

# Rogers v. Koons and Sonnabend Gallery, Inc. 751 F. Supp. 474 (S.D.N.Y. 1990)

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15. *Id.* at 510 (quoting Brief for Respondents at 46).
16. *Id.*
17. *Id.* at 511.
18. *Id.*
19. *Id.*
20. *Id.* at 512.
21. *Id.*
22. *Id.*
23. *Id.* at 513.

## Rogers v. Koons and Sonnabend Gallery, Inc., 751 F. Supp. 474 (S.D.N.Y. 1990).

### Introduction

In *Rogers v. Koons and Sonnabend Gallery, Inc.*, the United States District Court for the Southern District of New York granted Plaintiff Rogers' motion for summary judgment in his copyright infringement suit against Defendant Koons.<sup>1</sup> Rogers, a professional photographer, brought this action after discovering that Koons, a sculptor, had made an exact sculptural replica of Rogers' commissioned photograph entitled "Puppies." The court found unpersuasive the defense claims that the photographic subjects were facts within the public domain, or that copyright protection was limited to the work's original medium of expression, or that Koons' actions constituted "fair use" of the copyrighted work. However, the court denied Plaintiff's motion for summary judgment for money damages against Defendant Sonnabend Gallery, Inc., the principal gallery which displayed Koons' sculptures. The court found the facts insufficient to establish a theory of liability for contributory infringement against the gallery without proof of the gallery's knowledge of the unlawful infringement.<sup>2</sup>

### Facts

In 1980, Art Rogers was commissioned to take a photographic portrait of a new litter of eight German Shepherd puppies owned by Jim Scanlon, a California resident. The resulting work, entitled "Puppies," portrayed Scanlon and his wife sitting on a bench holding the puppies. The appeal of the portrait brought much commercial success. Between the years 1980 and 1989, Rogers was able to exploit the image of "Puppies" in a variety of forums and mediums, including a graphic reproduction on notecards and postcards.

In 1986, a well-known American artist and sculptor, Jeff Koons, began creating sculptures for his upcoming exhibit at the Sonnabend Gallery entitled "Banality Show." The artist described his show

as a "critical commentary on conspicuous consumption, greed, and self indulgence."<sup>3</sup> Each work included in the show was produced in three copies available for public sale and one copy to be retained by Koons himself.

In late 1987 or early 1988, Koons purchased two notecards of Rogers' photograph, "Puppies." Deciding to use the image in his sculpture exhibit, Koons tore off the copyright notice on the notecard and sent it to an Italian art studio with instructions to create a sculptural version of the portrait.<sup>4</sup> Within his instructions and throughout further correspondence with the Italian art studio, Koons directed that the sculptural work "must be just like photo" and reproduced "as per photo."<sup>5</sup> Koons also included within the instructions an enlarged photocopy of "Puppies" on a chart with arrows pointing to different areas of the photograph indicating more specific directions. Koons' final product was a wood sculpture which he entitled "String of Puppies." In December 1988, the Sonnabend Gallery displayed the work, and Koons sold three editions of "String of Puppies" for a total of \$367,000 while retaining the fourth for himself.

Rogers first heard of Koons' sculpture after a friend of Scanlon's saw a picture of "String of Puppies" in the *Los Angeles Times* advertising Koons' "Banality Show." The friend thought the *Times* had merely colorized Rogers' original portrait of the Scanlon family. Scanlon realized the portrait had been replicated and notified Rogers. Rogers then registered "Puppies" with the United States Copyright Office, which recorded the effective date of registration as July 6, 1989 and the date of first publication in the United States as November 20, 1980.

On October 11, 1989, Rogers filed this suit against Koons and Sonnabend Gallery and moved for summary judgment on the first cause of action (copyright infringement) in the complaint. Koons and Sonnabend Gallery cross-moved for summary judgment dismissing all causes of action.

### Legal Analysis

In his defense, Koons argued two different theories. First, he claimed that his use of Rogers' photograph did not constitute copyright infringement because copyright protection does not extend to the factual content of Rogers' photograph, Rogers' image was only protected in its original photographic medium, and Rogers did not establish that the two works were substantially similar. Second, Koons claimed that his sculpture fell within the "fair use" exception to copyright infringement.

