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Architects, Artists, Photographers, Property Owners, the Public and Their Rights:

Reconciling VARA, the AWCPA, and Copyright Fundamentals

David E. Shipley*

Murals, sculpture, and other works of visual art have been parts of buildings, monuments and other structures for centuries.¹ Copyright infringement litigation in the federal courts of the United States between artists, architects, photographers, and building owners is, however, relatively recent.² The outcome of these lawsuits has an impact on the public seeing works of visual art; experiencing works of visual art on buildings, monuments, and structures; and, looking at photographs of visual art on those architectural works. This article focuses on how the Copyright Act's protection of artists' rights in their works of visual art on buildings under the Visual Artists Rights Act (VARA) relates to the Copyright Act's protection of architectural works under the Architectural Works Copyright Protection Act (AWCPA). Both VARA and the AWCPA were passed in 1990 as amendments to the Copyright Act.³

There are several questions concerning the relationship between VARA, the AWCPA, and the rest of the Copyright Act. One concerns a visual artist's rights against unauthorized

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¹ See photos of the following works in H.W. Janson, History of Art: A Survey of the Major Visual Arts from the Dawn of History to the Present Day (1963) – the Great the Sphinx (p. 39), Michelangelo's ceiling fresco in the Sistine Chapel (pgs. 359-60), stained glass windows in the Chartres Cathedral (p. 252), statues on and above the portals to the Chartres Cathedral (p. 250), and the statues on the Paris Opera House (pgs. 463-64).

² See text and notes at 50 to 184 *infra* discussing cases litigated and decided between 2000 and 2022. The nation's federal courts have exclusive subject matter jurisdiction over claims arising under the Copyright Act. 28 U.S.C. § 1338(a).

³ VARA and the AWCPA were both enacted by Congress in 1990 and the Copyright Act is at 17 U.S.C. §§ 101 *et seq.* See Jane C. Ginsburg, *Copyright in the 101st Congress: Commentary on the Visual Artists Rights Act and the Architectural Works Copyright Protection Act of 1990*, 14 Columbia-VLA J. of Law & the Arts, 477 & 497 (1990).

photographs or other pictorial representations of a building that incorporates the artist's work, such as a mural or sculptural work, when the artist's work is visible in that photograph or pictorial representation. Another question concerns the visual artist's rights in a work incorporated in a building when the owner of the building wants to remodel or demolish the building. Relatively recent litigation involving photographs of murals on buildings and sketches of floor plans, both posted on websites,⁴ and the whitewashing of highly acclaimed street art⁵ that had been sprayed on a dilapidated warehouse,⁶ has required federal courts to interpret and apply provisions in VARA, the AWCPA, and the Copyright Act to resolve these questions.

This article first summarizes the provisions in VARA, the AWCPA, and the Copyright Act that the courts have interpreted and applied in the litigation over these questions.⁷ Next, it discusses how these questions arise, and then analyzes several decisions in which courts have grappled with these questions and interpreted VARA, the AWCPA, and the Copyright Act. After explaining and reconciling the results in these cases, this article recommends a way to interpret several provisions in these statutes in order to accommodate the rights and interests of artists, architects, photographers, building owners, and the public. It encourages courts to interpret and apply the pictorial representations exception in section 120(a) of the AWCPA to reach only works of visual art that are integral to the design of the architectural work, and not to pictorial,

⁴ Falkner v. General Motors LLC, 393 F. Supp. 3d 927 (C.D. Cal. 2018) (a mural); Mercedes Benz, USA, LLC v. Lewis, 2019 WL 4302769 (E.D. Mich. 2019)(a mural); Designworks Homes, Inc. v. Columbia House of Brokers Realty, Inc., 9 F. 4th 803 (8th Cir. 2021)(plans for an interior feature in a home). The Falkner and Mercedes Benz cases have settled. David Halberstadter, Katten Muchin Rosenman, *Life in the Fast Lane: How Urban Car Ads Depicting 'Street Art' Can Backfire*, AIPLA Newsstand, January 26, 2022.

⁵ The Second Circuit used 'aerosol art' to describe the graffiti or street art that was at issue in Castillo v. G&M Realty, L.P., 950 F.3d 155, 162 (2nd Cir. 2020). See generally Michaela Morrissey, *Copyright Takes to the Streets: Protecting Graffiti Under the Visual Artists Rights Act*, 56 U. Rich. L. Rev. 735 (2022). See text and notes at notes 50 to 74 *Infra*.

⁶ Castillo v. G&M Realty, L.P., 950 F.3d 155, 162 (2nd Cir. 2020).

⁷ See text and notes at notes 50 to 184 *infra*. See also Jane Ginsburg, *supra* note 3, at 477 & 497.

graphic, or sculptural elements that are conceptually separable from the architectural work, or are not visible from a public place. Section 120(b) of the AWCPA, dealing with a building owner's right to alter or tear down a building embodying a copyrightable architectural work, should be interpreted the same way. This accommodates the rights of visual artists under VARA and the Copyright Act with the rights of building owners, architects, photographers and the public under the AWCPA and the Copyright Act.⁸

I. VARA and the AWCPA

This article concentrates on two statutes Congress passed in 1990 that amended the Copyright Act. They became law shortly after the United States officially adhered to the Berne Convention for the Protection of Literary and Artistic Works.⁹ One statute is the Architectural Works Copyright Protection Act (AWCPA).¹⁰ It dramatically changed the copyright status of architecture in the United States¹¹ by establishing a new architectural copyright.¹² The AWCPA defines an “architectural work” as the “design of a building as embodied in any tangible medium of expression, including a building, architectural plans, or drawings.” The work includes the

⁸ The litigation discussed in this article is not hypothetical. See David Halberstadter, *supra* note 4. The author states “[w]hether Volkswagen wins, loses, or settles this dispute [plaintiff’s mural seen prominently in a commercial] one thing is certain. It will have to spend time, effort and attorney’s fees to achieve a resolution of this plaintiff’s claims. It may also find itself the subject of negative publicity. Automobile manufacturers and other retailers would be prudent to follow some basic steps before releasing this type of advertisement to the public ...”.

⁹ The United States joined the Berne Convention on March 1, 1989. Craig Joyce et al., *Copyright Law* 33 (11th Ed. 2020). See also, Marshall Leaffer, *Understanding Copyright Law* 134-35 & 399 (6th Ed. 2014); Jane Ginsburg, *supra* note 3, at 478, 490-91 & 497.

¹⁰ Pub. L. No. 101-650, 104 Stat. 5089, 5133 (1990).

¹¹ David E. Shipley, *The Architectural Works Copyright Protection Act at Twenty: Has Full Protection Made a Difference?* 18 J. Intel. Prop. L. 1, 4 (2010).

¹² 17 U.S.C. § 102(a)(8).

overall form as well as the arrangement and composition of spaces and elements in the design, but does not include individual standard features.”¹³

The AWCPA narrows the specific protection it extends to architectural works by stating:

The copyright in an architectural work that has been constructed **does not include** the right to prevent the making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations of the work, if the building in which the work is embodied is located in or ordinarily visible from a public place.¹⁴

Thus, “one may freely take a photograph of an architectural work, including a ‘building,’ without infringing the copyright in that work.”¹⁵

Architects are the authors of the buildings they design and ordinarily own the copyright to their architectural works.¹⁶ Because of the limitation in section 120(a), an architect would not have an infringement claim against *Architectural Digest* for publishing photographs of a recently constructed building he or she designed if that new structure is visible from a public place. An assumption underlying this exception is that architects are not harmed by the publication of photographs or other pictorial representations of their works.¹⁷ It is, however, uncertain whether this exemption extends to photos of buildings that include conceptually separable pictorial,

¹³ *Id.* § 101. See also David E. Shipley, *Has Full Protection Made a Difference*, *supra* note 11, at 11-16 (discussing what has been regarded as a building under the AWCPA).

¹⁴ 17 U.S.C. § 120(a) (emphasis added).

¹⁵ *Falkner v. General Motors LLC*, 393 F. Supp. 3d 927, 931 (C.D. Cal. 2018). See also Jane C. Ginsburg, *supra* note 3, at 494-95 (discussing this limit on the scope of protection as well as section 120(b) that gives building owners discretion to remodel or demolish structures).

¹⁶ David Shipley, *Has Full Protection Made a Difference*, *supra* note 11, at 16-17.

¹⁷ *Id.* at 35-36. This is good publicity for an architect.

graphic, or sculptural works incorporated in them, or to photos and other pictorial representations of interiors of constructed buildings or to their floorplans.¹⁸

The AWCPA also provides:

Notwithstanding the provisions of section 106(2), the owners of a building embodying an architectural work may, without the consent of the author or copyright owner of the architectural work, make or authorize the making of alterations to such building, and destroy or authorize the destruction of such building.¹⁹

This means that the AWCPA limits the architect/copyright owner's right to prepare derivative works under section 106(2) of the Copyright Act by giving a building's owner the right to remodel or destroy a structure without the architect's permission. Building owners have full discretion to alter or demolish their structures.²⁰ This means that the architect/copyright owner on a particular building cannot object to that building's owner about remodeling it or adding a new wing. These are not unauthorized derivative works.²¹

The other statute passed in 1990 that amended the Copyright Act is the Visual Artists Rights Act (VARA).²² This act grants, for the first time in the United States, federal moral rights to the creators of qualifying works of visual art.²³ These are the rights of integrity, attribution

¹⁸ See text and notes at notes 124 to 184 *infra*. See also David Halberstadter, *supra* note 4, stating that "over the last decade, at least four automobile manufacturers have found themselves embroiled in copyright litigation as a result of having incorporated public art into their advertisements").

¹⁹ 17 U.S.C. § 120(b).

²⁰ Jane Ginsburg, *supra* note 3, at 494.

²¹ "A 'derivative work' is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgement, condensation, or any other form in which the work may be recast, transformed or adapted." 17 U.S.C. § 101 (definition of derivative work)

²² 17 U.S.C. § 106A.

²³ See generally, David E. Shipley, *The Empty Promise of VARA: The Restrictive Application of a Narrow Statute*, 83 Mississippi L. J. 985, 987-89 (2014); Jane Ginsburg, *supra* note 3, at 478-490. Several states had enacted moral

(paternity), and, with respect to works of recognized stature, to prevent destruction. These rights are subject to the fair use defense in section 107.²⁴

VARA defines ‘works of visual art’ as:

[A] painting, drawing, print, or sculpture, existing in a single copy, in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author, or, in the case of a sculpture, in multiple cast, carved or fabricated sculptures of 200 copies or fewer that are consecutively numbered by the author and bear the signature or other identifying mark of the author.²⁵

Especially relevant to this article is VARA’s provision governing the rights of an artist whose work of visual art is incorporated in a building.²⁶ This section of VARA distinguishes between removable and non-removable works of visual art, and spells out steps the building’s owner should take when it wants to remodel or destroy a building with a work of visual art of recognized stature that is in, or on, that building.²⁷

At the same time that VARA grants this special protection to works of visual art that have recognized stature and are incorporated in a building, the AWCPA provides that the owner of a

rights statutes prior to the passage of VARA. Brian Lee, *Making Sense of ‘Moral Rights’ in Intellectual Property*, 84 Temp. L. Rev. 71, 79-80 (2011)

²⁴ David Shipley, *The Empty Promise of VARA*, *supra* note 23, at 992-93 (discussing 17 U.S.C. §§ 106A(a), 106A(a)(3)(A), 106 A(a)(1) & (2), and 106A(a)(3)(B)). Professor Ginsburg notes that VARA, unlike copyright law generally, protects the art work itself from mutilation and/or destruction thus preserving actual works of art -this is in addition to copyright law’s protection for the creator’s incorporeal exploitation rights. Jane Ginsburg, *supra* note 3, at 479.

