

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN

QUINCY M. NERI,

Plaintiff,

v.

SENTINEL INSURANCE COMPANY LTD and
ERIC FERGUSON dba White School Studios,

Defendants.

OPINION AND ORDER

13-cv-382-bbc

Plaintiff Quincy M. Neri has brought this proposed action for damages against defendants Eric Ferguson and his insurer for Ferguson's alleged violation of her copyright and trademark rights in a sculpture that plaintiff created and called Mendota Reflection. Judgment was entered in this case on August 2, 2013, denying plaintiff leave to proceed and dismissing this case under the theory of claim preclusion. I determined that plaintiff was precluded from proceeding by a final judgment entered in Neri v. Monroe, 11-cv-429-slc, in which this court entered summary judgment for defendants, after finding that plaintiff did not have a valid copyright in the same sculpture that was at issue in that case as well as in the present case. Order, dkt. #152, 11-cv-429-slc.

However, on August 12, 2013, the court of appeals issued a decision vacating the judgment in case no. 11-cv-429-slc and remanding the case to Magistrate Judge Stephen Crocker for further proceedings. Order, Neri v. Monroe, No. 12-3204 (7th Cir. Aug. 12,

2013). Because the judgment in the present case depended on the judgment dismissing case no. 11-cv-429-slc, the court of appeals vacated the judgment in this case and remanded for further proceedings. Order, Neri v. Sentinel Insurance Company Limited, No. 13-2825 (7th Cir. Dec. 3, 2013). This means that this case is starting over from scratch.

As stated above, I dismissed this case initially on claim preclusion grounds because judgment had been entered against plaintiff in case no. 11-cv-429-slc. That case remains pending; it is in the summary judgment stage of the proceedings. It is virtually certain that judgment will be entered in that case before this one, and it is likely that the resolution of the claims in that case will have a preclusive impact on at least some of the claims in this lawsuit. Nonetheless, I will proceed to screen plaintiff's claims, and the parties can address the effect of the judgment in the other case at a later date.

Plaintiff seeks leave to proceed in forma pauperis with her claims, and the court has already concluded that plaintiff may proceed without prepayment of the \$350 filing fee. In screening plaintiff's complaint, I must dismiss any portion that is legally frivolous, malicious, fails to state a claim upon which relief may be granted or asks for money damages from a defendant who by law cannot be sued for money damages. 28 U.S.C. § 1915.

The court must read the allegations of the complaint generously. McGowan v. Hulick, 612 F.3d 636, 640 (7th Cir. 2010). I construe plaintiff's complaint as containing federal copyright infringement claims as well as trademark infringement claims under the federal Lanham Act and both Wisconsin common and statutory law, and I will allow her to proceed on these claims. Also, I understand her to be attempting to bring a claim regarding

the “distortion” of her artwork in defendant’s photographs, but I will not allow her to proceed on such a claim or any other arising out of the alleged distortion of her artwork.

I draw the following facts from plaintiff’s complaint.

ALLEGATIONS OF FACT

Plaintiff Quincy Neri is an artist who lives in Madison, Wisconsin. In April 2009, she finished a glass sculpture and ceiling design project in a local home. The project is titled “Mendota Reflection,” and plaintiff has registered a copyright for the artwork.

In April 2011, plaintiff discovered that pictures of Mendota Reflection were featured on the website for a company named Architectural Building Arts. Plaintiff did not give permission for these pictures to appear on the website. Defendant Eric Ferguson, who does business as White School Studios, was listed on the website as an author (I understand Ferguson to be a photographer who took pictures of the artwork). Plaintiff states that Ferguson gave usage rights for his photographs to Architectural Building Arts to place them on its website. Also, Ferguson signed a release allowing his photographs of the artwork to be used by the National Association of the Remodeling Industry and its sponsors in publications and on the internet, without first receiving permission from plaintiff.

Plaintiff believes that her “artwork design is distinctive in that it is unusual in shape, design and color that sets it apart from the others.” In at least some of the photographs, Ferguson altered the pictures, resulting in “an untrue and distorted representation of the artwork.”

Defendant Sentinel Insurance Company Limited was defendant Ferguson's professional liability insurer for at least a portion of the time Ferguson violated plaintiff's copyright.

