

Highway Art Policy Revisited: Rethinking Transfers of Copyright Ownership in State-Owned Transportation Artwork

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INTRODUCTION

In the spring of 2017, a group of West Oakland fourth-graders and their teachers gathered in a blighted underpass beneath the I-580 freeway, waving hand-painted posters and chanting: “Art is peace, art is peace.” The children were part of an initiative called the Oakland Super Heroes Mural Project (“Super Heroes Project”), which for several years had engaged local artists to help students create murals for neglected spaces in their community. But their latest project, planned for a wall of the I-580 underpass, had hit a snag. The California Department of Transportation (“Caltrans”) owned the underpass, and it was requiring the students and their artist mentors to sign away their copyrights in the mural.¹

In an interview with Bay Area public media station KQED, Caltrans spokesperson Bob Haus said the copyright transfer was necessary, in case the mural was damaged and Caltrans needed to repair it—“[a]nd we can’t do that,” Haus claimed, “if we don’t have the copyright.”² That surprised Super Heroes Project director Amana Harris, who had supervised a different mural on nearby Caltrans property two years earlier without encountering this issue. “Caltrans wants exclusive copyrights,” she told KQED. “But . . . we don’t have exclusive copyrights to give.”³

What had halted the young artists in their tracks was a sudden change in Caltrans’ official policy on public art. In May 2016, Caltrans revised the “Transportation Art” section of its Project Development Procedures Manual (“PDPM”), a lengthy document that lays out the department’s policy standards for highway development projects. This update to the PDPM included a new approach to the intellectual

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1. Cy Musiker, *Student Project to Beautify Oakland Underpass Hampered by Caltrans*, KQED ARTS (Apr. 27, 2017), <https://perma.cc/Y5XQ-2PMC>.

2. *Id.*

3. *Id.*

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property (“IP”) rights of the artists who create public artworks installed within the state highway system. While Caltrans had previously allowed artists to keep their copyrights subject to a nonexclusive license of certain reproduction rights to the state,⁴ the 2016 policy (hereinafter the “Transportation Art Policy”) requires artists to assign their “entire rights, title and interest in” such works of art to Caltrans, including their “common law and federal copyright ownership rights.”⁵ The artist must execute a copyright assignment and transfer agreement, which Caltrans must approve, before the art is installed.⁶ This requirement exists even though the policy assumes that certain local “public agencies,” not the state of California itself, will be responsible for commissioning works of art; the policy directs the commissioning agency for a given work of art to also sign onto the assignment and transfer agreement.⁷

Caltrans introduced the Transportation Art Policy with little public explanation of its rationale. Still, one can draw a rough sketch of the department’s probable motives based on its sparse statements and recent litigation history, as well as the aims underlying similar transfer requirements in other contexts. Haus’ comment in relation to the Super Heroes Project suggests that Caltrans was motivated by the desire to avoid liability under the Visual Artists Rights Act (“VARA”) if it must alter or remove public artworks. Since VARA protects the rights of certain artists to prevent the intentional destruction, distortion, or mutilation of physical embodiments of their work,⁸ an attempt by Caltrans to repair or remove art it deemed damaged could theoretically subject the state to liability if the work were destroyed or unfavorably altered in the process. That concern may have seemed especially salient after a muralist brought a 2009 VARA suit against Caltrans for painting over a work of his that had been defaced by graffiti; although the suit was dismissed, it may have prompted the state to seek stronger protections.⁹ Other common justifications for requiring a commissioned artist to sign away her copyright may also be at play: Caltrans may wish to make unfettered use of works of transportation art without negotiating particularized licenses, to secure control over lawsuits against third-party copyright infringers, or to ensure the continuing distinctiveness of each work of public art.¹⁰

The Transportation Art Policy is not a satisfying response to those concerns. As currently written, the policy cuts deeply against the interests of the other parties who have a stake in public art commissions. It could prevent independent artists from reaping the economic rewards of their own creations and make it harder for local

4. Memorandum from Dolores Vallis, Acting Chief, Div. of Design, Cal. Dep’t of Transp. (Aug. 5, 2003), <https://perma.cc/LET9-7EGJ>.

5. CAL. DEP’T OF TRANSP., *Landscape Architecture*, in PROJECT DEVELOPMENT PROCEDURES MANUAL 29-7, 29-79 (last updated May 24, 2018), <https://perma.cc/D3ZE-NNFV> [hereinafter CAL. DEP’T OF TRANSP., *Landscape Architecture*].

6. *Id.*

7. *Id.* at 29-78–29-79.

8. 17 U.S.C. § 106A(a)(3) (2017).

9. See *Romero v. Cal. Dep’t of Transp.*, No. CV 08–8047, 2009 WL 650629 (C.D. Cal. Mar. 12, 2009); see also *infra* text accompanying notes 122–127.

10. See *infra* text accompanying notes 128–133.

agencies to commission artwork, both of which would likely result in fewer works of art for the general public to enjoy. Such a burdensome measure is not commensurate with California's interests in protecting itself from liability, since the Eleventh Amendment all but assures states' immunity from suits under the Copyright Act.¹¹ In any event, more artist-friendly alternatives to wholesale assignment of copyright ownership can meet the state's needs.

Moreover, much is at stake with Caltrans' choice of copyright policy. As of 2017, the California state highway system consisted of 250 highways spanning more than 15,000 miles.¹² The extent of Caltrans' jurisdiction magnifies the potential impact of the Transportation Art Policy—especially given that nearly one out of every three state highway miles is located within an urban area,¹³ where public art is more likely to be installed.

This Note argues that state policies that, like Caltrans', require a transfer of copyright in works of public art are ill-fitted to their purposes, and that the goals of copyright law are better served by alternative contractual arrangements. In Part I, I provide an overview of the legal landscape in the United States with respect to transfers of copyright ownership, visual artists' moral rights, and public art commissions. In Part II, I outline the substance of Caltrans' Transportation Art Policy and the possible justifications for its 2016 revision, and then show why the policy is both a poor fit for those presumptive objectives and an unwarranted burden on stakeholders. Finally, in Part III, I discuss alternatives to public art policies that require copyright transfer. I argue that states or state agencies seeking to own public artwork should, as Caltrans once did, allow artists to retain copyright provided that they grant the state a nonexclusive license for reasonable public uses. The advantage of such an approach—which many other states already employ—is that it offers reasonable protection for the state's legitimate interests in avoiding liability and enforcing the copyright, without the attendant harms to artistic creativity and to the public.

I. COPYRIGHT TRANSFER, MORAL RIGHTS, AND PUBLIC ART

To understand why a measure like the Transportation Art Policy might have emerged, it is helpful to consider a few key elements of U.S. copyright law. First, under the federal Copyright Act of 1976 (“the Copyright Act”), an author is free to sell or otherwise transfer to a third party her copyright in a work she has created. Second, federal and state statutes grant to creators of visual art a limited set of “moral rights,” which are separate from authors' rights to exploit their work for economic gain. Importantly, the law around moral rights in the United States contains a number of gaps around issues germane to public art. While courts have attempted to fill some of these gaps, judicial interpretations sometimes raise more questions than they answer.

11. U.S. CONST. amend. XI; *see also infra* notes 143–149.

12. CAL. DEP'T OF TRANSP., CALTRANS FACT BOOKLET 15 (2019), <https://perma.cc/4BUG-Y9R2>. By contrast, there are about 7,900 miles of federally owned roads in the state. *Id.* at 16.

13. *Id.* at 15.

A. COPYRIGHT ALIENABILITY AND THE WORK-FOR-HIRE DOCTRINE

There are a number of avenues under federal law by which someone other than the creator of a protectable work may own the copyright in that work. As a baseline, the law provides that the author of a work initially owns the copyright.¹⁴ Moreover, the author's ownership of the copyright survives the sale of the material object which embodies the work.¹⁵ That means that, ordinarily, an artist who sells a painting or sculpture she has created does not thereby transfer her copyright in that painting or sculpture to the buyer. Instead, copyright remains with the artist unless otherwise specified by contract.¹⁶

However, copyright law also affords an author considerable freedom to relinquish the copyright in a work she has produced. Under U.S. law, IP is subject to the traditional common-law understanding that a property owner should be able to freely part with title to her property, including by transferring it to another.¹⁷ Congress specifically intended "the principle of unlimited alienability of copyright" to be a feature of the Copyright Act, and courts have recognized this "broad purpose" of the Act.¹⁸

The statute achieves the goal of alienability by providing that "the ownership of a copyright may be transferred in whole or in part by any means of conveyance or by operation of law."¹⁹ Any such transfer, unless by operation of law, must be executed through a written instrument signed by the owner of the rights transferred (or the owner's agent).²⁰ Notwithstanding the requirement of a signed writing, transfers may take a number of forms; Congress defined a "transfer of copyright ownership" to include "an assignment, mortgage, exclusive license, or any other conveyance, alienation, or hypothecation" of a copyright or any of the component rights.²¹ A nonexclusive license, however, is not considered a transfer of copyright ownership.²²

The current law also reflects the principle of divisibility, another broad goal of the Copyright Act.²³ The statute provides that any of the exclusive rights which comprise a copyright under 17 U.S.C. § 106 may be transferred and owned

14. 17 U.S.C. § 201(a) (2017).

15. 17 U.S.C. § 202 (2017).

16. 3 MELVILLE B. NIMMER AND DAVID NIMMER, NIMMER ON COPYRIGHT § 10.09[A] (Matthew Bender, rev. ed.) [hereinafter NIMMER ON COPYRIGHT].

17. See generally Neil Netanel, *Alienability Restrictions and the Enhancement of Author Autonomy in United States and Continental Copyright Law*, 12 CARDOZO ARTS & ENT. L.J. 1, 1–2 (1994).

18. For Congress' intent to incorporate the principle of alienability into the Copyright Act, see H.R. REP. NO. 94-1476, at 123 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5738, 1976 WL 14045. For judicial recognition of this principle, see, for example, *NBC v. Copyright Royalty Tribunal*, 848 F.2d 1289, 1293–94 (D.C. Cir. 1988).

19. 17 U.S.C. § 201(d)(1) (2017).

20. 17 U.S.C. § 204(a) (2017).

21. 17 U.S.C. § 101 (2017).

22. *Id.*

23. *NBC*, 848 F.2d at 1293.

separately.²⁴ The same is true of subdivisions of any of the § 106 rights.²⁵ Following transfer of any of these exclusive rights, or a subset thereof, the new right holder enjoys the same legal protection as the copyright owner, and has access to the same remedies, with respect to the right she holds.²⁶ Thus, a right holder to whom part of a copyright is transferred, as by assignment or exclusive license, is entitled to sue an infringer of that particular right.²⁷

The work-for-hire doctrine is a different mechanism by which a party other than a work's actual creator can obtain copyright ownership. The Copyright Act defines a "work made for hire" as either "a work prepared by an employee within the scope of his or her employment," or one of several enumerated types of commissioned works if the parties agree in writing that the work will be considered a work made for hire.²⁸ In such cases, the employer—not the individual who prepared the work—is considered the work's author and, by default, owns the copyright.²⁹ Since copyright vests initially in the employer in a work-for-hire scenario, it is conceptually and legally distinct from the situation where an independent artist is vested with ownership of the copyright upon creating a work of art and then later transfers the copyright to another.³⁰

Before Congress enacted the employee-specific language in the Copyright Act, courts adopted an expansive view of the work-for-hire doctrine and generally found that art commissions were works made for hire.³¹ However, the Supreme Court has more recently used a dispute around a commissioned sculpture to clarify the distinction between works created by independent contractors and those made by employees within the scope of their employment.³² The framework the Court established in *Community for Creative Non-Violence v. Reid* suggests that a skilled freelance artist who creates a work of art for a commission fee dependent on the work's completion will generally be treated as an independent contractor.³³ That, in turn, means that copyright vests initially in the artist, provided the work is not one of

24. 17 U.S.C. § 201(d)(2) (2017). The principle of divisibility is a feature of the Copyright Act of 1976 specifically; under prior law, a copyright owner generally could not transfer anything less than the entire bundle of rights associated with the copyright. See 3 NIMMER ON COPYRIGHT, *supra* note 16, §§ 10.01, 10.02[A].

25. 17 U.S.C. § 201(d)(2) (2017).

26. *Id.*

27. 17 U.S.C. § 501(b) (2017).

28. 17 U.S.C. § 101 (2017). The enumerated types of works in the second part of the definition include contributions to collective works, works commissioned as part of motion pictures or other audiovisual works, and compilations. *Id.* Traditional forms of visual art, such as painting and sculpture, are not included.

29. 17 U.S.C. § 201(b) (2017).

30. One key difference is that an author who transfers her copyright interest generally retains the right to terminate the transfer and reclaim the copyright after thirty-five years, while works made for hire are not subject to this termination right. See 17 U.S.C. § 203(a) (2017); ROBERT A. GORMAN, JANE C. GINSBURG & R. ANTHONY REESE, COPYRIGHT: CASES AND MATERIALS 386 (9th ed. 2017).

31. See generally Julie Katzman, Note, *Joint Authorship of Commissioned Works*, 89 COLUM. L. REV. 867, 868–69 (1989).

32. *Cnty. for Creative Non-Violence v. Reid*, 490 U.S. 730 (1989).

33. For the Court's framework for differentiating an employee from an independent contractor, see *id.* at 751–53.

the enumerated types of works in the second prong of the “work made for hire” definition.³⁴ Since *Reid* elucidates when artists are considered the authors of art they produce, it’s worth taking a closer look at the Court’s approach.

The case arose after sculptor James Reid agreed to produce a sculptural display for the nonprofit organization Community for Creative Non-Violence (“CCNV”). Several CCNV members conveyed to Reid their idea for the sculpture, which was to raise awareness about homelessness through a “modern Nativity scene” in which the human figures “would appear as contemporary homeless people.”³⁵ Reid completed the sculpture in his own studio, which CCNV members occasionally visited to monitor his progress, and he accepted most of CCNV’s suggestions regarding the sculpture’s appearance. After CCNV displayed the sculpture for a month, it returned the work to Reid’s studio for repairs. But when CCNV announced its plan to take the sculpture on a multi-city fundraising tour, Reid claimed the sculpture wasn’t durable enough to travel so extensively, refused to return it, and filed a copyright registration certificate. CCNV sued for the sculpture’s return and a determination of copyright ownership.

To decide which of the two parties was the sculpture’s rightful author, the Court analyzed whether it was a work made for hire. Finding that Congress intended the terms “employee” and “scope of employment” in § 101 to have the same meanings as under the “general common law of agency,”³⁶ the Court determined that the crucial question was whether Reid was CCNV’s employee or an independent contractor.³⁷ It engaged in a multi-factor analysis of that issue, weighing considerations such as the hiring party’s right to control the manner and means by which the product is accomplished, the duration of the relationship between the parties, the provision of employee benefits, and several others.³⁸ Ultimately, most of the factors weighed in favor of finding that Reid was an independent contractor, and therefore the Court held that the sculpture was not a work made for hire.³⁹ Reid would be the sole author and copyright owner, unless the lower court determined on remand that CCNV was a joint author.⁴⁰

Although the Court’s inquiry was fact-dependent, the upshot of *Reid* for commissioned works of public art is that in most cases, such works probably will not

34. 17 U.S.C. § 101 (2017); see also Robert Penchina, *The Creative Commissioner: Commissioned Works Under the Copyright Act of 1976*, 62 N.Y.U. L. REV. 373, 383–86 (1987).