²⁵ 17 U.S.C. § 101(1). A second part of the definition deals with still photographic images produced for exhibition purposes only being protected subject matter. *Id.* §101(2).

²⁶ *Id.* § 113(d).

²⁷ *Id.* §§ 113(d)(1)(non-removable works) and 113(2)(removable works) See generally, David Shipley, *The Empty Promise of VARA*, *supra* note 23, at 992-95 and 1030-35; Jane C. Ginsburg, *supra* note 3, at 485-87 (if the artist and building owner agreed in writing when the work was created that it would be damaged or destroyed on removal, then the owner of the structure can renovate or demolish the building without the permission of the artist – otherwise the building’s owner needs to adhere to section 113(d)).

building can remodel or destroy it without infringing the architect's copyright in the architectural work.²⁸ However, the AWCPA is silent about what the building owner should do about a work of visual art incorporated in the building that it wants to remodel or demolish.

Questions about how VARA and the AWCPA fit together have been raised for many years and remain largely unresolved.²⁹ Several of these issues are highlighted in the following scenario.

A highly regarded artist paints a large mural on the street side of a building that is an architectural work under the AWCPA. The owner of the building pays for the mural, and the artist/muralist³⁰ retains the copyright in the mural as a pictorial work.³¹ The mural is also work of visual art under VARA,³² that has recognized stature thanks to positive reviews and the artist's sterling reputation.³³ The building's architect owns the copyright in the building as an architectural work.³⁴ A car dealer, with the building owner's

²⁸ 17 U.S.C. § 120(b). This section provides that the owner of a building embodying a protected architectural work can make these substantial changes notwithstanding a copyright owner's right to prepare derivative works. *See also* Marshall Leaffer, *supra* note 9, at 139; Jane C. Ginsburg, *supra* note 3, at 494.

²⁹ Marshall Leaffer, *supra* note 9, at 139 & 403-04; Craig Joyce, *supra* note 9, at 219-20, 606 & 621-22. Both statutes were enacted in order to bring the Copyright Act into compliance with treaty obligations under the Berne Convention. Craig Joyce, *supra* note 9, at 33; David Shipley, *Has Full Protection Made a Difference*, *supra* note 11, at 4; David Shipley, *The Empty Promise of VARA*, *supra* note 23, at 987; Jane C. Ginsburg, *supra* note 3, at 497.

³⁰ For purposes of Copyright, the author is the person to whom anything owes its origin. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 57-58 (1884)..

³¹ 17 U.S.C. §§ 102(a)(5) & 101. Pictorial, graphic and sculptural works "include two-dimensional and three-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, diagrams, models, and technical drawing, including architectural plans. Such works shall include works of artistic craftsmanship insofar as their form but not their mechanical or utilitarian aspects are concerned; the design of a useful article ... shall be considered a pictorial, graphic or sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or sculptural features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article." *Id.* §101.

³² "A 'work of visual art' is – (1) a painting, drawing, print or sculpture existing in a single copy, in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author, . . ." 17 U.S.C. § 101 (the definition). *See* text at note 25 *supra*.

³³ *See* text and notes at notes 64 to 84 *infra*.

³⁴ David Shipley, *Has Full Protection Made a Difference*, *supra* note 11, at 16-17 (this is in the standard American Institute of Architect's contract).

permission, uses the building with its mural as the backdrop for a photograph that is used to advertise one its new vehicles. This photo is displayed on billboards throughout the area and it shown on the dealer's website.

If this advertising is done without permission from the muralist and the building's architect, has the car dealer infringed their copyrights?³⁵ The answer is no regarding the architect's copyright on the building because 17 U.S.C. § 120(a) provides that the copyright in an architectural work does not include the right to prevent the making or public display of photographs of the building.³⁶ However, the answer is not certain regarding the artist's copyright in the mural on that building. Is it part of the building so that the exception in 17 U.S.C. § 120(a) applies, or is it a conceptually separable pictorial work protected by the artist's copyright. Courts are split on this issue.³⁷

The scenario also implicates VARA's relationship with the AWCPA regarding the rights of a muralist and the rights of that building's owner to remodel or destroy the structure. The AWCPA provides in section 120(b) that the owner of a building may, without consent of the owner of copyright in that architectural work (the building), make alterations or authorize its destruction.³⁸ However, the AWCPA says nothing about the rights of a visual artist whose work

³⁵ The plaintiffs – the muralist and the architect - would likely assert that the billboards violate their reproduction and display rights as well as their right to prepare derivative works. 17 U.S.C. §§ 106(1), (2), and (5).

³⁶ The Act states that "The copyright in an architectural work that has been constructed does not include the right to prevent the making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations of the work, if the building in which the work is embodied is located in or ordinarily visible from a public place." 17 U.S.C. § 120(a).

³⁷ *Falkner v. General Motors LLC*, 393 F. Supp. 3d 927 (C.D. Cal. 2018); *Mercedes Benz, USA, LLC v. Lewis*, 2019 WL 4302769 (E.D. Mich. 2019). Both of these cases have settled. David Halberstadter, *supra* note 4. See also text and notes at notes 119 to 145 *infra*. Cf. *Petersen v. Diesel Power Gear LLC*, 2022 BL 456881 (S.D.N.Y. 12/21/22) (apparel company infringed plaintiff's copyright in large mural by using it as the backdrop in social media posting for a truck giveaway – no discussion of section 120a).

³⁸ 17 U.S.C. § 120(b) states that "[n]otwithstanding the provisions in section 106(2), the owners of a building embodying an architectural work may, without the consent of the author or copyright owner of the architectural

is incorporated in a building that is about to be remodeled or destroyed.³⁹ On the other hand, VARA addresses the muralist's rights in 17 U.S.C. § 113(d) without referencing the AWCPA. It provides that creators of works of visual art of recognized stature that are incorporated in buildings enjoy the protections of the VARA, and it distinguishes between removable works of visual art, and works that cannot be removed and thus have to be destroyed when the building is remodeled or torn down.⁴⁰

If the mural is of 'recognized stature,' then under section 113(d)(1), the building owner's destruction of a non-removable work while remodeling or tearing down the building will violate the artist's integrity right under VARA absent a signed agreement between the artist and the building's owner that installation of the work could be subject to destruction by reason of removal.⁴¹ If the work of visual art can be removed without destruction, distortion or mutilation, then the building's owner has to notify the muralist of his or her plans for the building and give the artist 90 days after receiving the notice to remove the work or pay for its removal.⁴² In short, a building owner's rights under the AWCPA to alter or destroy a building (an architectural work) notwithstanding an architect's copyright in that architectural work, are qualified by VARA if an

work, make or authorize the making of alterations to such building, and destroy or authorize the destruction of such building."

³⁹ See generally, David Shipley, *The Empty Promise of VARA*, *supra* note 23, at 1030-40.

⁴⁰ House Report on the Visual Artists Rights Act of 1990, H.R. Rep. No. 101-514 (1990) *reprinted in* 1990 U.S.C.C.A.N. at 6930 [hereinafter H.Rep. with cites to the U.S.C.C.A.N. pagination]. See also Keith Attlessey, *The Visual Artists Rights Act of 1990: The Art of Preserving Building Owner's Rights*, 22 Golden Gate U. L. Rev. 371, 385 (1992).

⁴¹ 17 U.S.C. § 113(d)(1)(A). The rights conferred by VARA will not apply if the parties have executed a written agreement "that specifies that installation of the work may subject the work to destruction, distortion, mutilation, or other modification, by reason of its removal." 17 U.S.C. § 113(d)(1)(B).

⁴² *Id.* §§ 113(d)(2) & (3). In essence, the artist must be given an opportunity to remove the work of visual art from the building. See generally, David Shipley, *The Empty Promise of VARA*, *supra* note 23, at 1030-35.

artist's protected work of visual art, like a mural, is incorporated in the architectural work and is a work of recognized stature.⁴³

Thus, a building's owner does not need to worry about the architectural copyright before remodeling or demolishing the structure due to section 120(b) in the AWCPA.⁴⁴ In addition, due to section 120(a) of the AWCPA, the building's owner and others can take photographs of the building without worrying about owner of the copyright on that architectural work if the building is visible from a public place.⁴⁵ However, if a work of visual art like a mural is in or on the building, then the building's owner should be concerned about the visual artist's rights under VARA when the remodeling or demolition of the building is contemplated⁴⁶ Moreover, if the building's owner and others want to take photographs of the building with its mural, they should be concerned about the muralist's rights under the Copyright Act generally and VARA specifically.⁴⁷ The cases discussed in the following sections highlight these issues.

II. Works of Recognized Stature and the Buildings Exception

The creator of a work of visual art with recognized stature, under VARA, has the right to prevent destruction of that work. "[A]ny intentional or grossly negligent destruction of that work is a violation of that right."⁴⁸ This right, and the right to prevent distortion and mutilations that are prejudicial to an artist's honor or reputation, are subject to the limitations in section 113(d).⁴⁹

⁴³ Michaela Morrissey, *supra* note 5, at 742-44; David Shipley, *The Empty Promise of VARA*, *supra* note 23, at 1030-31.

⁴⁴ *Id.* § 120(b).

⁴⁵ *Id.* § 120(a).

⁴⁶ *Id.* § 113(d).

⁴⁷ *See generally*, David Halberstadter, *supra* note 4.

⁴⁸ 17 U.S.C. § 106A(a)(3)(B).

⁴⁹ *Id.* § 106A(a)(3)(A). If sued for a VARA violation, property owners will likely argue that the destroyed work of visual art was not of recognized stature. This was a major issue in the *Castillo* and *Helmsley-Spear* cases discussed here in at notes 50 to 81 *infra*. VARA does not define 'recognized stature.' *See also* David Shipley, *The Empty Promise of VARA*, *supra* note 23, at 1021-22.

The Second Circuit's 2020 decision in *Castillo v. G&M Realty L.P.*⁵⁰ provides a powerful message to property owners about remodeling or tearing down a building containing a work of visual art that might be damaged or destroyed in the remodeling or demolition process. Specifically, *Castillo* is about the rights VARA extends to visual artists whose works of recognized stature in a building are destroyed by the building's owner.

