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Comment on *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 992 F.3d 99 (2d Cir. 2021)

Jane C. Ginsburg
Columbia Law School, jane.ginsburg@law.columbia.edu

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Jane C. Ginsburg, Columbia Law School

Abstract

The Second Circuit's decision in Andy Warhol Foundation v. Goldsmith *retreats both from its prior caselaw's generous characterization of artistic reuse as "transformative," and from the outcome-determinacy of a finding of "transformativeness." The decision suggests both that courts may be applying a more critical understanding of what "transforms" copied content, and that courts may be reforming "transformative use" to reinvigorate the other statutory factors, particularly the inquiry into the impact of the use on the potential markets for or value of the copied work. The court also provided an important explanation of copyrightable authorship in photographs.*

In addition to analyzing the Second Circuit's decision in Andy Warhol Foundation v. Goldsmith, *this Comment also addresses the relevance to transformative use of the Supreme Court's ruling in* Google v. Oracle, *and concludes that the highly software-specific context of that case cabins its fair use analysis to functional code far from the "core of copyright."*

Introduction

Since the US Supreme Court's 1994 adoption of "transformative use" as a criterion for evaluating the first statutory fair use factor ("nature and purpose of the use"),[1] the "transformative use" analysis has engulfed all of fair use.[2] A finding of "transformativeness" often foreordained the ultimate outcome, as the remaining factors, especially the fourth (impact of the use on the market for or value of the copied work), withered into restatements of the first. "Appropriation" artists benefitted from substantial leeway to incorporate other artists', particularly photographers', works as "raw material" in their "transformative" reworkings, most notably (or notoriously) in the Second Circuit's 2013 decision in *Cariou v. Prince*, in which artist Richard Prince created a series of 30 paintings, titled *Canal Zone*, for which he enlarged images from photojournalist Patrick Cariou's book *Yes, Rasta* tenfold and transferred them to canvases, sometimes superimposing colors or other elements on the otherwise unchanged images and sometimes incorporating the images in a collage

[1] 17 U.S.C. sec. 107(1); *Campbell v Acuff-Rose*, 510 US 569 at 579 (1994) (hereafter *Campbell*), *citing* Pierre N. Leval, *Toward a Fair Use Standard*,103 Harv. L. Rev. 1105 (1990).

[2] See generally Barton Beebe, *An Empirical Study of US Copyright Fair Use Opinions*, 1978–2005, 156 U. Pennsylvania L. Rev. 549 (2008). For a more recent empirical study, see Jairui Liu, *An Empirical Study of Transformative Use in Copyright Law*, 22 Stan. Tech. L. Rev. 163 (2019).

with other images taken from Cariou's book or from other sources; the court held all but five of these images to be fair use.[3]

More recent decisions, however, indicate that *Cariou* may represent the outer limit of "transformative" fair use, as courts express greater scepticism concerning what uses actually "transform" content copied into new works.[4] The Second Circuit's decision in *Andy Warhol Foundation* retreats both from its prior caselaw's generous characterization of artistic reuse as "transformative," and from the outcome-determinacy of a finding of "transformativeness." The decision suggests both that courts may be applying a more critical understanding of what "transforms" copied content, and that courts may be reforming "transformative use" to reinvigorate the other statutory factors, particularly the inquiry into the impact of the use on the potential markets for or value of the copied work. The court also provided an important explanation of copyrightable authorship in photographs.

Facts

In this declaratory judgment action brought by the Andy Warhol Foundation, photographer Lynn Goldsmith created a portrait of entertainer Prince in 1981 (see below). Vanity Fair licensed the photograph in 1984 for $400 "for use as an artist's reference in connection with an article to be published in Vanity Fair Magazine." Vanity Fair commissioned Andy Warhol to create an illustration based on the photograph and it published Warhol's illustration to accompany an article about Prince in the November 1984 issue of Vanity Fair. The illustration published in Vanity Fair was one of a series of 16 silkscreen paintings, prints and drawings Warhol created based on Goldsmith's photograph.

After Prince's death in 2016, Vanity Fair obtained a license from the Andy Warhol Foundation to republish one of the Warhol images (a different one than the magazine had printed in 1984) on the cover of a special issue of the magazine devoted to the performer (see below). Vanity Fair did not obtain a license from Goldsmith, nor did its special issue credit her source photograph, although the November 1984 issue had included a source credit.

[3] *Cariou v Prince*, 714 F.3d 694 (2d Cir. 2013).

[4] See, e.g., *TCA Corp v McCollum*, 839 F.3d 168, 181 (2d Cir 2016) (calling *Cariou* "the high-water mark of our court's recognition of transformative works"; *McCollum* concerned the incorporation of a comedy routine into a dramatic work); *Dr. Seuss Enters., L.P. v. ComicMix LLC*, 983 F.3d 443 (9th Cir. 2020) (holding *Oh the Places You'll Boldly Go*, a mashup of Dr. Seuss' *Oh the Places You'll Go* and television series *Star Trek*, not "transformative" and not a fair use).

