

PERMISSIVE CERTIFICATES: COLLECTORS OF ART AS COLLECTORS OF PERMISSIONS

Peter J. Karol*

Abstract. Artists have been dramatically reshaping the fine art certificate of authenticity since the 1960s. Where traditional certificates merely certified extant objects as authentic works of a named artist, newer instruments purported both to authorize the creation of unbuilt artworks and instruct buyers how to manifest and install them. Such “Permissive Certificates” have fascinated contemporary art historians ever since. Prior scholarship has shown how such documents, essentially blueprints for art creation, force us to confront fundamental ontological questions on the nature of art, the relationship between artist, collector and viewer, and the influence of money and acquisitiveness on art generation. But rarely, if ever, have they been approached as legal instruments.

This Article accordingly fills that gap by construing Permissive Certificates through the complex but potent array of legal rights that they define. It argues that Permissive Certificates are not unitary instruments, but in fact an amalgamation of two distinct legal structures. They couple narrow retrospective warranties on the one hand with prospective copyright licenses and rights of source association on the other. Critically, as with all copyright and source-based permissions, they are conditioned on the owner/licensee complying with use guidelines. Material variations from such terms place the owner/licensee outside the scope of the license, or otherwise in breach, and at risk of claims of infringement by the artist.

This approach to Permissive Certificates yields two important insights. First, they harbor an unappreciated power as a tool for artist control, particularly in jurisdictions such as the U.S. where moral rights remain relatively weak. Second, and more broadly, as art becomes increasingly more dematerialized, digitized, and duplicable, and ever more legalized in turn, Permissive Certificates will grow more and more into the locus of value for such works. Over the long run, museums and other collectors of fine art will become collectors, not of objects, but of permissions. The aura of the artist’s hand will be that of a signature and not of a brushstroke.

* Professor of Law, New England Law | Boston. Thank you to Zahr Said, Laura Heymann, and Fred Yen for comments on an earlier draft of this work, and to London Lundstrum for terrific research assistance. I am also indebted to feedback I received from participants at the 2019 Works in Progress Intellectual Property, Junior IP Law Scholars Association, and the New England Regional Junior Faculty Scholarship colloquia. This Article also benefitted from the Beyond Copyright workshop at NYU Law, held in conjunction with the 2019 CAA Annual Conference. Finally, thank you to the fantastic New England Law library reference staff, and Barry Stearns, in particular, as well as the terrific editorial team at the *Washington Law Review*.

INTRODUCTION.....	1177
I. PERMISSIVE CERTIFICATES IN CONCEPTUAL, POST-REPRESENTATIONAL AND NEW MEDIA ART	1184
A. Early Permissive Certificates (1960s and 1970s).....	1187
B. Later Permissive Certificates (1980s and 1990s).....	1188
C. Permissive Certificates After 2000.....	1191
D. The Paradox of Permissive Certificates	1193
II. CERTIFICATES AS LICENSES.....	1195
A. Permissive Certificates as Narrow Warranties of Authorship.....	1196
B. Permissive Certificates as Licenses.....	1198
1. The Basic Structure of Intellectual Property Licenses 1199	
a. Affirmative Licenses.....	1199
b. The Trademark and Right of Publicity First-Sale Doctrine and the Dastar Objection.....	1204
2. The Exemplary Gonzalez-Torres and Evans Certificates are Enforceable Contracts and Express Copyright Licenses that Authorize Use of an Artist's Name.....	1208
a. The "Untitled" 1989/1990 and Evans Certificates Are Likely Enforceable as Contracts 1209	
b. Gonzalez-Torres's "Untitled" 1989/1990 Certificate and the Evans Certificate Are Express Copyright Licenses of Copyrighable Works.....	1213
c. The Certificates Evidence the Owners' Right to Use the Artists' Names in Connection with Exhibition or Sale of the Genuine Artwork .	1217
III. IMPLICATIONS	1220
A. Permissive Certificates as a Tool for Artist Control	1220
1. The Problem of Artist Control and Moral Rights Law in the United States.....	1221
2. Artist Control by Contractual/License Restrictions 1223	
a. Enforcement of Contract Terms.....	1223
b. Reproductions of the Artworks Outside the Scope Permitted by the Certificates is a Copyright Infringement.....	1224
c. Material Variations Void the Authentication and Invite Infringement Claims	1225
3. Termination	1226
4. Limits on Transferability	1227
a. Contractual Restraints.....	1227
b. Background Legal Restraints on Transfer....	1228

B. Collectors of Art as Collectors of Permissions.....	1229
CONCLUSION	1231

INTRODUCTION

He intended to invest in paper.

- Donald Judd on Count Giuseppe Panza¹

In 1990, renowned conceptual and minimalist artist Donald Judd authored an unrelenting four-part polemic against Giuseppe Panza, one of the world's foremost collectors of such art. The essay, *Una stanza per Panza*, opened with a short, declarative first sentence: "Giuseppe Panza makes my work himself, contrary to the original agreement that it be made only under my supervision."²

Given the thirty-plus pages of invective that follow (Judd launched into an extended comparison of Panza to Richard Nixon just one paragraph later),³ a reader could be excused for breezing by this sober opening statement of the case. Judd, it seems, was establishing some factual context to motivate the argument to come. A celebrated artist, Judd was angry at a collector of his works because the collector did not follow an agreement to make Judd's art in a certain way.

Judd's statement, however, is stranger and far more provocative than it may at first appear. At a minimum, it raises a range of questions centering around its passing reference to an "original agreement." How could a collector (that is, an art buyer) ever make an artist's work in the artist's name? What "original agreement" is Judd alluding to that could delegate such a power? Did Judd consent to this arrangement? If not, how could it be enforceable? If so, what motivated the artist to cede the right to create artwork in his name in the first place? Perhaps most perplexing of all to a lawyer: if Panza's fabrication of Judd's works was indeed "contrary" to an agreement, why didn't Judd sue to enforce its terms rather than attack Panza through hostile essays?

Adding to these mysteries was Judd's decision, a year earlier, to take out a paid advertisement in *Art in America*, a leading art publication, renouncing authorship of an "installation wrongly attributed" to Judd at

1. DONALD JUDD, *Una stanza per Panza* (1990), in DONALD JUDD WRITINGS 630, 643 (Flavin Judd & Caitlin Murray eds., 2016).

2. *Id.* at 631.

3. *Id.*

the Ace Gallery in Los Angeles.⁴ “Fabrication of the piece,” the advertisement read, “was authorized by Giuseppe Panza without the approval or permission of Donald Judd.”⁵ Under what set of circumstances would a living artist think it necessary to advertise that he did not permit the creation of certain sculptures in his name?

As it happens, Judd, along with many other leading figures in post-1960s American art, did execute agreements—often labeled Certificate or Certificate of Authenticity—with Panza and other collectors.⁶ This Article refers to those agreements and the documents that memorialized them as “Permissive Certificates.”⁷ Such documents generally served a dual function quite different from the traditional art warranties, or promises of authenticity, from which they took their name. On the one hand, they resembled plans or blueprints instructing the collector how to fabricate and install the subject artwork. Indeed, at the time of Panza’s purchase, many of these artworks had never been fabricated and only existed in the form of such plans.⁸ On the other hand, these documents also purported to authenticate or warrant the subject works as genuine, much like traditional certificates of authenticity which are familiar to collectors of high-value objects of any kind.⁹

4. See Advertisement, *Donald Judd: Prints and Related Works*, ART IN AMERICA, Mar. 1990, at 104, 128 (showing the advertisement that Judd took out to renounce authorship of works refabricated by Panza in Judd’s name for an exhibit in Los Angeles).

5. *Id.*

6. See generally Martha Buskirk, *Public Experience/Private Authority*, 26 CORNELL J.L. & PUB. POL’Y 469, 471–76 (2017) (describing the collecting practice of Panza with respect to leading United States conceptual and minimalist artists).

7. In particular, by the term “Permissive Certificate” I mean: a document originated by an artist that purports to authorize another (1) to fabricate or otherwise manifest one or more tangible elements of an artwork pursuant to instructions contained in the document, and (2) prospectively certifies the to-be-fabricated or manifested artwork as a genuine work by that artist. I intend to exclude from this definition artworks or art practices that purport to create or define legal rights as a component of the work itself. For instance, *Donorcard* (2005) by the artist Carey Young consists of a series of small business-card-sized cards, resembling organ donor cards, signed by Young. Carey Young, *Donorcard*, in IN DEED: CERTIFICATES OF AUTHENTICITY IN ART, 71, 71 (Susan Hapgood & Cornelia Lauf, eds., 2011) [hereinafter *In Deed Catalog*] (showing *Donorcard*). The cards, given away to viewers, read:

In consideration of the donation of this card to me by the Artist, I hereby agree that this object will only become an artwork by her upon the inclusion of my signature, and that it will retain its status as an artwork solely for the duration of the Artist’s life, or my life, whichever is the shorter.

This is followed by a countersignature block meant to be signed by the viewer. Young is captivatingly using the language and conventions of law to create art. The cards are not, though, certifying the authenticity of a separate work. Thus, they are not properly Permissive Certificates as I use the term.

8. Buskirk, *Public Experience*, *supra* note 6, at 471–76.

9. See *infra* Part II(A).

Perhaps unsurprisingly, this nascent practice of creating, authorizing, and prospectively authenticating artworks solely through legal documents led to a near-immediate parade of disputes that continues to this day. The Guggenheim Museum, for instance, purportedly “knew” that it was attaining a “mare’s nest of problems” when it acquired hundreds of works from the Panza collection in the 1990’s, including many unfabricated Judd artworks memorialized only in certificates and diagrams.¹⁰ The extent of these problems eventually forced it to create its “Panza Collection Initiative.” Tasked with studying ethical, legal, and conservational questions concerning conceptual and minimalist artworks, the initiative has since received over \$3 million in grant funding to reckon with art that exists as much on paper as it does in object form.¹¹

This multiyear research project recently culminated in a two-day symposium, entitled *Object Lessons*, held at the Guggenheim in April 2019.¹² In connection with that symposium, the museum controversially announced that it had formally decided to “decommission[.]” more than ten contested Judd works in its collection, among others.¹³ This sui generis category includes some works previously fabricated by Panza over Judd’s objections, as well as Judd works which have only ever existed in paper form.¹⁴ Moreover, the Guggenheim has stated its intention to never unilaterally “realize” these decommissioned works nor display them as

10. Randy Kennedy, *Tricky Business: Defining Authenticity*, N.Y. TIMES (Dec. 20, 2013), <https://www.nytimes.com/2013/12/22/arts/design/guggenheim-project-confronts-conceptual-arts-nature.html> [<https://perma.cc/Y8YK-RVT5>].

11. *Id.*; see also Eileen Kinsella, *The Guggenheim Gets \$750,000 to Help Answer Knotty, Existential Questions About the Nature of Conceptual Art*, ARTNET NEWS: ARTWORLD (Aug. 29, 2018), <https://news.artnet.com/art-world/guggenheim-museum-gets-750k-mellon-grant-1339031> [<https://perma.cc/HEH5-KEUM>] (announcing an additional \$750,000 in funding for the third phase of this initiative).

12. See *Object Lessons: The Panza Collection Initiative Symposium at the Solomon R. Guggenheim Museum, Peter B. Lewis Theatre* (Apr. 9–10, 2019) (on file with author) [hereinafter *Object Lessons Symposium*].

13. See, e.g., Andy Bettaglia, *‘The Work of Art Begins to Wobble’: Guggenheim Museum Stares Down Heady Questions about Minimal and Conceptual Art in Panza Collection*, ARTNEWS (Apr. 9, 2019), <http://www.artnews.com/2019/04/09/guggenheim-panza-collection-symposium/> [<https://perma.cc/6A68-6L2M>].

14. See *Object Lessons Symposium*, *supra* note 12, listing panel titled, *Decommission: Rights, Responsibility and the Status of the Work* (Apr. 9–10, 2019). According to the policy discussed at the conference, this category “refers to any work that—for reason of authenticity or condition—is deemed to be non-viable, yet, being possessed of historical significance, is preserved in whole or part.” See still shots of slide from *Object Lessons Symposium* slideshow, *“Decommission” Text for SRGM Collection Policy* (Apr. 10, 2019) (on file with the author). The Guggenheim has stated its intention never to unilaterally fabricate these decommissioned works, meaning that they might be forever lost to the public as artworks. *Id.* (noting that “[i]n cases where the work is unrealized in any form, it will remain unrealized”).

artworks, meaning that they might be forever lost to the public as works of art.¹⁵

While Judd's anger over Panza's alleged wrongful treatment and fabrication of his works is surely the most prominent dispute concerning certificate-based art, it is hardly the only example. Just last year, for instance, a clash arose regarding a Sol LeWitt wall drawing.¹⁶ Like many artworks in the Panza collection, LeWitt's work was often memorialized and transferred only in certificate and diagram form.¹⁷

The owner of one such wall drawing (#679) left it to the Menil Collection in his will, along with the private home where the work had been painted directly onto a large wall.¹⁸ The Menil, being an art museum, understandably elected to sell the house but retain the work. It accordingly took title to and accessioned the underlying certificates into its collection, and then painted over the original wall drawing pursuant to LeWitt's recognized intention for transfer of his works.¹⁹

The successor owner of the residence, however, had different ideas and later decided to "un-erase" and expose the original wall drawing by having the added layer of sheetrock mud removed.²⁰ The ensuing outcry was so strong that a local art blogger was purportedly pressured by the Menil Collection to issue a correction for even alluding to the original (exposed) painted wall as "a LeWitt."²¹ A successor owner of a Certificate

15. *Id.*

16. See, e.g., Paula Newton, *Disappeared Sol LeWitt Painting Slowly Reappears in Houston Home*, GLASSTIRE (Jan. 9, 2018, 12:30 PM), <http://glasstire.com/2018/01/09/disappeared-sol-lewitt-painting-slowly-reappears-in-houston-home/> [<https://perma.cc/ZBB9-YA2G>]; Dan Singer, *How the 30-Ft.-Tall Ghost of a Sol LeWitt Drawing is Slowly Reappearing in Houston's Museum District*, SWAMPLOT (Jan. 5, 2018), <http://swamplot.com/how-the-30-ft-tall-ghost-of-a-sol-lewitt-drawing-is-slowly-reappearing-in-houstons-museum-district/2018-01-05/> [<https://perma.cc/N5MB-PS6D>]; see also Julia Halperin, *One Texas Woman's Paradoxical and Controversial Quest to Prove She Rediscovered a Major Work of Conceptual Art*, ARTNET NEWS: ART WORLD (Jan. 18, 2018), <https://news.artnet.com/art-world/sol-lewitt-drawing-menil-texas-1201514> [<https://perma.cc/6EJA-ZGQ3>].

17. LeWitt's wall drawings are generally memorialized in the form of transferable certificates, accompanied by an illustrated diagram, instructing an owner how to recreate the work anew each time it is (re)installed. See generally Peter J. Karol, *The Threat of Termination in a Dematerialized Art Market*, 64 J. COPYRIGHT SOC'Y U.S.A. 187, 187–90 and apps. A and B (2017) [hereinafter Karol, *Termination*] (describing same in detail).

18. Singer, *supra* note 16.

19. *Id.*

20. There is even a website for the "un-erasing" project itself. See Lynn Steen & Jonna Hitchcock, *Un-Erasing Sol Lewitt*, <http://unerasingollewitt.com/index.html> [<https://perma.cc/3PDU-B6W3>] (last visited Aug. 17, 2019, 1:56 PM).

21. Paula Newton, *UPDATE: Why "Unerasing" a Sol LeWitt is Impossible*, GLASSTIRE (Jan. 11, 2018), <http://glasstire.com/2018/01/11/update-why-unerasing-a-sol-lewitt-is-impossible/> [<https://perma.cc/LTC8-3JNU>].

of Authenticity for a LeWitt wall-drawing, in other words, persuaded a third-party commentator to retract her reference to LeWitt's authorship of the original painted mural despite the fact that no one disputes that he created it. On what grounds? The certificate had since changed hands.²²

This LeWitt conflict closely parallels a prior dispute involving the British artist Damien Hirst.²³ In 1988, as an early example of his "spot painting" series, Hirst painted a series of bright, multi-colored spots directly onto a wall in a London home.²⁴ At the same time, he created a handwritten "Certificate of Authenticity" for the work, known as "Bombay Mix," which specifically required that the piece "must be painted out before it is re-made for anywhere else."²⁵ When the original home owner sold the home and moved, Hirst allegedly painted a new version of Bombay Mix on canvas for the original owner to take with him pursuant to the instructions in the certificate.²⁶ For whatever reason, however, the original wall was never painted over and the new homeowners, understanding its value, professionally removed and remounted the section of wall in preparation for a later sale.²⁷

Hirst's attorneys sent a cease-and-desist letter to the new home owners, demanding that they destroy the work and not refer to it as a Hirst artwork.²⁸ By all accounts, Hirst's actions made the wall drawing unsellable even though no one disputed that Hirst personally created the original mural, or that the new homeowners legally possessed good title to the piece of wall as part of their purchase of the home. As summed up by the gallerist trying to sell the original Bombay Mix painted wall surface, "I am essentially not allowed to say that I have a picture by the artist that is actually by the artist."²⁹

Art historians, artists, cultural critics, economists, and philosophers of art have spent decades unpacking and critiquing the aesthetic and pecuniary paradoxes underlying these Permissive Certificates.³⁰ This

22. *Id.*

23. See generally Ben Bryant & Robert Mendick, *Spot of Bother over Damien Hirst Wall Art Painting*, THE TELEGRAPH (July 12, 2014, 10:45 PM), <https://www.telegraph.co.uk/culture/art/10963754/Spot-of-bother-over-Damien-Hirst-wall-art-painting.html> [<https://perma.cc/KP7P-UXZ9>].

24. *Id.*

25. *Id.*

26. See *id.*

27. *Id.*

28. *Id.*

29. *Id.*

30. For a few of these perspectives, see MARTHA BUSKIRK, *THE CONTINGENT OBJECT OF CONTEMPORARY ART* (2003); JOAN KEE, *MODELS OF INTEGRITY: ART AND LAW IN POST-SIXTIES AMERICA* 43–64, 191–26 (2019) [hereinafter KEE, *MODELS*] (surveying the rise of contract and

Article, by contrast, takes a narrower approach. It studies these documents solely and simply as legal instruments, trying to understand them as focal points of legal—as opposed to aesthetic—value.