In 2002 Gerald Wolkoff, the owner of dilapidated warehouse buildings in Long Island City, New York, enlisted Jonathan Cohen, a well-regarded aerosol artist, to turn the warehouses into an exhibition space. Cohen and other artists rented studio space in the buildings and filled the walls with aerosol art. With Cohen serving as curator, this exhibition space, called 5Pointz, became a major global center for aerosol art that attracted thousands of visitors and considerable coverage in the media.⁵¹ Many of these works were visible from the street and from commuter trains going by on nearby tracks.⁵²

In May 2013, after learning that Wolkoff sought approvals to demolish the buildings in order to build luxury apartments, Cohen and numerous 5Pointz artists sued under VARA to prevent destruction.⁵³ As discussed earlier, VARA grants visual artists like Cohen and his fellow plaintiffs several moral rights⁵⁴ including preventing modifications that would harm their reputations.⁵⁵ Moreover, visual artists have the right to block destruction of their works of

⁵⁰ 950 F.3d 155 (2nd Cir. 2020).

⁵¹ *Id.* at 162. Some of the works had a short life span, and were painted over, while other works had permanence. A system of norms governed the process often with Cohen's permission and consent of the artist whose work was overpainted. During its lifespan, 5Pointz was home to about 10,650 works.

⁵² *Cohen v. G&M Realty*, 988 F. Supp. 2d 212, 218-20 (E.D.N.Y. 2013).

⁵³ *Castillo*, 950 F.3d at 162-63. Cohen first tried to have 5Pointz designated a site of cultural significance and to raise money to buy the site. Both efforts were unsuccessful. *Id.*

⁵⁴ See text and notes at notes 22 to 29 *supra*.

⁵⁵ 17 U.S.C. §106A(a)(3)(A)

recognized stature even if they no longer retain copyright in their works.⁵⁶ The plaintiffs received a temporary restraining order to stop destruction of the buildings but their application for a preliminary injunction was denied on November 12, 2013 when the court issued a minute order and told the parties that a written order would soon follow.⁵⁷

Even though a written opinion was forthcoming, defendant Wolkoff deployed a group of workers to destroy the plaintiffs' aerosol art by whitewashing over all the works.⁵⁸ The trial judge issued a written order on November 20, 2013, soon after the whitewashing of the aerosol art. He said that preliminary injunctive relief was inappropriate given the transitory nature of the plaintiffs' works, and that monetary damages under VARA could remedy any injuries the artists proved at trial if they could show that some of their works had achieved recognized stature.⁵⁹

The three-week trial was in the fall of 2017 before an advisory jury. The primary issues were whether the plaintiffs' aerosol art works had achieved recognized stature, and if so, their value.⁶⁰ The jury returned its verdict on November 15, 2017, finding that 28 of the works were of recognized stature and had been destroyed unlawfully, and that eight other works had been

⁵⁶ 950 F.3d at 163; 17 U.S.C. § 106A(a)(3)(b). The artist's rights under VARA are independent of their economic rights under the Copyright Act. *Id.* The statute states "[s]ubject to section 107 and independent of the exclusive rights provided in section 106, the author of a work of visual art – (1) shall have the right." *Id.* §106A(a). *See also* Jane Ginsburg, *supra* note 3, at 485-89; David Shipley, *The Empty Promise of VARA*, *supra* note 23, at 993-94.

⁵⁷ 950 F.3d at 163. A minute order comes about when a trial judge sits officially, with or without a court reporter, and a clerk keeps minutes of the court session. In that session the only record of an oral order made by the judge may be in the minutes. This order is called a minute order or minute entry. Black's Law Dictionary 1322 (11th Ed. 2019 - Bryan A. Garner editor).

⁵⁸ 950 F.3d at 163. The owner refused the artists access to the site to recover any works that could be removed. *Id.*

⁵⁹ *Id.* The court found that these graffiti artists, who had permission to do their works, understood that the owner of the abandoned warehouse might want to develop the property. *Cohen v. G&M Realty*, 988 F. Supp. 2d at 227. The court also said that VARA did not give it authority to preserve the dilapidated building that the plaintiffs had decorated. *Id.* at 226. *See also* Jane Ginsburg, *supra* note 3, at 486 n.33 (in discussing section 113(d) and what might happen if an owner did not have a signed agreement regarding non-removable works and still renovated or destroyed the building – she wrote "one may anticipate that most courts would limit the artist's relief to an award of damages").

⁶⁰ 950 F.3d at 163.

mutilated and thus damaged the artists' reputations. The jury recommended an award of \$545,750 in actual damages, and \$651,750 in statutory damages.⁶¹

Three months later, on February 15, 2018, the trial judge issued his findings of fact and conclusions of law. He determined that 45 of the whitewashed works were of recognized stature, that Wolkoff had violated VARA with his whitewashing, and that his violations were willful.⁶² He concluded that the owner "acted out of 'pure pique and revenge for the nerve of the plaintiffs to sue to attempt to prevent the destruction of their art.'"⁶³ The maximum amount of statutory damages for willful infringement of \$150,000 per infringement was awarded for each of the works for a total of \$6.75 million.⁶⁴ The Second Circuit affirmed.⁶⁵

The *Castillo* decision is important for several reasons. First, the Second Circuit acknowledged that aerosol art, also called graffiti or street-art, is copyrightable and protectable as a work of visual art under VARA.⁶⁶ However, it is important to remember that Cohen and the other aerosol artists at 5Pointz had permission to spray their works on Wolkoff's dilapidated warehouses. Works of visual art painted or placed on property illegally, or without permission of the property owner, might not enjoy protection under copyright law or VARA.⁶⁷ Second, the decision recognizes that aerosol art can be of recognized stature and enjoy heightened protection under VARA.⁶⁸ After all, the court stated that the crux of the dispute at trial was whether the

⁶¹ *Id.*

⁶² *Id.* The jury verdict was advisory, not binding on the District Court.

⁶³ *Id.* at 164 *quoting* the trial judge's order.

⁶⁴ *Id.*

⁶⁵ 950 F.3d at 155 and 173.

⁶⁶ Michaela Morrissey, *supra* note 5, at 735 & 749-50.

⁶⁷ David Shipley, *The Empty Promise of VARA*, *supra* note 23, at 1009 & footnotes 123-25 & 1020 at n.189. *See also* Michaela Morrissey, *supra* note 5, at 753-55 and 764-65; Michael Garfinkel, *Street art raises novel copyright issues – or does it?* DLA Piper, Intellectual Property and Technology News (December 19, 2019); Froese Law, *Is Street Art and Graffiti Copyright Protected?* www.froeselaw.com/post (June 22, 2020),

⁶⁸ 950 F.3d at 166-67. *See also* Michaela Morrissey, *supra* note 5, at 754.

works were of recognized stature and thereby protected from destruction.⁶⁹ Third, the decision holds that VARA's protections extend to temporary works as well as permanent works of visual art.⁷⁰ Fourth, the opinion provides a treatise on determining willfulness in connection with awarding the maximum of statutory damages for infringement.⁷¹ Finally, this was a major and relatively rare win for artists over the rights of property owners.⁷²

Wolkoff could have avoided this litigation and these statutory damages by getting Cohen and the other artists to waive their VARA rights in writing before spraying their works on the walls at 5Pointz. Absent that, his lawyers should have looked at section 113(d) and advised him and his company to follow what VARA spells out for the rights of creators of removable and non-removable works of visual art.⁷³ Compliance might have cost time and money but not much compared to the \$6.75 million award in statutory damages the defendant incurred for his willful infringement of the artists' rights under VARA.⁷⁴

Carter v. Helmsley-Spear is an important and relatively early VARA case from the 1990s in which several artists persuaded a trial court to enjoin a property owner from removing a large art installation integrated into a building's lobby.⁷⁵ Even though the Second Circuit eventually reversed the trial court because the art installation was deemed a work for hire and thus

⁶⁹ 950 F.3d at 163-64 & 166. The issue was discussed at length by the Court of Appeals. *Id.* at 166-68.

⁷⁰ *Id.* at 167-68.

⁷¹ *Id.* at 164-65 & 172-73.

⁷² David Shipley, *The Empty Promise of VARA*, *supra* note 23, at 994 fn. 44 & 1047.

⁷³ 17 U.S.C. § 113(d).

⁷⁴ See also David Shipley, *The Empty Promise of VARA*, *supra* note 23, at 1031-35 (discussing the drawn-out battle over the removal of artwork attached to the steel reinforcement braces on an outer wall of a loft building in New York City that was litigated in *Board of Managers of Soho International Art Condominium v. City of New York*).

⁷⁵ 861 F. Supp. 303, 327 (S.D.N.Y. 1994)

unprotected by VARA,⁷⁶ the trial court's discussion of how to determine recognized stature has influenced other courts.⁷⁷ The trial court stated:

[T]he recognized stature requirement is best viewed as a gate-keeping mechanism – protection is afforded only to those works of art that art experts, the art community, or society in general views as possessing stature. A plaintiff need not demonstrate that his or her art work is equal in stature to that created by artists such as Picasso, Chagall, or Giacometti. As one commentator has noted, “The advantages of the ‘of recognized stature’ qualification include barring nuisance law suits,” ... Nor must the trier of fact personally find the art to be aesthetically pleasing; indeed, courts have persistently shunned the role of art critic.⁷⁸

The court added in a footnote that its test for recognized stature was consistent with an early version of VARA providing that courts should consider the opinions of artists, art dealers, and collectors in determining recognized stature.⁷⁹ The determination should be based on the testimony of experts on both sides of the issue, and satisfying the test requires that the work is viewed as meritorious.⁸⁰

The bottom line from *Castillo*, *Carter v. Helmsley-Spear* and other decisions is that building owners need to be careful before remodeling or destroying property that contains a work of visual art that fits under VARA and arguably has recognized stature. Absent a signed waiver, the building owner should adhere to the terms in section 113(d) depending on whether the work of

⁷⁶ 71 F.3d 77, 88 (2nd Cir. 1995). VARA's definition states that a work of visual art does not include a work for hire. 17 U.S.C. § 101(2)(B). See also David Shipley, *The Empty Promise of VARA*, *supra* note 23, at 1010 to 1015.

⁷⁷ See, e.g., *Castillo*, 950 F.3d at 166-167; *Martin v. City of Indianapolis*, 192 F.3d 608, 612 (7th Cir. 1999); *Scott v. Dixon*, 309 F. Supp. 2d 395, 400 (E.D.N.Y. 2004).

⁷⁸ *Carter*, 861 F. Supp. at 325.

⁷⁹ *Id.* at n.10.

⁸⁰ *Id.*

visual art is removable. If there is litigation, it is likely that one of the highly contested issues will be determining whether the work of visual art is of recognized stature.⁸¹

III. Representations of Works of Visual Art in or on a Building

Under VARA the creator of a work of visual art with recognized stature that is in or on a building can restrict the building owner's rights to remodel or demolish the building.⁸² Moreover, VARA distinguishes between removable and non-removable works of visual art.⁸³ If the work can be removed from the building, then the artist must be given an opportunity to remove it before the building's owner starts a remodeling or demolition project.⁸⁴ On the other hand, under section 120(b) of the AWCPA a building's owner does not need permission from the holder of the architectural copyright before remodeling the building or authorizing its destruction.⁸⁵

Another issue is what rights, if any, does the creator of a work of visual art that is in or on a building have regarding photographs and other pictorial representations of that building. If the artist's work of visual art can be seen in a photograph of the building, does the artist have an infringement claim if the photo was taken without his or her permission? After all, the photograph is a reproduction of that work of visual art. Does the AWCPA's pictorial representation exception for architectural works in section 120(a) extend to a work of visual art incorporated in that architectural work? ⁸⁶

⁸¹ See the cases cited at note 77 *supra*. See also David Shipley, *The Empty Promise of VARA*, *supra* note 23 at 1020-27.