35. *Reid*, 490 U.S. at 733 (quoting *Reid v. Cmty. for Creative Non-Violence*, 652 F. Supp. 1453, 1454 (D.D.C. 1987)).

36. *Id.* at 740–41.

37. *Id.* at 751.

38. *Id.* at 751–52.

39. *Id.* at 752–53. As the Court noted, a work commissioned from an independent contractor is a work made for hire only if it falls under one of the enumerated categories of works in subsection (2) of the definition of “work made for hire” and the parties expressly agree that the work is to be treated as such, 17 U.S.C. § 101 (2017), but this plainly did not apply in *Reid*, 490 U.S. at 738.

40. *Id.* at 753. On remand, the district court entered a consent judgment that recognized Reid as the sculpture’s sole author and sole owner of all § 106 rights with respect to three-dimensional reproductions; Reid and CCNV were deemed co-owners of the § 106 rights with respect to two-dimensional reproductions. *Cmty. for Creative Non-Violence v. Reid*, Civ. A. No. 86–1507, 1991 WL 415523 at *1 (D.D.C. Jan. 7, 1991).

constitute works for hire.⁴¹ Assuming a particular piece is not classified as a work made for hire, copyright will vest by default in the artist. If the commissioner or owner of the public art piece wants more control over the economic exploitation of the work, the parties must contract for a different allocation of rights, either through assignment or nonexclusive licensing. *Reid*'s clarification of the work-for-hire doctrine also has important consequences for whether U.S. law recognizes a particular artist's moral rights, a topic to which I now turn.

B. MORAL RIGHTS UNDER U.S. LAW: THE CALIFORNIA ART PRESERVATION ACT AND THE VISUAL ARTISTS' RIGHTS ACT

Some countries, particularly in Europe, have long recognized the species of authors' rights known as "moral rights," which relate to the "personal" aspect of authorship and are independent of the economic rights encompassed by copyright.⁴² One category of moral rights are known as rights of attribution, which include an author's right to be known as the author of her work, her right to disclaim authorship of works that she has not created, and her right to publish a work anonymously.⁴³ Another type of moral right involves the author's rights to prevent others from deforming or distorting her work, sometimes known as rights of integrity.⁴⁴ Other kinds of moral rights exist, but the rights of attribution and integrity are those that have been recognized in some form by the international community via Article *6bis* of the Berne Convention.⁴⁵ The United States, which did not accede to the Berne Convention until more than a century after its adoption, has treated moral rights inconsistently in its copyright law.

1. California Recognizes Some Artists' Moral Rights

One of the first legislative recognitions of artists' moral rights in the United States was the California Art Preservation Act ("CAPA"), which went into effect in 1980. CAPA's protections apply only to the creators of works of "fine art," defined in the statute as "an original painting, sculpture, or drawing, or an original work of art in glass, of recognized quality."⁴⁶ "Fine art" does not, however, include works which

41. See, e.g., 1 ALEXANDRA DARRABY, ART, ARTIFACT, ARCHITECTURE AND MUSEUM LAW § 7:64, Westlaw (database updated July 2017) (noting that courts are especially likely to treat visual artists as independent contractors "because of their creativity and skills, and the proficiency required to create artwork"). Furthermore, most common forms of public art, such as sculptures and murals, are unlikely likely to fall into any of the nine categories enumerated in the second subsection of the work-for-hire definition in § 101. See *Reid*, 490 U.S. at 738 (stating that the second subsection of the definition does not cover sculpture).

42. 3 NIMMER ON COPYRIGHT, *supra* note 16, § 8D.01[A].

43. *Id.*

44. *Id.*

45. *Id.* § 8D.01[B] (citing Berne Convention for the Protection of Literary and Artistic Works (Paris text), July 24, 1971, art. *6bis* (1) ("[T]he author shall have the right to claim authorship of the work and to object to any distortion, mutilation, or other modification of, or other derogatory action in relation to, the said work, which shall be prejudicial to his honor or reputation.")).

46. CAL. CIV. CODE § 987(b)(2) (West, Westlaw through Ch. 860 of 2019 Reg. Sess.).

are “prepared under contract for commercial use by [a] purchaser.”⁴⁷ Since the works of “transportation art” described in the Caltrans Transportation Art Policy include only graphic and sculptural artwork prepared for public, noncommercial use,⁴⁸ CAPA would presumably apply to them.

With respect to the works it covers, CAPA offers certain protections for the artist’s rights of attribution and integrity. It provides that the artist of a work of fine art retains the right to claim authorship of the work or, “for a just and valid reason,” to disclaim authorship.⁴⁹ Additionally, CAPA prohibits any person, except for an artist in possession of her own work, from intentionally defacing, mutilating, altering, or destroying a work of fine art.⁵⁰ CAPA also extends posthumous protections to applicable works; the statute recognizes the named rights for deceased artists’ heirs until the fiftieth anniversary of the artist’s death.⁵¹

2. Congress Introduces Federal Protection for Moral Rights

CAPA and other similar state laws were the only statutory schemes of protection for artists’ moral rights in the United States until 1991, when the federal Visual Artists Rights Act of 1990 (“VARA”) took effect.⁵² While VARA brought the United States a step closer to full compliance with the Berne Convention, the protections it establishes are fairly limited. First, the statute recognizes certain artists’ rights of attribution. An artist of a work covered by VARA has the right to claim authorship of the work and to prevent attribution to her of a work she did not create.⁵³ She can also disclaim authorship of a work which she created, but which has been distorted, mutilated, or otherwise modified in a way that would harm her reputation.⁵⁴ Second, VARA offers some protection for rights of integrity. A covered artist has the right to prevent “any intentional distortion, mutilation, or other modification of [a work] which would be prejudicial to his or her honor or reputation,” as well as any intentional or grossly negligent “destruction of a work of recognized stature.”⁵⁵ However, these integrity rights are not recognized when the modification results from the ordinary passage of time, from the nature of the materials used in the work, from conditions of the work’s presentation to the public,

47. *Id.*

48. *See infra* note 110 and accompanying text.

49. CAL. CIV. CODE § 987(d) (West, Westlaw through Ch. 860 of 2019 Reg. Sess.).

50. CAL. CIV. CODE § 987(c)(1) (West, Westlaw through Ch. 860 of 2019 Reg. Sess.). Framers, conservators, and restorers are held to the somewhat higher standard of gross negligence, *see* CAL. CIV. CODE § 987(c)(2) (West, Westlaw through Ch. 860 of 2019 Reg. Sess.).

51. CAL. CIV. CODE § 987(g)(1) (West, Westlaw through Ch. 860 of 2019 Reg. Sess.). In this sense, CAPA is “consistent with the minimum requirements set forth in the Berne Convention,” although it protects a much narrower range of works. Karen Gantz, *Protecting Artists’ Moral Rights: A Critique of the California Art Preservation Act as a Model for Statutory Reform*, 49 GEO. WASH. L. REV. 873, 883–87 (1981).

52. Visual Artists Rights Act of 1990, Pub. L. No. 101-650, Title VI, 104 Stat. 5128 (codified in scattered sections of 17 U.S.C.).

53. 17 U.S.C. § 106A(a)(1) (2017).

54. 17 U.S.C. § 106A(a)(2) (2017).

55. 17 U.S.C. § 106A(a)(3) (2017).

or from conservation efforts.⁵⁶

VARA applies only to artists who author “works of visual art,”⁵⁷ defined to include paintings, drawings, prints, or sculptures that exist in a single copy or in a limited edition of no more than 200 signed copies, as well as photographs produced for exhibition purposes.⁵⁸ A “work of visual art” does not include any work made for hire, meaning VARA acknowledges no rights of attribution or integrity for an artist who makes art for her employer within the scope of her employment.⁵⁹ Like CAPA, VARA seems likely at first glance to apply to the types of works created as “transportation art” under Caltrans’ Transportation Art Policy, which include pictorial, graphic, and sculptural works of public art prepared by artists who are likely to be viewed as independent contractors.⁶⁰

Other provisions of VARA may be relevant to works of transportation art that are painted on or otherwise integrated into permanent three-dimensional structures. If a work of art “incorporated in or made part of a building” after June 1, 1991, cannot be removed from the building without being destroyed, distorted, or mutilated—and the artist has acknowledged as much in writing—then the right to disclaim authorship and the rights of integrity, as laid out in § 106A(a)(2) and § 106A(a)(3), are not recognized.⁶¹ On the other hand, if the work *is* removable, the building’s owner must attempt to provide the artist with written notice of an impending removal.⁶² If the artist does not remove the work or pay for removal within 90 days of receiving notice, the rights described in § 106A(a)(2) and § 106A(a)(3) do not apply.⁶³ Notably, the statute does not define “building,” so it’s not clear whether works of art incorporated into non-habitable structures, such as highway overpasses, bridges, or cloverleaf interchanges, fall under the § 113(d) exception.⁶⁴ This remains an unsettled issue that could affect how VARA applies to certain works of transportation art.

56. 17 U.S.C. § 106A(c) (2017).

57. 17 U.S.C. § 106A(a) (2017).

58. 17 U.S.C. § 101 (2017).

59. *Id.*

60. *See infra* note 110 and accompanying text.

61. 17 U.S.C. § 113(d)(1) (2017).

62. 17 U.S.C. § 113(d)(2) (2017).

63. *Id.* The rights which § 106A(a)(2) and § 106A(a)(3) confer also do not apply if the owner is unsuccessful in notifying the artist after a good-faith attempt. *Id.*

64. The legislative history of the Architectural Works Copyright Protection Act of 1990, passed contemporaneously with VARA, suggests that Congress did not intend the term “building” to encompass bridges and related non-habitable structures. H.R. REP. NO. 101-735 (1990), *reprinted in* 1990 U.S.C.C.A.N. 6935, 6951, 1990 WL 200440 (“The sole purpose of [passing the Architectural Works Copyright Protection Act] at this time is to place the United States unequivocally in compliance with its Berne Convention obligations. Protection for bridges and related non-habitable structures is not required by the Berne Convention . . . As a consequence, the phrase ‘or other three-dimensional structures’ was deleted from the definition of architectural work and from all other places in the bill.”). *See also* 37 C.F.R. § 202.11(d)(1) (2018) (expressly excluding “[s]tructures other than buildings, such as bridges, cloverleaves, dams, walkways,” and other such structures from the types of works which the Copyright Office will register as architectural works). Yet at least one court has justified interpreting the VARA building exception more broadly on the grounds that the exception is meant to protect the property rights of building owners, a policy that applies equally to owners of other permanent structures. *Kammeyer v. Oneida Total Integrated Enter.*, 15-869-JGB, 2015 WL 5031959 at *6 (C.D. Cal. Aug. 24, 2015) (finding that a dam is a “building” for purposes of § 113(d)).

One additional noteworthy aspect of both VARA and CAPA is that they provide mechanisms for artists to waive their moral rights. Under VARA, only the artist of a covered work can claim moral rights in that work, whether or not she owns the copyright.⁶⁵ Accordingly, the rights created by § 106A cannot be transferred to another party; the only way for an artist to divest herself of those rights is to waive them.⁶⁶ Like VARA, CAPA does not permit transferring the rights of integrity and attribution, except that the California statute does allow the heirs, beneficiaries, or devisees of a deceased artist to enforce the rights for a fifty-year period following the artist's death.⁶⁷ Crucially, both VARA and CAPA state that the relevant rights can be waived only through an express written instrument signed by the artist, and VARA requires that this written document specify the work and the precise uses to which the waiver applies.⁶⁸ In the absence of a signed writing, then, an artist cannot typically be said to have waived her moral rights.⁶⁹

There is some question whether, and to what extent, CAPA has been preempted by VARA, which expressly provides that a state statute is preempted when (1) the rights it confers are "equivalent" to the rights conferred by § 106A, and (2) the works it protects are "works of visual art," as defined by § 101, and are those works to which VARA applies.⁷⁰ But VARA places no limitation on rights protected under state law which are "not equivalent" to any § 106A rights.⁷¹ At least one California court has observed that VARA appears to preempt CAPA, but that "it is not certain whether the California statute and the federal legislation are equal in scope."⁷² Presumably, a living artist no longer has recourse to CAPA in attempting to enforce her rights of attribution or to prevent intentional destruction of a painting or sculpture created after June 1, 1991, since VARA plainly confers equivalent rights. By contrast, it seems just as clear that CAPA's protections for post-mortem artists' rights, which are explicitly not a feature of VARA, survive preemption.⁷³ Between those two poles, the case for preemption is murkier. Professor Nimmer argues that an artist's right to prevent "alteration" of her work—recognized as a subset of the right of integrity under CAPA but not VARA—is nevertheless preempted.⁷⁴ This view is consistent with the legislative history, which indicates Congress's intent that

65. 17 U.S.C. § 106A(b) (2017). *See also supra* text accompanying note 42.

66. 17 U.S.C. § 106A(e)(1) (2017).

67. CAL. CIV. CODE § 987(g)(1) (West, Westlaw through Ch. 860 of 2019 Reg. Sess.).

68. 17 U.S.C. § 106A(e)(1) (2017); CAL. CIV. CODE § 987(g)(3) (West, Westlaw through Ch. 860 of 2019 Reg. Sess.).

69. CAPA does include one exception to the requirement of a signed writing: An artist is deemed to have waived her rights in a nonremovable work incorporated into a building, unless she expressly reserves those rights in a written instrument signed by the building owner. CAL. CIV. CODE § 987(h)(1) (West, Westlaw through Ch. 860 of 2019 Reg. Sess.). For works installed after June 1, 1991, this provision is likely preempted by VARA. *See supra* note 61 and accompanying text.

70. 17 U.S.C. § 301(f)(1) (2017).

71. 17 U.S.C. § 301(f)(2)(B) (2017).

72. *Lubner v. City of Los Angeles*, 45 Cal. App. 4th 525, 531 (2d Dist. 1996).

73. *See* 17 U.S.C. § 301(f)(2)(C) (2017) ("Nothing in paragraph (1) annuls or limits any rights or remedies under the common law or statutes of any State with respect to . . . activities violating legal or equitable rights which extend beyond the life of the author.")

74. 3 NIMMER ON COPYRIGHT, *supra* note 16, § 8D.07[C].

VARA should preempt even state statutes that offer broader protection for the same rights.⁷⁵ Yet the preemption of state laws which grant *greater* protection than VARA would result in a net *loss* of safeguards for artists' moral rights—an outcome at odds with VARA's attempt to bring the United States into compliance with the Berne Convention.⁷⁶ That dissonance suggests VARA may be better understood as a floor for moral rights protection, and that portions of state laws that go further than VARA are not preempted. CAPA does contain an express severability provision, which could help save portions of the statute.⁷⁷

3. VARA and the Unsettled Common Law of Public Art

VARA represented a significant change in the way U.S. law recognized the rights of certain creators. It is especially relevant for those who make public art. What we tend to consider the most common forms of public art, such as murals and sculpture,⁷⁸ fall naturally under the Copyright Act's definition of "works of visual art." And public art is, by definition, installed in common spaces—often dynamic places where a community's pluralistic interests and evolving needs may entail a greater likelihood of removal or modification, which could implicate VARA. Yet far from resolving the key legal questions associated with public artwork, VARA has introduced an entirely new set of ambiguities, and courts struggle to define the protections the law provides to public art. This subsection will review two post-VARA cases that have given shape to the law around public art and that help form the backdrop against which Caltrans' Transportation Art Policy emerged.