Some readers may find this a tedious way of approaching stirring original artworks. However, it is important to do so for two reasons. First, this method shows that Permissive Certificates are not just documents of art historical interest. They also function as highly complex (and equally paradoxical) legal devices defining valuable legal rights. If the early Permissive Certificates of conceptual art captured an “aesthetic of linguistic conventions and legalistic arrangements,” as art historian Benjamin Buchloh put it, then this Article intends to show that those latter arrangements were, and still are, real ones.³¹

More specifically, the legal function of Permissive Certificates is twofold. As their name suggests, they initially warrant that the named artist created the conceptual content of the underlying work. In this regard, they parallel traditional fine art certificates of authenticity, though with important differences detailed below. Their other (underappreciated) legal function, however, is not to promise retrospective authentication but rather to grant prospective permissions. That is, they grant the owner of the documents the right to realize an artwork and label it as a work by the artist if the work remains materially unaltered from its original plan. As such, they are essentially copyright licenses coupled with a right of source association.

Critically, as with all copyright and source-based permissions, Permissive Certificates are generally conditioned on the owner/licensee complying with use guidelines. Material variations from such terms place

certificate-based artworks); Benjamin H.D. Buchloh, *Conceptual Art 1962–1969: From the Aesthetic of Administration to the Critique of Institutions*, 55 THE MIT PRESS 105, 117–55 (1990) (surveying a history of the Conceptual Art movement); Laura A. Heymann, *Dialogues of Authenticity*, 58 STUD. L. POL. & SOC'Y 25 (2015) [hereinafter Heymann] (exploring questions of authorship and authenticity in the context of certificate-based and other artworks); NICOLAS BOURRIAUD, RELATIONAL AESTHETICS (Simon Pleasance & Fronza Woods, trans., 2002) (essays on the works of Gonzalez-Torres and others). For artist statements on the subject, see for example, Sol LeWitt, *Paragraphs on Conceptual Art*, ARTFORUM (June 1967), https://www.corner-college.com/udb/cproVozeFxParagraphs_on_Conceptual_Art_Sol_LeWitt.pdf [<https://perma.cc/LAZ6-PERW>]; JUDD, *supra* note 1 (lamenting mistreatment of Judd's certificate-based works by collector Giuseppe Panza). For an aesthetic philosopher's account of certificate-based and related art, see K.E. GROVER, ART AND AUTHORITY 165–73 (2018). For market-based discussions, see, for example NOAH HOROWITZ, ART OF THE DEAL: CONTEMPORARY ART IN A GLOBAL FINANCIAL MARKET 87–42 (2014) (describing market for what he calls “experiential art”); DON THOMPSON, THE \$12 MILLION STUFFED SHARK: THE CURIOUS ECONOMICS OF CONTEMPORARY ART 14–15 (2008) (commenting on pricing of works by Gonzalez-Torres and others). Most of the certificates discussed in this article may be found in the catalog for a seminal show on the subject, which contains a range of essays on certificates. See generally In Deed Catalog, *supra* note 7.

31. Buchloh, *supra* note 30, at 131.

the owner/licensee outside the scope of the license, or otherwise in breach of its conditions, and, therefore, at risk of claims of infringement by the artist.³²

Second, this Article shows that Permissive Certificates harbor unappreciated power to be an effective tool for artist control. This is particularly salient in jurisdictions such as the United States where moral rights—that is, the personal, noneconomic rights of an author to assert control over works after they have been transferred—remain relatively weak.³³ Permissive Certificates could serve as something of a super-moral-right to artists inclined to use them in this way. To be clear, this Article does not make a normative case for giving artists and their representatives more control over sold works. Rather, it aims to show that these certificates exist as a potent alternative source of legal rights for artists and artist estates, for better or worse.

Part I chronologically surveys exemplary uses of Permissive Certificates in conceptual, post-representational, and new-media art.³⁴ The final section of this Part reveals and explains a central legal paradox behind the foregoing certificates. Namely, that traditional certificates of authenticity function retrospectively by making a factual claim about a particular object that exists in history. Permissive Certificates, however, purport to certify the authenticity of something not yet in existence, prospectively.

Part II seeks to resolve this paradox by arguing that these documents are not unitary instruments, but rather an amalgamation of two distinct legal structures. In particular, they couple retrospective, if narrow, warranties on the one hand with copyright licenses and prospective rights of source authentication on the other. This Part begins by analyzing traditional certificates of authenticity in fine art, showing how Permissive Certificates still perform a typical authentication function—though only in the limited sense that the artist is warranting creation of the underlying content of the work and not a particular tangible object. It next provides an overview of non-patent intellectual property licensing in the United

32. See *infra* Part II.

33. See *infra* Part III(A)(1) for a discussion of moral rights.

34. References to “conceptual, post-representational and new media art” are meant broadly to encompass any artistic practice including reproducible components or that is in any degree recreated anew for each realization or exhibition. I do not mean to refer to “conceptual art” in the limited sense by which that (controversial) term might be understood as a specific and time-bracketed, art-historical moment. My use of the term includes, for instance, artists like Josh Kline (whose work uses 3D-printable components meant to be recreated each time the work is shown), video or digital artists, classic conceptualists like Sol LeWitt, and post-representational contemporary artists such as Rikrit Tiravanijja. Due to space constraints, the artists discussed throughout are simply representative examples of the countless practitioners in these spaces. See *infra* Part I.

States, including basic principles of contract formation and enforceability, as well as quasi-licensing doctrines like the first-sale exceptions in trademark and right of publicity law. Finally, this Part applies these foregoing legal structures to two representative examples of actual Permissive Certificates. It demonstrates how, under federal law, they are structured as copyright licenses coupled with basic rights of source association (arising primarily from first sale rights).

Part III explores the implications of the conclusions in Part II. It approaches the question from two perspectives. First, it takes a practical approach and shows how Permissive Certificates can function as a potent tool for artists to exert legal control over works they sold long ago. Second, it steps back and reflects more generally on what this might mean for artists and collectors of art as we move into the middle of the twenty-first century. It argues that museums and other collectors will increasingly become repositories not of art objects but of legal instruments that grant highly valuable, often exclusive, intangible rights to create and show artworks. Over the long run, museums and other collectors of fine art will become collectors—not of things, but of permissions.

I. PERMISSIVE CERTIFICATES IN CONCEPTUAL, POST-REPRESENTATIONAL AND NEW MEDIA ART

By 2011, Permissive Certificates—certificates of authenticity containing both instructional and authenticating components—had become prolific enough to warrant their own traveling exhibition. A quick flip through the catalog for the show, entitled *In Deed: Certificates of Authenticity in Contemporary Art*, reveals the wide range of practices and sheer number of different artists who have created art by use of certificates over the last five or so decades.³⁵

The genesis of this practice, however, came as much from the demands of collectors as from the creativity of artists. Giuseppe Panza, in particular, was focused on finding ways to memorialize his ownership of conceptual works that he was increasingly acquiring in the late 1960s and early 1970s solely in the form of paper permissions.³⁶ As the art historian Martha Buskirk describes, “the documents that appear in Panza’s files were clearly instigated by the collector rather than by the artist—with Panza wanting evidence of ownership not only for pieces purchased as objects, but far more urgently, for a number acquired in the form of plans

35. See generally *In Deed* Catalog, *supra* note 7.

36. Buskirk, *Public Experience*, *supra* note 6, at 472.

for future works.”³⁷ Indeed, Judd himself was, at best, ambivalent about his early certificate practices, and arguably adopted the form at the behest of Panza.³⁸

Judd essentially confirms this in his *Una Stanza* essay, where he laments that his early certificates were the creation of Panza in collaboration with Judd’s former gallerist, the legendary Leo Castelli, and lawyers that did not represent Judd’s interests.³⁹ Be that as it may, Judd’s certificates still form paradigmatic examples of how early American conceptual and minimalist artists created and sold works in the form of paper permissions.⁴⁰

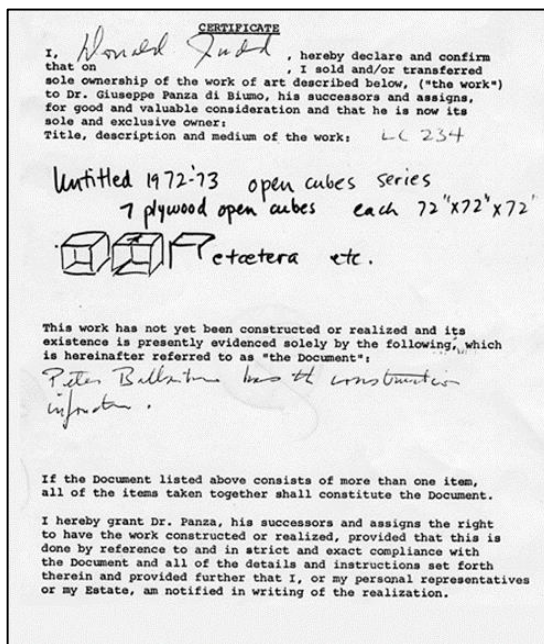
37. *Id.*

38. *Id.*

39. JUDD, *supra* note 1, at 655. For instance, “[i]t’s important to say that all arrangements with Panza were made by Castelli and . . . his lawyer, not mine.” *Id.*

40. This practice should be distinguished at the outset from two similar modes of art creation, the outsourcing of fabrication by sculptors and the commissioning of works through the use of contracts. It has, of course, long been a common practice of sculptors to have professional foundries create casts of works under their oversight or with their authorization using molds created by the artist. *See, e.g.*, Sharon Hecker, *The Afterlife of Sculptures: Posthumous Casts and the Case of Medardo Rosso (1858–1928)*, 16 *J. ART HISTORIOGRAPHY* 1 (June 2017) (same). That practice, however, assumes oversight and involvement by the artist, and often is anchored by a physical mold created by the artist. *Id.* This is different from Permissive Certificates which in their purest form can involve the transfer of documentation without any associated objects and, at times, without even continuing oversight by the artist. Similarly, the common practice of creating works on commission will often involve a contract between artist and buyer. *See, e.g.*, *Serra v. U.S. Gen. Servs. Admin.*, 847 F.2d 1045, 1047 (2d Cir. 1988) (describing contract between Richard Serra and the U.S. Government in the famous Titled Arc dispute). In such cases, the artist is generally directly involved in creation and initial delivery of a physical art object, though disputes often arise thereafter. *Id.*

FIGURE 1

FIGURE 2⁴¹

Figures 1 and 2, First Page for Certificate and Later Installation Shot for Donald Judd, Untitled [seven plywood boxes] (1972–1973).

41. © 2019 Judd Foundation / Artists Rights Society (ARS), New York; Photo: © Walter Klein, Düsseldorf. Used with Permission.

A. *Early Permissive Certificates (1960s and 1970s)*

In the 1970s, in an early example of conceptual certification practice, Judd issued Panza a three-page certificate for a work that had not yet been “constructed or realized,” known as, *Untitled [Seven plywood boxes: open back]*.⁴² The document, now part of the Guggenheim’s Panza collection, is simply entitled, “Certificate.” It “confirm[s]” Panza as the “sole and exclusive owner” of the “work of art described” on the document, and further that Judd personally “sold and/or transferred” the work. It thereby serves a basic authentication function by confirming a provenance directly from the named artist.⁴³

As one reads on, the certificate morphs from a form of warranty into an instrument of instruction and control. First, the document offers a hand-drawn sketch plan of the work yet to be realized.⁴⁴ In technical legal language, it then effectively authorizes Panza (or his successors) “the right to have the work constructed or realized, provided that this is done by reference to and in strict and exact compliance with the Document and all of the details and instructions set forth therein and provided further [that Judd is notified accordingly].”⁴⁵ This language is prototypical of an intellectual property license.⁴⁶ The author/owner of an intangible legal interest (Judd) is permitting an authorized party (Panza) to use that legal interest. The right is then made expressly subject to various limitations. The legal function being performed by the document has strayed far from the realm of retrospective authentication and entered that of prospective permission and post-sale control.⁴⁷

42. According to documents in the Panza Collection Initiative, although the date of the artwork is indicated as 1972–1973 on first page of the certificate, the certificate was itself executed in 1975, at the behest of Panza. See Object Lessons Symposium Screenshots, *supra* note 12 (showing 1975 execution date on final page of document).

43. Donald Judd, Certificate for *Untitled [Seven plywood boxes: open back]*, GUGGENHEIM MUSEUM (1972–1973) [hereinafter Judd Certificate], available at <https://www.guggenheim.org/conservation/the-panza-collection-initiative/donald-judd> [https://perma.cc/DM7G-K3UQ]. This work is one of the nine Judd works fabricated by Panza that the Guggenheim recently classified as “decommissioned” because of Judd’s objections to its purportedly shoddy and unauthorized realization. See Bettaglia, *supra* note 13.

44. The document further cross-references other “construction information” in the possession of Peter Ballantine, a longtime fabricator of Judd’s works. Judd Certificate, *supra* note 43.

45. *Id.* “Document” is a defined term and includes the extrinsic construction information in Ballantine’s possession, referenced above.

46. See *infra* Part II(B).

47. In later writings, Judd excoriated Panza for unilaterally recreating and installing the subject works without Judd’s involvement. See JUDD, *supra* note 1, at 646–47 (“Panza ignored instructions over and over and made my work himself. He never asked about an installation; he just did it. Is it interesting now, or in a century, to see Panza’s construction of my work or his version of its

Many other artists working in conceptual and performance-based practices throughout the 1970s were active users of certificates, generally tasking them to serve dual roles as a form of authentication and guide for installation. LeWitt's well-known form of certificate for his wall drawings described and illustrated parameters of the work that LeWitt intended for the purchaser to recreate on a wall of the purchaser's choosing.⁴⁸ Dan Flavin used certificates in much the same fashion to both authenticate and inform a purchaser how to recreate his neon light installations.⁴⁹ Gordon Matta Clark, best known for his dramatic and performative "cuts" of actual buildings, created a "Certificate of Authenticity and Ownership" for a planned cut of his home in 1976.⁵⁰ That document first "certifies" (in the present tense) "the work described here" as "authentic." But it goes on to detail the planned work in the future tense ("the artist home *to be* cut into two-foot sections") and makes clear that the certificate was created "before the completed project date."⁵¹

Unlike Judd's certificate for Panza, neither LeWitt's, Flavin's, nor Matta Clark's certificates make express contractual demands on their owners concerning fabrication or performance of the work. Nevertheless, they generally mandate, in some combination, that the certifying document (i) shall itself not be considered the artwork, (ii) may not be reproduced, and/or (iii) must accompany the work if transferred.⁵²

B. *Later Permissive Certificates (1980s and 1990s)*

By the late 1980s, these early forays into memorializing art on paper by Judd, LeWitt, Matta Clark, Flavin and others crystallized into

installation? It's better that the work doesn't exist than be wrong. It's not made to be wrong.").

48. See generally Karol, *supra* note 17, at 187–90 & apps. A and B.

49. Dan Flavin, certificate for *Untitled (1970)*, in *In Deed Catalog*, *supra* note 7. Although Flavin's certificates are particularly sparse, even he makes gestures at artistic control by noting: "This is a certificate only. It is not a drawing of mine." *Id.* According to Joan Kee, Flavin actually employed a two-step process whereby he would "partly certify" the work upon purchase of the instructions, and then later "'completely' certify it upon . . . execution." KEE, *MODELS*, *supra* note 30, at 204.

50. Gordon Matta-Clark, *Certificate of Authenticity and Ownership (1976)*, in *In Deed Catalog*, *supra* note 7, at 37. For a general discussion of Matta Clark's "cuts" as well as his other law-infused works, see KEE, *MODELS* *supra* note 30, at 103–28.

51. *Id.* (emphasis added).

52. See, e.g., Karol, *supra* note 17, app. B ("This certification is the signature for the wall drawing and must accompany the wall drawing if it is sold or otherwise transferred."); *id.* ("This is a diagram . . . but is not a certificate or a drawing."); Flavin, *supra* note 49, at 20 ("This is a certificate only. It is not a drawing of mine."); Matta-Clark, *supra* note 50, at 37 ("This document . . . shall at no time be reproduced as a work . . . [A]ny work . . . shall be considered fake and of no commercial value unless accompanied by this signed document . . . No duplicates or replacements of this document will be made at any time.").

certifying instruments that purport to control as much as they authenticate and instruct. Felix Gonzalez-Torres, for example, began creating multi-page, legalistic certificates of authenticity for his ephemeral candy spills, paper stacks and other works.⁵³ He continued this practice throughout the early nineties until his tragically early death in 1996, after which point his estate and The Felix Gonzalez-Torres Foundation took over issuing (and reissuing) them for works created during his lifetime.⁵⁴

Figure 3⁵⁵



Felix Gonzalez-Torres, “Untitled” 1989/1990, Print on paper, endless copies, 26 in. at ideal height x 29 x 56 in. overall (Original paper size: 29 x 23 inches).

Take Gonzalez-Torres’s “Untitled” 1989/1990, a work consisting of “endless copies” of two of stacks of printed paper, each about twenty-six inches high.⁵⁶ The work consists of two stacks of paper printed anew for each exhibition. The text on one stack reads, “[s]omewhere better than

53. See generally KEE, MODELS, *supra* note 30, at 191–226.

54. See Joan Kee, *Felix Gonzalez-Torres on Contracts*, 26 CORNELL J.L. & PUB. POL’Y 517, 518 (2017) [hereinafter Kee, *Felix Gonzalez-Torres*]. As Kee explains, Gonzalez-Torres’s own certificate-issuing practices evolved over time with later certificates being issued by his estate after his death. According to Kee, Gonzalez-Torres never consulted an attorney in preparing the documents, though his foundation now does. KEE, MODELS, *supra* note 30, at 203–04.

55. © Felix Gonzalez-Torres. Courtesy of The Felix Gonzalez-Torres Foundation.

56. The complete certificate to “Untitled” 1989/1990, may be found at 26 CORNELL J.L. & PUB. POL’Y app. A at 1–6 (2017) [hereinafter “Untitled” 1989/1990 Certificate].

this place.”⁵⁷ The other, “[n]owhere better than this place.”⁵⁸ In 2002, Gonzalez-Torres’s estate and gallery posthumously issued the works accompanying “Certificate of Authenticity and Ownership” to a buyer that countersigned it.⁵⁹ The certificate expressly grants the new owner the “right to reprint sheets from the stacks at any time for the purposes of recreating or regenerating the stacks.”⁶⁰

The intention of the piece—and the reason why reprinting is so essential to its actualization—is that “third parties may take individual sheets from the stacks.”⁶¹ In other words, viewers are invited to take away individual sheets from each installation of the work, thus creating a participatory and interactive element of the work.⁶²

Even more so than the Judd certificate, the six single-spaced pages of the ownership document consist of language designed to simultaneously guide and limit the owner’s use and resale of the work. The terms range from technical suggestions (a recommended typeface and font size for the text) to dense and strict restrictions on resale (including, most prominently, a right of first refusal on behalf of the Andrea Rosen Gallery and Felix Gonzalez-Torres Foundation).⁶³ The document goes so far as to purport to restrict non-parties’ rights in the take-away copies by asserting that “no one owning a single sheet taken away at an exhibition has the right to reprint, publish or otherwise commercially use the sheet[.]”⁶⁴

The primary purpose of issuing these certificates was “to reassure owners who found it difficult to see how an idea could be a unique work of art.”⁶⁵ That is, buyers of conceptual works demanded something tangible that could serve as the locus of value for the piece.⁶⁶ Just as Panza, the early conceptual collector, pushed artists to create certificates in part

57. *Id.* at 1.

