

arts

# LAW MEMO

## Who owns the skyline?

In September, a federal judge in Cleveland ended a three-and-a-half-year legal battle when she ruled that a local photographer could sell his poster of the Rock & Roll Hall of Fame without violating any trademark laws.

The case, *The Rock & Roll Hall of Fame v. Gentile Productions*, was the first to consider whether the owner of a trademark in a building design can prevent others from marketing an image of the building.

It was closely watched by intellectual property scholars, state legislators, First Amendment advocates, museum administrators, souvenir manufacturers, and free lance photographers. This issue of *Arts Law Memo* summarizes the legal issues raised by this interesting dispute.

### DAVID & GOLIATH

Who owns the commercial rights to images of distinctive buildings? The Rock & Roll Hall of Fame claimed it had the right to protect its image and its trademark from being exploited. Photographer Chuck Gentile (pronounced gin-TILLY) said he was fighting for the right to take a picture of a public landmark without getting permission or paying royalties and for his ability to make a viable livelihood.

His lawyer, J. Michael Murray, was more caustic. "It's ironic that an institution that is supposed to be dedicated to freedom of artistic expression, the rock industry, tried to trample a young artist," he said.

The concept for a museum dedicated to rock and roll's heritage was initiated in 1983, when a group of influential figures in the music industry created the Rock & Roll Hall of Fame Foundation.

The foundation conducted a nationwide search for an appropriate location, and in 1986, Cleveland was selected as the home of the Rock & Roll Hall of Fame and Museum, the world's first museum dedicated to the living

heritage of rock and roll music.

Why Cleveland? The answer is part historical, part civic boosterism. It was DJ Alan Freed who popularized the term rock and roll on his Cleveland-based radio show during the 1950s. In the 1980s, long before the term "cultural tourism" was popularized, the Greater Cleveland Growth Association organized a petition drive and offered an attractive incentive package.

Although the \$92 million project was billed as a public-private partnership, it was largely financed with local and state government funds.

Located on the shore of Lake Erie in downtown Cleveland's North Coast Harbor, the 150,000 square-foot facility opened in 1995. The striking building was designed by internationally-renowned architect I.M. Pei, who also designed the National Gallery of Art's East Building in Washington, D.C., the John F. Kennedy Library in Boston, and the expansion of the Louvre.

Pei's design is a composition of bold geometric forms and dramatic cantilevered spaces that are anchored on a 162-foot tower. The tower supports a dual-triangular-shaped glass "tent" that extends at its base onto a 65,000 square-foot plaza.

The building houses more than 55,000 square-feet of exhibition areas, as well as administrative offices, a gift shop, and a café.

Tension and turmoil have marked the history of the fledgling nonprofit museum. There are two (often feuding) boards, the New York-based foundation, which represents the interests of the music industry and still oversees the induction process, and the Cleveland board, which governs museum operations.

Dennis Barrie, the former director of the Contemporary Arts Center in Cincinnati, which mounted the controversial Mapplethorpe exhibit,

Published by the St. Louis Volunteer Lawyers and Accountants for the Arts (VLAA), *Arts Law Memo* is mailed, free of charge, to more than 650 Missouri and Southwestern Illinois arts organizations, VLAA volunteers, and corporate sponsors.

VLAA helps artists and arts organizations solve and avoid legal and accounting problems by:

- Making referrals to lawyers and accountants;
- Mediating arts-related disputes;
- Publishing *Arts Law Memo* and concise how-to guides;
- Sponsoring seminars and public forums;
- Arranging for guest speakers;
- Maintaining a reference library;
- Operating an arts space clearinghouse;
- Supplying model contracts and other arts law and business materials;
- Facilitating meetings;
- Conducting and disseminating research on issues affecting the arts;
- Contributing articles to publications;
- Collaborating on arts advocacy initiatives;
- Matching volunteers with arts organizations seeking board members; and
- Providing access to the national VLA network.



This issue was written by Sue Greenberg, VLAA's executive director.

*This publication is distributed with the understanding that VLAA is not engaged in rendering legal or accounting counsel. We urge you to seek professional services to address your specific needs.*

### St. Louis Volunteer Lawyers and Accountants for the Arts

3540 Washington  
St. Louis, MO 63103  
314/652-2410  
vlaa@stlrac.org  
www.vlaa.org

served as the new museum's director from 1993 to 1996. He was apparently forced out by a disgruntled New York board member. Since his departure, there have been three directors in four years.

Most recently — just before Christmas — Terry Stewart, the museum's executive director, dismissed its senior director of public relations and marketing. Public relations will be handled by a combination of national and local outside companies.