One important caveat associated with the application of VARA to public artwork: It is not clear whether VARA covers art that is site-specific, a category which often describes public art.⁷⁹ The common law considers site-specific art a subset of integrated art, which encompasses works composed of "two or more physical objects that must be presented together as the artist intended for the work to retain its meaning and integrity."⁸⁰ Works of site-specific art include the location of the artwork as one of their component physical objects, such that "[t]o remove a work of site-specific art from its original site is to destroy it."⁸¹ If VARA does protect site-

75. See H.R. REP. NO. 101-514 (1990), *reprinted in* 1990 U.S.C.C.A.N. 6915, 6931, 1990 WL 258818 ("[T]he new law will preempt a State law granting the right of integrity in paintings or sculpture, even if the State law is broader than Federal law, such as by providing a right of attribution or integrity with respect to covered works without regard to injury to the author's honor or reputation.").

76. Jane C. Ginsburg, *Copyright in the 101st Congress: Commentary on the Visual Artists Rights Act and the Architectural Works Copyright Protection Act of 1990*, 14 COLUM.-VLA J.L. & ARTS 477, 490 (1991).

77. Joseph Zuber, *The Visual Artists Rights Act of 1990—What It Does, and What It Preempts*, 23 PAC. L.J. 445, 496 (1992) (citing CAL. CIV. CODE § 987(k)).

78. See, e.g., Curtis Carter, *Toward an Understanding of Sculpture as Public Art*, 14 INT'L Y.B. OF AESTHETICS 161, 161 (2010) (noting that sculpture is arguably the most common form of public art).

79. *Public Art*, AMERICANS FOR THE ARTS, <https://perma.cc/H74G-ZAJT> (last visited Oct. 20, 2019) ("Public art is often site-specific, meaning it is created in response to the place and community in which it resides.").

80. *Phillips v. Pembroke Real Estate, Inc.*, 459 F.3d 128, 129 (1st Cir. 2006).

81. *Id.*

specific art, intentionally removing a site-specific artwork “of recognized stature” from its original location would seemingly always effect a violation of VARA.⁸²

Faced with this dilemma, the First Circuit—the only federal court of appeals to address the matter directly—has concluded that VARA does not apply to site-specific art at all.⁸³ The issue arose in *Phillips v. Pembroke Real Estate, Inc.*, after Pembroke Real Estate commissioned sculptor David Phillips to work on a public sculpture park on land Pembroke had leased from the Massachusetts Port Authority.⁸⁴ Working closely with the park’s landscape architect, Phillips had developed multiple pieces of bronze and granite sculpture and stonework which he integrated into the park’s overall layout.⁸⁵ About two years after Phillips completed his commission, Pembroke endeavored to remove most of his sculptures, citing problems with the original park design and maintenance issues.⁸⁶ Phillips objected and filed suit, arguing that his sculptures constituted a single, integrated, and site-specific work of art and that VARA prohibited the relocation of site-specific art.⁸⁷ The district court concluded that most of Phillips’ work in the park was indeed integrated and site-specific, but that he was not entitled to an injunction under VARA because relocation of the individual pieces of sculpture fell within the public presentation exception.⁸⁸

On appeal, the First Circuit agreed that Phillips could not use VARA to prevent Pembroke from removing his work from the park, but disagreed with the district court’s reasoning. Relocating a site-specific work necessarily destroys it, the court affirmed, because “the location of the work is an integral element of the work.”⁸⁹ But, according to the court, it would be nonsensical for VARA to simultaneously recognize a right of integrity in site-specific works *and* permit their destruction through the public presentation exception.⁹⁰ Instead, on its reading of the statute’s plain language, the court concluded that “VARA does not apply to site-specific art at all.”⁹¹ By contrast, the Seventh Circuit has indicated in dictum that it doubts site-specific artwork is categorically excluded from protection.⁹² However, the Supreme Court has not ruled on the matter, meaning that *Phillips* remains the definitive case on VARA’s applicability to site-specific art. Although the First Circuit’s

82. By its terms, the statute creates a right to prevent the “destruction” of only works “of recognized stature.” 17 U.S.C. § 106A(a)(3) (2017). See *infra* text accompanying notes 98–103 for one court’s interpretation of this phrase.

83. *Phillips*, 459 F.3d at 143.

84. *Id.* at 130.

85. *Id.* at 130–31.

86. *Id.* at 131.

87. *Id.* at 131–32.

88. *Id.*; see also 17 U.S.C. § 106A(c)(2) (2017) (“The modification of a work of visual art which is the result of . . . the public presentation, including lighting and placement, of the work is not a destruction, distortion, mutilation, or other modification . . . unless the modification is caused by gross negligence.”).

89. *Phillips*, 459 F.3d at 134.

90. *Id.* at 140.

91. *Id.* at 143.

92. *Kelley v. Chi. Park Dist.*, 635 F.3d 290, 292 (7th Cir. 2011) (“There is reason to doubt . . . that *all* site-specific art is excluded from VARA.”).

interpretation does not bind other circuits, *Phillips* sketches a limit to the types of visual artworks that VARA protects—a limit with clear implications for the rights and duties that exist between the owners and creators of public art.

In contrast to *Phillips*, a recent district court case suggests an expansion of the range of artwork which may find protection under VARA. *Cohen v. G & M Realty* centered around a Long Island City warehouse building known as 5Pointz.⁹³ The building had become a “haven” for legal graffiti after the graffiti artist Jonathan Cohen reached an agreement with the building’s owner to allow other artists to paint there.⁹⁴ When the owner, Gerald Wolkoff, made plans to demolish the 5Pointz warehouse, Cohen and twenty other graffiti artists unsuccessfully sought a preliminary injunction under VARA.⁹⁵ However, in the eight days between the order of denial and the court’s written opinion, Wolkoff whitewashed the building, destroying nearly all the plaintiffs’ artwork.⁹⁶ The plaintiffs then sought monetary damages under VARA’s provision preventing the “destruction of a work of recognized stature.”⁹⁷

The court discussed at length what the statutorily undefined phrase “of recognized stature” means for the purposes of § 106A(a)(3)(B). Expert testimony is not the sole determinant of whether a work is of recognized stature, the court noted; rather, “common sense,” “generally accepted standards of the artistic community,” and “inferred recognition from a successful career” are all relevant factors.⁹⁸ In applying this analysis to the 5Pointz graffiti, the court found that the thirty-seven works on highly visible long-standing walls had all achieved recognized stature, since they were curated for those spaces by a prominent, qualified member of the artistic community (Cohen himself).⁹⁹ Eight additional works were “of recognized stature” in part because they had attracted significant “third-party attention” or “social media buzz”; however, four works were *not* “of recognized stature,” either because they were not part of the curated collection or because they hadn’t achieved sufficient third-party attention.¹⁰⁰ The court awarded the plaintiffs the maximum statutory damage award (largely because it found that Wolkoff had willfully destroyed the works).¹⁰¹

As of this writing, *Cohen* is on appeal to the Second Circuit. But this closely-watched case could herald a liberalizing shift in judicial understandings of what qualifies as a work of “recognized stature,” particularly given the district court’s apparent rejection of the idea that such a work must have a proven market value.¹⁰²

93. 320 F. Supp. 3d 421 (E.D.N.Y. 2018), *appeal docketed*, No. 18-538 (2d Cir. Feb. 23, 2018).

94. Greg Howard, *Graffiti Gets Paid at 5Pointz. Now What?*, N.Y. TIMES (Feb. 20, 2018), <https://perma.cc/Q8YR-C5QC>. See also *Cohen*, *supra* note 93, at 433 (noting that the 5Pointz site was “a mecca for the world’s largest collection of quality outdoor aerosol art”).

95. See *Cohen v. G & M Realty L.P.*, 988 F. Supp. 2d 212, 214 (E.D.N.Y. 2013).

96. *Cohen*, *supra* note 93, at 427.

97. 17 U.S.C. § 106A(a)(3)(B) (2017).

98. *Cohen*, *supra* note 93, at 438.

99. *Id.* at 439.

100. *Id.* at 440.

101. *Id.* at 445, 447.

102. See *id.* at 442 (holding that “plaintiffs failed to establish a reliable market value for their

Even if the court's ruling is reversed or limited, the 5Pointz litigation highlights the interpretive difficulty inherent in the "recognized stature" language and shows that a case-by-case evaluation will often be required.¹⁰³ Given the unpredictability surrounding which works of art are entitled to protection under VARA, commissioners and owners of public art may be increasingly motivated to seek out contractual arrangements that securely insulate them against moral rights liability.¹⁰⁴

II. CALTRANS' TRANSPORTATION ART POLICY AND ITS SHORTCOMINGS

The doctrinal rules and cases discussed in Part I are crucial context for understanding the significance of the change in Caltrans' posture toward transportation art. The free alienability of copyright makes it possible—and procedurally simple—for an artist to assign away her *economic* rights in a work. Meanwhile, statutory protection for visual artists' *moral* rights implies heightened duties for owners of artwork toward those artists, along with a greater potential for liability. While case law has clarified some murky issues around commissioned public art (for example, the default allocation of rights when an artist works as an independent contractor), it has also raised new questions that may drive public art owners to seek greater protection.

It's against this backdrop that Caltrans has developed its current approach to public artwork installed within the state highway system. In this Part II, I will first discuss the substance of the Transportation Art Policy and consider possible justifications for its adoption. I will then elaborate on why the policy is at best a puzzling—and at worst a counterproductive—attempt to achieve its apparent aims.

A. SUBSTANCE AND POSSIBLE OBJECTIVES OF THE TRANSPORTATION ART POLICY

Within the California Department of Transportation, the Caltrans Headquarters Division of Design is responsible for the establishment and consistent application of official policies for project development.¹⁰⁵ To provide guidance regarding these policies, the Division of Design maintains a document called the Project Development Procedures Manual ("PDPM"). The PDPM does not impose requirements different from, or in addition to, those imposed by the law.¹⁰⁶ However, it does "provide[] the functional framework" of Caltrans' official procedures with regard to the conception, planning, and execution of state highway improvement

works").

103. Eileen Kinsella, *After 5Pointz, Can Artists and Developers Ever Work Together Again? Experts Lay Out the Way Forward*, ARTNET (Mar. 7, 2018), <https://perma.cc/K738-AP7A>.

104. See, e.g., Richard Chused, *Moral Rights: The Anti-Rebellion Graffiti Heritage of 5Pointz*, 41 COLUM. J. L. & ARTS 583, 629 (2018).

105. CAL. DEP'T OF TRANSP., *Introduction*, in PROJECT DEVELOPMENT PROCEDURES MANUAL 1-3, 1-3 (last updated July 1, 1999), <https://perma.cc/PF5H-CKNS> [hereinafter CAL. DEP'T OF TRANSP., *Introduction*].

106. *Id.* at 1-4.

projects.¹⁰⁷ Importantly, many of these procedures are designated “mandatory” by virtue of the language the manual uses to describe them.¹⁰⁸

The Transportation Art Policy proceeds from Caltrans’ statutory authority to control encroachments within the state highway right-of-way.¹⁰⁹ This includes “transportation art,” which the PDPM defines as a “graphic or sculptural artwork, either freestanding or placed upon a required engineered transportation feature (such as a noise barrier, retaining wall, bridge, bridge abutment, bridge rail, or slope paving) that expresses unique attributes of a community’s history, resources, or character.”¹¹⁰ But according to the policy, transportation art is not commissioned by Caltrans itself, or by the state at all; instead, the work is to be “proposed, provided, installed, maintained, and removed or restored by the public agency representing the area in which the art will be installed.”¹¹¹

Even as Caltrans places transportation art commissions within the purview of local government, it requires both artists and local agencies to assign it broad rights in any such works. The policy’s language regarding IP rights is as follows:

Transportation art located within Caltrans’ right-of-way is a benefit to the people of California and will become property of the State. Prior to the installation or placement of the approved transportation art, the artist(s) and public agency must provide Caltrans with an executed and notarized copyright assignment and transfer agreement containing terms and conditions approved by Caltrans. The copyright assignment and transfer agreement assigns, transfers, and conveys the artist’s entire rights, title and interest in and to the approved transportation art to Caltrans, including but not limited to, the artist’s common law and federal copyright ownership rights to the approved transportation art.¹¹²

There are a number of noteworthy features here. First, the state of California takes ownership of the tangible art object, even though the local public agency is assumed to be the party that commissioned the work. Second, the language describing the procedure for the transfer of copyright ownership indicates that assignment is mandatory (“*must* provide Caltrans with an executed and notarized copyright assignment and transfer agreement” (emphasis added)).¹¹³ Third, nowhere does the Transportation Art Policy expressly contemplate the waiver of an artist’s *moral* rights. In fact, the policy does not once mention VARA, CAPA, or the rights protected under either.¹¹⁴

107. CAL. DEP’T OF TRANSP., *Foreword* to PROJECT DEVELOPMENT PROCEDURES MANUAL (last updated Sept. 3, 2019), <https://perma.cc/4A7G-E9YR>.

108. CAL. DEP’T OF TRANSP., *Introduction*, *supra* note 105, at 1-5 (“[T]his manual uses the word ‘must’ to indicate mandatory project development procedures and policies for which Caltrans is responsible.”).

109. CAL. STS. & HIGH. CODE § 90 (West, Westlaw through Ch. 860 of 2019 Reg. Sess.).

110. CAL. DEP’T OF TRANSP., *Landscape Architecture*, *supra* note 5, at 29-78.

111. *Id.* “Public agency” refers to a municipality, county, tribal government, or non-federally recognized tribe. *Id.*

112. *Id.* at 29-79.

113. *See supra* note 108.

114. One cannot sensibly read these rights into the phrase “transfers . . . the artist’s entire rights, title and interest in and to the approved transportation art” because VARA and CAPA rights are non-

While transportation art objects have become state property since at least 2003, the Transportation Art Policy is a relatively new departure from prior practice. Before 2016, Caltrans allowed the artist to retain ownership of her copyright.¹¹⁵ The artist was simply expected to grant to Caltrans “consent . . . to reproduce artwork for promotional purposes.”¹¹⁶ But when the Division of Design issued an update to Chapter 29 of the PDPM in May 2016, it included the new language creating the requirement of copyright transfer.¹¹⁷ The memorandum announcing the changes did not include any findings of fact or elaborate on any circumstances that may have motivated them.¹¹⁸ Nor has Caltrans offered much public explanation for the new requirement, leaving the door open to speculation about why the department thought the change advisable.

One possibility is that Caltrans believes that copyright assignment helps it avoid liability for violating an artist’s right of integrity under VARA or CAPA. This justification would be consistent with Caltrans’ response to the Oakland Super Heroes Project, a notable exception to the department’s public reticence regarding the intention behind the new Transportation Art Policy. According to Caltrans’ spokesperson, Caltrans needed copyright ownership to fix artwork if it should become damaged.¹¹⁹ Since owners of material embodiments of copyrighted works already have the right to “recondition . . . and otherwise repair” their copies of the works regardless of who owns the copyright,¹²⁰ Caltrans’ statement implies that it is wary of retaliation by artists who feel its repair jobs violate their moral rights in their work, including the right to prevent the prejudicial modification of an art object. Its policy response suggests that it associates an artist’s transfer of copyright ownership in a work of art with her surrender of moral rights.

