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## Banksy Got Back? Problems with Chains of Unauthorized Derivative Works and Arrangements in Cover Songs Under a Compulsory License

Matthew A. Eller

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## **Abstract**

This Article will analyze the scope of copyright ownership in relation to chains of unauthorized derivative works and chains of arrangement rights in cover versions of musical recordings. In particular, the analysis will focus on the gray area in the law where an unauthorized derivative work ("D1") is created by an author and another author creates a second derivative work ("D2") based off of D1. In situations such as these, does the creator of the original derivative work have any rights in their creation if their derivative work was unauthorized?

Further, depending on what rights do exist for D1, can the creator of the D2 be found to be infringing upon D1? Moreover, even in the case of certain authorized chains of works such as musical "covers" produced under a compulsory license, does the creator of the first derivative work D1 have any legal recourse against further authorized derivative work creators who base their work on the first derivative work?

This phenomenon is demonstrated through examples based in contemporary urban art (Keith Haring and Banksy) and cover songs created through compulsory licenses (Sir Mix-A-Lot, Glee, and Jonathan Coulton).

## **Keywords**

music, copyright, derivative works, compulsory licenses

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SCHOOL OF LAW

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*Article*

**Banksy Got Back? Problems With  
Chains of Unauthorized Derivative  
Works and Arrangements in Cover  
Songs Under a Compulsory License**

***Matthew A. Eller\****

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This Article will analyze the scope of copyright ownership in relation to chains of unauthorized derivative works and chains of arrangement rights in cover versions of musical recordings. In particular, the analysis will focus on the gray area in the law where an unauthorized derivative work (“D1”) is created by an author and another author creates a second derivative work (“D2”) based off of D1. In situations such as these, does the creator of the original derivative work have any rights in their creation if their derivative work was unauthorized?

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This phenomenon is demonstrated through examples based in contemporary urban art (Keith Haring and Banksy) and cover songs created through compulsory licenses (Sir Mix-A-Lot, *Glee*, and Jonathan Coulton).

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## INTRODUCTION

This Article will analyze the scope of copyright ownership in relation to chains<sup>1</sup> of unauthorized derivative works and chains of arrangement rights in "cover" versions of musical recordings. In particular,

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<sup>1</sup> "Chains," as utilized in this Article, is a term coined by Professor Brett Frischmann at Benjamin N. Cardozo School of Law, after a discussion with him regarding this phenomenon. Chains occur when the second author borrows from the first author's work, creating a derivative work. It can be further complicated, or lengthened, when a third author borrows from the second author's work, and so forth.

the analysis will focus on the gray area in the law where an unauthorized derivative work (“D1”) is created, and then a different author creates a second derivative work (“D2”) based off of D1. In this situation, does the creator of the original derivative work have any rights in his or her creation if the derivative work was unauthorized? Further, depending on what rights exist for the creator of D1, can the creator of D2 be found to be infringing upon D1?

Moreover, even in the case of certain authorized chains of works such as musical “covers” produced under compulsory licenses, does the creator of the first derivative work have any legal recourse against further authorized derivative work creators who base their work on the first derivative work?

### I. BACKGROUND

To better understand this phenomenon, one may first look to the world of contemporary urban art. The famed New York artist Keith Haring created many illustrations of a barking dog in his iconic style.



**Figure 1. Keith Haring's Barking Dog<sup>2</sup>**

Over 30 years later, the elusive street artist Banksy (most likely without authorization) created a piece of street art, entitled "Choose Your Weapon," in which a hooded character is taking the Haring dog for a walk.



**Figure 2. Choose Your Weapon, Banksy<sup>3</sup>**

As a response to Banksy's creation (and his subsequent creation of a title sequence for *The Simp-*

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<sup>2</sup> Keith Haring's Barking Dog, MATHI DESIGN, [http://www.mathidesign.com/boutique\\_us/images\\_produits/zMURDO\\_1.jpg](http://www.mathidesign.com/boutique_us/images_produits/zMURDO_1.jpg) (last visited May 24, 2014).

<sup>3</sup> Banksy's Choose Your Weapon, URBAN DEFECTS GALLERY, <http://www.urbandefectsgallery.com/shop/banksy-choose-your-weapon-grey/> (last visited May 24, 2014).

sons),<sup>4</sup> another street art collective under the moniker J-Boy created a piece of urban art entitled “Very Little Helper,”<sup>5</sup> a variation featuring *only* the Banksy hooded character walking Santa’s Little Helper, the family dog from the classic television show *The Simpsons*. Note that J-Boy’s creation does not use the Haring dog or any expression from the original work in the chain.



**Figure 3. Very Little Helper, J-Boy<sup>6</sup>**

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<sup>4</sup> *Banksy Drags the Simpsons Into the Sweatshop in Controversial New Title Sequence*, DAILY MAIL REP. (Oct. 11, 2010, 12:15 PM), <http://www.dailymail.co.uk/tvshowbiz/article-1319517/Banksys-Simpsons-Korean-sweatshop-opening-sequence.html>.

<sup>5</sup> Stephen Saban, *JBoy vs Banksy: It's Dog Eat Dog in the Graffiti World*, WOW REP. (Oct. 11, 2010, 1:15 PM), [http://worldofwonder.co/2010/10/11/Dog\\_Eat\\_Dog\\_in\\_the\\_Graffiti/?utm\\_source=wow&utm\\_medium=permalink&utm\\_campaign=related](http://worldofwonder.co/2010/10/11/Dog_Eat_Dog_in_the_Graffiti/?utm_source=wow&utm_medium=permalink&utm_campaign=related).

<sup>6</sup> J-Boy's Very Little Helper, 34 FINE ART GALLERY, <http://34fineart.com/emulateind.htm> (last visited May 24, 2014).



Although the parties in this example will most likely never litigate these issues in court, we will assume for the purposes of this Article that they in fact are litigating the hypothetical in order to analyze how the law might be applied. For this reason, this chain of works raises many questions as to which parties own which copyrights in which images. For instance, if Banksy did not receive authorization from Haring (or Haring's foundation) to create "Choose Your Weapon," does he forfeit all copyright protection in his entire piece? Similarly, does the law allow Banksy to be found to be infringing upon Keith Haring's copyright in his dog, while at the same time retaining a valid copyright in his hooded figure?

Further, depending on how the law interprets the extent of Banksy's copyright protection in his unauthorized derivative work will dictate if, and to what extent J-Boy possesses a valid copyright in his derivative work based off of Banksy's "Choose Your Weapon." If the court finds that Banksy, as the creator of an unauthorized derivative work, deserves no copyright protection at all, and has no valid copyright in "Choose Your Weapon," this will essentially allow J-Boy to use his original expression free of the threat of infringement. Alternatively, if the court recognizes a copyright in Banksy's original creation of the hoodie character because it is severable from the Haring dog, then this may open up J-Boy to liability for copyright infringement.

Another illustration of this gray area of rights attached to chains of works can be seen in the arena of sound recordings. Recently, the hit television show *Glee* lawfully, under a compulsory license, recorded and performed a cover version of the classic hip hop song "Baby Got Back," originally recorded by

Sir Mix-a-Lot.<sup>7</sup> Pursuant to the compulsory license *Glee* recorded and performed what may be described as a country music variation.

