



---

## Leigh v. Warner Brothers, Inc. 212 F.3d 1210 (11th Cir. 2000)

Christine Quintos

Follow this and additional works at: <https://via.library.depaul.edu/jatip>

---

### Recommended Citation

Christine Quintos, *Leigh v. Warner Brothers, Inc. 212 F.3d 1210 (11th Cir. 2000)*, 11 DePaul J. Art, Tech. & Intell. Prop. L. 309 (2001)

Available at: <https://via.library.depaul.edu/jatip/vol11/iss1/10>

This Case Summaries is brought to you for free and open access by the College of Law at Via Sapientiae. It has been accepted for inclusion in DePaul Journal of Art, Technology & Intellectual Property Law by an authorized editor of Via Sapientiae. For more information, please contact [digitalservices@depaul.edu](mailto:digitalservices@depaul.edu).

## CASE SUMMARIES

### *LEIGH V. WARNER BROTHERS, INC.*

212 F.3d 1210 (11<sup>th</sup> Cir. 2000)

#### INTRODUCTION

Plaintiff-Appellant, Jack Leigh filed suit against Warner Brothers for copyright and trademark infringement in the United States District Court for the Southern District of Georgia, which granted summary judgment in favor of Warner Brothers on all claims, but one claim which the parties have settled.<sup>1</sup> Leigh appealed the decision and the United States Court of Appeals for the Eleventh Circuit affirmed the grant of summary judgment for Warner Brothers on Leigh's trademark claims and copyright claim relating to film sequences.<sup>2</sup> The appellate court then reversed the grant of summary judgment for Warner Brothers on Leigh's copyright claims as it relates to single-frame images and remanded for proceedings consistent with its decision.<sup>3</sup>

#### I. BACKGROUND

In 1993, Random House commissioned Jack Leigh to take a photograph for the cover of the John Berendt novel, *Midnight in the Garden of Good and Evil*.<sup>4</sup> After reading the novel, Leigh looked for appropriate settings for the cover photograph in Savannah, Georgia.<sup>5</sup> Leigh discovered a statue in Bonaventure Cemetery known as the Bird Girl sculpted by Sylvia Shaw Judson

---

1 *Leigh v. Warner Brothers, Inc.*, 212 F.3d 1210, 1212 (11th Cir. 2000).

2 *Id.* at 1213.

3 *Id.*

4 *Id.*

5 *Id.*

in 1938.<sup>6</sup> She created three copies of the statue, one purchased by the Trosdal family who then placed it in their plot at Bonaventure Cemetery.<sup>7</sup> Leigh photographed the statue for the cover of the novel and granted Random House permission to use the photograph, retaining ownership and registering his claim of the copyright in the photograph.<sup>8</sup> Nowhere in the novel is the Bird Girl statue mentioned.<sup>9</sup>

In 1997, Warner Brothers produced the movie *Midnight in the Garden of Good and Evil* based on the novel.<sup>10</sup> Warner Brothers wanted to use the Bird Girl statue both in the film and promotional materials.<sup>11</sup> With the permission of Sylvia Shaw Judson's heir, Warner Brothers created a replica of the statue since the Trosdal family moved their copy of the statue from their plot in Bonaventure Cemetery.<sup>12</sup> Warner Brothers then proceeded to photograph and film their replica of the Bird Girl in a new location at Bonaventure Cemetery.<sup>13</sup> The statue is featured in three segments of film footage: a promotional clip and clips at both the beginning and end of the movie.<sup>14</sup> The statue is also featured in six still images: a promotional photograph, a nearly identical picture on the "goodandevil" website, a movie poster, a newspaper advertisement, the cover of the movie's soundtrack, and an internet icon.<sup>15</sup> Leigh filed suit against Warner Brothers for copyright and trademark infringement.<sup>16</sup> The district court granted summary judgment for Warner Brothers on all claims but one and Leigh timely appealed.<sup>17</sup>

---

6 *Leigh*, 212 F.3d at 1213.

7 *Id.*

8 *Id.*

9 *Id.*

10 *Id.*

11 *Leigh*, 212 F.3d at 1213.

12 *Id.*

13 *Id.*

14 *Id.*

15 *Id.* at 1214.

