1-1-2008

Can Intellectual Property Laws Stem the Rising Tide of Art Forgeries

Joseph C. Gioconda

Follow this and additional works at: https://repository.uchastings.edu/hastings_comm_ent_law_journal

Part of the Communications Law Commons, Entertainment, Arts, and Sports Law Commons, and the Intellectual Property Law Commons

Recommended Citation

This Article is brought to you for free and open access by the Law Journals at UC Hastings Scholarship Repository. It has been accepted for inclusion in Hastings Communications and Entertainment Law Journal by an authorized editor of UC Hastings Scholarship Repository. For more information, please contact wangangela@uchastings.edu.
Can Intellectual Property Laws Stem the Rising Tide of Art Forgeries?

by

JOSEPH C. GIOCONDA∗

I. Introduction

As in every art collectors' dream, an unknown painting by a famous artist suddenly appeared on eBay. A seemingly uninformed
rube who sold under the name “golfpoorly,” listed what appeared to be a previously unknown painting by Richard Diebenkorn for a mere twenty-five cents. The seller had claimed he found the painting at a garage sale, and naively mentioned that the slightly damaged canvas—caused by his son’s plastic tricycle—could be easily repaired with duct tape. Diebenkorn’s handwritten initials and the year 1952 appeared in the corner of the painting. Bidding commenced and capped at $135,805.00, the amount offered by a buyer in the Netherlands.

The oddity of a rare, valuable and previously unknown painting appearing on eBay in such circumstances, compounded by its high sale price, attracted the attention of suspicious bidders and, eventually, a tenacious reporter at The New York Times. The reporter discovered that the unsophisticated everyman “golfpoorly” was in fact a California attorney named Kenneth Walton. He had actually hunted down the painting with a shady business partner, not stumbled upon it at a garage sale. Walton believed the painting so strongly resembled a real Diebenkorn that he added a forged signature and year to the canvas. There was no toddler son, and no plastic tricycle, only the siren call of easy money.

A criminal probe was initiated by the Federal Bureau of Investigation and the United States Attorney’s Office. The authorities discovered that Walton was actually a skilled seller of fraudulent artwork who had sold dozens of forged paintings on eBay.

3. WALTON, supra note 3, at 116-121.
4. The painting displayed “D.B. ‘52” in the lower right hand corner, which was how Richard Diebenkorn typically signed his work to indicate he painted it in 1952. Id. at 111.
5. Id. at 124-33.
7. “Art forgery” is not a precisely defined legal term. It generally includes deliberate imitations, genuine objects altered by reworking, early copies not originally intended to deceive, pastiches, and products of students from a master’s workshop that are erroneously attributed to the master. See generally LEONARD D. DUBOFF AND SALLY HOLT CAPLAN, THE DESKBOOK OF ART LAW K-6 to K-13 (Oceana Publ’g 1999). For purposes of discussion in this article, art forgery will not only be limited to intentional acts
Some of these paintings eventually sold for tens of thousands of dollars. He had constructed a vast sea of "shill bidders"—false identities on eBay, which he used to bid on his own auctions to artificially raise prices. Walton openly admits: "I tricked people out of sizable sums of money in exchange for worthless works of art." He admits he worked with shady business partners and often preyed on unsophisticated purchasers, such as the stay-at-home mother of two who sobbed after the attorney sold her a $2,300 fake Gaugin.

Despite his yearlong, elaborate conspiracy and the damage done to eBay's (and the Bar's) credibility, at his sentencing for a federal felony charge for wire fraud, Walton received a plea deal so lenient, even the judge was "uncomfortable" with its clemency and found it "troubling," but then nonetheless handed it down in less than five minutes. Walton received nine months probation and paid restitution for a few of his fraudulent transactions.

Due in part to the rarity of prosecutions, as well as the lack of severity of sentencing, there is a general sense in the art community and among law enforcement that the current legal regime is not meaningfully combating the rising tide of art forgeries. In contrast, intellectual property laws have been strengthened and effectively utilized to attack the similar epidemic of counterfeit consumer products, DVD's and luxury goods. However, these laws are underutilized in the context of forged art.

The question naturally arises: Are existing intellectual property laws helpful in combating the skyrocketing and insidious threat of art forgeries?
This article will begin by discussing the growth and nature of art forgery. It will then survey the current laws applicable to the sale of forged art. It will also discuss how existing intellectual property laws may intersect with the issue. Ultimately, it will conclude that the existing intellectual property framework, while most certainly inadequate to eliminate the threat, provides some potentially useful and underutilized legal tools to combat the rising tide of forged art.

II. The Explosive Growth of the International Art Market

The commercial art world was once quaint and elite. Wealthy collectors traveled to attend exclusive auctions at Christie’s or Sotheby’s in New York or London, and bid on a few rare books or paintings. Forgeries always presented a risk to buyers, but that fear was typically quelled by “provenance,” detailed, researched proof of the chain of ownership of the artwork. Nonetheless, the threat of forgeries persisted. The prevalence of the hazard has waxed and waned, typically presenting a greater menace to commerce when the art market became infused with streams of capital invested by less sophisticated buyers with a newfound interest in art.

Today, the art market is booming, and has become an international economy in itself. Christie’s and Sotheby’s have combined sales of over $6 billion and maintain hundreds of offices worldwide. Investors from China, India, Russia and the Middle
East dramatically drive up the prices of art, purchasing it remotely or even online.\textsuperscript{21} Investment banks and pension plans invest in risky high-priced "art funds," some of which have returned extraordinary profits.\textsuperscript{22} Investment in the chancy, unregulated art economy is considered an alternative asset class,\textsuperscript{23} one which has historically yielded returns far superior to the regulated securities markets.\textsuperscript{24} Contemporary art has seen such an astonishing increase in profitability that it has led some to speculate that it may be the art world’s equivalent of the technology “bubble.”\textsuperscript{25} Even unsophisticated investors have emerged to invest staggering sums.\textsuperscript{26} And as the famous works are snatched up by billionaires and investment banks, speculators have shown no trepidation toward spending upward of $1 million on "art futures"—buying works by unknown artists with an unproven history, in the hopes of "buying the work of obscure artists before they board the fame train."\textsuperscript{27}


\textsuperscript{22} Georgina Adam et al., Art Funds Struggling, FORBES, Sept. 20, 2005 ("We have bought many million-dollar paintings and have sold some, most recently two works, which we bought privately and resold within 25 weeks, which gave us an 80% mark-up."). available at http://www.forbes.com/home/collecting/2005/09/19/abn-armo-artfunds-cx_0920hot_ls.html.


\textsuperscript{26} Carl Vogel, Mystery Bidder Spends $95 Million on a Picasso, N.Y. TIMES, May 4, 2006, §B1, Metropolitan Desk at 4.

But the volatility of this relatively unregulated global market creates the potential for massive information asymmetries, including nagging questions as to authenticity,\(^{28}\) concerns that even provenance cannot allay completely.\(^{29}\) The economic effect of having a work’s authenticity cast into doubt is devastating.\(^{30}\)

One museum in Australia discovered that the hard way. Donated by Rupert Murdoch’s father, and having hung in the Melbourne Museum for the last forty years, a painting titled “Head of a Man” stated its attribution beneath it: Vincent Van Gogh. However, experts started to become suspicious of the painting’s authenticity in part because the painting is oriented horizontally and is painted on canvas mounted on a panel—an unusual medium for Van Gogh.\(^{31}\) Fearing a momentous economic loss, the Melbourne gallery stood behind the painting’s authenticity.\(^{32}\)

After exhaustive forensic analysis, experts finally declared the painting—initially valued at over $20 million—to be a fake worth thousands of dollars at most.\(^{33}\) The painting had been misattributed to Van Gogh, and had likely been painted in the late 1880s by a talented copyist.\(^{34}\) No intentional fraud or forgery was suspected or alleged, but whether the Melbourne “Van Gogh” was an intentional forgery or an innocent misattribution is irrelevant to the Museum’s finances; its economic value had been devastated.