Previously, a musician named Jonathan Coulton, also under a valid compulsory license, had recorded a country version of “Baby Got Back.” Interestingly, the *Glee* version of the song shockingly resembled the Coulton cover.<sup>8</sup> One could gather that in reality, *Glee*’s version of “Baby Got Back” was actually a cover of Coulton’s pre-existing cover.<sup>9</sup> Notably, Coulton’s cover does not receive its own copyright protection as far as the underlying musical composition because of the compulsory license Coulton acquired for his cover, which does not protect the arrangement itself.

Anybody may obtain a compulsory license to make a cover version of a song, provided that all formalities in 17 U.S.C. § 115 are followed. A compulsory license may be obtained for any nondramatic musical work that has previously been distributed to the public in the United States under the authority of the copyright owner.<sup>10</sup> Consequently, a cover artist must serve proper notice on the copyright holder and make timely royalty payments to the copyright holder.<sup>11</sup> Further, § 115 allows the cover artist “the

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<sup>7</sup> Chelsea Stark, ‘*Glee*’ *Airs ‘Baby Got Back’ Cover Despite Copyright Controversy*, MASHABLE (Jan. 25, 2013), <http://mashable.com/2013/01/25/glee-baby-got-back-jonathan-coulton>.

<sup>8</sup> Madina Toure, *Artist Unhappy With Glee’s Use of ‘Baby Got Back’: Do Cover Songs Have an Identity of Their Own?*, SYRACUSE.COM BLOG (Jan. 28, 2013, 1:20 PM), [http://blog.syracuse.com/opinion/2013/01/post\\_181.html](http://blog.syracuse.com/opinion/2013/01/post_181.html).

<sup>9</sup> *Id.*

<sup>10</sup> 17 U.S.C. §115(a)(1) (2012).

<sup>11</sup> *Id.* at § 115(b)(1), (c)(2).

privilege of making a musical arrangement of the work to the extent necessary to conform it to the style or manner of interpretation of the performance involved, but the arrangement shall not change the basic melody or fundamental character of the work, and *shall not be subject to protection as a derivative work* under this title, except with the express consent of the copyright owner.”<sup>12</sup>

Essentially, by choosing to record his cover version under a compulsory license, Coulton elected to receive no rights in the new arrangement used to produce his country version. Under § 115, the arrangement effectively falls into the public domain, and consequently the cover artist cannot claim it because of the way the statute is designed, and the original songwriter cannot claim it, as the original songwriter is not author of the arrangement.<sup>13</sup>

The ownership of the copyright as to the composition and arrangement of “Baby Got Back” belongs to Anthony L. Ray (better known by his stage name, Sir Mix-A-Lot), and its publisher Universal Music,<sup>14</sup> and as such Coulton appears to have no legal recourse against *Glee* for copyright infringement for copying his country arrangement of the song.<sup>15</sup>

Once again, creators of the first work in a chain of works may have no recourse to protect their

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<sup>12</sup> *Id.* at (a)(2) (emphasis added).

<sup>13</sup> Mike Madison, *Coulton, Glee, and Copyright*, MADISONIAN.NET BLOG, (Jan. 28, 2013), <http://madisonian.net/2013/01/28/coulton-glee-and-copyright>.

<sup>14</sup> Elizabeth Landau, *Singer Alleges ‘Glee’ Ripped Off His Cover Song*, CNN (Jan. 26, 2013, 11:59 AM), <http://www.cnn.com/2013/01/26/showbiz/glee-coulton-song-copyright/index.html>.

<sup>15</sup> Note that the analysis would differ if *Glee* actually used Coulton’s sound recording, as that would be infringement.

original portions of such works, allowing the next in the chain to freely steal their expression. In this case, the fact that a compulsory license under § 115 clearly states that the cover artist does not create a derivative work makes the arrangement unprotectable and leaves Coulton in a difficult situation.<sup>16</sup>

Attempting to quantify the actual rights of each member of these derivative work chains will involve analyzing many ambiguous areas of law such as: (1) if authorization is needed to create a derivative work that will result in any rights at all for the derivative artist, (2) the many policies behind different court's reasoning for denying or allowing derivative work rights without prior approval, (3) some exceptions unique to each area of intellectual property (such as VERA for works of fine art and compulsory licenses for musical compositions), and (4) some possible solutions to remedy such situations.

## II. DERIVATIVE WORKS

### *A. The Derivative Work*

The Copyright Act of 1976, specifically in § 106(2), bestows on creators of original works of authorship (which are fixed in any tangible medium of expression) a collection of exclusive rights including the right “to prepare derivative works based upon the copyrighted work.”<sup>17</sup>

A derivative work is defined in 17 U.S.C. §102 as:

a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art

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<sup>16</sup> 17 U.S.C. § 115(a)(2) (2012).

<sup>17</sup> 17 U.S.C. § 106(2) (2012).

reproduction, abridgement, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a “derivative work.”<sup>18</sup>

Accordingly, under this definition both pieces of art based on the Haring dog qualify as derivative works. Moreover, both musical cover versions of “Baby Got Back” are not considered to be derivative works under § 115, but would be under other similar circumstances, which will be discussed in the solutions portion of this Article.<sup>19</sup>

Relatedly, both of these examples also demonstrate how the right to reproduce these works can be extremely profitable. Commonly, the rights to reproduce such derivative works can be more valuable than the right to the original work itself.<sup>20</sup> Banksy is considered by many to be the most popular living street artist of our generation, having had several pieces of art sell for over a million dollars at auction,<sup>21</sup> and his art being reproduced and sold on everything from canvases to T-shirts. Similarly, *Glee* is one of the highest rated shows on television today,<sup>22</sup>

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<sup>18</sup> 17 U.S.C. § 102 (2012).

<sup>19</sup> See *infra* Part IV.B.

<sup>20</sup> *Atari, Inc. v. North Am. Philips Consumer Elec. Corp.*, 672 F.2d 607, 618 n.12 (7th Cir. 1982).

<sup>21</sup> Lowpro, *Viewpoints: Top 25 Most Expensive Banksy Works Ever*, ARRESTED MOTION (Sept. 21, 2011), <http://arrestedmotion.com/2011/09/banksy-top-25-most-expensive-works-ever>.

<sup>22</sup> Daniel Bowen, *Glee: The Most Important Show on TV?*, WHAT CULTURE (Oct. 30, 2012), <http://whatculture.com/tv/glee-the-most-important-show-on-tv.php>.

and for a small up-and-coming artist such as Coulton, being associated with such a hit television show could exponentially increase his current fan base, resulting in greater record sales and live concert attendance.

***B. Do You Need Authorization From the Original Copyright Holder to Create a Derivative Work?***

The crux of the issue at hand, especially when analyzing the Keith Haring derivative works chain, is whether the creator of an unauthorized derivative work can claim any rights in his or her unique expression. The answer to this question is one of abundant ambiguity and is greatly dependent on the Circuit in which the case is brought.