58. *Id.*

59. *Id.*

60. *Id.*

61. *Id.* at 2.

62. To that end, this author took away a pair of sheets from an installation of “*Untitled*” 1989/1990 Certificate in Miami, which remain in his office.

63. *Id.* at 1.

64. *Id.* It is difficult to imagine how such a quasi-contractual restriction could be enforced against a visitor that has taken away a sheet of paper, as the certificate is never shown to, let alone signed by, the museum-going public. In fact, the Felix Gonzalez-Torres Foundation refused to allow a certificate to be included in the In Deed show, effectively blocking the public from being aware of its terms. The Felix Gonzalez-Torres Foundation, correspondence from 2010 in In Deed Catalog, *supra* note 7, at 25 (reprinting email of denial).

65. Kee, *Felix Gonzalez-Torres*, *supra* note 54, at 522–23.

66. See generally Buskirk, *Public Experience*, *supra* note 6 at 471–73.

to assure Panza of his ownership rights, buyers of Gonzalez-Torres works required documentation of their purchases.⁶⁷

Despite (or perhaps because of) these restrictions, the right to exhibit and reproduce two different Gonzalez-Torres paper stacks (in the form of these certificates) have sold at auction for \$770,500⁶⁸ and \$1.65 million,⁶⁹ respectively, with his equally dematerialized candy spill works having sold for almost ten times that amount.⁷⁰

C. *Permissive Certificates After 2000*

Permissive Certificates with express artist control provisions have all but become an industry custom for artworks with a conceptual or reproducible component. Most commonly, they are associated with the now-common acquisition of video and other “time-based” artworks that have long been understood to require copyright permissions, in addition to possession of the content itself, to be publicly displayed.⁷¹ Their reach, however, is far broader than time-based works, extending to many different media and practices.

To take one representative example, Cerith Wyn Evans’s *With the Advent of Radio Astronomy . . . (Clear)*, created in 2010, consists of a paragraph of text (seventy-three words long) written by the artist.⁷² Like many works of text art, the words are printed in glossy vinyl and affixed to a wall with an adhesive.⁷³ There are no prescribed dimensions for the

67. *Id.* at 472 (“[T]he documents that appear in Panza’s files were clearly instigated by the collector rather than by the artist—with Panza wanting evidence of ownership not only for pieces purchased as objects, but far more urgently, for a number acquired in the form of plans for future works.”).

68. See Auction results listing for *Felix Gonzalez-Torres: “Untitled” (Blue Mirror)*, SOTHEBY’S: CONTEMPORARY ART DAY AUCTION 463 (Nov. 14, 2012, 9:30 AM), <http://www.sothebys.com/en/auctions/ecatalogue/2012/contemporary-art-day-auction-n08901/lot.463.html> [<https://perma.cc/SXV4-WSG7>].

69. See Auction results listing for *Felix Gonzalez-Torres: “Untitled” (Aparición)*, SOTHEBY’S: CONTEMPORARY ART EVENING SALE 3 (May 11, 2011, 7:00 PM) <http://www.sothebys.com/en/auctions/ecatalogue/2011/contemporary-i-n08744/lot.3.html> [<https://perma.cc/5FUV-BHMU>].

70. See Karol, *supra* note 17, at 200. The concept of “dematerialization” in art was introduced in a canonical essay on conceptual art coauthored by Lucy R. Lippard and John Chandler. See Lucy R. Lippard and John Chandler, *The Dematerialization of Art*, ART INT’L 12.2, at 31–36 (Feb. 1968) (observing that “a trend appears to be provoking a profound dematerialization of art, especially of art as object, and if it continues to prevail, it may result in the object’s becoming wholly obsolete”).

71. Karol, *supra* note 17, at 200–02 (describing conventions concerning licenses for time-based works).

72. See Online Listing for *Cerith Wyn Evans: With the Advent of Radio Astronomy*, WHITE CUBE (Jan. 22, 2018) [hereinafter WHITE CUBE Online Listing], http://whitecube.com/shop/editions/cerith_wyn_evans_with_the_advent_of_radio_astronomy_grey/ [<https://perma.cc/4MN3-BL3Z>].

73. *Id.*

piece; however, one exhibited version was about one-half meter by one-and-one-half meters as mounted.⁷⁴

A collector wishing to purchase an edition of *With the Advent of Radio Astronomy* from Evans's gallerist, White Cube in London, could attain the piece directly through an online shopping basket from the gallery's website for just over £1,000.⁷⁵ What exactly, though, is the collector attaining for that price? The entire paragraph of text constituting the work is provided on the public website, meaning there is nothing secret about the words themselves. The purchaser receives a CD containing a digital image of the text, as well as "installation instructions," however it is difficult to imagine someone who could not figure out how to print and mount the text on a wall themselves by just looking at the installation shot on the gallery's website.⁷⁶

The true value to the collector of this otherwise easily reproducible work, of course, is the "Certificate of Authenticity" which accompanies the piece.⁷⁷ That document is a quintessential example of Permissive Certificates in contemporary practice. It satisfies the collector's desire for genuineness in that it clearly and expressly "certifies the authenticity of the above work" and is signed and dated by the artist himself.⁷⁸ In that regard, it mimics traditional fine art warranties of genuineness.⁷⁹

Yet, as with most of the preceding examples, the lion's share of the instrument consists of limiting language that circumscribes the purchaser's rights and serves a double function as instructions:

Requirements for reproduction:

- Polymeric high-performance vinyl 9899–90, Clear, thickness 66 microns.
- No minimum or maximum dimensions apply.
- Only to be reproduced using the pdf file supplied at the time of purchase.
- Only one copy of the artwork should be displayed by a single owner at any given time.

74. *Id.* The work is one edition of twenty-five. *Id.*

75. *Id.*

76. *Id.*

77. Cerith Wyn Evans, Certificate, *With the advent of Radio Astronomy* in In Deed Catalog, *supra* note 7, at 71 [hereinafter Evans Certificate].

78. *Id.*

79. *See infra* Part II(A).

- Apart from the scale of the text, there must be no other modifications to the design, which must remain as specified.⁸⁰

In no uncertain terms, the document then goes on to connect its certification function to its control function: “Any reproduction of the above work is only guaranteed to be an authentic work of art by Cerith Wyn Evans when all reproductions requirements listed above have been met and accompanied by this certificate.”⁸¹ Finally, the certificate reserves all intellectual property rights in the artist.⁸²

D. *The Paradox of Permissive Certificates*

The Evans Certificate reveals in particularly stark terms the central paradox behind every one of the Permissive Certificates described above. Namely, in the same document through which Evans gave a present, unconditional warranty of genuineness, he conditioned future endorsements *of the same work* on the owner fulfilling certain requirements prospectively.

In essence, these legal instruments are simultaneously making the following two statements:

- (i) I presently certify that the existing thing described in this document, A, is an artwork by me that is owned by you; and
- (ii) I will in the future certify that the thing to be created pursuant to this document, A, is an artwork by me that is owned by you if and only if my rules for A are followed.⁸³

There is, to be sure, no inherent logical inconsistency in these statements. The two claims are being made with respect to different points in time, one present and the other future. One can approve of an activity now but disapprove of the way it is being conducted later.

The difficulty, though, is that these sorts of highly conditional guarantees go against the very essence of traditional fine art warranties. Warranties, traditionally conceived, certify that an already existing thing has a set of properties at the time of sale.⁸⁴ For instance, in order to assure a doubtful buyer, a dealer might warrant that a particular artist painted a

80. Evans Certificate, *supra* note 77, at 71 (emphasis in original). The certificate elsewhere specifies, among other things, that it is not itself “a work of art and must not be displayed as such” and that it “will . . . not be reissued if lost.” *Id.*

81. *Id.*

82. *Id.*

83. *Id.*

84. *See infra* Part II(A).

particular work.⁸⁵ These promises concern actual objects, created at some point in time prior to the issuance of the warranty. The fight is over the accuracy of a set of historic facts concerning their origin.

By contrast, Permissive Certificates purport to warrant authorship of objects to be created and/or events to be performed in the future. Although in almost all cases, the subject “work” is spoken of in the past tense, as having been created by the artist/author prior to the creation of the instrument, the physical manifestations of that work are yet-to-be-realized. This is fundamentally and deeply at tension with the retrospective essence of traditional fine art warranties.

Using Evans’s case as an example, the buyer has purchased one of a predetermined twenty-five editions of *With the Advent of Radio Astronomy*. And the certificate repeatedly references the work in the past tense, as a thing already in existence. The language and structure of the document is thus far consistent with traditional certifications of fine art as authentic as of the time of sale. But that is where any consistency with traditional warranties ends.

Specifically, the physical manifestation of that edition of the work—the adhesive vinyl wall text—has not yet been created by the buyer at the time of sale. The buyer, after all, is expressly permitted to reproduce the text for that edition as often as the buyer wishes from the digital file, so long as there is never more than one copy displayed at any given time. So, while the edition is one of twenty-five, that particular edition itself can be recreated (by physically reprinting the vinyl letters) an infinite number of times. The edition is, really, one of an infinite number of possible physical versions of the work, with each actualization calling for separate authentication with each future printing.

Much the same can be said for higher-value single-edition works, like those of Gonzalez-Torres. There is only ever one “*Untitled*” 1989/1990, and it was created by Gonzalez-Torres while he was alive. That point is made expressly in the certificate.⁸⁶ It is intentionally a conceptual piece that evolves over time but remains one “unique” work. To the extent that the genesis of the content of that work predates the act of certification, it is again consistent with traditional warranty practice.⁸⁷ But the warranty collapses prospectively. It is, in effect, purporting to certify the factual

85. See, e.g., *Rogath v. Siebenmann*, 129 F.3d 261, 26263 (2d Cir. 1997) (dispute over scope of warranty contained in bill of sale for a Francis Bacon self-portrait of dubious authenticity).

86. See “*Untitled*” 1989/1990 Certificate, *supra* note 56, at 1 (specifying “‘*Untitled*’, 1989/1990 . . . is a unique work of art owned by [the named owners] . . . The physical manifestation of this work in more than one place at a time does not impugn this works uniqueness since its uniqueness is defined by its ownership, verified by” the certificate).

87. *Id.*

accuracy of a thing-to-be-created (two printed stacks of paper) in the future.

To see this, just imagine a printing for a new exhibition that includes a typo in one of the stacks. Perhaps the paper reads, “somewhere better than this place.” This is clearly not the work. The error completely alters the meaning of the sentence, rendering it a common homonym error that would convey an entirely different message to a viewer.

But in order to make that determination (that is, in order to de-authenticate this iteration of the work) a current and new appraisal must be made. This might involve looking to the earlier-created certificate, and comparing its instructions to the current, erroneous stacks. The certificate tells us it is real, and by Gonzalez-Torres, but only if the proper sentence is used.⁸⁸ This is a conditional verification and, as such, it requires someone (gallerist Andrea Rosen, say, or the Gonzalez-Torres Foundation, or some other person designated as an expert) to look at the reprint to vouch for its accuracy or, in this case, expose its error. Critically, however, this requires a new, present-day recertification of a now-historic object (the stack printed for the current exhibition).

The paradox, then, is that artists are certifying that a work is genuine but because the works are, by definition, reproducible, each and every reproduction necessitates a new appraisal and recertification. In fact, to the extent that the original certificate purports to be able to authenticate a later iteration, it is making a misleading claim. It is impossible to swear to the truth of a fact that has not yet happened. The later iteration, to serve a valid warranty function, necessitates some later expert’s recertification.

One might be tempted, at this point, to simply chalk the paradox up to the notoriously elusive nature of conceptual art. It is an entire aesthetic premised on the slipperiness of the idea of a static “artwork,” and might simply be too inherently subversive for traditional legal doctrines to digest.⁸⁹ But there is, in fact, a straightforward and well-developed legal regime that can make sense of, and justify, this paradox of Permissive Certificates.

II. CERTIFICATES AS LICENSES

This Part argues that the apparent paradox of Permissive Certificates results from their performance of a double function under a single name. These instruments are an amalgam of two highly divergent legal

88. *Id.* (detailing precise language to be printed on the sheets).

89. *Cf.* Michael J. Madison, *The End of the Work as We Know It*, 19 J. INTELL. PROP. L. 325, 328–29, 350–52 (2012) (exposing misfit between the notion of the “work” in conceptual art and U.S. copyright law).

paradigms that have been pressed into service together in one document. Once these two functions are disaggregated, the paradox evaporates.

On the one hand, as their name suggests, they serve a retrospective authentication function as a warranty. This warranty, however, is narrower than that typically used in fine art transactions. It is a guarantee that the named artist created the aesthetic content of the work. This is related to, but more limited than, the conventional fine art warranty that assures a buyer that the named artist created (or supervised the creation of) a specific and existent tangible object.

The secondary function of these certificates, however, is at once less transparent and more meaningful to buyers of works with a conceptual or otherwise reproducible component. Namely, they provide a conditional set of permissions. Although these can vary from work to work, the documents generally may be read to include at least the following core permissions: (i) to make and display reproductions of the physical manifestations of the work; (ii) to perform any acts necessary to realize the piece; and (iii) to associate the artist's name with the future realization of the work and call it genuine.

Before discussing these permissions below, it is important to note at the outset that they are *conditional*. Should a buyer/licensee of a work not follow rules that are expressly or impliedly stated in the certifying instrument, then the permissions may be withdrawn. In short, the secondary function of Permissive Certificates is to provide forward looking, but conditional, permissions to create something genuine and associate it with a particular source. And that tracks the essential structure of an intellectual property license.⁹⁰

A. *Permissive Certificates as Narrow Warranties of Authorship*

Broadly understood, a contractual warranty is simply “a seller’s promise that the thing being sold is as represented or promised.”⁹¹ Thus,

90. For prior observations along these lines, see Eduardo M. Peñalver & Sergio Muñoz Sarmiento, *Law in the Work of Felix Gonzalez-Torres*, 26 CORNELL J.L. & PUB. POL’Y 449, 452–53 (2017) (“[P]erhaps under certain circumstances, it is more appropriate to think of the collector of Gonzalez-Torres works as a mere licensee.”); Daniel McClean, *Authenticity in Art and Law: A Question of Attribution or Authorization?* in *In Deed Catalog*, *supra* note 7, at 93 (describing certificates in conceptual art as “authorizing the owner to fulfill the work”); Kee, *MODELS*, *supra* note 30, at 204 (calling Gonzalez-Torres certificates “hybrid license-contracts”); Kee, *Felix Gonzalez-Torres*, *supra* note 54, at 518 (2017) (observing of Gonzalez-Torres’s early certificates that they “tended to resemble a hybrid of a conventional certificate of authenticity and a set of instructions”). Buskirk also clearly recognizes that these certificates have the power to form contractual bases for artists to control their work. Buskirk, *Public Experience*, *supra* note 6, at 476.

91. *Warranty*, BLACK’S LAW DICTIONARY 1821 (10th ed. 2014).

art warranty disputes have long boiled down to case-specific inquiries over what, exactly, the seller promised to the buyer especially with respect to representations over who painted or otherwise created the work.⁹² Given the heavily fact-specific nature of these cases, it is dangerous to generalize about authenticity claims.⁹³ That said, key art market jurisdictions such as New York have been at pains to lock down the definitions, once and for all, of attributive language typically used in certificates of authenticity.⁹⁴

What, though, can these traditional fine art authenticity laws—created with tangible objects in mind—teach us about the legal effect of a forward-looking Permissive Certificate such as that used by LeWitt, Judd, Evans or Gonzalez-Torres? Of particular interest for these purposes, New York legislators were acutely aware of the problem of “multiples” in crafting their legislation concerning certificates of authenticity.⁹⁵

92. For instance, in a classic nineteenth century case, a jury interpreted a bill of sale containing the language “Four pictures, Views in Venice, Canaletto” to be a warranty of genuineness that the artist Canaletto painted the work, as opposed to a mere expression of opinion. *Power v. Barham*, 111 Eng. Rep. 865, 865–66 (K.B. 1836) (upholding jury’s determination that bill of sale was a warranty). The court affirmed this verdict, despite an earlier case having come out the opposite way for an analogous attribution in a different catalog. *Id.* at 866; *cf. Jendwine v. Slade*, 170 Eng. Rep. 459, 459–60 (N.P. 1797) (simply putting the name of an artist opposite a picture in a catalog is a statement of opinion and not a warranty).

93. Modern art warranty cases in the United States remain similarly fact-specific, with parties regularly fighting over the meaning of contractual representations made by sellers. The disputes, however, are typically now channeled through modern statutory frameworks such as the Uniform Commercial Code (U.C.C.) and various state law art market regulations. *See, e.g.*, U.C.C. § 2-313(b) (“Any description of the goods which is made part of the basis of the bargain creates an express warranty that the goods shall conform to the description.”); *Christie’s Inc. v. SWCA, Inc.*, 867 N.Y.S.2d 650, 655–57 (Sup. Ct. 2008) (analyzing complicated set of letter agreements through framework of New York Art and Cultural Affairs Law § 13.01). In the sculpture context, disputes can concern later casts from an original authentic mold, or new casts made from earlier casts, known as *surmoulage*. *See Hecker, supra* note 40, at 4 (defining *surmoulage* and related notions); *Christie’s Inc.*, 867 N.Y.S.2d at 653 (whether a description of a Picasso sculpture as genuine and not *surmoulage* had a reasonable basis in fact was a factual dispute preventing summary judgment over liability for rescinded sale).