It’s understandable that Caltrans would be concerned with avoiding moral rights liability, as judicial uncertainty about what constitutes a protected work under VARA may prompt owners of public art to establish stronger liability shields for themselves.¹²¹ This matter may seem especially vital to Caltrans, which has already had to defend against a VARA lawsuit in the last decade: Frank Romero, who had

transferable. *See infra* notes 136–140 and accompanying text.

115. Memorandum from Dolores Vallis, Acting Chief, Div. of Design, Cal. Dep’t of Transp. (Aug. 5, 2003), <https://perma.cc/LET9-7EGJ>.

116. *Id.*

117. *See* Memorandum from Timothy Craggs, Chief, Div. of Design, Cal. Dep’t of Transp. (May 3, 2016) (on file with author) (highlighting changes to the “Transportation Art” section of Chapter 29, including with regard to the copyright assignment and transfer agreement).

118. *Id.* By contrast, other “manual change transmittal” memoranda issued by the Division of Design have provided at least a basic explanation of why changes to the PDPM were appropriate. *See, e.g.*, Memorandum from Janice Benton, Chief, Div. of Design, Cal. Dep’t of Transp. (Sept. 28, 2018), <https://perma.cc/WXP4-MM9K> (“Changes were needed in response to the CTC State Highway Operations and Protection Program (SHOPP) Guidelines implemented in an earlier Caltrans policy memo . . .”).

119. *See supra* text accompanying note 2.

120. Pamela Samuelson, *The Quest for a Sound Conception of Copyright’s Derivative Work Right*, 101 GEO. L.J. 1505, 1537 (2013) (citing *Fawcett Publ’ns v. Elliot Publ’g Co.*, 46 F. Supp. 717 (S.D.N.Y. 1942); *Bureau of Nat’l Literature v. Sells*, 211 F. 379, 381–82 (W.D. Wash. 1914)).

121. *See supra* note 104 and accompanying text.

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created a mural on an underpass of the 101 Freeway to celebrate the 1984 Olympics in Los Angeles, sued Caltrans in 2009.¹²² According to Romero, Caltrans determined that graffiti had desecrated the mural and painted it over without first notifying him.¹²³ Romero asserted a cause of action for violation of his § 106A right of integrity.¹²⁴ While Caltrans was able to convince the court to dismiss the case on the grounds that the department was immune from suit under the Eleventh Amendment,¹²⁵ it may have viewed *Romero* as a shot across the bow. If Romero had had advance notice of Caltrans' plans to destroy his mural, he could have sought injunctive relief to frustrate those plans, since an artist whose work is covered by VARA has the right to prevent its destruction, assuming it is of recognized stature.¹²⁶ Given that the Eleventh Amendment would *not* prevent an artist in Romero's position from obtaining an equitable remedy against state officials,¹²⁷ perhaps Caltrans anticipated that it might not escape a moral rights suit so easily in the future and wanted additional insurance against those types of claims.

Still, there are a number of reasons this explanation isn't entirely compelling. As it's written, the Transportation Art Policy does not require artists to waive their VARA rights, nor does it address moral rights at all. And, as *Romero* demonstrates, the Eleventh Amendment already gives Caltrans some cover from damage suits involving the right of integrity.¹²⁸ However, there are at least three other conceivable justifications for the policy.

First, it's possible that Caltrans introduced the Transportation Art Policy's copyright transfer requirement as a safeguard against infringement liability. Caltrans may believe that owning the copyright in a work of transportation art is the best way to avoid being liable to the creator for unauthorized uses of that work. This is perhaps a more plausible explanation than the moral rights objective, given that the Transportation Art Policy explicitly references copyright but not moral rights. It's easy to imagine the state having an interest in the ability to freely display, reproduce, and make derivatives of a work of transportation art. For example, the state may wish to use photographs of the artwork in public relations materials or official publications, or to create merchandise that replicates the work. A requirement of copyright transfer ensures that the state would have the right not only to exploit the work in these foreseeable ways, but also to engage in entirely new uses in the future, regardless of whether those uses are currently contemplated or even known. Having the artist assign the copyright forestalls the need for the state to return to the artist to license previously unforeseeable uses. Of course, Eleventh Amendment immunity

122. *Romero v. Cal. Dep't of Transp.*, No. CV 08-8047, 2009 WL 650629 at *1 (C.D. Cal. Mar. 12, 2009).

123. *Id.*

124. *Id.*

125. *Id.* at *5. See *infra* notes 143-149 and accompanying text (discussing states' Eleventh Amendment immunity from suit under federal copyright law).

126. Rebecca E. Hatch, *Cause of Action for Destruction of "Work of Visual Art" of "Recognized Stature" Under Visual Artists Rights Act*, 63 CAUSES OF ACTION 2D 649 § 9.

127. See *Ex parte Young*, 209 U.S. 123 (1908).

128. See *infra* Part II.B.1 for further discussion of why the Transportation Art Policy does not align with an objective of avoiding moral rights liability.

already prevents copyright owners from obtaining damages for infringement by a state, just as it halted Frank Romero's VARA claim.¹²⁹ But by owning the copyright, the state would also be able to ward off suits by artists seeking equitable remedies for infringement.

Next, the Transportation Art Policy may be motivated by a desire to ensure state control over any legal action against third-party infringers. Because many artists lack the resources to vigorously enforce their copyrights, the state may believe it is in a better position to police infringement. Given that motive, copyright transfer would make some sense, since under the Copyright Act it is the "legal or beneficial owner" of any of the exclusive rights under a copyright who has standing to bring an infringement action to enforce that right.¹³⁰ Caltrans wouldn't be the first state agency to express this concern: The Oregon Arts Commission once used a standard contract for commissioning public artwork that, like the Transportation Art Policy, required copyright assignment from the artist. The Commission justified its assignment policy by stating that it would have standing to sue infringers only if it owned the copyright.¹³¹

A final possible objective of the copyright assignment requirement may relate to a more general interest in protecting the distinctiveness of California's public art. As Caltrans acknowledges, works of public art often "express[] unique attributes of a community's history, resources, or character."¹³² Such works may even come to be viewed as distinguishing symbols of the communities in which they are situated; an example is "La Grande Vitesse," an abstract sculpture by Alexander Calder installed in downtown Grand Rapids, Michigan, and incorporated into the city's official logo.¹³³ In order to encourage and preserve this sort of identity-making, the state may have an interest in ensuring that the works of transportation art it owns remain unique and are not replicated elsewhere. That goal could be achieved in part by giving the state control over litigation against third-party infringers, as discussed above. However, the state may also want to prevent the artist herself from producing replicas of a work of transportation art she has created. As long as the artist retains the copyright, she is free to create other pieces that are similar or identical, or to authorize others to do the same, absent an agreement to the contrary. Caltrans may view state ownership of the copyright as a blunt way to prevent such activities, which could dilute the artwork's uniqueness.

129. *Romero v. Cal. Dep't of Transp.*, No. CV 08-8047, 2009 WL 650629 at *5 (C.D. Cal. Mar. 12, 2009).

130. 17 U.S.C. § 501(b) (2017). Of course, transfer of the entire copyright is unnecessary for the transferee to enforce individual exclusive rights, since the "legal or beneficial owner" of any of the § 106 rights—or a subset thereof—may enforce that right (or sub-right). *See supra* notes 26-27 and accompanying text.

131. 6 ALEXANDER LINDEY, LINDEY ON ENTERTAINMENT, PUBLISHING & THE ARTS § 16:94, annotation to Article 6 (3d ed.) (hereinafter LINDEY ON ENTERTAINMENT).

132. CAL. DEP'T OF TRANSP., *Landscape Architecture*, *supra* note 5, at 29-78.

133. 6 LINDEY ON ENTERTAINMENT, *supra* note 131, § 16:94, annotation to Article 6; *see also Initial Public Art Project Becomes a Landmark*, NATIONAL ENDOWMENT FOR THE ARTS, <https://perma.cc/CQ8T-WSL4> (last visited Mar. 1, 2019); *Facts and History: Symbols of Grand Rapids*, CITY OF GRAND RAPIDS, <https://perma.cc/G2HZ-S93D> (last visited Mar. 1, 2019).

B. WHY THE TRANSPORTATION ART POLICY DOESN'T ADD UP

Until Caltrans provides further explanation of its intent in introducing the 2016 updates to the Transportation Art Policy, reasonable guesses as to its objectives will have to suffice.¹³⁴ Based on the department's scant public comments, its litigation history, and the intent behind similar requirements in other contexts, one can reasonably conclude that Caltrans wished to achieve some combination of the goals outlined in Part II.A: to limit the state's susceptibility to litigation over artists' moral and economic rights, to give the state control over any litigation against infringing third parties, and to ensure public artwork retains its unique character.

But the Transportation Art Policy, as currently written, is a clumsy fit for these objectives, which Caltrans could accomplish more precisely in other ways. At the same time, the required procedure is excessively burdensome and could create harmful consequences for artists, local agencies, and the public at large.

1. The Policy Is a Poor Fit for Its Presumptive Policy Aims

Considering Caltrans' public response to the Oakland Super Heroes Project mural, the Transportation Art Policy may be an attempt to protect the state from liability for violating artists' rights of integrity.¹³⁵ But, if this is indeed the primary justification for the policy, the requirement of copyright transfer is both ineffective and unnecessary. Merely owning the copyright in a work of transportation art, without more, does not absolve the state of its duty to respect the artist's moral rights. And even so, the state already has recourse to other safeguards, springing from both VARA and the Eleventh Amendment.

First, the Transportation Art Policy does not expressly mention the right of integrity or any moral rights at all—a curious omission, if the avoidance of moral rights suits is truly a motivating concern for Caltrans. As VARA makes clear, an artist's rights under § 106A are independent of the exclusive rights associated with her copyright in her artwork.¹³⁶ The transfer of copyright ownership never implies a transfer of an artist's § 106A rights, because those rights simply cannot be transferred.¹³⁷ Nor does copyright transfer constitute a waiver of rights under § 106A.¹³⁸ Thus, unless the artist expressly waives her VARA rights in a detailed, signed writing, she retains those rights for as long as she lives, even if she transfers ownership of the art object or assigns away her copyright in the work.¹³⁹ It follows that “a VARA claim may be brought by someone who doesn't own the copyright.”¹⁴⁰

134. A California state public records request, No. R000742-111118, submitted to Caltrans Nov. 11, 2018, and answered Jan. 8, 2019, provided little new information about the motives behind the policy change. See e-mail from La Verna Santillano, Assoc. Governmental Program Analyst, Div. of Project Mgmt., Cal. Dep't of Transp., to author (Jan. 8, 2019, 18:54 EST) (on file with author).

135. See *supra* text accompanying notes 119–127.

136. 17 U.S.C. § 106A(a) (2017).

137. 17 U.S.C. § 106A(e)(1) (2017).

138. 17 U.S.C. § 106A(e)(2) (2017).

139. *Kelley v. Chi. Park Dist.*, 635 F.3d 290, 300 (7th Cir. 2011).

140. *Kammeyer v. Oneida Total Integrated Enter.*, 15-869-JGB, 2015 WL 5031959 at *5 (C.D. Cal.

So the Transportation Art Policy, which by its terms doesn't require the artist to waive her moral rights, does little to prevent her from asserting her right of integrity if her work is damaged or destroyed. Granted, the PDPM does not provide exact language for the "copyright assignment and transfer agreement" it contemplates, so actual executed contracts may very well include express moral rights waivers compliant with § 106A. Even so, the failure to mention moral rights creates an odd disconnect between the requirements laid out in the Transportation Art Policy and this presumptive goal.

Next, recall Caltrans' position that the new policy empowers it to fix damaged works of transportation art—and, apparently, to escape liability if its "fix" violates the artist's right of integrity. Overlooking for the moment that the Transportation Art Policy saddles local public agencies, not the state, with the responsibility for maintaining and restoring transportation artwork, the risk of liability under VARA for maintenance activities is relatively low. Successful reported VARA claims are, historically, somewhat rare; on the whole, courts have been reluctant to privilege artist-plaintiffs' moral rights over defendants' property rights.¹⁴¹ But even if cases like *Cohen* suggest a renewed judicial openness to enforcing artists' rights, VARA already contains explicit exceptions related to routine maintenance.¹⁴² For example, if during the course of repairing the Super Heroes Project mural, Caltrans modified it in a way that the artists considered a violation of their integrity rights, Caltrans could not be liable absent gross negligence.

Finally, the outcome of the *Romero* litigation confirms that the state can take shelter from many VARA claims under the Eleventh Amendment.¹⁴³ That Amendment bars lawsuits by a plaintiff against a state, unless the state consents to suit or Congress has abrogated the state's sovereign immunity pursuant to a valid exercise of its Fourteenth Amendment enforcement powers.¹⁴⁴ The Copyright Remedy Clarification Act ("CRCA"), enacted in 1990, purports to abrogate state sovereign immunity with respect to claims brought under Title 17 of the U.S. Code, which includes VARA.¹⁴⁵ However, the CRCA is presumptively invalid following the Supreme Court's 1999 decision in *Florida Prepaid Postsecondary Educ. Expense Bd. v. College Sav. Bank*, which struck down the parallel Patent and Plant Variety

Aug. 24, 2015).

141. David E. Shipley, *The Empty Promise of VARA: The Restrictive Application of a Narrow Statute*, 83 MISS L.J. 985, 989 (2014).

142. Under § 106A(c), the modification of a work of visual art as a result of "conservation, or of the public presentation, including . . . placement, of the work" is not recognized as an actionable "destruction" of the work, unless the modification happens as a result of gross negligence. 17 U.S.C. § 106A(c)(2) (2017).

143. *Romero v. Cal. Dep't of Transp.*, No. CV 08–8047, 2009 WL 650629 at *5 (C.D. Cal. March 12, 2009).

144. See Sue Ganske Graziano & Don Boren, *Suing States for Copyright Infringement—An Eleventh Amendment Bar?*, 15 J.C. & U.L. 269, 270–71 (1989).

145. 17 U.S.C. § 511(a) (2017) ("Any State . . . shall not be immune, under the Eleventh Amendment of the Constitution of the United States or under any other doctrine of sovereign immunity, from suit in Federal court by any person . . . for a violation of any of the exclusive rights of a copyright owner provided by [Title 17].").

Protection Remedy Clarification Act.¹⁴⁶ As of this writing, the Supreme Court has not explicitly ruled on whether the CRCA is a valid abrogation of state sovereign immunity,¹⁴⁷ but the courts that have considered the issue after *Florida Prepaid*—including the *Romero* court—have assumed that it is not.¹⁴⁸ As a result, states almost certainly cannot be held liable for damages under federal copyright law, including for violations of VARA. An artist could proceed with a suit against state officials in their official capacities only to obtain prospective injunctive relief from an ongoing violation of the law.¹⁴⁹

Thus, the cases where the state could conceivably need additional protection from liability for violating VARA's integrity rights, beyond what the statute and the Eleventh Amendment already offer, are limited to instances where all of the following conditions are true: (1) the state, rather than a local agency, acts (or proposes to act) upon the artwork in a manner that could cause a violation of the right of integrity;¹⁵⁰ (2) the purported violation occurs (or will occur) either as a result of activity other than "conservation" or "public presentation," or through gross negligence;¹⁵¹ and (3) the remedy the artist seeks is injunctive and prospective rather than monetary, which would normally require the artist to have advance notice of the impending violation. This limited universe of possible claims suggests the state's response to the prospect of liability is excessive.¹⁵²

Since the Transportation Art Policy does not clearly fit a goal of avoiding moral rights liability, one might surmise that the policy better serves the other possible objectives discussed above in Part II.A. Yet Caltrans' requirement of copyright transfer isn't a satisfying answer to those concerns, either.

