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# Holy Case of Copyright Infringement, Batman!

Aiellen Fajardo\*

## I. INTRODUCTION

Imagine you are the film producer of the next high-action thriller about super-heroes and villains of the big city. You think that Los Angeles and New York City would provide the perfect backdrop for a number of scenes, so your cast and crew arrange to tape there.

The opening scene of the movie is designed to give the audience a taste for the action in store for them. Fittingly, the story begins with a hostage scene atop a downtown multi-story building. Police, news vans, and city officials are gathered in anxious anticipation of what the kidnapers will do next. As the camera sweeps upward to one of the top floors where police-spotlights have been aimed, it takes in much of the street's surrounding area, such as the neighboring buildings and their adjacent gardens, gates, and benches.

Andrew Leicester is suing Warner Brothers ("Warner") over these seconds of film footage in the movie *Batman Forever*.<sup>1</sup> He claims that its opening scenes infringed the copyright in a work that he created called *Zanje Madre*, located in front of the 801 Figueroa Tower in Los Angeles.<sup>2</sup> R&T Development ("R&T") paid Leicester \$2.5 million to create the work.<sup>3</sup> While filming the opening scene, Warner included a brief glimpse of the work, most noticeably the tops of the wrought iron gates of the garden.<sup>4</sup> Leicester says that Warner

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<sup>1</sup> *BATMAN FOREVER* (Warner Bros. 1994). This movie stars Val Kilmer as Batman, Tommy Lee Jones as Two-Face, Jim Carey as The Riddler, and Nicole Kidman as Dr. Chase Meridian.

<sup>2</sup> Plaintiff's Complaint at 20, *Leicester v. Warner Bros.*, (C.D. Cal. 1995) (No. 95-4058).

<sup>3</sup> Jack Skelley, *The Bat Suit: Artist Charges Batman Forever is Two-faced in Copyright Dispute*, L.A. DOWNTOWN NEWS, June 26, 1995 at A1.

<sup>4</sup> The author viewed *Batman Forever* in theaters, on cable television, and again on home videotape. Downtown Los Angeles' Figueroa Street was the location for Gotham's Pan-Asia Town. Other Los Angeles sites that can be seen in *Batman Forever* are the lobby of the

should have sought his permission to use his work when they decided to film on Figueroa Street.<sup>5</sup>

The work creates the courtyard around the ground level of the 801 Figueroa Tower in downtown Los Angeles's financial district. Leicester says that the *Zanje Madre* was carefully created to convey a sense of the harmony between the city of Los Angeles and its natural "tributaries."<sup>6</sup> *Zanje Madre* is the Spanish name given to the main channel of the Los Angeles River after it was modified to more effectively irrigate early farming communities in the Los Angeles Basin.<sup>7</sup> The work offers tenants of 801 Figueroa and passers-by a pleasant respite to the hectic pace associated with the financial district. Water pours from a rock into a cross-shaped pool. This rock is pierced by an arrowhead, recalling the marking on the San Bernardino foothills leading up to the Lake Arrowhead watershed, a nearby source of Los Angeles water. The water from the pool is channeled toward a second reservoir, surrounded on either side by terra cotta "field systems." The second reservoir is connected to a circular desert, symbolic of the Los Angeles Basin. Around this circle stands pairs of columns. The pair of columns nearest the reservoir resembles giant drill heads from water wells. The middle pair of columns recalls the form of skyscrapers. Finally the third, highest pair of columns takes its forms from the 801 Tower itself. A mythical figure is perched on a middle column. The columns on the Eighth Street side of the building have brass crowns which emerge vertically from the column

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Pantages Theater (a Hollywood landmark near the intersection of Hollywood and Vine) and the downtown Los Angeles Theater (built in 1931). Plaintiff's Complaint at 49.

<sup>5</sup> Plaintiff's Complaint at 4. An artist even has the right to hide his new creation from the public eye. *Mazer v. Stein*, 347 U.S. 201, 207 (1954).

<sup>6</sup> Plaintiff's Complaint at 21. Mickey Gustin, arts planner for the Community Redevelopment Agency of Los Angeles, writes:

The Zanje Madre is a splendid example of the artist, architect, and developer working together with the Community Redevelopment Agency to give the City a very special place for people to experience. It is beautiful on a strictly aesthetic level, and it is challenging as it tells a story about this City and its relationship to water.

<sup>7</sup> Plaintiff's Complaint at 20.

core and fan out. A cactus garden and benches are located on the western periphery of the courtyard.<sup>8</sup>

Leicester claims that he suffered irreparable damage to his reputation and the reputation of his artistic creations as a consequence of being associated with the movie *Batman Forever*. Supposed future clients will no longer believe in the purity of his artistic motives if the *Zanje Madre* is associated with a money-making tale of victims and villains. Clients would instead think that he has gone L.A. native.<sup>9</sup>

Statutory damages for intentional infringement of a registered copyright range from \$500 to \$100,000 for each act of infringement.<sup>10</sup> If each showing of the film counts as one act of infringement, Warner stands to pay millions in damages. Does Andrew Leicester have a valid claim?

Moviemakers since the beginning of the industry have filmed on real streets and in real cities. In fact, that is why they picked Hollywood. The outdoor light is exceptionally good a large portion of the year. Other locales have also attracted film producers. King Kong atop the Empire State Building,<sup>11</sup> the Blues Brothers driving past the Chicago Picasso,<sup>12</sup> and Ferris Bueller admiring actual paintings in the Art Institute of Chicago<sup>13</sup> are just a few examples of how movies have incorporated actual buildings, sculptures, and paintings. Indeed, the opening scenes of many movies feature aerial shots in which the camera "pans across" the New York City, Philadelphia, or Las Vegas skylines.<sup>14</sup> Isn't the *Zanje Madre* part of the Los Angeles public domain? For all its artistic merit, the sculpture is simply a construction that breaks up the humdrum of the downtown area. People eat lunch in it, walk by it, probably comment

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<sup>8</sup> Plaintiff's Complaint at 21-4.

<sup>9</sup> Plaintiff's Complaint at 47.

<sup>10</sup> *Id.* See also 17 U.S.C. § 504(c) (1996).

<sup>11</sup> KING KONG (RKO 1933).

<sup>12</sup> THE BLUES BROTHERS (Universal City Studios, Inc. 1980).

<sup>13</sup> FERRIS BUELLER'S DAY OFF (Paramount Pictures 1986).

<sup>14</sup> For example, BRIGHT LIGHTS, BIG CITY (United Pictures, Inc. 1988) starring Michael J. Fox and Helen Slater features aerial footage of the New York City skyline; PHILADELPHIA (TriStar Pictures, Inc. 1993) starring Tom Hanks and Antonio Banderas features aerial footage of the Philadelphia skyline, and CASINO (Universal City Studios 1995) starring Robert DeNiro and Sharon Stone features aerial footage of the Las Vegas skyline.

on it every day. Indeed, tourists using their own video cameras record themselves in front of it. Must moviemakers seek permission from every sculptor, painter or building owner before they decide to film a public street in their movie? Has "public" all of a sudden become "private?"

Although copyright laws have their roots in the United States Constitution,<sup>15</sup> copyright infringement actions against movie production companies for alleged appropriation in their films are fairly recent.<sup>16</sup> As a result, this question is one of first impression for many courts. Part II of this Comment will first present a brief history of United States copyright law. Part III follows with an explanation of the legal elements that Leicester must successfully demonstrate before he may bring a claim of copyright infringement in court. This section will show that Leicester's claim are tenuous at best because the handful of existing, analogous case precedents are on Warner's side. However, since Warner is indeed doing legal battle with Leicester in court, Part IV of the analysis will turn to the fair use doctrine as Warner's best defense against a copyright infringement claim. Courts have dismissed an artist's copyright infringement claim because 1) the artist's work could be seen only for a fleeting amount of time in the movie, and 2) because the use of the work in the film could not substitute for the actual work. Both of these characteristics are similar to Leicester's claim, in that the *Zanje Madre* can only be seen for brief seconds in the movie, and the movie's depiction of the work cannot substitute for the *Zanje Madre* itself.<sup>17</sup> Part V discusses the possibility that Warner may also use the work for hire doctrine, a transfer of ownership and implied license argument, or a public

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<sup>15</sup> The purpose of copyright law is "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8, cl. 8. See generally *The 1976 Copyright Act*, 17 U.S.C. §§ 101-1101 (as amended through 1996).

<sup>16</sup> Heather Meeker, *The Ineluctable Modality of the Visible: Fair Use and Finer Arts in the Post-modern Era*, 10 U. MIAMI ENT. & SPORTS L. REV. 195, 202 (1993). Copyright protection was extended to the visual arts relatively late, because the technology for reproducing images was in its infancy when the 1909 Act was passed. Pictorial, graphic or sculptured works were not appropriate material for copyright protection until *Mazer v. Stein*. 347 U.S. 201 (1954).