The Second Circuit in *Eden Toys, Inc. v. Florelee Undergarment Co.* dealt with the fictional children's cartoon character Paddington Bear.<sup>23</sup> The court held that when analyzing a string of derivative illustrations that the Plaintiff indeed did have a valid copyright obtained through licenses authorizing the derivative works, but addressed the possible outcome absent the valid license.<sup>24</sup> *Eden Toys* involves three successive tiers of valid copyrights in drawings of Paddington Bear which all were derivative works stemming from one another. The Plaintiff, through licensing agreements, obtained a valid copyright to all three tiers. In a footnote analyzing whether the Plaintiff could have a valid copyright in the chain of derivative without authorization in the original Paddington drawings, the court explains:

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<sup>23</sup> *Eden Toys, Inc. v. Florelee Undergarment Co., Inc.* 697 F.2d 27, 35 (2d Cir. 1982).

<sup>24</sup> *Id.* at 36-37.

It is true that if Eden did not have Paddington's consent to produce a derivative work based on Paddington's copyrighted illustrations its derivative copyrights would be invalid, since the pre-existing illustrations used without permission would "tend[ ] to pervade the entire derivative work."<sup>25</sup>

Here, the court recognizes the fact that a derivative work by its nature retains the "same aesthetic appeal" as the original work, and consequently, because of its inherent similarities, will be an infringing derivative work if authorization is absent.<sup>26</sup>

### ***C. Is There a Bright Line Rule Somewhere Over the Rainbow?***

Around the same time the *Eden* case was being litigated, the Seventh Circuit, in *Gracen v. Bradford Exchange*,<sup>27</sup> although only in dicta, expresses the view that there is a bright line rule that a derivative work cannot be endowed with any copyright protection if the work was created without the authorization of the original works copyright holder.<sup>28</sup>

In *Gracen*, the Defendant Bradford Exchange, under a license from MGM Studios, invited several artists to compete to win an exclusive contract to produce paintings that would be used on a series of collector's plates featuring characters from the classic movie *The Wizard of Oz*.<sup>29</sup> Originally, the Plaintiff Gracen's painting of the character Dorothy was

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<sup>25</sup> *Id.* at 34 n.6.

<sup>26</sup> *Id.* at 35.

<sup>27</sup> *Gracen v. Bradford Exch.*, 698 F.2d 300 (7th Cir. 1983).

<sup>28</sup> *Pickett v. Prince*, 52 F. Supp. 2d 893 (N.D. Ill. 1999).

<sup>29</sup> *Gracen*, 698 F.2d at 301.

selected to be the image for the collector's plates, but after a disagreement as to the terms of the contract, Gracen was replaced by another artist who based their painting not on the movie's depiction of Dorothy, but instead on Gracen's painting of Dorothy.<sup>30</sup>

Although the court affirmed the district court's grant of summary judgment on the grounds that the painting lacked sufficient originality to be copyrightable,<sup>31</sup> in dicta the court, considering 17 USC §103(a), declared that:

[E]ven if Miss Gracen's painting and drawings had enough originality to be copyrightable as derivative works she could not copyright them unless she had authority to use copyrighted materials from the movie. "[P]rotection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully." Therefore, if Miss Gracen had no authority to make derivative works from the movie, she could not copyright the painting and drawings, and she infringed MGM's copyright by displaying them publicly.<sup>32</sup>

Although in dicta, the *Gracen* court lays out a bright line rule awarding no rights to those who create unauthorized derivative works, even to such aspects that are original to the derivative work's author.

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<sup>30</sup> *Id.*

<sup>31</sup> *Id.* at 305.

<sup>32</sup> *Id.* at 302.



***D. A TKO for Original Expression in  
Unauthorized Derivative Works?***

Following in the footsteps of the *Gracen* decision, in the Ninth Circuit case, *Anderson v. Stallone*, Plaintiff Anderson was a screenwriter who wrote a 31-page treatment entitled *Rocky IV* based on the famous characters created by Sylvester Stallone for his *Rocky* movie franchise.<sup>33</sup> Sometime in the early 1980s, while on tour promoting the movie *Rocky III* to members of the press, Stallone shared an idea for *Rocky IV* in which Rocky is asked by a representative from the White House to fight a Russian boxer as a prelude to the Olympics.<sup>34</sup> The fight would take place in Russia, where Rocky would have to overcome insurmountable odds to become the victor. Anderson based his 31-page treatment on this description portrayed by Stallone and credited him as a co-author.<sup>35</sup> Anderson presented his treatment to members of MGM who would be producing the film, but they chose not to option Anderson's script. Subsequently, Stallone completed his own *Rocky IV* script, which was used to create the fourth installment of the series.<sup>36</sup>

Plaintiff Anderson claims that Stallone had copied his *Rocky IV* script from Anderson's 31-page treatment, and brought suit for copyright infringement arguing the position that he is entitled to copyright protection for the non-infringing portions of his treatment.<sup>37</sup> The court granted summary judgment for Defendant Stallone partly based on the fact that

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<sup>33</sup> *Anderson v. Stallone*, No. 87-0593-WDKGX, 1989 WL 206431 (C.D. Cal. Apr. 25, 1989).

<sup>34</sup> *Id.* at \*1.

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

<sup>36</sup> *Id.* at \*2.

<sup>37</sup> *Id.* at \*5.

Anderson's work was not entitled to any copyright protection under 17 U.S.C. § 103(a) and § 106(2).<sup>38</sup>

Anderson argued that § 103(a) grants copyright protection to those parts of his treatment that are original expression, owed solely to him.<sup>39</sup> In his argument, Anderson pointed to the language of the Notes of Committee on the Judiciary, House Report No. 94-1476, which stated

the bill prevents an infringer from benefiting, through copyright protection, from committing an unlawful act, *but preserves* protection for those parts of the work that do not employ the preexisting work.<sup>40</sup>

The court recognized that the language of the House Report is confusing, but disagreed with Anderson's logic, stating that taking the language as a whole is meant to award such rights only to compilations, not derivative works.<sup>41</sup> The House Report clarifies this distinction by stating,

an unauthorized translation of a novel could not be copyrighted at all, but the owner of copyright in an anthology of poetry could sue someone who infringed the whole anthology, even though the infringer proves that publication of one of the poems was unauthorized.<sup>42</sup>

The Court ultimately held that Stallone owns

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<sup>38</sup> *Id.*

<sup>39</sup> *Id.* at \*9.

<sup>40</sup> *Id.* (citing H.R. REP. 1476, 94th Cong., 2d Sess. 57-58 (1976)) (emphasis added).

<sup>41</sup> *Id.*

<sup>42</sup> *Id.*

the copyrights for the first three *Rocky* movies and that under 17 U.S.C. § 106(2), Stallone also has the exclusive right to prepare derivative works.<sup>43</sup> The Court also determined that due to the fact that Anderson's treatment is an unauthorized derivative work, he has no interest in the copyright (even in parts original to his own expression) and has infringed upon Stallone's copyright.<sup>44</sup>

***E. This Is What It Sounds Like When  
Unauthorized Derivative Works Holders Cry?***

Ironically, in 1999, the musician Prince found himself not so much partying,<sup>45</sup> but instead defending himself against a copyright infringement claim in the Seventh Circuit. The case of *Pickett v. Prince*<sup>46</sup> involved an electronic guitar designer who incorporated the Prince symbol into the design of the body of a guitar.



