substantially similar to another, it is relevant to the issue of what those protected elements are, and it is to those issues that both Professors Sturken and Cost will opine.

As the Parties argued in their motions for summary judgment, not all elements of the Garcia Photo are protected by copyright. There are a limited set of elements in a photograph of a "real world" object that might be protected from copying by the law which include the background, angle, pose, lighting, shading, evoked expression of the photograph as well as the camera and film used to create it. Additionally, when those items in a particular photograph are not original or creative expression of the photographer, they are not protected. Finally, elements that flow naturally from the idea of the photograph (here, a portrait of a political leader) are not protected by copyright under the doctrine of *scenes á faire*.

It is these issues as to which expert testimony is not just relevant but necessary. Laypersons are unlikely to know, without information from someone with expertise, what elements of political photographs are conventional and what is original. In addition, there is no question that the Hope Poster is not a verbatim copy of the Garcia Photo and that some elements were changed. Some, like the background, are obvious. Others, such as lighting and shading, are more subtle. An expert can help identify those changes for the jury and explain, mechanically, how they were made. It is to these issues that Professors Sturken and Cost will testify and their testimony will assist the triers-of-fact. Accordingly, the Court should deny the AP's motion.

II. ONE 3 TWO'S INTENTION TO OFFER PREVIOUSLY DISCLOSED EXPERT WITNESSES AND TESTIMONY IS PROPER

A party is entitled to call another party's expert as a witness at trial for purposes of eliciting an opinion previously expressed. *See Penn Nat. Ins.*, 245 F.R.D. at 193-95 (denying motion *in limine* to preclude the defendant from calling at trial an expert retained by, but not planned to be called by, the plaintiff insurers, and holding that a party could call the experts at trial and question them about the opinions they had previously formed and embodied in their reports); *see also Nichols II v. American Risk Management Inc.*, No. 89 Civ. 2999, 2000 WL 97282 (S.D.N.Y. Jan.

28, 2000) (denying motion to strike the plaintiff's designation of deposition testimony of another party's expert who had settled prior to trial); *Cary Oil Co., Inc. v. MG Refining & Marketing, Inc.*, No. 99 Civ. 1725 (VM), 2003 WL 1878246, *4-5 (S.D.N.Y. Apr. 11, 2003) (Federal Rules of Civil Procedure "are not designed to prohibit a witness from testifying about anything not explicitly mentioned in his Rule 26 disclosure, but rather to protect one party from being blindsided by another party with new opinions never before discussed" and finding that to the extent the plaintiff's expert sought to offer new opinions, the defendants had more than a month before trial to prepare and any failure to disclose was harmless).[1]

A. One 3 Two Does Not Seek to Offer any New Testimony, Evidence or Opinion

As a preliminary matter, the AP misconstrues the nature of the testimony One 3 Two seeks to elicit from Professors Sturken and Cost at trial. As the law permits, One 3 Two intends to offer expert opinions previously expressed by Sturken and Cost in each of their respective expert reports and deposition testimony. One 3 Two is ***not*** seeking to introduce any new opinions or evidence. As the Court is aware, Fairey and the AP reached a settlement after the close of expert discovery. Fairey and One 3 Two shared many of the same defenses, and One 3 Two's liability for infringement is dependent on whether Fairey's Hope Poster is infringing. Fairey designated Professors Sturken and Cost to opine as to which, if any, of the elements of the Garcia Photo were protected and which, if any, of those elements were copied in the Hope Poster. Those issues are no

[1] *Zahler v. Twin City Fire Ins. Co.*, No. 04-CV-10299 (LAP), 2007 WL 4563417, at *1 (S.D.N.Y. Dec. 21, 2007) and *In re Motel 6*, 161 F. Supp. 2d 227, 243 (S.D.N.Y. 2001) are both inapposite because in those cases the expert's testimony was not previously disclosed. *See* AP's Motion at 5. Here, the opinions of Professors Sturken and Cost were timely disclosed by Fairey, and the AP has deposed each of these experts. Moreover, One 3 Two notified the AP of its intention to rely on these experts more than one month before trial. Thus, any failure by One 3 Two to disclose its intention to rely on these experts at trial prior to the Rule 26 disclosure deadline was both "substantially justified" and "harmless." Fed. R. Civ. P. 37(c)(1).

different whether the trier-of-fact is considering the Hope Poster image as a poster or replicated on a t-shirt.

The AP has had ample opportunity to depose Professors Sturken and Cost as to their opinions on these issues and consequently there is no danger of prejudice. Any conceivable prejudice was mitigated by One 3 Two's disclosure of its intent to offer testimony from Professors Sturken and Cost more than 30 days prior to trial. Under the Federal Rules of Civil Procedure, a party is permitted to supplement its expert's report up to 30 days before trial. *See* Fed. R. Civ. P. 26(e)(2). Here, One 3 Two does not seek to offer any new evidence, argument or opinion at all. Rather, One 3 Two intends to call witnesses to offer testimony long ago shared with, and tested by, the AP. Accordingly, One 3 Two's intention to offer previously disclosed experts and expert testimony is proper. *Penn Nat. Ins.*, 245 F.R.D. at 193-95.