⁸² See the discussion of the *Castillo* and *Carter v. Helmsley-Spear* litigation at notes 50 to 81 *supra*.

⁸³ 17 U.S.C. §§ 113(d)(1) & (d)(2).

⁸⁴ *Id.* § 113(d)(2)

⁸⁵ *Id.* § 120(b).

⁸⁶ Michael Garfinkel, *supra* note 67; Jane Ginsburg, *supra* note 3, at 495.

Leicester v. Warner Brothers is a Ninth Circuit decision with a thorough discussion of the AWCPA's pictorial representation limitation on the copyright in an architectural work.⁸⁷ The primary issue was whether this limitation extended to a sculptural work incorporated in a building that was visible in a movie. The works of authorship at issue in *Leicester* and the other cases discussed in this section are copyrightable as a pictorial, graphic or sculptural works, and they also fit under VARA as works of visual art.⁸⁸

Leicester, an artist known for public art, was retained by the developers of the new 801 Office Tower building in Los Angeles to create a substantial artistic work using the building's courtyard with a fountain and several towers that formed a wall and entrance to the courtyard and the building.⁸⁹ His work, titled *Zanja Madre* (Mother Ditch), tells an allegorical story of the history of Los Angeles and its dependence on water from the mountains. Leicester's contract gave the developer permission to use *Zanja Madre* in brochures, catalogs, and advertisements, and Leicester agreed not to make any reproductions of the work.⁹⁰

The building's owner gave Warner Brothers permission in 1994 to use the 801 Tower as the Gotham City Bank in the movie "Batman Forever." Leicester and the building's architect were not consulted. Four of Leicester's towers and the streetwall portion of his work appear in several scenes in the movie.⁹¹ He registered *Zanja Madre* with the Copyright Office as a

⁸⁷ 232 F.3d 1212 (9th Cir. 2000).

⁸⁸ *Zanja Madre*, the work at issue in *Leicester*, was registered with the Copyright Office as a sculptural work. 232 F.3d at 1215. It could be treated as a work of visual art under VARA, and it also might be seen as site-specific art. The First Circuit ruled in *Phillips v. Pembroke Real Estate*, 459 F.3d 129 (1st Cir. 2006) that VARA did not extend to site-specific art. See generally, David Shipley, *The Empty Promise of VARA*, *supra* note 23, at 1035-40; Jane C. Ginsburg, *supra* note 3, at 486-87 (discussing problems with site-specific art). Based on the *Castillo* decision, the murals at issue in the *Falkner* and *Mercedes Benz* decisions, discussed at notes 119 to 148 *infra*, are works of visual art that fall under VARA and are not site-specific.

⁸⁹ 232 F.3d at 1214-15.

⁹⁰ *Id.*

⁹¹ *Id.* at 1215. The 801 Tower opened in 1992, after the enactment of the AWCPA and VARA.

sculptural work and sued Warner Brothers for copyright infringement.⁹² The building's architect did not have an infringement claim against Warner Brothers due to the section 120(a) exception for pictorial representations of architectural works. The rationale for this exception is that the right to exploit architectural works is not harmed by allowing photographs and other pictorial representations.⁹³ The House Report accompanying the AWCPA states that "numerous scholarly books on architecture are based on the ability to use photographs of architectural works."⁹⁴ Moreover, architecture is a public art form so Congress determined that copyright in an architectural work does not include an exclusive right to create images of buildings.⁹⁵ Thus, the question was whether the section 120(a) exception covered Warner Brothers showing portions of Leicester's Zanja Madre in the movie. Was his copyrightable sculptural work infringed by being shown in the movie or was it part of the building under the pictorial representations exception to the architectural works copyright?

The U.S District Court for the Central District of California determined that the section 120(a) exception was applicable because Leicester's towers had functional aspects and were designed to be part of the building, they matched with the building's architecture, and the artistic features at the tops of Leicester's towers were incorporated in the 801 Tower's structure and design.⁹⁶ Zanja Madre was an integrated part of the architectural work.⁹⁷ In addition, the trial court refused to treat it as conceptually separable from the building because the intent of

⁹² 232 F.3d at 1215. His contract provided that he retained all rights under the Copyright Act. *Id.* at 1230 n. 7 (Judge Fisher's dissent).

⁹³ See text and notes at notes 14 to 18 *supra*. H.R. Rep. No. 101-735 at 22 (photos, posters and other representations of architectural works do not interfere with their normal exploitation).

⁹⁴ H.R. Rep. No. 101-735 at 22.

⁹⁵ *Id.* Shipley, *Has Full Protection Made a Difference*, *supra* note 11, at 35-36.

⁹⁶ 232 F.3d at 1215 *discussing* Leicester v. Warner Bros., 1998 WL 34016724 (C.D. Cal. May 29, 1998).

⁹⁷ *Id.* See also Barry Werbin, *Using Creative and Architectural Works in Film and Media Productions*, <https://www.herrick.com/publications/using-creative-and-architectural-works> (October 2016).

Congress in passing the AWCPA was to establish a new kind of protection for architectural works as a substitute for the protection previously afforded to some non-utilitarian sculptural features incorporated into a building.⁹⁸ The House Report accompanying the AWCPA states:

By creating a new category of protectible subject matter in new section 102(a)(8), and, therefore, by deliberately not encompassing architectural works as pictorial, graphic, or sculptural works in the existing section 102(a)(5), the copyrightability of architectural works shall not be evaluated under the separability test applicable to pictorial, graphic, or sculptural works embodied in useful articles. There is considerable scholarly and judicial disagreement over how to apply the separability test, and the principal reason for not treating architectural works as pictorial, graphic, or sculptural works is to avoid entangling architectural works in this disagreement.⁹⁹

The Ninth Circuit affirmed. A major point of contention was whether the AWCPA should be interpreted to eliminate separate protection for sculptural works attached to buildings. Leicester argued that Congress did not abolish protection for pictorial, graphic or sculptural works incorporated in buildings when it passed the AWCPA, but the majority opinion, by Judge Rymer, responded that the record supported the trial court's finding that Leicester's work was part of the design plan for the architectural work.¹⁰⁰ The streetwall towers were part of the functional and architectural vocabulary of the building, and not conceptually separable sculptural works entitled to copyright protection.¹⁰¹ "Because the streetwall towers are part of the

⁹⁸ *Id.* One of the reasons for treating architectural works separately from pictorial, graphic, and sculptural works was to avoid entangling architecture in the heated disagreements over applying the separability and independence test to pictorial, graphic, or sculptural works embodied in useful articles. H.R. Rep. No. 101-735 at 20.

⁹⁹ H.R. Rep. No. 101-735 at 20.

¹⁰⁰ 232 F.3d at 1217-19.

¹⁰¹ *Id.* at 1219.

architectural work, §120(a) applies.”¹⁰² Leicester did not have an infringement claim “for a pictorial representation of the 801 Tower and its streetwall embodying a protected architectural work.”¹⁰³ According to the majority, the exception for pictorial representations of architectural works would otherwise make no sense.¹⁰⁴

A concurring opinion by Judge Tashima said that the lower court found only that the four towers at issue were a portion of the architectural work that included the building and its towers.¹⁰⁵ Hence, section 120(a) protected Warner’s pictorial representation “[i]n these factual circumstances, where a joint architectural/artistic work functions as part of a building.”¹⁰⁶ The concurrence also explained that the protection for architectural works established by the AWCPA was the exclusive remedy for pictorial, graphic, and sculptural works embodied functionally in a building.¹⁰⁷ Section 102(a)(8) “now provides the sole source of copyright protection for functional PGS works embodied in architectural works.”¹⁰⁸ If conceptual separability applied, then the section 120(a) exception would be meaningless. His opinion stated that this reading of the statute carried out “Congress’ intent to reject the conceptual separability test as a device for determining the scope of protection for architectural works.”¹⁰⁹ However, Judge Tashima agreed with the dissent that the lower court found only that the four relevant

¹⁰² *Id.*

¹⁰³ *Id.*

¹⁰⁴ *Id.* One commentator stated that the building’s streetwall towers were deemed part of the “overall building plan to extend the property line to the street as required by the county. *The towers served to define the street frontage and enhance the pedestrian level of the complex.*” Barry Werbin, *supra* note 97 (emphasis added)

¹⁰⁵ 232 F.3d at 1221.

¹⁰⁶ *Id.* at 1222. This was the lower court’s conclusion. Judge Tashima also noted that the free-standing elements of Zanja Madre were not at issue in the litigation. *Id.* at fn. 2.

¹⁰⁷ *Id.* at 1223-24. The judge noted that providing full protection for a sculptural work embodied as a functional element in an architectural work would eviscerate the pictorial representation exception. *Id.* at 1223.

¹⁰⁸ *Id.* at 1224.

¹⁰⁹ *Id.* This “gives meaning and substance to the pictorial representation exemption ...” *Id.*

towers were “a portion of the architectural work which includes the building and those four towers.”¹¹⁰

Judge Fisher, dissenting, believed that Leicester’s towers could be seen as conceptually separate from the building and thus entitled to copyright protection as a sculptural work under section 102(a)(5).¹¹¹ He contended that the district court erred in concluding that the AWCPA eliminated separate protection for pictorial, graphic, and sculptural works that are part of, but conceptually separable from, an architectural work.¹¹² The dissent noted that conceptually separable features on buildings were considered copyrightable before the enactment of the AWCPA, that the AWCPA added protection for architectural works, and that the AWCPA should not read eliminating protection for sculptural works incorporated in buildings.¹¹³

The dissent also said that it would be odd to read the AWCPA as eliminating protection for separable features when Congress, at almost the same time as enacting the AWCPA, expanded protection for certain works of visual art by enacting VARA.¹¹⁴

I would not interpret the AWCPA as destroying PGS artists’ established intellectual property rights, when, at the same time, Congress was expressing through VARA a desire to enhance the rights of PGS artists.¹¹⁵

The dissent was unwilling to read the AWCPA as making what he deemed to be a “drastic change in the law” with respect to pictorial, graphic, and sculptural works in the absence of

¹¹⁰ *Id.* at 1221.

¹¹¹ *Id.* at 1225.

¹¹² *Id.* at 1226. The dissent acknowledged that determining the effect of the AWCPA on PGS works incorporated in buildings was not simple. *Id.*

¹¹³ *Id.* at 1226-27.