If the Transportation Art Policy is meant to prevent artists from taking legal action against the state for the unauthorized reproduction of a work of transportation art (or

146. 527 U.S. 627, 630 (1999) (finding that the Patent and Plant Variety Protection Remedy Clarification Act, which expressly abrogated state sovereign immunity from claims of patent infringement, could not "be sustained as legislation enacted to enforce the guarantees of the Fourteenth Amendment's Due Process Clause" and was thus invalid under the Eleventh Amendment).

147. Debra Oakes, *Validity, Construction, and Application of Copyright Remedy Clarification Act*, 60 A.L.R. FED. 2D 625 § 2 (2011). The Supreme Court is poised to settle the issue this term. See *Allen v. Cooper*, 139 S. Ct. 2664, 2664 (2019) (granting certiorari in a recent Fourth Circuit case involving the validity of the CRCA as an abrogation of state sovereign immunity).

148. See, e.g., *Romero*, 2009 WL 650629 at *5; accord *Allen v. Cooper*, 895 F.3d 337, 353–54 (4th Cir. 2018); *Chavez v. Arte Publico Press*, 204 F.3d 601, 607–08 (5th Cir. 2000); *Scott v. Cal. African Am. Museum*, CV 14-02273-AB, 2015 WL 12806471 at *3 (C.D. Cal. July 24, 2015); *Mktg. Info. Masters, Inc. v. Bd. of Trs. of Cal. State Univ. Sys.*, 552 F. Supp. 2d 1088, 1094–95 (S.D. Cal. 2008).

149. See *Ex parte Young*, 209 U.S. 123 (1908).

150. While local public agencies are responsible for the maintenance and removal of transportation art, the PDPM states that Caltrans may perform maintenance if a public agency fails to fulfill its responsibility and "reserves the right to immediately remove or alter transportation art due to emergency, construction, restoration, or other necessary activities affecting the transportation facility." CAL. DEP'T OF TRANSP., *Landscape Architecture*, *supra* note 5, at 29-85.

151. 17 U.S.C. § 106A(e)(2) (2017).

152. I note that artists could also have VARA claims against the state related to the rights of attribution—if, for example, the state failed to credit an artist as the author of the work. See 17 U.S.C. § 106A(a)(1)(A) (2017). This would not seem to be a major concern for Caltrans, particularly given that the PDPM expressly permits transportation art to include the "name, identifying logo, or symbol of the artist" on or near the artwork. CAL. DEP'T OF TRANSP., *Landscape Architecture*, *supra* note 5, at 29-79.

for the infringement of another § 106 right), requiring a transfer of copyright ownership is unnecessary. For one thing, as with *Romero*-style VARA claims, the Eleventh Amendment protects the state from damages liability for infringement, since no constitutionally valid abrogation of sovereign immunity exposes states to suits seeking damages under federal copyright law.¹⁵³ That fact alone substantially limits the extent to which the state need be concerned about infringement liability. Of course, nothing bars a copyright owner with a valid cause of action from seeking injunctive relief against a state, so Caltrans could still face legal consequences for unauthorized reproduction or other use of a copyrighted work of art. Even so, requiring the creator of a work of transportation art to assign away her copyright is a clumsy, overbroad measure that gives the state more than it reasonably needs. Caltrans could easily protect its ability to use and reproduce the work for public purposes by permitting the artist to keep the copyright but obtaining from her a nonexclusive, royalty-free license for the uses it anticipates.¹⁵⁴ Since such alternative, workable methods exist to ensure the state avoids infringing the copyright in a work of transportation art, a blanket copyright transfer should not be required in order for the state to escape potential injunctions.

It should also not be required for the state to sue third-party infringers. While a “legal or beneficial” ownership interest in a copyright imparts standing to institute an action for infringement,¹⁵⁵ this hardly means that the state must be the sole owner of the entire copyright. Owners or exclusive licensees of individual § 106 rights, or sub-rights, are entitled to bring suit to enforce those particular rights, so a partial ownership interest in the copyright would suffice.¹⁵⁶ An artist may also agree to allow a state to file suit in her name, even if the state cannot claim an ownership interest and thus would not have standing otherwise.¹⁵⁷

Separately, it is worth questioning the merits of allowing the state exclusive control over the enforcement of copyright against third-party infringers. While it’s true that many artists lack the financial resources to bring infringement lawsuits—implying that the state is in a better position to enforce the copyright—artists also normally have a more compelling interest in enforcement in the first place.¹⁵⁸ Given this distribution of incentives and resources, it is not clear that there is a net benefit to giving the state sole control over infringement suits to the exclusion of the artist.¹⁵⁹

153. See *supra* notes 145–149 and accompanying text.

154. Americans for the Arts recommends this general approach to public art commissions, and many states have adopted it in their own public art programs. See *infra* Part III.B.1 (discussing the merits of nonexclusively licensing IP rights to state entities that acquire public art).

155. 17 U.S.C. § 501(b) (2017).

156. See *Silvers v. Sony Pictures Entm’t, Inc.*, 402 F.3d 881, 884–85 (9th Cir. 2005).

157. This is a common practice for performing rights organizations (“PROs”), which nonexclusively license public performance rights from their members yet are authorized to control enforcement actions. See *infra* notes 206–210 and accompanying text.

158. 6 LINDEY ON ENTERTAINMENT, *supra* note 131, § 16:94, annotation to Article 6.

159. Note that, even after transferring legal ownership of her copyright to the state, an artist could still claim standing to enforce the copyright if she is determined to have a sufficient “beneficial interest.” A beneficial interest might exist if, for example, there is an agreement that the artist has a right to receive royalty payments after the transfer, as was the case in *Cortner v. Israel*, 732 F.2d 267, 270–71 (2d Cir. 1984).

Finally, it is not clear that assigning the copyright to the state is the only effective way to ensure the continued distinctiveness of a work of art. A state can secure reasonably limited guarantees of an artwork's exclusivity by contract even as the artist retains the vast majority of the rights associated with her copyright in the work. For example, the New York Bar Association's model agreement for public art commissions includes a simple provision aimed at protecting the work's distinctiveness: "In view of the intention that the Work in its final dimension shall be unique, the Artist shall not make any additional exact duplicate, [three]-dimensional reproductions of the final Work, nor shall the Artist grant permission to others to do so except with the written permission of" the commissioning entity.¹⁶⁰ Since this type of provision is commonplace in art commission contracts, it's likely that an artist who creates a work of transportation art in California will have already made a guarantee of uniqueness to the local public agency that commissioned it. The template contract used by the San Francisco Art Commission, for example, includes a paragraph whereby the "Artist warrants that the design of the Artwork . . . is an edition of one, and that neither Artist nor Artist's agents will execute or authorize another to execute another work of the same or substantially similar image, design, dimensions and materials as the Artwork."¹⁶¹ So, if the City and County of San Francisco—or another local agency with a similar standard contract—commissions and provides a work of transportation art, there would be no need for Caltrans to do anything more to ensure that the artist does not replicate the work.

2. The Policy Is Likely to Harm Artists, Local Agencies, and the Public

For the reasons discussed above, the Transportation Art Policy is not well tailored to the objectives at which it appears to be aimed. But its mismatch to its presumptive goals is not the policy's only flaw. Caltrans' demand that an artist transfer ownership of her copyright to the state also introduces affirmative harms into a policy that purports to balance "aesthetic . . . and community values" with the department's transportation goals.¹⁶² The parties who are likely to feel the negative effects of the copyright transfer requirement include the artists who create transportation art, the local agencies who commission it, and the members of the public who benefit from it.

a. Artists

First, the current Transportation Art Policy prevents artists who create works of

160. 6 LINDEY ON ENTERTAINMENT, *supra* note 131, § 16.94 at ¶ 6.1 (alteration in original).

161. San Francisco Arts Commission Public Art Template Contract, S.F. ARTS COMM'N § 27A(g), <https://perma.cc/24QT-2TWT> (last visited Feb. 28, 2019). *See also* Los Angeles County Civic Art Fabrication Installation Contract, LA COUNTY ARTS COMM'N § 7.19.6, <https://perma.cc/59Y7-5DL9> (last visited Feb. 28, 2019) ("The ARTIST represents and warrants to the COUNTY that the Artwork is unique and an edition of one . . . and that the ARTIST will not execute or authorize another to execute another work of art of the same theme and/or design, dimensions, and/or materials as the Artwork commissioned pursuant to this Agreement.").

162. CAL. DEP'T OF TRANSP., *Landscape Architecture*, *supra* note 5, at 29-7.

transportation art from reaping many of the economic rewards of their work beyond a commission fee, which may not itself be especially lucrative.¹⁶³ As Alexander Lindey notes, selling mock-ups, sketches, or other documents of an artist's process "often provides an essential source of income" for that artist.¹⁶⁴ But if an artist who paints a mural beside a state highway wishes to, say, make her preliminary sketches available for sale, assigning the copyright in her design to Caltrans could prevent her from doing so. Likewise, after transferring copyright ownership to Caltrans, the artist would technically need to license her own creation back to reproduce it, even in two dimensions for promotional or similarly limited purposes. Because the fee paid to an artist for a typical commission is often not enough to compensate her for the reproduction rights as well as the physical art object, Lindey points out that when a commissioning entity is considering how to treat copyright, a "blanket transfer . . . would give the commissioning body more than it reasonably needs and, more importantly, probably more than it has paid for."¹⁶⁵ In the case of Caltrans, which does not itself commission works of transportation art or compensate artists, the problem Lindey identifies is compounded; the copyright transfer requirement certainly gives Caltrans "more than it has paid for," since it has paid nothing.

The copyright transfer requirement could also impact an artist's career beyond the immediate limitations it places on how the artist can exploit a specific work of transportation art. Just as an artist would, strictly speaking, need to license the work back in order to reproduce it, she would also have to get permission to make any derivative work. That, in turn, could hinder the artist's creative development, since artists may reuse or build upon previous work in creating an oeuvre. To be sure, it's not clear that an artist would in practice face any real threat of infringement liability for creating a subsequent work similar to a work which she had authored, but in which she no longer owned the copyright. An instructive case on this issue is *Fantasy, Inc. v. Fogerty*, involving an unsuccessful suit against singer-songwriter John Fogerty by his former record company, the assignee of his copyright in his 1970 song "Run Through the Jungle."¹⁶⁶ Fantasy claimed that the song "The Old Man Down the Road," which Fogerty wrote in 1984, infringed the copyright it owned in "Run Through the Jungle."¹⁶⁷ Fogerty's expert witnesses argued at trial that any similarities between the two songs were nothing more than characteristics of the songwriter's style, and the court entered judgment for Fogerty following a favorable jury verdict.¹⁶⁸ Yet the fact that the *Fogerty* case was allowed to proceed to trial at all, despite that Fogerty was indisputably the original author of the copyright in "Run Through the Jungle," demonstrates that such suits could represent a real risk for the artist who assigns away her copyright. If a visual artist transfers her copyright in a work of transportation art to Caltrans, and then proceeds to create substantially similar work—even though she may view it as part of the natural development of her

163. 6 LINDEY ON ENTERTAINMENT, *supra* note 131, § 16:94, annotation to Article 6.

164. *Id.* § 16:94, annotation to Article 1.

165. *Id.* § 16:94, annotation to Article 6.

166. 654 F. Supp. 1129, 1130 (N.D. Cal. 1987).

167. *Id.*

168. *Fantasy, Inc. v. Fogerty*, 38 T.D. 10677, 1988 WL 1097031 (N.D. Cal. 1988).

artistic language—she could be vulnerable to suit for copyright infringement.¹⁶⁹

Some California artists have recognized as much, and one artist commissioned to create a work of transportation art since the 2016 update to the Transportation Art Policy has publicly expressed dismay at the policy’s potential consequences for artists’ careers. Troy Corliss, a sculptor who works in glass and metal, created a piece that was selected by the public in 2015 for installation in a Kings Beach traffic circle.¹⁷⁰ But Corliss, unwilling to give up his copyright in the work, backed out of the commission when he learned of Caltrans’ assignment and transfer requirement.¹⁷¹ By Corliss’ estimation, this was the first time in his twenty-six years of making large-scale public art pieces that he had been required to surrender the copyright in one of his designs.¹⁷² “Removing a design from the artist’s vocabulary will effectively halt the development of that body of artwork,” Corliss said in a 2018 interview. “Most established artists won’t even consider a project that asks them to give up their design because of the impact it could have on their career.”¹⁷³

Corliss, a self-identified “established artist,” felt at liberty to walk away from the Kings Beach project when presented with contract terms with which he wasn’t comfortable. It is important to note, however, that many artists—particularly those who are less “established” and for whom the opportunity to create a highly visible work of public art is unique—may not believe they have a choice but to accept Caltrans’ demands. Working artists already occupy a weak bargaining position relative to the state, and compelling them to either assign away their rights in their work or give up a valuable business opportunity puts them at an even greater disadvantage.¹⁷⁴

b. Local Agencies

It isn’t only artists who are likely to be negatively affected by Caltrans’ 2016 changes to the Transportation Art Policy. The local agencies to which Caltrans assigns responsibility for providing transportation art will also bear certain costs, and municipal arts councils have already taken notice.¹⁷⁵ While these agencies are likely

169. *But see* Schiller & Schmidt, Inc. v. Nordisco Corp., 969 F.2d 410, 414 (7th Cir. 1992) (Posner, J.) (indicating in dictum that an artist whose works look similar because they share the artist’s style, rather than because the artist actually copied an earlier work in a later work, should not be considered to be infringing). Of course, if courts generally accept Judge Posner’s view, it would further weaken any argument by the state that copyright transfer is the best way to ensure an artwork’s continued distinctiveness, since artists could continue to make stylistically similar works even without owning the copyright.

170. Kara Fox, *Public Art, in a Roundabout Way*, MOONSHINE INK (Sept. 13, 2018), <https://perma.cc/X6SS-B7ZH>.

171. *Id.*

172. *Id.*

173. *Id.*

174. This point parallels Julie Katzman’s observation that, historically, freelance artists’ weak bargaining position was further enervated by the compelled transformation of commissioned works into works for hire. *See* Katzman, *supra* note 31, at 875.

