

THE “ORANGE PRINCE” OF COPYRIGHT: WARHOL’S PRINCE SERIES & TRANSFORMATIVE FAIR USE

HALEY A. PALMER*

*Dearly Beloved, we are gathered here today to get you through this thing called life. Electric word, life. It means forever, and that’s a mighty long time.*¹

INTRODUCTION

Despite the tragic death of musical icon Prince in 2016, his presence lives on through his music, in those he has inspired, and most recently, in the Supreme Court of the United States. Andy Warhol’s Prince Series, a collection of artworks concerning its namesake, has been alleged to infringe the copyright of Lynn Goldsmith’s photograph of Prince through a series of lawsuits. In a 7-2 decision, the Supreme Court held there was no fair use defense available to the Andy Warhol Foundation.²

The doctrine of fair use serves as a statutory defense to copyright infringement. It provides exceptions against the enforcement of copyright protection in certain circumstances, notably when news, parody, or art is involved. “The fair use doctrine thus ‘permits [and requires] courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster.’”³ The two most important factors of the fair use doctrine are the purpose and character of use, and the effect of the use upon the potential market. Under the first factor, precedent has directed that courts look to the “transformative” value of the derivative work.⁴ Works were transformative when they underwent a (1) physical transformation or (2) a change in use, purpose, or meaning.⁵ What qualifies as transformative, and whether it sufficiently necessitates fair use, depends on the specific court.

* J.D. Candidate, 2024, Notre Dame Law School. I would like to thank Professor Randy J. Koziel for advising me on this Note and my friend Allison Morcus for her feedback and suggestions. I would also like to thank my family for their love and support in my law school endeavors.

1. PRINCE AND THE REVOLUTION, *Let’s Go Crazy*, on PURPLE RAIN (Warner Bros. 1984).
2. See Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 598 U.S. 508 (2023).
3. Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 577 (1994) (quoting Stewart v. Abend, 495 U.S. 207, 236 (1990)).
4. *Id.* at 579 (1994) (quoting Pierre N. Leval, *Toward A Fair Use Standard*, 103 HARV. L. REV. 1105, 1111 (1990)).
5. See Brian Sites, *Fair Use and the New Transformative*, 39 COLUM. J.L. & ARTS 513, 519 (2016).

The Ninth Circuit and the Second Circuit appear to interpret the relevant Supreme Court caselaw differently. The Ninth Circuit views secondary works “as transformative as long as new expressive content or message is apparent.”⁶ This means works can be sufficiently transformative with little change to their actual content. In contrast, the Second Circuit approach largely differs because the court has become reluctant to consider changes in purpose and expression, particularly when the secondary work remains recognizably derived from the original. This reticence is an attempt to avoid bright-line rules, as encouraged by the Supreme Court in this area, and to exercise caution regarding the derivative work right. Consequently, the Second Circuit’s break from prior interpretation in *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26 (2d Cir. 2021), creates a divide between the traditional approach utilized by the Ninth Circuit and that of the Second Circuit.

Before the latest decision, the Supreme Court had addressed transformative fair use only once since *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994), largely leaving the parameters of the transformation analysis open to interpretation by the circuit courts.⁷ This question of interpretation was recently resolved on May 17, 2023, by the Supreme Court in *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*. In this case, the Court considered “whether a work of art is ‘transformative’ when it conveys a different meaning or message from its source material (as [the Supreme] Court, the Ninth Circuit, and other courts of appeals have held), or whether a court is forbidden from considering the meaning of the accused work where it ‘recognizably deriv[es] from’ its source material (as the Second Circuit has held).”⁸ Holding for photographer Lynn Goldsmith, the Court’s new decision narrows the availability of the fair use defense.

This note will argue that the Supreme Court should have established a broader conception of fair use intended to protect more works. To provide a brief roadmap, Section I discusses the background of copyright law and the fair use doctrine. Section II examines recent doctrine on transformative use, and how this doctrine differs between the Ninth and Second Circuits. Section III considers the various arguments established in *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith* and argues that the Ninth Circuit provides a more defensible approach. Section IV evaluates the Court’s decision and provides a critique in light of my Section II findings.

