

IP Suit Over Katy Perry Dress Faces Big Hurdles

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The dress that Katy Perry wore to the Metropolitan Museum of Art's annual Costume Institute Gala in May seems to have sparked more than run-of-the-mill prognostications about whether the pop star deserved to be on a "best" or "worst" dressed list. Moschino SpA, the Italian fashion house that supplied the dress, as well as its designer Jeremy Scott, now face allegations under federal copyright and trademark law and related claims in an action filed in the Central District of California on Aug. 5, 2015. The plaintiff, Brooklyn-based artist Joseph Tierney (a.k.a. "Rime"), alleges that the dress and other pieces in Scott's fall/winter 2015 collection, copied his 2012 mural "Vandal Eyes" without his knowledge or consent. The mural, painted in graffiti style, is located on the broad side of a building in Detroit.

The complaint presents a photograph of "Vandal Eyes" juxtaposed with images of Katy Perry and supermodel Gigi Hadid wearing the dress, as well as a shot of Jeremy Scott sporting a matching jacket on the Met Gala red carpet. Tierney accuses Moschino and Scott of literal misappropriation of his work, including his distinctive signature "Rime," in connection with the Moschino collection. Tierney further alleges that defendants defaced his work by superimposing the Moschino and Jeremy Scott brand names on his design in spray-paint style. In addition, Tierney claims that his "street cred" and reputation as a graffiti artist have been compromised by his apparent association with the fashion giant, whose reputation for luxury and glamour renders it "antithetical to the outsider 'street cred' that is essential to graffiti artists."

Tierney alleges that Perry and Scott's publicity stunt at the Met Gala, replete with a spray-painted Rolls Royce and Moschino branded cans of fake spray paint, resulted in increased profits and enhanced the value to the Moschino and Jeremy Scott brands. As a remedy, the suit seeks all lost proceeds Tierney purportedly suffered as a result of the alleged infringement, as well as the increased profits that Moschino purportedly earned from capitalizing on Tierney's work. The suit also asks the court to recall and destroy the infringing apparel.

Although the lawsuit has already garnered significant media coverage, it is important to note that Tierney faces some significant substantive challenges from a legal perspective. It remains to be seen whether this action can survive these challenges or whether Moschino and Scott will succeed on a motion to dismiss.



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Jurisdiction

As an initial matter, it is unclear whether the U.S. District Court for the Central District of California is the appropriate court to exercise personal jurisdiction over the controversy. Tierney alleges that defendants are subject to personal jurisdiction in the Central District because they “reside or transact business in, have agents in, or are otherwise found in and have purposely availed themselves of the privilege of doing business in California and in this District.” But the complaint is sparse on the specifics — alleging only that Moschino operates a store in Beverly Hills and that Scott maintains an office in Los Angeles. To be sure, these minimal contacts in California are insufficient to render defendants subject to general jurisdiction under *Daimler AG v. Bauman*, 134 S. Ct. 746 (2014). Tierney does not spell out his theory for specific jurisdiction, which requires that the claim arise from defendants’ activities related to the forum.

Copyright

The decision to bring suit in federal court in California may have been a strategic call on the part of the plaintiff, because Tierney alleges that he is located in New York (where the Met Gala took place), and that his “Vandal Eyes” painting is located in Detroit. Tierney’s lawyers may have been looking to secure access to favorable precedents in California.