175. *See, e.g.*, City of San Jose Public Art Committee, Regular Meeting Minutes, CITY OF SAN JOSE (Aug. 1, 2017), <https://perma.cc/7KX5-DW3P> (noting “the issue around copyrights on artworks located on CalTrans property” would “impact public art statewide”).

accustomed to negotiating the terms of art commissions, the Transportation Art Policy effectively requires them to ensure that the artists they select for transportation projects are also willing to accept Caltrans' conditions. This could result in higher bargaining costs for local agencies wishing to commission art for state highways—which can be among the most prominent thoroughfares that traverse their jurisdictions.¹⁷⁶ Local agencies may find it difficult to find artists of a certain stature who are willing to comply with the transfer requirement, which would limit their options for acquiring high-quality artwork. Alternatively, the policy could force local agencies to increase the commission fees they pay to artists, in order to attempt to compensate them for the loss of their copyright.¹⁷⁷ Finally, if the state owns the copyright in a work of public art commissioned by a municipality, that municipality would need to negotiate its own agreement with Caltrans to license any promotional or other uses of the very work it had commissioned. Overall, the Transportation Art Policy could cause local agencies to reconsider whether the benefits of public art are worth these costs.

c. The Public

In the end, the adverse consequences of the Transportation Art Policy's requirement of copyright transfer fall upon the public at large. By overly burdening artists and making local agencies think twice about the costs of soliciting public works of art, the Transportation Art Policy may inadvertently deprive California's residents and visitors of the many known benefits of public art. Public art is a well-recognized means of beautifying shared spaces, fostering community identity and strengthening communal values, encouraging economic development, improving civic participation, and generally enhancing a population's quality of life.¹⁷⁸

In addition to these general benefits, public art has a special role to play in the transportation sector. It can serve as a vehicle for "creative placemaking," a process which uses arts and culture to enhance public engagement in the development of transportation projects, especially among populations that don't often have the

176. For example, Caltrans has jurisdiction over San Francisco's Van Ness Avenue, one of the city's busiest north-south corridors which connects the Golden Gate Bridge with I-80 and I-280 and passes directly through the city's historic Civic Center. See *Van Ness Improvement Project*, S.F. METROPOLITAN TRANSIT AUTHORITY, <https://perma.cc/6L7Y-UW9Y> (last visited Jan. 25, 2019). The City and County of San Francisco commissioned a sculptural lighting installation for a rapid transit project on Van Ness Avenue before the 2016 Transportation Art Policy updates. See *Arts Commission Unveils Van Ness Public Art Proposal*, S.F. METROPOLITAN TRANSIT AUTHORITY, <https://perma.cc/JD8D-TK8A> (last visited Mar. 1, 2019). In late 2018, the Executive Committee of the San Francisco Arts Commission reluctantly authorized a modification of the city's existing contract with the artist to accommodate the Caltrans copyright transfer agreement. San Francisco Arts Commission, Meeting Minutes of the Executive Committee, CITY & COUNTY OF S.F. (Oct. 22, 2018), <https://perma.cc/4523-ZHN7>.

177. See generally 6 LINDEY ON ENTERTAINMENT, *supra* note 131, § 16:94, annotation to Article 6. While the ability to command higher commission fees could be a boon to artists, cash-strapped arts councils wouldn't necessarily be able to afford them, and might simply choose to commission less art.

178. See generally Cathay Y.N. Smith, *Community Rights to Public Art*, 90 ST. JOHN'S L.R. 369, 381–83 (2016); NAT'L ASSEMBLY OF STATE ARTS AGENCIES, STATE POLICY BRIEFS: PERCENT FOR ART, 6–7 (2013), <https://perma.cc/42KF-9SQG>.

opportunity to participate, such as low-income or minority communities.¹⁷⁹ Public artwork and the process of selecting it can help address transportation-related challenges in a number of ways, including by engaging multiple local stakeholders, fostering community ownership of a transportation project, and helping to heal divisions created by transportation infrastructure, such as urban highways.¹⁸⁰

Caltrans is apparently cognizant of these benefits; the PDPM states that Caltrans “recognizes the effects of transportation facilities on local communities and encourages integrating these facilities with their surroundings to enhance and reflect the aesthetic, environmental, scenic, and cultural values of the affected community.”¹⁸¹ Transportation art, Caltrans seems to acknowledge, can be a way to counter the potentially disruptive effects of highway development and to give a community a sense of ownership in transportation infrastructure. But the harsher Caltrans’ terms are on artists and the more difficult it becomes for municipalities to commission artwork in line with those terms, the less likely it is that the community will be able to enjoy the benefits of transportation art. Recall, for example, the West Oakland schoolchildren who, by participating in artist-led mural projects, had the chance to reclaim and beautify their blighted neighborhood—until the new Transportation Art Policy intervened.

III. ALTERNATIVES TO THE TRANSPORTATION ART POLICY

It should be evident that the Transportation Art Policy is not a satisfying procedure for administering IP rights in public art. But the foregoing analysis demands an assessment of how Caltrans could address its presumed concerns about liability and control over the artwork more effectively, and in a way that doesn’t overburden the artists and local agencies with whom the state partners. A logical starting point for that inquiry is a survey of other jurisdictions’ policies around public art, to understand how government entities other than Caltrans have handled similar concerns about liability and the allocation of IP rights. Examining other policies also helps to illuminate the rights and protections that a state wishing to acquire public art reasonably needs.

A. COPYRIGHT IN PERCENT-FOR-ART PROGRAMS

Currently, Caltrans is fairly unique among state transportation departments in maintaining a specific, public-facing procedure for allocating rights in transportation art.¹⁸² However, we can understand how other states have addressed IP rights in public art more generally by considering the policies they implement in percent-for-art programs.¹⁸³ Under most such programs, the state or a particular state agency

179. TRANSP. FOR AM., ARTS, CULTURE AND TRANSPORTATION: A CREATIVE PLACEMAKING FIELD SCAN 6 (2017), <https://perma.cc/N2K8-N6HU>.

180. *Id.* at 8.

181. CAL. DEP’T OF TRANSP., *Landscape Architecture*, *supra* note 5, at 29-78.

182. However, Alaska’s Department of Transportation administers that state’s Art Works in Public Buildings and Facilities program alongside the Alaska State Council on the Arts. *See infra* note 187.

183. Percent-for-art programs, which are created by statute or regulation, require or recommend that

will own any tangible art object acquired, but state policies regarding ownership of the copyright vary.¹⁸⁴ Some states do not publicly specify a default arrangement for IP rights in the artwork and presumably leave the issue to individual contracts. Of the states that do have a standard policy regarding copyright ownership, most allow artists to retain their economic rights under the Copyright Act. These include Rhode Island, which reserves copyright to the artist by statute;¹⁸⁵ Oregon and Florida, which accomplish the same through relevant regulations;¹⁸⁶ and Maine, Hawai'i, and Alaska, which maintain model contracts that allow the artist to retain copyright.¹⁸⁷ One exception to this general pattern of artist-retained copyright is Illinois' Art in Architecture program, which by a standard contract requires artists of works acquired for the program to transfer their copyright to the state; however, the artist does reserve certain rights of reproduction and may petition the state's Capital Development Board for the right to use the copyright.¹⁸⁸

Given Caltrans' copyright transfer requirement for transportation art, it may be surprising that California is among the states whose formal public art initiative has actually reserved IP rights for the artist. The California Art in Public Buildings Act, enacted in 1976, provides that the creator of a work of art acquired for a state building pursuant to the Act retains "the right to reproduce [the] work of art, including all rights to which the work of art may be subject under copyright laws."¹⁸⁹ While the Act does allow for the artist's reproduction rights to be "limited by written

a certain portion of the budget for the construction or renovation of state facilities be earmarked for public artwork. NAT'L ASSEMBLY OF STATE ARTS AGENCIES, STATE POLICY BRIEFS: PERCENT FOR ART 1 (2013), <https://perma.cc/42KF-9SQG>.

184. *Id.* at 5.

185. R.I. STATUTES § 42-75.2-8 (artist retains right to reproduce artwork, "including all rights to which the work of art may be subject under copyright laws," except that she does not retain the exclusive right to display the work publicly, nor the right to "prevent degradation, mutilation, or aesthetic ruining of the work").

186. Ore. Business Dev. Dep. Rule 123-475-0050(4)(g) (artist "retains those rights specified in ORS 359.355," *i.e.* the right of reproduction); Fla. Admin. Code Rule 1T-1.033 (artist "maintains all rights to render drawings or photographs of the work, with the exception that the State may reproduce faithful images of the work for non-commercial use" with attribution).

187. ME. STATE COMM'N ON THE ARTS & HUMANITIES, THE PERCENT FOR ART HANDBOOK: A GUIDE FOR SELECTING PUBLIC ART THROUGH MAINE'S PERCENT FOR ART LAW 69 (1984), <https://perma.cc/JV9C-X6VT> (artist expressly reserves all rights under the Copyright Act, but "shall not unreasonably refuse the contracting agency and/or [Maine Arts] Commission permission to reproduce the Work graphically for purposes strictly for the sole use and benefit of the public"); HAW. STATE FOUND. ON CULTURE & THE ARTS, NON-EXCLUSIVE LICENSE TO USE WORK OF ART, <https://perma.cc/A8AL-KLGQ> (last accessed Jan. 25, 2019) (artist or copyright holder agrees to a "non-exclusive license, which does not transfer ownership of [her] copyright to the HSFC"); STATE OF ALASKA DEP'T OF TRANSP. & PUB. FACILITIES, POLICY & PROCEDURE NO. 05.02.010, PROCUREMENT OF ARTWORK FOR PUBLIC BUILDINGS AND FACILITIES (2002), <https://perma.cc/XEA4-Y5M4> (artist keeps copyright, granting State the rights to "make and distribute derivative expressions of the work of art limited to photographs for documentary and archival purposes and for publication in articles of information about [the Alaska State Council on the Arts], the work of art, and the artist").

188. STATE OF ILL. CAPITAL DEV. BD., GENERAL CONDITIONS OF CONTRACT § 2(F)(2)-(3) (2012), <https://perma.cc/6B46-KK69>.

189. CAL. GOV. CODE § 15813.5(a)(2) (West, Westlaw through Ch. 860 of 2019 Reg. Sess.). For a model commission agreement under this statute, see 6 LINDEY ON ENTERTAINMENT, *supra* note 131, § 16:95.

contract,”¹⁹⁰ it is telling that the California legislature has determined that the state should not normally need to own copyright in the works of public art it acquires. That the legislature found this attribution of rights sufficient for the state’s purposes makes it even more troubling that Caltrans has implemented a mandatory procedure that goes considerably further.

Municipalities that maintain percent-for-art or similar initiatives take varying approaches to copyright. One might expect copyright transfer requirements to be more prevalent at the municipal level than at the state level, since cities and towns cannot shelter under Eleventh Amendment immunity as states can.¹⁹¹ For instance, the city of Salem, Oregon, requires artists of works acquired by the city to assign away their copyrights, though the ordinance also expressly provides that an artist retains a nonexclusive right to reproduce the work “for professional advertisement and promotional purposes.”¹⁹² But other major cities’ policies permit artists to keep their copyrights. New York City’s Department of Transportation (“DOT”) partners with community nonprofits and the city’s Department of Cultural Affairs to commission and present public art on DOT property; the legal agreement an artist signs with DOT provides that the artist retains copyright.¹⁹³ Likewise, under the San Francisco Art Commission’s standard contract for artwork commissions, an artist “shall retain all 17 U.S.C. § 106 copyrights in all original works of authorship.”¹⁹⁴

In addition to these state and municipal programs, there is also a percent-for-art analogue at the federal level: the Art in Architecture Program, through which the General Services Administration (“GSA”) commissions artists to create permanent works of public art for federal buildings nationwide. According to the GSA’s Fine Arts Policies and Procedures, contractual terms may vary on a case-by-case basis, but most artists hired to produce work for Art in Architecture retain copyright.¹⁹⁵

B. RETHINKING THE TRANSPORTATION ART POLICY

With a few limited exceptions, then, Caltrans’ Transportation Art Policy is an isolated approach to the potential liabilities inherent in owning tangible public art pieces. Given the policy’s misalignment with its presumptive objectives—compounded by the additional burdens it places on artists, local agencies, and the public—it is important that similar guidelines do not take hold in other jurisdictions. But what alternatives are available to state agencies who may be looking for greater security against artist litigation, or just increased clarity around the allocation of IP rights in public art? What procedure should replace the Transportation Art Policy in California, keeping in mind that the fundamental goal of copyright law is to

190. CAL. GOV. CODE § 15813.5(a)(2) (West, Westlaw through Ch. 860 of 2019 Reg. Sess.).

191. *See, e.g.*, *Hess v. Port Authority Trans-Hudson Corp.*, 513 U.S. 30, 47 (1994).

192. SALEM REVISED CODE § 15.050(a).

193. *DOT Art & Event Programming: Frequently Asked Questions, Resources, and Tips*, N.Y.C. DEP’T OF TRANSP., <https://perma.cc/FM4T-GTFZ> (last visited Jan. 25, 2019).

194. San Francisco Arts Commission Public Art Template Contract, *supra* note 161, § 27A(a).

195. GEN. SERVICES ADMIN., FINE ARTS POLICIES AND PROCEDURES 81 (2017), <https://perma.cc/7P9J-95PL>.

“stimulate artistic creativity for the general public good”¹⁹⁶

I argue that the best way to balance all parties’ interests is by leaving copyright with the artist, provided she agrees to grant the state a nonexclusive license to reproduce the work of public art. There’s a good reason this is the approach reflected in many states’ percent-for-art policies: It is the arrangement most likely to give a state the protections it reasonably requires while permitting artists to continue to exploit their own designs. In Part III.B.2, I also consider other potential solutions to the issues underlying policies like the Transportation Art Policy. Specifically, I address the possibility of co-ownership arrangements in which the artist and state each have a partial interest in the work’s copyright, as well as legislative responses to the larger uncertainties that persist in the law of public art. Ultimately, though, none of these alternatives is as practicable or well-tailored as changing the state’s default contractual terms to allow the artist to retain copyright conditional upon a nonexclusive license.

1. Striking the Right Balance Through Nonexclusive Licensing

Caltrans’ adoption of the Transportation Art Policy is troubling not only because the new policy is deeply flawed, but also because the approach it supplanted had already struck the appropriate balance between the state’s and artists’ interests. Before 2016, Caltrans’ stated policy toward IP rights in transportation art was that “any copyright claimed by the artist may be retained by the artist, provided consent is granted to the Department to reproduce artwork for promotional purposes.”¹⁹⁷ Moving away from a practice of allowing the artist to keep her copyright, subject to a limited, nonexclusive license of certain reproduction rights, puts Caltrans out of step with most other states’ approaches to copyright in public art.¹⁹⁸ The shift even diverges from California’s own public policy, as expressed in the Art in Public Buildings Act.¹⁹⁹ What underlies these other policies is a recognition that the rights captured in a nonexclusive license offer plenty of protection for state interests even as they preserve artists’ ability to fully exploit their work.

Ultimately, a standard contract that reserves copyright to the artist, but grants a nonexclusive license to the state for specific purposes, is the best way to address the concerns motivating the Transportation Art Policy without excessively burdening artists, local agencies, or the public. This general approach is not controversial: In addition to being a dominant practice in state and municipal percent-for-art programs, nonexclusive licensing is the approach advanced by the nonprofit arts advocacy organization Americans for the Arts, which maintains a set of best practices around public art commissions. With respect to IP rights, the organization recommends that “[a]rtists should retain copyright to their Artwork. However, Artists should expect to grant license to the contracting agency or ultimate owner for

196. *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975).

197. Memorandum from Dolores Vallis, Acting Chief, Div. of Design, Cal. Dep’t of Transp. (Aug. 5, 2003), <https://perma.cc/LET9-7EGJ>.

198. *See supra* notes 185–187 and accompanying text.

199. *See supra* note 189 and accompanying text.

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reasonable use of images of the Artwork for publicity, educational, and reasonable promotional purposes upon which the parties agree.”²⁰⁰ Americans for the Arts’ model contract demonstrates one way this can work in practice; it provides that the artist “retains all rights under the Copyright Act of 1976 . . . as the sole author of the Artwork for the duration of the copyright,” but grants to the commissioning agency “an irrevocable license to make two-dimensional reproductions of the Artwork for non-commercial purposes.”²⁰¹ While a purportedly irrevocable nonexclusive license is still subject to the author’s termination right,²⁰² this basic language assures protection for at least thirty-five years against infringement liability for the main uses a state would want to make of the work.