I. BACKGROUND

The Constitution bestows authority upon Congress to create copyright law for the express purpose of “promot[ing] the Progress of Science”⁹ This clause is largely interpreted as a utilitarian or consequentialist justification:

6. *Seltzer v. Green Day, Inc.*, 725 F.3d 1170, 1177 (9th Cir. 2013).

7. In 2021, the Supreme Court decided *Google LLC v. Oracle of America, Inc.*, 141 S. Ct. 1183 (2021).

8. Petition for Writ of Certiorari at i, *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 143 S. Ct. 1258 (2023) (No. 21-869).

9. U.S. CONST. art. I, § 8, cl. 8.

copyright law creates “adequate incentives to engage in the production of new artistic and literary works.”¹⁰ The economic and intellectual expense for copiers distributing replicas is significantly lower than the cost of creating the original work.¹¹ Thus, American copyright law turns on a quid-pro-quo philosophy—the law protects artistic and literary works to encourage artists, who in turn benefit societal culture and the public domain through their original creations.

Even as this protection incentivizes creation, however, it can stifle it too. Too much protection can limit, or even bar, subsequent creators from building on the existing artistic work.¹² Moreover, the more protected material exists, the less material there is available for future creators. To address these limitations, copyright law contains several provisions designed to narrow the scope of protection given to artists. First, copyright protection is limited in duration.¹³ Once the protection expires, works are placed in the public domain where artists are free to replicate or use them as inspiration for derivative works. Second, copyright is limited to specific kinds of works that sufficiently meet the requirements for protection.¹⁴ Third, copyright protection is limited by the fair use doctrine.

Fair use is the broadest limitation on copyright protection,¹⁵ and it intends to account for the way that artistic expression builds on existing works. “[A]s Justice Story explained, ‘[i]n truth, in literature, in science[,] and in art, there are, and can be, few, if any, things, which in an abstract sense, are strictly new and original throughout. Every book in literature, science[,] and art, borrows, and must necessarily borrow, and use much which was well known and used before.’”¹⁶ First originating in *Folsom v. Marsh*, 9 F. Cas. 342 (C.C.D. Mass. 1841),¹⁷ the doctrine and its determinative factors were codified by Congress in the Copyright Act of 1976:

[T]he fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

10. JEANNE C. FROMER & CHRISTOPHER JON SPRIGMAN, *COPYRIGHT LAW: CASES AND MATERIALS* 10 (3rd ed. 2021).

11. *See id.*

12. *See id.* at 12.

13. *See id.* at 180, tbl.6.

14. To be eligible for copyright, works must be original works of authorship fixed in any tangible means of expression. 17 U.S.C. § 102(a). Systems, methods, processes, ideas, or concepts are further excluded from copyright protection. *Id.* § 102(b). For more on eligibility limitations, see 1 MELVILLE B. NIMMER & DAVID NIMMER, *NIMMER ON COPYRIGHT* ch. 2 (1978) (hereinafter 1 *NIMMER ON COPYRIGHT*).

15. *See* FROMER & SPRIGMAN, *supra* note 10, at 389.

16. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 575 (1994) (quoting *Emerson v. Davies*, 8 F. Cas. 615, 619 (C.C.D. Mass. 1845) (alterations adopted)).

17. *See* FROMER & SPRIGMAN, *supra* note 10, at 389.

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.¹⁸

The factors are to be weighed together “in light of the purposes of copyright.”¹⁹ This does not require each factor to be given equal importance, however. In a fair use analysis, the first and fourth factors are often weighed most heavily.²⁰ The fourth factor looks to whether the copying by another “materially impair[s] the marketability of the work which is copied.”²¹ The first factor examines the commercial or noncommercial character of the use, as well as any transformative value.²² What qualifies as transformative, and whether it sufficiently necessitates fair use, depends on the specific court.

II. PRIOR TRANSFORMATIVE USE DOCTRINE

The Ninth Circuit and the Second Circuit are the most influential circuit courts when it comes to defining and applying the transformative use doctrine.²³ Nearly twenty-seven percent of non-Ninth Circuit opinions cite the Ninth Circuit in fair use cases, and nearly twenty-four percent of non-Second circuit cases similarly cite the Second Circuit.²⁴ Consequently, the Second Circuit’s break from prior interpretation in *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26 (2d Cir. 2021), creates a significant divide between the traditional approach utilized by the Ninth Circuit and that of the Second Circuit. Prior to the latest ruling, the Supreme Court had addressed transformative fair use only once since affirming its significance in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994). Due to the gap in caselaw, lower courts possessed great discretion with regards to the transformation analysis.²⁵

18. 17 U.S.C. § 107.