Photo: Lynn Goldsmith

Andy Warhol, *Prince* (for *Vanity Fair*)

The SDNY decision

In concluding on a motion for summary judgment that Warhol's use of Goldsmith's photograph was fair use,[5] the district court held Warhol's use to be transformative. While Goldsmith portrayed Prince as "not a comfortable person" and a "vulnerable human being," the Warhol series, according to the court,

> can reasonably be perceived… to have transformed Prince from a vulnerable, uncomfortable person to an iconic, larger-than-life figure. The humanity Prince embodies in Goldsmith's photograph is gone. Moreover, each Prince Series work is immediately recognizable as a 'Warhol' rather than as a photograph of Prince—in the same way that Warhol's famous representations of Marilyn Monroe and Mao are recognizable as 'Warhols,' not as realistic photographs of those persons. … [The Warhol series] add[s] something new to the world of art and the public would be deprived of this contribution if the works could not be distributed.[6]

The trial court appeared to be suggesting that the more characteristic and celebrated an artist's style, the broader his entitlement to adopt others' works. But, while the Warhol version may be "immediately recognizable" as an iteration of his brand of representation, it is far from clear that no reasonable jury could have found that, despite the works' "aesthetic differences," Goldsmith's photograph both remains identifiable in Warhol's version and that its essence persists. "Transformation" may be in the beholding; Warhol may have "transformed Prince from a vulnerable, uncomfortable person to an iconic, larger-than-life figure." But it does not follow that the "icon" symbolizes power or self-satisfaction. A reasonable jury might equally well have perceived a heightening of the "humanity" that, for the court, Warholisation drained from the image.

As in *Cariou*, the court's determination that Warhol's use was "transformative" influenced its evaluation of the fourth factor as well: "It is plain that the markets for a Warhol and for a Goldsmith fine-art or other type of print are different."[7] Like Richard Prince, Warhol's celebrity sells his works, while Goldsmith shares Cariou's obscurity. The court was similarly dismissive of Goldsmith's claim that the Warhol prints usurped her licensing market:

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[5] *Andy Warhol Found. v Goldsmith*, 382 F. Supp. 3d 312 (SDNY 2019). The following analysis of the district court's decision is adapted from Jane C. Ginsburg, *Fair Use in the United States: Transformed, Deformed, Reformed?*, 2020 SINGAPORE JOURNAL OF LEGAL STUDIES 265, https://law1.nus.edu.sg/sjls/articles/SJLS-Mar-20-265.pdf

[6] *Id* at 326. The court appears to have assumed that Goldsmith's remedies, had she prevailed, would have included injunctive relief. That outcome, however, is by no means certain. See *eg*, *Salinger v Colting*, 607 F.3d 68 (2d Cir 2010) (following Supreme Court's decision in *eBay Inc v MercExchange, LLC*, 547 US 388 (2006), requiring showing of irreparable harm from infringing sequel of *The Catcher in the Rye*).

[7] *Andy Warhol Found.*, 382 F. Supp. 3d at 330.

> Goldsmith's evidence and arguments do not show that the Prince Series works are market substitutes for her photograph. She provides no reason to conclude that potential licensees will view Warhol's Prince Series, consisting of stylized works manifesting a uniquely Warhol aesthetic, as a substitute for her intimate and realistic photograph of Prince. Although Goldsmith points out that her photographs and Warhol's works have both appeared in magazines and on album covers, this does not suggest that a magazine or record company would license a transformative Warhol work in lieu of a realistic Goldsmith photograph.[8]

The court did not consider whether the relevant markets included the one of licensing to Warhol himself (and to other artists who would use Goldsmith's work as "raw material"). Rather, the court's analysis suggested that Warhol may permissibly preempt Goldsmith's opportunities to license her work simply because he is more famous and recognizable than she. One might instead inquire, if the public wants "a Warhol," must it be a Warhol of a Goldsmith? The trial court's approach lent support to the criticism that a "transformative use" exemption conflicts with the statutory grant of exclusive rights to make derivative works; the statute defines these as encompassing any "form in which a work may be recast, *transformed*, or adapted."[9]

The Second Circuit decision

The Second Circuit reversed. It held that the district court improperly assessed the first fair use factor, "purpose and character of the use," and that "the district court's error in analyzing the first factor was compounded in its analysis of the remaining three factors. We conclude upon our own assessment of the record that all four factors favor Goldsmith and that the Prince Series works are not fair use as a matter of law."

On the first factor, the Second Circuit quoted the Supreme Court's characterization of transformativeness: "whether the new work merely supersedes the objects of the original creation, or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message."[10] But the Second Circuit chided the district court for applying a bright line rule "that any secondary work that adds a new aesthetic or new expression to its source material is necessarily transformative."[11] The court pointed to the five (of 30) works in *Cariou* that it had not held fair use as a matter of law, observing that while Prince's minimal changes

[8] *Id* at 330, 331.