Economists have characterized this distinction between “genuine” and “fake” art as irrational.\(^{35}\) Rather than on aesthetics alone, economic valuation in the art world is subjective and largely


\(^{29}\) Even provenance itself has been forged. See Peter Landsman, A 20th Century Master Scam, MUSEUM SECURITY NETWORK, available at http://www.museum-security.org/myatt-drew.htm. See also Claire Babbidge, Fighting Forgery in the Art World, BBC NEWS, Nov. 23, 2006 (“Drew would forge details and slip these into documents at research libraries, and, using an old typewriter, he managed to pass off the fake as genuine...”).

\(^{30}\) See, U.S. v. Aleskerova, 300 F.3d 286, 298 (2d Cir. 2002) (upholding Metropolitan Museum of Art Curator’s testimony that Bremen drawings attributed to Dürer and Rembrandt were fakes and that their value would greatly diminish at the “slightest hint” of inauthenticity).


\(^{32}\) Id.


\(^{34}\) Id.

depends largely on the "aura" which an artwork has acquired. Regardless of its aesthetics, the perceived authenticity of the art work is at the core of the aura, giving it significant economic value during resale. Thus the difference between an art connoisseur paying $20 million for a genuine Van Gogh or a few thousand dollars if it is later deemed fake, is baffling when the exact same painting is still hanging on the wall. The art world is therefore perhaps the quintessential example of commodity fetishism in late capitalist economies.

Contributing to its irrationality and volatility, the supply and demand curve of specific artists' works is arbitrary and inconsistent over time. Furthermore, to the extent that the art economy is auction-based, value is often predicated on the economics of ego-driven—the very desire to acquire an artwork augments its sale price irrationally.

Consequently, the exaggerated economic value of authentic art in a volatile international market, along with extremely low expenses associated with counterfeiting it, makes art forgery an alluring prospect for opportunists. Because forgery siphons value by artificially increasing supply, the presence of forgeries is a drag on the art economy: Art forgers defraud consumers, threaten integrity and trust in the marketplace, increase transaction costs, and decrease the


37. It is difficult to value artwork using standard valuation methods. A common valuation method is the so-called "intuitive approach" which may rely on the "romantic appeal or "glamour" of an artwork." See Levy, supra note 19.

38. Clarke, supra note 26, at 11. Even courts have struggled with this seeming irrationality. In Balog v. Center Art Gallery-Hawaii, Inc., the district court ruled that "the ordinary purpose to which an artwork is put to be displayed is for its aesthetic appeal" and "a counterfeit will have satisfied that purpose equally with an original." 745 F. Supp. 1556, 1563 (D. Haw. 1990).


42. See, e.g., Michael Hutter, Again Fake? Three Frameworks for Models of Information Goods, and a Remark on Regulation, presented at the International Conference on The Economics of Copying and Counterfeiting, Venice (December 3-4,
value of authentic art which is in limited supply, particularly if the artist is deceased.\textsuperscript{43}

III. The Explosive Growth of Art Forgeries

While art forgeries are as old as art itself and have garnered tremendous attention as a romanticized notion,\textsuperscript{44} the exponential growth of forged art as a fundamental and viable threat to the mass art market is unprecedented.\textsuperscript{45} One Manhattan gallery owner anecdotally claims, "I am bombarded with fakes. It goes on every single day. It's like a minefield. Wherever you turn, there's a fake out there."\textsuperscript{46} The problem is international in scope, and growing: As much as half of art sold may be spurious, and the value of art forgeries traded in Britain alone each year is estimated at between $250 million and $500 million.\textsuperscript{47}

As art and antiquities of dubious authenticity proliferate on a worldwide scale and are sold over the internet to defrauded consumers, the similarity to the commercial threat posed by fake watches, handbags and counterfeit DVDs becomes apparent.

1998) (arguing that forgeries increase transaction costs because buyers face a larger uncertainty about the art objects they intend to purchase).

\textsuperscript{43} See Working the Art of Alternatives, TIMES BUS. LTD. INV. ADVISER (Oct. 3, 2005) (stating that the art market is essentially supply driven, and the market value of artwork depends on supply being limited); see also FTC v. Magui Publishers, Inc. Civ. No. 89-3818RSWL(GX), 1991 WL 90895, at *16-17 (C.D. Cal., Mar. 28, 1991)(defendant Magui published over 32,000 fake Dali prints. The Court held that Magui's fraud had misled purchasers as to the scarcity of the prints and consequently given them an incorrect impression of the prints' value); but see Bruno S. Frey, Art Fakes - What Fakes? An Economic View INSTITUTE FOR EMPIRICAL RESEARCH IN ECONOMICS UNIVERSITY OF ZURICH, Working Paper No. 14 (July 12, 1999), available at http://e-collection.ethbib.ethz.ch/ecol-pool/incoll/incoll_528.pdf (arguing that there are beneficial economic outcomes stemming from copying art).

\textsuperscript{44} SANDOR RADNÖTI, THE FAKE: FORGERY AND ITS PLACE IN ART (1999).


\textsuperscript{46} Hope, supra note 45.

Counterfeiting and piracy have exploded in recent years, increasing fivefold from 1989 to 2003.\textsuperscript{48} Counterfeit goods cost the U.S. economy between $200 billion - $250 billion per year and the world economy approximately $650 billion per year. The U.S. Chamber of Commerce has declared that “nearly every company, in every industry is vulnerable.”\textsuperscript{49} Nearly every company, in every industry is vulnerable. Counterfeiters emulate everything from brake pads to cell phone batteries to golf clubs and even prescription drugs.\textsuperscript{50} U.S. Customs seizures of counterfeit goods have increased dramatically,\textsuperscript{51} but it is impossible to know for certain how many fake goods entered the borders undetected.

Counterfeiting is further exacerbated by the fact that, in comparison with illegal activities such as drug trafficking, the market for counterfeit goods demands little investment capital, carries a low risk of prosecution, and generates extraordinary economic returns.\textsuperscript{52} In fact, counterfeiting is a multi-billion dollar industry—almost as lucrative as illegal drug smuggling and illegal arms trading markets.\textsuperscript{53}

As the international art market burgeons, so does the commercial threat presented by forged art. The art world is currently facing the rising tide of counterfeiting that has threatened the luxury goods and entertainment industries for years. Perhaps most disturbing is the link between fake art objects and organized crime,\textsuperscript{54} even including possible links to terrorism.\textsuperscript{55}


\textsuperscript{50} See generally TIM PHILIPS, \textit{KNOCKOFF: THE DEADLY TRADE IN COUNTERFEIT GOODS} (Kogan Page 2005).


\textsuperscript{52} PHILIPS, supra note 50.

\textsuperscript{53} \textit{Id.} See also Carol Noonan & Jeffery Raskin, \textit{Intellectual Property Crimes, in 38 AM. CRIM. L. REV.} 1008 (2001).

\textsuperscript{54} Maria Hegstad, \textit{Art Forgeries Used to Fund Crime Gangs, ADVERTISER (AUSTRALIA), Nov. 25, 2006, at 1; see also AUSTRALIAN, supra note 47.}

How much art is actually forged? This variable is theoretically unknowable, but as much as forty percent of what turns up for sale in galleries may be composed of some type of fake, Thomas Hoving, an art historian and former director of New York's Metropolitan Museum, has suggested. The precise number and impact is impossible to accurately measure, but as one art gallery owner explained anecdotally, the art market has become infected by forgeries: "A forgery is dead on arrival and it infects other things. You begin to look at everything with suspicion. Real stuff begins to look like them."