OPINION

A. Copyright

Under 17 U.S.C. § 102(a)(5), sculptural works may be entitled to copyright protection. A plaintiff alleging copyright infringement must establish two elements: "(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original." Feist Publications Inc. v. Rural Telephone Service Co., 499 U.S. 340, 361 (1991). Material may be protected by copyright if it is an "original wor[k] of authorship fixed in any tangible medium of expression." 17 U.S.C. § 102(a). "Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity." Feist Publications, Inc., 499 U.S. at 345. Those who do the copying may be held liable as well as those who contribute to infringement. Metro-Goldwyn-Mayer Studios Inc. v. Gorkster, Ltd., 545 U.S. 913, 930 (2005) ("One infringes contributorily by intentionally inducing or encouraging direct infringement, and infringes vicariously by profiting from direct infringement while declining to exercise a right to stop or limit it.").

In this case, plaintiff alleges that she owns a copyright in an original glass sculpture and ceiling design and that defendant Ferguson took photographs of the artwork and then

allowed third parties to display the artwork on their websites without her permission. These allegations are sufficient to state a claim upon which relief may be granted. Although the “copies” at issue are photographs rather than glass sculptures, the Court of Appeals for the Seventh Circuit has held that a plaintiff may prove infringement even if the “work is transferred into a different medium.” Atari, Inc. v. North American Philips Consumer Electronics Corp., 672 F.2d 607, 618 (7th Cir. 1982). “[C]ourts are split on whether photographs of a copyrighted work are properly considered derivative works,” FragranceNet.com, Inc. v. FragranceX.com, Inc., 679 F. Supp. 2d 312, 322 (E.D.N.Y. 2010), but the Court of Appeals for the Seventh Circuit has assumed in at least one case that they are. Ty, Inc. v. Publications Intern. Ltd., 292 F.3d 512, 518-19 (7th Cir. 2002). It is premature at this stage to consider whether defendants may have a valid defense, such as fair use, 17 U.S.C. § 107 or whether plaintiff is not entitled to copyright protection because the sculpture is a “work made for hire,” 17 U.S.C. § 101.

B. Trademark

I understand plaintiff to be attempting to bring trademark infringement claims under the federal Lanham Act and both Wisconsin common and statutory law.

1. Federal Lanham Act

First, as to a federal claim, section 43(a) of the Lanham Act creates a federal civil remedy against any person who uses in commerce “any word, term, name, symbol, or device”

or "any false designation of origin" if it "is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person." 15 U.S.C. § 1125(a)(1). Because "the purpose of a trademark, whether federally registered or unregistered, is to designate the origin of goods, the infringement of such a trademark is actionable under section 43(a)." TMT North America, Inc. v. Magic Touch GmbH, 124 F.3d 876, 881 (7th Cir. 1997) (quoting W.T. Rogers Co. v. Keene, 778 F.2d 334, 337 (7th Cir. 1985)).

Plaintiff is somewhat unclear on the scope of her trademark claim, but I do not understand her to be bringing a claim regarding the name "Mendota Reflection" because she does not allege that any of the defendants have been using that name or that the public associates the phrase with her. Rather, I understand her to be asserting a "trade dress" claim because she states that her "artwork design is distinctive in that it is unusual in shape, design and color that sets it apart from the others."

This type of trademark consists of all the various elements used to promote or identify the service or product. Publications International, LTD. v. Landoll, Inc., 164 F.3d 337, 338 (7th Cir. 1998). See also Incredible Technologies, Inc. v. Virtual Technologies, Inc., 400 F.3d 1007, 1015 (7th Cir. 2005) ("The term trade dress refers to the "appearance of a product when that appearance is used to identify the producer."). Trade dress serves the same function as a trademark and the law treats it the same way. Publications International, LTD., 164 F.3d at 338.

In order to succeed in an action for trade dress infringement, plaintiff must show that (1) her trade dress is distinctive and (2) consumers are likely to be confused as to the source or affiliation of a product or service because of defendant's use. Even giving credence at this point in the proceedings to plaintiff's statement that her artwork is distinctive, it may be a tall order to *prove* consumer confusion over defendant's use of pictures of her artwork, but I see no reason to deny her leave to proceed on a Lanham Act trade dress claim at this point. "Ultimately, all those who knowingly play a significant role in furthering trade dress infringement are liable as contributing parties." R.F.M.A.S., Inc. v. Mimi So, 619 F. Supp. 2d 39, 84 (S.D.N.Y. 2009) (citing 4 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 25:19 (4th ed. 2009) ("Everyone who knowingly participates in the preparation, distribution and sale of infringing goods or services is potentially liable as a contributory infringer.")). Because plaintiff alleges that defendant allowed third parties to display her artwork in ways that arguably could cause confusion over its source, I will allow her to proceed on a federal trade dress claim.