<sup>17</sup> *Woods v. Universal Studios, Inc.*, 920 F. Supp. 62 (S.D.N.Y. 1996).

domain argument in its defensive arsenal, although none of these arguments are as strong as the fair use doctrine. The work for hire doctrine mandates that if an employee creates a work in the scope of his employment, then the copyright of the work vests in the employer. If Leicester can be considered an employee of R&T, then Leicester holds no copyright over the *Zanje Madre*. The transfer of ownership and implied license argument, analyzed in Part VI, operates much in the same manner, in that if Leicester transferred his ownership of the *Zanje Madre* to R&T, then R&T is the rightful owner of the work. Through an implied license, R&T allowed Warner to film it. Part VII focuses on parody. Although Warner has a host of other defensive arguments in its favor, a parody argument should be rejected by Warner's counsel as a possible winner for Leicester. Finally, Part VIII presents a more policy oriented, common sense argument in defense of Warner, in that an undesirable "slippery slope effect" could occur should Leicester prevail.

## II. HISTORY

The United States Constitution authorizes the government to grant property rights to artists in their works.<sup>18</sup> In addressing copyrights in the Constitution, the Framers based their considerations on a compromise between protecting an individual's right to profit from his work, and the right of the public to benefit from the artist's creativity.<sup>19</sup> This balance ensures that for a limited time, the owner

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<sup>18</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>19</sup> The law "as presently written, does not recognize moral rights or provide a cause of action for their violation, since the law seeks to vindicate the economic, rather than the personal, rights of authors." *Gilliam v. ABC, Inc.*, 538 F.2d 14, 24 (2d Cir. 1976). The doctrine balances the exclusive right of copyright owners against "the public's interest in the dissemination of information affecting areas of universal concern, such as art, science and industry." *Wainwright Sec. Inc. v. Wall Street Transcript Corp.*, 558 F.2d 91, 94 (2d Cir. 1977), *cert. denied*, 434 U.S. 1014 (1978). See also U.S. CONST. art. I, § 8: "Monopoly privileges granted by Congress are intended to motivate the creative activity of authors and inventors by the provision of a special reward while simultaneously allowing public access to the work after the limited period of exclusive control has expired."

of a copyright could sell, display, perform, distribute, or make copies of his original work at his discretion and for his gain.<sup>20</sup>

To obtain a valid copyright, the work must be an “original work . . . fixed in any tangible medium of expression.”<sup>21</sup> By “original” is meant only those components of the work that are unique to the creator.<sup>22</sup> Originality is not a high threshold to satisfy; courts only require that the creator contribute more than a “mere[ly] trivial” variation.<sup>23</sup> Protection is also limited to the expression of an idea, and not the idea itself.<sup>24</sup>

Copyright notification and registration alerts potential infringers that they must seek permission to copy a copyrighted work or risk the consequences.<sup>25</sup> However, these rights are vested in an owner for only a set period of time.<sup>26</sup> After the owner’s copyright in a work expires, the public has a right of access to the work and free reign to copy or imitate the work. This encourages the spread of new ideas in

<sup>20</sup> “Copyright in a work created on or after January 1, 1978, subsists from its creation and . . . endures for a term consisting of the life of the author and fifty years after the author’s death.” 17 U.S.C. § 106 (1996).

<sup>21</sup> 17 U.S.C. § 102(a) (1996); 15 U.S.C. § 1125(a) (1996). Indeed, copyright immediately vests in your home movies, vacation photographs, or “to-do” lists. Jessica Litman, *The Public Domain*, 39 EMORY L.J. 965, 973 (1990).

<sup>22</sup> *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991).

<sup>23</sup> *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951). See also MELVILLE NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.08[c][1] (“mere dash of originality”); *Feist Publications*, 499 U.S. at 340.

<sup>24</sup> 17 U.S.C. § 102(b) (1996); *Mazer v. Stein*, 347 U.S. 201, 207 (1954). A particularly illustrative example of this distinction between an idea (which is not protected) and the expression of that idea (which is protected) is given in *Rogers v. Koons*, 960 F.2d 301, 307 (2d Cir.), *cert denied*, 506 U.S. 934 (1992). There, the court recognized that ideas are found in the common domain. However, what is protected is the original or unique way an author expresses those ideas. Therefore, the court focused not on the idea transmitted by a photograph of a man and a woman with eight small puppies seated on a bench, but rather on Rogers’ particular expression of that idea—“as caught in the placement, in the particular light, and in the expression of the subjects—that gives the photograph its charming and unique character.” *Rogers*, 960 F.2d at 308.

<sup>25</sup> NIMMER, *supra* note 23. Copyright laws do not “condone a practice of infringe now, pay later.” *Woods v. Universal City Studios, Inc.*, 920 F. Supp. 62, 65 (S.D.N.Y. 1996). Damages awarded may be actual or statutory, and may include attorneys’ fees. 17 U.S.C. §§ 504(b), 504(c), 505 (1996).

<sup>26</sup> For works created after 1977, the protection lasts for the “life of the author and fifty years after the author’s death.” 17 U.S.C. § 302(a) (1996).

the market place, and fosters an environment of competition among artists who find it useful to copy the work.

### III. COPYRIGHT INFRINGEMENT DOCTRINE

The test by which a plaintiff may make a case for copyright infringement consists of two elements: 1) plaintiff must prove that he owns a valid copyright and 2) plaintiff must prove defendant infringed one of his exclusive rights (including actual copying).<sup>27</sup> Most plaintiffs have little problem fulfilling the first element.<sup>28</sup> However, what qualifies as "copying" is a complex notion to measure.

A "copy" has been defined with approval by the Supreme Court as "[t]hat which comes so near the original as to give to every person seeing it the idea created by the original."<sup>29</sup> To establish that the defendant engaged in copying, a plaintiff must show that the defendant mechanically copied the plaintiff's work.<sup>30</sup> There must also be some degree of permanence. Otherwise, the defendant is found not to have copied under the *de minimus* maxim.<sup>31</sup>

Only rarely does direct evidence of copying exist.<sup>32</sup> If evidence of direct copying is unavailable, proof of access to the work and

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<sup>27</sup> 17 U.S.C. § 501 (1996).

<sup>28</sup> Although registration is not legally necessary, a certificate of registration from the U.S. Register of Copyrights is prima facie evidence of a valid copyright. However, this presumption is rebuttable. 17 U.S.C. § 410(c) (1996).

<sup>29</sup> *Amsinck v. Columbia Pictures Indus.*, 862 F. Supp. 1044, 1046 (S.D.N.Y. 1994).

<sup>30</sup> *Id.*, at 1047.

<sup>31</sup> *Mura v. CBS*, 245 F. Supp. 587, 589-90 (S.D.N.Y. 1965).

It would seem that a copy involves the conception that it must have some degree of permanency or the maxim *de minimis* would apply. Thus, while the making of a single copy may be infringement, if this copy were destroyed almost as soon as made, as, for example, if a vaudeville artist drew with colored chalks, or if a verse were cast upon a screen through a stereopticon, it may be doubted whether such a temporary production could fairly be called a copy.

*Id.* (quoting ARTHUR W. WEIL, *AMERICAN COPYRIGHT LAW* 406 (1917)).

<sup>32</sup> *Rogers v. Koons*, 960 F.2d 301 (2d Cir.), *cert. denied*, 113 S.Ct. 365 (1992), was one of the rare cases of copyright infringement in which there was direct evidence of copying. Koons neither drew nor painted. He bought a copy of a postcard, tore the copyright notice off, and sent it to Italy to be copied.



substantial similarity between the two works suffices.<sup>33</sup> Proof of access is fulfilled if the work is in a place like a museum such that the defendant would not have to do anything illegal to see it.<sup>34</sup> Even if it were difficult to prove that the defendant actually viewed the original work, proof that the defendant had a reasonable opportunity to view it is enough.<sup>35</sup>

Showing substantial similarity between the original work and the work in question, however, is more problematic.<sup>36</sup> Substantial similarity does not require identical copying of every detail.<sup>37</sup> The main inquiry is whether the similarities between the original and the copy are similarities of "idea" or of "expression."<sup>38</sup> There is no infringement if the copying involves unprotected aspects of the work, such as ideas, processes or facts,<sup>39</sup> or if only insubstantial similarities exist between the copyrightable expression of the two works.<sup>40</sup>

Two categories of substantial similarity exist: comprehensive, non-literal similarity and fragmented, literal similarity.<sup>41</sup> The former category means similarity between the two works not just to a minor segment, but where the fundamental essence of a work is duplicated in another.<sup>42</sup> The latter category recognizes that the defendant may have literally copied the work; the question becomes whether the similarity relates to matter that constitutes a substantial portion of the author's work.

Leicester cannot prove comprehensive, non-literal similarity. Since the *Zanje Madre* is on a busy city street outdoors, Warner had access to the work. However, Warner's fleeting depiction of the *Zanje Madre* is clearly not substantially similar to the actual work. It

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<sup>33</sup> NIMMER, *supra* note 23, § 13.01.

<sup>34</sup> *Id.* at § 13.02.

<sup>35</sup> *Id.*

<sup>36</sup> It is in this step of the analysis that "copying" becomes a question to be determined by the specific facts of the case at hand. *Id.* at § 13.05[A].