Historically, art forgery was perpetrated on a relatively small scale by extremely talented forgers who fooled even the world's most renowned art experts. These cases created headlines because they were so shocking. But today, high-profile, multi-million dollar forgeries, while potentially lucrative, are not as common as mass market fakes. Famous forgeries present greater risk of detection precisely because they attract attention. Sophisticated and wealthy buyers are far more likely to hire experts to scrutinize the work or even employ advanced forensic techniques to evaluate authenticity before a major purchase. Nonetheless, even experts note that the


57. Hope, supra note 45, at 2.


59. Hope, supra note 45, at 2. Advanced and elaborate forensic techniques such as carbon dating, "White Lead" testing, X-Ray diffraction and fluorescence, dendrochronology, thermoluminescence, and statistical analysis of wavelet decomposition have all been used to determine the authenticity of art. See generally Carissa Corson, The Art of Forensics, FORENSIC EXAMINER, June 22, 2006, at 64, 65. These methods take time and are cost-prohibitive for lesser-priced works. Additionally, their consistency and accuracy has been questioned. See STUART J. FLEMING, AUTHENTICITY IN ART: THE SCIENTIFIC DETECTION OF FORGERY (Crane, Russak & Co. 1976). See also ROGER MARIJNISSEN, PAINTINGS: GENUINE, FRAUD, FAKE: MODERN METHODS OF EXAMINING PAINTINGS (Elsevier 1985); WALTER MCCrone & RICHARD WEISS, FAKEBUSTERS (World Scientific Publ'g Co. 1999). Also see generally Duboff & Caplan, supra note 8 at K-16 to K-37.

60. Some con artists, however, have still managed to conduct egregious and daring scams. Ely Sakhai, a gallery owner in lower Manhattan, would acquire valuable originals, acquire forgeries of those paintings, and then sell the forgeries at auction for millions of
quality of fakes has become astounding, rendering consistent analysis difficult.\textsuperscript{61}

Fraudulent purveyors can also operate online where the anonymity of the internet and consumer pipedreams of discovering a "garage-sale treasure" operate jointly to blind mass market buyers to the risks associated with purchasing art online.\textsuperscript{62} Internet sites selling questionable artwork to the average consumer have proliferated.\textsuperscript{63} As Walton puts it, "there is someone on eBay willing to take a chance on virtually every forged painting that is offered."\textsuperscript{64} Other forgers operate in tourist destinations, scamming the unwary and unschooled consumer.\textsuperscript{65} Some forgers are brazen enough to sell millions of dollars of fake art on television.\textsuperscript{66} Additionally, the sale of fake lithographs and numbered prints has become commonplace.\textsuperscript{67}

dollars. He represented that the forged paintings were authentic, and would later sell the originals at public auction. The scheme was revealed when a Gauguin surfaced in both the Sotheby's and the Christie's catalogues for the same season. See Press Release, U.S. Dep't Just., U.S. Charges NYC Gallery Owner in Multimillion Dollar Global Scheme to Sell Real Masterworks and Forged Copies (Mar. 10, 2004), available at www.fbi.gov/dojpressrel/pressre104/art031004.htm.

61. Hope, supra note 45, at 2. For example, one art forger publicly conned a noted art expert on the Antiques Roadshow, a popular television program dedicated to evaluating art and antiques. Forger Duped TV Art Expert Out of Pounds 20,000 for Worthless Painting, DAILY MAIL (UK), Sept. 19, 2006, at 27 ("Sentencing him, recorder Terence Coghlan QC told Thwaites that his paintings were 'deeply impressive'").

62. eBay sellers such as Walton frequently engage in "shill bidding," using false identities on eBay to artificially drive up auction prices with bids, as well as engaging in fake transactions, and leaving false positive feedback for each identity. See WALTON, supra note 2, at 23, 57-60, 88-90.


64. WALTON, supra note 2, at 110.

65. See, e.g., United States v. Center Art Gallery Hawaii, Inc., 745 F. Supp. 1556, 1558-60 (D. Haw. 1990) (non-professional art collectors purchased a number of pieces that the Gallery misrepresented were either original or limited edition prints by Salvador Dali).


67. See LERNER & BRESSLER, supra note 16, at 452-53. "Prints" or "lithographs" usually refer to either limited edition reproductions of original works in another medium which are signed by the artist, or are a primary art making process in which the artist etches directly onto a plate, stone, or block. Id. Because they maintain some tie to the genuine artist, prints are generally more valuable than replicas or reproductions. When an artist signs and numbers a limited edition print, he or she represents to buyers that there are only as many copies in the marketplace as are indicated and that additional copies will never dilute the market value of the buyer's print. Forging prints is relatively easy, however, and is a prevalent practice causing many consumers to be misled. See, e.g., FTC v. Magui Publishers, Inc., Civ. No. 89-3818RSWL (GX), 1991 WL 90895, at *1 (C.D. Cal. Mar. 29, 1991) (in which a marketer of fine-art prints produced 32,000 fraudulent Dali prints).
Although profiteering from art forgery is most visible in the posh gallery and auction-house scene, mass market art fraud has a wider economic impact. Internet sites selling questionable artwork to the average consumer have proliferated. Walton admits, "The internet has provided a vast new market for art criminals. . . . For art forgers, the Internet has provided many customers." These sites render the distribution channels of forged artwork considerably more porous than in the past, when only a few dealers had a monopoly on the art market—and sold to sophisticated buyers. In recent years, the industry has become increasingly atomistic as millions of small players have entered the game. These players often include relatively unsophisticated purchasers.

Art forgeries do not only harm those who choose to voluntarily enter the volatile art market putting their own dollars at risk—forgeries can also rob the public treasury. If the value of art is artificially inflated when a forgery is donated to a museum, the taxpayers suffer huge losses when the donor takes a charitable deduction. To defend against this harm, charitable donations of art in excess of five $5,000 require an independent appraiser to submit an evaluation of the donated art. If the donation includes art with a claimed value of $20,000 or more, the art must physically be submitted to the National Art Appraisal Service for evaluation. However, ongoing questions relating to authenticity of the art work can trigger an audit by the Internal Revenue Service.

In the event of an audit, the IRS decides whether to refer the appraisal to the Commissioner's Art Advisory Panel. The members of this Panel are independent experts who hold closed-door meetings to evaluate issues regarding claimed value and authenticity of charitable deductions. The Panel submits a final report to the Internal Revenue Service which typically adopts the Panel's report as findings of fact.

69. See Noonan & Raskin, supra note 53, at 1008, 1010 (the complexity and expense of accurate authentication makes it difficult for buyers to determine if a work is forged. Moreover, swindled buyers may continue the deception in order to resell the piece or to avoid calling into question the legitimacy of the remaining pieces in their collection).
70. WALTON, supra note 2, at 87.
72. See LERNER & BRESSLER, supra note 16, at 1151.
73. See Id.
Often, the Panel finds that open questions relating to valuation and authenticity have significantly diminished the art's deductible value.\(^4\)

Insurance companies have also struggled to avoid the wider harm caused by the prevalence of forgeries in the art market. To avoid paying claims for stolen or damaged art later discovered to be inauthentic, insurers have successfully argued that the art forgeries present a "mutual mistake of fact."\(^5\) This legal theory allows for a unilateral rescission of the insurance contract when the insured art object innocently turns out to be a forgery after a loss is claimed.\(^6\) The insurer may not have to refund the excess premiums that were paid based on the assumption that the art was genuine and therefore had a higher value.\(^7\) However, when the insured knows that the art was a forgery, the court will void the insurance policy completely on the grounds of fraud.\(^7\) Nonetheless, how much forged art is insured at its inflated value is unknown.

In sum, the proliferation of international art distribution channels has made the new art economy increasingly challenging to regulate. Large numbers of fakes are created in the Far East, further complicating enforcement efforts, demanding international cooperation.\(^7\)

**IV. Criminal Laws Against Art Forgery**

Criminal prosecutions against art forgery are seldom brought, in part due to high evidentiary burdens and law enforcement disinterest. However, in an attempt to combat the threat that fake art poses, various governmental agencies are empowered by statute to

---


75. LEONARD D. DUBOFF & CHRISTY O. KING, ART LAW IN A NUTSHELL 69-71 (2000)

76. See LERNER & BRESSLER, supra note 16, at 129.

77. See Orient Insurance v. Dunlap, 193 Ga. 241, 17 S.E.2d 703 (1941) (court refused to order refund of excess premiums since mutual mistake was not discovered until after loss, insured had assumed that risk).