¹¹⁴ *Id.*

¹¹⁵ *Id.* at 1227

statutory language or clear legislative intent.¹¹⁶ “[A] PGS work that is part of, but conceptually separate from, an architectural work can enjoy full PGS copyright protection.”¹¹⁷ Judge Fisher would have remanded for a determination of conceptual separability. If Leicester’s towers were seen as being separable, then Warner’s pictorial representations of them in the movie would have infringed Leicester’s copyright in *Zanja Madre*.¹¹⁸

The Ninth Circuit’s *Leicester* decision, with its three opinions, does not provide a definitive interpretation of section 120(a) of the AWCPA. The safest conclusion is that a pictorial, graphic, or sculptural work that is on a building comes within that exception if the work is determined to be integral to the architectural work and thus within scope the copyright on that work. All three judges agreed that the AWCPA’s pictorial representation exception in section 120(a) extends to works of visual art that are integral to the architectural work and function as part of the building. The trial judge and two of the three appellate judges found that Leicester’s *Zanja Madre* was part of the architecture of the 801 Tower. Judge Fisher, dissenting, wanted to remand for a determination of whether Leicester’s sculptural work was conceptually separable from the architectural work. It is also safe to conclude that the judges did not agree about the scope of the section 120(a) exception. Specifically, the judges disagreed on whether the exception applied if the pictorial, graphic, or sculptural work in or on the building was not part of the architectural work, but a conceptually separable feature.

Eighteen years after the decision in *Leicester* the relationship between pictorial, graphic and sculptural works, architectural works, and the section 120(a) exception was litigated once

¹¹⁶ *Id.* at 1235 (the language of the AWCPA did not explicitly eliminate this protection).

¹¹⁷ *Id.*

¹¹⁸ *Id.* The *Leicester* case “highlights the challenges of using public art in a film where a work is so closely integrated with a building’s structure and overall footprint as to be deemed part of the overall architectural work.” Barry Werbin, *supra* note 97.

again in the U.S. District Court for the Central District of California in *Falkner v. General Motors LLC*.¹¹⁹ The plaintiff was an artist invited by an art gallery in Detroit to create an outdoor mural as part of a marketing project of murals displayed throughout a Detroit parking garage. The garage and an accompanying building had been constructed before the artist painted his mural.¹²⁰

Plaintiff was allowed to choose where in the garage to paint his mural, and was afforded complete creative freedom with respect to the mural. ... Plaintiff was given no aesthetic to match and was not told of any function that the mural should play.¹²¹

A professional automotive photographer traveled to Detroit, borrowed a new Cadillac, and took several photographs including one with the new car in front of two walls in the garage with the plaintiff's mural.¹²² The photographer sent several photographs to GM's advertising agency, and the agency posted a photo on GM's social media with the Cadillac in front of the mural.¹²³ The plaintiff artist's suit alleged several claims including copyright infringement. GM's motion for summary judgment relied on the section 120(a) exception that "one may freely take a photograph of an architectural work, including a 'building,' without infringing a copyright in the work."¹²⁴ The court stated:

¹¹⁹ 393 F. Supp. 3d 927 (C.D. Cal. 2018). The *Leicester* case also started out in the Central District of California. 1998 WL 34016724 (C.D. Cal. May 29, 1998).

¹²⁰ *Id.* at 929. See also Dekuzu, *Whether Section 120(a) limits the copyright protection of a PGS work that is physically connected to an architectural work?* August 27, 2020.

¹²¹ 393 F. Supp. 3d at 929. The mural was painted on two perpendicular walls in the parking garage.

¹²² *Id.* The photograph did not show the plaintiff's pseudonym but it did include a plaque containing copyright management information. However, that information could not be read in the photo. *Id.* at 929-30

¹²³ *Id.* at 930. The photos were posted to promote the new Cadillac XT5. Bobby Ghajar, Marcus Peterson, and Alexander Galicki, *2 Copyright Rulings Reveal Evolving Protection For Street Art*, Law 360, May 12, 2020.

¹²⁴ 393 F. Supp. 3d at 931.

This case presents a more complex issue: whether Section 120(a) applies to (and thus limits the copyright protection of) a PGS work that is physically connected to an architectural work. This issue has been addressed in one case to date: *Leicester v. Warner Brothers*.¹²⁵

The judge in *Falkner* did a thorough analysis of the trial and appellate rulings in *Leicester*, including the concurring and dissenting opinions.¹²⁶ He said that

[a]ll three judges on the ... panel unambiguously agreed that, for Section 120(a) to apply to a PGS work that is not itself an architectural work, the PGS work must be ‘part of’ an architectural work. ... In other words, in order for a PGS work to be treated as an architectural work ... the PGS work must either be an independent architectural work or be ‘part of’ an architectural work.¹²⁷

The judge then presented the facts relevant to the finding that Leicester’s street-wall towers in Zanja Madre were part of the 801 Tower. These included decorative elements complementing the building’s pilasters, and the use of the same pink granite and green marble in both. In addition, the street-wall was an architectural element mandated by the development agency, and it functioned to channel traffic into the building’s courtyard.¹²⁸ Lastly, the court summarized the arguments for and against applying the conceptual separability doctrine to pictorial, graphic or sculptural works that are part of architectural works, and stated that “an

¹²⁵ *Id.* (citation of *Leicester* omitted).

¹²⁶ *Id.* at 931-34.

¹²⁷ *Id.* at 934 (citations omitted)

¹²⁸ *Id.* at 934-35.

important question appears to remain open, at least partially, after *Leicester*: whether conceptual separability applies in the context of architectural works.”¹²⁹

The district court ultimately denied GM’s motion for summary judgment because it could not conclude, as a matter of law, that section 120(a) applied to the plaintiff’s mural and thus permitted unauthorized photographs of it.¹³⁰ The court had no difficulty deciding that the parking garage was a building and an architectural work under the AWCPA.¹³¹ However, it could not say that the plaintiff’s mural was an integral part of the parking garage. GM did not argue that it was an architectural feature, and there was no evidence that it was designed to appear as part of the building or to serve a functional purpose. The mural was inspired by the plaintiff’s prior works, and the design of the garage and the accompanying building were completed before the plaintiff started his mural.¹³² “Because the relevant facts in *Leicester* are entirely distinguishable from those here, and because the facts in the record tend to establish ... the *lack* of a relevant connection between the mural and the parking garage” the mural is not part of architectural work under the AWCPA.¹³³

This statement makes sense. The plaintiff’s mural was not integral to, or dependent on, the parking garage. It was painted by the plaintiff on two walls after the garage had been built. In contrast, *Leicester*’s Zanja Madre was tied into the architecture of the 801 Tower. It was integral to the building’s design. It was functional as well as decorative. Based on the Second Circuit’s

¹²⁹ *Id.* at 936.

¹³⁰ *Id.* at 937.

¹³¹ *Id.* at 936-37. The court discussed *Moser Pilon Nelson Architects, LLC. v. HNTB Corp.*, 2006 WL 2331013, at *6 (D. Conn. 2006) in which a federal district court in Connecticut held that a parking garage qualified as a building and an architectural work. *Id.*

¹³² Dekuzu, *supra* note 120. Based on the facts in the record, there was not a relevant connection between the mural and the parking garage, so the court was unwilling to hold that the mural was part of an architectural work. *Id.*

¹³³ 393 F.3d. at 937. The parties eventually settled. David Halberstadter, *supra* note 4.

decision in *Castillo* and assuming Falkner's mural was of recognized stature, the muralist might have a claim under VARA if the owner of the parking garage whitewashed it or destroyed it when tearing down the structure.¹³⁴ On the other hand, it makes no sense to say that Falkner might enjoy the protections of VARA but cannot recover for the unauthorized depiction of his mural in an Instagram post advertising an automobile.¹³⁵ That conduct constitutes the unauthorized reproduction and display of Falkner's copyrighted mural, a pictorial work.¹³⁶

Mercedes Benz USA, LLC. v. Lewis,¹³⁷ litigated in the U.S. District Court for the Eastern District of Michigan, is similar to *Falkner*. The judge's introduction states:

In broad terms, Mercedes obtained a permit to photograph various locations in downtown Detroit in conjunction with advertising one of its vehicles. Mercedes posted six (6) of the photographs on Instagram which depict in whole or in part murals painted on public buildings in Detroit by defendants. Defendants, through counsel, sent letters to Mercedes contending that the use of defendants' murals violates copyright law. Mercedes responded by seeking declaratory relief.¹³⁸

¹³⁴ See text and notes at notes 50 to 74 *supra*.

¹³⁵ Cf. Leicester, 232 F.3d at 1227 & 1234-35 (Fisher J., dissenting); Jane C. Ginsburg, *supra* note 3, at 495 (observing that if a building had elements that were separately protectable as pictorial, graphic or sculptural works, the unauthorized pictorial representation of the element could be an infringement of the PGS work).

¹³⁶ See, e.g. Ringgold v. Black Entertainment Television, Inc., 126 F.3d 70 (2nd Cir. 1997) (unauthorized use of a poster of a plaintiff's work of art as set decoration in TV series episode violated the display right). "Today, most film and television productions that use more than a *de minimis* depiction of creative works ... either go through the often laborious task of seeking permission from the owners of the original works or commission new works in the 'style' of the original." Barry Werbin, *supra* note 97. Photographers of commercial spaces and buildings are advised to get a property release if their photos include images of artwork unless the work is in the public domain or integrated into the building. Natalie Robert, *Copyright Information for Architectural Photography*, Expert Photography.

¹³⁷ 2019 WL 4302769 (E.D. Mich. 2019).

¹³⁸ *Id.* at *1. Mercedes unveiled its newest SUV at the North American International Auto Show in Detroit in January 2018. The city gave it permission to photograph the new model in several locations. The defendants had painted the murals that appeared in the photos in connection with an art festival, Murals in the Market. Each mural "was painted on the side of façade of a building, was integrated into that building, and became a permanent

After removing the photos from Instagram, Mercedes sought a declaratory judgement that its posts had not infringed the muralists' copyrights because the murals were parts of buildings and subject to the section 120(a) exception.¹³⁹ The defendants moved to dismiss, arguing that Mercedes had failed to state a claim under the ACWPA. The court disagreed, concluding that Mercedes had "alleged a plausible claim that section 120(a) of the ACWPA protects Mercedes' right to photograph publicly visible buildings which contained defendants' murals."¹⁴⁰ The court reached this conclusion after briefly discussing *Leicester* and saying the "film's depiction of the building (including PGS design elements) was therefore protected and not in violation of copyright law. That is precisely the claim Mercedes is asserting here."¹⁴¹ The court stated that "nothing in *Leicester* supports defendants' argument that Mercedes does not have a claim under the ACWPA."¹⁴²

The determination that Mercedes stated a claim did not mean it would ultimately win on the merits.¹⁴³ The company's defense based on section 120(a) is identical to GM's defense against Falkner's infringement claim. Also, the *Mercedes Benz* court said the Ninth Circuit had recognized that Leicester "might have an infringement claim where, for example, someone created a reproduction of his sculpture divorced from the context of the building in which it was embodied, . . . However, plaintiff did not have an infringement claim based on a *photograph of*

fixture of the Eastern Market's cityscape." *Id.* at *1 & *2 (repeated for each of the defendant artists with minor variations).

¹³⁹ *Id.* at *2. Mercedes also said that what it had done was a fair use and thus not an infringement. *Id.*

¹⁴⁰ *Id.* at *7 (emphasis in the opinion).