B. The Opinions of Professors Sturken and Cost are Relevant to the Claims Asserted against One 3 Two

The AP's effort to preclude the testimony of Professors Sturken and Cost is based on the incorrect assumption that the claims the AP asserts against One 3 Two are somehow materially different from the claims asserted against Fairey, who originally designated the experts. A brief review of the facts at issue demonstrate the fallacy of that argument.

The AP contends that it holds the copyright, including the exclusive right to make derivative works from, the Garcia Photo. It is undisputed that One 3 Two never had access to the Garcia Photo. The claims against One 3 Two are based on the argument that (1) Shepard Fairey actually copied the Garcia Photo; (2) that Shepard Fairey made and distributed a derivative work—the Hope Poster—that included protected expression from the Garcia Photo, thus appropriating the AP's copyrighted material; and (3) that One 3 Two reproduced Fairey's image on t-shirts and sweatshirts

without the AP's permission. The AP cannot establish that One 3 Two infringed any of the AP's rights unless it proves that the Hope Poster includes protected expression from the Garcia Photo.

As the Court recognized at the hearing on the Parties' Motions for Summary Judgment on February 15, 2011, "[t]he scope of protection can be different for different photographs. There are elements that deserve protection and there are elements that don't." Transcript of February 15, 2011 Hearing ("Tr.") at 12:25-13:2. The Court further noted that "[t]here are differences in the Fairey version. So we need to understand how important are those differences." *Id.* at 20:21-22. It is to those critical issues that Professors Sturken and Cost will speak. Their testimony is not just relevant, but, given the nature of the issues presented, necessary.

1. Professor Marita Sturken's Opinion Regarding the Conventional Nature of President Obama's Pose Is Relevant to the Issue of Substantial Similarity

Professor Sturken holds a Ph.D. and is the Chair of the Department of Media, Culture and Communication at New York University as a well as a professor in that department. Her specialty is the study of visual culture, including the study of images across social arenas. The opinions expressed in her report fall into two general categories: The iconic status of the Hope Poster and the reasons for that status. Among other things, Professor Sturken opines that the pose, angle and gaze of Barack Obama are conventional elements of a portrait of a political leader.[2]

[2] Professor Sturken also opined that the Hope Poster was transformative, and that Fairey's addition of new material to the conventional elements of the Garcia Photo demonstrate a purpose and message that is different from the Garcia Photo. Those opinions were relevant to the fair use defense that both Fairey and One 3 Two asserted, and as to which the Court granted the AP's Motion for Summary Judgment on February 15, 2011. Nonetheless, as argued in One 3 Two's Opposition to the AP's Motion *in Limine* to preclude evidence relating to Fair Use, One 3 Two's reasonable belief that its use of the Hope Poster image was fair use is relevant to the AP's claims, and the evidence should be admitted for that reason as well.

Courts in this District have found that protectible elements of a photograph may include posing the subjects, lighting, angle, selection of the film and camera, evoking the desired expression, background, perspective, shading, and color. *See, e.g., Psihoyos v. The National Geographic Society*, 409 F. Supp. 2d 268, 275 (S.D.N.Y. 2005). While these elements of a photograph may at times be protectible, "[a] copyright in a photograph derives from "the photographer's original conception of his subject, not the subject itself." *Psihoyos*, 409 F. Supp. 2d at 275; *see also* 1 Melville B. Nimmer and David Nimmer, Nimmer on Copyright § 2.08[E][1] (Matthew Bender, Rev. Ed.) ("[C]opyright in [a] photograph conveys no rights over the subject matter conveyed in the photograph."). "Copyright protection extends only to those components of a work that are original to the author…." *Boisson v. Banian, Ltd.*, 273 F.3d 262, 268 (2d Cir. 2001); *Knitwaves, Inc. v. Lollytogs, Ltd.*, 71 F.3d 996, 1003-04 (2d Cir. 1995) ("What is protectable then is 'the author's original contributions,' . . . the original way in which the author has 'selected, coordinated, and arranged' the elements of his or her work.") (citing *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 350, 358 (1991)).

As a result, the non-original "facts" of a photograph—such as the features of the face of a photographic subject—are not protected by copyright. *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 …."). In addition, under the *scenes á faire* doctrine, elements of a photograph that "follow naturally from the work's theme rather than from the author's creativity" are similarly not protectible. *Psihoyos*, 409 F. Supp. 2d at 274. Conventional images or poses that flow naturally from the idea of the photograph are not protectible. Thus, courts have refused to find copyright infringement for the distinctive pose of an image of a hula dancer that appeared in both a

photograph and a stained glass window because the pose flowed naturally from the idea of an image of a hula dancer. *Reece v. Island Treasures Art Gallery*, 468 F. Supp. 2d 1197 (D. Haw. 2006).