94. *See generally* N.Y. ARTS & CULT. AFF. LAW § 13.01 (McKinney 2018). After first tracking the U.C.C. in clarifying generally that “material facts” stated in a certificate of authenticity operate as an “express warranty.” *Id.* at § 13.01(1)(b). The New York law goes on to list common attributive language in certificates, and defines the legal meaning of those terms:

- (a) The work is by a named author or has a named authorship, without any limiting words, means unequivocally, that the work is by such named author or has such named authorship;
- (b) The work is “attributed to a named author” means a work of the period of the author, attributed to him, but not with certainty by him; or
- (c) The work is of the “school of a named author” means a work of the period of the author, by a pupil or close follower of the author, but not by the author.

Id. at § 13.01(3).

95. *Id.* at § 11.01(21). Multiples, under the statutory definition, are “prints, photographs, positive or negative, sculpture and similar art objects produced in more than one copy” that sell for over a

Although the definition of “multiples” does not expressly encompass creations as difficult to define as text art and Felix Gonzalez-Torres paper stacks, the final catch-all clause (“similar art objects”) seems broad enough safely to cover almost all works existing in more than one copy so long as they have at least some tangible (“object”) component.

What is beyond dispute is that the drafters clearly meant for statements of authorship in certificates of authenticity to apply with equal force to originals as to multiple-editioned works.⁹⁶ Critically, where a certificate of authenticity of any type—multiple or original—states that a “work is by a named author or has a named authorship,” this “means[,] unequivocally, that the work is by such named author or has such named authorship.”⁹⁷ Elsewhere the statute equates being both an artist and an author of a multiple with being the person who is the “creator” of that work.⁹⁸

Putting all this together, it is fair to conclude that the New York statute (perhaps one of the most specific of its type in defining the meaning of certificates of authenticity) mandates that where Permissive Certificates name an author, that author must have “created” the underlying work.⁹⁹ The initial authentication function of certificates thus assures buyers that the artist identified in the certificate created the aesthetic content of the work.

B. *Permissive Certificates as Licenses*

The limited retrospective warranty of content creation, however, cannot be all that a buyer of a conceptual work is attaining. As discussed at length above, the owner of Evans’s *With the Advent of Radio Astronomy*

baseline price. *Id.*

96. *Id.* at § 11.01(6) (“‘Certificate of authenticity’ means a written statement by an art merchant confirming, approving or attesting to the authorship of a work of fine art *or multiple*, which is capable of being used to the advantage or disadvantage of some person.”) (emphasis added)). The definition of “[c]ertificate of authenticity” expressly covers “multiples,” as do both the definitions of “artist” and “author.” *Id.* at §§ 11.01(1), (3). Section 13.05, moreover, generally applies the main warranty provisions (section 13.01) to multiples. *Id.* at §§ 13.01, 13.05.

97. *Id.* at § 13.01(3)(a).

98. *Id.* § 11.01(1), (3). The definition of “[a]rtist” further adds that an artist of a multiple is the person who “conceived or created the image” underlying the work. *Id.* § 11.01(1).

99. I do not mean to suggest that the New York legislature or judges interpreting these statutes are the final arbiters of what is or is not an authentic artwork. As Professor Laura Heymann reminds us in an extended discussion of authenticity, “the law’s pronouncements regarding authenticity can only carry so much weight.” Heymann, *Dialogues*, *supra* note 23, at 48–49. There are many instances where judges have concluded that a work is or is not authentic through legal processes, only to find that the market rejected that conclusion. *Id.* For these purposes, I am only referring to legal (and not market-based) means of authentication.

expects to print anew and exhibit on a wall a paragraph of adhesive vinyl text, and the owner of Gonzalez-Torres's "*Untitled*" 1989/1990 expects to reprint and allow visitors to take away sheets from two stacks of paper.¹⁰⁰ Giuseppe Panza, for instance, the original purchaser of Judd's *Untitled [Seven plywood boxes: open back]* fabricated the sculpture described in the certificate after he attained it, with little to no supervision by Judd and, indeed, over the artist's objections.¹⁰¹

This section shows how the essentially prospective function of a Permissive Certificate defines it as, in large part, a non-patent intellectual property license. First, it briefly explains the operation of copyright licenses, showing how they are structured to grant reproduction rights of the sort central to an owner's realization of conceptual, post-representational and new media works. Second, it explains the relationship between authentication and labeling—that is, why the owner of a genuine article generally has the right to truthfully reveal and advertise its source. Finally, using two of the examples described above, it predicts that U.S. courts would likely interpret these documents to create a contractually enforceable copyright license coupled with proof of authenticity sufficient to justify use of the artist's name in connection with exhibiting and reselling the work.

1. *The Basic Structure of Intellectual Property Licenses*

a. *Affirmative Licenses*

At its core, a license is "a permission . . . to commit some act that would otherwise be unlawful."¹⁰² A license primarily operates in a negative capacity, preventing the property owner from enforcing a legal right it would otherwise have. In the intellectual property context, "the licensee is engaging in acts which would infringe . . . but for the permission granted in the license."¹⁰³

100. See *supra* Part I(B).

101. See The Solomon R. Guggenheim Foundation, *Donald Judd*, GUGGENHEIM, <https://www.guggenheim.org/conservation/the-panza-collection-initiative/donald-judd> [https://perma.cc/DM7G-K3UQ]. For Judd's general opposition to Panza's unsupervised installations of his works, see JUDD, *supra* note 1; KEE, MODELS, *supra* note 30, at 201.

102. *License*, BLACK'S LAW DICTIONARY 1059 (10th ed. 2014). As one court summarized it in a copyright case, "The word 'license,' means permission, or authority; and a license to do any particular thing, is a permission or authority to do that thing." *Ticketmaster LLC v. RMG Techs., Inc.*, 507 F. Supp. 2d 1096, 1106 (C.D. Cal. 2007) (quoting *Fed. Land Bank of Wichita v. Bd. of Cty. Comm'rs*, 368 U.S. 146, 154 n.23 (1961)).

103. 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 18:79, at 18-213 (5th ed. 2019).

Not surprisingly, then, trademark, copyright, and right of publicity licenses are simply permissions to use the grantor's copyrighted work,¹⁰⁴ trademark,¹⁰⁵ and publicity rights,¹⁰⁶ respectively.¹⁰⁷ Courts will generally recognize such licenses so long as the alleged licensor owns an identifiable trademark, copyright, or publicity interest, and a signed, written instrument before the court can be read to grant permission to use that interest "with reasonable clarity."¹⁰⁸

This assumes that the licensed interest is valid. Under the doctrine of copyright misuse, for instance, a copyright license may not be extended to protect otherwise uncopyrightable ideas.¹⁰⁹ This raises some concerns with respect to artworks with conceptual content, as a substantial body of scholarship questions the copyrightability of fundamentally conceptual works.¹¹⁰ Professor Amy Cohen, for instance, focuses on the

104. 2 WILLIAM F. PATRY, *PATRY ON COPYRIGHT* § 5:118, at 5-279 (2019).

105. *Bunn-O-Matic Corp. v. Bunn Coffee Serv., Inc.*, 88 F. Supp. 2d 914, 920–21 (C.D. Ill. 2000).

106. 2 J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 10:15, at 475 (2d ed. 2019).

107. U.S. moral rights under Visual Artists Rights Act (VARA) cannot be "transferred," however they may be waived if done so in writing. 17 U.S.C. § 106A(e) (2012). A waiver, which essentially "permit[s] the author to hold harmless activity that in the absence of a waiver would violate VARA," operates much like the licenses discussed above. 5 WILLIAM F. PATRY, *PATRY ON COPYRIGHT* § 16:37, at 16-77 (2019).

108. *Weinstein Co. v. Smokewood Entm't Grp., LLC*, 664 F. Supp. 2d 332, 340 (S.D.N.Y. 2009) (quoting *Rico Records Distributions, Inc. v. Ithier*, No. 04 Civ. 9782(JSR), 2006 WL 846488, at *1 (S.D.N.Y. Mar. 30, 2006)). As one court famously noted with respect to the minimal requirements for a statutory, exclusive copyright license, "It doesn't have to be the Magna Charta; a one-line pro forma statement will do." *Effects Assocs., Inc. v. Cohen*, 908 F.2d 555, 557 (9th Cir. 1990); *see, e.g., Ticketmaster LLC v. RMG Techs., Inc.*, 507 F. Supp. 2d 1096, 1108 (C.D. Cal. 2007) (identifying license in boilerplate website terms of use agreement that authorized limited copying for personal use); *Rico Records*, 2006 WL 846488, at *1 (denying summary judgment where language on checks could amount to exclusive copyright licenses or transfers). A copyright license agreement, moreover, may omit the terms "copyright" or "exclusive rights." *Papa's-June Music, Inc. v. McLean*, 921 F. Supp. 1154, 1159 (S.D.N.Y. 1996). As the focus of this article is on written certificates of authenticity, it will assume for these purposes that there is a written instrument that a court can interpret. That said, a non-exclusive copyright license does not even need to be in writing, as it is not considered a transfer of copyright ownership. *Keane Dealer Servs., Inc. v. Harts*, 968 F. Supp. 944, 947 (S.D.N.Y. 1997) (citing *I.A.E., Inc. v. Shaver*, 74 F.3d 768, 775 (7th Cir. 1996)). Whether a court will imply a non-exclusive copyright license is a heavily fact-dependent question that may include consideration of whether the artist/copyright owner transferred an object (such as an artwork) embodying the copyright. *See, e.g., Corbello v. DeVito*, 777 F.3d 1058, 1067 (9th Cir. 2015) (reversing grant of summary judgment due to existence of "contradictory facts" concerning licensor intent). In *Teter v. Glass Onion, Inc.*, 723 F. Supp. 2d 1138, 1148–49 (W.D. Mo. 2010), for instance, the court found that a visual artist granted an implied license to a gallery allowing the gallery to post images to its website for purposes of reselling the artist's work.

109. *Lasercomb Am., Inc. v. Reynolds*, 911 F.2d 970, 979 (4th Cir. 1990).

110. *See generally* Megan Carpenter & Steven Hetcher, *Function over Form: Bringing the Fixation Requirement into the Modern Era*, 82 *FORDHAM L. REV.* 2221 (2014); Glen Cheng, *The Aesthetics of*

idea/expression dichotomy, worrying that its stringent application to conceptual artworks will cause judges to refuse to recognize copyright protections for art lacking “permanent form” thereby making an impermissible artistic value judgment based on outmoded, classical conceptions of art.¹¹¹

Professor Zahr Said has argued on alternative grounds that “copyright illogically excludes conceptual art from protection on the basis of fixation”¹¹² In other words, the copyright rule excludes from coverage any work which is not “sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.”¹¹³ Professors Megan Carpenter and Steven Hetcher similarly apply a sort of equal treatment principal for art creation in concluding that fixation doctrine should drop its “transitory duration” exclusion in order to avoid “discriminating against important strains of contemporary art.”¹¹⁴

These concerns may be justified for some substantially ideational, transitory or formless works.¹¹⁵ Professor Said, for instance, argues that

Copyright Adjudication, 19 UCLA ENT. L. REV. 113, 127 (2012); Amy B. Cohen, *Copyright Law and the Myth of Objectivity: The Idea-Expression Dichotomy and the Inevitability of Artistic Value Judgments*, 66 IND. L.J. 175, 208, 231–32 (1990); Charles Cronin, *Dead on the Vine: Living and Conceptual Art and Vara*, 12 VAND. J. ENT. & TECH. L. 209, 252 (2010); Joan Infarinato, Note, *Copyright Protection for Short-Lived Works of Art*, 51 FORDHAM L. REV. 90, 91–92 (1982) (arguing a few years after the Copyright Act went into effect that courts should interpret the fixation and other requirements to support copyrightability of “short-lived” environmental and site-specific artworks such as Christo’s “Running Fence”); Madison, *The End of the Work*, *supra* note 89, at 350–52 (critiquing judicial approaches to “dynamic” artworks); Donald M. Millinger, *Copyright and the Fine Artist*, 48 GEO. WASH. L. REV. 354, 359 (1980) (“Conceptual artists, for whom art is the process of creation and for whom the finished product, being merely ancillary, is usually temporary would not meet the fixation requirement.”); Lori Petruzzelli, Comment, *Copyright Problems in Post-Modern Art*, 5 DEPAUL-LCA J. ART & ENT. L. 115, 123 (1995); Zahr K. Said, *Copyright’s Illogical Exclusion of Conceptual Art*, 39 COLUM. J.L. & ARTS 335 (2016).

111. Cohen, *supra* note 107, at 208, 231–32. Working in a more anti-protectionist vein, Lori Petruzzelli describes a 1976 Chris Burden performance piece wherein he served espresso drinks to gallery patrons and later sold the cream pitcher relic for \$24,000. Petruzzelli focuses not on any fixation problems with the performance but rather suggests that in such pieces the idea is effectively merged with the expression. This leads her to the “ridiculous” result that if granted a copyright Burden may be able to stop others from serving coffee or even threaten coffee pitcher makers with an infringement action. She concludes that “the Copyright Act should not be changed to accommodate the specific problems posed by post-modern art.” Petruzzelli, *supra* note 110, at 115, 123.

112. Said, *supra* note 110, at 337.

113. *Id.* at 338 (quoting 17 U.S.C. § 101 (2012) (definition of “fixed”).)

114. Carpenter & Hetcher, *supra* note 110, at 2227.

115. As an example of a substantially ideational work, take for instance Pierre Bismuth’s *Certificate of Authenticity—Ed Ruscha* from 2000. In Deed Catalog, *supra* note 7, at 6. The certificate, signed not by Bismuth but by the conceptual artist Ed Ruscha, consists entirely of a typed sentence stating, “This is to certify that this is not an original work by Ed Ruscha.” It is an arresting piece,

certain recent fixation holdings would likely deny copyright protection to a Gonzalez-Torres candy spill due to its “inherently changing” nature.¹¹⁶ Said nevertheless advocates for an alternative reading of earlier fixation precedent that she hopes sympathetic courts might use in order to save *Untitled (Portrait of Ross in L.A.)* from losing copyright protection. In Professor Said’s view, “[t]hat the viewer’s input has a limited, and predictable, impact on the work constrains the range of possible different versions of the work, and renders it effectively fixed.”¹¹⁷

This work faces serious copyrightability problems, but arguably for different reasons. Both Said and a reversed lower court opinion she cites fail to discuss a more serious fixation challenge than the fact that the work depletes as visitors take candy away. The bigger problem is that the piece has no prescribed form even when first installed in its ideal weight. The dimensions of Gonzalez-Torres’s candy piles are generally left “variable”—meaning that one can place the candy in the shape of a cube or flat rectangle, or, as is more typical, pile the pieces in a corner.¹¹⁸ Thus, there is no predictable range of possible shapes for a candy spill work—and quite intentionally so, from Gonzalez-Torres’s perspective.

Critically for copyrightability purposes, however, this shapelessness does not extend to his paper stack pieces, which are far more fixed in their physical instantiations. Indeed, as demonstrated by my analysis of two representative Permissive Certificates below, including the Gonzalez-Torres stack work, many, if not most, works with some reproducible or conceptual content still contain tightly controlled formal elements that allow the pieces to remain copyrightable.¹¹⁹

challenging us to consider how we “treat the value of signature and the hand versus the overarching idea” as Professors Susan Hapgood and Cornelia Leaf express it. *Id.* at 84. But purely as a “concept” it is almost certainly not copyrightable. 17 U.S.C. § 102(b) (2012).

116. Said, *supra* note 110, at 348 (referencing *Williams Elecs., Inc. v. Artic Int’l, Inc.*, 685 F.2d 870, 874 (3d Cir. 1982)).

117. *Id.*

118. See, e.g., “*Untitled*” 1989/1990 Certificate, *supra* note 56, at 1 (noting, “[e]ach manifestation may physically differ slightly” according to the owner’s ongoing right to interpret the “open-ended yet specific parameters” of the work). The latter certificate does suggest that the “ideal manifestation” of the work is to pour them on the floor where two walls meet (i.e., loosely piled in a corner in the familiar way his work is shown). *Id.* That is not a requirement, however, and even where followed that method results in candies scattering. See “*Untitled*” (*Portrait of Ross in L.A.*), ART INSTITUTE OF CHICAGO, <http://www.artic.edu/aic/collections/artwork/152961> [<https://perma.cc/3VVX-R8VS>] (Art Institute of Chicago listing for “*Untitled*” (*Portrait of Ross in L.A.*) noting “[d]imensions vary with installation”).

119. See *infra* Part II.B. These copyrightability arguments regarding conceptual and minimalist art are beyond the scope of the Article. The point for these purposes, however, is not to argue that all works captured in Permissive Certificates are copyrightable, particularly given how many different and varied art practices use such certificates, but rather that there is at least a colorable claim of

Another material feature of most licensing arrangements is that they create bilateral contracts insofar as *both* parties agree to perform acts under the agreement, and failure to perform can lead to a claim for breach of contract.¹²⁰ Often the licensee is required not only to pay royalties or an up-front payment as consideration for the license, but also to use the copyrighted work or mark or name in certain ways but not others.¹²¹

Critically, uses of licensed rights outside the scope of a copyright license are breaches of the license, and amount to infringements if they are conditions of that license.¹²² The same generally holds for holdover licensees who continue to use the once-licensed works, marks, or names after termination of the license (for instance, after termination for breach).¹²³

These provisions thus provide a substantial amount of ongoing control to the licensor (or artist, in the case of this Article). For instance, where a gallery duly attained a license to post a limited set of existing images of an artist's work on its website, the gallery was exposed to claims of

copyrightability in many cases.

120. *Bilateral Contract*, BLACK'S LAW DICTIONARY 391 (10th ed. 2014).

121. See *Bunn-O-Matic Corp. v. Bunn Coffee Serv., Inc.*, 88 F. Supp. 2d 914, 921–22 (C.D. Ill. 2000) (use of BUNN trademark in form not authorized by license is a breach and an infringement); *PATRY*, *supra* note 104, § 5:126, at 5-295 to 5-296, 5-295 n.1 (copyright licensee “may place conditions on the exercise of a license, and any use inconsistent with those conditions or otherwise outside the scope of the license will expose the licensee to an infringement claim”) (collecting cases).

122. *MDY Indus., LLC v. Blizzard Entm't, Inc.*, 629 F.3d 928, 939 (9th Cir. 2010). A copyright infringement claim based on use outside the scope of the license will hold where (1) the copying is “beyond the scope of a license possessed by the defendant,” . . . and the source of the copyright owner's complaint must be grounded in a right protected by the Copyright Act, such as unlawful reproduction or distribution.” *Storage Tech. Corp. v. Custom Hardware Eng'g & Consulting, Inc.*, 421 F.3d 1307, 1315–16 (Fed. Cir. 2005) (first quoting *Stenograph L.L.C. v. Bossard Assocs., Inc.*, 144 F.3d 96, 99 (D.C. Cir. 1998); and then citing 17 U.S.C. § 106 (2012)). In the trademark context, use by a licensee which is outside the scope of the license is both trademark infringement and a breach of contract. 4 J. THOMAS MCCARTHY, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 25:30, at 25-98, 25-98 n.2 (5th ed. 2019) (collecting cases).