<sup>37</sup> *Id.* at § 13.03[A].

<sup>38</sup> *Id.* at § 13.03.

<sup>39</sup> 17 U.S.C. § 102(b) (1978); H.R. REP. NO. 94-1476, 94th Cong., 2d. Sess. 56-67 (1976).

<sup>40</sup> WILLIAM F. PATRY, *THE FAIR USE PRIVILEGE IN COPYRIGHT LAW* 361 (1985).

<sup>41</sup> NIMMER, *supra* note 23, § 13.03[A].

<sup>42</sup> *Id.* at § 13.03[A][1].

can hardly be said that Warner duplicated the fundamental essence of the work. The work's symbolism of harmony between Los Angeles and its waterways cannot be detected in the movie, the theme of which is a hero's fight against evil. There is no comprehensive, non-literal similarity and therefore no substantial similarity.

There is also no fragmented, literal similarity. Warner may have literally filmed the *Zanje Madre*. But only a minor segment of the work can be seen in *Batman Forever*. That is not to say that Warner may claim immunity on the grounds that the infringement "is such a little one."<sup>43</sup> If, however, the similarity is only as to nonessential matters, then there is no substantial similarity.<sup>44</sup> Assessing what are "nonessential matters" is a value judgment.<sup>45</sup> Here, Warner can argue that such a small part of the *Zanje Madre* was duplicated that it should be regarded *de minimus*. Not the whole work, but merely the tops of the columns are seen in the movie. Those parts of the work in the movie are so "nonessential" without the garden and stream components of the work, that no one would ever recognize it in the movie. Thus, there is no substantial similarity.

In determining whether there is substantial similarity of either of the above categories, two questions must be asked: 1) whether the defendant copied from plaintiff's work, and 2) whether defendant took so much of plaintiff's work that defendant wrongfully appropriated something which belongs to plaintiff.<sup>46</sup>

Leicester can satisfy the first question, since Warner indeed copied Leicester's work. The second question is harder for Leicester to support. Whether defendant took so much of plaintiff's work that defendant wrongfully appropriated something which belongs to plaintiff is answered through the ordinary observer test.<sup>47</sup> If an ordinary person who has recently seen a work recognizes that work in

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<sup>43</sup> NIMMER, *supra* note 23, § 13.03[A][2] (quoting *Chicago Record-Herald Co. v. Tribune Ass'n*, 275 F. 797 (7th Cir. 1921)).

<sup>44</sup> *Id.*

<sup>45</sup> *Id.*

<sup>46</sup> NIMMER, *supra* note 23, § 13.03[E][3].

<sup>47</sup> *Id.* at § 13.03. See also *Ideal Toy Corp. v. Fab-Lu Ltd.*, 360 F.2d 1021, 1022 (2d Cir. 1966).

a movie immediately and spontaneously, without any aid or suggestion or critical analysis by others, then there is substantial similarity.<sup>48</sup>

Here is where Warner beats Leicester at his own game. Warner may have to admit to copying, but the ordinary movie-goer who knew what the *Zanje Madre* looked like would not recognize it in *Batman Forever*. It is just too difficult to discern the work in the film. In addition to poor lighting due to the movie's mood of darkness, the couple of scenes with the *Zanje Madre* in it are too fleeting to get a good image of it. It more likely would escape notice by the ordinary observer, and would be recognizable only if someone pointed it out to her or suggested it was there.<sup>49</sup> There is no substantial similarity between the work and what appeared in the movie. Thus, Leicester cannot even bring forth a case for copyright infringement.

#### A. *The Total-Concept-and-Feel Test*

The Ninth Circuit has applied another test for judging substantial similarity called the Total-Concept-and-Feel test,<sup>50</sup> which would favor Warner. It is very similar to the traditional, two-part analysis for substantial similarity. The first question of the traditional analysis becomes a question of "extrinsic" similarity. This asks whether there is similarity in general ideas.<sup>51</sup> The second question of the traditional analysis in turn becomes a question of "intrinsic" similarity, measured by the ordinary observer test.<sup>52</sup>

Here again, Warner prevails. The extrinsic similarity prong of the Total-Concept-and-Feel test proves difficult for Warner, because the actual work appears in the movie. Beyond a similarity between

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<sup>48</sup> See generally NIMMER, *supra* note 23, § 13.03[E][1][b].

<sup>49</sup> Indeed, after visiting the *Zanje Madre* and then viewing "Batman Forever" on video, it took several "stops," "rewinds" and "pauses" for this author to catch a glimpse of the work.

<sup>50</sup> In *Roth Greeting Cards v. United Card Co.*, 429 F.2d 1106, 1110 (9th Cir. 1970) the court found infringement when "the characters depicted in the art work, the mood they portrayed, the combination of art work conveying a particular mood with a particular message, and the arrangement of the words on the [defendant's] greeting card[s] [were] substantially the same" as on the plaintiff's cards. See also *Sid & Marty Krofft Tel. Prods. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977).

<sup>51</sup> NIMMER, *supra* note 23, § 13.03[A][1][c].

<sup>52</sup> See *supra* note 47 and accompanying text.

general ideas, Warner appropriated the work itself. However, there is no intrinsic similarity between the two, as measured by the ordinary observer test. The moods of the *Zanje Madre* and of the movie are totally different. The mood that the *Zanje Madre* imparts is calm, serene, and harmonious. The mood of the film, on the other hand, is high-action, cynical, and eerie. The mood of *Batman Forever* is not such that the ordinary person would recognize the work in the movie. Thus, if the Los Angeles trial court of the Ninth Circuit decides to use the Total-Concept-and-Feel test, Leicester will still not be able to bring forth a case for copyright infringement.

### B. Analogous Cases

If Leicester is able to put together a case for copyright infringement, Warner would first look to analogous cases which were decided in the infringer's favor. A recent case which closely resembles the current Leicester/Warner controversy is *Woods v. Universal Studios, Inc.*<sup>53</sup> Artist Lebbeus Woods created a pencil drawing called *Neomechanical Tower (Upper) Chamber* which depicted a chamber with a high ceiling, a chair mounted on a wall and a sphere suspended in front of the chair at face level. The wall and floor of the chamber are comprised of large rectangles forming a grid pattern. The chair is attached to a vertical rail on the wall. The drawing appeared in a catalog published in 1987.

In 1995, Universal Studios released the movie *12 Monkeys*. In an opening scene, Bruce Willis is brought into a room, and is ordered to sit in a chair which is attached to a vertical rail on a wall. The chair slides up the rail several yards above the floor. A sphere descends from above and stops at face level, suspended by a metal armature. The movie's director admitted that in preparing the set design for *12 Monkeys*, he reviewed a copy of a book that included Woods' drawing and discussed it with the movie's production designer.<sup>54</sup> Woods saw the movie in early 1996, and notified Universal of his suit for copyright infringement. Woods successfully proved copying; indeed,

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<sup>53</sup> 920 F. Supp. 62 (S.D.N.Y. 1996).

<sup>54</sup> *Id.* at 64.

the court noted that the movie copied Woods' drawing in striking detail. There was a mechanical copying of Woods' drawing, such that it was not merely a fleeting image on the screen, but an integral part of the scene. One could go even further and say that Universal made a set out of Woods' drawing.<sup>55</sup>

At first glance, Woods' case would seem to suggest that Leicester has a fighting chance against Warner. The court ruled that Universal copied Woods' drawing by making a real-life model of it. Similarly, not only did Warner copy Leicester's work, but they actually filmed it as it appears at 801 Figueroa. However, there are many distinctions between the two cases which suggest that Leicester cannot win a case for copyright infringement.

The first distinction is that Woods' *Chamber* ultimately became the set for a number of scenes in the movie. In *Batman Forever*, Leicester's work was never filmed as an integral part of any scene, much less an actual set of the movie. The snippets of film in which the *Zanje Madre* can be discerned are but fleeting seconds in length.

A second distinction is that Universal intended to imitate the drawing by bringing it to life as a real movie set. The main character, played by Bruce Willis, sat in a room that looked exactly like Woods' *Chamber*. On the other hand, Warner did not intend to replicate the *Zanje Madre* into a movie set. As a symbolic interplay between the city and its natural surroundings, the *Zanje Madre* is plant life with running water, surrounded by statuesque columns and man-made benches. This setting is easily distinguished from the eeriness and mystery created by the set-makers of *Batman Forever*. Most of the scenes in the movie are dark and set at night; hardly any of the scenes are during daylight hours or set in bright light. When the film crew of *Batman Forever* filmed the hostage scene on Figueroa Street, neon street signs, scattered car headlights and TV news spotlights were the only lights on an otherwise dark street. Even the sky was black-purple. Consequently, the garden component of the *Zanje Madre* cannot be seen in the movie, and the only discernible portion of the work in the film are the tops of the columns of the wrought-iron gate.

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<sup>55</sup> *Id.* The court waited to enforce an injunction until Woods provided separate copyright registration certificates for the 1987 pencil drawing.

Therefore, the set-makers of *Batman Forever* did not intend to create a copy of *Zanje Madre* for their movie, much less show the *Zanje Madre* in exact detail.