Here, One 3 Two contends that although the Garcia Photo and the Hope Poster look similar to one another, all of the similarities flow from elements of the photograph that are not protected. Factually, One 3 Two will show that some of the elements that might be protected in the photograph were not Garcia's original, creative expression because he did not choose, control or otherwise create them, such as the lighting and Obama's expression. One 3 Two will also demonstrate that elements of Garcia's protected expression were not copied in the Hope Poster, such as the angle, shading and background. Finally, and perhaps most significantly, One 3 Two will show that the elements that Garcia's Photo and the Hope Poster have in common and those things that make them appear most similar never belonged to Garcia at all, including the fact of Obama's appearance and his conventional pose, and thus the AP cannot preclude Shepard Fairey or One 3 Two or anyone else from copying them. Professor Sturken's testimony is relevant to this last issue.

Professor Sturken will opine that, based on her study of cultural images over time and across various disciplines, the three-quarters pose is a conventional pose that has long been associated with political leaders. *See, e.g.*, Exhibit B to the AP's Motion, Expert Report of Martia Sturken at 3-8. Professor Sturken includes several examples of other leaders depicted in this same pose, ranging from Andrew Jackson to John F. Kennedy, Jr. to Che Guevera. Because this pose (along with the angle of the image being taken from below) flows naturally from the idea of a political portrait, the *scenes á faire* doctrine establishes that it is not protected by copyright. A jury is unlikely to be familiar with the history of political imagery or to otherwise determine what poses are or are not conventional to political portraits, and Professor Sturken's testimony would assist the trier-of-fact

on that issue. Indeed, the AP's current position flatly contradicts the arguments it made in its Motion for Summary Judgment, where the AP cited to Sturken's opinion on the issue of infringement (albeit while misconstruing her testimony). *See* AP's Motion for Summary Judgment ("MSJ") at 17 and 34. There is consequently no basis to exclude her testimony.

2. Professor Frank Cost's Opinion Relating to Fairey's Creative Process and Changes He Made to the Garcia Photo Is Relevant to the Infringement Analysis

The opinion of Professor Frank Cost is similarly relevant to the infringement analysis. As the Court has recognized, in analyzing substantial similarity it will be necessary to analyze and understand the differences between the Hope Poster and the Garcia Photo. As the Court noted in denying the Parties' motions for summary judgment on the issue of infringement: "There was copying, that's admitted. There was also change, that's admitted. The issue is whether the changes are material in relationship to changing the overall impression." Tr. 23:16-19. Professor Cost will help the jury understand what changes were made so that the jury can assess their materiality.

Professor Cost is a professor of digital imaging and publishing at the College of Imaging Arts and Sciences at Rochester Institute of Technology. Fairey designated Professor Cost as an expert for two reasons: First, the AP has disputed that Shepard Fairey created the Hope Poster as he has claimed, specifically that Mr. Fairey used a material called "Rubylith" which he cut by hand to make the image. Professor Cost recreated Mr. Fairey's process based on the record and opines that, among other things, Mr. Fairey did use Rubylith to create the images. If the AP cross-examines Fairey on that issue and impeaches him, Professor Cost's testimony would be relevant to rebut that impeachment and rehabilitate Mr. Fairey's testimony. It is therefore inappropriate to preclude Professor Cost from testifying before the AP examines Mr. Fairey.

In addition, Professor Cost summarizes some of the changes Fairey made to the Garcia Photo. While some are obvious, like the change in the background, others are more subtle but

impact the total concept and feel of the Hope Poster and an expert can identify those changes for the jury. Although the applicable test for substantial similarity is that of a lay observer, testimony relating to Fairey's creative process and the actual changes he made to the Garcia Photo is nevertheless instructive and will assist the jury in making a more informed observation with respect to what was copied and what was not. The jury can then determine what portions of the Hope Poster (if any) are the protected elements of the Garcia Photo, which elements were Fairey's, and then make the determination about whether the protected elements of the Garcia Photo are substantially similar to the Hope Poster. Thus, One 3 Two is not seeking to put forward Cost's testimony on the ultimate issue of substantial similarity, but rather on what was copied, and, if need be based on the AP's cross examination of Fairey, what was changed. Accordingly, One 3 Two should not be precluded from offering the testimony of Cost at trial.

III. CONCLUSION

For the reasons stated herein, the Court should deny the AP's motion to preclude One 3 Two from presenting Shepard Fairey's expert witnesses at trial.

Dated March 4, 2011
Los Angeles, California

Respectfully Submitted,

By: /s/ Robyn C. Crowther

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