[9] 17 USC § 101 (emphasis added). See *e.g., Authors Guild v Google, Inc*, 804 F.3d 202, 215 (2d Cir. 2015) ("A further complication that can result from oversimplified reliance on whether the copying involves transformation is that the word 'transform' also plays a role in defining 'derivative works,' over which the original rights holder retains exclusive control."); *Kienitz v Sconnie Nation*, 766 F.3d 756, 758 (7th Cir 2014) ("We're skeptical of *Cariou*'s approach, because asking exclusively whether something is 'transformative' not only replaces the list in §107 but also could override 17 U.S.C. §106(2), which protects derivative works. To say that a new use transforms the work is precisely to say that it is derivative and thus, one might suppose, protected under §106(2). *Cariou* and its predecessors in the Second Circuit do not explain how every 'transformative use' can be 'fair use' without extinguishing the author's rights under §106(2).").

[10] 992 F.3d at 110, *quoting Campbell*, 510 U.S. at 579

[11] *Id*. at 111.

to these photographs "certainly imbued the originals from which they derive with a 'new aesthetic,'" nonetheless, the changes were not sufficiently substantial to permit the court to determine fair use as a matter of law.[12]

Equally importantly, the court at last confronted the tension between transformative fair use and the author's exclusive right to make or to authorize the making of derivative works. Under the statutory definition, a work that has been "transformed" is a derivative work.[13] But if "transforming" a work is a fair use, then the copyright exception would appear to cancel out one of the author's exclusive rights. The Second Circuit acknowledged that "an overly liberal standard of transformativeness, such as that embraced by the district court in this case, risks crowding out statutory protections for derivative works."[14] The court recognized that its characterization of derivative works in *Cariou* "as secondary works that merely present 'the same material but in a new form' without 'add[ing] something new,'[15] could be "susceptible to misapplication . . . Indeed, many derivative works 'add something new' to their source material."[16] To preserve the viability of the derivative works right while retaining "transformativeness" as a pertinent (if not determinative) fair use consideration, the court reviewed its appropriation art fair use caselaw.

> A common thread running through these cases is that, where a secondary work does not obviously comment on or relate back to the original or use the original for a purpose other than that for which it was created, the bare assertion of a "higher or different artistic use," is insufficient to render a work transformative. Rather, the secondary work itself must reasonably be perceived as embodying an entirely distinct artistic purpose, one that conveys a "new meaning or message" entirely separate from its source material. While we cannot, nor do we attempt to, catalog all of the ways in which an artist may achieve that end, we note that the works that have done so thus far have themselves been distinct works of art that draw from numerous sources, rather than works that simply alter or recast a single work with a new aesthetic.[17]

The court's analysis evokes a variant of the quip "copying from one source is infringement; copying from multiple sources is research": appropriating and altering multiple images into one new work "transforms" each one; a use consisting solely of a single work appropriated *in toto* and verbatim is not "transformative" as a matter of law.

The court did not exclude all possibility that reworking a single prior work might yet be "transformative," but "the secondary work's transformative purpose and character must, at a bare minimum, comprise something more than the imposition of another artist's style on the primary work such that the secondary work remains both recognizably deriving from, and retaining the essential elements of, its source material."[18] Like derivative works adaptations, Warhol's revisions to

[12] *Id.*
[13] 17 U.S.C. sec.101.
[14] 992 F.3d at 111.
[15] 714 F.3d at 708.
[16] 992 F.3d at 111.
[17] *Id.* 114 (citation omitted).
[18] *Id.*

Goldsmith's photograph altered the medium, but "the Goldsmith Photograph remains the recognizable foundation upon which the Prince Series is built."[19] The Second Circuit took aim at one of the district court's more unfortunate rationales for finding Warhol's reworkings a transformative fair use:

> Finally, we feel compelled to clarify that it is entirely irrelevant to this analysis that "each Prince Series work is immediately recognizable as a 'Warhol.'"[20] Entertaining that logic would inevitably create a celebrity-plagiarist privilege; the more established the artist and the more distinct that artist's style, the greater leeway that artist would have to pilfer the creative labors of others. But the law draws no such distinctions; whether the Prince Series images exhibit the style and characteristics typical of Warhol's work (which they do) does not bear on whether they qualify as fair use under the Copyright Act.[21]

The Second Circuit also observed that Warhol's use was "commercial in nature, but . . . produce[d] an artistic value that serves the greater public interest. . . . Nevertheless, just as we cannot hold that the Prince Series is transformative as a matter of law, neither can we conclude that Warhol and AWF are entitled to monetize it without paying Goldsmith the 'customary price' for the rights to her work . . ."[22]

The third fair use factor, the amount and substantiality of the use, under which courts inquire whether the defendant took more than required for its fair use purpose, elicited another strong critique of the district court's analysis. Although Warhol had taken the entirety of Goldsmith's depiction of Prince's face (albeit not her presentation of his torso), the district court found this copying neither quantitatively nor qualitatively substantial because Warhol's treatment of the photograph, stripping out its contrast and substituting a completely different color scheme, essentially copied only the "fact" of Prince's face, leaving out Goldsmith's expressive contributions. The Second Circuit rejoined that Warhol's "end product is not merely a screenprint identifiably based on a photograph of Prince. Rather it is a screenprint readily identifiable as deriving from a *specific* photograph of Prince, the Goldsmith Photograph. . . . Nor can Warhol's appropriation of the Goldsmith Photograph be deemed reasonable in relation to his purpose. While Warhol presumably required a photograph of Prince to create the Prince Series, AWF proffers no reason why he required *Goldsmith*'s photograph."[23]