Finally, a third distinction is that Universal's *12 Monkeys* producer admitted that he discussed the drawing with the production designer, making it a clear cut case of copying.<sup>56</sup> Copying that is so "blatantly apparent" may not even require a trial.<sup>57</sup> With such strong evidence against Universal, Woods prevailed in his claim of copyright infringement. On the other hand, Leicester puts forth no such evidence that the production designers of *Batman Forever* considered incorporating his work in the film. Had Warner's intention been to film Leicester's work as an integral part of the movie, then they hardly succeeded. Only a brief glimpse of the work is seen in the movie. The *Zanje Madre* is not filmed in any detail nor is the work a focal point in any of the scenes of the movie. More likely, the creators of *Batman Forever* wanted to make the characters the focal point of the movie. The bright purple and crimson of Batman and Robin's costumes, as well as the signature shocking green of the Riddler, show even more starkly on the movie screen set against the darkness of the night sky and gray city. Moreover, only a small part of the *Zanje Madre* that is shown for mere split seconds in the film. All these dissimilarities make Leicester's case easily distinguishable from Woods' case of copyright infringement.

A case more analogous to the Warner/Leicester controversy is *Amsinck v. Columbia Pictures Industries, Inc.*<sup>58</sup> In that case, plaintiff Amsinck owned a 1986 copyright in a Baby Bears design which she licensed to a number of entities. One of these entities created a Baby Bears Musical Mobile based on her design. The package containing the mobile identified Amsinck as the copyright owner.

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<sup>56</sup> *But see* *Weissmann v. Freeman*, 868 F.2d 1313 (2d Cir.), *cert. denied*, 493 U.S. 883 (1989), (researcher's use of a syllabus was not a fair one because defendant's planned use of the syllabus was for the same intrinsic purpose as that intended by plaintiff, thereby undermining plaintiff's ability to enjoy the fruits of her labor); *see also* *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539 (1985) (verbatim quotes from the "heart" of unpublished presidential memoirs were intended to supplant copyright holders' commercially valuable right of first publication).

<sup>57</sup> *Rogers v. Koons*, 960 F.2d 301, 307 (2d Cir.), *cert. denied*, 113 S.Ct. 365 (1992).

<sup>58</sup> 862 F. Supp. 1044 (S.D.N.Y. 1994).

In 1989, Columbia Pictures released *Immediate Family*, a movie in which the mobile appears in several scenes of a bedroom where a couple is building a nursery. Columbia even altered the mobile that it was more easily filmed. They hung the mobile from the ceiling rather than from the crib. This is not a “mechanical” copying, but instead one in which the defendants have used the actual work in the film. A movie-watcher could only see the mobile for seconds, which made its appearance fleeting and impermanent.<sup>59</sup> Columbia did not seek Amsinck’s permission nor did they put her name in the credits. In deciding that Columbia did copy Amsinck’s Mobile, the court was persuaded by Columbia’s argument that its use was fair. In the following section, this will be shown to be the most convincing argument for Warner, as well.<sup>60</sup>

#### IV. THE FAIR USE DOCTRINE

##### A. *The Basic Doctrine*

If a plaintiff makes a successful case for copyright infringement by proving the requisite elements,<sup>61</sup> the fair use doctrine permits the defendant to infringe on a copyright without fault.<sup>62</sup> The equitable<sup>63</sup> doctrine of fair use allows defendants to appropriate a copyrighted work in a reasonable manner without the copyright owner’s consent.<sup>64</sup> This exception considers the goal of copyright law to encourage the creation of original expression, but yet avoid suppression of creation of new expression that is based on existing works.<sup>65</sup> Courts must occasionally subordinate the copyright owner’s

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<sup>59</sup> *Id.* at 1044.

<sup>60</sup> *Id.* at 1048.

<sup>61</sup> See *supra* note 27 and accompanying text.

<sup>62</sup> PATRY, *supra* note 40, at 1.

<sup>63</sup> *Id.* The courts must be free to adapt the doctrine to particular situations on a case by case basis.

<sup>64</sup> 17 U.S.C. § 107 (1994).

<sup>65</sup> Meeker, *supra* note 16, at 196.

interest to maximize financial return to the greater public interest in the development of art, science and industry.<sup>66</sup>

Fair use is one of the most troublesome concepts to grasp because, like so many other doctrines in the law, there are no exact lines of demarcation, only loose guidelines.<sup>67</sup> The Supreme Court emphasized that this is an "equitable rule of reason,"<sup>68</sup> in that fair use presupposes that the alleged infringer acted in good faith.<sup>69</sup> Thus, when courts decide if a use is fair, courts must judge according to traditional equities of fair use.<sup>70</sup> Courts utilize four factors identified by Congress and enumerated in federal statute when determining fair use: 1) the purpose and character of the use, 2) the nature of the copyrighted work, 3) the amount and substantiality of the work used, and 4) the effect of the use on the market value of the original.<sup>71</sup>

### 1. The Purpose and Character of the Use

The purpose and character of the use means whether the copying was done in good faith<sup>72</sup> to benefit the public, or instead done with the commercial interest of the user in mind.<sup>73</sup> Commercial use weighs heavily in favor of a finding of unfair use.<sup>74</sup> If the use was motivated by commercial gain, this factor weighs heavily against fair use. However, the issue is not whether the sole motive was monetary

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<sup>66</sup> Berlin v. E.C. Publications, Inc., 329 F.2d 541, 544 (2d Cir.), *cert. denied*, 379 U.S. 822 (1964).

<sup>67</sup> MacDonald v. Du Maurier, 144 F.2d 696, 701 (2d Cir. 1944).

<sup>68</sup> Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417 (1984).

<sup>69</sup> Marcus v. Rowley, 695 F.2d 1171, 1175 (9th Cir. 1983).

<sup>70</sup> 17 U.S.C. § 107 (1994).

<sup>71</sup> *Id.*

<sup>72</sup> Time Inc. v. Bernard Geis Assocs., 293 F. Supp. 130, 146 (S.D.N.Y. 1968).

<sup>73</sup> MCA, Inc. v. Wilson, 677 F.2d 180, 182 (2d Cir. 1981).

<sup>74</sup> Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 451 (1984) ("[E]very commercial use of copyrighted material is presumptively an unfair exploitation of the monopoly privilege that belongs to the owner of the copyright . . ."). Indeed, a wrongful denial of use with commercial interests in mind militates heavily against an otherwise strong case for fair use. Rogers v. Koons, 960 F.2d 301, 308 (2d Cir.), *cert. denied*, 113 S.Ct. 365 (1992).



gain, but whether the user would profit without paying the customary price.<sup>75</sup>

Certain purposes in which fair use is most likely to be found are criticism, comment, news reporting, teaching, scholarship, and research.<sup>76</sup> These examples indicate that fair uses are those that contribute in some way to the public welfare.<sup>77</sup> However, these examples are not exhaustive.<sup>78</sup>

The first factor is not determinative. Fair use depends on the totality of factors.<sup>79</sup> Therefore, even if this factor weighs heavily against the defendant, analysis under the next three factors should continue.<sup>80</sup>

In *Amsinck*, the purpose of the film was not criticism, comment, or news reporting. Columbia was not motivated by some humanistic yearning to convey some message to the American public. Instead, production companies make movies to realize commercial gains. Thus, Columbia's claim of fair use is cannot be substantiated by the first factor of fair use alone. However, Columbia did not intend to profit from the use of the mobile without paying the "customary price." Critics who provide criticism for commercial gain commit no infringement. Columbia's use of the mobile was not for the purposes of taking over demand for *Amsinck's* work, just as a critic's use of a clip from a movie is not for the purpose of taking over demand for that movie.

Like Columbia, Warner made *Batman Forever* as a commercial enterprise. However, Warner's particular use of the *Zanje Madre* in its film was not to achieve monetary gain. More likely, Warner chose

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<sup>75</sup> Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 562 (1985). See also NIMMER, *supra* note 23, § 13.05[A][1].

<sup>76</sup> 17 U.S.C. § 107 (1994).

<sup>77</sup> Pacific and S. Co., Inc. v. Duncan, 744 F.2d 1490, 1496 (11th Cir. 1984).

<sup>78</sup> When a broadcast uses a work located in the scene of an event being reported, there is a possible fair use defense. Patry has argued that there is no conceptual reason why these uses should be considered fair use, and describes them as examples of excused innocent infringement. See *supra* note 40 at 408.

<sup>79</sup> Wojnarowicz v. American Family Ass'n, 745 F. Supp. 144 (S.D.N.Y. 1990). In this case, the court went through all four factors and found that the second factor weighed in favor of plaintiff, but the first and third factors and especially the fourth factor weighed heavily in favor of fair use.

<sup>80</sup> Rogers v. Koons, 960 F.2d 301, 309 (2d Cir.), *cert. denied*, 113 S.Ct. 365 (1992).

the Los Angeles locale for its convenience to the recording studios and because it was easily convertible to a Gotham City street. Anyone who has viewed *Batman Forever* would be hard-pressed to say the work was ever filmed with an eye to capturing the *Zanje Madre's* essence, its creativity, or even its entirety. That is because Warner *incidentally* filmed the work. For Warner and the justice system, it is simply the case of the wrong work with the wrong creator; that is, a creator who is willing to abuse the legal system for his own ends.