**Figure 4. The Prince Symbol.<sup>47</sup>**

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<sup>43</sup> Id. at \*18.

<sup>44</sup> Id.

<sup>45</sup> Prince's popular single "1999" declares that he's going to "party like it's 1999." Daniel Dunican, *Prince – 1999 (12inch) (Vinyl)*, YOUTUBE (May 15, 2014), <https://www.youtube.com/watch?v=NpTygqODWBg>.

<sup>46</sup> *Pickett v. Prince*, 52 F. Supp. 2d 893 (N.D. Ill. 1999).

<sup>47</sup> Prince Logo, WIKIPEDIA, [http://upload.wikimedia.org/wikipedia/en/a/af/Prince\\_logo.svg](http://upload.wikimedia.org/wikipedia/en/a/af/Prince_logo.svg) (last visited May 24, 2014).

Pickett hoped that he could ultimately sell the guitar to Defendant Prince and bolster his reputation as a guitar maker.<sup>48</sup> Prince decided not to purchase Pickett's guitar, and subsequently Pickett discovered Prince performing with a different guitar that similarly incorporated the aforementioned symbol. Pickett filed suit against Prince, alleging copyright infringement as to his rights in the symbol guitar.<sup>49</sup>

Prince defended such claims by arguing that the Plaintiff cannot bring a copyright infringement suit because the Defendant never granted the Plaintiff the authority to create a derivative work, and as such the Plaintiff has no enforceable rights to sue upon.<sup>50</sup>

Pickett argued that the court should not adhere to the *Gracen* bright line standard, stating that without a valid authorization to create a derivative work one cannot have any rights in such work, which the court should instead treat as mere dictum. Pickett instead insisted that the "pervades" standard originally mentioned in the *Eden Toys* footnote should control.<sup>51</sup>

The court explains that the Plaintiff never actually articulates what the "pervades" standard entails, but the court understands the Plaintiff's argument to follow the logic that copyright protection is available under § 103(a) for parts of the derivative work that do not employ the preexisting work regardless of whether authorization was obtained.<sup>52</sup>

[U]nder Plaintiff's interpretation, authori-

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<sup>48</sup> *Pickett*, 52 F. Supp. 2d at 896.

<sup>49</sup> *Id.*

<sup>50</sup> *Id.*

<sup>51</sup> *Id.* at 901.

<sup>52</sup> *Id.* at 902.

zation is never necessary for a valid copyright in original parts of the derivative work (i.e., those parts not “pervaded” by the preexisting work). For Plaintiff, a derivative work is only unlawful if the original work “pervades” it entirely; whether or not the creator of the original work has authorized it is irrelevant. In other words, Plaintiff finds no circumstances in which authorization would be an issue.<sup>53</sup>

According to the Plaintiff, the language in § 103(a) expresses a Congressional intent that some infringing derivative works would still receive copyright protection, *but only covering those “original” parts* not employing the pre-existing material,<sup>54</sup> as long as the original aspects of the derivative work do not “pervade” the entirety of the pre-existing copyrighted material, whether or not authorization was granted by the original copyright owner.<sup>55</sup>

The court for many reasons finds the Plaintiff’s argument unavailing, and even though the bright line rule proposed in *Gracen* was presented in dicta, the court sided with the Defendant finding that the Plaintiff’s symbol guitar had no copyright protection because it lacked the necessary authority from the Defendant, Prince, to be considered a legitimate derivative work.<sup>56</sup>

### ***F. Professor Nimmer’s Treatise***

Although the Northern District of Illinois ultimately followed the bright line standard articulated

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<sup>53</sup> *Id.* at 904.

<sup>54</sup> *Id.* at 902.

<sup>55</sup> *Id.*

<sup>56</sup> *Id.* at 906.

in *Gracen*, in a footnote the court discussed the ambiguity surrounding the topic of whether the creator of an unauthorized derivative work can maintain a valid copyright in his or her portion of such work that does not “pervade” the original right holder's creation.<sup>57</sup> The court contemplated the fact that even Professor Nimmer's treatise, considered to be the go to authority in almost every copyright case, “does not answer this matter conclusively.”<sup>58</sup>

The court explains that Professor Nimmer addresses what he calls the “lawful use of the underlying work as a condition to a derivative copyright.”<sup>59</sup> The statement enunciates the point that if a copyrighted work is incorporated into a derivative work without authority from the original copyright holder that act will constitute copyright infringement.<sup>60</sup>

Nonetheless, the court continues to point out that Professor Nimmer separately states that a derivative work still may claim copyrightability under § 103(a) in that which was originally contributed to the derivative work even though the derivative author may be an infringer as to that which was borrowed from the pre-existing work. Professor Nimmer states “only that portion of a derivative . . . work that employs the pre-existing work would be denied copyright.”<sup>61</sup>

The court finds these two views to be somewhat contradictory, and appears to question a bright line authorization standard because there may be a possibility where, without a valid authorization to create a derivative work, the author may be able to

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<sup>57</sup> *Id.* at 906 n.17; see *supra* Part II.C for further discussion.

<sup>58</sup> *Id.*

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

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

<sup>61</sup> *Id.*

salvage some rights.

One can see that even though the *Pickett* court follows the dicta of *Gracen*, it still recognizes that there are contradictory views as to the “pervasive” standard, which is still an unsettled point of law.

### III. THE FAIR USE DEFENSE & POLICY CONCERNS

#### *A. Policy*

There are many reasons stated by the different courts as to why their legal interpretations have led to what is clearly a preference for not awarding unauthorized derivative works creators with any rights, but there are also powerful policy concerns, not always addressed or expressed in an upfront manner by the court, but surely are influential in their reasoning.

One such case that deals with important policy considerations (although not specifically spawning its holding from a derivative works analysis) is *Castle Rock Entertainment v. Carol Publishing Group*.<sup>62</sup> This Second Circuit case involved Plaintiff Castle Rock Entertainment, the copyright holders to the hit television series *Seinfeld*, suing Carol Publishing for copyright infringement concerning their trivia quiz book entitled *The Seinfeld Aptitude Test*, known as *The SAT*. *The SAT* was a 132-page book containing 643 trivia questions and answers concerning the many characters and events that had taken place over several seasons of the *Seinfeld* television program. The Defendant based such questions on 84 of the 86 existing episodes that had aired by the time of the book’s publication. The majority of the questions

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<sup>62</sup> *Castle Rock Entm’t, Inc. v. Carol Publ’g Grp.*, 150 F.3d 132 (2d Cir. 1998).

in *The SAT* were multiple-choice questions, which included one correct answer taken directly from a *Seinfeld* television episode, and multiple incorrect answers that were the Defendant's original creation.<sup>63</sup>

The Court, when analyzing the copyright infringement claim, decided to treat the 86 *Seinfeld* episodes as one "discrete, continuous television series" in aggregate, and not as each their own independent work, or each respectively being a derivative work based on the prior episode.<sup>64</sup>

The Court held that *The SAT* unlawfully copied the Plaintiff's expression by deriving their questions from the *Seinfeld* television series, and that such copying did not constitute a fair use as codified in 17 U.S.C. § 107.<sup>65</sup> The Court, while coming to this conclusion in their fair use analysis, discusses the policy matter of the possible future derivative works market for the Plaintiff. The Court states that "[u]nlike parody, criticism, scholarship, news reporting, or other transformative uses, *The SAT* substitutes for a derivative market that a television program copyright owner such as Castle Rock 'would in general develop or license others to develop.'" <sup>66</sup> In essence, the Court, while analyzing the fourth factor of the fair use test – the "effect of use upon potential market for or value of copyrighted work"<sup>67</sup> – is in a roundabout manner stating that the future derivative work market is a right that valid copyright holders should have control over.