¹⁴¹ *Id.* at *5 (citation omitted).

¹⁴² *Id.* See generally, Amelia Brankov (Frankfurt Kurnit Klein & Selz PC), Mercedes's Claims Against Street Artists Survive Dismissal Motion AIPLA Newsstand, September 12, 2019.

¹⁴³ 2019 WL 4302769 at *7. The court stated "[w]hether they will prevail on this claim is not before the Court at this time." *Id.*

the building that included the sculpture as a design element of the building.”¹⁴⁴ Moreover, the court did not determine whether the defendants’ murals were integrated with the designs of architectural works like much of Leicester’s Zanja Madre was integral to the 801 Tower, or whether they were purely decorative and not functional like Falkner’s mural on the parking garage in *Falkner v. General Motors*.

Based on the *Leicester*, *Falkner* and *Mercedes Benz* decisions, the best way to interpret and apply section 120(a) of the AWCPA is to say that the creator of a pictorial, graphic, or sculptural work that is on a building comes within that exception if his or her work is determined to be integral to the architectural work. This means that if the artist’s work of visual art can be seen in a photograph of the building (the architectural work), then the artist will not have an infringement claim if the photo was taken without his or her permission. The AWCPA’s pictorial representation exception for architectural works in section 120(a) extends to works of visual art that are integral to the architectural work and function as part of the building like Leicester’s Zanja Madre was part of the architecture of the 801 Tower. On the other hand, if the pictorial, graphic, or sculptural work on the building is not part of the architectural work, but decorative like the mural on the parking garage in *Falkner*, then the AWCPA’s pictorial representation exception should not apply. The creator of that work of visual art, like the muralist in *Falkner*, could file a copyright infringement claim over the unauthorized photograph of his or her PGS work.¹⁴⁵

¹⁴⁴ *Id.* at 5 (emphasis added). The court also said that the artists’ reliance on *Star Athletica* was misplaced because that decision “does not address the public’s right to photograph useful articles that include PGS works as design elements under section 113(c) – let alone the public’s right to photograph buildings under section 120(a).” *Id.* at *6. That decision does not prevent Mercedes from asserting a claim under the AWCPA. *Id.* The defendants made several other arguments about why Mercedes’ claim based on the AWCPA that the court disposed of in short order. *Id.* at *6 - *7. Mercedes stated a claim for relief. The parties eventually settled and Mercedes dropped the lawsuit. David Halbertstadter, *supra* note 4.

¹⁴⁵ See *Petersen v. Diesel Power Gear LLC*, 2022 BL 456881 (S.D.N.Y. 12/21/22) (an apparel company infringed a Utah’s artists copyright in his 100 foot mural by using it as a backdrop in social media promotion for a truck

IV. Representations of Plans and the Section 120(a) Exception

Plans and blueprints were held copyrightable before the passage of the AWCPA in 1990.¹⁴⁶ The unauthorized reproduction of plans and blueprints to make copies of those documents was, and still is, copyright infringement.¹⁴⁷ The AWCPA made the unauthorized use of copyrighted plans and blueprints to construct the architectural work depicted in them copyright infringement.¹⁴⁸ Most importantly, the statute extended full protection to works of architecture including constructed buildings.¹⁴⁹

There is, however, disagreement over whether the section 120(a) exception, allowing pictorial representations of buildings visible to the public, also allows the reproduction of plans and blueprints for that building in promotional brochures or on websites.¹⁵⁰ For example, if a real-estate company reproduces floor plans for an already constructed home in marketing and sales materials without the architect's permission, can it claim the section 120(a) exception if

giveaway); Kyle Jahner, *Utah Muralist Wins Copyright Ruling, But Fails to Prove Intent*, Bloomberg Law, IP Law (December 22, 2022) (noting also that there have been a number of suits by muralists against companies that use their murals as backdrops for products in marketing materials, and that such use without the artists' permission generally infringes). See also Jane Ginsburg, *supra* note 3, at 495 (noting that the unauthorized photograph of a separable PGS element on a building may be an infringement of that PGS work, but not of the architectural work).

¹⁴⁶ See, e.g., *Imperial Homes v. Lamont*, 458 F.2d 895 (5th Cir. 1972) (the plaintiff prepared plans for a home called 'Chateau,' built model homes that were open to the public, and prepared a promotional brochure containing the model's floor plan, and the court held that if the defendant imitated or transcribed those plans in whole or in part, it had infringed); *Aitken, Hazen, Hoffman, Miller, P.C. v. Empire Construction Co.*, 542 F. Supp. 252 (D. Neb. 1982) (defendant infringed by reproducing plaintiff's plans); David Shipley, *Copyright Protection for Architectural Works*, 37 S.C. L. Rev. 391, 396-401 (1986),

¹⁴⁷ *Aitken, Hazen, Hoffman, Miller, P.C. v. Empire Construction*, 542 F. Supp. 252, 254-56 (D. Neb. 1982).

¹⁴⁸ Compare *Christopher Phelps & Associates LLC v. Galloway*, 492 F.3d 532 (4th Cir. 2007) with *Scholz Homes, Inc. v. Maddox*, 379 F.2d 84 (6th Cir. 1967); David Shipley, *Has Full Protection Made a Difference*, *supra* note 11, at 32-35.

¹⁴⁹ David Shipley, *Has Full Protection Made a Difference*, *supra* note 11, at 4-5 (discussing 17 U.S.C. § 102(a)(8).

¹⁵⁰ Compare *Sorenson v. Wolfson*, 96 F. Supp. 3d 365 (S.D.N.Y. 2015) (section 120a applies), *Morgan v. Hawthorne Homes, Inc.*, 2009 WL 1010476 at *12 (W.D. Pa. 2009) (section 120a applies) and *Kitchen & Bath Concepts of Pittsburgh v. Eddy Homes*, 2016 U.S. Dist. Lexis 177016 at *7 to *14 (W.D. Pa. 2016) (section 120a applies) with *Designworks Homes, Inc. v. Columbia House of Brokers Realty, Inc.*, 9 F.4th 803 (8th Cir. 2021) (section 120(a) does not apply). See also Joel Sonnenberg, *Unsuspectingly Following Your Floor Plan into an Architectural Copyright Wall*, AIPLA Newsstand, May 18, 2022.

sued for copyright infringement by the architect?¹⁵¹ Realtors believe that this exception applies but the Eighth Circuit has ruled in favor of the architect.¹⁵² On the other hand, several federal district courts have ruled that posting plans of a home that is visible from the street, or plans for a unit in a condominium building that is visible from the street, were not infringements because of the section 120(a) exception.¹⁵³

In one of the several federal district court rulings, the defendant posted on its website plans for a home that was visible from the street.¹⁵⁴ In another one, the defendant posted a sketch of the floorplan for a condominium unit located in a building that was visible from the street.¹⁵⁵ The 120(a) exception arguably applied in both cases because the statute says that copyright in a constructed architectural work does not include the right to prevent “pictorial representations of the work, if the building in which the work is embodied is located in or ordinarily visible from a public place.” The basic argument is that the floorplan is the work embodied in a building that is

¹⁵¹ Joel Sonnenberg, *supra* note 150 discussing *Designworks Homes, Inc. v. Columbia House of Brokers Realty, Inc.*, 9 F.4th 803 (8th Cir. 2021).

¹⁵² 9 F. 4th 803 (8th Cir. 2021). *See also* Stuart Richeson & Andrew Coffman, Phelps Dunbar, *Does Using Floor Plans in Real Estate Listings Violate Copyright Law?* AIPLA Newsstand, June 6, 2022.

¹⁵³ *Sorenson v. Wolfson*, 96 F. Supp. 3d 347, 365-66 (S.D.N.Y. 2018) (defendant not liable for posting plans for Unit 7A on a website); *Morgan v. Hawthorne Homes, Inc.*, 2009 WL 1010476, at *12 (W.D. Pa. 2009) (plaintiff admitted that houses were constructed and visible from the street so the defendant’s pictorial representation of plans on its website was not actionable); *Kipp Flores Architects, LLC v. AMH Creekside Dev., LLC.*, 2022 U.S. Dist. Lexis 142279 at *19 to *24 (W.D. Tex. 9/16/22) (use of renderings and floorplans in marketing materials not infringing based on section 120a); *Kitchen & Bath Concepts of Pittsburgh v. Eddy Homes*, 2016 U.S. Dist. Lexis 177016 at *7 to *14 (W.D. Pa. 2016) (interior elements of a house constitute part of the architectural work under the section 120a exception). The status of interior design under copyright law is uncertain. For instance, Circular 41 from the Copyright Office states that copyright does not protect “[i]nterior design, such as the selection and placement of furniture, lighting, paint, or similar items.” *See generally*, Kim Carlson, *Design on Someone Else’s Dime: The Profiteering of Interior Designer’s Works from a Lack of Rights in the Modern Era*, 28 J. of Intel. Prop. Law 397 (2021). One author notes that architectural copyright does not distinguish interiors from exteriors, and that a photo that shows a kitchen, the living room, and the bedroom though a doorway runs the risk of copyright infringement and that the photographer should get a signed release. Natalie Roberts, *Copyright Law Information for Architectural Photography*, Expert Photography.

¹⁵⁴ *Morgan v. Hawthorne Homes, Inc.* at *12. *See also* *Kitchen & Bath Concepts of Pittsburgh v. Eddy Homes*, 2016 U.S. Dist. Lexis 177016 at *7 to *14 (W.D. Pa. 2016) (similar litigation over photographs of a home’s interior spaces).

¹⁵⁵ *Sorenson v. Wolfson*, 96 F. Supp. 3d at 365-66.

visible from a public place. Moreover, an architectural work is defined in section 101 as “the design of a building as embodied in any tangible medium of expression, including a building, architectural plans, or drawings” and also “the overall form as well as the arrangement and composition of spaces and elements in the design.”¹⁵⁶

In one case involving plans for a home, the plaintiff argued unsuccessfully that the pictorial representations exception did not extend to technical drawings like plans.¹⁵⁷ The court did not, however, analyze or parse the statute. However, in another decision the court made clear that its ruling that the 120a exception extended to interior spaces depicted in photographs was warranted by AWCPA’s definition of ‘architectural work’ as ‘the overall form as well as the arrangement and composition of spaces.’¹⁵⁸ The primary issue in the case about posting a sketch of plans for a condominium unit was whether the exception should apply to plans for a unit that was ‘substantially constructed’ and the court held that it did.¹⁵⁹

A 2021 decision from the U.S. Court of Appeals for the Eighth Circuit ruled that section 120(a) eliminated liability for artistic reproductions of architectural works, not functional reproductions.¹⁶⁰ The plaintiff Designworks held the copyright to plans for a ‘triangular atrium design with stairs’ that was used in several homes including 1713 Kenilworth, a home built in Columbia, Missouri in 1999.¹⁶¹ The owners of this home retained the defendant brokers in 2017 to list and market it. Defendants hired a person to measure the interior of the home and draw

¹⁵⁶ 17 U.S.C. § 101 (definition of architectural work).

¹⁵⁷ *Morgan v. Hawthorne Homes, Inc.* at *12.