2. Wisconsin common law

Wisconsin recognizes a cause of action at common law for infringement of a trademark or trade name. Madison Reprographics, Inc. v. Cook's Reprographics, Inc., 203 Wis. 2d 226, 233-34, 552 N.W.2d 440, 444-45 (Wis. Ct. App. 1996); First Wisconsin National Bank v. Wichman, 85 Wis. 2d 54, 63, 270 N.W.2d 168, 172-73 (1978). In order to prevail on this claim, plaintiff must show that her artwork is distinctive of her goods or

services and that defendant's use is likely to cause confusion. Madison Reprographics, 203 Wis. 2d at 234; Restatement (Third) of Unfair Competition §§ 9, 20 (1995). This standard is very similar to that under the Lanham Act, so I will allow plaintiff to proceed on a Wisconsin common law claim as well.

3. Wis. Stat. § 132.033

Another cause of action for trademark infringement exists under Wisconsin law. Wis. Stat. § 132.033, provides a cause of action to “[e]very person, association or union adopting or using a [registered] mark” against a party who uses or displays a “counterfeit mark identical or substantially identical” to the registered mark. Wis. Stat. § 132.033(1); see also Wis. Stat. § 132.001(2) (defining “mark” to require that it be registered). Plaintiff states that she registered a state of Wisconsin trademark regarding the artwork in 2011. It is unclear whether plaintiff has a registered mark in the name “Mendota Reflection” or the trade dress itself, but construing plaintiffs’ allegations generously, I can infer that plaintiff has a registered mark in the trade dress. Because plaintiff alleges that defendant allowed the use of plaintiff’s mark in ways that arguably infringed her trademark, I will allow her to proceed on a claim under § 132.033.

C. Distortion of Images

Plaintiff alleges that defendant altered at least some of the photographs of the artwork, resulting in “an untrue and distorted representation of the artwork.” It is unclear

why plaintiff chose to include this allegation, and I am unaware of any causes of action that plaintiff would have for making a distorted copy of her intellectual property beyond the claims on which she is already proceeding.

For example, under amendments to the Copyright Act made by the Visual Artists Rights Act of 1990, creators of certain types of visual art, such as sculptures, may “prevent any intentional distortion, mutilation, or other modification of that work which would be prejudicial to his or her honor or reputation.” 17 U.S.C. § 106A(a)(3)(A). However, I cannot locate any authority suggesting that “mutilations” or “distortions” covered by this provision applies to anything other than the *artwork itself* rather than to a photograph of the artwork. That is, plaintiff might have been able to bring a claim under this provision if she has alleged that defendant physically removed or destroyed portions of the artwork, rather than just taking pictures of it that she believes distorts the true character of the piece. She did not make these allegations so I will not allow her to proceed on any claims regarding these allegations.

ORDER

IT IS ORDERED that

1. Plaintiff Quincy Neri is GRANTED leave to proceed on the following claims against defendant Eric Ferguson

- a. a copyright infringement claim under federal law;
- b. trademark infringement claims under the Lanham Act, Wisconsin common

law and Wis. Stat. § 132.033.

2. Plaintiff is DENIED leave to proceed on claims that defendant distorted her artwork.

3. For the remainder of this lawsuit, plaintiff must send defendants a copy of every paper or document that she files with the court. Once plaintiff learns the name of the lawyer that will be representing defendants, she should serve the lawyer directly rather than defendants. The court will disregard documents plaintiff submits that do not show on the court's copy that she has sent a copy to defendants or to defendants' attorney.

4. Plaintiff should keep a copy of all documents for her own files. If she is unable to use a photocopy machine, she may send out identical handwritten or typed copies of her documents.

5. I am sending copies of plaintiff's complaint and this order to the United States Marshal for service on defendants.

Entered this 27th day of January, 2014.

BY THE COURT:
/s/
BARBARA B. CRABB
District Judge