78. See Merchants Fire Assurance Corp. v. Lattimore, 263 F.2d 232, 244 (9th Cir. 1959).

79. Elisabeth Butler, Publishers Help Bust Chinese Counterfeiters, ART BUS. NEWS, Dec. 2003, available at http://findarticles.com/p/articles/mi_m0HMU/is_13_30/ai_111895861 ("Guangzhou Copyright Bureau searched two warehouses and a retail shop in Guangzhou, Tianhe, to seize more than 166,000 fake prints and 176 print films used to make counterfeit posters.")
prosecute suspected art forgers. While prosecutions are rare, they are occasionally brought in extreme cases.

A. Federal Laws

Federal prosecutions have been successful using generalized criminal statutes, including the Racketeer Influenced and Corrupt Organizations Act ("RICO"). For example, a successful RICO charge was brought against a family which had sold counterfeit prints purportedly by Chagall, Miro, and Dali. The defendants were also found guilty of other federal crimes including Conspiracy to Defraud, Money Laundering, and Postal Fraud. Federal prosecutors are also able to prosecute forgers using the federal Wire Fraud statute if the criminal enterprise involved electronic communications.

The Federal Trade Commission, acting under the authority of the FTC Act, is empowered to bring independent federal charges against forgers. The FTC Act has been used to combat an array of unfair trade practices in the art market. For example, an FTC Act prosecution was successfully brought against purveyors of fake Dali prints in FTC v. Magui Publishers, Inc. In that case, the defendant had collected millions of dollars from his sale of forged prints.

B. State Laws

Criminal prosecutions are also possible under certain state criminal laws, such as prohibitions against criminal fraud, or against the simulation of personal signatures. However, in order to trigger criminal liability under states' laws, the government must prove that

89. Id.
90. See, e.g., CAL. PENAL CODE § 470 (Deering 2008); N.Y. PENAL LAW §§ 170.00, 190.60 (McKinney 2007).
the defendant had intent to defraud. The evidentiary burden, as in all criminal prosecutions, is high.

Generally, state law criminal statutes employed to combat fraud and forgery were not originally tailored to address the art market. Consequently, some states have endeavored to regulate the art market through legislation more specifically aimed at curbing art fraud and forgery. For example, in the late 1960s, New York State sought to directly prohibit art forgery through a statute titled Criminal Simulation, worded broadly enough to capture both forgers and the art dealers who knowingly attempt to sell the forgeries. However, since its passage, criminal simulation charges have been brought only once in New York in the context of art forgery, and that single prosecution was unsuccessful. Many other states subsequently adopted similar statutes that are applicable to art forgery cases, with varying degrees of punitive severity. However, criminal prosecutions of art forgers under those statutes are rare—or non-existent.

V. Civil Laws

When clear cases of large-scale intentional criminal fraud cannot be easily established, rendering criminal prosecution unlikely, remedies for damages caused by art forgery have typically been

---

92. LERNER AND BRESSLER, supra note 16, at 251.
93. Levy, supra note 17, at 872-73.
94. N.Y. PENAL LAW § 170.45 (McKinney 2007) (under this section of the New York penal code, a person is guilty of criminal simulation when he or she: (1) With intent to defraud, makes or alters any object in such manner that it appears to have an antiquity, rarity, source or authorship which it does not in fact possess; or (2) With knowledge of its true character and with intent to defraud, he utters or possesses an object so simulated).
enforced through individual civil suits for breach of duties sounding in contract and tort law.\textsuperscript{97}

The Uniform Commercial Code provides contractually-based relief to duped buyers based on warranties of authenticity.\textsuperscript{98} However, the predominant civil theory to address art forgery remains civil fraud. When substantiating a civil fraud claim, the plaintiff is generally required to prove that the defendant falsely represented a material fact, that this representation was made with intent to deceive, that the plaintiff reasonably relied on the representation, and the representation resulted in damages to the plaintiff.\textsuperscript{99} Satisfying all of these elements is a challenging goal for many plaintiffs.\textsuperscript{100}

Many large art transactions take place via the conduit of an established auction house or gallery which consigns the art. Consignment sales are usually subject to a standardized contract which limits the claims that a buyer may assert against the auction house in the event of an authenticity dispute.\textsuperscript{101} To avoid these contractual limitations, some aggrieved buyers have sued, alleging a heightened fiduciary duty of trust existed between themselves and the auction house.\textsuperscript{102} However, courts have been reluctant to recognize any additional fiduciary duty arising between the houses and the art purchaser.\textsuperscript{103} Therefore, a less stringent set of obligations thereby limits the tort claims that buyers can assert against an auction house in the event of an authenticity dispute.\textsuperscript{104}

To fill the gap between civil and criminal litigation, some states have enacted consumer protection statutes expressly governing

\begin{itemize}
  \item \textsuperscript{97} See generally ROY S. KAUFMAN, ART LAW HANDBOOK 478 (Aspen Law & Business, 2000); see also Jori Finkel, “Art Auctions on Cruise Ships Lead to Anger, Accusations and Lawsuits,” THE N.Y. TIMES, July 16, 2008 at E1.
  \item \textsuperscript{98} U.C.C. § 2-313 (2007).
  \item \textsuperscript{100} Lacking proof of fraud, a buyer may succeed on a claim for negligent misrepresentation in tort law. Generally speaking, an action may be brought against a seller for negligent misrepresentation if the seller made an untrue representation of a material fact without any reasonable ground for believing it to be true. The seller must have intended to induce the plaintiff to rely on the negligently made statement, and the plaintiff in turn must have justifiably relied on it. Finally, the plaintiff must suffer damages. See Levy, supra note 17, at 874.
  \item \textsuperscript{101} See LERNER & BRESSLER, supra note 16, at Appendix 4.
  \item \textsuperscript{102} See Mickle v. Christie’s, 207 F. Supp. 2d 237, 242 (S.D.N.Y. 2002); See also Krahmer v. Christie’s, 903 A.2d 773, 784 (Del. Ch. 2006).
  \item \textsuperscript{103} Id.
  \item \textsuperscript{104} For example, in New York, negligent misrepresentation can only be brought when there is a special relationship of trust between the defendant and plaintiff, a relationship that has been rejected in the absence of a fiduciary duty. Krahmer v. Christie’s, 903 A.2d at 783-784.
\end{itemize}
established art dealers' representations. These statutes generally provide that buyers are entitled to rely upon an express (rather than implied) warranty of authenticity from an art merchant. Further, some courts have ruled that unsophisticated art purchasers are permitted to more reasonably rely on false representations from established sellers than would avid collectors, given that new entrants to the market lack the sophistication and foresight of the more experienced buyers.

However, buyers have been expected to conduct reasonable due diligence before making an art purchase. Despite the high cost of doing so, some courts have penalized buyers for not hiring experts to appraise and authenticate the art before purchase (or shortly thereafter).

VI. Intellectual Property Laws Applicable to Forged Art

The art industry should consider creative applications of U.S. intellectual property laws to fill the gap where existing criminal and civil laws have failed. These intellectual property laws generally do not apply the same heightened standard of proof beyond a reasonable doubt of ill intent, as do criminal fraud laws.