16 *Leigh*, 212 F.3d. at 1212.

17 *Id.*

## II. LEGAL ANALYSIS

A. *Issues*

On appeal, the court considered the scope of a photographer's copyright and trademark rights in his work, the role of the court in determining whether images are "substantially similar" for the purpose of copyright, and the power of the court to rule on dispositive motions without first allowing broad discovery.<sup>18</sup>

B. *Leigh's Copyright Claims*

The court stated that in order to establish a copyright infringement claim, a plaintiff must prove that he owns a valid copyright and that the defendant copied original elements of that work.<sup>19</sup> To prove copying, the plaintiff must show that the defendant had access to the alleged infringed work and produced a "substantially similar" work to the copyrighted work.<sup>20</sup> Further, the court emphasized that the plaintiff must specifically show that the defendant's work is substantially similar to the plaintiff's protected elements of the copyrighted work.<sup>21</sup> Warner Brothers does not contest that Leigh owns a valid copyright.<sup>22</sup> Leigh contends that the district court incorrectly determined his copyright scope and the substantial similarity issue.<sup>23</sup>

The appellate court stated that the statue's appearance itself or of Bonaventure Cemetery does not fall within Leigh's copyright scope.<sup>24</sup> Nor does the statue's association with the novel,

---

18 *Id.*

19 *Id.* at 1214.

20 *Id.*

21 *Leigh*, 212 F.3d at 1214.

22 *Id.*

23 *Id.*

24 *Id.*

*Midnight in the Garden of Good and Evil*, fall within its purview.<sup>25</sup>  
Copyright protects original expression, not ideas.<sup>26</sup>

The appellate court agreed with the district court that Leigh's copyright covered elements of the photographer's artistic craft, including elements such as his selection of lighting, shading, timing, angle, and film.<sup>27</sup> Leigh argued that the court should have considered the overall combination of these elements with the mood they convey.<sup>28</sup> The appellate court disagreed stating that the "eerie" mood of the photograph was scenes faire expression commonly associated with cemeteries, therefore, was not original or protectable.<sup>29</sup> The court did not want to focus on scenes faire, however, remarking that analyzing such characteristics could dangerously extend copyright protection to unoriginal aspects of the work.<sup>30</sup> Instead, the court chose to focus on Leigh's artistic craft.<sup>31</sup>

The appellate court found that the district court was correct in holding that the film sequences featuring the Bird Girl statue were not substantially similar to the protected elements of Leigh's photograph.<sup>32</sup> The district court's findings supported its holding that the film sequences and Leigh's photograph were very different. One sequence featured the Bird Girl in a foggy cemetery with her head cropped out of the frame and a Celtic cross, which was not included in the photograph.<sup>33</sup> Another sequence shows only the upper portions of the Bird Girl on the left side of the screen, partially in color and in daylight.<sup>34</sup> The final sequence shows a side shot of the Bird Girl revealing her head and shoulders

---

25 *Id.*

26 *Leigh*, 212 F.3d at 1214.

27 *Id.* at 1215.

28 *Id.*

29 *Id.* Scenes a faire doctrine arises when common or standard elements naturally flow from a common theme, therefore, is not copyrightable. *Beal v. Paramount Pictures Corp.*, 20 F.3d 454, 459 (11th Cir. 1994).

30 *Leigh*, 212 F.3d at 1215.

31 *Id.*

32 *Id.*

33 *Id.*

34 *Id.*

then later her torso as the camera rotated around her.<sup>35</sup> The scene shot the statue on the left side of the screen and in daylight.<sup>36</sup> Additionally, the scenes were shot in a different location of the cemetery, which included different gravestones and greenery than Leigh's photograph.<sup>37</sup>