123. See 3 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* § 10.15(A)(3) (2019) (“[U]pon rescission, the assignment or license is terminated and the copyright proprietor may hold the former grantee liable as an infringer for subsequent use of the work.”) (collecting cases); MCCARTHY, *TRADEMARKS AND UNFAIR COMPETITION*, *supra* note 119, § 25:30, at 25-98 (“[C]ontinued use by an ex-licensee after the license has been terminated is an act of trademark infringement.”) (collecting cases).

infringement when it created and posted its own new images of the same works.¹²⁴ The same principle holds on the trademark side.¹²⁵

The right of publicity raises unique issues in the licensing context, due both to state law variations and its close relationship to the right of privacy (which is often treated as an issue of consent or waiver rather than license).¹²⁶ An in-depth analysis of the distinction between licenses and waivers is beyond the scope of this Article. Either way, however, in many cases courts appear equally willing to find that a living person permitted the use of his or her name as they are with the license of a corporate trademark.¹²⁷

b. The Trademark and Right of Publicity First-Sale Doctrine and the Dastar Objection

Although, as just described, it is common practice to grant permission to use trademark and publicity rights, courts often eschew a license-based framework in favor of a first-sale paradigm when it comes to sales or displays of goods that use or embody another's trademark or name.¹²⁸ This is particularly true in the absence of express licensing terms. That is

124. *Teter v. Glass Onion, Inc.*, 723 F. Supp. 2d 1138, 1150 (W.D. Mo. 2010); *see also*, *LGS Architects, Inc. v. Concordia Homes of Nev.*, 434 F.3d 1150, 1156 (9th Cir. 2006), *overruled on other grounds by* *Perfect 10, Inc. v. Google, Inc.*, 653 F.3d 976, 979, 981 (9th Cir. 2011) (use of licensed architectural plans to build additional homes in a new community exceeded the scope of the license and subjected licensee to claims of copyright infringement); *Reinsdorf v. Skechers U.S.A.*, 922 F. Supp. 2d 866, 876 (C.D. Cal. 2013) (use of a licensed photograph beyond the six-month limit in the license exposed company to claims of copyright infringement).

125. *See, e.g.*, *Franchised Stores of N.Y., Inc. v. Winter*, 394 F.2d 664, 668 (2d Cir. 1968) (authorized trademark licensee held a trademark infringer where he used unlicensed syrups in some of his Carvel branded-products and sold some non-Carvel products at Carvel-branded stores).

126. MCCARTHY, *supra* note 106, § 10:30, at 499–501 (collecting state rules). One obvious limitation with rights of publicity licenses is that many states do not (or previously did not) allow the underlying rights to survive death. *See generally* Michael Decker, *Goodbye, Norma Jean: Marilyn Monroe and the Right of Publicity's Transformation at Death*, 27 CARDOZO ARTS & ENT. L.J. 243 (2009) (discussing dispute over posthumous survival of Marilyn Monroe's right of publicity).

127. This is particularly true in the digital environment. *See, e.g.*, *Perkins v. LinkedIn Corp.*, 53 F. Supp. 3d 1190, 1214–15 (N.D. Cal. 2014) (similar holding under California common law right of publicity); *Pratt v. Everalbum, Inc.*, 283 F. Supp. 3d 664, 668 (N.D. Ill. 2017) (finding under Illinois law that plaintiff consented to use of his name by a smartphone app where the app indicated that it would invite his friends, asked for access to his contacts, and informed him that the messages would be sent “via SMS”).

128. *See, e.g.*, *Tiffany (NJ), Inc. v. eBay Inc.*, 600 F.3d 93, 103 (2d Cir. 2010) (holding that reseller eBay may use plaintiff's TIFFANY trademark to describe accurately the genuine Tiffany goods offered for sale on its website); *Dow Jones & Co., Inc. v. Int'l Sec. Exch., Inc.*, 451 F.3d 295, 308 (2d Cir. 2006) (affirming dismissal of trademark complaint where defendant used plaintiff's trademark to accurately describe the name of shares covered by defendant's option products).

because owners of a genuine work do not need permission to call it what it is or resell it as such. As one licensing treatise puts it:

The courts do not imply a license to use a trademark upon the sale of a tangible item bearing the mark. Rather, they have developed the concept of trademark first sale grounded in an idea of “fair use,” allowing use of a trademark truthfully to identify the source of an item.¹²⁹

Under this framework, Tiffany & Co. could not use trademark law to stop eBay from advertising genuine Tiffany merchandise and labeling it accurately as Tiffany.¹³⁰ Nor could McGraw-Hill, the owner of the registered SPDR trademark for exchange-traded funds, prevent an unlicensed option trading exchange from listing and trading genuine SPDR options on its exchange.¹³¹ While a trademark conveys an exclusive right to use the mark, that “right generally does not prevent one who trades a branded product from accurately describing it by its brand name, so long as the trader does not create confusion by implying an affiliation with the owner of the product.”¹³²

This trademark first-sale doctrine is, however, subject to an important limitation for these purposes. Namely, it does not apply “when an alleged infringer sells trademarked goods that are materially different than those sold by the trademark owner.”¹³³ Thus, the Sixth Circuit found error when the district court dismissed a complaint brought by the owner of a trademark for various audiobooks. The owner alleged that its rival was buying, repackaging, and reselling those same audiobooks as different editions for a different market.¹³⁴ The court concluded that the differences between the editions could have been material, so the plaintiff’s claims

129. 2 RAYMOND T. NIMMER & JEFF C. DODD, MODERN LICENSING LAW § 10:32 (2018–2019 ed. 2018).

130. *Tiffany*, 600 F.3d at 103.

131. *Dow Jones & Co.*, 451 F.3d at 308.

132. *Id.*

133. *Brilliance Audio, Inc. v. Haight Cross Commc’ns, Inc.*, 474 F.3d 365, 370 (6th Cir. 2007); *see also Iberia Foods Corp. v. Romeo*, 150 F.3d 298, 302–03 (3d Cir. 1998); *Martin’s Herend Imps., Inc. v. Diamond & Gem Trading USA, Co.*, 112 F.3d 1296, 1301–02 (5th Cir. 1997); *Societe Des Produits Nestle, S.A. v. Casa Helvetia, Inc.*, 982 F.2d 633, 638 (1st Cir. 1992); *Original Appalachian Artworks v. Granada Elecs., Inc.*, 816 F.2d 68, 73 (2d Cir. 1987); *Abercrombie & Fitch v. Fashion Shops of Ky.*, 363 F. Supp. 2d 952, 963–65 (S.D. Ohio 2005) (adopting this rule). This materiality standard is judged not from the trademark owner’s (for instance, artist’s) perspective, but rather from the purchasing public’s (i.e., art buyer’s) perspective, and is judged on a case by case basis. *Brilliance Audio*, 474 F.3d at 370 (quoting *Davidoff CIE*, 263 F.3d at 1302 (“To be material, a difference must be one that consumers consider relevant to a decision about whether to purchase a product.”)).

134. *Brilliance Audio*, 474 F.3d at 370–71.

should have been allowed to proceed.¹³⁵ A different court likewise allowed an artist to proceed with his claim for trademark infringement against a gallery reselling his genuine works, but only because evidence suggested that the gallery created the misimpression that it was a favored or authorized dealer when it was not.¹³⁶

Courts will similarly deny right of publicity infringement claims for downstream (for instance, secondary) resales of genuine goods bearing a celebrity's name or image.¹³⁷ For instance, the Eleventh Circuit denied right of publicity claims brought by representatives of a famous athlete and race car driver against a company that bought genuine trading cards bearing their names and images, mounted them to plaques, and resold them without permission.¹³⁸

As with trademark cases, however, the first-sale defense will not bar right of publicity cases where the goods are not in fact genuine. In a case involving the late photographer Ansel Adams, for instance, right of publicity and trademark claims survived a motion to dismiss allegations that sixty-five "lost" negatives purportedly discovered by plaintiffs were not in fact genuine and, therefore, could not be sold as the work of Adams.¹³⁹

Finally, whenever discussing trademark and right of publicity doctrine in fine art it is important to spend a moment on *Dastar Corp. v. Twentieth Century Fox Film Corp.*¹⁴⁰ In *Dastar*, the Supreme Court held that the unfair competition provisions of the Lanham Act may not be used by an author to challenge the omission of the author's name from a product containing the work (in that case, a videotape).¹⁴¹ That is because the Court read the term "origin" in the Lanham Act narrowly to refer to the origin of the physical product and not the author of the underlying content.¹⁴² In short, *Dastar* ruled that the Lanham Act does not provide a

135. *Id.*

136. *Teter v. Glass Onion, Inc.*, 723 F. Supp. 2d 1138, 1156 (W.D. Mo. 2010).

137. MCCARTHY, *supra* note 106, § 7:31 ("The issue is whether a celebrity (or deceased celebrity's successor) who licenses a product is entitled to a royalty upon every downstream resale of that product thereafter. The first sale defense dictates that the answer is 'no.'").

138. *Allison v. Vintage Sports Plaques*, 136 F.3d 1443, 1450 (11th Cir. 1998) (holding, "as a matter of law, Vintage merely resells cards that it lawfully obtains"). Akin to the material differences exception in trademark doctrine, the first sale doctrine in right of publicity cases does not apply to bona fide goods that have been repackaged to the point of becoming "separate and distinct" products. *Id.*

139. *Ansel Adams Publ'g Rights Tr. v. PRS Media Partners, LLC*, No. C 10-03740 JSW, 2010 WL 4974114, at *3-4 (N.D. Cal. Dec. 1, 2010).

140. 539 U.S. 23 (2003).

141. *Id.* at 37-38.

142. *Id.*

cause of action for failure to credit content creators (so-called reverse-passing-off claims).¹⁴³

It is difficult in the U.S. to even mention trademarks in the art context without being met by the suggestion that the *Dastar* case somehow acts as a bar or heavy limitation against trademark protection in that space.¹⁴⁴ As a substantial swath of scholarship has attempted to show, however, the reach of *Dastar* is not as great as its fearsome reputation might suggest.¹⁴⁵

Relevant to this Article, *Dastar* has been interpreted not to apply to affirmative passing off or false endorsement claims, wherein one falsely uses an artist's name or trademarks to imply that they endorse a work.¹⁴⁶ Indeed, those claims are the exact opposite of the situation in *Dastar*.

In addition, *Dastar* certainly does not limit artists from attaining U.S. trademark rights in their personal names. In the aforementioned case concerning the painter Lee Teter, the court had no objection to Teter asserting his own name as a trademark against his former gallery after a

143. *Id.*

144. To give just one anecdotal example, at a recent conference concerning authenticity in posthumous sculpture at which the author was present, an audience member inquired whether trademarks might play a role in policing posthumous artistic creations. A panelist more or less dismissed the notion with a summary reference to the *Dastar* case. For an overview of the conference, see generally, *The Afterlife of Sculptures: Posthumous Casts in Scholarship, the Market, and the Law*, CATALOGUE RAISONNÉ SCHOLARS ASS'N, <https://www.catalogueraisonne.org/events/2018/5/1/the-afterlife-of-sculptures-posthumous-casts-in-scholarship-the-market-and-the-law> [<https://perma.cc/4635-M4D8>].

145. For scholarly approaches, see, for example, Laura A. Heymann, *The Birth of the Authornym: Authorship, Pseudonymity, and Trademark Law*, 80 NOTRE DAME L. REV. 1377, 1432–44 (2005) (distinguishing *Dastar*-type reverse passing off cases from affirmative passing off cases based on authorship claims); Mark P. McKenna, *Dastar's Next Stand*, 19 J. INTELL. PROP. L. 357, 387 (2012) (concluding, after thorough analysis of *Dastar*'s highly uncertain legacy, that it should be understood to rule out “confusion that is attributable to the content of a creative work,” but not “trademark protection for all copyrightable works”).

146. See, e.g., Adams, 2010 WL 4974114 at *3 (“*Dastar* Doctrine” inapplicable to affirmative false designation and trademark claims brought by artist's estate); Estate of Barré v. Carter, 272 F. Supp. 3d 906, 917, 944 (E.D. La. 2017) (allowing affirmative claim for false endorsement based on use of “persona” over defendant's *Dastar* arguments); Beastie Boys v. Monster Energy Co., 66 F. Supp. 3d 424, 454 n.19 (S.D.N.Y. 2014) (“*Dastar* does not address whether a defendant's unauthorized use of copyrighted works, when occurring in conjunction with the defendant's unauthorized use of protected marks, can support a § 43(a) claim of an implied endorsement.”); Bach v. Forever Living Prods. U.S., Inc., 473 F. Supp. 2d 1110, 1118 (W.D. Wash. 2007) (distinguishing *Dastar* as inapplicable where artist pursues affirmative trademark infringement claims sounding in false endorsement or affiliation as opposed to plagiarism). *Dastar* itself concerned a reverse passing off claim, wherein the defendant (*Dastar*) was accused of false designation of origin based on its failure to credit the original author of the work. *Dastar*, 539 U.S. at 31. Trademark claims likely to arise in the context of certificates of authenticity disputes, involving affirmative use of the artist's name over the artist's objections, are thus the opposite of those at issue in *Dastar*.

change of ownership led to a falling out between the parties.¹⁴⁷ Along these lines, the United States Patent and Trademark Office (USPTO) expressly allows trademark registrations for artists with respect to use of their names or their pseudonyms on their own original works of art.¹⁴⁸ *Dastar* should therefore not be understood as to undermine the basic relevance of trademark and right of publicity law to artists.

2. *The Exemplary Gonzalez-Torres and Evans Certificates are Enforceable Contracts and Express Copyright Licenses that Authorize Use of an Artist's Name*

This section applies U.S. contract and non-patent intellectual property law to two certificates described in the first Part of this Article: the Gonzalez-Torres certificate for “*Untitled*” 1989/1990 and the Evans Certificate for *With the advent of Radio Astronomy*. These two works were selected because both certificates are publicly available and were produced relatively recently, and they are good examples of works with strong conceptual content that regularly sell at auction (Gonzalez-Torres) and commercial galleries (Evans). Moreover, there is at least a plausible argument for applying U.S. law (in particular, the law of New York State) to their interpretation.¹⁴⁹

147. *Teter v. Glass Onion, Inc.*, 723 F. Supp. 2d 1138, 1154–56 (W.D. Mo. 2010).

148. 2 U.S. PATENT AND TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1202.09(b), at 1200–89 (5th ed. 2017). As a general rule, personal names may be trademarks where they have developed secondary meaning in the minds of the public. 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 13:1, at 13-3, § 13:2, at 13-9 (5th ed. 2019).

149. This jurisdiction was chosen primarily for analytic convenience, and because many fine art cases are decided under New York law. With regard to Gonzalez-Torres, the certificate itself was created on Andrea Rosen Gallery letterhead, then a New York gallery with a New York address listed, which is also the location for The Felix Gonzalez-Torres Foundation which purports to own all of his copyrights. “*Untitled*” 1989/1990 Certificate, *supra* note 56; *see About, THE FELIX GONZALEZ-TORRES FOUNDATION*, <http://felixgonzalez-torresfoundation.org/about> [<https://perma.cc/4KLP-X8QL>] (asserting copyright ownership). The certificate for Evans’s piece was created on White Cube gallery letterhead listing a London address, along with a Canadian affiliate. Evans Certificate, *supra* note 77. Nevertheless, the gallery sold the work directly online and shipped outside the European Union. *See WHITE CUBE Online Listing, supra* note 72. This means that it is plausible that New York law would apply were a hypothetical buyer to reside in New York. *See Tarbert Trading, Ltd. v. Cometals, Inc.*, 663 F. Supp. 561, 566 (S.D.N.Y. 1987) (applying New York law to breach of contract dispute between English seller and New York buyer for the sale of Kenyan kidney beans).

a. *The “Untitled” 1989/1990 and Evans Certificates Are Likely Enforceable as Contracts*

As a preliminary formal matter, both the “*Untitled*” 1989/1990 and Evans Certificates are written documents, signed by the artist (Evans) or his agent (the Gonzalez-Torres estate and gallery). Thus, they should both be formally acceptable for enforcement against the artist or artist’s representative.¹⁵⁰

A trickier question is whether the artist could enforce them against the buyer.¹⁵¹ The Gonzalez-Torres case is relatively easy here, as the buyers, Rosa and Carlos de la Cruz, countersigned the certificate.¹⁵² But there is no signature block for the buyers on the face of the Evans Certificate.¹⁵³ Thus, counter-enforceability by Evans against a buyer will likely turn on whether the buyers signed an accompanying bill of sale or invoice.¹⁵⁴ For a signed writing to constitute a binding contract, “the parties must make a manifestation of mutual assent sufficiently definite to assure that they are truly in agreement with respect to the material terms of their contract.”¹⁵⁵ This is known as the “definiteness” requirement, which can be raised to challenge ambiguous writings that omit material terms.¹⁵⁶ Both the “*Untitled*” 1989/1990 and Evans Certificates generally contain an extensive number of definitive and sophisticated contractual requirements

150. U.C.C. § 2-201 (AM. LAW INST. & UNIF. LAW COMM’N 1977). For brevity, I am assuming that the U.C.C. applies to these transactions because they are for the sale of “goods” that are movable, existing and identified at the time of sale. *Id.* § 2-105 (definition of “Goods”). That is generally the case for artworks. *Balog v. Ctr. Art Gallery-Hawaii, Inc.*, 745 F. Supp. 1556, 1562 (D. Haw. 1990) (paintings, prints and sculpture fall within Uniform Commercial Code’s definition of “goods”); *Teter*, 723 F. Supp. 2d at 1150 (“artwork is a ‘good,’ and the sale of artwork is governed by the UCC”). One could argue that conceptual artworks are neither moveable nor existing as goods at the time of sale, but rather are more in the nature of designs or plans. Courts have held that the U.C.C. does *not* apply to the sale of designs, technical drawings, and professional advice by licensors. *See Snyder v. ISC Alloys, Ltd.*, 772 F. Supp. 244, 253 (W.D. Pa. 1991). Such arguments, however, are beyond the scope of this analysis.

151. These documents may be viewed as instruments of artist control; in which case the artist would absolutely want to be able to assert it against the buyer. For this reason, it is advisable that artists have buyers countersign Permissive Certificates as a matter of course.