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<sup>63</sup> *Id.* at 135.

<sup>64</sup> *Id.* at 138.

<sup>65</sup> *Id.* at 145.

<sup>66</sup> *Id.* (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 592 (1994)).

<sup>67</sup> 17 U.S.C. § 107 (2012).



The logic in *Castle Rock* is further extrapolated upon in *Warner Brothers Entertainment and J.K. Rowling v. RDR Books*.<sup>68</sup> Here, the Second Circuit was faced with, among other claims, a copyright infringement claim by the Plaintiff, the copyright holder of the enormously popular *Harry Potter* series, brought against the Defendant, a book publisher who was attempting to publish the unauthorized *The Harry Potter Lexicon*, which the Defendant described as the “definitive” Harry Potter encyclopedia.<sup>69</sup> The Defendant compiled the information for the content of the *Lexicon* from the creator of the *Harry Potter* character and author of the series, “J.K. Rowling, either in the novels, the ‘schoolbooks,’ from her interviews, or from material which she developed or wrote herself,” and a small amount of select outside reference sources, such as *Bullfinch’s Mythology*, *Field Guide to Little People*, *New Shorter Oxford English Dictionary*, and online encyclopedias.<sup>70</sup>

The Court did not agree with the Plaintiff’s contention that the *Lexicon* was indeed an unauthorized derivative work based on the *Harry Potter* franchise because the *Lexicon* was not an “elaborate recounting” that did not follow the same plot structure as the *Harry Potter* novels, and because the purpose of the *Lexicon* was to give the reader an understanding of individual elements in the elaborate world of *Harry Potter* that appear in diverse and voluminous sources as organized in an A-to-Z reference guide.<sup>71</sup>

The Court once again, as in *Castle Rock*, confronted the policy issues surrounding the potential

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<sup>68</sup> Warner Bros. Entm’t, Inc. v. RDR Books, 575 F. Supp. 2d 513 (S.D.N.Y. 2008).

<sup>69</sup> *Id.* at 523.

<sup>70</sup> *Id.* at 525.

<sup>71</sup> *Id.* at 539.

for a future derivative works market. Although the court did not hold that the market for reference guides becomes derivative simply because a copy-right holder may plan to produce or license a similar product,<sup>72</sup> the Court did hold that

in striking the balance between the property rights of original authors and the freedom of expression of secondary authors, reference guides to works of literature should generally be encouraged by copyright law as they provide a benefit to readers and students; but to borrow from Rowling's overstated views, they should not be permitted to 'plunder' the works of original authors . . . without paying the customary price . . .

and consequently authors would "lose incentive to create new works that will also benefit the public interest."<sup>73</sup>

In sum, the Court was hesitant to hold that a copyright holder's plans to produce a similar work in the future does not *per se* lead to the fourth factor of the fair use analysis tipping in their favor, noting the fact that the Defendant's *Lexicon* would essentially "plunder" the works of Rowling, and additionally that "one potential derivative market that would reasonably be developed or licensed by Plaintiffs is use of the songs and poems in the Harry Potter novels"<sup>74</sup> would be impaired by the publishing of Defendant's *Lexicon* which was enough to find the work of Defendant infringing, and strongly against public

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<sup>72</sup> *Id.* at 550.

<sup>73</sup> *Id.* at 551.

<sup>74</sup> *Id.*

policy.

Further illustrating the policy concerns intertwined with unauthorized derivative works, the *Pickett* court,<sup>75</sup> who found ambiguity as to interpretations concerning statutory language in the House Report while anchoring their decision to following *Gracen's* bright line rule, was particularly sympathetic to Defendant Prince, because granting any copyright in the Plaintiff's derivative work may deprive him of the exclusive right to produce additional derivative works based on the symbol he created.<sup>76</sup>

In particular, the Court emphasized that Prince may lose the ability to one day produce and market the guitar at issue in the case, or possibly a bass guitar version, or even a violin containing the Prince symbol.<sup>77</sup> The possibility of Prince producing such items the future is not farfetched, just as the possibility of a future production of a trivia book in *Castle Rock*. Prince is one of the most well-known musicians in the world and has used the symbol as part of many derivative works such as T-shirts, posters, and other merchandise. One should also note that instilling any sort of copyright in *Pickett's* unauthorized guitar could potentially rob Prince of the opportunity to license his symbol to other guitar makers of his choice in the future,<sup>78</sup> similar to the songs from the *Harry Potter* series discussed by the court in *RDR*. The court describes such a situation as the "creation of a *de facto* monopoly on derivative works to the detriment of the owner of the copyright in the preexisting work."<sup>79</sup>

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<sup>75</sup> See *supra* Part II.E.

<sup>76</sup> *Pickett v. Prince*, 52 F. Supp. 2d 893, 909 (N.D. Ill. 1999).

<sup>77</sup> *Id.*

<sup>78</sup> *Id.*

<sup>79</sup> *Id.* at 908.

These examples illustrate the fact that courts, when deciding what rights may be awarded to an unauthorized derivative works holder, cannot simply look at severability or the pervasiveness of the derivative work, but must also factor in policy concerns such as the potential for a future derivative market for the valid copyright holder, the benefit that will be instilled in the public interest by offering authors incentives to create further works, and avoiding the creation of a “de facto monopoly.”<sup>80</sup>

### ***B. Fair Use, Punishment, and the Public Domain***

As previously discussed, many courts, while grappling with the problem of unauthorized derivative works or policies related to potential future markets for production or licensing of such works, have analyzed the possibility of a fair use defense presented by a defendant. Although this Article is not principally concerned with the fair use defense in regard to the Banksy and Coulton hypotheticals, a brief discussion as to its relevance is still warranted.

The doctrine of fair use is a limited exception in American copyright law to copyright holder’s otherwise exclusive rights. The fair use doctrine is designed to “fulfill copyright’s very purpose, ‘[t]o promote the Progress of Science and useful Arts.’”<sup>81</sup> Codified in § 107 of the Copyright Act of 1976,<sup>82</sup> fair use is justified “for purposes such as criticism, comment, news reporting, teaching, scholarship, or re-

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<sup>80</sup> *Id.*

<sup>81</sup> Warner Bros. Entm’t, Inc. v. RDR Books, 575 F. Supp. 2d 513, 540 (S.D.N.Y. 2008) (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 575 (1994) (quoting U.S. Const. art. I, § 8, cl. 8)).

