



Copyright Law Alert: New York District Court Dismisses Claims Of Copyright Infringement Involving A Photograph That Depicts Graffiti And Also Finds Alleged Infringement De Minimis

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On January 13, 2021, the U.S. District Court for the Southern District of New York granted a motion to dismiss of trademark and copyright claims of a pro se plaintiff's amended complaint in its entirety in *Gayle v. Allee*, No. 18 Civ. 3774 (JPC), 2021 U.S. Dist. LEXIS 6756 (S.D.N.Y. Jan. 13, 2021).

Specifically, the court dismissed the pro se plaintiff's claims of copyright infringement against a photographer and art gallery for exhibiting and offering for sale a photograph that depicted graffiti tagged with the words "ART WE ALL ONE" and for similarly titling that photograph "Art We All One"

As a practical matter, this case emphasizes the importance of the need to properly plead a federal copyright infringement claim and that the mere use of a phrase from a copyrighted work is not enough to prove substantial similarity. It also provides a good example of what a court considers to be de minimis copyright infringement.

Background and Procedural History

Plaintiff Itoffee R. Gayle holds a copyright relating to the phrase "ART WE ALL" through Registration No. VA-2-006-958 entitled "Art We All," containing eight photos and Registration No. VA 2-088-822, entitled "Art We All Group Registration Photos," containing 13 photos.

Gayle, proceeding pro se, filed suit alleging claims of, among others, copyright infringement against photographer David Allee and the Morgan Lehman Gallery (collectively, "defendants") for exhibiting and offering for sale a photograph that depicted graffiti tagged with the words



“ART WE ALL ONE” and for similarly titling that photograph “Art We All One.”

Gayle’s claims related to a photograph that Allee took of two buildings in New York City. Viewable in the bottom right corner of the photograph is a small construction barrier tagged with graffiti reading, “ART WE ALL ONE.” The photograph—which Allee titled “Art We All One”—was displayed for sale in the gallery in 2017 as part of one of Allee’s solo exhibitions.

But Gayle failed to allege which specific images were infringed, instead seemingly arguing that it is the text “ART WE ALL” and “ARTWEALL” that are copyrightable in and of themselves. The defendants moved to dismiss the initial complaint/first motion to dismiss. During a telephone conference, the court granted defendants’ first motion to dismiss. During that conference, the court concluded that Gayle had not adequately alleged a copyright claim because he failed to plead what images were covered by the copyright and how any infringement was more than “de minimis.” The court nonetheless gave Gayle leave to file an amended complaint.

Gayle subsequently filed an amended complaint. The amended complaint (like the initial complaint) alleged claims of copyright infringement for exhibiting and offering for sale a photograph that depicted graffiti tagged with the words “ART WE ALL ONE” and for similarly titling that photograph “Art We All One.” Defendants moved to dismiss the amended complaint, contending that it had failed to cure the deficiencies identified by the court’s initial ruling.

Gayle Failed to Properly Plead a Federal Copyright Claim

With respect to the federal copyright claim, defendants contended that Gayle had not properly pleaded a federal copyright infringement claim. In order to prevail on a copyright infringement claim, a plaintiff must demonstrate: (1) ownership of a valid copyright; and (2) infringement of the copyright by the defendant. *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 108-09 (2d Cir. 2001). And, to establish copyright infringement, a plaintiff with a valid copyright must demonstrate: (1) the defendant actually copied the plaintiff’s work; and (2) the copying is illegal because a substantial similarity exists between the defendant’s work and the protectible elements of plaintiff’s work. *Hamil Am. Inc. v. GFI*, 193 F.3d 92, 99 (2d Cir. 1999).



During the court's telephone conference related to the first motion to dismiss, the court elaborated that Gayle failed to identify which original works were covered by his two copyright registrations—namely, which specific images attached to Gayle's opposition belong to which copyright registration.

In the amended complaint, Gayle again alleged that he owned two valid copyrights and that those copyrights were registered in accordance with statute. He also alleged by what acts and in what manner that those copyrights were infringed, namely the creation and display of Allee's photograph.