Intellectual property laws have not traditionally been used to fight art forgery for a number of probable reasons. First, intellectual property laws evolved to serve primarily utilitarian purposes, and consequently present a complex checkerboard of rights only few of which are applicable to art forgery. For example, utility patents generally offer little assistance in combating art forgeries. Design

---

105. See, e.g., California, CAL. CIV. CODE §§ 1740-1745.5 (Deering 2005); Michigan, MICH. COMP. LAWS ANN. § 442.322(a) (West 2002); New York, N.Y. ARTS & CULT. AFF. LAW § 13.01(1) (Gould 2008).
106. See DUBOFF & KING, supra note 75, at 79-80.
107. See Balog v. Center Art Gallery-Hawaii, Inc., 745 F. Supp. 1556, 1565-66 (D. Haw. 1990) (amateur buyers were reasonable in relying on the art dealer's representations as the basis for information regarding the authenticity of the art works).
108. Krahmer v. Christie's, supra note 106. at 782.
109. Id.
110. There are exceptions such as criminal copyright infringement which requires "willfulness" (17 U.S.C. § 506), and federal criminal trademark counterfeiting which requires "intent." 18 U.S.C. § 2320 (2006).
111. See, e.g., U.S. CONST. art. I, § 8, cl. 8 (providing Congress limited power to enforce intellectual property rights as necessary to "promote the Progress of Science and useful Arts"); see generally Sara K. Stadler, "Forging a Truly Utilitarian Copyright," 91 Iowa L. Rev. 609 (2006) (discussing utility of copyright in context of art forgery).
112. One unique approach to use patent protection against forgeries is by the French artist Yves Klein who spent years of his career using only one color in his paintings. The
HASTINGS COMM/ENT L.J.

patents also present a complicated process of application for most art, and are relatively unfamiliar to the art community.113

Historically, trademark and copyright laws evolved to protect aesthetic and non-utilitarian art forms from commercial piracy. Therefore, primary tools in the fight against forged art are existing are such laws, and their anti-counterfeiting enforcement components.114

A. U.S. Copyright

U.S. copyright laws protect original pictorial, graphic, and sculptural works, and therefore encompass many different types of art.115 The copyright owner enjoys the right to receive financial payment from those who wish to copy, perform, publish, adapt, display or distribute the copyrighted work.116 Unless the work is strictly one “made-for-hire,” the copyright resides in the creator(s) until it is divested by assignment or expiration after death.117 Additionally, the sale of an art object does not automatically transfer the underlying intellectual property in the art itself to the purchaser.118

In the United States, all works published prior to 1923 are in the public domain, and are thus generally reproducible by photographic

color is called International Klein Blue, or IKB, and Klein acquired Fr. Patent s in the process used to develop the paint. See Fr. Patent No. 63,471 (filed 1960).


114. It is beyond the scope of this article to address international issues, and their effects on U.S. intellectual property. However, it is worth noting that recently, the UN Educational, Scientific and Cultural Organization (UNESCO) has joined forces with Interpol and the International Council of Museums (ICOM) to issue guidelines to stem the illegal traffic of works of art and historic objects on the Internet. These three organizations developed a set of “Basic Actions Concerning Cultural Objects being offered for Sale over the Internet.” While clearly a step in the right direction, these Basic Actions are merely non-binding suggestions to UNESCO member states.


118. 17 U.S.C. § 204 (2006); See also Ringgold v. Black Entm't Television, Inc., 126 F.3d 70 (2d Cir. 1997) (absent a written assignment of the underlying copyright, the only rights transferred through sale of art are the right of physical possession, the right to publicly display the copy to viewers in the place where the copy is located, and the right to further transfer the physical art object without the artist's permission). See also Visual Artists' Rights Act of 1990 (“VARA”), 17 U.S.C. § 106A (2006).
or other means. For art created more recently, copyright protection is relatively easy to obtain and is enforceable for the duration of the artist's life and for 70 years beyond. As soon as a work is fixed in a tangible medium, it receives copyright protection. However, such protection can be lost if the work is "published." Once a work is published, a copyright notice will need to be placed on the work in order to protect the artist's rights. In the context of visual art, where such notice can be disruptive to an artwork's aesthetic value, notice can be placed on the frame or reverse side of a work, or on the base or pedestal of a sculpture. Registration of a copyright is necessary for the copyright holder to sue infringers.

Copyright laws are advantageous in combating certain types of art forgery. For example, assuming a work is not found to be in the public domain and is otherwise copyrightable, creation of replicas or reproductions of that work violate the U.S. Copyright Act, triggering civil liability.

The artist has the right to seek, among other things, actual and/or statutory damages and immediate seizure and ultimate destruction of the infringing art. Criminal liability can also attach to copyright infringement. Federal criminal laws against copyright infringement have been criticized as difficult and ineffective because, much like

122. See 17 U.S.C. § 101 (2006) ("Publication is the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease or lending."). Publication is the unrestricted distribution of copies of a work. However, mere public display of a work will not constitute publication.
123. See Richard L. Stroup, A Practical Guide to the Protection of Artists Through Copyright, Trade Secret, Patent & Trademark Law, HASTINGS COMM. & ENT. L.J. (1980-1981) ("An artist should make a good faith effort to place appropriate notice on or with his or her work in a manner which reasonably notifies the public while not unduly detracting from the creation.").
125. "Replicas" and "Reproductions" commonly refer to works of art that are intentionally copied for resale, but are usually not intended to be falsely attributed to the artist, or passed off as real. Reproductions are sometimes authorized by the museum or art owner. In fact, large art museums often maintain "imaging" studios in which they create mass market, printed reproductions of their collection, often made available for sale at museum gift shops. Lower quality, mass market reproductions are obviously harder to pass off as originals of famous works, but may constitute a copyright infringement.
laws against fraud, they require proof of intent beyond a reasonable doubt and generate little prosecutorial interest.128

Copyright protection of art has an additional benefit that is rarely used—protection by U.S. Customs against importation of art forgeries.129 Recordation of copyrights is voluntary at the U.S. Customs Service, and is simple to accomplish.130 Further, U.S. Customs has the power to detain, seize and ultimately destroy the counterfeit art when it enters the borders.131

A critical benefit of copyright registration is that intellectual property rights owners are now able to take advantage of the Digital Millenium Copyright Act’s (DMCA) “takedown” procedures.132 Under the DMCA, an internet service provider receives safe harbor from allegations of infringement when he expeditiously removes an allegedly infringing item from his website when receiving proper notice from the copyright owner.133

Copyright laws have limited reach in addressing more subtle types of art forgery and imitation. For example, copyright law does not prevent a forger from creating a painting generally “in the style” of another artist, even if that imitation later causes deception in the marketplace. In fact, copying works of great artists that have lapsed into the public domain is strongly encouraged as an effective method of study and practice.134 Merely using the original work as an inspiration may not in itself constitute a copyright infringement, because copyright law permits insubstantial similarities between

128. See Noonan & Raskin, supra note 53, at 1014 (“A stringent mens rea requirement . . . limits the usefulness and success of art crime prosecutions pursued under the Copyright Felony Act.”).
130. Id.
133. 17 U.S.C. § 512(c)(3)(A)(i-vi)(2006). The notice must include the following: (i) A physical or electronic signature of a person authorized to act on behalf of the owner of an exclusive copyright that is allegedly infringed; (ii) identification of the copyrighted work; (iii) identification of the allegedly infringing work; (iv) contact information; (v) a statement that the complaining party has a good faith belief that use of the material in the manner complained of is not authorized by the copyright owner, its agent, or the law; and (vi) a statement under penalty of perjury, that the complaining party is authorized to act on behalf of the owner of an exclusive right that is allegedly infringed. Id.
134. See SCOTT HODES, THE LAW OF ART AND ANTIQUES 54 (Oceana Publ’g 1966) (painters learn by copying and, in the past, students who could execute a good copy were respected).
works. In addition, as Walton cleverly points out, the copyright laws would not reach his particular species of eBay fraud.

Because a large percentage of art collections include art which has lapsed into the public domain, museums and collectors are presented with a conundrum—how to protect older, public domain works from intentional forgery using U.S. copyright law. To sidestep this fundamental obstacle, some museums have claimed to own independent intellectual property rights in sculptural and photographic reproductions of public domain works that they have created themselves. In doing so, the museum could theoretically possess a new and independent copyright in the underlying art work. A successful copyright registration on a public domain work would assist in combating forgeries and unauthorized reproductions of that work through standard copyright litigation.