<sup>82</sup> 17 U.S.C. § 107 (2012).

search” and as such is not an infringement of copyright.<sup>83</sup>

In a fair use analysis, after a finding of the defendant’s infringement of a copyright, the court must analyze this defense on a case-by-case basis by balancing a four-factor test: (1) the purpose and character of the use; (2) nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and, (4) the effect of the use upon the potential markets.<sup>84</sup> If the Court finds that the factors weigh in the defendant’s favor, the fair use doctrine will excuse such infringement. Fair use must ideally balance

on one hand “[t]he monopoly created by copyright . . . rewards the individual author in order to benefit the public,” and on the other “[m]onopoly protection of intellectual property that impeded referential analysis and the development of new ideas out of old would strangle the creative process.”<sup>85</sup>

In the realm of unauthorized derivative works, the fair use doctrine does play a relevant role in that if the unauthorized derivative work is found to be justified after weighing the four fair use factors, this would in essence transform the unauthorized derivative work into a piece no longer needing permission from the original copyright holder, and as such rescue the derivative work creator’s rights in their original expression. The House Report No. 94-1476,

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<sup>83</sup> *Id.*

<sup>84</sup> *Id.*

<sup>85</sup> *Warner Bros. Entm’t, Inc.*, 575 F. Supp. 2d at 540 (quoting Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1109 (1990)).

when clarifying § 103, specifically anticipates for such a situation when they explain,

Under this provision, copyright could be obtained as long as the use of the preexisting work was not “unlawful,” even though the consent of the copyright owner had not been obtained. For instance, the unauthorized reproduction of a work might be “lawful” under the doctrine of fair use or an applicable foreign law, and if so the work incorporating it could be copyrighted.<sup>86</sup>

Although some could argue that Banksy’s “Choose Your Weapon” could be saved by a court finding that it qualifies for fair use protection under § 107 in the enumerated categories of either criticism or comment, there are far too many other unknown factors to definitively come to such a conclusion.<sup>87</sup>

Another school of thought focuses on the idea that the law does not reward wrongdoers, and as such Banksy, by not obtaining a valid authorization to create “Choose Your Weapon,” loses the privilege of copyright protection in his original expression, and all other related benefits because of his bad act. This theory essentially forces any unauthorized derivative work, absent a valid exception such as fair use, into the public domain. In the Banksy situation, Haring would still hold all rights in his dog character, but all additional expression added by Banksy, such as his hooded figure character, as a result of his transgression would instead be thrust into the public domain,

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<sup>86</sup> H.R. REP. 1476, 94th Cong., 2d Sess. 57-58 (1976).

<sup>87</sup> Ultimately this Article is more concerned with the possible outcomes of no valid fair use defense. See *supra* Part III.B for a discussion regarding fair use.

free for anyone to use. Some would argue that this is the correct result because Banksy should not be rewarded for violating Haring's legal rights, and society should reap the benefits of the misdeed with new elements added to the public domain for everyone to improve upon.

Similarly, in the case of a musician who chooses to create a cover version of a song by satisfying the requirements of a compulsory license under § 115 by operation of law, the expression found in the new arrangement falls into the public domain, facing a similar fate to that of an unauthorized derivative work discussed above. This is effectively why Coulton has no legal recourse against *Glee* for stealing his country arrangement. Because Coulton chose to use a compulsory license to create his cover version of "Baby Got Back," a legal consequence of such a decision (surely unanticipated by Coulton) is that now his arrangement is part of the public domain for all to use freely.<sup>88</sup>

This result is distinguishable from the Banksy situation in the manner that Coulton was not a wrongdoer; in fact his actions were completely legal and encouraged under § 115. However, because the compulsory license is a cost effective method to obtain access to source material without obtaining the copyright owner's permission, which can be costly for a new artist to negotiate for such rights, the consequence of such a convenience comes with the downside of no legal rights in the cover artist's new arrangement.<sup>89</sup>

Although fair use may be a viable defense for the creator of an unauthorized derivative work in

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<sup>88</sup> Madison, *supra* note 13.

<sup>89</sup> *Id.*

some limited situations, it is not a viable solution in all circumstances. Fair use is reserved for actors who are not wrongdoers. Subsequently, those wrongdoers will effectively find their work added to the public domain for all to use freely. Similarly, and arguably unfairly, a parallel result is inevitable under § 115 as to the arrangement of cover songs as a consequence of the compulsory licenses convenience.

#### IV. ANALYSIS & APPLICATION

##### *A. Did Banksy Choose the Wrong Weapon?*

Now, the discussion will return to the first hypothetical concerning the chain of derivative works based on the Keith Haring dog.<sup>90</sup> In this example, Banksy has created his derivative work “Choose Your Weapon” by producing his own original hooded figure holding the Keith Haring dog on a leash as if the figure is taking the dog for a walk.

If one analyzed “Choose Your Weapon”<sup>91</sup> under the reasoning set out in *Eden Toys*, one could come to the conclusion that because Banksy most certainly did not obtain Haring’s consent to produce the derivative work, he would hold no rights in the work. Under this logic, J-Boy’s piece “Very Little Helper”<sup>92</sup> would not be infringing as a derivative work as to the hooded character created by Banksy, and would be free from any form of copyright infringement liability with regard to Banksy.

Moreover, the *Eden Toys* court was the first to discuss this idea of the original copyright holder’s work pervading the entire derivative work. In this

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<sup>90</sup> See *supra* Figure 1, note 2, and accompanying text in Part I.

<sup>91</sup> See *supra* Figure 2.

<sup>92</sup> See *supra* Figure 3.



case, one can easily separate the Haring dog from the hooded figure without any overlap. An argument can be made that the Haring dog does not tend to pervade the entire derivative work because both images are completely separable; consequently, Banksy should be liable for infringing the Haring dog, but may retain rights as to the hooded figure character. These rights could be used to bring his own suit against J-Boy for creating an unauthorized derivative work using Banksy's copyrighted hooded figure.

However, following the reasoning laid out in dicta by the *Gracen* court, Banksy would forfeit all rights in "Choose Your Weapon," including those parts of expression that are original to him, although completely severable. As such, J-Boy essentially has stolen Banksy's original expression with no fear of liability from Banksy (but is still of course possibly liable to *The Simpsons* for using the image of Santa's Little Helper).

A similar result would be produced under the holding in *Stallone*. However, the logic followed by the court in *Stallone* was based on the idea that the character of Rocky was developed to such a point that he was part of "one of the most highly delineated group of characters in modern American cinema."<sup>93</sup> Moreover, the characters in the derivative work, Plaintiff Anderson's *Rocky IV* treatment, "[were] not merely substantially similar to Stallone's, they are Stallone's characters."<sup>94</sup> As such, because the character Rocky, combined with his unique personality and mannerisms created by Stallone, was so intertwined and essential to the story that there

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<sup>93</sup> Anderson v. Stallone, No. 87-0593-WDKGX, 1989 WL 206431, at \*7 (C.D. Cal. Apr. 25, 1989).

<sup>94</sup> *Id.* at \*8.

could be no way to separate the two, identifying which aspects could be protectable without the Rocky character would be an impossible chore.