However, Gayle failed to allege which specific images of his two copyright registrations—which collectively contain 21 photos—had been infringed, instead seemingly arguing that it is the text "ART WE ALL" and "ARTWEALL" that are copyrightable in and of themselves. The court determined that those phrases, absent more, do not merit copyright protection. Therefore, the court held that Gayle failed to adequately plead a copyright claim.

The Photograph and Gayle's Copyrighted Work Are Not Substantially Similar

The court next found that Gayle's amended complaint failed for a more fundamental reason—the image of the graffiti in the photograph and Gayle's copyrighted work were not substantially similar as a matter of law, since the only common elements were non-copyrightable.

The court first considered whether the phrase "ART WE ALL" is copyrightable, and concluded that it is not. "The standard test for substantial similarity between two items is whether an ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard [the] aesthetic appeal as the same." *Yurman Design*, 262 F.3d at 111 (quotations omitted).

However, if a work has both protectible and unprotectible elements, the court must undertake a more discerning analysis and attempt to extract the unprotectible elements



from consideration and ask whether the protectible elements, standing alone, are substantially similar. See *Peter F. Gaito Architecture, LLC v. Simone Dev. Corp.*, 602 F.3d 57, 66 (2d Cir. 2010). Further, “it is axiomatic that words, short phrases, titles and slogans are not subject to copyright, even if they are trademarked.” See, e.g., *Moody v. Morris*, 608 F. Supp 2d 575, 579 (S.D.N.Y. 2009).

The court considered Gayle’s argument that “[i]t is this artistic design that comprises the copyrighted material, not the words by themselves.” The court recognized that even if the words are not subject to copyright protection, it should consider whether Gayle presented the words in an original manner that would be protectible.

However, Gayle did not point to any component parts that would be protected. And, after reviewing the images attached to the amended complaint, the court was unable to identify any protected elements that had been infringed. Accordingly, looking at both the elements and the overall look of the copyrighted images and the graffiti, the court concluded that Gayle failed to state a claim for copyright infringement.

The Alleged Copyright Infringement Is De Minimis

Finally, the court concluded that Gayle’s copyright claim failed for yet another reason—any alleged infringement is de minimis. Copying a piece of work is not a copyright violation if the copying is de minimis, meaning that it is so “trivial . . . as to fall below the quantitative threshold of substantial similarity.” *Ringgold v. Black Ent. Television Inc.*, 126 F.3d 70, 74 (2d Cir. 1997).

Gayle argued that the similarity of the Mark, the closeness of the products and defendants’ motive and lack of good faith demonstrate that defendants’ use of the mark was not de minimis. However, the Second Circuit has explained that substantial similarity for the purposes of the de minimis inquiry is not entirely about whether something was copied. See *Ringgold*, 126 F.3d at 74-75.

The court must look not to whether there was factual copying, but rather whether that copying rose above a de minimis level. Courts generally reject the claim that the use of a copyright in



another image, without more, is anything more than de minimis.

According to the amended complaint, the photograph was on display only at one exhibition at the gallery in 2017. Moreover, while the photograph is titled “Art We All One,” the actual graffiti appears in small print in the bottom corner of the photograph in a manner that is far less prominent than the apartment buildings that dominate the vast majority of the photograph, and even less prominent than other items in the photograph. Accordingly, the court determined that any alleged infringement concerning the use of the “Art We All One” phrase was both qualitatively and quantitatively de minimis such that it cannot support an infringement claim.

The other practical significances of this case include that the court provided the pro se plaintiff with wide latitude and essentially granted the plaintiff a “do over” in the form of leave to file an amended complaint. The court offered the pro se plaintiff in the first motion to dismiss substantive feedback on how to cure any defects and the issues to address to overcome a subsequent motion to dismiss. In addition, this case provides a clear outline of how to properly plead federal trademark infringement and likelihood of confusion at the motion to dismiss stage.

We will continue to monitor and report on developments in these areas of copyright law. In the meantime, please feel free to contact us to learn more.

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