A great advantage of nonexclusive licensing is that, while it squarely addresses a state agency’s interest in avoiding infringement-related disputes, it doesn’t give the state more than it reasonably needs. States are already likely to have Eleventh Amendment immunity from lawsuits where the plaintiff seeks damages under the federal copyright law,²⁰³ but a license would also shield a state from equitable actions. The main thing to recognize is that a state agency does not need to own exclusive rights in the work embodied in a tangible piece of public art in order to freely display it or to make copies for public purposes. If the state is the owner of the physical art object, it is automatically entitled to display the piece publicly, regardless of whether it owns the copyright or has a license from the artist.²⁰⁴ As for the reproduction right, a comparison of state percent-for-art policies indicates the subsets of that right which are likely to be most important for a state to secure. Generally, policies that reserve copyright to the artist nevertheless carve out the state’s ability to make two-dimensional reproductions of the work for noncommercial purposes. A representative example is Maine’s model percent-for-art contract, under which the artist retains copyright but “shall not unreasonably refuse the contracting agency and/or [Maine Arts] Commission permission to reproduce the Work graphically for purposes strictly for the sole use and benefit of the public.”²⁰⁵ This sort of language gives the state reasonable flexibility to make

200. Sarah Conley Odenkirk, 2016 PAN Council, *Proposed Best Practices for Public Art Projects* § 24, AMERICANS FOR THE ARTS (June 2016), <https://perma.cc/XVK8-HP8K>.

201. AMS. FOR THE ARTS, ANNOTATED MODEL PUBLIC ART COMMISSION AGREEMENT 17 (2005), <https://perma.cc/8AUY-35LC>.

202. 17 U.S.C. § 203(a)(5) (2017) (“Termination of the grant may be effected notwithstanding any agreement to the contrary.”).

203. See *supra* notes 143–149 and accompanying text.

204. 17 U.S.C. § 109(c) (2017) (“Notwithstanding the provisions of section 106(5), the owner of a particular copy lawfully made under this title, or any person authorized by such owner, is entitled, without the authority of the copyright owner, to display that copy publicly . . . to viewers present at the place where the copy is located.”).

205. ME. STATE COMM’N ON THE ARTS & HUMANITIES, *supra* note 187, at 69. See also Fla. Admin. Code Rule 1T-1.033 (state “may reproduce faithful images of the work for non-commercial use” with attribution); STATE OF ALASKA DEP’T OF TRANSP. & PUB. FACILITIES, *supra* note 187 (state may “make and distribute derivative expressions of the work of art limited to photographs for documentary and archival purposes and for publication in articles of information about [the Alaska State Council on the Arts], the work of art, and the artist”). Municipal public art contracts can also help to illuminate the scope of the license which a public agency can reasonably expect to secure; for example, San Francisco’s model contract includes a nonexclusive license allowing the city to “make and distribute . . . photographs and

promotional, documentary, and educational uses of the work that benefit the public, without taking excessive control from the artist.

In addition, allowing the artist to retain copyright subject to a nonexclusive license does not necessarily preclude a state from enforcing the copyright in the artist's name. It is true that the Copyright Act extends the right to bring an infringement suit only to "the legal and beneficial owner of an exclusive right under a copyright,"²⁰⁶ meaning that a nonexclusive licensee does not have standing to sue in its own name.²⁰⁷ However, the practices of performing rights organizations ("PROs") with respect to the rights they administer suggest that a state, even as a nonexclusive licensee, could take responsibility for an infringement action as a surrogate in the artist's name. Songwriters nonexclusively license their performance rights to a PRO, such as the American Society of Composers, Authors, and Publishers ("ASCAP") or Broadcast Music, Inc. ("BMI"), and authorize the PRO to enforce those rights, including by filing suit in the songwriters' names.²⁰⁸ This arrangement permits the PRO to relieve authors of the expenses of monitoring and enforcing their copyrights, even though it would not itself have standing.²⁰⁹ Likewise, a public art licensing agreement between a state agency like Caltrans and an artist could include a provision authorizing the state to sue third-party infringers in the artist's name. Of course, with the state as nonexclusive licensee, the artist could concurrently enforce her own rights if she so chose.²¹⁰ Under this model, the state benefits from the ability to protect the distinctiveness of the public art piece it owns, while an artist of limited means may benefit from having the state's resources brought to bear to enforce her copyright.

Other state interests that may have motivated the current Transportation Art Policy would not be directly addressed by a nonexclusive license, but additional contractual provisions could easily tackle them. Like the Transportation Art Policy, a nonexclusive license would not, by itself, address an artist's § 106A moral rights. It would also not inherently prevent the artist from later duplicating the commissioned work of art. Yet art commission contracts regularly solve these problems without requiring copyright transfer. If a state agency foresees needing more protection against moral rights liability than the Eleventh Amendment and

other 2-dimensional reproductions," which it may use "for any City-related purpose, including advertising, educational and promotional materials, brochures, books, flyers, postcards, print, broadcast, film, electronic and multimedia publicity, gifts for the [San Francisco Art Commission's] benefactors, documentation of City's Civic Art Collection, and catalogues or similar publications." San Francisco Arts Commission Public Art Template Contract, *supra* note 161, § 26A(b)(2).

206. 17 U.S.C. § 501(b) (2017).

207. *Sybersound Records, Inc. v. UAV Corp.*, 517 F.3d 1137, 1144 (9th Cir. 2008); *see also* 3 NIMMER ON COPYRIGHT, *supra* note 16, § 10.02[B][1].

208. *See, e.g.*, ASCAP Writer Member Agreement, AM. SOC'Y OF COMPOSERS, AUTHORS, & PUBLISHERS § 4, <https://perma.cc/4NVC-LPK4> (last visited Feb. 28, 2019); BMI Writer Agreement, BROAD. MUSIC, INC. § 15, https://www.bmi.com/forms/affiliation/bmi_writer_agreement_W800.pdf (last visited Feb. 28, 2019).

209. *Ocasek v. Heggglund*, 116 F.R.D. 154, 161 (D. Wyo. 1987) ("The very purpose of ASCAP is to relieve the copyright owner of the time-consuming and expensive task of enforcing his rights.").

210. *See id.* at n.2 ("Inasmuch as ASCAP's right is non-exclusive, the copyright owner may enforce his right concurrently with ASCAP.").

VARA's conservation and public presentation exceptions already offer, the agreement could include an express waiver of moral rights as against the state. Since this would be a significant concession on the artist's part, the state should, at a minimum, restore the artist's right to disclaim authorship if the work is damaged.²¹¹ The state should also agree to make reasonable efforts to notify the artist if it intends to significantly alter or remove the work and to give the artist the opportunity to recover it herself.²¹² To address the state's interest in maintaining the distinctive character of the artwork without affecting the artist's right to produce derivative works, the contract might also specify that the artist may not make, or authorize others to make, exact duplicates without the state's permission.²¹³ Thus, insofar as it provides reasonable safeguards for the state's interests, nonexclusive licensing is about equally effective as the Transportation Art Policy's copyright transfer requirement, especially when combined with the supplemental provisions described.

Just as importantly, leaving copyright ownership with the artist better comports with the interests of the other stakeholders in public art commissions. Above all, handling the allocation of IP rights by nonexclusive license is a much more artist-friendly approach than requiring artists to sign away their copyrights. Since the fee an artist receives for a public art commission may not be especially remunerative,²¹⁴ she has a particular interest in retaining her ability to fully exploit her copyright's economic value. With a nonexclusive licensing agreement, the artist can continue to make and sell reproductions that are not exact duplicates and grant nonexclusive licenses to third parties. She is also free to make derivative works, which may be of critical importance to artists who are developing a coherent style and body of work.²¹⁵ None of this would be possible with a wholesale assignment of copyright ownership, absent some sort of license-back provision. A nonexclusive licensing arrangement gives artists the maximum amount of control over how their work is exploited and the ability to fully enjoy the fruits.

The benefits of this type of arrangement would redound not just to artists, but also to local agencies. Admittedly, in cases where local agencies commission art that the state will ultimately own, the local agency will still be responsible for brokering a separate contract between the artist and the state, whether that contract involves a complete transfer or a nonexclusive license. Just as the current Transportation Art Policy requires the artist and local agency to provide the state with a copyright

211. Conley Odenkirk, *supra* note 200, § 29.

212. For examples of this type of moral rights waiver, see San Francisco Arts Commission Public Art Template Contract, *supra* note 161, § 22C; Los Angeles County Civic Art Fabrication Installation Contract, *supra* note 161, §§ 7.20.1, 7.21.3.4; 6 LINDEY ON ENTERTAINMENT, *supra* note 131, § 16:94, ¶ 7.4.(c).

213. See, e.g., AMS. FOR THE ARTS, *supra* note 201, § 7.4(a) ("In view of the intention that the final Artwork shall be unique, the Artist shall not make any additional exact duplicate, [three]-dimensional reproductions of the final Artwork, nor shall the Artist grant permission to others to do so except with the written permission of the [commissioning] Agency." (first alteration in original)). Note that in the case of Caltrans, the artist may already have made such a guarantee to the local agency which commissioned the work, so this provision may be superfluous. See *supra* note 161 and accompanying text.

214. 6 LINDEY ON ENTERTAINMENT, *supra* note 131, § 16:94, annotation to Article 6.

215. *Id.*

transfer agreement in addition to any contract the artist has with the commissioning agency, establishing a nonexclusive license between the artist and state would be an additional procedure that would likely fall to the commissioning agency to supervise. However, because nonexclusive licensing is a far more artist-friendly solution than an exclusive transfer, it should be less burdensome for local agencies to identify reputable artists willing to comply with the state's requirements.

Finally, allowing the artist to retain copyright ownership should contribute to greater proliferation of public art generally. Since this type of arrangement can benefit the state in many of the same ways as a procedure like the Transportation Art Policy does, while also offering much more palatable terms to artists, it should enable increased cooperation among the parties and diminish barriers to successful negotiation around public art. Without the requirement that the artist assign her copyright to the state, there ought to be one fewer obstacle to commissioning and installing art in public spaces—which makes it more likely that the state's residents and visitors will be able to enjoy the benefits of public art, from aesthetic improvement to economic development to community identity.

Because nonexclusive licensing both (1) addresses most of the concerns a state may have around the IP rights in commissioned public art and (2) is far more favorable to artists than a requirement of copyright transfer, this solution is ultimately the most consistent with the chief goal of copyright law: to encourage art-making for the public good. A nonexclusive license provides a state with reasonable protections against liability for infringement and can easily be coupled with a limited moral rights waiver, allowing the state to avoid potentially costly suits in equity. With its liability concerns minimized, the state should be in a better position to welcome increased art-making. At the same time, allowing artists to retain their copyright means they can continue to reap economic rewards beyond the commission fee (for example, by making reproductions and derivative works) without state interference. Since this arrangement is more likely to be economically worthwhile for artists than assigning away their copyright, it's also more likely to stimulate artistic creativity. Overall, artist-retained copyright—subject to a nonexclusive license and supplemental contract provisions that address the state's interests with specificity—is the solution most likely to balance the interests of all stakeholders in state-owned public art.

2. Other Contractual and Legislative Alternatives

a. Copyright Co-Ownership

A different way to allocate rights in public art might be to have the artist assign to the state an undivided share of the copyright in the work while retaining an undivided interest for herself, resulting in co-ownership of the copyright by the artist and state.²¹⁶ This type of arrangement could relieve the state of possible liability

216. This approach is not entirely unknown to the realm of public art: In the U.S. Register of Copyrights' survey of artists for her 1996 report on the implementation of VARA's waiver provision, at least one artist submitted a copy of a public art contract whereby he and the commissioning party had each

under federal copyright law and give the state enforcement authority over third-party infringers, while still allowing the artist to continue exploiting her economic rights in her work to a certain extent. Since the artist would retain partial control over the work, copyright co-ownership is a somewhat more artist-friendly solution than a full transfer of ownership and would have less of a chilling effect on the creation of public art. Ultimately, though, the promise of co-ownership as an alternative to policies like the Transportation Art Policy is diminished by both uncertainties in the law and the burdens co-owners can place on one another's exercise of rights.

There are several reasons a co-ownership arrangement could be an appealing alternative to a requirement of copyright transfer. First, copyright co-ownership by the artist and a state agency would absolve the state from any liability to the artist for infringing her § 106 rights. Joint ownership of a copyright is treated as a tenancy in common, meaning that each owner has an undivided share in the entire work.²¹⁷ Consequently, one co-owner of a copyright cannot be liable to another co-owner for infringement.²¹⁸ Co-ownership would thus give the state the same freedom to reproduce the work as it would have if the artist transferred her entire copyright, but without wiping out the artist's right to exploit the copyright and to maintain continuity in her body of work.

Second, co-ownership offers a way to balance the parties' respective incentives and resources to enforce the copyright against third-party infringers. Courts and commentators generally recognize that each joint owner of a copyright can obtain standing to sue infringers independently of the other owner or owners.²¹⁹ As a co-owner, the state would thus be in a position to enforce the copyright in a work of public art against third parties, just as if the copyright had been transferred to it wholesale. This could be a positive outcome for both state and artist, given that the state will likely be the party with greater economic resources to support litigation. At the same time, the artist—who may have stronger incentives to exclude third parties from the unauthorized use of her work—would also have the right to bring a lawsuit against an infringer. Thus, joint ownership of copyright in public art has the advantage of allowing both parties who might have an interest in enforcing the copyright to do so.

Third, a co-ownership arrangement would be friendlier to artists than a requirement that they sign away their entire copyright, since an artist would retain an

received 50 percent ownership of the copyright in the work. U.S. COPYRIGHT OFFICE, WAIVER OF MORAL RIGHTS IN VISUAL ARTWORKS, 176–77 (1996), <https://perma.cc/A4FL-M3ZV>. The artist, Rockne Krebs, had agreed in the same contract to waive his CAPA and VARA rights against the work's commissioner. *Id.* at 177.

217. 1 NIMMER ON COPYRIGHT, *supra* note 16, § 6.09; *see also* Sybersound Records, Inc. v. UAV Corp., 517 F.3d 1137, 1145 (9th Cir. 2008).

218. *See, e.g.*, Richmond v. Weiner, 353 F.2d 41, 42 (9th Cir. 1965).