Copyright protection is limited to "original acts of expression," thereby leaving purely factual information within the public domain. Accordingly, Koons argued that Rogers' photographic subject was in the public domain as non-protectable factual information.<sup>6</sup> The court, however, rejected this argument. Because of the unique manner in which Rogers posed and photographed his subjects, the photograph's so-called factual information could not be isolated from Rogers' work of art. "Puppies," in its entirety, constituted an original act of expression which was protected material under copyright law.<sup>7</sup>

A copyright owner has the exclusive right to create, or authorize the creation of, derivative works from his original copyrighted work.<sup>8</sup> Koons asserted that this right did not extend to use of the original material in a different medium of expression. However, the court rejected this assertion.<sup>9</sup> "In copyright law the medium is not the message, and a change in medium does not preclude infringement." Likewise, differences in materials and dimensions between two works are insignificant.<sup>10</sup> Koons was therefore not insulated from liability merely because he copied Rogers' work in a sculptural form rather than in its original photographic medium. Under the plain language of the Copyright Act, Koons' sculpture constituted an unauthorized derivative work of Rogers' photograph.<sup>11</sup>

Koons further contended that Rogers had to prove substantial similarity between the two works of art in order to establish copyright infringement. However, Rogers countered that substantial similarity need not be considered when direct copying is conceded. Using the substantial similarity test of *Ideal Toy Co. v. Fab-Lu Ltd.*, the court concluded without question that Koons' sculpture "String of Puppies" was appropriated from Rogers' photograph "Puppies."<sup>12</sup> Koons had instructed the Italian studio to make an exact sculptural replica of the photograph. The result was a work of art that was mistaken, even by the subject's friend, as the original portrait taken by Rogers. This duplication constituted copyright infringement.<sup>13</sup>

Koons' second defense theory, based on the fair use doctrine, was also defeated by the court. In order to establish fair use, four non-exclusive factors are considered: (1) the purpose and character of the use; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion of the protected work used; and, (4) the effect of the use on the potential market for the original work.<sup>14</sup>

The court considered each of these four factors in turn. First, it concluded that Koons' use of Rogers'

photograph was for commercial purposes, as evidenced by the sale of the three editions of "String of Puppies." Second, the court declared that when a copyrighted work is creative in nature, its use is less likely "fair." Third, the court considered it obvious that Koons had incorporated the entire original copyrighted work into his sculpture.<sup>15</sup>

The final factor, concerning the harm to potential marketability of the copyrighted work, is the most important in fair use doctrine analysis.<sup>16</sup> Citing *Stewart v. Abend*, the court rejected Koons' claim that because his *sculpture* did not compete directly with Rogers' *photograph*, there was no harm caused to the market for "Puppies."<sup>17</sup> However, the court properly focused its inquiry on recognized or potential markets for derivative versions of the original work.<sup>18</sup> Koons' infringement effectively subverted Rogers' potential profit from the sale of the art-rendering rights to his copyrighted portrait.<sup>19</sup> Therefore, the court concluded that Koons' appropriation of "Puppies" did indeed harm the potential marketability of Rogers' original work of art and was "indefensible under the fair use doctrine."<sup>20</sup>

Finally, the court briefly considered the liability alleged against Sonnabend Gallery, Koons' primary exhibitor. Rogers' claim against the Gallery presumably arose under the proposition that "one who, with knowledge of the infringing activity, induces, causes or materially contributes to the infringing conduct of another, may be held liable as a contributory infringer."<sup>21</sup> However, without proof that Sonnabend had knowledge of Koons' infringing conduct, there was no liability for materially contributing to that conduct. The record lacked evidence showing Sonnabend knew Koons had copied Rogers' original photograph.<sup>22</sup> Accordingly, the court dismissed Koons' claim for money damages against Sonnabend Gallery.<sup>23</sup>

## Conclusion

By ruling in favor of Rogers, the court furthered the policy behind the Copyright Act. The law intends to "have a liberal construction in order to give effect to what may be considered as an inherent right of the author in his work."<sup>24</sup> In rejecting Koons' "substituted medium" argument, the court protects both "the work of the artisan" and "the genius of the artist."<sup>25</sup> The rights of the copyright owner are thereby secured against all attempts to appropriate the original work. Ω

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1. Rogers v. Koons and Sonnabend Gallery, Inc., 751 F. Supp. 474 (S.D.N.Y. 1990).