19. *Campbell*, 510 U.S. at 578.

20. See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 566 (1985) (“This last factor is undoubtedly the single most important element of fair use.”); *Campbell*, 510 U.S. at 579 (“[T]he more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use.”); *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 818 (9th Cir. 2003) (“The more transformative the new work, the less important the other factors, including commercialism, become.”).

21. See *Harper & Row*, 471 U.S. at 567 (quoting 1 Nimmer § 1.10[D], at 1–87).

22. See *Campbell*, 510 U.S. at 578–79.

23. See Clark D. Asay, Arielle Sloan & Dean Sobczak, *Is Transformative Use Eating the World?*, 61 B.C. L. REV. 905, 932–33 (2020).

24. See *id.*

25. In 2021, the Supreme Court decided *Google LLC v. Oracle America, Inc.*, 141 S. Ct. 1183 (2021). The Court’s recent decision in *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*, 143 S. Ct. 1258 (2023), will be subsequently addressed in Sections III and IV.

A. The Ninth Circuit of Appeals Approach

In the foundational case *Campbell v. Acuff-Rose Music, Inc.*, the Supreme Court held that determining the purpose and character of a use under the first factor requires an investigation into the transformative value of work: “[the first factor] asks, in other words, whether and to what extent the new work is ‘transformative.’”²⁶ In assessing transformative value, the court inquires whether the new work adds something that differs in purpose or character to sufficiently alter the original expression, meaning, or message.²⁷ Using the material in a way that “merely repackages or republishes the original” is unlikely to be sufficiently transformative.²⁸ Courts have found parody,²⁹ search engines,³⁰ and use of photographs in both biographical picture books³¹ and tabloids³² to be sufficiently transformative.

Secondary uses may be transformative either through physical alteration or through a change in purpose and message.³³ For works involving copyrighted language, transformative use in practice may look like “criticizing the quoted work, exposing the character of the original author, proving a fact, or summarizing an idea argued in the original in order to defend or rebut it.”³⁴ Parody is the epitome of transformative fair use of language and largely serves as the backbone of the doctrine.³⁵ Visual works, similarly, may either appear visually different or convey new expression and meaning. Often, they may do both. These transformations can be referred to as “content transformativeness” and “purpose transformativeness,” respectively.³⁶

Works categorized as content transformative alter the original work in some capacity, often to varying degrees. In *Bridgeport Music, Inc. v. UMG Recordings, Inc.*, 585 F.3d 267 (6th Cir. 2009), the secondary work was deemed transformative due to changes in theme, mood, and tone from the original song even where there was no obvious change in purpose.³⁷ Similarly, in *Blanch v. Koons*, 467 F.3d 244 (2d Cir. 2006), the original work was lightly altered and

26. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994) (quoting Pierre N. Leval, *Toward A Fair Use Standard*, 103 HARV. L. REV. 1105, 1111 (1990)).

27. *Id.* at 578–79.

28. Pierre N. Leval, *Toward A Fair Use Standard*, 103 HARV. L. REV. 1105, 1111 (1990).

29. *Campbell*, 510 U.S. at 569.

30. *See* *Authors Guild v. Google, Inc.*, 804 F.3d 202 (2d Cir. 2015); *Authors Guild, Inc. v. HathiTrust*, 755 F.3d 87 (2d Cir. 2014).

31. *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605 (2d Cir. 2006).

32. *Núñez v. Caribbean Int’l News Corp.*, 235 F.3d 18 (1st Cir. 2000). *But see* *Monge v. Maya Mags., Inc.* 688 F.3d 1164 (9th Cir. 2012).

33. *See* *Sites*, *supra* note 5, at 519 (2016).