On the other hand, with respect to the still images of the Bird Girl, the appellate court found that the similarities of the still images to Leigh's photograph were significant enough to preclude summary judgment presenting a question of fact for a jury.<sup>38</sup> Though differences between the two works were identifiable, the court found a number of common expressive elements protected by Leigh's copyright. First, all the photographs were taken from a low position so as not to reveal the contents of the bowls the Bird Girl held.<sup>39</sup> Second, Spanish moss bordered the tops of all the photographs except the soundtrack cover.<sup>40</sup> Also, that statue is fairly centered in all the photos except a newspaper advertisement.<sup>41</sup> Furthermore, the lighting shines on the statue leaving the surrounding cemetery in darkness.<sup>42</sup> Finally, all the photographs are monochromatic.<sup>43</sup> Though differences were found, such as the depiction of a smaller and more distant statue in the still images making the greenery and headstones more prominent and the lighting more extreme in the images, enough significant similarities existed to deny summary judgment and leave the question of fact to the jury.<sup>44</sup>

### C. Leigh's Trademark Claims

The court stated that in order to prevail on a trademark infringement claim, a plaintiff must prove that he had a valid

---

<sup>35</sup> Leigh, 212 F.3d at 1215.

<sup>36</sup> Id.

<sup>37</sup> Id.

<sup>38</sup> Id. at 1216.

<sup>39</sup> Id.

<sup>40</sup> Leigh, 212 F.3d at 1216.

<sup>41</sup> Id.

<sup>42</sup> Id.

<sup>43</sup> Id.

<sup>44</sup> Id.

trademark and that the defendant adopted an identical or similar mark that is likely to cause consumer confusion.<sup>45</sup> Under the Lanham Act,<sup>46</sup> a trademark is defined as any word, name, symbol or device, or any combination thereof that is capable of identifying or distinguishing one's goods from others and is capable of indicating the source of the goods.<sup>47</sup> The plaintiff's mark must have been used prior to the defendant's confusing mark.<sup>48</sup>

Leigh asserted that his photograph of the Bird Girl was a "source identifier" that promoted his workshops and the sale of his artwork.<sup>49</sup> The district court, however, felt Leigh attempted to protect his visual style concluding that it was not proper trademark function.<sup>50</sup> Leigh submitted into evidence a brochure from his Southern Images Gallery in Savannah, websites for his gallery and the Nuovo Fine Art Gallery, advertisements and flyers for exhibits and workshops at the Houston Photo Center, the Genesee Center for the Arts, the Gwinnett Fine Arts Center, as well as his own affidavit.<sup>51</sup> Though he offered these items to support his trademark claim, none of the advertisements, brochures, or websites predated the 1997 release of Warner Brothers' film thereby failing to establish Leigh's ownership of trademark rights.<sup>52</sup> Leigh's affidavit, however, did predate the 1997 release, but lacked the factual detail necessary to warrant any probative value.<sup>53</sup> It merely asserts that Leigh used the photograph to promote his work since May 1994 and mentions the Southern Images Gallery, but fails to mention any other details.<sup>54</sup> The appellate court held that Leigh failed to meet his burden of proving that his trademark rights predated the release of Warner Brothers' film and failed to give specific, factual support to create a genuine

---

<sup>45</sup> *Leigh*, 212 F.3d at 1216.

<sup>46</sup> 15 U.S.C. § 1125(a)

<sup>47</sup> *Leigh*, 212 F.3d at 1216.

<sup>48</sup> *Id.* at 1217.

<sup>49</sup> *Id.*

<sup>50</sup> *Id.*

<sup>51</sup> *Id.*

<sup>52</sup> *Leigh*, 212 F.3d at 1217.

<sup>53</sup> *Id.*

<sup>54</sup> *Id.*

issue for trial to refute Warner Brothers' motion for summary judgment.<sup>55</sup>

Additionally, the court noted that Leigh's use of the Bird Girl photo on the websites and advertisements were used descriptively and not as a trademark.<sup>56</sup> The photograph was merely an example of works available at an auction or an example of the works displayed at an exhibition.<sup>57</sup> At first, the Southern Images Gallery website appears to use the photograph as a trademark indicating Leigh as its source.<sup>58</sup> However, in actuality the picture rotates every five seconds with five other photographs of Leigh.<sup>59</sup> The appellate court noted that the examples of Leigh's use of the photograph in the evidence submitted seems to identify the gallery as a whole and the art it displays or sells or concern a special event where the photograph is on display or for sale.<sup>60</sup> The appellate court felt the images were not used as a "separate and distinct mark on the good, but, rather, as the good itself."<sup>61</sup>