First year attendance at the Rock Hall (as it is known locally) — 800,000 — surpassed projections, but it dropped 40 percent between 1996 and 1997. According to the institution's annual report, it lost \$1.37 million in 1997.

The hefty admission charge (\$14.95 for adults) and other earned revenue are helping the museum stay afloat. But the museum has a very small acquisitions budget and, while it is the city's dominant tourist attraction, observers say Goliath's long term viability may be in question.

Enter David. In 1995, Chuck Gentile took a series of pictures of the Rock Hall from a public sidewalk. He then produced a four-color poster showing the building back-lit by the violet-and-burnt orange postcard-perfect glow of the sunset over Lake Erie.

The caption under the photo read "Rock 'N Roll Hall of Fame" and below that, "Cleveland." His signature also appeared on the poster, which sold for \$40 to \$50.

Gentile, 41, is a Cleveland native who went into business for himself in 1991 specializing in commercial advertising and photographs of buildings. His poster portfolio includes most of the city's landmarks.

Because Gentile did not have a licensing agreement with the Rock Hall, the museum filed an injunction to stop him from selling the posters.

#### **A TRADEMARK CASE**

Although Gentile's lawyer, J. Michael Murray, said the initial ruling "struck a great blow for freedom of expression," it was not heard as a First Amendment case. Under the rules by

which courts deal with legal issues, Constitutional questions are not considered if the case can be disposed of on other grounds.

Still, the case did serve as a reminder that intellectual property rights often conflict with free speech, pitting the rights of an artist to create against a company's right to exclusive control over its valuable trademark.

How about copyright? The Rock Hall case was not about copyright infringement, although Gentile's supporters pointed to copyright laws as an appropriate line of defense.

As of 1990, an original design of a building embodied in any tangible medium of expression, including a building, architectural plans, or drawings, is subject to copyright protection as an "architectural work."

The "work" includes the overall form as well as the arrangement and composition of spaces and elements in the design but does not include individual standard features such as windows or doors or design elements that are functionally required.

However, noting that "architecture is a public art form and is enjoyed as such" Congress provided an important exception: The copyright in an architectural work 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 is ordinarily visible from a public place.

Yet another area of law was mentioned in connection with the case. Some contend that the right of publicity — the right of celebrities to control the commercial exploitation of their identities — should also apply to famous landmarks. Currently, this right protects living people, not buildings, animals or other property.

So, the Rock Hall sought protection under trademark law, claiming that Gentile's poster was causing confusion in the marketplace.

Trademarks are distinctive words, symbols, designs or combination words and design, slogans, unique packaging, building designs, or even distinctive sounds or colors.

The owner of the trademark has the exclusive right to use it on the product it was intended to identify and often on related products.

Some examples of trademarks are the Olympic rings, NBC's "three chimes," or Hallmark's "when you care enough to send the best."

Unlike patent protection, which requires registration, or copyright, which protects original works as soon as they are fixed in a tangible medium of expression, trademark protection arises through use. Generally, the first party to use a mark has the exclusive right to use it in the specific geographic area of that first use.

Approximately 100 American

buildings, including the Chrysler Building, the facade of the NY Stock Exchange, the marble lions in front of the New York Public Library, the Citicorp Center in Manhattan and the Transamerica Tower in San Francisco are registered trademarks.

However, trademarked architecture is most commonly associated with franchised fast-food restaurants. For example, McDonald's can prevent another hamburger chain from conducting business under golden arches.

### ROUND ONE

The David and Goliath relationship of the parties was particularly evident during the first trial. The Rock Hall was represented by Jones, Day, Reavis & Pogue, one of the nation's largest law firms, while Gentile appeared *pro se* (without a lawyer) at the preliminary injunction hearing.

The museum argued that Gentile was making money from the image and the trademark, while hurting sales of what it considered its own authorized pictures and drawings.

The museum also said it has licensing agreements with other photographers, T-shirt and plastic snow dome manufacturers, and the money made from those products is used to help pay back the taxpayer guaranteed bonds that were issued to raise construction funds.

Gentile asserted that he did not need permission to sell the posters because the Rock Hall is in a public space.

In 1996, U.S. District Judge George W. White, finding a "likelihood of confusion" that would cause damage to the museum's licensing program and revenues, granted a preliminary injunction ordering the photographer to turn over his unlicensed posters.

On hearing the court's decision, Gentile told the *New York Times*, "I think Jerry Garcia would be rolling over in his grave."

### ROUND TWO

With the assistance of the American Society of Media Photographers (ASMP), a trade association with about 5,000 professional members, Gentile appealed. The case was heard in mid-

1997.

Gentile argued that the district court abused its discretion. Specifically, he said that his photograph was not a trademark use of the Rock Hall's building design and that the caption on the poster was simply a description, also a non-trademark use.