¹⁵⁸ *Kitchen & Bath Concepts of Pittsburgh v. Eddy Homes*, 2016 U.S. Dist. Lexis 177016 at *10 to *11 (W.D. Pa. 2016).

¹⁵⁹ *Sorenson v. Wolfson*, 96 F. Supp. 3d at 366 *citing* *Richard J. Zitz, Inc. v. Dos Santos Pereira*, 232 F.3d 290, 292-93 (2nd Cir. 2000).

¹⁶⁰ *Designworks Homes*, 9 F.4th at 809-10. *See also* Stuart Richeson & Andrew Coffman, *supra* note 152.

¹⁶¹ *Designworks Homes*, 421 F. Supp. 838, 841-42 (W.D. Mo. 2019)

1713 Kenilworth's floorplan. This plan was published in 2017 when the home went on the market, and Designworks sued the brokers for copyright infringement.¹⁶²

The U.S. District Court for the Western District of Missouri granted summary judgment for the defendants. It said that architectural plans and drawings are copyrightable as pictorial graphic and sculptural works and as architectural works, and it noted that the defendants' motion for summary judgment was based in part on the affirmative defense provided by section 120(a).¹⁶³ After summarizing the Ninth Circuit's *Leicester* decision, it said that courts applying section 120 "have concluded that interior elements of a house constitute 'architectural works.'"¹⁶⁴ The court also said that section 120(a) had been read to apply to technical drawings upon which a structure might be based,¹⁶⁵ and that creating this kind of pictorial representation of a constructed building that is visible from a public place was not an act of infringement.¹⁶⁶

The plaintiff argued that the exemption was "limited to the exterior structure of 1713 Kenilworth that is ordinarily visible from a public place."¹⁶⁷ The district court said that this argument was belied by 'the building in which the work is embodied' language in section 120(a) and the work at issue was the design, "which is embodied in the completed architectural work located at 1713 Kenilworth, which is ordinarily visible from a public place."¹⁶⁸ The plaintiff's copyright registration conferred ownership in the underlying technical drawings and the completed structure at that location.¹⁶⁹ The creation of the floorplan for this home by the

¹⁶² *Id.* Designworks also claimed a violation of VARA.

¹⁶³ 421 F. Supp. 3d at 845. The defendants also raised the affirmative defense of fair use under section 107.*Id.*

¹⁶⁴ *Id.* at 846 (citations omitted).

¹⁶⁵ *Id.* citing Hawthorne Homes, *supra* at notes 155 to 157.

¹⁶⁶ 421 F. Supp. 3d at 846 citing Sorenson.

¹⁶⁷ *Id.*

¹⁶⁸ *Id.* at 846-47.

¹⁶⁹ *Id.* at 846 discussing Registration K.

defendants was not infringing because that plan is a pictorial representation of the structure's interior so summary judgment for the defendants was appropriate.¹⁷⁰

The Court of Appeals for the Eighth Circuit reversed.¹⁷¹ The court parsed the language of section 120(a) closely, distinguished technical drawings from artistic representations like paintings and photographs, and declined to hold that functional floorplans are 'other pictorial representations' covered by 120(a).¹⁷² The court said it was necessary to restrict 120(a) like this because:

[I]t would be quite difficult to create a floorplan of a building simply by viewing it from a public place. Floorplans typically stem from someone's access to the interior of a building, though perhaps some interior features of a building are discernible from the outside. The point is that Congress did not appear to be directing § 120(a) toward floorplans.¹⁷³

The court said that the decisions concluding that section 120(a) applied to floorplans were not persuasive.¹⁷⁴ It discussed the House Report on the AWCPA, noted that the American Institute of Architects proposed an amendment to 120a to prohibit pictorial representations in order to stop the unauthorized design and construction of substantially similar architectural works, and

¹⁷⁰ *Id.* at 847. *See also* Kitchen & Bath Concepts of Pittsburgh, 2016 U.S. Dist. Lexis 177016 at *10 & *11 (photographs of the interior of a constructed home used for marketing do not infringe because of the section 120a exception); Landrau v. Solis Betancourt, 554 F. Supp. 2d 102 (D. P.R. 2007) (plaintiff architectural firm sued another architectural firm for Lanham Act violations and copyright infringement after articles in magazines credited the defendant firm as the architect and designer of the home featured in the articles with photos of the interior – the plaintiff's infringement claim was dismissed because it failed to allege that the defendant firm had copied the plans or the design).

¹⁷¹ 9 F.4th 803 (8th Cir. 2021), *cert. denied*, No 21-1217 (June 27, 2022).

¹⁷² Designworks Homes, 9 F.4th at 807-10.

¹⁷³ *Id.* at 810.

¹⁷⁴ *Id.*

said that the drafters of section 120(a) did not believe it covered floorplans.¹⁷⁵ The bottom line for the Eighth Circuit, relying on the text of section 120(a) and its legislative history, was that the “text does not encompass floorplans.”¹⁷⁶

The Eighth Circuit’s distinction between floorplans and other ‘pictorial representations’ of a constructed building visible from a public place is consistent with statements made by the Copyright Office in connection with copyright registration for architectural works. Circular 41 states:

An architectural work and a technical drawing for an architectural work are separate works. To register both an architectural work and a technical drawing as separate works, you will need to file separate applications for each work. If you only intend to register an architectural drawing or blueprint as a visual art work (but do not intend to register the architectural work depicted in those drawings), select ‘technical drawing.’¹⁷⁷

The Eighth Circuit’s reasoning is also consistent with AWCPA’s legislative history in that Congress did not remove architectural plans from the scope of pictorial, graphic and sculptural

¹⁷⁵ *Id.* discussing H.R. Rep. 101-735, at 22 n.50 and concerns raised by the AIA. The court said that the AIA did not explicitly mention plans “it certainly appears that their unauthorized production was the source of” the organizations concern. 9 F.4th at 810.

¹⁷⁶ *Id.* at 811. The court also addressed the argument that it would be incongruous to read section 120(a) as not including floorplans while permitting the owner of a building embodying an architectural work to alter or destroy it since those acts might necessitate the creation of plans. *Id.* it stated that the “decision does not preclude the district court on remand from considering whether some other defense might apply or whether the plaintiffs have demonstrated a claim of copyright infringement in the first place.” *Id.* For example, Designworks sued another builder for allegedly infringing its plans for a two-story triangular design with stairs as part of the home’s main room, and lost on summary judgment with the court determining that the only similarity between the works was the two-story triangular atrium and that did not establish copying. *Designworks Homes, Inc. v. Thomson Sailors Homes, LLC*, 9 F. 4th 961 (8th Cir 2021).

¹⁷⁷ Copyright Office Circular 41, Copyright Registration of Architectural Works, Chapter 900 section 126 of the Compendium of U.S. Copyright Office Practices. See also 37 C.F.R. § 202.11(c)(3)(“Where dual copyright claims exist in technical drawings and the architectural work depicted in the drawings, any claims with respect to the technical drawings and architectural work must be registered separately”).

works,¹⁷⁸ and kept the copyright in the architectural work separate from copyright in plans and drawings.¹⁷⁹ Moreover, the rationale for the 120(a) exemption is that architecture is ordinarily a public art form, and architects' rights to exploit their works are not harmed by allowing photographs and other representations of structures ordinarily visible to the public.¹⁸⁰ That cannot be said about the interior of a building or the architect's blueprints for the entire house or the plans for part of it like an atrium. These plans and technical drawings might be 'pictorial representations' under the Copyright Act's definition of pictorial, graphic and sculptural works, but reproducing these 'pictorial illustrations' of a building that is located in a public place should not come under the section 120(a) exception unless those plans or technical drawings can be discerned when looking at the architectural work.¹⁸¹

Finally, UNESCO and the body that administers the Berne Convention jointly made the following general statement about copyright for works of architecture:

The reproduction of the external image of a work of architecture by means of photography, cinematography, painting, sculpture, drawing or similar methods should not require the authorization of the author if it is done for private purposes or, even if it is done for

¹⁷⁸ 17 U.S.C. § 101 (defining pictorial, graphic and sculptural works to include architectural plans).

¹⁷⁹ H.R. Rep. No. 101-735, at 19.

¹⁸⁰ See text and notes at notes 16 to 18 and 93 to 96 *supra*; David Shipley, *Has Full Protection Made a Difference*, *supra* note 11, at 35.

¹⁸¹ But see Brief of Copyright Scholars as *Amici Curiae* in Support of Petitioners, *Columbia House of Brokers, Realty, Inc. Petitioners v. Designworks Homes, Inc., Respondents*, On Petition for a Writ of Certiorari to the United States Court of Appeals for the Eighth Circuit, No. 21-1217 (April 7, 2022). See also Stuart Richeson & Andrew Coffman, *supra* note 152 (the court decided that section 120(a) only eliminated liability for artistic reproductions, but not functional reproductions, and that the safest course for brokers and agents was not to use floor plans in the advertisements).

commercial purposes, where the work of architecture stands in a public street, road, square or other place normally accessible to the public.¹⁸²

Accordingly, since the AWCPA was enacted to enable the United States to meet obligations under the Berne Convention, section 120(a) should be interpreted to except only external images of architectural works, not representations of floor plans and interiors.¹⁸³ The Eighth Circuit's decision in *Designworks* rests on a solid foundation.¹⁸⁴

IV. Synthesis

The works of visual art at issue in the cases discussed in this article are copyrightable pictorial, graphic, or sculptural works under 17 U.S.C. § 102(a)(5).¹⁸⁵ The creators of copyrightable works of visual art that are in, or on, architectural works, enjoy the rights of integrity and attribution under VARA including, for works of recognized stature, rights against alteration and destruction.¹⁸⁶ This article has asserted that the photographic and pictorial representations exception in section 120(a) of the AWCPA for architectural works should not be interpreted and applied to encompass photographs and other representations of conceptually separable works of visual art in or on a building when those works are not integral to the architectural work's design or the way it functions. In other words, the AWCPA should not be interpreted to extinguish or limit visual artists' rights under VARA and the Copyright Act

¹⁸² Joint meeting of the World Intellectual Property Organization and UNESCO, Principle WA.7, 22 Copyright 401, 411 (Dec. 1986)(emphasis added).

¹⁸³ Cf. Jane Ginsburg, *supra* note 3, at 496.

¹⁸⁴ The Eighth Circuit acknowledged concerns raised by relators and homeowners, but noted that 120(a) was one several defenses to infringement, and that the court's opinion did not undermine any other defenses like fair use. 9 F.4th at 810-11. Another one might be an implied license for the owner of the home to display its plans and the home's interior in marketing the home. See *Effects Associates v. Cohen*, 908 F.2d 555 (9th Cir. 1990)(defendant granted an implied license to use special effects the plaintiff had created for defendant's movie).

¹⁸⁵ See text and note at note 31 *supra* (definition of pictorial, graphic, and sculptural works).