However, a work must be “original” to be copyrightable. Thus an important practical question is raised—if a museum merely photographs a public domain work, does the museum now essentially possess a renewed and independent copyright in the underlying work? When the new image is an exact replica or reproduction of a public domain artwork, museums have been forced to argue that the single act of capturing the art work on film contains the requisite element of creativity or originality to justify a new and independent copyright in the new reproduction. At least one U.S. court has flatly rejected this theory, but the case was interpreting UK copyright law. Applying this concept under the U.S. Copyright Act to combat forgeries of public domain art is an ongoing, creative venture that should be further explored.

135. See Harper & Row Publ’g, Inc. v. Nation Enters., 471 U.S. 539, 569 (1985) (the Supreme Court rejected Nation Enterprise’s fair use defense in part because it had reproduced the "heart" of the work and was therefore not an insubstantial taking).
136. WALTON, supra note 2, at 140-41.
137. See Feist Publications Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 342 (1991) (holding that the requisite level of creativity a work to be “original” is “extremely low—even a small amount will suffice”); See also Stroup, supra note 123, at 194.
138. See Bridgeman v. Corel Corp., 25 F. Supp. 2d 421 (S.D.N.Y. 1999) (applying UK law, the court held that museum reproductions which sought to approximate the original work as closely as possible lacked the requisite originality and creativity necessary for copyright protection).
139. Id. (holding that the photographer of the public domain works added nothing original to the art—such photography was merely “slavish copying”).
B. Design Patents

Unlike utility patents, which protect "useful" inventions, design patents allow for the protection of non-functional components of designs. The design must be novel, non-obvious at the time made to a person of ordinary skill, and ornamental rather than functional. Design patents require an expensive and fairly lengthy application process in the U.S. Patent Office. Patent examiners also frequently reject applications and require submission of numerous amendments before permitting issuance of registration (if at all).

Design patents do have some benefits in combating forgeries. For example, in contrast to copyright infringement, proof of an act of intentional copying is not necessary to prove design patent infringement. Remedies can include disgorgement of ill-gotten profits and an injunction against further manufacture or sale. The court also has the power to treble damages and award attorneys' fees when the infringement is willful.

Design patents are frequently compared to copyright registrations. However, acquiring copyrights is much less expensive, applications are processed much faster, last for much longer periods of time, and allow for statutory damages, criminal liability and ex parte seizure remedies, all of which design patent protection does not. The practical usefulness of the design patent law versus copyright in combating art forgeries is debatable, but some commentators have concluded that wise artists and museums should apply for both sets of rights if feasible.

C. Trademark Law

As two respected art law commentators have noted, federal trademark laws in the United States are "not normally looked to for recourse by copyright holders of visual art." However underutilized, this area of intellectual property law could provide assistance in the fight against fake art.

Generally speaking, U.S. trademark law evolved in the commercial context to protect consumers from becoming confused
between different companies' "brands" used in commerce.\textsuperscript{144} States enforce similar trademark laws to minimize consumer confusion.

Unlike fraud laws, intent to cause confusion is not a prerequisite for a finding of trademark infringement.\textsuperscript{145} While intentional infringement of a registered trademark, or trademark "counterfeiting," triggers much harsher penalties, including seizure of the infringing property, as well as civil and criminal penalties,\textsuperscript{146} even a purely innocent sale of confusingly similar product may be enjoined.\textsuperscript{147}

An artist's use of his personal signature, monogram or "chop" to distinguish or "brand" his work as his own is a well-established practice in both Eastern and Western art history.\textsuperscript{148} This tradition was utilized to achieve both artistic and commercial distinction, but the common purpose was to have the signature function as a unique source-identifier at a later point in time, particularly if the art object's origin or authenticity was questioned.\textsuperscript{150} Interestingly, despite this storied history, under U.S. federal trademark laws, an artist's use of his personal name on art objects to signify distinctiveness of source does not necessarily protect that artist's name from being copied by unauthorized third parties.\textsuperscript{151}

\begin{footnotes}
\item[144.] J. Thomas McCarthy, \textit{McCarthy on Trademarks and Unfair Competition} 349-351 (West Publ.'g Supp. 2008).
\item[145.] \textit{Id.} (in trademark infringement cases, proof of "actual copying or intent to ride on another's goodwill is not necessary").
\item[147.] McCarthy, supra note 144, at 349-352 ("liability [for trademark infringement] turns on the fact of likely customer confusion and not on the subjective mental state of the defendant. A mistaken, good faith belief will not excuse otherwise illegal infringement.") (emphasis in original).
\item[148.] The colloquial "chop" was adopted from a Malay word during the colonization of the Straits Settlements. \textit{See} Wikipedia entry, \textit{available} at http://en.wikipedia.org/wiki/Seal_(Chinese).
\item[150.] Consequently, mimicking artists' signatures form the core of the forgers' task. Walton describes his frequent consultation of authoritative texts on artists' signatures when he reconstructed forged signatures on art. Walton, supra note 3, at 97; \textit{see also} Davenport's \textit{Art Reference & Price Guide} (2006/2007 Edition, LTB Gordonsart, Inc. 2005).
\item[151.] While federal trademark laws may not suffice to protect all artists' personal names, the unauthorized and intentional use of an artist's personal name may constitute violations under independent federal, state and local laws. \textit{See, e.g.}, Criminal Simulation, N.Y. PENAL LAW § 170.45 (McKinney's 2007); \textit{See also} Salesman for Studio is Convicted in Forging of Artist's Signature, N.Y. TIMES, Dec. 16, 1993, \textit{available at} http://select.nytimes.com/gst/abstract.html?res=F00616F9358DDDAB0994DB494D81.
\end{footnotes}
This limitation arises in part because U.S. trademark laws frown upon the use of a mere personal name as a trademark. A surname is therefore protectable as a trademark under Section 43(a) of the Lanham Act only if certain strict evidentiary conditions are met. Only if there is a widespread and established customer association between the name and the artist's work will the name be said to have developed secondary meaning and be protected from unauthorized use.

Famous artists' names are therefore more likely to satisfy this rigorous standard than lesser known ones. For example, one court held that Pablo Picasso had established secondary meaning in his name, and his heirs therefore possessed the unique right to commercially advertise and profit from the use of his name and his reputation in the art world as protected by federal trademark law. However, overcoming this legal hurdle may be difficult, if not impossible, for new and relatively unknown artists to meet. The title art may also be protectable under trademark law.

Because of their commercial history, logos are generally entitled to greater protection than personal names. Therefore, under

152. Under 15 U.S.C. § 1052(e), a mark which is "primarily a surname" is not federally registrable on the Principal Register without proof of secondary meaning. See also Peaceable Planet, Inc. v. Ty, Inc., 362 F.3d 986 (7th Cir. 2004) (articulating the court's concerns for monopolizing a personal name as a trademark).

153. Boston Beer Co. v. Slesar Bros. Brewing Co., 9 F.3d 175, 180 (1st Cir. 1993) ("Proof of secondary meaning entails vigorous evidentiary requirements."). The plaintiff must not only show that it used a personal name as a trademark, but that a "substantial portion of the consuming public associates [the name] specifically with [its] business." Id. at 182.

154. This is usually accomplished using a costly consumer survey. In addition to surveys, evidence of the artist's success, amount and nature of advertising of the artist's name, the length of time of his artistic career, and the volume of his art sales can help to establish secondary meaning.

155. See Visual Art Galleries Ass'n v. Various John Does, 80 Civ. 4487 (S.D.N.Y. 1980). The Trademark Office has also permitted registration of the word "PICASSO" as a trademark to third parties, finding that there was no likelihood of confusion protecting the use of PICASSO on lasers (U.S. Trademark Reg. No. 3,246,686), alcoholic beverages (3,209,561), silverware (2,709,992), construction services (2,503,655), vinyl flooring (2,629,763), and drive-through pizza places (1,465,018).