## 2. The Nature of the Copyrighted Work

The nature of the copyrighted work means whether the work is creative, imaginative, or represents an investment of time on the part of the creator in anticipation of a financial return.<sup>81</sup> The more creative a work, the more protection it should be accorded from copying.<sup>82</sup> As with the first factor, even if the second factor militates heavily against a finding of fair use, analysis under the other factors is necessary.<sup>83</sup> Thus, in its application to *Amsinck*, the court found that even though her work was creative, this factor was not enough to defeat fair use.<sup>84</sup>

Leicester's sculpture is definitely a creative work. The *Zanje Madre* is the product of his imagination, creativity and hard work. No one could have created the *Zanje Madre* by looking it up in a textbook. It was something only Leicester's mind could have fathomed, and only his hands could have molded. However, as the *Amsinck* court held, this factor is not determinative. Therefore, a close examination of all the factors must be done before fair use can be ruled out.

## 3. The Amount and Substantiality of the Work Used

The amount and substantiality of the work used goes to the amount of copying of expression, not the factual content of the material in the

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<sup>81</sup> Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 452 (1984).

<sup>82</sup> Maxtone-Graham v. Burtcheall, 631 F. Supp. 1432 (S.D.N.Y. 1986).

<sup>83</sup> See *supra* note 79.

<sup>84</sup> *Amsinck v. Columbia Pictures Indus., Inc.*, 862 F. Supp. 1044, 1050 (S.D.N.Y. 1994).

copyrighted works.<sup>85</sup> When more of the work is copied than necessary, it is an unfair use.<sup>86</sup> However, sometimes even wholesale copying is permitted.<sup>87</sup>

The *Amsinck* court found that Columbia also violated the third factor. Not only was the work copied, but the actual and entire mobile was used. However, the mobile was seen for mere seconds, or a fleeting amount of time.<sup>88</sup>

This factor also militates against Warner, because not only did it copy the *Zanje Madre*, but it actually used the genuine work in the film. However, like the mobile, the work is seen for split seconds in the opening scenes of the movie. Therefore, even if this factor does weigh in favor of unfair use, this is not the last consideration.

#### 4. Fair or Foul: The Fourth Factor of Fair Use

The fourth factor of fair use analyzes the effect of the use on the market value of the original. This factor is the central consideration in determining fair use.<sup>89</sup> It weighs the benefit gained by the copyright owner when the copying is found to be unfair and the benefit gained by the public when the copying is found to be fair.<sup>90</sup> This factor asks whether the use tends to interfere with sales of the copyrighted work.<sup>91</sup> Can the copying be used as a substitute for the

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<sup>85</sup> *Salinger v. Random House, Inc.*, 811 F.2d 90, 97 (2d Cir. 1987).

<sup>86</sup> *Rogers v. Koons*, 960 F.2d 301, 310 (2d Cir.), *cert. denied*, 113 S.Ct. 365 (1992).

<sup>87</sup> *See Maxtone-Graham*, 631 F. Supp. at 1263.

<sup>88</sup> Time seems to be a prominent consideration of whether wholesale copying is permitted. *See Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 424 (1984). In *Sony*, the defendant's copying equipment (Betamax video cassette recorders) was used by the public to record television programs—the copyright of which was owned by plaintiffs. "Time-shifting" actually enlarged the viewing audience, and did not impair plaintiff's right in the value of the copyright. *Id.*

<sup>89</sup> *See also NIMMER*, *supra* note 23, §13.05[A][1] ("This last factor is undoubtedly the single most important element of fair use.").

<sup>90</sup> *Rogers v. Koons*, 960 F.2d 301, 311 (2d Cir.), *cert. denied*, 113 S.Ct. 365 (1992). To invalidate a fair use claim, a plaintiff could show that if the infringing use "should become widespread, it would adversely affect the potential market for the copyrighted work." *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 450 (1984).

<sup>91</sup> *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 566 (1985).

copyright owner's work?<sup>92</sup> Where the copy does not compete in any way with the original, the law's central concern that creation will be discouraged if demand can be undercut by copiers is absent.<sup>93</sup> If the copyright owner suffers no demonstrable harm from use of the work, the doctrine requires a finding of fair use on the part of the defendant.<sup>94</sup> The less adverse the effect that the alleged infringer has on the copyright owner's expectations of financial gain, the less public benefit need be shown to justify the copying.<sup>95</sup>

The *Amsinck* court based its entire decision on this factor. The use of the mobile in the movie could hardly undercut demand for the mobile itself. This is because a film clip of a mobile cannot perform the functions of an actual mobile. Columbia's use of the mobile could not have prejudiced sales of the design or sales of the mobile. If people saw the movie and wanted a mobile, they could not have bought the video and expected it to fulfill their mobile needs. A filmed mobile cannot be used as a substitute for an actual mobile. *Amsinck* failed to demonstrate any harm from use of the work. Her expectations of financial gain were in no way lessened by Columbia's use of the work. Therefore, the court gave this factor overwhelming consideration, even though the other three factors all leaned toward a finding of unfair use, and ruled that Columbia's use was fair.

If fair use fails when copying is substantial,<sup>96</sup> then the *Amsinck* court seems to have given undue deference to the fourth factor. But as with most laws, there are exceptions. Virtually complete copying is almost always an infringement on a copyright; however, if use of the entire work does not supplant the function of the work, then the use may be deemed fair.<sup>97</sup> Thus, the *Amsinck* court reasoned that such incidental use of the mobile in Columbia's film could not function as a replacement for the mobile.

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<sup>92</sup> *Mura v. CBS*, 245 F. Supp. 587, 590 (S.D.N.Y. 1965).

<sup>93</sup> *Consumers Union v. General Signal Corp.*, 724 F.2d at 1051.

<sup>94</sup> *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 452 (1984).

<sup>95</sup> *MCA, Inc. v. Wilson*, 677 F.2d 180, 183 (2d Cir. 1981).

<sup>96</sup> See also *NIMMER*, *supra* note 23, § 13.05[D][1].

<sup>97</sup> *Id.*

A similar case which does not find infringement is *Mura v. CBS*.<sup>98</sup> In this case, a copyright holder in a design for a pig hand puppet and a rooster hand puppet brought a copyright infringement case against Columbia for broadcasting the puppets on a Captain Kangaroo program for approximately thirty-five seconds. The court reasoned that the copies of the hand puppets on the program could not be used as a substitute for the original works. Therefore, even if it was a copy of the hand puppets,<sup>99</sup> the court concluded that Columbia's use of the puppets was a fair one.<sup>100</sup> "[T]he *evanescent* reproduction of a hand puppet on a television screen . . . is so different in nature from the copyrighted hand puppet that [it is] not a copy . . . the puppets were not the principle attraction on the television programs. Rather, their use was *incidental*."<sup>101</sup>

If factor four is accorded the same weight as it was in *Amsinck* or *Mura*, then clearly Warner will prevail. In no way does the film footage of the *Zanje Madre* substitute for the work itself. The fleeting seconds showing the *Zanje Madre* were hardly enough time for a prospective buyer or patron to develop interest in the work, much less consider the footage an adequate substitute for the work. The work is more than what can be seen in the movie; it is a garden, with seats for people to eat lunch. It has a fountain with a stream running its length, and it is colorful and vibrant, not dark and monochromatic. Thus, someone who has seen the *Zanje Madre* and then the movie would hardly come to the conclusion that she saw it in the movie. Even if someone did recognize the *Zanje Madre* in the movie, the fleeting images of it in the movie are not enough to act as a substitute for the work. Thus, under a fair use defense, Leicester's claim must fail.

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<sup>98</sup> 245 F. Supp. 587 (S.D.N.Y. 1965).

<sup>99</sup> The court looked to whether the reproduction of the images of the puppets was so transitory and impermanent in nature that it could not be a "copy." *Id.* at 588.

<sup>100</sup> *Id.* at 590.

<sup>101</sup> *Id.* (emphasis added).

## V. WORK FOR HIRE DOCTRINE

Copyright in a work vests initially in the author of the work.<sup>102</sup> However, in the case of a work made for hire,<sup>103</sup> the employer or other person for whom the work was prepared is considered the author for the purpose of the 1976 Copyright Act,<sup>104</sup> and unless the parties have expressly agreed otherwise in a signed, written instrument, owns all of the rights comprised in the copyright.<sup>105</sup> The presumption that

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<sup>102</sup> 17 U.S.C. § 201(a) (1994).

<sup>103</sup> A work made for hire is . . . (1) a work prepared by an employee within the scope of his or her employment; or (2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire.