152. “*Untitled*” 1989/1990 Certificate, *supra* note 56, at 6.

153. Evans Certificate, *supra* note 77.

154. *See infra* note 162, and accompanying text.

155. *Aiello v. Burns Int’l Sec. Servs. Corp.*, 973 N.Y.S.2d 88, 94 (App. Div. 2013). That is, “there must be a meeting of the minds as to the essential terms of the agreement.” *May v. Wilcox*, 582 N.Y.S.2d 294, 294 (App. Div. 1992).

156. *Aiello*, 973 N.Y.S.2d at 94. That said, courts are reluctant to find contracts indefinite, and will only strike down a contract as indefinite as a “last resort.” *Id.* at 95.

that easily meet the definiteness standard.¹⁵⁷ Neither the “*Untitled*” 1989/1990 nor Evans Certificates, however, say a word about payment or consideration of any sort.

This same omission of a price term proved fatal to a contract involving a certificate in a 2010 decision under New York law.¹⁵⁸ In that case, the parties disputed whether a freestanding certificate (entitled a “Certificate of Authority”) given by the copyright owner to the defendant served to extend an expired copyright license for the sale of Russian-language videos. The certificate, however, failed to address the consideration, licensing rate, or obligations of the parties with respect to the works at issue. Thus, the court refused to validate it as a binding copyright license on its own.¹⁵⁹ Despite the similar “certificate” terminology at issue, however, the case is distinguishable from this setting. There, the Second Circuit put great weight on the fact that defendants were attempting to use the Certificate of Authority to extend a prior license that had expired under its own limited terms.¹⁶⁰

Art transactions arise in a very different context. Fine art certificates of authenticity rarely exist in isolation. They are provided to complement bills of sale and not to challenge them. The silence of the certificates themselves is not reflective of the absence of a price term, but that the certificate is not an appropriate place to list it.¹⁶¹ Consistent with this notion, under the Uniform Commercial Code, the price need not appear on the face of the contract because the Code recognizes that in many cases “the parties have based their agreement on a price list or catalogue known to both of them.”¹⁶²

157. *See supra*, Part I(C).

158. *Close-Up Int’l, Inc. v. Berov*, 382 F. App’x 113, 116 (2d Cir. 2010).

159. *Id.* (affirming grant of summary judgment denying existence of copyright or trademark license where a Certificate of Authority was issued “pursuant to the contract in force between the parties” and that contract had expired on its own terms). In the same (unreported) case, the federal appellate court in New York also concluded that a bare document, which was styled a “Certificate of Authority,” could not by itself alter or extend the terms of a complete, prior license agreement that had expired. *Id.* at 115.

160. *Id.* The (unreported) case should thus be understood only to stand for the proposition that a freestanding Permissive Certificate will not be interpreted to alter or extend an otherwise integrated and complete prior agreement between the parties.

161. Among other reasons, the certificates are often made public (as with the two discussed here) and private art buyers and sellers often prefer to keep sales prices confidential. *See, e.g.*, THOMPSON, *supra* note 30, at 193–94 (describing art world resistance to transparent pricing).

162. *See* U.C.C. § 2-201 cmt. 1 (AM. LAW INST. & UNIF. LAW COMM’N 1977). Courts in New York have similarly interpreted bills of sale together with other documents relating to the same fine art transaction to form a single contract if they “form part of a single transaction and are designed to effectuate the same purpose.” *Edelman Arts, Inc. v. Art Int’l (UK) Ltd.*, 841 F. Supp. 2d 810, 823 (S.D.N.Y. 2012) (construing contract for sale of fine art by reading bill of sale in connection with

Turning back to the works at issue here, the Evans piece easily satisfies this standard. The White Cube gallery website advertised a sales listing, complete with the £1,020 sticker price, including the Evans Certificate.¹⁶³

The “*Untitled*” 1989/1990 Certificate is less definitive, but it states that its terms are “integral conditions to the sale of the work” which suggests the existence of a separate but integrated bill of sale or invoice for the piece.¹⁶⁴ So long as the parties created a bill of sale and rendered payment in connection with executing the “*Untitled*” 1989/1990 Certificate, this objection to its enforceability as a contract is readily overcome.

Finally, where “it is clear from the language of an agreement that the parties intended to be bound” the court will “endeavor to hold the parties to their bargain.”¹⁶⁵ Although there is strong evidence of an intent to be bound on the face of the “*Untitled*” 1989/1990 Certificate,¹⁶⁶ intent to bind the buyer is less clear in the Evans case as it lacks a buyer’s signature block. Nevertheless, certain terms in the contract so clearly apply only to the buyer (such as, “[t]his certificate must accompany the work”) that a court might be willing to infer an intent to bind such parties.¹⁶⁷

Some scholars, in particular Professor Joan Kee, have pushed back on a reading of Gonzalez-Torres certificates of authenticity as properly enforceable contracts.¹⁶⁸ In questioning their contractual validity, Kee observes that “the certificates often expressed the artist’s intentions as choices owners could make rather than as conditions that had to be fulfilled, or even obligations they were bound to perform.”¹⁶⁹ Also problematic to Kee is that they do not “specify or suggest how legal sanctions could be taken to force bearers to fulfill the certificates’s terms

related faxes); *see also* Richman v. Brookhaven Servicing Corp., 363 N.Y.S.2d 731, 733 (Dist. Ct. 1975) (“It is not essential to the validity of a contract that the consideration be recited therein since it may be implied, or proved by parol evidence.”); 22 N.Y. JUR. 2D CONTRACTS § 59 (2019) (consideration may be implied and not expressly stated in instrument).

163. *See* WHITE CUBE Online Listing, *supra* note 72. Presumably buyers also received an invoice with actual purchase.

164. “*Untitled*” 1989/1990 Certificate, *supra* note 56, at 6; *see also*, Kee, *Felix Gonzalez-Torres*, *supra* note 54, at 523 (suggesting that the certificates accompanied a bill of sale or invoice).

165. 166 Mamaroneck Ave. Corp. v. 151 E. Post Rd. Corp., 78 N.Y.2d 88, 91 (1991).

166. The final paragraph before the signature block explicitly requires the buyer’s “agreement to these terms which are integral conditions to the sale of the work . . . and completes the binding nature of this contract.” “*Untitled*” 1989/1990 Certificate, *supra* note 56, at 6.

167. Evans Certificate, *supra* note 77.

168. Kee, *Felix Gonzalez-Torres*, *supra* note 54, at 521 (“[T]he lack of enforceability may bar González-Torres’s certificates from being properly known as contracts.”).

169. *Id.* at 519.

or to compensate the artist (or his estate) for non-fulfillment of the same.”¹⁷⁰

Neither of these concerns, however, should prevent a court from reading the certificate here as an enforceable contract. It is certainly true that many of the provisions of Gonzalez-Torres’s certificates intentionally give significant discretion to owners of his works. Gonzalez-Torres left many choices (such as the precise height of the paper stacks in “*Untitled*” 1989/1990 or the arrangement of his candy spills) to the owners of the pieces. These choices are a core component of the aesthetic of the work.¹⁷¹

There is nothing, however, problematic or unenforceable about giving discretion to one party to a contract. Most enforceable contracts contain wide areas of discretion.¹⁷² This is especially true in the field of licensing, where licensees often have significant discretion within parameters built into the use of licensed property. To take just one example, a standard form contract for the reproduction of sculptures found in a commercial database gives the licensee discretion to choose how many sculptures to reproduce up to a maximum amount, where to sell those works in the world, who to retain to manufacture the copies, and when to commence with production.¹⁷³

Nor is there any requirement—or even a suggestion—that a contract enumerate a sanction for failure to comply with its terms. Courts will simply default to standard remedies where the contract is silent.¹⁷⁴

In short, Kee may be correct in her suggestion that the discretionary nature of Gonzalez-Torres certificates, their silence as to sanction for breach, and their overall imprecision render them ambiguous, coy, or even strategically porous contracts.¹⁷⁵ But, in the event of a dispute between the current owner and the estate, that would not stop a court from formally recognizing this signed, dense, document to be a binding agreement and interpreting it as best it can.

170. *Id.* at 521 (referencing Stewart Macaulay, *Non-Contractual Relations in Business: A Preliminary Study*, 28 AM. SOC. REV. 55, 58 (1963)).

171. KEE, MODELS, *supra* note 30, at 225 (“The point was not simply about giving owners freedom of choice, but about claiming that there was no one right choice.”).

172. *See, e.g.*, *Siporin v. Adler*, 111 N.W.2d 848, 850–51 (Mich. 1961) (affirming the validity of a contract placing payment of an employee bonus entirely at the discretion of the employer); *Howtek, Inc. v. Relisys*, 958 F. Supp. 46, 48 (D.N.H. 1997) (“The fact that an agreement grants a party some degree of discretion in performing does not render the agreement unenforceable.”).

173. 5B AM. JUR. LEGAL FORMS § 72:173, at 722–32 (2d ed. 2014).

174. *See, e.g.*, U.C.C. § 2-703-711 (AM. LAW INST. & UNIF. LAW COMM’N 1977) (discussing a buyer’s remedies in general).

175. Kee, *Felix Gonzalez-Torres*, *supra* note 54, at 526–27.

b. *Gonzalez-Torres’s “Untitled” 1989/1990 Certificate and the Evans Certificate Are Express Copyright Licenses of Copyrightable Works*

Assuming a court were to find that the certificates and any related documents comprise enforceable contracts, then they would likely also be interpreted to be express, written copyright licenses.

Taking each in turn, Gonzalez-Torres’s “*Untitled*” 1989/1990 opens by defining the subject work by title, dimensions, catalogue number, and a dense paragraph of text delimiting the content of the work. It then explicitly states that “the owner has the right to reprint sheets” and “the right to manifest the work at any time.”¹⁷⁶

The first clause is an explicit grant of the reproduction right with respect to the printed sheets which make up the physical manifestation of the work.¹⁷⁷ The second clause is slightly more ambiguous as it uses a term, “manifest,” which is not defined in the Copyright Act.¹⁷⁸ That term, however, when used as a verb, means “to make evident or certain by showing or displaying.”¹⁷⁹ Under that definition, the second clause tracks the public display right.¹⁸⁰ A court would therefore likely (and rightly) read this document as a license by the copyright owner (at the time, the Gonzalez-Torres estate) of the right to reproduce and publicly display “*Untitled*” 1989/1990.¹⁸¹

Much the same can be said for the Evans Certificate. It, too, permits reproduction of the text artwork when it states, “Only to be reproduced using the [digital] file supplied at the time of purchase.”¹⁸² The reasonable negative inference of that statement is that reproductions using the proper digital file are allowed. Similarly, the instructions regarding size, scale,

176. “*Untitled*” 1989/1990 Certificate, *supra* note 56, at 1.

177. 17 U.S.C. § 106(1) (2012).

178. *See* 17 U.S.C. § 101 (2012) (providing no definition for “manifest”).

179. *Manifest*, MERRIAM-WEBSTER, <https://www.merriam-webster.com/dictionary/manifest> [<https://perma.cc/8B97-A6LT>].

180. 17 U.S.C. § 106(5). The Copyright Act already allows an exception to the public display right for owners of lawfully made copies. 17 U.S.C. § 109(c). Accordingly, it is not technically necessary to also license the public display right so long as the artwork owner has been given the right to make an authorized copy. Nevertheless, it would be understandable for a licensee to desire such an express permission as an added safeguard. This reading is confirmed by a later provision that gives rules for when “this work is publicly exhibited by the owner” or a borrowing institution. “*Untitled*” 1989/1990 Certificate, *supra* note 56, at 2.

181. This, of course, assumes the copyrightability of the underlying work. *See below* for a discussion of that issue.

182. Evans Certificate, *supra* note 77; WHITE CUBE Online Listing, *supra* note 60 (stating the purchaser attains a digital file on a CD that contains the text used to realize the artwork).

and thickness of the lettering all imply a permission on the part of the certificate's owner to print such letters (so long as they comply with the instructions) in order to realize the work. A court would have to bend over backwards to deny that a purchaser has the right to reproduce at least one version of the artwork at a time.

In much the same vein, arguably the certificate also grants a license for public display. Specifically, it states, “[o]nly one copy of the artwork should be displayed by a single owner at any given time.”¹⁸³ Just as before, the logical inference is that a single owner has permission to display one copy of the work at a given time.

An additional question in the copyright context concerns exclusivity.¹⁸⁴ Here, it seems obvious that the copyright license in the Evans Certificate is meant to be non-exclusive. On its own terms, it is an edition of twenty-five, and the suggestion is that each owner will receive a certificate for each respective edition of the work.¹⁸⁵

The “*Untitled*” 1989/1990 Certificate is a thornier matter when it comes to exclusivity. In favor of finding the license to be exclusive, the certificate repeatedly and consistently refers to the work as being a “unique art work.”¹⁸⁶ Uniqueness implies exclusivity. Thus, the owners of the piece would have a strong claim that only they have the right to reproduce the stacks. On the other hand, the uniqueness of an original artwork is not the same as the uniqueness of the license or right of reproduction. This is a straightforward proposition in the traditional art context, where one can be the only owner of a Jackson Pollock oil painting without being the exclusive licensee allowed to reproduce it.¹⁸⁷

This distinction, though, breaks down in a dematerialized work like Gonzalez-Torres’s “*Untitled*” 1989/1990, where the very essence of the unique original is reproducibility. In such a case, what could it mean that Rosa and Carlos de la Cruz are the owners of a “unique art work” other than that they are the only ones with the right to reproduce the paper stacks containing the phrases on them described in the certificate? The work is

183. Evans Certificate, *supra* note 77.

184. See, e.g., *Jacob Maxwell, Inc. v. Veeck*, 110 F.3d 749, 753 (11th Cir. 1997) (analyzing whether license was exclusive or nonexclusive for purposes of determining whether implied oral license had validly been created).

185. Evans Certificate, *supra* note 77 (this is inherent in the notion that the physical certificate must accompany the work).

186. “*Untitled*” 1989/1990 Certificate, *supra* note 56, at 1; see also *id.* at 2 (referring to the “uniqueness” of the work).

187. See Visual Artists Rights Act of 1990, Pub. L. No. 101-650, 104 Stat. 5128 (codified in scattered sections of 17 U.S.C.). Under the Act, ownership of a copyright is distinct from ownership of a material copy, including the original copy. See 17 U.S.C. § 202 (2012).

meant to be created anew with each showing and is depleted over time as visitors take sheets away with them.

To make matters even more complicated, according to Emilie Keldie, director of the Gonzalez-Torres Foundation, the archives maintained in the Foundation include information that shows an owner of a single Gonzalez-Torres spill or stack has the right to loan the artwork to another institution (thereby authorizing the installation of a candy pile at the borrowing museum) while simultaneously maintaining a second stack at the owner's home.¹⁸⁸ Indeed, an owner may even install more than one stack at a time in a single location (imagine candy piles in every corner of a museum). None of this impugns the uniqueness of the work as a single aesthetic piece.¹⁸⁹

Even under this expansive reading, the license may be understood as exclusive in the sense that only one party (the current owner) has the authority to sublicense rights to a third party (the borrowing institution). As with most intellectual property licenses, the exclusivity relates not to the number of tangible manifestations of the work, but rather to the right to authorize the creation of such manifestations.

Finally, there remains the question of copyrightability. This Article contends that more likely than not both artworks are copyrightable under current law. As discussed above, the two primary challenges offered against the copyrightability of artwork with conceptual content is that it is “inherently changing” and, thus, not “fixed” under section 102(a),¹⁹⁰ and that such works are fundamentally only a “concept” or “idea” and barred by section 102(b).¹⁹¹ Neither should pose a problem in these cases.

Looking first to Evans's work,¹⁹² the easier of the two to analyze, it is clearly fixed in the form of the digital of wall text provided with purchase. Although there is some variability with respect to the dimensions of the text, that is true for all copyrightable text-based works such as poems. And apart from the text, the certificate dictates that the owner may make no other modifications. As for the idea/expression dichotomy, that should pose no problems as well. Again, the analogy to poetry is apt. Although Evans is a conceptual artist, and reproducible text art clearly has a conceptual component, it is difficult to imagine a court that would refuse

188. See Telephone Interview with Emilie Keldie, Director, Felix Gonzalez-Torres Foundation (Mar. 27, 2019).

189. See *id.*

190. See 17 U.S.C. § 102(a).

191. See 17 U.S.C. § 102(b); see also *supra* Part II(B)(1)(a).

192. See Evans Certificate, *supra* note 77.

to treat this seventy-three-word paragraph as anything other than protectable expression.¹⁹³

Gonzalez-Torres's "*Untitled*" 1989/1990 may be a tougher case but it is likely the work is still copyrightable. With respect to fixation, specifically the Copyright Act requirement that a work must be "sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration[,]"¹⁹⁴ it is important to start by distinguishing his stacks from his candy spills. The latter generally consist of hard candies of an "ideal weight" that may be exhibited in whatever physical shape the owner wishes.¹⁹⁵ The shape then necessarily changes unpredictably as viewers remove the candies throughout the day from the original spill pile (itself of highly variable dimensions).

The subject stack work at issue, however, must be exhibited in the form of two stacks, placed ten inches apart. Each sheet in the stacks must always contain the precise language defined by Gonzalez-Torres, and the text must be centered on the sheet. Although a particular height of the stacks is not mandated, Gonzalez-Torres prescribes an "ideal" height for the starting point of the stacks. In addition, and even more so than with the candy spills, the stacks will reduce in size in a very predictable way as viewers take a page away—with each sheet removed, the stack gets one sheet-width shorter but retains its rectangular form. This is a dynamic artwork, but one that is dynamic within well-defined parameters. It is not nearly as variable as, for instance, the living wildflower garden that was denied copyright protection on fixation grounds.¹⁹⁶ To that end, Gonzalez-Torres himself referred to his stack works as "sculptures" in recognition of their defined form.¹⁹⁷

With respect to idea/expression concerns,¹⁹⁸ again, this is a more challenging work for establishing copyrightability than that by Evans,

193. *Cf.* Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 345–46 (1991) (affirming copyrightability of poems even where two poets create the same poem independent of each other).

194. 17 U.S.C. § 101 (defining "fixed").

195. *See, e.g.*, Certificate of Authenticity and Ownership for *Untitled (L.A.)* at 1, 2 (noting that "[e]ach manifestation of the work may physically differ according to the owner's ongoing right to interpret the specific, yet open-ended parameters of the work") (on file with author); Certificate of Authenticity and Ownership for *Untitled (Portrait of Dad) 1991, reproduced at* 26 CORNELL J.L. & PUB. POL'Y APP. 1 (2017). The latter certificate does suggest that the "ideal manifestation" of the work is to pour them on the floor where two walls meet (i.e., loosely piled in a corner in the familiar way his work is shown). That is not a requirement, however.