The court's analysis of the fourth factor – effect of the use on the potential market for the copyrighted work – emphasized considerations that prior transformative use cases sometimes submerged. The court began by stressing that the inquiry into market harm must take into account the impact of the use were it to become widespread. The district court rather dismissively asserted that no one seeking a Warhol would wish to acquire a Goldsmith, and that the works therefore did not compete; the Second Circuit accepted that the artists' "primary market" might differ. But it

[19] *Id.* at 115.
[20] *Warhol*, 382 F. Supp. 3d at 326.
[21] 992 F.3d at 115.
[22] *Id.* at 117.
[23] *Id.* at 119 (emphases in original).

stressed the derivative works market of licensing images as an "artist's reference" for other artists to stylize.

> [W]e . . . must consider the impact on this market if the sort of copying in which Warhol engaged were to become a widespread practice. That harm is also self-evident. There currently exists a market to license photographs of musicians, such as the Goldsmith Photograph, to serve as the basis of a stylized derivative image; permitting this use would effectively destroy that broader market, as, if artists "could use such images for free, there would be little or no reason to pay for [them]." This, in turn, risks disincentivizing artists from producing new work by decreasing its value — the precise evil against which copyright law is designed to guard.[24]

Having found that the Warhol Foundation's fair use defense failed as a matter of law, the court then addressed what should have been the predicate issue: was the Warhol image infringingly similar to Goldsmith's? Because fair use is an affirmative defense, a court normally would not turn to that issue unless the copyright owner had made out a *prima facie* case of infringement. By going directly to fair use, the district court short-circuited the usual inquiry. Rather than remanding to the district court for a ruling on whether Warhol substantially copied protected expression, however, the Second Circuit held as a matter of law that Warhol had reproduced Goldsmith's copyrightable contributions.

Comment

The Second Circuit's clear condemnation of most of the district court's analysis indicates a substantial "clarification" of (not to say retreat from) its reasoning in *Cariou*, a decision the court characterized

> as the "high-water mark of our court's recognition of transformative works." And, as we have previously observed, that decision has not been immune from criticism. While we remain bound by *Cariou*, and have no occasion or desire to question its correctness on its own facts, our review of the decision below persuades us that some clarification is in order.[25]

In *Cariou*, the court's finding of transformativeness effectively "stampeded"[26] the assessment of the other factors, particularly the fourth. If a transformative use exploits a transformative market and hence a market that does not encroach on the plaintiff's markets, then a court's acceptance of the "transformativeness" of the use tends to pre-empt the fourth factor. In *Cariou*, having found that most of the defendant's works at issue were transformative, the Second Circuit then considered the harm suffered by the plaintiff. Where in *Andy Warhol Foundation* the Second Circuit emphasized Goldsmith's market for licensing derivative works, in *Cariou* it disregarded Cariou's potential derivative works market, observing "There is nothing in the record to suggest that Cariou would ever develop or license secondary uses of his work in the vein of Prince's

[24] *Id.* at 122 (citations omitted).
[25] *Id.* at 110 (citations omitted).
[26] See Barton Beebe, supra note 2, at 588–591.

artworks."[27] Where in *Andy Warhol Foundation* the Second Circuit declined to defer to Warhol's high-end art market status, or to belittle Goldsmith's relatively proletarian position in the artistic hierarchy, in *Cariou* the court emphasized the vast differences between the audiences for Prince's works and for Cariou's. The latter's book was out of print; he had sold only four prints from the book to acquaintances and his total revenue from *Yes, Rasta* was $8,000, while Prince exhibited his works in the most exclusive galleries, sold them for over $2,000,000 and had invited Hollywood stars (such as Robert DeNiro, Angelina Jolie and Brad Pitt) and celebrities from the contemporary art world, to the opening of Richard Prince's *Canal Zone* show.[28] As poor Cariou could never hope to reach the heights that Richard Prince had achieved, the Court determined, it followed that the photographer's and the artist's markets did not overlap, and that Prince's transformative appropriation did not harm Cariou's pitiful market.

Given this precedent, it may be understandable that the *Andy Warhol Foundation* district court discerned a "celebrity-plagiarist privilege"[29] justifying its dismissive treatment of Lynn Goldsmith's market prospects. The Second Circuit's course correction restores the independence of the fourth fair use factor, particularly with respect to the importance of the markets for derivative works.