17 U.S.C. §§ 101(1)-(2) (1994). The concept of a work made for hire first arose in controversies over copyright ownership involving works by persons who were employees. See, e.g., *Colliery Eng'g Co. v. United Correspondence Sch. Co.*, 94 F. 152 (S.D.N.Y. 1899); *Little v. Gould*, 15 F. Cas. 612 (N.D.N.Y. 1852). The Supreme Court first took note of the work for hire doctrine in *Bleistein v. Donaldson Lithographing Co.* 188 U.S. 239, 248 (1903). The Court found that an employer owned the copyright to advertisements that had been created by an employee in the course of his employment. *Id.*

<sup>104</sup> 17 U.S.C. § 302 (1994).

<sup>105</sup> 17 U.S.C. § 201(b) (1994). Under 17 U.S.C. § 106, the copyright holder is entitled to the exclusive rights to reproduce, distribute, perform and display the work, and to prepare derivative works based upon it. Though these rights may be held separately, at the point of creation, all rights vest in the legal author of the work. Karen L. Gulick, *Creative Control, Attribution and the Need for Disclosure: A Study of Incentives in the Motion Picture Industry*, 27 CONN. L. REV. 53, n.42. Imposing the burden to contract to avoid the statutory rule on the purchaser, who generally has the stronger bargaining position and readier access to legal advice, is the intended balance. See VARMER, WORKS MADE FOR HIRE AND ON COMMISSION STUDY NO. 13 FOR THE SENATE SUBCOMMITTEE ON PATENTS, TRADEMARKS AND COPYRIGHTS 140, 86th Cong., 1st Sess., Copyright Law Revision (Comm. Print 1961) (*cited in Dumas v. Gommerman*, 865 F.2d 1093, 1101 (9th Cir. 1989)). Although the Act does not define "employee," "employment," or related terms, it is inferred that Congress meant them in their settled, common law sense, since nothing in the text of the work for hire provisions indicates that those terms are used to describe anything other than the conventional relation of employer and employee. Congress' intent to incorporate agency law definitions is suggested by § 101(1)'s use of the term "scope of employment," a widely used agency law term of art. Moreover, the general common law of agency must be relied on, rather than the law of any particular state, since the Act is expressly intended to create a federal law of

initial ownership rights vest in the employer for hire is well established in copyright law.<sup>106</sup> However, it is clear in the statute that parties must agree before the creation of a work that it will be a work made for hire.<sup>107</sup> This was written into the statute to protect people against false claims of oral agreements.<sup>108</sup>

An equally important purpose in legislating the work for hire designation was to ensure predictability through advance planning.<sup>109</sup> Only works produced by formal, salaried employees are covered by the 1976 Copyright Act, 17 U.S.C. § 101(1). When an artist holds himself out as a freelancer, his employer should anticipate that the commissioned work will not be a work for hire.<sup>110</sup> The hiring party need not possess or exercise artistic control over the product for a work to be "specially ordered or commissioned" within the meaning of § 101(2).<sup>111</sup> The key issue is whether the person who requested the work was the main reason for the preparation of the creation of the work.<sup>112</sup>

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uniform, nationwide application by broadly preempting state statutory and common law copyright regulation. 17 U.S.C. § 302(c) (1994).

<sup>106</sup> 17 U.S.C. § 201 (historical notes, 1994). In the case of a work made for hire, the copyright endures for a term of seventy-five years from the year of its first publication, or a term of one hundred years from the year of its creation, whichever expires first. 17 U.S.C. § 302(c) (1994). In effect, the existence of this provision means that an employee does not have the right to terminate the ownership rights of the employer after thirty-five years. Without the provision, the employee would be able to terminate what would otherwise be treated as a transfer of his or her own copyright ownership. Gulick, *supra* note 105, at n.32.

<sup>107</sup> *Playboy Enters., Inc. v. Dumas*, 53 F.3d 549, 559 (2d Cir.), *cert. denied*, 116 S.Ct. 567 (1995).

<sup>108</sup> *Id.* at 558 (citing *Schiller & Schmidt, Inc. v. Nordisco Corp.*, 969 F.2d 410 (7th Cir. 1992)).

<sup>109</sup> *Community for Creative Non-Violence v. Reid*, 490 U.S. 730, 750 (1989). However, Nimmer makes a creative argument that if the written requirement is strictly adhered to, parties who intended for a work for hire, but did not get around to executing all the necessary paperwork before the start of the creation of the work, are frustrated by the whole bureaucratic process. NIMMER, *supra* note 23, § 5.03[B][2][b].

<sup>110</sup> *Dumas v. Gomerman*, 865 F.2d 1093, 1104 (9th Cir. 1989).

<sup>111</sup> This argument was explicitly rejected by the Supreme Court in *Playboy Enters., Inc. v. Dumas*, 53 F.3d 549, 561 (2d Cir.), *cert. denied*, 116 S.Ct. 567 (1995).

<sup>112</sup> NIMMER, *supra* note 23, § 5.03[B][2][d] (*quoted in Playboy*, 53 F.3d at 549). However, when the relationship between the parties is ambiguous, it is necessary to apply the general common law of agency. This requires consideration of the following factors:

For this argument to work for Warner, the *Zanje Madre* must first be considered to be a work made for hire within the definition of the 1976 Copyright Act, 17 U.S.C. § 107. Leicester was an employee of R&T, the company who built the 801 Tower on Figueroa Street. As Leicester's employer, R&T was the author of anything Leicester created while he was their employee, provided that this was agreed to by Leicester and R&T.<sup>113</sup> The presumption arises that initial ownership rights vested in R&T. As such, the *Zanje Madre's* author is R&T, not Leicester. Therefore, R&T could have authorized Warner to film the *Zanje Madre*.

However, Leicester would counter that he was not an employee of R&T, but an independent contractor. As such, the work can only come under the purview of the statute if the work comes within the one of the nine statutory categories of § 101(2) of the 1976 Copyright Act and the parties agree in a signed instrument.<sup>114</sup>

In a Los Angeles Times article, it was reported that R&T paid Leicester \$2.5 million for creating the work.<sup>115</sup> However, the

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- (1) The hiring party's right to control the manner and means by which the work is accomplished;
  - (2) The skill required to create the work;
  - (3) The source of the instrumentalities and tools;
  - (4) The location of the work;
  - (5) The duration of the relationship between the parties;
  - (6) Whether the hiring party has a right to assign additional projects to the hired party;
  - (7) The extent of the hired party's discretion over when and how long to work;
  - (8) The method of payment;
  - (9) The hired party's role in hiring and paying assistants;
  - (10) Whether the work is part of the regular business of the hiring party;
  - (11) Whether the hiring party is in business;
  - (12) The provision of the employee benefits;
  - (13) The tax treatment of the hired party.

Community for Creative Non-Violence v. Reid, 490 U.S. 730, 751-2 (1989).

<sup>113</sup> 17 U.S.C. § 101(1) (1994) applies to employees. If the work was in the scope of employment, an agency law employee is a copyright employee, and the employer is the "author" of the work. *Easter Seals Soc. for Crippled Children & Adults of La., Inc. v. Playboy Enters., Inc.*, 815 F.2d 323, 329 (5th Cir. 1987).

<sup>114</sup> § 101(2) is really statutory permission for certain kinds of independent contractors to give "authorship" to their buyers. *Easter Seals Soc.*, 815 F.2d at 329.

<sup>115</sup> Skelley, *supra* note 3.



article did not specify whether or not R&T commissioned Leicester to create the work. It also did not relate to whether Leicester became a formal employee of R&T for the purposes of creating the work for the 801 Tower. Since the relationship between Leicester and R&T is unclear from these facts, Warner should first argue under agency law that Leicester was an employee within the scope of the work for hire doctrine.

One of the factors of agency law to determine whether there is an employer/employee relationship between two parties is the extent of the hiring party's right to control the manner and means by which the work is accomplished.<sup>116</sup> Warner can argue that Leicester was not given free artistic reign. Indeed, R&T would have wanted the right to approve of the aesthetics of the final product. R&T must have given guidelines as to how high a fee it was willing to pay Leicester. This impacted what kind of materials, what sort of labor, and how much effort Leicester was willing to devote to the endeavor. Finally, Leicester was physically confined to limit the size of the work to the space allotted him at the 801 Tower.

The manner by which the work was accomplished was also dictated by R&T. Leicester was probably given a date at which the work was to be completed. Likewise, Leicester could not have started the project until he could have access to the building. This may have been prevented by architects, builders, and construction workers who were still erecting the tower. Thus, the manner by which the work was accomplished was controlled by R&T.

The location of the work is also a factor to be considered in deciding if there was an employer/employee relationship between R&T and Leicester.<sup>117</sup> The work is adjacent to the 801 Tower. It is not in a museum or housed in a private collection, but rather it is in the middle of the Los Angeles financial district. It is out in public, for any passer-by to see. Leicester knew that he would not be able to monitor who would be able to see and enjoy the work once he finished it. It would not be behind closed doors or behind any walls. Unlike a museum or private collection, where Leicester could monitor who

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<sup>116</sup> *Id.*

<sup>117</sup> *Id.*

has access to his work, Leicester would not be able to control who sees his work (unless he destroyed it). It can be seen from the city street. If Leicester wanted to maintain some sort of control over his work, he should have made the work for himself, so that he could determine when, where, and how to display it. As it is, the space is an open-air garden, where people can sit and enjoy the respite of a midday lunch hour. Even visitors from out of town can access the work. Therefore, the location of the work is such that Leicester has less of a claim on it than R&T, who had the space created to distinguish the 801 Tower from the ordinary downtown building in Los Angeles.