156. The U.S. Code provides that proof of substantially exclusive and continuous use of a mark for five years preceding application for registration can be accepted as prima facie evidence of secondary meaning. 15 U.S.C. § 1052(f) (2006).

157. The title of some forms of art may be protected by trademark law. See MCCARTHY, supra note 146, § 10:2 - 10:22.

158. Trademarks must be inherently distinctive to be protectable. Generally, common or ordinary words (including people's names) do not satisfy the distinctiveness requirement. Id.
prevailing trademark law, artists are best served to battle forgeries when they incorporate a stylized logo or unique monogram to identify their work, rather than merely their personal signature. Such a practice is firmly established in the East, and is considered acceptable in the Western art world. An artist’s consistent use of a distinctive logo on his art creations may entitle him to federal trademark registration, and afford the protections that attach thereto. Federal trademark registration would allow the artist to utilize a more effective legal tool against art forgery than use of his name alone, as the forger’s use of a confusingly similar logo on spurious art would trigger civil and even criminal liability for counterfeiting.

Trademark registration of an artist’s logo has an additional and underutilized benefit: Voluntary recordation of the trademark registration at the U.S. Customs Service gives an artist the protection of Customs agents sealing the borders of the United States from unauthorized importation of works bearing his unauthorized logo or mark. The U.S. Customs service offers this benefit for registered trademarks—unregistered trade dress does not qualify. Further, as with registered copyright infringement, U.S. Customs has the power to seize and ultimately destroy art that counterfeits a registered trademark.

There is no statutory analog to the DMCA for trademark infringement, but operators of some popular online auction sites have announced their intention to abide by the concept when a trademark


160. Albrecht Dürer (German, 1471-1528) used a distinctive monogram inside an Egyptian-style cartouche as his signature on his woodcuts. See Small Horse (Engraving c. 1505) and Knight, Death and the Devil (Engraving c. 1514). James McNeill Whistler (American, 1834-1903) often used a combination of his name and a butterfly for his signature. See Village Shop, Chelsea (Painting 1883/1884). Other famous artists who consistently used distinctive logos are JC Leyendecker, James Penfield, Hy S. Watson and Charles A. Winter. See Famous Artist and Illustrator Signatures, available at http://www.2neatmagazines.com/signatures-L-Z.html.

163. Additionally, when counterfeit art enters U.S. borders with entry documentation that is fraudulently and deliberately misstating the origin and value of the art, the importer is subject to serious penalties. 18 U.S.C. § 542 (2006); See also U.S. Customs Forms 7533 and 7501, available at http://cbp.gov/xp/cgov/toolbox/forms. The forged art may also be seized and/or forfeited. 19 U.S.C. § 1595a (2006).
is allegedly infringed by an item listed on their site. The VERO (Verified Rights Owner Program) is one “takedown” mechanism available to delist items on eBay that allegedly infringe trademarks or copyrights.

D. Trade Dress: Protecting an Artist’s Style

Not all art forgeries are identical copies of others’ works. Forgeries can include paintings completed in another author’s style which are then erroneously sold as previously undiscovered originals. Some artists have attempted to use the “false advertising” and unregistered “trade dress” provisions of trademark law to protect the personal style of their artwork from such imitations.

These provisions of the Lanham Act (and analogous state laws) may give a right to sue those who create their art who paint “in the style of” another, more famous artist, and attempt to pass it off as the undiscovered work of the more famous artist. A successful claim for trade dress infringement under Section 43(a) of the Lanham Act requires proof that the trade dress is nonfunctional, that it is inherently distinctive or has acquired secondary meaning, and that a competitor’s trade dress is so similar to that of the complainant that confusion as to the source of the goods is likely.

---

165. Id.
166. See LERNER AND BRESSLER, supra note 16, at 258. Famous forger Hans van Meegeren’s “Vermeers” are an example of forgeries in the genuine artist’s style. Van Meegeren’s forgeries were so good that when they were “discovered” Abraham Bredius erroneously declared one to be “the masterpiece of Johannes Vermeer.” FRANK WYNNE, I WAS VERMEER: THE RISE AND FALL OF THE TWENTIETH CENTURY’S GREATEST FORGER (Bloomsbury 2006) (emphasis in original). David Stein was another former art dealer who could paint in the style of Picasso, Chagall, Matisse, Miro, Braque, and Klee, among others. See A History of Art Forgery, available at http://www.mystudios.com/gallery/forgery/history/forgery-19.html.
167. See, e.g., First Brands Corp. v. Fred Meyer, Inc., 809 F.2d 1378 (1987) (holding that the trade dress must have acquired secondary meaning); Chevron Chem. Co. v. Voluntary Purchasing Groups, Inc. 659 F.2d 695 (5th Cir. 1981) (requiring that the trade dress either has secondary meaning or is inherently distinctive); Two Pesos Inc. v. Taco Cabana, Inc., 505 U.S. 763 (1992) (trade dress that is inherently distinctive is protectable without showing that it has acquired secondary meaning); Wal-Mart Stores, Inc. v. Samara Brothers, Inc., 529 U.S. 205 (2000) (product configuration trade dress is protectable only if it has acquired secondary meaning).
168. In assessing the likelihood of confusion, courts generally consider the eight factors set forth in Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492, 495 (2d Cir. 1961), cert. denied, 368 U.S. 820 (1961). The eight factors are: (a) strength of the user’s mark; (b) degree of similarity between the two marks; (c) competitive proximity of the two products; (d) likelihood that the plaintiff will enter the defendant’s market; (e) evidence of actual confusion; (f) the junior user’s good faith; (g) the sophistication of the purchasers. Id.
In the context of art fraud and forgery, at least some courts have held that an artist's distinctive style may receive trade dress protection under the Lanham Act, provided certain key threshold issues are met. In Romm v. Simcha International, Inc., the defendants sold limited edition and fine art posters based on the work of the Israeli artist Tarkay. These posters were not forgeries; they bore the signature of the real artist and were thus not passed off as the work of Tarkay. The complainants alleged that the defendants' manufacture and sale of the reproductions was intended to willfully trade on the plaintiff's goodwill and on the secondary meaning created by Tarkay's unique and distinctive style. The Court agreed, finding that consumers were likely to be confused by the similar styles of Tarkay's work and the prints produced by the defendants.

Despite the Eastern District of New York's willingness to give federal intellectual property protection to an artistic style, other courts faced with this creative theory have been unwilling to extend such protection. At some point, courts have held, these trade dress claims are interfering with the policies in copyright when the subject of the claim involves rights that are already protected under copyright laws.

Further, the U.S. Supreme Court has held that the Lanham Act prevents confusion as to the origin of goods, but that "origin" refers strictly to the producer of the tangible goods that were offered for sale, and not to the author of any idea, concept, or communication embodied in those goods.

Finally, despite the court's ruling in Romm v. Simcha International, Inc., Lanham Act claims may also be difficult to bring.

170. Id. (holding that recovery under Section 43(a) of the Lanham Act extends to "symbols and collections of colors and designs", and that the plaintiff's claim met the test for trade dress infringement—the style of the Tarkay paintings was (a) non-functional; (b) inherently distinctive (thus eligible for protection without proof of secondary meaning); and (c) the competitor's use of the Tarkay style was likely to cause confusion amongst consumers as to the source of the product).
171. See, e.g., Leigh v. Warner Bros., 212 F.3d 1210 (11th Cir. 2000) (holding that to allow trade dress protection of an artist's style where that style merely identifies the artist would undermine copyright law by granting a monopoly over ideas and themes); Galerie Furstenberg v. Coffaro, 697 F. Supp. 1282 (S.D.N.Y. 1988) (plaintiff brought several claims against a counterfeiter of etchings to which the plaintiff held rights; the court held that Salvador Dali's style is not a trademark and the plaintiff was not entitled to protection under New York statute prohibiting trademark dilution).
due to another obstacle—the aesthetic functionality defense. The aesthetic functionality defense effectively promotes competition in cases where giving trade dress protection to a design would result in a monopoly over the market for that design. Although no court has yet applied the aesthetic functionality defense in the case of art forgery, it may be difficult to establish that one has an exclusive property interest in a distinctive brush stroke, use of certain colors, composition tendencies, or portrayal of consistent subject matter. Part of the challenge facing artists in the trade dress context is the fundamental linguistic challenge of articulating distinctive visual and aesthetic features as verbal recitations for courts to evenly apply across cases.