196. *Cf.* Kelley v. Chicago Park Dist., 635 F.3d 290, 305 (7th Cir. 2011) (noting that the artist's garden installation was "not stable or permanent enough to be called 'fixed'").

197. Kee, MODELS, *supra* note 30, at 222–23.

198. Exemplifying the idea/expression challenges faced by minimalist art, the Copyright Office

given its near-minimalist aesthetic.¹⁹⁹ It would be a deep misreading of the piece, however, to suggest that Gonzalez-Torres was capturing only an “idea,” such as the idea of art that can be taken away by a viewer, as opposed to giving form to expression. As curator and art historian Nicolas Bourriaud contends of an analogous stack piece, it is not merely “a poster hand-out, but a work endowed with a defined form and a certain density, a work not displaying its construction (or dismantlement) process, but the form of its presence amid an audience.”²⁰⁰

Bourriaud goes on to expand on the role of pairings and dualism in Gonzalez-Torres (the necessary form of two stacks; the relation between stacks and viewer), reflective of his deep commitment to exploring human couples and the brutal loss of his partner to AIDS, and contrasts “the simplicity of the forms used by the artist” with “their tragic and militant content.”²⁰¹ Whether we agree with Bourriaud’s “relational aesthetics” or not, the existence of a substantial body of scholarship focused on the expressive choices made by Gonzalez-Torres lends strong credence to its existence as (often haunting) aesthetic expression and not mere idea.²⁰²

c. *The Certificates Evidence the Owners’ Right to Use the Artists’ Names in Connection with Exhibition or Sale of the Genuine Artwork*

The owner of “*Untitled*” 1989/1990 or an edition of *With the advent of Radio Astronomy* does not want merely to recreate and display the work. The institutional or private collector will want freedom to inform the

recently and controversially denied registration to Cady Noland’s famed *Log Cabin* work for being just that—a façade of a log cabin. See REV. BD., U.S. COPYRIGHT OFF., APP. SER. NO. SR 1-5582119381, LETTER RE: SECOND REQUEST FOR RECONSIDERATION FOR REFUSAL TO REGISTER LOG CABIN (2018), <https://www.copyright.gov/rulings-filings/review-board/docs/log-cabin.pdf> [<https://perma.cc/FN8J-5GRJ>] [hereinafter LETTER RE: SECOND REQUEST FOR RECONSIDERATION].

199. Here, for instance, the piece consists of just ten words, which makes a poetry analogy more difficult. This would also open the piece up to an attack based on the de minimis doctrine if the work consisted only of text. Cf. U.S. COPYRIGHT OFFICE, U.S. COPYRIGHT OFFICE CIRCULAR 33 (“Words and short phrases . . . are uncopyrightable because they contain an insufficient amount of authorship.”). Here, however, text is just one aspect of a much more complete and complex artwork. The Copyright Office (controversially) denied registration. See LETTER RE: SECOND REQUEST FOR RECONSIDERATION, *supra* note 198.

200. BOURRIAUD, *Relational Aesthetics*, *supra* note 30, at 49 (emphasis omitted).

201. *Id.* at 52–53.

202. As Professor Said poignantly notes of the candy spill work “*Untitled*” (*Portrait of Ross in L.A.*) (1991), the 175-pound ideal weight of the pile prescribed in the certificate “represented the ideal weight of Gonzalez-Torres’s lover, who lost weight as a side effect of AIDS, wasting away as his sickness intensified.” Said, *supra* note 92, at 348. For many museum-goers, the act of removing or even eating one of the proffered candies from this work, in light of its expressed meaning, becomes spiritually powerful, indeed haunting, in all the ways we hope for great works of art.

world that the work is by Felix Gonzalez-Torres or Cerith Wyn Evans, respectively, particularly when trying to resell or donate it.

In an institutional setting, this would come in the familiar form of a didactic museum wall text or label providing the artist's name. In a gallery or auction setting, the name might further appear next to prices or lot descriptions and estimates. Each would surely also want to use the name on collateral materials for the sale or show on the website, traditional poster and print advertising, social media, etc. As shown at the outset with respect to the Hirst *Bombay Mix* dispute, if and when that individual seeks to sell the work, the artist's name can be worth hundreds of thousands of dollars.

Do the certificates for these works grant such a right to their owners? Indirectly, yes. While the documents might not rise to the level of affirmative trademark or right-of-publicity licenses, by certifying the authenticity of the subject works they effectively immunize the owners from trademark and right of publicity claims so long as the owners do not falsely affiliate themselves with the artist or estate, and so long as the works comply with the certificate instructions.

When it comes to trademark and right of publicity rights, certificates function slightly differently than with respect to copyright. In the copyright space, as shown above, the certificates grant affirmative copyright rights such as of reproduction or display. They create express copyright licenses. For trademarks and rights of publicity, however, they do not affirmatively authorize the owner/buyer of a work to apply a particular label or use an artist's name in connection with sale of the work. Instead, they speak in terms of confirming the source and authenticity of the piece.

For instance, the Evans Certificate does not license the right to use Evans's name in connection with sale or exhibition of the work. Instead, it attributes authorship of the piece to Evans,²⁰³ and then conditions its certification of authenticity on the buyer/owner adhering to its terms.²⁰⁴ Similarly, nowhere in the six pages of text in the "*Untitled*" 1989/1990 Certificate is there any express grant of permission to use Gonzalez-Torres's name. There are, however, numerous statements that make clear that the work is by Felix Gonzalez-Torres.²⁰⁵ The entire contract—

203. As with the Gonzalez-Torres work, Evans's name appears atop the Certificate, and he signed it. See Evans Certificate, *supra* note 77.

204. *Id.* ("Any reproduction of the above artwork is only guaranteed to be an authentic work of art by Cerith Wyn Evans when all reproduction requirements listed above have been met and accompanied by this certificate.")

205. Each and every page of the document contains the artist's full name in capital letters at the

presumably including its basic certification function—is then integrally conditioned on the buyers following its terms.²⁰⁶ Both works are also entitled “Certificate of Authenticity.”²⁰⁷

In other words, with respect to their author-source certification (for instance, trademark and right of publicity) function, these documents operate not by licensing a right to use the artist’s name, but by conditionally warranting the genuineness of the work as by the artist. This is best understood not as an affirmative trademark or right of publicity license, but rather as a conditional statement of authenticity.²⁰⁸ That, in turn, tracks the narrow first-sale exceptions to trademark and right of publicity claims discussed above.²⁰⁹ This is true for the same reasons that the owner of a genuine thing, like a Tiffany necklace or Orel Hershiser baseball card, has the right to call it that and resell it under that brand or name.²¹⁰

Under this line of cases, in the U.S., the owner of a genuine artwork does not need an affirmative license to list the name of the true artist that created it in connection with its resale or display, or to show an artist’s signature or stamp. This is because neither an artist nor an estate could bring a viable trademark or right of publicity claim to prevent them from doing so.²¹¹ Such a question, moreover, will likely not turn on whether there was a license but rather on whether the certificate is valid and the work materially unchanged from that described in the certificate.²¹²

In sum, the trademark and right of publicity function of Permissive Certificates is not to license the use of the artist’s name, but rather to

top, and the first page uses possessive punctuation to state that “Felix Gonzalez-Torres’[s] “Untitled”, (sic) 1989/1990 . . . is a unique work owned by Rosa and Carlos de la Cruz.” It is also stamped with his signature by the estate. “*Untitled*” 1989/1990 Certificate, *supra* note 56, at 5 (describing stamp) and 6 (showing signature).

206. *Id.* at 6.

207. The “*Untitled*” 1989/1990 Certificate adds the phrase “and Ownership” to its title. *See generally id.*

208. For example, one that can be revoked if the terms of the certificate are not adhered.

209. *See supra* Part II(B)(1)(b). As above, I am assuming that there had already been a bona fide first sale of the work in connection with initial provision of the certificate.

210. *Id.*

211. The owner may not, however, otherwise falsely suggest a connection to the artist or estate beyond the mere authenticity of the work. *Tiffany (NJ) Inc. v. eBay Inc.*, 600 F.3d 93, 102–03 (2d Cir. 2010) (“[A] defendant may lawfully use a plaintiff’s trademark where doing so is necessary to describe the plaintiff’s product and does not imply a false affiliation or endorsement by the plaintiff of the defendant.”).

212. *See supra* Part II(B)(1)(b).

evidence the work's genuineness and thereby insulate a bona fide owner from trademark or right of publicity claims.²¹³

III. IMPLICATIONS

Two primary implications follow from the fact that Permissive Certificates function as contractually binding licenses and guarantees of source. First, from an on-the-ground perspective, it would establish Permissive Certificates as a powerful, practical, and market-accepted tool for artist control. Where moral rights doctrines do not provide legal entitlements, a Permissive Certificate can be wielded to enforce strict compliance with the certificate through the threat of legal sanction. Or, more potently, it could provide a tool for the artist or successor to prevent resale or revoke the original sale entirely. Second, considered more abstractly, this conclusion further positions the Certificate of Authenticity as the locus of value for reproducible artworks at a moment when reproducibility is increasingly at the heart of artistic practice. In this sense, collectors of art become collectors of permissions. Each is discussed in turn below.

A. *Permissive Certificates as a Tool for Artist Control*

This section argues, descriptively, that Permissive Certificates are poised to become a legal tool for artist control—one more useful to artists and their estates, perhaps, than U.S. moral rights legislation. First, it briefly reviews the avenues for artist control under current law. Next, it shows how Permissive Certificates allow for private controls through contractual restriction and scope limitations. It then turns to resale restriction and termination, arguing that through Permissive Certificates an artist or artist's estate might deprive a collector of the ability to sell or show an artwork in their collection.

213. One might attempt to distinguish the first sale cases by pointing to the fact the certified artworks at issue here (by definition) have not yet been completely realized at the moment of sale. As discussed in Part I(D), the authentication function is operating prospectively. That is different from a Tiffany necklace, which was created and stamped *TIFFANY* once and for all by Tiffany prior to the first sale. Nevertheless, the point of the first sale doctrine with respect to source authentication is that once the work has been authenticated, the buyer has a right to tell the world its source. This would appear to hold regardless of whether the artist chose to authenticate the piece in advance on spec rather than after fabrication, so long as it has not been materially altered. *See* Carpenter & Hetcher, *supra* note 110.

1. *The Problem of Artist Control and Moral Rights Law in the United States*

In the fine arts context, moral rights generally provide artists with rights to preserve the integrity (for instance, prevent mutilation or destruction) of an artwork after it has been sold; receive credit for the work (or be entitled to revoke credit where it is no longer the work of that artist); and choose when and how to divulge the work to the public.²¹⁴ These non-economic rights are particularly strong in European countries, such as France, where they cannot be assigned and even survive the death of the artist.²¹⁵ They are notoriously weak in the United States, however.²¹⁶

Once an artist sells a traditional artwork in the United States, that artist has few means of controlling what the new owner does with it. Copyright law allows the artist to prevent reproductions of the work,²¹⁷ but the first sale doctrine and exceptions to the public display right mean that there is little the artist can do through copyright law to prevent resale or display of the work.²¹⁸ The circumscribed moral rights provisions contained in the Visual Artists Rights Act (VARA) prevent mutilations, distortions, destructions and other modifications of certain unique and limited edition artworks in some cases,²¹⁹ and allow visual artists to disclaim authorship in others,²²⁰ but those provisions are gap-ridden and have not proved themselves to be a fertile source of artist control.²²¹

214. *See generally* 3 NIMMER ON COPYRIGHT § 8D.01 (2019).

215. *Id.*

216. *See infra* note 221 (collecting scholarship on this point).

217. 17 U.S.C. § 106(1) (2012).

218. 17 U.S.C. §§ 106(a),(c) (2012).

219. 17 U.S.C. §§ 106A(a)(2), (a)(3).

220. 17 U.S.C. § 106A(a)(1).

221. It is beyond the scope of this paper to address gaps in U.S. moral rights law in any depth. Other scholars, however, have given this issue substantial attention. *See, e.g.*, Roberta Rosenthal Kwall, *How Fine Art Fares Post VARA*, 1 MARQ. INTELL. PROP. L. REV. 1 (1997) (assessing weaknesses in VARA through review of early case law); Roberta R. Kwall, “*Author-Stories: Narrative’s Implications for Moral Rights and Copyright’s Joint Authorship Doctrine*,” 75 S. CAL. L. REV. 1, 22 (2001) (noting that “[m]any articles have lamented the absence of adequate moral rights protection in the United States” and collecting the same); Jane C. Ginsburg, *The Right to Claim Authorship in U.S. Copyright and Trademarks Law*, 41 HOUS. L. REV. 263, 300 (2004); Rebecca Stuart, *A Work of Heart: A Proposal for a Revision of the Visual Artists Rights Act of 1990 to Bring the United States Closer to International Standards*, 47 SANTA CLARA L. REV. 645, 646 (2007) (observing that “[t]he American legal system places a lower value on the works of visual artists than foreign legal systems by failing to provide protection for the moral rights of all artists.”); 3 NIMMER ON COPYRIGHT § 8D.02(A) (2019) (acknowledging that the “scope [of US moral rights law] is limited even within the realm of visual arts”); Robert C. Bird, *Moral Rights: Diagnosis and Rehabilitation*, 46 AM. BUS. L.J. 407, 408 (2009).

To name just a few limitations, for post-1990 works, VARA protections die with the artist,²²² its most potent provisions apply only to works of “recognized stature,”²²³ it exempts negligent art conservation and exhibition decisions,²²⁴ and it covers only traditional, copyrightable “work[s] of visual art.”²²⁵ This latter limitation is especially problematic for works captured in Permissive Certificates, which are generally not traditional, unique art objects. Nor does the U.S. allow an artist to prevent or profit from resale of the artist’s work through a *droit de suite* (for instance, a right to receive a percentage of the resale price when an artwork is later sold by an original buyer).²²⁶ State law protections, for their part, form an irregular patchwork and are largely preempted by VARA with respect to visual art.²²⁷

There is far from an academic consensus that VARA protections should be increased, with prominent scholars having indicated their opposition to moral rights legislation.²²⁸ Regardless of how one feels about the normative value of moral rights in the abstract, however, artists regularly do, in fact, attempt to control their works after sale.²²⁹ Indeed, artists have attempted to overcome VARA limitations through the development, for instance, of form contracts designed to give the artist downstream control of sold artworks.²³⁰ In part due to market rejection of their onerous terms,

222. 17 U.S.C. § 106A(d)(1).

223. 17 U.S.C. § 106(A)(a)(3)(B).

224. 17 U.S.C. § 106(A)(c)(2).

225. 17 U.S.C. § 106(A)(a) (limiting the application of the act to works of visual art); 17 U.S.C. § 101 (defining work of visual art to exclude, inter alia, non-copyrightable, audiovisual, works in editions of more than 200 copies).

226. See U.S. COPYRIGHT OFFICE, *Resale Royalties: An Updated Analysis* 6 (2013), <https://www.copyright.gov/docs/resaleroyalty/usco-resaleroyalty.pdf> [<https://perma.cc/DK8V-7K6U>] (describing the history of failed attempts to pass a resale royalty in the U.S.). California’s state resale royalty law, which originally required that an artist domiciled in California be paid a 5% royalty on all resales of that artist’s work, has been narrowed to the point of irrelevance by recent court decisions. See, e.g., *Sam Francis Found. v. Christies, Inc.*, 784 F.3d 1320, 1322 (9th Cir. 2015) (holding the act unconstitutional as applied to sales outside of California); *Close v. Sotheby’s, Inc.*, 894 F.3d 1061, 1072 (9th Cir. 2018) (holding that the Copyright Act preempts California Resale Royalty Act for claims arising after January 1, 1978).

227. 17 U.S.C. § 301(f)(1) (2012). To be sure, when VARA does apply, it can be quite a power tool. See, e.g., *Cohen v. G&M Realty L.P.*, 320 F. Supp. 3d 421, 427–28 (E.D.N.Y. 2018) (affirming \$6.75 million VARA judgment for willful destruction of aerosol art).

228. See, e.g., Amy M. Adler, *Against Moral Rights*, 97 CALIF. L. REV. 263, 265 (2009) (arguing “moral rights laws endanger art in the name of protecting it”).

229. See, e.g., Karol, *Termination*, *supra* note 17, at 212–13 (discussing the same).

230. The most well-known of these is the Artist’s Reserved Rights Transfer and Sale Agreement developed by Professors Robert Projansky and Seth Siegelau in 1973. See *In Deed Catalog*, *supra* note 7, at 51 (reprinting the same). Among other things, it grants artists “ongoing control over the exhibition, reproduction, and maintenance of their work, as well as a 15% resale royalty[.]” Buskirk,

however, these agreements (in contrast to Permissive Certificates generally) have never been widely adopted.²³¹

2. *Artist Control by Contractual/License Restrictions*

a. *Enforcement of Contract Terms*

The most immediate means through which artists could use Permissive Certificates as a form of control over the uses to which buyers put their art would be to enforce their terms as binding contract restrictions.²³²

Imagine, for instance, that a purchaser of one of the twenty-five editions of Cerith Wyn Evans's, *With the advent of Radio Astronomy*, decides to create two copies of the work so that she can keep one at her home while she loans another copy to a traveling exhibition. This is technically easy to accomplish, as the buyer possesses a CD and can print as much vinyl text as she wishes. This is, however, arguably a violation of the clause reading, "[o]nly one copy of the artwork should be displayed by a single owner at any given time."²³³ Were the certificate enforceable as a contract, then Evans could demand that a court enforce the provision by enjoining the buyer's efforts. A similar argument could be made should the buyer use a slightly different font type from that prescribed by the digital file, thereby contravening the requirement, "[a]part from the scale of the text, there must be no other modifications to the design."²³⁴ In such a case, Evans could assert the contract to prevent modifications.

The Gonzalez-Torres case is slightly different. As Kee emphasizes, many of the instructional guidelines in the "*Untitled*" 1989/1990 certificate are simply recommendations, as shown by repeated use of the terms like "may" and "ideally."²³⁵ Nevertheless, other requirements in the certificates are quite definitive. For instance, the phrases "[s]omewhere

Public Experience, *supra* note 6, at 476 (describing the same).