Another factor of agency law asks whether the work is part of the regular business of the hiring party and whether the hiring party is still in business.<sup>118</sup> As developers, R&T is in the business of developing new sites and buildings. Together with architects and other developers, R&T brought into being what is now 801 Tower and its *Zanje Madre*.<sup>119</sup> Currently, R&T is still in operation. This factor evidences that R&T is a reliable institution that hired Leicester.

Finally, another factor of agency law concerns the tax treatment of the hired party.<sup>120</sup> Leicester must have claimed his earnings from R&T for creating the work on his income tax returns. R&T paid Leicester \$2.5 million to create the space. This money was part of his salary, taxable by the federal government.

However, there are several factors which Leicester can point to in his favor. It is assumed that Leicester and R&T had a short working relationship, from the beginning to the end of the creation of the *Zanje Madre*. Even if it took Leicester years to create the work, he was only in their employ for the duration of time it took him to create the *Zanje Madre*. Another factor in Leicester's favor was his discretion over when and how to work. Since creativity cannot be forced during ordinary business hours, artists usually set their own hours.

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<sup>118</sup> *Id.*

<sup>119</sup> The Architects' Collaborative of Cambridge, Massachusetts, Cushman and Wakefield, and the CRA all worked together with R&T Development on the *Zanje Madre*. Plaintiff's Complaint at 29.

<sup>120</sup> Skelley, *supra* note 3.

Inspiration comes and goes. An artist may be motivated to work throughout the night. This is something R&T could not control.<sup>121</sup>

These different facts must be weighed against one another to see which side will prevail on this argument.<sup>122</sup> However, a cogent argument for Warner is that Leicester was an employee of R&T because they paid him and because of their ability to place the work out in public. Thus, Leicester's work is the property of R&T, who had the authority and discretion to permit Warner to film the building and the *Zanje Madre*.

If it is determined that Leicester is an employee of R&T, the court will apply § 101(1) and find that the *Zanje Madre* is a work for hire; however, if the court finds that Leicester is an independent contractor, it must apply § 101(2).<sup>123</sup> All works by independent contractors—"works specially ordered or commissioned"—are not works for hire unless the work comes under one of the nine categories of § 101(2). In addition, Warner would have to show that Leicester and R&T agreed in a signed instrument for the *Zanje Madre* to be a work for hire. This stage of the test would prove fatal for Warner, since it seems the *Zanje Madre* does not fall within any of the nine categories of § 101(2). Therefore, Warner would be better off arguing that Leicester was an employee of R&T, so that the court would apply § 101(1) instead of § 101(2).

## VI. TRANSFER OF OWNERSHIP AND IMPLIED LICENSE

If Warner can prove Leicester transferred his copyright ownership of the *Zanje Madre* to R&T, Warner would show that Leicester has

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<sup>121</sup> Cf. *Marco v. Accent Publishing Co., Inc.*, 969 F.2d 1547 (3rd Cir. 1992) (court vacated judgment denying freelance photographer's motion for preliminary injunction and remanded to the trial court). The photographer was an independent contractor who used his own equipment, paid his own taxes, supplied his own studio, did not receive employee benefits, worked in a distinct occupation, and was paid by the job.

<sup>122</sup> *Easter Seals Soc. for Crippled Children and Adults of La., Inc. v. Playboy Enters., Inc.*, 815 F.2d 323, 335 (5th Cir. 1987).

<sup>123</sup> See *supra* note 111.

no claim to the *Zanje Madre*. Then R&T could have granted Warner an implied, nonexclusive license to film the *Zanje Madre*.<sup>124</sup>

A copyright owner may sell or license his ownership rights only in writing.<sup>125</sup> If Leicester transferred his copyright ownership of the *Zanje Madre* to R&T in a signed contract or other written instrument, then he cannot bring forth a case for infringement. In transferring his copyright ownership to R&T, he would no longer be the proper "author" of the work. Those rights would have immediately vested in R&T. The existence of a license, exclusive or nonexclusive, is a defense to a claim of copyright infringement.<sup>126</sup>

A nonexclusive license in a copyrighted work may be given orally or by law to effect the intent demonstrated by the parties' conduct.<sup>127</sup> It is an exception to the writing requirement of § 204. Lack of objection is the equivalent of a nonexclusive license.<sup>128</sup> The licensor/creator of the work does not transfer ownership of the copyright to the licensee.

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<sup>124</sup> *I.A.E. Inc. v. Shaver*, 74 F.3d 768, 773, n.4 (7th Cir. 1995). Federal courts have original and exclusive jurisdiction over copyright actions. 28 U.S.C. § 1338(a). In conjunction with a review of a copyright claim, federal courts may also determine related questions of contract law. See NIMMER, *supra* note 23, § 12.01(A), at 12-8 and n.19.

<sup>125</sup> *Shaver*, 74 F.3d at 771. Under execution of transfers of copyright ownership, "a transfer of copyright ownership, other than by operation of law, is not valid unless an instrument of conveyance, or a note or memorandum of transfer, is in writing and signed by the owner of the rights conveyed or such owner's duly authorized agent." 17 U.S.C. § 204(a) (1994).

<sup>126</sup> *Shaver*, 74 F.3d at 755 (citing *Effects Assocs. v. Cohen*, 908 F.2d 555, 559 (9th Cir. 1990)). When consideration is paid for a license, it is irrevocable. *Id.* at 772 (citing NIMMER, §§ 10.01[C][5], 10.02[B][5]). In an exclusive license, the copyright holder permits the licensee to use the protected material for a specific use, and further promises that the same permission will not be given to others. *Western Elec. Co. v. Pacent Reproducer Corp.*, 42 F.2d 116, 118 (2d Cir. 1930).

<sup>127</sup> *Shaver*, 74 F.3d at 775, n.10; *Gracen v. Bradford Exch.*, 698 F.2d 300, 303 (7th Cir. 1983) (considering the scope of an implied nonexclusive license after confirming "Nimmer is right" regarding enforceable unwritten licenses such as oral and implied nonexclusive licenses). A transfer of copyright ownership is an assignment, mortgage, exclusive license, or any other conveyance, alienation, or hypothecation of a copyright, whether or not it is limited in time or place or effect, but not including a nonexclusive license. 17 U.S.C. § 101 (1994). A nonexclusive license may be granted orally, or may even be implied from conduct. NIMMER, *supra* note 23, § 10.03[A].

<sup>128</sup> NIMMER, *supra* note 23, at §10.03[A].

An effective transfer of copyright ownership from Leicester to R&T, coupled with these tenets of contract law, make another forceful argument in Warner's favor. After a transfer of copyright ownership from Leicester, R&T had the ability to grant Warner a license to include the *Zanje Madre* in its film in exchange for valuable consideration. Warner would not have had the authority to grant the same permission to others, but could only use the copyrighted material for its specific use. Even if Warner had not obtained a license in exchange for consideration, R&T could be said to have given Warner an implied, nonexclusive license. R&T did not object to the filming of the 801 Tower or the *Zanje Madre*. This lack of objection was implied consent. Indeed, R&T has not brought action against Warner for infringement of copyright. Therefore, Warner has another defense against Leicester's claim.

## VII. PARODY AS FAIR USE

A category of the fair use doctrine is fair use as parody. Parody occurs when an artist closely imitates the style of another artist to create a new work that ridicules the style and expression of the original for comic effect or social commentary.<sup>129</sup> Parody is encouraged because it fosters the creativity which copyright laws were enacted to promote.<sup>130</sup> Parody entitles its creator to more extensively use the copyrighted work than is ordinarily allowed under substantial similarity.<sup>131</sup> The copied work need not be the object of the parody, but may reflect on life in general.<sup>132</sup>

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<sup>129</sup> *Rogers v. Koons*, 960 F.2d 301, 309-10 (2d Cir.), *cert. denied*, 113 S.Ct. 365 (1992).

<sup>130</sup> *Warner Bros., Inc. v. ABC, Inc.*, 720 F.2d 231 (1983).

<sup>131</sup> *Elsmere Music, Inc. v. NBC*, 623 F.2d 252 (2d Cir. 1980) (*per curiam*).

<sup>132</sup> *MCA, Inc. v. Wilson*, 677 F.2d 180, 184 (2d Cir. 1981); *see also* *Elsmere Music, Inc. v. NBC*, 482 F. Supp. 741, 746 (S.D.N.Y. 1980), *aff'd per curiam*, 623 F.2d 252 (2d. Cir. 1980). In *Elsmere*, the court held that the song "I Love Sodom" was a fair use parody of "I Love New York" even though the former was an attempt to satirize the way in which New York City had attempted to improve its somewhat tarnished image through the use of a slick advertising campaign and had nothing to do with the song "I Love New York" itself. *See also* *Berlin*, 329 F.2d at 545.