¹⁸⁶ 17 U.S.C. §§ 106A(a)(1)-(a)(3) & 113(d)(1)-(d)(2).

because Congress, by enacting VARA in the same year that it enacted the AWCPA, enhanced the rights of visual artists.¹⁸⁷

In passing the AWCPA, Congress also made clear that it did not want architects to grapple with the separability test that impacts the scope of copyright protection for pictorial, graphic and sculptural works in or on useful articles.¹⁸⁸ However, there is nothing in the AWCPA suggesting that Congress wanted to prevent sculptors, muralists, and other artists who create works of visual art attached to or placed on buildings “from attempting to satisfy the difficult separability test and thereby gain full PGS copyright protection for their works.”¹⁸⁹

In addition, the Copyright Office states that copyright protection does not extend to “[p]urely functional features of an architectural work, ...”¹⁹⁰ Determining whether an architectural feature is functional requires an analysis comparable to determining whether a sculptural feature or a mural painted or sprayed on a building is conceptually separable.¹⁹¹ In *Leicester* the portions of Zanja Madre shown in a movie were determined to be integral to the design of the architectural work - the 801 Tower. They were, in essence, functional and determined to be part of that architectural work as a whole.¹⁹² Accordingly, the section 120(a) exception in the AWCPA applied so showing those portions of Zanja Madre in a movie did not infringe Leicester’s copyright. What he had created was encompassed by the architectural work

¹⁸⁷ *Leicester*, 232 F.3d at 1227 (Fisher, J. dissenting).

¹⁸⁸ H. Rep. No. 101-735, at 20.

¹⁸⁹ *Leicester*, 232 F.3d at 1232 (Fisher, J. dissenting).

¹⁹⁰ Copyright Office Circular 41, Copyright Registration of Architectural Works, Chapter 900 section 126 of the Compendium of U.S. Copyright Office Practices. See also H.R. Rep. No. 101-735, at 20-21.

¹⁹¹ Cf. *Leicester*, 232 F. 3d at 1233 (Fisher J., dissenting); David Shipley, *Has Full Protection Made a Difference*, *supra* note 11 at 44-45. See generally, David Shipley, *All for Copyright Stand Up and Holler! Three Cheers for Star Athletica and the U.S. Supreme Court’s Perceived and Imagined Separability Test*, 36 Cardozo Arts & Ent. L. J. 149 (2018) (thorough discussion of the U.S. Supreme Court’s test for determining copyrightability).

¹⁹² Cf. *Falkner v. General Motors LLC*, 393 F. Supp. 3d at 937 (noting that the *Leicester* court commented “that PGS works may be part of an architectural work when they are designed to appear as part of the building or when they serve a functional purpose that is related to the building”).

copyright on the 801 Tower.¹⁹³ The *Leicester* decision regarding Zanja Madre and the movie ‘Batman Forever’ was correct since Leicester’s sculptural work, as shown in the movie, was integral to the building and functioned as part of that architectural work. There was no need to address the conceptual separability of the parts of Zanja Madre shown in the movie.

In contrast, the murals on the buildings in Detroit that were in the Cadillac and Mercedes Benz advertising photographs posted on social media, and the aerosol art works on the walls of the warehouse in Long Island City that were whitewashed, were not integral to the designs of those buildings nor were they functional. They were conceptually separable works of visual art painted after the buildings were designed and constructed. Had the *Falkner* and *Mercedes Benz* cases gone to trial on whether the advertising photographs infringed the artists’ copyrights in their murals, the results should have been in favor of the artists notwithstanding the section 120(a) exception.¹⁹⁴ The artists’ murals were pictorial works that were not integral to the buildings on which they were painted. They are conceptually separable from the architectural works.¹⁹⁵ The section 120(a) exception in the AWCPA should not be applied to extinguish the rights of artists who create works of visual art on or in buildings that are not integral to the design or function of those buildings.¹⁹⁶

The Second Circuit’s 2020 ruling in *Castillo v. G&M Realty L.P.*¹⁹⁷ provides a clear statement about the rights of visual artists under VARA when their works of recognized stature

¹⁹³ See Barry Werbin, *supra* note 97 (explaining how Leicester’s streetwall towers were part of the overall building plan to extend the property line to the street – they defined the street frontage).

¹⁹⁴ Both cases settled. See David Halberstadter, *supra* note 4.

¹⁹⁵ Falkner was commissioned to create the mural on a preexisting building, and he was given artistic license to decide where to place the mural and what to paint. Loeb & Loeb LLP, *Falkner v. General Motors LLC*, AIPLA Newstand, September 17, 2018. See also *Mercedes Benz, USA, LLC v. Lewis*, 2019 WL 4302769 at *1-*2. Cf. *Petersen v. Diesel Power Gear LLC*, 2022 BL 456881 (S.D.N.Y. 12/21/22).

¹⁹⁶ *Leicester*, 232 F.3d at 1227 & 1235 (Fisher J., dissenting).

¹⁹⁷ 950 F. 3d 155 (2nd Cir. 2020)

on a building are damaged or destroyed by the building's owner.¹⁹⁸ VARA grants authors of certain works of visual art the right to prevent, or recover for, the destruction of a work of recognized stature.¹⁹⁹ It also spells out what should be done when a work of visual art has been incorporated in a building and the owner of that building wants to remodel or demolish the structure.²⁰⁰ Assuming the murals in the *Falkner* and *Mercedes Benz* cases have achieved recognized stature, the owners of the buildings with those murals will have to comply with section 113(d) of VARA before altering or tearing down the structures absent a signed waiver of rights by the artists. Those murals are conceptually separable from the architectural works. The buildings do not depend on them in order to function. The murals are similar to the graffiti art sprayed on the warehouse walls that were whitewashed in the *Castillo* litigation. They were conceptually separable. The warehouse could have functioned without having those works sprayed on the walls by the aerosol artists.

Turning back to *Leicester* and *Zanja Madre*, it is appropriate to ask whether the owner of the 801 Tower in Los Angeles could remodel the building or demolish it without complying with section 113(d) of VARA. After all, section 120(b) of the AWCPA provides that the owners of a building embodying an architectural work may make alterations or authorize destruction of the building without getting permission from the owner of the architectural work.²⁰¹ What are Leicester's rights under VARA, if any, in the event the owners of the 801 Tower wants to remodel the building or tear it down and they do not have a written waiver of rights from him?

¹⁹⁸ See text and notes at notes 50 to 74 *supra*.

¹⁹⁹ 17 U.S.C. § 106A(a)(3)(B).

²⁰⁰ *Id.* §§ 113(d)(1) & (d)(2).

²⁰¹ 17 U.S.C. § 120(b)

Leicester's copyright infringement claim against the unauthorized display of portions of Zanja Madre in the Batman movie failed because the scenes came within the section 120(a) exception. Those portions of Zanja Madre were determined to be integral to the architectural work.²⁰² As part of that work, those portions of Zanja Madre would seem to be within section 120(b) as integral to the architectural work the should its owner want to remodel or destroy the building. If Leicester cannot object to the movie or to photographs of portions of the building showing his streetwall towers, it makes no sense to say that he has rights under VARA to block the destruction or remodeling of the building even assuming Zanja Madre has recognized stature.

However, there were freestanding elements of Zanja Madre that were not at issue in the *Leicester* litigation.²⁰³ In addition, Leicester retained the right to buy back Zanja Madre, even the streetwall, and this suggests that some aspects of his work were not just conceptually separable, but physically separable.²⁰⁴ Unless Leicester signed a waiver of his rights, and assuming Zanja Madre is a work of recognized stature, then he is entitled under section 113(d)(2) of VARA to notice of at least 90-days to remove the work before the building is torn down.²⁰⁵

But for uncertainties surrounding VARA's application to site-specific art,²⁰⁶ the separable sculptural components of Leicester's work in the courtyard should be protected under VARA as sculptural works of visual art.²⁰⁷ He should be given the opportunity to remove them

²⁰² See text and notes at notes 95 to 119 *supra*.

²⁰³ 232 F.3d at 1222 n.2 (Tashimi J., concurring).

²⁰⁴ Cf. 232 F.3d at 1235 note 11,

²⁰⁵ *Id.*

²⁰⁶ See note 88 *supra*.

²⁰⁷ Site-specific art was at issue in *Phillips v. Pembroke Real Estate*, 459 F.3d 128 (1st Cir. 2006). The artist's sculptural works and paths in a park was unified by a theme of spiral and circular forms. Litigation under VARA ensued after he objected to redesigning his work or relocating it. The lower court said that even though this was an integrated work of visual art, the free-standing sculptural pieces could be moved. It also said that VARA's public presentation exception applied so that the artist had no right to object the placement of the works. 459 F.3d at 130-32. See also David Shipley, *The Empty Promise of VARA*, *supra* note 23, at 1035-40.

in the event of remodeling or demolition of the building.²⁰⁸ However, if those components of Zanja Madre cannot be removed, then the building's owner needs a waiver from the artist or else he might be like the owner of the warehouses in *Castillo* and have to pay damages to Leicester for the destruction of Zanja Madre when the building is remodeled or demolished. To interpret VARA and the AWCPA otherwise makes no sense. As Judge Fisher noted in his dissent in *Leicester*:

Without continued application of conceptual separability for PGS works incorporated into buildings, those works, as part of the 'architectural work,' could be altered or destroyed without the permission of their authors. This interpretation would have Congress acting simultaneously to enhance, through VARA, the rights of authors of work of visual art while reducing, through the AWCPA, the rights of authors whose works of visual art are part of a building.²⁰⁹

Judge Fisher concluded that this inconsistency can be avoided by an interpretation of these statutes that preserves pictorial, graphic and sculptural works protection for works of visual art attached to buildings.²¹⁰ I agree with Judge Fisher and this synthesis explains how to interpret the several statutes.

The provisions in VARA and the AWCPA discussed in this article are intended to benefit photographers and others who want to photograph or otherwise portray architectural works, artists seeking to protect their rights in works of visual art incorporated in buildings, and the rights of building owners who want to remodel, alter, or demolish their buildings. Architects

²⁰⁸ 232 F.3d at 1235 n. 11 (noting that Leicester retained the right to buy back the sculpture, including the street wall, should the building even be demolished).

²⁰⁹ *Id.* at 1235.

²¹⁰ *Id.*

holding the copyrights on architectural works are not afforded any protection by the AWCPA or VARA against photographers and others who want to photograph their publicly visible works. Architects also do not have any rights against building owners who want to remodel or demolish their structures.²¹¹ In contrast, the artist who creates a work of visual art incorporated in a building enjoys rights under VARA that can limit or restrict the building owner's rights in the property, especially if that work of visual art has recognized stature.²¹² Finally, if the artist's work of visual art in or on an architectural work is not an integral or functional part of the building's design, then the artist has the right to authorize photographs and other pictorial representations of his or her work of visual art notwithstanding the limitation in section 120(a) of the AWCPA. Similarly, architects have the right to authorize the reproduction of their copyrighted blueprints and plans for constructed buildings that are visible from a public place because the exception in section 120(a) was not intended to cover plans and the work's interior design that cannot be discerned by observing the building from a public place.

²¹¹ 17 U.S.C. §§ 120(a) & 120(b).

²¹² *Id.* §§ 106A(a)(1)-(a)(3) & 113(d)(1)-(d)(2).