- For example, in his complaint, Tierney does not claim to have received a copyright registration for his “Vandal Eyes” painting. Rather, Tierney conspicuously alleges that he has merely applied to register the work. But there is presently a circuit split regarding the question whether an application for registration — rather than registration itself — is sufficient to satisfy the requirement under 17 U.S.C. § 411(a) that a work be registered for a copyright infringement claim to proceed. Filing suit in California enables Tierney to take advantage of the fact that the Ninth Circuit Court of Appeals decided in *Cosmetic Ideas Inc. v. IAC/InterActiveCorp.*, 606 F.3d 612 (9th Cir. 2010) that an application to register is enough. In New York, in contrast, it remains unclear whether an application is enough.
- Tierney also alleges that his “Vandal Eyes” graffiti painting contained copyright management information protected under 17 U.S.C. § 1202(b) and that the defendants intentionally removed and/or altered that information. But courts have also differed in applying the appropriate definition of “copyright management information” under § 1202(c), which was enacted as a part of the Digital Millennium Copyright Act aimed at creating protections specific to digital media. Although the mural in question would fall outside the scope of a narrow definition of the term, recent cases in the Central District of California have tended towards a broad interpretation of “copyright management information.” Notably, in *Williams v. Cavalli* (C.D. Cal. Feb. 12, 2015), a group of graffiti artists survived a motion to dismiss on a § 1202 claim against renowned designer Roberto Cavalli for removing and altering their signatures in reproduced images of a mural they had painted. This specific issue has not been addressed by the Ninth Circuit, however, and thus Tierney’s claim could go either way.

Trademark

To prevail on his trademark infringement claim, Tierney must show (1) that his “Rime” mark is valid and entitled to protection; and (2) that Moschino and Scott’s unauthorized use of the mark is likely to cause confusion with respect to the source of their goods, or deception as to affiliation, connection, or

sponsorship of their goods. On July 28, 2015, Tierney filed an application to register his “Rime” mark for footwear, headwear and T-shirts. But a registration is not required to assert a trademark claim if Tierney can establish that, as he alleges, his signature has “secondary meaning” — meaning that the consuming public uses it to identify a particular source of goods or services. Even assuming Tierney meets this burden, it is an open factual question whether defendants’ use of the “Rime” mark is likely to cause confusion among consumers. It is possible that a court will find that consumers are more likely to perceive the pieces as influenced by graffiti style generally than as a work offered, approved, or sponsored specifically by Tierney.

Right of Publicity

Tierney also alleges that Moschino has infringed his “right of publicity” under California Civil Code § 3344, which prevents the commercial use of a celebrity’s “name, voice, signature, photograph or likeness, in any manner” without permission or compensation. Section 3344 has been construed quite broadly in determining what constitutes a right of publicity violation, as evidenced by Bette Midler’s claim over the use of an impersonation of her vocal style in *Midler v. Ford Motor Co.*, 849 F. 2d 460 (9th Cir. 1988). Even if Tierney can establish that Moschino violated his right of publicity, he will still need to establish its value in order to prove his damages.

Negligence

Tierney’s complaint also includes a vague negligence claim, but it is unclear from the face of the complaint what duty of care Moschino and Scott could possibly have owed to Tierney in order to give rise to a colorable claim that Moschino and Scott were “negligent” in observing that duty to Tierney.

Other Issues

Tierney’s suit also poses other interesting legal questions.

- **Admissibility of Evidence:** As support for his claim that his reputation has suffered a blow due to his perceived association with Scott, Tierney points to previous accusations against Scott that he copied designs by other artists. The complaint suggests that, as a result of Scott’s sullied reputation in the art community, any perceived association between Scott and Tierney is damaging to Tierney’s reputation and career. While this evidence might be admissible to establish a pattern of behavior under Federal Rule of Evidence 404(b), it might also be inadmissible under Federal Rule of Evidence 403, which can be used to exclude evidence of prior misconduct if it poses a danger of unfair prejudice.
- **Damages:** Tierney’s complaint alleges that Moschino’s 16 percent revenue growth in the first quarter of 2015, as reported by the Wall Street Journal, was the product of Moschino’s debut of the fall/winter 2015 line featuring his work. Undoubtedly, the February 2015 Moschino runway show, and the theatrics by Perry and Scott at the Met Gala in May 2015 generated a lot of buzz — but to attribute all of the company’s subsequent increases in revenue to the allegedly infringing designs is a bold claim that may be difficult to prove.

Although not the first infringement action of its kind, Tierney’s lawsuit presents unique factual and legal questions that have already drawn the attention of fashionistas and lawyers alike. It will be interesting to see whether Tierney’s suit survives in federal court or whether it settles quickly, as these cases often

do. If it proceeds, it could provide useful guidance on several of the open issues discussed above.

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