231. According to Professor Kee, from a market perspective there was an "almost total rejection of the Agreement as a legal instrument . . ." Kee, *MODELS*, *supra* note 30, at 55 (emphasis omitted). Some have argued for a more trademark-centric approach to moral rights, particularly for contemporary artists. See, e.g., Xiyin Tang, Note, *The Artist as Brand: Toward a Trademark Conception of Moral Rights*, 122 *YALE L.J.* 218, 230 (2012). This concept is consistent with approaching Permissive Certificates as licenses.

232. This would require, of course, that the certificates be enforceable as contracts. At a minimum, this would usually require a countersignature by the buyer. See *supra* Part II(B)(2)(a).

233. Evans Certificate, *supra* note 77.

234. *Id.*

235. For instance, "[i]f [75 lb. white offset by Georgia Pacific] paper is not available, a similar paper may be used," or "[t]he text is ideally reproduced at this size." "*Untitled*" 1989/1990 Certificate, *supra* note 56, at 1.

better than this place” and “[n]owhere better than this place” that must appear on the two stacks of sheets are not subject to any discretion.²³⁶ Similarly, the certificate requires that “the stacks must be exhibited with the printed side of the sheet on view.”²³⁷

For these core requirements, the Felix Gonzalez-Torres Foundation could have a viable contract claim against a buyer who (for instance) uses the term “then” instead of “than” in the text, or who insists on showing the printed side down to be contrarian. Importantly, in both cases, the contract claims are essentially providing the equivalent of a moral right of integrity where a VARA claim would itself face challenges.²³⁸

b. Reproductions of the Artworks Outside the Scope Permitted by the Certificates is a Copyright Infringement

In addition to, and arguably more potent than the foregoing contract-based claims, such actions would arguably be outside the scope of the license and thereby amount to copyright infringement.²³⁹

Understood as a copyright license, the buyer of Evans’s work is permitted to reproduce one and only one copy of the work at a given time. Reproducing two copies (one for home use, and one for a traveling exhibition) is materially outside the scope of the license, just as is using an architect’s plans for additional, unpermitted houses.²⁴⁰ Similarly, Gonzalez-Torres’s contract contains clear, strong restrictions on resale, a contractually permissible type of restraint on alienation. In particular, his Foundation must be given a right of first refusal.²⁴¹ Should the current owners attempt to sell the piece without first offering it to the Foundation,

236. *Id.*

237. *Id.*

238. For example, among other VARA enforceability problems, it is not clear in Evans’s case that a font change would “be prejudicial to his [] honor or reputation” or that text art is even a “work of visual art” to begin with. *See* 17 U.S.C. §§ 106A(a)(2), (3)(A), 101 (2012) (only a painting, drawing, print, sculpture or photograph may be a “work of visual art”); 17 U.S.C. § 106A(d)(1). In Gonzalez-Torres’s case, one major bar is the fact that he passed in 1996 thus rendering VARA inapplicable to most of his works (even in those rare cases where it might otherwise attach).

239. *See supra* Part II(B)(1)(a).

240. *LGS Architects, Inc. v. Concordia Homes of Nev.*, 434 F.3d 1150, 1156 (9th Cir. 2006), *overruled on other grounds by* *Perfect 10, Inc. v. Google, Inc.*, 653 F.3d 976 (9th Cir. 2011). As the Federal Circuit put it, “[a]s an example, consider a license in which the copyright owner grants a person the right to make one and only one copy of a book . . . [o]bviously, a licensee who made a hundred copies of the book would be liable for copyright infringement because the copying would violate the Copyright Act’s prohibition on reproduction and would exceed the scope of the license.” *Storage Tech. Corp. v. Custom Hardware Eng’g & Consulting, Inc.*, 421 F.3d 1307, 1316 (Fed. Cir. 2005).

241. *See “Untitled”* 1989/1990 Certificate, *supra* note 56, at 3–4.

in violation of that provision, it would surely be a breach of contract like the others discussed above.

More importantly, however, any reproductions made by the successor would likely be unauthorized and thus considered outside the scope of the copyright license and an act of copyright infringement. The existence of copyright infringement claims strongly improves the artist's position. In addition to bringing in powerful copyright remedies in certain cases, (including statutory damages and attorney's fees)²⁴² a copyright infringement claim does not necessitate the existence of an enforceable, written contract.

Finally, it is critical to note that buyers likely will not be in a position to challenge the overall validity or enforceability of the certificate as a contract. After all, those buyers are benefiting from the copyright license contained within the contract. Without that license, they would (by definition) be committing copyright infringement each time they recreate the work. Buyers would thus be forced into the difficult litigation position of admitting the existence of the license, and its ongoing force and effect, while at the same time contesting their breach. This gives strong leverage to the artist in any dispute.

c. Material Variations Void the Authentication and Invite Infringement Claims

As detailed above, an artist in the U.S. cannot rely on traditional trademark or right of publicity law to prevent an owner from accurately representing the piece to be by that artist for purposes of display or resale.²⁴³ The signed certificate of authenticity definitively evidences the accuracy of the attribution. This assumes, however, that the artwork does not materially differ from that described in the certificate. If an artist can demonstrate that the work shown differs materially from the original, then it will no longer be insulated from trademark and right of publicity claims, respectively.²⁴⁴

A starting place for any such analysis should be the parameters set by the certificate itself. In Evans's case, for instance, the certificate explicitly conditions its guarantee of authenticity on "all reproduction requirements listed above hav[ing] been met."²⁴⁵ The same prohibited font alteration that could provide Evans with a claim for breach of contract or copyright

242. See 17 U.S.C. §§ 504(c), 505 (2012).

243. *Supra* Part II(B)(1)(b).

244. *Id.*

245. Evans Certificate, *supra* note 77.

infringement could thus potentially support a claim for trademark or right of publicity infringement.²⁴⁶ So too with respect to the definitive requirements in Gonzales-Torres's works. A change to the core phrase in the text, for instance, would almost certainly be a material alteration that voids the certificate and exposes the owner to a trademark and right of publicity suit.

3. *Termination*

Another major implication of recognizing Permissive Certificates as copyright licenses is that they become subject to statutory copyright termination in the U.S. after thirty-five years.²⁴⁷ This allows an artist or estate to terminate, without payment, any copyright licenses or assignments the artist granted during their lifetime, regardless of whether the contract allowed for such termination or not.²⁴⁸ The avowedly paternalistic theory behind Congress's decision to grant termination rights was to give artists (and other authors) another bite at the apple so that they may renegotiate licenses in the event that their works become successful.²⁴⁹

As shown above, once a copyright license has been terminated, further reproductions are acts of copyright infringement.²⁵⁰ Thus, the putative owner of a Felix Gonzalez-Torres paper stack piece is at risk for claims of copyright infringement by his Foundation should that owner try to realize the piece for exhibition post-termination.²⁵¹ The same would hold for purchasers of an edition of Evans's *With the advent of Radio Astronomy*. An owner would be at risk of an infringement claim should she reprint a new set of vinyl wall text for a new exhibition from the authorized PDF in her possession after termination. This is true even where a Permissive Certificate appears on its face to be a perpetual grant.

246. One wrinkle here is that the case law suggests materiality is determined from the perspective of the purchasing public, which would here likely be buyers of contemporary art. *See supra* note 133. Art buyers, however, would likely look to the certificate to guide their own views of materiality, thereby leading to the same result.

247. This issue is explored at length in Karol, *Termination*, *supra* note 17 *passim*.

248. 17 U.S.C. § 203(a) (2012).

249. Kate Darling, *Occupy Copyright: A Law & Economic Analysis of U.S. Author Termination Rights*, 63 *BUFF. L. REV.* 147, 150–51 (2015) (describing the history of provisions).

250. *See supra* note 123.

251. This assumes, of course, that the work is copyrightable. *See* Part II(B)(2)(b). The Foundation purports to hold the copyright in and to all works by Gonzalez-Torres. *See* THE FELIX GONZALEZ TORRES FOUNDATION, http://felixgonzalez-torresfoundation.org/?page_id=56 [<https://perma.cc/4KLP-X8QL>].

In short, if Permissive Certificates are recognized as copyright licenses, then they become no more than thirty-five-year leases that the artist or the artist's successor may or may not choose to tolerate after that time.²⁵²

4. *Limits on Transferability*

a. *Contractual Restraints*

Licenses can and often do contain contractual restraints on assignment or sublicense.²⁵³ These are generally enforced by courts according to their own terms, but construed narrowly.²⁵⁴ Attempts to transfer such a non-assignable license are void, and render the attempted transferee at risk for copyright infringement claims should it attempt to use the licensed copyright interest.²⁵⁵

A surprisingly large percentage of the “*Untitled*” 1989/1990 Certificate—more than half of the six pages—is taken up by restrictions on transfer. The license is assignable on its face for purposes of “loans to exhibitions.”²⁵⁶ The owners may also “resell the work” in which case the Gonzalez-Torres Foundation will issue a new certificate in the name of the new owners—the functional equivalent of an assignment of the original owner’s rights on resale.²⁵⁷

Nevertheless, the right to assign is heavily circumscribed. Most seriously, the Foundation is granted a right of first refusal to purchase the work should the current owners attempt to sell it.²⁵⁸ Even where the Foundation chooses not to acquire the work, it is still a necessary party to

252. The same termination problems would arise under contract law, in the event of a material breach of the contract/certificate by the artwork owner. A material breach would entitle the artist to rescind the contract and copyright license, rendering subsequent reproductions acts of infringement. See 3 NIMMER ON COPYRIGHT § 10.15(A) (2019).

253. See, e.g., MILGRIM ON LICENSING § 15.13 (2018) (“Typically, the licensor’s preference is that its licensee not have the right to sublicense.”).

254. *Traicoff v. Digital Media, Inc.*, 439 F. Supp. 2d 872, 879 (S.D. Ind. 2006) (“[P]arties may include an anti-assignment provision in the contract, prohibiting (1) the assignment of rights, (2) the assignment of duties, or (3) both. But, careful detail must be given to the language of such provision.”).

255. See, e.g., *Sapiano v. Millenium Entm’t, LLC*, No. CV 12-8122 PSG (MAN), 2013 WL 12120262, at *9 (C.D. Cal. Nov. 14, 2013) (allowing plaintiff to move ahead with copyright infringement claims against a party that was not a proper transferee of an exclusive copyright license).

256. “*Untitled*” 1989/1990 Certificate, *supra* note 56, at 1 (“[T]he owner has the right to assign this assignable right.”).

257. *Id.* at 2.

258. *Id.* at 3–4.

a resale transaction because of the detailed provisions governing reissuance of the certificate.²⁵⁹

The Evans Certificate license is more ambiguous as to resale, although it, too, would likely be interpreted to allow for transfer. In particular, though it nowhere affirmatively grants the right to assign the reproduction right, it does state, “[t]his certificate must accompany the work through all transfer of ownership” and will not be reissued if lost.²⁶⁰ The logical inference of this statement is that transfer of the license is permitted, so long as the original document is itself passed to the successor.

It is possible that some clauses in certificates that purport to limit resale would be preempted by the Copyright Act’s first sale doctrine, which permits one who has acquired ownership of a lawfully made copy (such as an artwork) to dispose of that copy without the permission of the copyright owner.²⁶¹ As a general matter, however, first sale cases apply to sales of a copy of the work at issue, and are not applicable to pure licensing transactions.²⁶² Permissive Certificates such as those used by Felix Gonzalez-Torres operate as pure licenses by providing permissions without transferring existing copies. As such, they are arguably outside the scope of the copyright first sale doctrine.

That said, one can imagine cases (for instance, that involving Damien Hirst’s *Bombay Mix* discussed at the outset) where a Permissive Certificate accompanies transfer of an actual copy of the work itself. In those cases, under U.S. law, one could argue that the purchaser/owner’s first sale rights trump any attempt by the copyright owner to limit resale of *that* copy in the certificate.

b. Background Legal Restraints on Transfer

In the absence of express permission to transfer an exclusive license, the Copyright Act “does not allow a copyright licensee to transfer its

259. *Id.*

260. Evans Certificate, *supra* note 77.

261. 17 U.S.C. § 109(a) (2012); *UMG Recordings, Inc. v. Augusto*, 628 F.3d 1175, 1177 (9th Cir. 2011).

262. *Quality King Distribs., Inc. v. L’anza Research Int’l, Inc.*, 523 U.S. 135, 146–47 (1998) (“[B]ecause the protection afforded by § 109(a) is available only to the ‘owner’ of a lawfully made copy . . . the first sale doctrine would not provide a defense to . . . any nonowner such as a bailee, a licensee, a consignee, or one whose possession of the copy was unlawful.”).

rights under an exclusive license, without the consent of the original licensor.”²⁶³ A similar rule holds for nonexclusive licensees.²⁶⁴

Contrary to the two examples just discussed, many—if not most—Permissive Certificates are silent on the subject of transfer.²⁶⁵ In such cases, acquirers of documents by resale or auction are at serious risk for claims of copyright infringement should they attempt to realize the certified works without the consent of the artist. This could be a serious cloud on the title of very high-value acquisitions.

B. *Collectors of Art as Collectors of Permissions*

Where traditional certificates of authenticity add value by confirming artist attributions, Permissive Certificates go further by authorizing realization of the underlying artwork. As thus far demonstrated, they do so not only through the norms, custom, and sanction of the art world,²⁶⁶ but with the weight of enforceable law behind them. This lends them an importance and value, for artworks with reproducible components, far beyond mere retrospective authentication. They are keys that unlock the works themselves.

Unsurprisingly, then, in disputes like those concerning the Menil Collection/LeWitt, there is a strong focus on the certificate as such, even where actual authorship of the work is not in dispute. Permissive Certificates are, and will increasingly continue to be, the locus of value for works with conceptual or reproducible content.

Stepping further back, perhaps the most theoretical implication of recognizing certificates of authenticity as certificates of permission is also the most meaningful. Namely, that collectors of art (both institutional and private) are poised to become collectors of permissions: repositories of legal rights rather than archives of objects.

263. *Gardner v. Nike, Inc.*, 279 F.3d 774, 780 (9th Cir. 2002). Some lower courts have disagreed with this holding, yet it remains the law in the Ninth Circuit. *See, e.g., Traicoff v. Digital Media, Inc.*, 439 F. Supp. 2d 872, 877 (S.D. Ind. 2006) (“This court also finds the reasoning in *Gardner* to be unpersuasive.”).

264. 2 PATRY ON COPYRIGHT § 5:127 (“Since a nonexclusive licensee is not a copyright owner, it may not, absent express authorization, transfer the license, nor may it, absent authorization, sublicense.”).

265. *See generally* In Deed Catalog, *supra* note 7 *passim* (most certificates shown lack any transferability language).

266. On the non-legal norms and customs of the art world in the context of dematerialized work, *see generally* Guy A. Rub, *Owning Nothingness Between the Legal and the Social Norms of the Art World*, 2019 BYU L. REV. (forthcoming 2019), available at <https://ssrn.com/abstract=3433327> [<https://perma.cc/F3SH-3HWH>].

As artists increasingly turn to dematerialized and reproducible art practices, collections like that of Giuseppe Panza—as much an archive of signed documents and related ephemera as one of objects—will move from the periphery to the mainstream. We should expect to see more museums replicating the Guggenheim’s multi-million-dollar Panza Collection Initiative. Those other museums, too, will want and seek to understand the rights they have been granted and restrictions by which they have been limited with respect to Permissive Certificates in their collections.

This practice of “invest[ing] in paper” as opposed to displaying realized artworks was, to be sure, the subject of Judd’s deep scorn.²⁶⁷ The artist dismissively described the collector of his certificates in unrelentingly mercantile terms: “sales, purchases and sales in quantity, are exactly what he wants to think about He really wants to talk about his investment in art . . . but must be restrained for appearances, and must whitewash investment for both himself and the public with idealistic platitudes.”²⁶⁸ Judd went so far as to compare Panza to Thersites in the Iliad in that “[n]othing stops him or shames him.”²⁶⁹

Underlying the strength of Judd’s hostility to the practice of collecting permissions, however, is a recognition of its commercial viability, seductiveness to collectors (private and institutional), and likely longevity. It will become ever more common to visit the Guggenheim, Whitney, MoMA, or the Crystal Bridges Museum in Arkansas (the purchaser of Gonzalez-Torres’s *Untitled (L.A.)* for \$7.67 million), not to admire the world’s one copy of *Demoiselles D’Avignon*, but because only the institution will have the legal right to spill candies and call them a Gonzalez-Torres, or to 3D-print an authentic Josh Kline installation from a file.

It is not difficult to imagine a paradigm shift in the future such that the very notion of authenticity will merge with that of permission. Future authenticity disputes, like current copyright and trademark litigations, will center on whether an artist truly authorized or executed the legal instrument, or the scope of any such permission, rather than whether the artist’s hand in fact touched the object at issue.

267. Judd, *supra* note 1, at 643.

268. *Id.* at 659.

269. *Id.* at 632. As mentioned at the outset, in part due to Judd’s denunciation of Panza’s recreations, the Guggenheim has decommissioned at least nine Panza fabrications of Judd’s works, and has further decided never to fabricate other unrealized Judd paper-based works in its collection, despite its relatively clear legal right to do so. See GROVER, *supra* note 30, at 168.

CONCLUSION

Like the underlying artworks themselves, conceptual artists created Permissive Certificates to meet and challenge the commercial pressures of art markets. As a result, Permissive Certificates have fascinated art historians for some time. Such documents, essentially instructions for art generation, force society to confront fundamental ontological questions on the nature of art, the relationship between artist, collector, and viewer, and the influence of money and acquisitiveness on art creation.

As this Article has shown, however, Permissive Certificates are also legal instruments. In their controlled allocation of rights to realize artworks, they create limited, often exclusive, copyright licenses. In many cases, they form enforceable contracts, placing duties and restrictions on collectors far more potent than those found in moral rights legislation. In their authorization of attribution, they negate source-based challenges to the owner's use of the artist's name or brand in connection with display or resale of the underlying works. As much as they are a grant of artistic permission, they are also an assertion of artist control.

Permissive Certificates are also very valuable from a simple market perspective; some sell for millions of dollars at auction, despite being nothing more than rights on paper. Perhaps not coincidentally, this closely parallels the technology sector of our economy, where companies are now valued for their intangible intellectual property assets over all else. In both cases, the value is in the legal rights, yet the value is real.

As new media artists continue to embrace reproducibility through 3D-printed, digitally-rendered, performance-based art practices and the like, Permissive Certificates are poised to become central to art acquisition and control. The great private collections and museums of the future will be vaults for contracts as much as objects, essentially repositories of permissions. In such an era, value will inhere in the museum's possession of an unassailable intellectual property right rather than an unassailable Vermeer.