Correspondingly, the dog in the Banksy piece, as in *Rocky*, was not merely substantially similar to that of the Haring dog, it was essentially identical. But unlike the character of Rocky, the Haring dog is not so intertwined with the hooded character that they could not be separated and easily distinguished, which is evidenced by the fact that J-Boy used the figure in his derivative work without any trace of the Haring dog, with the hooded character completely identifiable as originally created by Banksy). This aspect of severability could possibly be enough to differentiate these situations and conceivably negate much of the impact of the *Stallone* holding in this case.

Once more, a similar result almost certainly would be achieved under the holding of the *Prince* case. Again, the court in *Prince* followed the bright line rule laid out in *Gracen*, denying any sort of copyright protection to an unauthorized derivative work.<sup>95</sup> However, the court clearly established, that an unauthorized creator of a derivative work may be entitled to copyright protection in those facets of the derivative work which do not appear in the original copyrighted item, but only if the original aspects used in the unauthorized derivative are not so “pervasive” as to overtake the entire essence of the work.<sup>96</sup> The *Prince* court, in reality, based their denial of copyright protection of the Plaintiff’s guitar concerning those facets that were original to him.<sup>97</sup>

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<sup>95</sup> *Pickett v. Prince*, 52 F. Supp. 2d 893, 909 (N.D. Ill. 1999).

<sup>96</sup> *Id.*

<sup>97</sup> *Id.* at 907.

If the Prince symbol was removed from the guitar, all that would remain would be functional and utilitarian objects, such as guitar strings.<sup>98</sup> As such, even if the court did decide that the symbol guitar was separable, there would be nothing left to grant rights for anyhow.

As *Prince* suggests, the Banksy hooded figure is easily separated from the Haring dog and once divided, unlike the Prince symbol guitar, some protectable subject matter would indeed remain. The purely original expression that would normally be awarded full copyright protection (if it were not part of an unauthorized derivative work), once severed, would remain protectable.

Further, Banksy, as the creator of an unauthorized derivative work, would enjoy no copyright protection in his piece “Choose Your Weapon,” even though there are purely original aspects attributable only to Banksy. Interestingly, J-Boy will be able to use Banksy’s original expression as articulated in the form of his hooded character without fear of claims of copyright infringement brought by Banksy.<sup>99</sup>

It seems ironic and unjust that the law punishes the first author of an unauthorized derivative work in a chain by depriving them of all copyright protection, especially to any severable and original parts of the work, while simultaneously rewarding any other subsequent derivative work authors who take any original aspect of the first author’s unauthorized derivative work by allowing that second author to essentially perform the same bad act, free of any threat of legal consequences under copyright

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<sup>98</sup> *Id.*

<sup>99</sup> Although there most likely would be a trademark claim still available.

law.

Furthermore, a result mandating that Banksy would receive no rights in any portion of his work would be contrary to the policy concerns expressed in *Prince*. Essentially, Banksy has been foreclosed from enjoying any benefits in connection with future derivative works based on his original expression, including, but not limited to, future sequels of “Choose Your Weapon,” while J-Boy may freely exploit them. This can be seen as reminiscent of the *Prince* court’s logic, as to the future opportunity for Prince to produce his own guitars or violins based on his copy-righted symbol.

***B. Did Baby Get Back Any Rights for Coulton?***

The second situation posed earlier concerned the television show *Glee* recording and performing a cover version of an already existing cover version of the song “Baby Got Back.” Unlike the previous hypothetical however, both works in this chain were authorized by statute; the authority enjoyed by both works’ creators (*Glee* and Coulton) was obtained legitimately through a compulsory license.

As such, Coulton was within his rights to produce his cover version of “Baby Got Back” in a country music style. Similarly, *Glee*, which subsequently obtained the same compulsory license, was also well within its legal rights to also produce a country version of the same song.

The interesting ripple, which has resulted from this situation, is that Coulton is not entitled to any sort of credit or compensation from *Glee* for copying his original arrangement. Covers do not possess their own copyright protection as far as the underlying musical composition, so Coulton’s only legal recourse under copyright law is an infringement suit,

which he is only able to bring if *Glee* used portions of the *actual audio track* he recorded.<sup>100</sup>

So once again, in this gray area of the law, the author of the first work in a chain of derivative works is left with no recourse to defend the copying of their original expression that distinguished the derivative work from the original copyrighted work. This loophole allows the second author to escape all legal liability for their work that has essentially stolen the first author's expression, which would have been subject to copyright protection if it was not under a compulsory license.

This situation is distinguishable from all the prior cases analyzed, particularly when discussing the policy issues discussed in *Prince*. Specifically, the compulsory license is designed to make sure that the original composer, who must allow covers of their song, as long as the cover artist abides by the limitations of 17 U.S.C. § 115, is guaranteed to receive compensation from each cover through royalty payments. In *Prince* the court was sympathetic to the fact that many possible options from future derivative works could be foreclosed upon, robbing the original rights holder from future income. Here, the rights awarded through compulsory licenses do not foreclose any possible avenues to the original rights holder and only award rights to the creator of the secondary work if their actual sound recording is identically reproduced.

## **V. WHICH WEAPON SHOULD BANKSY CHOOSE? HOW CAN COULTON GET BACK HIS "BABY GOT BACK"?**

Both Banksy's and Coulton's situations raise many issues concerning the proper rights that should

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<sup>100</sup> Landau, *supra* note 14.

be afforded to artists who are links in a chain of artistic works that build from one another. Although one situation is constructed from a chain of unauthorized derivative works, and the other is composed under a lawful compulsory license, both find themselves with identical unfortunate fates. However, there are possibilities that feasibly could find a more favorable result for Banksy and Coulton.

As discussed earlier, one prospect for Banksy to obtain rights in the original expression of his hooded figure would be to defend an infringement action with a valid fair use defense. A court finding such an outcome would fundamentally excuse Banksy for his “wrongdoing” and preserve his rights in *only* the aspects of “Choose Your Weapon” which are original to him. This would allow Haring to keep all rights in his dog figure, and all future derivative projects or licensing opportunities he would like to exploit, and would leave limited circumstances in which Banksy could exploit the image. Further, Banksy would keep all rights in his original expression of the hooded character, which would include the ability to bring an infringement action against other unauthorized derivative works, such as J-Boy’s “Very Little Helper.” But as discussed earlier, a fair use defense is not an easy defense to prove, and as such most likely not a practical solution.

Another interesting aspect is that the compulsory license, if one existed for visual arts and was available to Banksy when he created “Choose Your Weapon,”<sup>101</sup> would possibly have been a viable solution. By complying with the limitations of a compulsory license applied to the visual arts, Banksy’s de-

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<sup>101</sup> Compulsory licenses under 17 U.S.C. § 115 are only for sound recordings, not for visual works.

ivative work would no longer have been considered unauthorized and he would not need authorization as long as he complied with whatever statutorily mandated actions must be fulfilled. Further, this would award him legal protection as to exact copies of his original expression, similar to the idea that Coulton's only current recourse would be if *Glee* used his actual sound recording. Under this theory one could argue that J-Boy, by copying Banksy's hooded character, has performed the equivalent of copying the actual sound recording, as may be the case in the *Glee* situation.