The appellate court also recognized that its past treatment of the first factor could lead to undermining the scope of the derivative works right. Consistently with some post-*Cariou* caselaw casting a more critical eye on assertions of transformativeness,[30] the Second Circuit sought but could not find "new meaning or message" in Warhol's adaptation of Goldsmith's photograph. It "examine[d] whether the secondary work's use of its source material is in service of a 'fundamentally different and new' artistic purpose and character, such that the secondary work stands apart from the 'raw material' used to create it."[31] Merely imposing one artist's style on another's work, without "comment[ing on] or relat[ing] back to the original"[32] is not likely to "transform" the copied portions of the plaintiff's work.

In this respect, the Second Circuit's analysis echoes the Ninth Circuit's in the recently decided *Dr. Seuss Ents. v. ComicMix Inc*.[33] There, also reversing a district court decision that had adopted a very encompassing concept of transformativeness, the Ninth Circuit declined to embrace a general fair use privilege for mashups, and held that *Oh the Places You'll Boldly Go*, a mashup of Dr. Seuss' *Oh the Places You'll Go* and the television series *Star Trek*, was not "transformative" and not a fair use. The court stated:

> *Boldly*'s claim to transformative use rests on the fact that it has "extensive new content." But the addition of new expression to an existing work is not a get-out-of-jail-free card that renders the use of the original transformative. The new expression must be accompanied by

[27] *Cariou*, 714 F.3d at 709.
[28] *Id*.
[29] The epithet is the Second Circuit's, not the district court's.
[30] *See, e.g., TCA Corp v McCollum*, 839 F.3d 168 (2d Cir 2016); *Brammer v Violent Hues Prods*, 922 F.3d 255 (4th Cir 2019); *Dr. Seuss Ents., supra* note 4.
[31] 992 F.3d at 114.
[32] *Id*. at 113.
[33] 983 F.3d 443 (9th Cir. 2020)

> the benchmarks of transformative use. . . . [These are] (1) "further purpose or different character" in the defendant's work, i.e., "the creation of new information, new aesthetic, new insights and understanding"; (2) "new expression, meaning, or message" in the original work, i.e., the addition of "value to the original"; and (3) the use of quoted matter as "raw material," instead of repackaging it and "merely supersed[ing] the objects of the original creation."[34]

According to the Ninth Circuit, *Boldly* met none of these "benchmarks." Significantly, and anticipating the Second Circuit's analysis in *Andy Warhol Foundation*, the Ninth Circuit emphasized *Boldly*'s potential superseding of Seuss's licensing markets for variations on *Oh the Places You'll Go*; indeed, the Second Circuit twice cited the Ninth Circuit's opinion in its discussion of harm to Goldsmith's derivative works market. *Andy Warhol Foundation* was in that respect an easy case, since AWF and Vanity Fair usurped the precise licensing market for which the magazine had paid – and granted Goldsmith name credit – in 1984. In ruling that the fourth fair use factor weighed against the Foundation, the Second Circuit had no need to speculate about remote or improbable potential licensing markets; its decision thus should not incur the usual criticism of fourth factor circular reasoning.

But the ire directed against the Second Circuit's analysis derives from normative rather than empirical appreciation of the photographer's market.[35] In contending that artists should enjoy free (in both senses of the word) entitlement to rework other artists' creations, critics of the Second Circuit's decision are asserting that there should be no cognizable market[36] for the reuse of another artist's work, even (or especially) in its entirety and substantially unaltered.[37] The "transformation" that should ensure the reuse's copyright immunity consists primarily in shifting the context of the work from lower forms of artlife (documentary photography) to the stratosphere of appropriation art. Critics promoting the higher cause of copyright-unlicensed artistic license disregard the potential markets of the creators of the "raw material." That such an approach would destroy an actual market and consequently truncate photographers' derivative work rights does not matter if that market should not exist in the first place.

Should such a market exist? We readily accept the proposition that authors should not control markets for works critical of theirs.[38] But, in endorsing broad leeway for parodies, the Supreme Court did not eschew all limits on the quantity of the taking; indeed, in *Campbell v. Acuff-Rose* it remanded for a determination whether the amount of copying exceeded that needed for Two Live Crew's purpose of parodying "Pretty Woman."[39] The Supreme Court acknowledged that too much

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[34] *Id.* at 453-54.

[35] *See, e.g.*, Blake Gopnik, *Warhol a Lame Copier? The Judges Who Said So Are Sadly Mistaken*, NEW YORK TIMES, April 5, 2021, https://www.nytimes.com/2021/04/05/arts/design/warhol-copyright-appeals-court.html

[36] The "no market" analysis of the fourth factor derives from *Campbell v. Acuff-Rose*, *supra*, note 1, 510 U.S. at 572, emphasizing that authors should not be able to control the market for works that criticize their creations ("no derivative market for critical works").

[37] Gopnick, *supra*.

[38] E.g., *Campbell*, *supra*.