E. Other Intellectual Property Laws

There exist other intellectual property laws at the federal and state levels that could assist in the fight against art forgery.


In a departure from its usual practice of incrementally amending existing intellectual property laws, after much controversy, Congress passed the Visual Artists Rights Act of 1990 ("VARA"). VARA protects, among other things, a visual artists' rights to proper attribution of his art. VARA's rights expire upon the death of the artist, and the statute is limited in other major respects as well.

174. See Pagliero v. Wallace China Co., 198 F.2d 339, 344 (9th Cir. 1952) (holding that a china pattern design was functional because it satisfied a consumer "demand for the aesthetic as well as for the utilitarian" and that granting relief to the plaintiff would have rendered him "immune from the most direct and effective competition with regard to these lines of China"); but see Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 160 (1995) (holding that a product feature may be functional "if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.").

175. This is especially true with respect to various art movements (such as cubism), in which artists are inspired by their contemporaries and create works in similar styles.

176. See, e.g., Yurman Design, Inc. v. PAJ, Inc., 262 F.3d 101, 117 (2d Cir. 2001) ("The trade dress of works that are decorative or artistic may be harder to capture in words, and may need descriptions more broadly framed, or may need drawings; but the party seeking protection must nonetheless be able to point to the elements and features that distinguish its trade dress.").


178. VARA defined a work of visual art as: "(1) a painting, drawing, print, or sculpture, existing in a single copy, in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author, or, in the case of a sculpture, in multiple cast, carved, or fabricated sculptures of 200 or fewer that are consecutively numbered by the author and bear the signature or other identifying mark of the author; or (2) a still photographic image produced for exhibition purposes only, existing in a single
Many commentators had originally hailed the new statute as a step in the new direction of recognizing the "moral rights" of artists, and embracing a broad intellectual property protection theory which originated in Europe but had never been accepted in the United States.\textsuperscript{181} However, VARA has remained a relatively obscure statute\textsuperscript{182} with very few cases litigated under it,\textsuperscript{183} and no reported cases involving art forgery or fraud. VARA's effectiveness in effectively fighting certain types of forged art has been seriously questioned.\textsuperscript{184}

The Copyright office recommended that there should be an effort made to increase awareness of this statute.\textsuperscript{185} However, the Copyright office's "recommendations were met with inaction."\textsuperscript{186} Using VARA to combat forged art still remains a serious possibility, and its lack of use underscores the need for further research and discussion on this topic.

2. The Federal Trademark Dilution Act

The Federal Trademark Dilution Act protects only "famous" marks from a likelihood of dilution.\textsuperscript{187} Some artists' names and styles could theoretically satisfy this heightened and even more rigorous standard.
3. **Right of Publicity**

Finally, some states recognize aggressive causes of action for misappropriation of identity and Right of Publicity, which may be applicable in the context of forged art. Art forgers who pass off their work as belonging to a more commercially viable artist effectively appropriate the commercial value of another person's identity. Usually, misappropriation of identity is limited to the use of a person's name or likeness, but it may be possible to make a claim if a defendant uses other identifying characteristics of a person, provided that they are so closely and uniquely associated with the individual that their use enables the defendant to appropriate the commercial value of the person's identity.

A serious limitation to using misappropriation of identity claims against art forgers is that federal copyright law preempts states from recognizing rights equivalent to those recognized by copyright. Therefore, misappropriation of identity claims must be limited to

---

188. See e.g., CAL. CIV. CODE § 3344, which prohibits using "another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent." The American Law Institute's Third Restatement of Unfair Competition expressly recognizes the right of publicity as a separate legal theory. Restatement (Third) of Unfair Competition § 46 (1995).

189. Right of publicity statutes exist in California, CAL. CIV. CODE § 3344; Florida, FLA. STAT. § 540.08; Kentucky, KY. REV. STAT. ANN. § 391.170; Massachusetts, MASS. GEN. LAWS, ch. 214, § 3A; Nebraska, NEB. REV. STAT. ANN. § 20-202; Nevada, NEV. REV. STAT. §§ 598.980-88; New York, N.Y. CIV. RIGHTS. Law §§ 50-51; Oklahoma, OKLA. STAT., tit. 12, §§ 1448-49; tit. 21, §§ 839.1-839.3; Rhode Island, R.I. GEN. LAWS §§ 9-1-28; 9-1-28.1; Tennessee, TENN. CODE ANN. § 47-25-1101 et seq.; Texas, TEX. PROP.CODE ANN. § 26.001 et seq.; Virginia, VA. CODE ANN. § 8.01-40; and Wisconsin, WIS. STAT. § 895.50.

190. The right of publicity secures the commercial value of a person's fame, and prevents the unjust enrichment of persons seeking to appropriate the value of that fame for themselves. See Bi-Rite Enters., Inc. v. Button Master, 555 F. Supp. 1188, 1198 (S.D.N.Y. 1983). Moreover, in some jurisdictions publicity rights are descendible, which allows for post-mortem enforcement. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995).

191. See, e.g., Hirsch v. S.C. Johnson & Son, Inc., 90 Wis.2d 379, (Wis. 1979) (allegation that the nickname "Crazylegs" identifying the plaintiff was sufficient to state a cause of action); Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831 (6th Cir. 1983) (stage phrase "Here's Johnny" found sufficiently identified with the plaintiff); Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821 (9th Cir.1974) (plaintiff identified by his distinctive racing car).

192. RESTATEMENT, supra, note 192.
personal identity and its uncopyrightable attributes, such as name, voice, and physical likeness. Moreover, the plaintiff must be identifiable by the defendant's use of his or her image. This complicates right of publicity claims against art forgers, with the exceptions of artwork bearing forged signatures, or of replicas and reproductions represented as being endorsed or signed by the artist. However, right of publicity and misappropriation of identity claims have been successfully brought against forgers in other contexts.

VII. Conclusion

Currently, criminal and civil fraud laws are the primary tools used to combat art forgery. However, these laws are unable to suppress the burgeoning international—and internet-driven—commercial threat that forged art poses. It would appear that the rising tide of fakes is not likely to be stemmed by current enforcement alone.

As discussed above in detail, there exist intellectual property laws which may be useful in combating the exponentially growing menace of art forgery. These laws must be utilized to be effective. The art community itself must invest resources by initiating litigation against forgers.

The art industry should lobby for, among other things, more consistent dedication of public resources toward prosecution of art forgers under existing intellectual property laws. Finally, the industry must take a leading role in educating the public about the gravity of the threat. As the luxury goods and entertainment industries can attest, the public must be educated and laws need to be aggressively and consistently enforced to be effective.

193. See, e.g., Cohen v. Herbal Concepts, Inc., 63 N.Y.2d 379, 384 (N.Y. 1984) (“The New York statute is designed to protect a person's identity, not merely a property interest in his or her 'name', 'portrait' or 'picture', and thus it implicitly requires that plaintiff be capable of identification from the objectionable material itself.”).

194. See, e.g., FTC v. Magui Publishers, Inc., 1991 U.S. Dist. LEXIS 20452 (C.D. Cal. Mar. 28, 1991) (although this was a public prosecution, the defendants Magui Publishers, Inc. had asserted that their prints had the approval of Salvador Dali, and that he played an important role in their creation and production).

195. See James v. Bob Russ Buick Inc., 167 Ohio App.3d 338, 342 (Ohio Ct. App. 2006) (“The forgery of the signature of another is a recognized variant of the tort known generally as invasion of privacy. More specifically, forgery amounts to the appropriation of the name or likeness of another.”).
***