Further, the real core of the issue in the Banksy chain of derivative works is the question of whether Banksy's unauthorized derivative work in fact "pervades" a sufficient amount of Haring's expression to not be entitled to any copyright, and relatedly, whether the novel expression of the hooded character presented by Banksy in his unauthorized derivative work is completely severable from the Haring dog, and if so, should be awarded independent copyright protection.

This situation would put courts in a difficult situation. How could a court set a standard to measure what "pervading" a work actually means? It would almost certainly involve a case-by-case analysis with many factors to balance similar to the fair use test discussed earlier, or possibly the "pervasive" standard could be an extension of the current fair use analysis?

### ***A. Viable Severability Standard***

Correspondingly, and ostensibly more practical, would be a viable severability standard (reminiscent of the analysis used in trademark law under the functionality doctrine). Under such a standard a

court would have to analyze: (1) to what extent the original expression of the offending derivative work is original to the offending artist, and (2) if the infringing and non-infringing expressions of the derivative work can be separated to such a point that both expressions could exist independently. If a defendant could satisfy both of these requirements, then a court could effectively award rights to the infringing derivative artist as to their independent expression, while simultaneously punishing them for infringing the unauthorized portions under a traditional infringement action.

Under this theory, the Court could award Banksy all the pertinent copyright protection in his hooded figure, including the right to sue others for infringement in that expression, and simultaneously proceed with a standard infringement analysis as to the Haring dog that Banksy used illegally, handing down punishment accordingly. Of course, there are flaws incorporated in this reasoning, including the fact that it ignores the public policy of not rewarding wrongdoers, and the fact that in this specific example, the derivative work is a fairly straight forward image which can easily be separated. (In Banksy's derivative work, it would be as easy as drawing a line down the center of the image between the Haring dog and the hooded figure.) Most other situations surely will not present the Court with such user-friendly separation, and as such may create judgments based on personal preference,<sup>102</sup> or parties be-

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<sup>102</sup> A concern that may be interpreted as parallel to the fears of judges interpreting artistic merit when determining if a valid copyright is merited, which is discussed in the seminal case *Bleistein v. Donaldson Lithographing Co.* 188 U.S. 239, 251 (1903), where the court determined “[i]t would be a dangerous undertaking for persons trained only to the law to constitute



ing assigned unwarranted copyright protection in others' rights.

### ***B. Attribution & Moral Rights***

The further irony stemming from both of these situations is strengthened by the fact that Coulton has expressed the opinion that attribution could have been one of the worthwhile solutions to *Glee* stealing his arrangement:

It's a little frustrating. Whether or not they're in the right legally, it doesn't seem like the best way to handle it. If you're going to claim that you're giving an artist exposure and they should be grateful – there's a right way to do that. Contact them ahead of time. Say this is great, we're going to talk about it on our blog and tell all our fans that they should be fans of yours. We're going to put a credit in the show. That doesn't cost them anything. It's a show with something like a \$3.5 million budget for each episode, but there are still so many free things they could have done to engender goodwill.<sup>103</sup>

Interestingly, moral rights of attribution are only awarded under US copyright law for works of

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themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public learned the new language in which their author spoke.”

<sup>103</sup> Laura Hudson, *Jonathan Coulton Explains How Glee Ripped Off His Cover Song – And Why He's Not Alone*, WIRED (Jan. 25, 2013, 3:21 PM), <http://www.wired.com/2013/01/jonathan-coulton-glee-song/>

fine art. Under the Visual Artists Rights Act of 1990 (VARA), works of art that meet certain criteria are traditionally awarded moral rights which are not present in any other sector of United States intellectual property law.<sup>104</sup> In particular, one of these exclusive rights is that the author of a work of visual art shall have the right to claim authorship of their original works.<sup>105</sup> If similar legislation to that of VARA were available for musicians who cover songs under a compulsory license, such as Coulton, they could be endowed with the right to at least be accredited for their arrangements of cover songs reproduced by a second derivative artist.

### ***C. Licensing***

Another viable solution for Coulton would be to obtain a license to “Baby Got Back” from the Harry Fox Agency. Agencies like Harry Fox act on behalf of many copyright holders in administering the further uses of such copyrights. These licenses are in many ways similar to the rights granted to an artist under § 115 in that they grant rights that are no greater and no lesser than the rights under § 115. The major difference between the Harry Fox license and the legal grant authorized by Congress in § 115 is that the license is actually a contract between the original composer and the cover artist, and possibly could be amended through negotiations to reflect an intellectual property right in the arrangement for the cover artist.<sup>106</sup>

Similarly, Coulton could circumvent the Harry Fox license all together, and instead approach Sir

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<sup>104</sup> 17 U.S.C. §106(a) (2012).

<sup>105</sup> 17 U.S.C. §106(1)(a) (2012).

<sup>106</sup> Madison, *supra* note 13.

Mix-a-Lot directly and negotiate a deal including, rights, royalties, and any other issues important to Coulton concerning his cover version. This agreement could entail requiring Coulton to assign his publishing rights (for the new arrangement) to Sir Mix-a-Lot, or conversely, Coulton could insist on keeping the publishing rights (and possibly pay Sir Mix-a-Lot a royalty) granting him rights in his new arrangement.<sup>107</sup>

### CONCLUSION

The fact that particularized special circumstances exist, such as the compulsory license and VARA, illustrates that legislation has been put in place to deal with deficiencies as to the rights of copyright holders. Of course, it is nearly impossible to prepare for every issue that could possibly arise concerning artist rights, however, these pieces of legislation prove that there are viable possibilities already available to fill holes in the law upon discovery.

Artists, like Banksy, who create severable unauthorized derivative works, may be assisted by the court's adoption of a test of some nature to retain rights in the original portions of such work, or by a successful fair use defense of an infringement action. But such options may be unlikely due to the strong public policy to not reward wrongdoers.

Coulton could never have anticipated when he chose to record his cover song under § 115 that another creator would copy his arrangement. Nonetheless, Coulton and others who find themselves in a similar predicament could be compensated by a law compelling attribution to such artists. More realistically however, many believe that *Glee* did actually

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<sup>107</sup> *Id.*

copy Coulton's actual recording,<sup>108</sup> so Coulton may find justice in a standard copyright infringement action (or most likely a settlement, if actual copying is proven).

Ironically, if Coulton did in fact receive attribution initially by *Glee*, he would most likely not be enjoying the large amount of publicity that has arisen from the unauthorized copying. For a brief period following the outrage, Coulton's cover version outsold any *Glee* song on iTunes.<sup>109</sup>

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<sup>108</sup> Caleb, *Were Jonathan Coulton's Actual Audio Tracks Reused by Glee?*, REFRACTORING MY BRAIN (Jan. 26, 2013, 11:23 PM), <http://refactoringmybrain.blogspot.com/2013/01/were-jonathan-coultons-actual-audio.html>.

<sup>109</sup> Michele Catalano, *Jonathan Coulton Vs. Glee And Fox Update: Last Laughs*, FORBES (Jan. 31, 2013, 8:17 PM), <http://www.forbes.com/sites/michelecatalano/2013/01/31/jonathan-coulton-vs-glee-and-fox-update-last-laughs>.