In the Rock Hall's opinion, making the poster was like going into a store, purchasing a bottle of Coke, taking a picture of it, and putting the word Coke underneath.

The Sixth Circuit reversed the District Court in 1998 with a strongly worded opinion in Gentile's favor.

"When we view the photograph in the poster, we do not readily recognize the design of the museum's building as an indicator of source of sponsorship," Judge James L. Ryan said in the court's ruling. "What we see, rather, is a photograph of an accessible, well-known, public landmark.

"Stated somewhat differently, in Gentile's poster, the Museum's building strikes us not as a separate and distinct mark on the good, but, rather, as the good itself. Thus, the photograph in Gentile's poster does not function as a trademark."

In his dissent, Chief Judge Boyce F. Martin, Jr. said he believed that the museum had a valid trademark in the building. He noted that the museum had used several "versions of the building shape" on T-shirts and other products as early as 1993, when the building was not yet a public landmark.

The judge also said that it should not matter from what angle the building was depicted.

### ROUND THREE

The museum appealed. In September, the U.S. District Court for the Northern District of Ohio presumably ended Gentile's battle when Judge Patricia Gaughan ruled in favor of his motion for a summary judgement, essentially dismissing the case. Point by point, referring back to the Sixth Circuit's ruling, she rejected all of the Rock Hall's arguments.

The judge said that the only new argument presented by the museum related to a survey conducted by a

marketing firm. Based on the results of the survey, the museum asserted that the public recognizes the building as being an identifier of the museum's goods and services.

"Assuming the survey is offered to establish plaintiffs have a protectable trademark," Judge Gaughan said, "it only shows that overwhelmingly, respondents recognized the building as a landmark and not as a protected trademark or as source-distinguishing."

### LESSONS LEARNED

What lessons can be learned from this case?

"Although we don't have a blanket ruling that photographs of buildings can never violate the building-owner's trademarks," said ASMP general counsel Victor Perlman, "we have strong indication that building-owners will have a tough time persuading the courts that their trademarks have been infringed, at least by photographic posters of their buildings."

For arts administrators, who are charged with the responsibility of maintaining their institution's identity and investing considerable resources in developing merchandise, the case provides an important message: trademarks are important assets that are frequently misunderstood.

In this case, the various images of the building by the Rock Hall worked against trademark protection. Several items sold by the museum displayed the rear of the building, which looks dramatically different than the front. And while the photo used in the museum's poster was also available in postcard form, so were postcards depicting close-up views of the building.

According to the court, these differing uses of the building's image prevented the creation of a distinct commercial impression. The court added that "consistent and repetitive use...is the hallmark of trademark."

To avoid trademark problems and strengthen their position should a dispute arise, arts administrators should seek advice from an experienced intellectual property attorney. For a referral, call VLAA, 314/652-2410.

Publication of *Arts Law Memo* is made possible by grants from the Regional Arts Commission; the Illinois Arts Council, a state agency; and the Missouri Arts Council, a state agency.



3540 WASHINGTON  
ST. LOUIS, MO 63103

NONPROFIT ORG.  
U.S. POSTAGE  
PAID  
ST. LOUIS, MO  
PERMIT NO. 3363



## Additional Resources

### IN THE NEWS

Last year, Congress passed the Anti-Cybersquatting Consumer Protection Act. It was designed to protect consumers and promote electronic commerce by cracking down on those who, in bad faith, register popular trademark names and attempt to sell them for outrageous fees to companies whose trademarked name or service were “distinctive” when the domain name was registered.

### ON THE WEB

How do trademarks differ from patents and copyrights? For a concise, easy-to-understand answer, consult the legal encyclopedia on the Nolo Press website ([nolo.com](http://nolo.com)). The U.S. Patent and Trademark Office website ([uspto.gov/](http://uspto.gov/)) contains more in-depth information.

### BOOKS

Borchard, William M. *Trademarks & the Arts*. This informative book was written for composers, visual artists, writers, and performers. The new edition contains chapters on the Internet and moral rights.

Shapiro, Michael S. and Brett I. Miller. *A Museum Guide to Copyright and Trademark*. Published by the American Association of Museums, this new guide is designed to help museums develop a clearer understanding of the importance of intellectual property. Excerpts from the book are posted on the association’s website ([aam-us.org](http://aam-us.org)).

### VLAA LIBRARY

Many books on arts law and business practices are available at the **St. Louis Volunteer Lawyers and Accountants for the Arts library** located within the Regional Arts Commission office, 3540 Washington, in Grand Center. The expansion of VLAA's library (which now includes the **Foundation Center’s database on CD ROM**) and promotion of its use is made possible by a generous grant from the Gateway Foundation.