[39] *Id.* 510 U.S. at. 594. For examples of inquiry into whether the defendant took more than needed, see e.g., Warner Bros Ent, Inc. v RDR Books, 575 F.Supp.2d 513 (SDNY 2008); Castle Rock Ent., Inc. v Carol Pub Group, Inc., 150 F 3d 132 (2d Cir 1998). See also Craft v Kobler, 667 F. Supp. 120, 129 (SDNY 1987) (Leval, J).

copying might invade the market for a "rap version" of the underlying musical composition.[40] The Count understood that too wide a normative "no market" sweep threatens to undermine the derivative works right.[41] A work might be critical of its target yet still take too much.[42]

The Second Circuit followed the Supreme Court's lead when it endeavored to navigate between unfair appropriation and fair use reuse by distinguishing[43] copying of a single work that "remains the recognizable foundation" of the reuse, from copying and altering multiple works into a complex whole. The latter kind of copying alters the meaning or message of the source works, while in the former kind of copying the recognizability of a single source preserves the underlying work's meaning or message (even though the second author's meaning or message may also overlay the first).

It is possible to acknowledge that the substantially unaltered taking of a single work can "transform" it in the art world sense urged by the Second Circuit's critics, yet not necessarily in the legal sense. Transformativeness is hardly the only instance in which the same term might carry different meanings in the art world and in copyright law. For example, repurposing a "found object" by changing its context from the utilitarian to the aesthetic, as Marcel Duchamp famously achieved with his 1927 "Fountain," an actual urinal placed on a pedestal in an art gallery, may be highly "original" in the art world sense. "Fountain" nonetheless is not an "original work of authorship" in the copyright sense because Duchamp did not create a replica, he adopted a preexisting actual urinal.[44]

"Transformativeness" in the legal sense may require that the alleged fair user do more than adopt another's work; she may need to add to her adoption an authorial contribution that could make her reuse a work of authorship in its own right.[45] The Second Circuit's comparison of the five of Richard Prince's Cariou-based canvases that it did not hold fair use with the 25 that it ruled fair use focused on the paucity of new matter added to the underlying works.[46] Similarly, in *Andy Warhol Foundation*, the Second Circuit found "the imposition of another artist's style on the primary work such that the secondary work remains both recognizably deriving from, and retaining the essential

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[40] "A work whose overriding purpose and character is parodic and whose borrowing is slight in relation to its parody will be far less likely to cause cognizable harm than a work with little parodic content and much copying." 510 U.S. at 593.

[41] *Id*. at 592-93: "But the [defendant's] work may have a more complex character, with effects not only in the arena of criticism but also in protectible markets for derivative works, too. In that sort of case, the law looks beyond the criticism to the other elements of the work, as it does here. 2 Live Crew's song comprises not only parody but also rap music, and the derivative market for rap music is a proper focus of enquiry."

[42] *Id.* See also Craft v Kobler, 667 F. Supp. 120, 129 (SDNY 1987) (defendant took more from Stravinsky's writings than needed to demonstrate that Robert Craft may have authored letters attributed to Stravinsky).

[43] To some subsequent ridicule, see Gopnick, *supra.*

[44] The copyright distinction between creation and adoption goes back at least to the Trademark Cases 100 U.S. 82, 94 (1879), in which the Supreme Court held that Congress did not have power under its authority over the "writings of authors" to enact a Trademarks law because trademark rights arise from adoption and use, not from creation.

[45] Incremental authorship may be necessary to fair use when the purpose of the use is the creation of a new work, but it is not a sufficient condition. As the Second Circuit emphasized, 992 F.3d at 111-12, the new work may be original, but still infringe the derivative works right.

[46] 992 F. 3d at 111. Accord, Graham v Prince, 265 F.Supp.3d 366 (SDNY 2017) (declining to rule Richard Prince's enlargements of third party Instagram posts fair use as a matter of law).

elements of, its source material"[47] an insufficient increment of authorship to render Warhol's treatment of Goldsmith's photograph transformative. "Transformative" works (in the *copyright* sense) do not "simply alter or recast a single work with a new aesthetic."[48] Warhol may have imposed a "distinct aesthetic sensibility that many would immediately associate with Warhol's signature style,"[49] but "style," however distinctive, is not a work of authorship. If a third party "Warholized" Goldsmith's image, Warhol would have no infringement claim for the appropriation of his style, and the third party alteration would be no more (or less) "transformative" than Warhol's own signature treatment of Goldsmith's image. The less copyrightable authorship in the alleged transformation, the more likely the first factor will disfavor the defendant; giving due consideration to all the fair use factors, a court may conclude that the taking is not fair use as a matter of law.