[W]here it is clear that the parody has neither the effect or intent of fulfilling demand for the original, and where the parodist does not appropriate a greater

Fair use as parody is perhaps the weakest argument Warner could make. Warner may argue that *Batman Forever* is a parody of life in the big city. That is why the cities that were chosen as backdrops were New York City and Los Angeles, perhaps the two biggest and most extreme cities with respect to crime, violence, and mayhem. Warner may also try to say that the inclusion of the *Zanje Madre* in the movie was meant to be subtle irony. In the midst of an awesome city such as Gotham, full of fear and hatred, sits this symbol of harmony between a city and its natural tributaries. The *Zanje Madre* was perfect to film as a social commentary on how deceptive life can be. The forces of nature and man are enemies, not peacefully co-existing inhabitants. However, this line of reasoning is tenuous at best, given that Warner never filmed the *Zanje Madre* as a focal element of any scene. Warner will more likely stick to its argument that the *Zanje Madre* was filmed incidentally, without the purpose of including it at all. Thus, Warner should not depend on parody as fair use to save the day.

#### VIII. PUBLIC DOMAIN

Perhaps one of Warner's best arguments is a policy-oriented, common sense approach utilizing the public domain. Works that are in the public domain are those that are free from copyright ownership. For example, the Bible is free from copyright ownership because it was created before copyright statutes existed. Similarly, expired copyrights can no longer protect works. They are no longer "covered by copyright." An example of this is Melville's *Moby Dick*.

In a thoughtful analysis of the public domain, Jessica Litman outlines three approaches courts have used. One of these categories is the "Film Cases." In a typical case, plaintiff/author of a book claims that his work was the basis for a successful film. Courts were reluctant to find infringement even though there was compelling

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amount of the original work than is necessary to 'recall or conjure up' the object of his satire, a finding of infringement would be improper.

evidence that the movie production company indeed copied the artist's work.<sup>133</sup>

Two lines of reasoning explain why the courts excused copying. The first is that the court realized that "ideas" are not copyrightable. As such, broad themes and plots that are found in time immemorial (such as love triangles, dueling forces of good and evil, or reunited lovers) cannot be copyrighted by one author, nor can these ideas be infringed upon by another author. The other is the scenes a faire doctrine,<sup>134</sup> whereby a movie production company uses details from an artist's work. This doctrine allows the court to excuse the infringement if what was copied is determined to be "trite" or "stock."

It seems that Warner will have difficulty if it tried to use either line of reasoning handed down by these courts. *Batman Forever* is a film depicting the fight between good and evil. This idea is the broad underlying theme which drives the whole film. But filming the *Zanje Madre* was not necessary to get that theme across to viewers. Therefore, this argument seems tenuous for Warner. The scenes a faire doctrine would yield the same results. The *Zanje Madre* is a detail in the film which is neither "trite" nor common to other films. It is a unique work which can hardly be called common "stock." Therefore, including the *Zanje Madre* in *Batman Forever* fails under the scenes a faire privilege. A public domain argument hardly seems worthwhile.

Since Warner cannot prevail upon public domain through either a "broad ideas" or scenes a faire application, what Warner may do is go beyond these applications and use the underlying reasoning supporting them. Litman suggests that although infringement may be

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<sup>133</sup> Litman, *supra* note 21, at 986; *see also* Ornstein v. Paramount Prods., Inc., 9 F. Supp. 896 (S.D.N.Y. 1935); *see generally* Witwer v. Harold Lloyd Corp., 46 F.2d 792 (S.D. Cal.), *rev'd*, 65 F.2d 1 (9th Cir. 1930), *cert. dismissed*, 296 U.S. 669 (1933).

<sup>134</sup> Litman, *supra* note 21, at 987. In the early 1940s, Judge Leon Yankwich, a federal district court judge in the Southern District of California, was the first to come up with the title "scenes a faire" for this concept. Yankwich explained in *Schwarz v. Universal Pictures Co.*, 85 F. Supp. 270, 278 (S.D. Cal. 1945) ("[Scenes a faire] are the common stock of literary composition-'clichés'-to which no one can claim literary ownership.").

blatant, some courts will not impose liability for two other reasons: financial equity<sup>135</sup> and the slippery slope.

When a film is first conceptualized, movie production companies put much thought into who will play the leading roles. This is because films base their popularity on its leading actors, not on a borrowed idea or a scenes a faire.<sup>136</sup> Indeed, generally the only way a film succeeds is if the leading actors are popular enough to draw in an audience to watch the film. Courts that excuse the movie production company believe that it would be unfair to favor the plaintiff when so little of a film's success had to do with the borrowed idea or scenes a faire from the plaintiff. Household names like DeNiro, Nicholson or Hanks give new meaning to a borrowed idea that has been recycled over and over again. Since these factors seem to have more to do with a film's success than the borrowed idea or scenes a faire, courts are more willing to overlook the infringement.

Similarly, courts are more forgiving of infringement if it will start a slippery slope, imposing a massive burden on the court system. "If one motion picture infringed because it told a familiar story, other films not before the court were equally vulnerable."<sup>137</sup> Indeed, if one film infringed on an author's storyline, who is to say a host of other films also infringed? Suit after suit would appear in court, all with the same claim about how one film copied its idea or cliché. Therefore, to thwart this undesirable outcome, courts are more willing to excuse the infringement.

Although Warner cannot succeed using a borrowed idea or scenes a faire application of public domain, Warner could demonstrate that their underlying rationales favor its infringement. Allowing Leicester to prevail would be financially inequitable. The success and international acclaim *Batman Forever* enjoys is not due to the inclusion of the *Zanje Madre* in the film. Val Kilmer's top billing in previous films, and similar accomplishments for *Batman Forever* co-stars Jim Carey and Nicole Kidman, did more for the movie's popularity than

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<sup>135</sup> Litman, *supra* note 21, at 988.

<sup>136</sup> *Id.* The success of the film *Stowaway* had more to do with its star, Shirley Temple, than with the premise that Twentieth Century-Fox allegedly plagiarized from Joan Storms play *Dancing Destiny*.

<sup>137</sup> *Id.*



the inclusion of the *Zanje Madre*. It would be hard to imagine its popularity can be at all attributable to the *Zanje Madre* appearing in the film. Therefore, Warner can argue that the *Zanje Madre* had little, if anything, to do with the movie's success. The damages that Leicester claims have no merit.

Warner can also argue that if Leicester prevails, courts will be deluged with suits from every building owner, artist, or side-street vendor whose skyscraper, sculpture, or hot-dog advertisement was included in an aerial shot or busy-street-chase-scene. To take this reductio ad absurdum even further, tourists and the general public, with their video recording equipment and cameras in hand, would be sued by these same building owners, artists, or side-street advertisers for failing to obtain permission from their respective copyright owners. Such a scenario would overwhelm the courts. Therefore, the court should take into account the adverse affects a ruling for Leicester would engender. In light of the infinite number of claims that could be brought under such a precedent, the courts would decide in favor of Warner.

The ridiculous extrapolation from an outcome where Leicester prevails would be that tourists and the general public, with their video recording equipment and cameras in hand, may be prohibited from taking photos and recordings in front of statues, sculptures, and buildings they visit unless they receive permission from individual, rightful owners. Getting permission would be difficult, time-consuming, and expensive. Moreover, enforcing this policy would be impossible, as guards police every sculpture, building, and work of art from being photographed or filmed. A judgment in favor of Leicester would mean the end of truly public areas, as the new question becomes one of "Who owns the streets?"

## IX. CONCLUSION

Warner has a number of strong arguments in defense against Leicester's case of copyright infringement. Warner's strongest defensive arsenal comprises analogous cases and the fair use doctrine. Analogous cases in this area of copyright law show that courts are willing to categorize the use of copyrighted material in film or on

television as *de minimus*. The most determinative factor of the fair use doctrine asks whether the infringer's use could substitute for the actual work. Warner's use of the *Zanje Madre* can, in no way, substitute for the actual work. Therefore, the use is "fair."

Although Warner may have to concede a parody as fair use argument, Warner has several other plausible arguments. Warner the work for hire doctrine as a defense. Another argument is transfer of copyright ownership in the *Zanje Madre* to R&T. Finally, Warner has another strong argument via the public domain.

A loss for Warner would be devastating on the market, the public, and on courts. Film producers would find it much more expensive to finance a film because of the additional costs of insurance for copyright infringement suits such as this one. Alternatively, it perhaps would become more expensive for film makers who have to create every new set in a movie, taking care to exclude buildings, billboards, and sculptures, since they could not film on an actual city street. This would make the cost of a movie ticket rise for the movie-going public, while the copyright owner has gained little, if anything at all. Simultaneously, courts would be overrun by infringement suits of artists and building owners for films that feature their work for a fleeting amount of time. The court system would have to deal with this mess, while it waits for the copyright laws to be amended to reflect this outcome.

Warner may have been more careful in what and where it was filming, but to rule in favor of Leicester would be precedentially unwise, unfair, and imprudent. Therefore, Leicester should fail in his case for copyright infringement against Warner.