219. *See, e.g.*, Davis v. Blige, 505 F.3d 90, 99 (2d Cir. 2007) (“[A] joint owner is not required to join his other co-owners in an action for infringement.”). While a court may require joinder of other co-owners at its discretion, *see infra* notes 227–228, Professor Nimmer argues that one co-owner may be treated as the “real party in interest” with respect to her own share of infringement-related damages, and should therefore be able to sue without joining the other co-owners. 3 NIMMER ON COPYRIGHT, *supra* note 16, § 12.03.

undivided interest in her copyright and could continue to reap economic benefits from her design beyond the original commission fee. This could include reproducing the work in order to promote it, selling any mock-ups or sketches she had retained, or creating derivative works—any of which she could do without her co-owner’s approval.²²⁰ The artist could also exploit the opportunity to license the work to third parties, since copyright co-owners may grant nonexclusive licenses independently of one another.²²¹

However, copyright co-ownership does not address all of the Transportation Art Policy’s presumed policy concerns. In particular, a co-ownership arrangement would exacerbate, rather than mitigate, state uncertainties around moral rights. Federal and state statutes provide little guidance as to the moral rights a co-owner may have against another co-owner, but it is unlikely that a co-owner that received its interest by transfer (rather than by co-authorship) would be able to unilaterally waive moral rights.²²² Thus, if a state desires protection against moral rights litigation beyond what the Eleventh Amendment already offers, a co-ownership agreement probably must be paired with an additional contractual provision that satisfies § 106A’s strict waiver requirements.²²³ This type of provision is not uncommon in art commission contracts,²²⁴ but it would not be inherent in or implied by a partial transfer. Furthermore, the lack of clarity around the treatment of moral rights in a jointly owned work is only one manifestation of the overall murkiness of the law surrounding copyright co-ownership. The dearth of statutory law on co-ownership in IP means that this arrangement is not a promising alternative to a policy that seems to be aimed fundamentally at resolving uncertainties around artists’ rights in favor of the state.²²⁵

220. See, e.g., *Oddo v. Ries*, 743 F.2d 630, 633 (9th Cir. 1984) (“[E]ach co-owner has an independent right to use or license the use of the copyright.”); *Weinstein v. Univ. of Illinois*, 811 F.2d 1091, 1095 (7th Cir. 1987) (“Each co-owner of a copyright may revise the work (that is, make a derivative work) and publish the original or the revision.”).

221. *McKay v. CBS Inc.*, 324 F.2d 762, 763 (2d Cir. 1963) (“[A] license from a co-holder of a copyright immunizes the licensee from liability to the other co-holder for copyright infringement.”).

222. To take the example of federally recognized moral rights under VARA: On the one hand, VARA permits unilateral waiver of the rights of attribution and integrity by any joint *author*. 17 U.S.C. § 106A(e)(1) (2017). That might suggest that joint owners can’t enforce those rights against one another, since internal consistency demands that VARA’s rules regarding “enforcement, waiver, and artist-versus-artist” conflicts not contradict one another. Peter H. Karlen, *Joint Ownership of Moral Rights*, 38 J. COPYRIGHT SOC’Y U.S.A. 242, 262 (1991). Keeping co-owners from enforcing § 106A rights against one another would also provide symmetry with the rule that one joint copyright owner cannot sue another for infringement. *Id.* at n.128. But it seems more likely that VARA’s allowance of a unilateral waiver of § 106A rights by a joint *author* does not extend to joint *owners* who obtained their ownership interest through transfer, rather than by coauthoring the work. Since the rights of attribution and integrity cannot be transferred, see *supra* notes 65–67 and accompanying text, the ability to *wave* those rights can hardly be transferred, either—and if a co-owner who was not an original author of the work cannot unilaterally waive VARA rights, the rationale for disallowing enforcement of those rights between co-owners all but disappears.

223. 17 U.S.C. § 106A(e)(2) (2017).

224. See, e.g., Scott Hodes, Roberta Rosenthal Kwall & Adine K. Varah, *Is That Lawn a Sculpture? What Every Museum Needs to Know About the Visual Artists Rights Act*, SL077 ALI-ABA 679, 685–86 (2006).

225. See Karlen, *supra* note 222, at 247. See generally Susan Scafidi, *Intellectual Property and*

Copyright co-ownership also amplifies the possibility that both the artist and the state could interfere with one another's capacities to exercise their rights. Co-owners may be required by state law to account to one another for any profits they each earn from the exploitation of the copyright,²²⁶ which would limit an artist's ability to profit from her work and could lead to accounting disputes between the parties. In addition, even though each co-owner probably has independent standing to bring an infringement suit, they will almost certainly have to provide notice to the other co-owner.²²⁷ Courts also have the discretion to require "any person having or claiming an interest in the copyright" to be joined as a plaintiff,²²⁸ which could create problems in cases where one co-owner wishes to enforce the copyright but the other does not. And even if joinder is not required, the plaintiff co-owner will still have an obligation to account to the other co-owner for any profits received in a settlement or award of damages.²²⁹

Overall, the appeal of co-ownership as an alternative to state policies like the Transportation Art Policy may be largely symbolic, in that rights-sharing between the artist and the state mirrors the unique moral investment a community may develop in public art.²³⁰ As a practical matter, however, copyright co-ownership is not an ideal solution. In assigning a coequal interest in her copyright to the state, an artist would give up a great deal of control over her work. That measure of control is more than the state reasonably needs, given existing Eleventh Amendment protections and—importantly—the proven efficacy of nonexclusive licensing.

b. Legislative Change

Some of the concerns that likely prompted Caltrans to adopt the Transportation Art Policy speak to broader issues in U.S. copyright law, especially gaps in how the law recognizes and enforces moral rights. For instance, Caltrans' insecurity about potential liability under VARA may be exacerbated by the lack of clarity around

Cultural Products, 81 B.U. L.R. 793, 806–08 (2001) (explaining that co-ownership of IP is an underdeveloped area of the law).

226. See *Oddo*, 743 F.2d at 633 (9th Cir. 1984) (citing *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 221 F.2d 569 (2d Cir.), *modified*, 223 F.2d 252 (1955)). Congress has implicitly approved the duty to account and other common-law principles of joint ownership as applied to copyright. See H.R. REP. NO. 94-1476 at 121, *reprinted in* 1976 U.S.C.A.N. 5659, 5736, 1976 WL 14045 ("There is also no need for a specific statutory provision concerning the rights and duties of the coowners of a work; court-made law on this point is left undisturbed. . . . [C]oowners of a copyright would be treated generally as tenants in common, with each coowner having an independent right to use or license the use of a work, subject to a duty of accounting to the other coowners for any profits.").

227. A court "may" require that the plaintiff co-owner provide written notice of the suit to any person with an interest in the copyright, and "shall" require that written notice be given to "any person whose interest is likely to be affected by a decision in the case." 17 U.S.C. § 501(b) (2017). Since a non-suing co-owner plainly has an interest in the copyright that is likely to be affected by a decision in an infringement suit, notice will very likely be required.

228. *Id.*

229. Michael Todd Mobley, Note, *Davis v. Blige: The Second Circuit's Rejection of Retroactive Copyright Licenses*, 24 BERKELEY TECH. L.J. 341, 360 (2009).

230. See generally Smith, *supra* note 178, at 380–83 (discussing communities' interest in public art, particularly as part of community cultural heritage).

whether transportation features like bridges or overpasses are “buildings” for the purposes of the § 113(d) building exception,²³¹ or the uncertainty regarding VARA’s applicability to site-specific art.²³² Since these issues are hardly unique to Caltrans’ acquisition of transportation art, they may be more fulsomely addressed by state or federal legislation than by scope-limited agency guidance or individual contracts. A viable legislative solution would have the advantage of being applicable outside Caltrans’ jurisdiction; for example, a new federal statute clarifying visual artists’ rights in works of site-specific art would provide guidance for owners of public artwork across the country, not just for Caltrans. Additionally, a “realistic and reasonably detailed statutory system” could save time and cost in the long term, compared to the process of devising an individual ownership agreement for each new work of art.²³³

In California, there would likely be support for state legislation that would override the Transportation Art Policy’s copyright transfer requirement. Historically, California has led the way in introducing laws that are more protective of artists’ rights than federal copyright law; not only did CAPA recognize the rights of attribution and integrity a decade before VARA went into effect, but California has also been the only state to adopt legislation that attempted to give artists the right to receive royalty payments when their original artwork was resold after its first transfer (*droit de suite*).²³⁴ In addition to California’s general openness to artist-friendly legislation, some state lawmakers have already expressed concern about the Transportation Art Policy and its effect on public art statewide, which suggests they might be willing to sponsor legislation that would moot it.²³⁵

What form such legislation might take is less clear. The California legislature might look to the state’s own Art in Public Buildings Act, which provides that artists of works acquired for state buildings pursuant to the Act retain “all rights to which the work of art may be subject under copyright laws.”²³⁶ A new, parallel statute could apply to art acquired by the state for installation within the state highway system. While this would be a narrow solution to the problems created by the Transportation Art Policy’s copyright transfer requirement, it wouldn’t necessarily address the broader issues that seem to have prompted the state to adopt the policy in the first place. Yet an attempt to legislate wider-ranging responses to the uncertainties around artists’ rights could run into conflicts with federal law. State lawmakers could, for example, devise a bill providing that an artist waives her right

231. See *supra* note 64 and accompanying text.

232. See *supra* notes 79–92 and accompanying text.

233. See Scafidi, *supra* note 225, at 808 (citing Carey R. Ramos & Joseph P. Verdon, *Joint Ownership of Intellectual Property: Pitfalls, Alternatives, and Contractual Solutions*, 559 P.L.I./PAT. 17 (1999)).

234. 1 HOWARD B. ABRAMS & TYLER T. OCHOA, LAW OF COPYRIGHT § 5:188, Westlaw (database updated Nov. 2019). The Ninth Circuit has held that the California Resale Royalties Act, CAL. CIV. CODE § 986, is preempted by 17 U.S.C. § 301. *Close v. Sotheby’s, Inc.*, 894 F.3d 1061, 1076 (9th Cir. 2018).

235. State Senators Beall, Wiener, and Skinner evidently wrote to Caltrans director Malcolm Dougherty in 2017 to share their concerns about the policy. See City of San Jose Public Art Committee, Regular Meeting Minutes, CITY OF SAN JOSE (Aug. 1, 2017), <https://perma.cc/9HRQ-N6UY>.

236. CAL. GOV. CODE § 15813.5(a)(2) (West, Westlaw through Ch. 860 of 2019 Reg. Sess.).

of integrity when she accepts a commission to create a work of public art for state property. While such a law would purport to eliminate state liability for violating the integrity right if it needed to remove or alter the work, it would likely be ineffective because it directly conflicts with VARA's provision that the right of integrity can only be waived through a highly specific, written, signed instrument.²³⁷

Legislative change at the federal level would not involve such preemption issues, and there is certainly room for Congress to amend VARA to clarify the role of moral rights in site-specific art—or even public art in general. In a student note which the First Circuit cited in *Phillips*,²³⁸ one author proposed that Congress add to VARA a limited waiver of moral rights that would apply whenever an artist agrees to install a work in a public space.²³⁹ Others have focused on whether public art should get copyright protection at all, arguing that artworks which the federal government commissions as monuments or memorials should automatically enter the public domain.²⁴⁰ These are intriguing ideas, especially when it comes to works of art designated as public memorials or as community identifiers, which arguably belong to the community as much as to the artist. However, automatic relegation to the public domain would make public art commissions very unattractive to many artists, as much as if they had to automatically sign away their copyright to the state. The same would be true of attaching a waiver of moral rights to any work of public art. For this reason, it may be politically difficult to enact such laws, which could even be seen as defeating the constitutional purpose of copyright law: to incentivize the progress of public knowledge.²⁴¹

Leaving the specifics of a potential legislative solution aside, there are a number of reasons this general approach is not an ideal fit for the problems identified. Most fatally, relying on legislation alone almost certainly means that the pace of change will be laborious. Legislatures are notoriously slow-moving, and it may be difficult or impossible to muster the political will to enact a proposal that satisfies all parties. Further complicating the necessary compromises, state agencies' concerns around public art seem to implicate both economic and moral rights. For instance, amending VARA to add a limited waiver of moral rights for public art would eliminate one source of insecurity that may be behind the Transportation Art Policy, but would not address who should control enforcement of the copyright in a state-owned work of public art—a question which stems less from uncertainty in the current law than from the naturally competing interests of artists and government commissioners. Given the delicate balances that new legislation would need to strike between these interests, there is a strong possibility that it would do more harm than good overall.

For all these reasons, in the search for a fair, efficient, closely-tailored, and

237. 17 U.S.C. § 106A(e) (2017).

238. *Phillips v. Pembroke Real Estate*, 459 F.3d 128, 134 (1st Cir. 2006).

239. Francesca Garson, Note, *Before That Artist Came Along, It Was Just A Bridge: The Visual Artists Rights Act and the Removal of Site-Specific Artwork*, 11 CORNELL J.L. & PUB. POL'Y 2003 (2001).

240. Julie Cromer Young, *Copyright in Memoriam*, 13 VAND. J. ENT. & TECH. L. 507 (2011); see also *Victoria M. Ger, Gaylord v. United States* 595 F.3d 1365 (*Fed. Cir.* 2010), 21 DEPAUL J. ART, TECH. & INTELL. PROP. L. 185 (2010).

241. See U.S. CONST. art. I, § 8, cl. 8.

readily-implemented alternative to a procedure like the Transportation Art Policy, changing the law is probably not the best solution. A contract-based approach, such as nonexclusive licensing, is both more easily implemented than new state or federal legislation and more likely to address the concerns of all relevant parties. Relying on contracts, rather than the political will of a legislature, means a state agency could implement a new policy in an instant; for example, Caltrans can simply issue a manual change and update the PDPM to reflect the preferred contract terms. A contractual approach also gives prospective owners of public art the flexibility to reach individualized agreements with each artist they engage. Even if Caltrans or a similarly situated agency prefers to develop a single, standard contract template for the sake of administrability, that default arrangement can be quite closely tailored to the needs of both the agency and the artists with whom it typically works. As I have suggested, the interests of both parties—not to mention local agencies and the public—are best served by adopting as a starting point a contract that allows the artist to retain copyright and grants a limited-purpose nonexclusive license to the state.

IV. CONCLUSION

At best, Caltrans' Transportation Art Policy can be viewed as an attempt to create a one-size-fits-all, easily administrable policy that bluntly achieves a number of state objectives at once. With a blanket requirement that artists assign their entire copyrights in works of transportation art to the state, Caltrans may believe it has simply eliminated the need for any complicated case-by-case negotiating or carve-outs. Administrability is, of course, a worthy consideration—but in its pursuit, the state cannot shunt aside the ultimate goal of copyright law: to promote art-making for the good of the public. The encouragement of *public* art, in particular, is a well-established public policy in California and in the United States generally, and the careful allocation of rights between artists and art-owning agencies plays an important role in that project.

State policies around transportation art specifically, and public art in general, should be directed as much as possible toward limiting state liability without placing unnecessary restrictions on artists' creative freedom or their ability to fully exploit their work. With respect to this ideal, procedures like the Transportation Art Policy fall appreciably short. While failing to squarely address one of the more salient potential liabilities—the possibility of an artist seeking an injunctive remedy against the state pursuant to a relatively unpredictable moral rights regime—the Transportation Art Policy has introduced a requirement that is both unnecessary for achieving the state's objectives and avoidably burdensome for the artistic community.

To better align with an overall policy of promoting the arts and associated public benefits, state agencies that acquire or plan to acquire public art must avoid requiring artists to sign away their copyrights. Instead, these agencies should employ alternative contractual procedures that give the state the protections it reasonably needs, even as they allow artists to retain most of their economic rights. This should typically take the form of a nonexclusive license to reproduce the work for public

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purposes—coupled, if desired, with other provisions that limit moral rights liability, authorize the state to enforce the copyright in the artist’s name, or prevent the artist from duplicating the work. As for Caltrans, it had the right idea when it endorsed a similar policy prior to the 2016 PDPM update. More investigation would be necessary to understand what, if anything, Caltrans found lacking in that procedure, or if the 2016 amendment was merely a misguided bureaucratic attempt to foreclose any possibility of liability to artists in one fell swoop. Either way, Caltrans must acknowledge the serious consequences which the Transportation Art Policy threatens, and it should recommit to a policy that sensitively balances the state’s needs with the interests of California’s artists, its localities, and its people.