Postscript: The effect (if any) of *Google v. Oracle* on transformative fair use of works of art

Ten days after the Second Circuit's decision, the Supreme Court announced its ruling in *Google v. Oracle*,[50] holding Google's copying of 11,500 lines of code from Sun Microsystem's Application Programming Interface [API] in the development of Google's Android cell phone operating system was fair use. The Court assumed "for argument's sake" that the API's were copyrightable,[51] but then devoted its fair use analysis to emphasizing its doubts about whether copyright should cover the APIs. In effect, as the majority admitted, the fair use determination achieved the same result as ruling the APIs uncopyrightable, but attained that objective through the back end of a copyright exception rather than the front end of applying the idea/expression distinction to ascertain the scope of protectable expression: "fair use can play an important role in determining the lawful scope of a computer program copyright, such as the copyright at issue here."[52]

Atypically for fair use analysis, but consistently with its backdoor assessment of copyrightability, the majority began its discussion with a lengthy analysis of the second fair use factor, "the nature of the copyrighted work," a factor that the last three decades of fair use caselaw tend to recite and then ignore.[53] The majority's treatment of the second factor stressed that the copied "declaring code" was "further from the core of copyright" than most computer programs[54] (and, one may infer *a fortiori*, than more traditionally expressive works). The particularity of the nature of the copied code set it apart from other works and spawned a made-to-order fair use analysis.[55]

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[47] 992 F. 3d at 114.
[48] *Id.*
[49] *Id.*
[50] 141 S. Ct. 1163, 2021 U.S. LEXIS 1864 (U.S. April 6, 2021).
[51] *Id.* at *9 ("we assume, for argument's sake, that the material was copyrightable").
[52] *Id.* at *32.
[53] The second factor weighed most heavily when the plaintiff's work was unpublished, see Harper & Row v. Nation Ents., 471 U.S. 539 (1985), but a subsequent amendment to section 107 in response to lower court decisions overemphasizing works' unpublished nature clarified that a work's unpublished status is not dispositive.
[54] 2021 U.S. LEXIS 1864 at *43.
[55] See *id.* at *84 n. 11 (Thomas, J. dissenting) ("Because the majority's reasoning would undermine copyright protection for so many products long understood to be protected, I understand the majority's holding as a good-for-declaring-code-only precedent.").

The majority next turned to the first fair use factor, and inquired into the transformativeness of Google's copying of Sun's declaring code. The functional character of the declaring code informed the majority's analysis of the purpose and character of Google's use: "Here Google's use of the Sun Java API seeks to create new products. It seeks to expand the use and usefulness of Android-based smartphones. Its new product offers programmers a highly creative and innovative tool for a smartphone environment. To the extent that Google used parts of the Sun Java API to create a new platform that could be readily used by programmers, its use was consistent with that creative 'progress' that is the basic constitutional objective of copyright itself."[56] Google's use of the code was "transformative" because "reimplementing an interface can further the development of computer programs."[57]

Were these statements taken out of context, so that verbatim copying "to create new products" were generally deemed "transformative," it would be difficult to imagine what kind of copying would *not* be transformative. Hence the importance of recalling the dubious copyrightability of what Google copied. The exceptionally *laissez faire* approach to fair use may be appropriate when the copied work is far from the "core of copyright": to generalize it beyond the most interoperable components of computer programs "would undermine copyright protection for so many products long understood to be protected."[58]

But, the majority's discussion of transformative use cites examples drawn from more traditional works of authorship. "[W]e have used the word 'transformative' to describe a copying use that adds something new and important. An 'artistic painting' might, for example, fall within the scope of fair use even though it precisely replicates a copyrighted 'advertising logo to make a comment about consumerism.'"[59] Arguably, this boiler-plate recitation endorses the kind of copying in which Warhol engaged in Goldsmith's case.[60] But there is an important difference: with respect to Lynn Goldsmith's photograph, unlike the Campbell's Soup logo to which the majority implicitly referred, Warhol was not "mak[ing] a comment" about what Goldsmith's work stood for.[61] His "flattening" silk screening technique may have "added something new and important" (though by the time he "Warholized" Goldsmith's photograph, the technique may equally well have been tired

[56] *Id*. at *45.

[57] *Id*. at *46. The majority's treatment of the fourth fair use factor similarly signals its potentially unique application to interface software: "Further, we must take into account the public benefits the copying will likely produce. Are those benefits, for example, related to copyright's concern for the creative production of new expression? Are they comparatively important, or unimportant, when compared with dollar amounts likely lost (taking into account as well the nature of the source of the loss)? We do not say that these questions are always relevant to the application of fair use, not even in the world of computer programs. Nor do we say that these questions are the only questions a court might ask. But we do find them relevant here in helping to determine the likely market effects of Google's reimplementation." Id. at *53-*54 (citation omitted).

[58] *Id*. at *84 (Thomas, J. dissenting).

[59] *Id*. at *44, citing *Campbell* v. Acuff-Rose, 510 U. S., at 579, and 4 *Nimmer on Copyright* §13.05[A][1][b] (internal quotations omitted).

[60] See Andy Warhol Foundation v. Goldsmith, Petition for Panel Rehearing and Rehearing En Banc (April 23, 2021), at 2 ("Indeed, *Google* described—as a paradigm example of transformative use—a Warhol-like work of art that is materially indistinguishable from the works at issue here."), 11-12 (same).

[61] It is not apparent that Warhol was making a comment about Prince, either. But even were Prince the object of a commentary, "AWF proffers no reason why he required *Goldsmith*'s photograph." 992 F.3d at 119 (emphasis in original).

and trite), but were every "copying use that adds something new and important" to "fall within the scope of fair use," then virtually no copying, beyond the most blatant piracy, would fall outside the fair use shelter.