Furthermore, Leigh failed to prove a likelihood of consumer confusion where consumers would be confused as to association or sponsorship of Leigh's photograph to the Warner Brothers' film or promotional materials.<sup>62</sup> Leigh asserted that he raised genuine issues of material fact relating to the likelihood of confusion factors considered by the Eleventh Circuit. Warner Brothers raised the fair use doctrine and First Amendment defenses, however, the court did not consider the issues since it determined that Leigh had no valid trademark rights in the photo.<sup>63</sup>

Finally, Leigh asserted he was entitled to moral rights under *Gilliam v. American Broad, Co.*,<sup>64</sup> which held that alteration of an

---

<sup>55</sup> *Id.*

<sup>56</sup> *Id.* at 1218.

<sup>57</sup> *Leigh*, 212 F.3d at 1218.

<sup>58</sup> *Id.*

<sup>59</sup> *Id.*

<sup>60</sup> *Id.*

<sup>61</sup> *Leigh*, 212 F.3d at 1218, (quoting *Rock & Roll Hall of Fame & Museum, Inc. v. Gentile Prods.*, 134 F.3d 749, 754 (6th Cir. 1998)).

<sup>62</sup> *Leigh*, 212 F.3d. at 1218.

<sup>63</sup> *Id.*

<sup>64</sup> *Gilliam v. American Broad, Cos.*, 538 F.2d 14, 24-25 (2nd Cir. 1976).



artist's work and attributing the new work to that artist could violate the Lanham Act.<sup>65</sup> The appellate court noted, however, that the Eleventh Circuit had not adopted *Gilliam*.<sup>66</sup> Even if it had adopted *Gilliam*, the court held that Leigh failed to meet the required elements to assert such a claim.<sup>67</sup> Warner Brothers did not alter or distort Leigh's photograph since it had built its own replica to photograph and film.<sup>68</sup> Furthermore, Warner Brothers never attributed the images to Leigh. Failing to meet these elements, the court held Leigh could not successfully raise a *Gilliam* claim.<sup>69</sup>

#### *D. Discovery*

Leigh asserted that the district court abused its discretion in granting summary judgment for Warner Brothers without allowing him to conduct additional discovery.<sup>70</sup> The court had stayed all discovery early in the litigation, ruling on Warner Brothers' summary judgment motions with the stay in effect.<sup>71</sup> A court may defer ruling on a summary judgment motion until the non-moving party can conduct all necessary discovery pursuant to Federal Rule of Civil Procedure 56(f).<sup>72</sup> To find an abuse of discretion, the plaintiff must show his case was substantially harmed from the denial of his requests for additional discovery.<sup>73</sup> The appellate court found that there was no abuse of the district court's discretion.<sup>74</sup> The court had an adequate record to grant Warner Brothers its summary judgment motion.<sup>75</sup> The court also found that Warner Brothers could not produce any additional evidence

---

<sup>65</sup> *Leigh*, 212 F.3d at 1218.

<sup>66</sup> *Id.*

<sup>67</sup> *Id.*

<sup>68</sup> *Id.*

<sup>69</sup> *Leigh*, 212 F.3d at 1218.

<sup>70</sup> *Id.* at 1219.

<sup>71</sup> *Id.*

<sup>72</sup> *Id.*

<sup>73</sup> *Id.*

<sup>74</sup> *Leigh*, 212 F.3d at 1219.

<sup>75</sup> *Id.*

that would change the fact that its film sequences were not substantially similar to the copyrighted elements of Leigh's photograph.<sup>76</sup> As for the Warner Brothers still images of the Bird Girl, additional discovery could be appropriate since it was held that a genuine issue of fact had been raised.

### III. CONCLUSION

The Court of Appeals for the Eleventh Circuit affirmed the grant of summary judgment for Warner Brothers on Leigh's trademark claims and the copyright claim in relation to the film sequences.<sup>77</sup> The appellate court reversed the grant of summary judgment for Warner Brothers on Leigh's copyright claim relating to Warner Brothers' single-frame images, and remanded for proceedings consistent with its decision.<sup>78</sup>

*Christine Quintos*

---

<sup>76</sup> *Id.*

<sup>77</sup> *Id.*

<sup>78</sup> *Id.*