One could espouse a principled position that "new and important" additions to copyrighted works should not infringe;[62] that the scope of copyright protection should be limited to verbatim, piratical copying, either in general, or with particular respect to works of art. Such a position, however, is not the one Congress chose when it specified exclusive rights over derivative works, and when it directed courts to take into account not only the nature and purpose of a defendant's use, but also the amount and substantiality of the use, and the effect of that use upon the potential market for or value of the copyrighted work.[63] Many if not most derivative works "add something new and important" to the works they copy and adapt; if that were all that was required to render the use "fair," then the use "if it should become widespread, it would adversely affect the potential market for the copyrighted work"[64] by usurping derivative works markets.

Google v. Oracle is best understood in the context of software interoperability that the majority so heavily underscored. To apply its dicta past the confines of that context would transmute transformative fair use far beyond the bounds Congress drew in balancing exclusive rights and copyright exceptions.

Coda: Copyrightability of Photographs

Finally, one should not overlook the Second Circuit's analysis of copyrightable expression in a photograph. The Foundation had argued that Warhol's "flattening" of the Goldsmith image and other Warholizing treatments had reduced his copying to the factual essence of Prince's face. Since Goldsmith could not claim to have created Prince's facial features, and Warhol had drained her image of many of the frequently-evoked contributions to photographic expression, the Foundation asserted that Warhol took only unprotected elements. The Foundation's contentions tested the bases of originality in photographs. As outlined in *Mannion v. Coors Brewing Co.*,[65] three, potentially overlapping, kinds of originality characterize a protectable photograph: originality in rendition, originality in timing, and creation of the subject. The first kind of originality "'resides . . . in such specialties as angle of shot, light and shade, exposure, effects achieved by means of filters, developing techniques etc.' . . . to the extent a photograph is original in [rendition], copyright protects not what is depicted, but rather how it is depicted."[66] The second consists of "being at the right place at the right time."[67] In the last kind of originality, "the photographer created 'the scene or subject to be photographed.'"[68] While Goldsmith neither created the subject nor set the scene – she

[62] Although such a standard would probably spur contention over what additions are "new and important," thus inviting assessments of the merits of the defendant's work.
[63] 17 U.S.C. secs. 106(2), 107 (1)(3)(4).
[64] Sony Corp. of Am. v. Universal City Studios, 464 U.S. 417, 451 (1984).
[65] 377 F. Supp. 2d 444 (SDNY 2005).
[66] *Id*. at 452 (citation omitted).
[67] *Id*. (citation omitted).
[68] *Id* at 453 (citation omitted).

photographed Prince against a white backdrop, Warhol reproduced Prince's features as Goldsmith had fixed them in her photograph. Goldsmith seized a precise moment, capturing a particular expression. Warhol's treatment eliminated many of the aspects evidencing originality in rendition, but not all, as the Second Circuit detailed. In rejecting the defense that Warhol took only the informational elements of the Goldsmith photo, the Second Circuit explained:

> As applied to photographs, this protection encompasses the photographer's "posing the subjects, lighting, angle, selection of film and camera, evoking the desired expression, and almost any other variant involved." The cumulative manifestation of these artistic choices — and what the law ultimately protects — is the image produced in the interval between the shutter opening and closing, *i.e.*, the photograph itself. This is, as we have previously observed, the photographer's "particular expression" of the idea underlying her photograph.[69]

In locating the photographer's "particular expression" in "the image produced in the interval between the shutter opening and closing," the Second Circuit confirmed that timing is a protectable element of an original work of photographic authorship. The photographer may not have "created the subject," but copyright can vest in the image that results from the choice of the moment to capture it.

Conclusion

Andy Warhol Foundation (and *Dr. Seuss Ents.*) may signal a taming of "transformative use." Prior caselaw, particularly in the district courts, seemed to accept almost any alleged new meaning or purpose, or added expression, as "transformative," and then, having racked the first fair use factor into the defendant's column, lined up the other three to conform to the first. Appellate courts now may be curbing this enthusiasm, both by adopting a more critical assessment of alleged transformations, and by reviving the independent importance of the fourth factor, market harm. In emphasizing the impact of the defendant's use on the plaintiff's ability to license derivative works, the Second Circuit may have begun to redress *Cariou*'s derogatory treatment of the art world proletariat. The court recognized that depriving photographers of licensing markets, including markets for using their works as "raw material" for other artists to stylize, disserves the overall goal of copyright to promote creativity by enabling artists to make a living.

Finally, the court's exposition of protectable expression in photographs should reassure photographers, particularly photojournalists, whose art consists largely of knowing how and when to seize the moment. Against the contention that such images merely convey a reality the photographer did not create, the court's emphasis on "the image produced in the interval between the shutter opening and closing,"[70] recognizes that "the readiness is all."[71]

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[69] 992 F.3d at 118 (citation omitted).
[70] *Id.*
[71] Shakespeare, *Hamlet* V.2.