34. Leval, *supra* note 28, at 1111.

35. Michael D. Murray, *What is Transformative? An Explanatory Synthesis of the Convergence of Transformation and Predominant Purpose in Copyright Fair Use Law*, 11 CHI.-KENT J. INTELL. PROP. 260, 272 (2012).

36. *Sites*, *supra* note 5, at 520; *see generally* Rebecca Tushnet, *Content, Purpose, or Both?*, 90 WASH. L. REV. 869 (2015).

37. *Sites*, *supra* note 5, at 520.

placed into a collage amongst other works.³⁸ The changes to the content altered the expressive meaning of the photograph and sufficiently transformed the secondary work.³⁹

More difficult to assess are works purely within the purpose transformative category, where the secondary work largely changes only the meaning of the original work. As the Supreme Court described, “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.’”⁴⁰ While changes are theoretically not required as a matter of law,⁴¹ artistic works seeking protection of the fair use doctrine generally incorporate minor aesthetic changes in addition to the transformed purpose.

The Ninth Circuit views secondary works “as transformative as long as new expressive content or message is apparent.”⁴² In *Seltzer v. Green Day, Inc.*, 725 F.3d 1170 (9th Cir. 2013), the court found fair use where plaintiff’s illustration was used as the backdrop of a rock band’s stage.⁴³ Using the formulation of the test found in *Campbell*, the circuit argued that “one work transforms another when ‘the new work . . . adds something new, with a further purpose or different character, altering the first with new expression, meaning or message.’”⁴⁴ Notably, “even where . . . the allegedly infringing work *makes few physical changes* to the original or fails to comment on the original,” it can still be transformative when accompanied by new meaning and content.⁴⁵

38. See *Blanch v. Koons*, 467 F.3d 244 (2d Cir. 2006). The Second Circuit also determined that defendant’s purpose was distinct from the original, comparing the advertisement to a work of visual art. See *id.* at 252–53. Later Second Circuit decisions have worried about collapsing the difference between purpose and expressive meaning. See *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 40 (2d Cir. 2021) (looking to an “overarching purpose” with a “high level of generality”).

39. See *Blanch*, 467 F.3d at 253.

40. *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1203 (2021) (quoting 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.05[A][1][b]). An example of an artistic painting deemed transformative in meaning might be Andy Warhol’s depictions of Campbell’s soup cans as a commentary on consumerism. See *Andy Warhol, Campbell’s Soup Cans*, MOMA LEARNING, https://www.moma.org/learn/moma_learning/andy-warhol-campbells-soup-cans-1962/ (last visited Jan. 10, 2023).

41. Multiple courts have held that use of an original, unaltered work in a searchable database is sufficient transformation due to the new purpose. See *Sites*, *supra* note 5, at 520 (citing *Authors Guild, Inc. v. HathiTrust*, 755 F.3d 87 (2d Cir. 2014); *A.V. v. iParadigms, LLC*, 562 F.3d 630, 639 (4th Cir. 2009)). Moreover, the Ninth Circuit has held that physical changes are not required for transformation. See *Seltzer v. Green Day, Inc.*, 725 F.3d 1170, 1177 (9th Cir. 2013).

42. *Seltzer*, 725 F.3d at 1177.

43. See *id.* at 1173.

44. *Id.* at 1176 (quoting *Campbell v. Acuff-Rose Music, Inc.* 510 U.S. 569, 579 (1994)).

45. *Id.* at 1177 (emphasis added); see also *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 818–20 (9th Cir. 2003) (holding that retransmission of images in a search engine as “thumbnail images” is transformative because it serves a different function and purpose than visual art); *LA News Serv. v. CBS Broad., Inc.*, 305 F.3d 924, 938–39 (9th Cir. 2002) (holding that video clip in montage was sufficiently transformed through editing to increase dramatic effect).

In *Seltzer*, the Ninth Circuit concluded defendant's use of the image was transformative because the original was used only as "raw material" in the video backdrop.⁴⁶ The original was "prominent" in the video, but appeared with a spray-painted cross over the image and in the specific context of the song discussing "the hypocrisy of religion."⁴⁷ The circuit notes that the meaning of the original is "debatable," but contrasts its possible meaning with the distinct "new information, new aesthetics, new insights and understandings" conveyed by the secondary work.⁴⁸ Within the secondary work, the original image "remains only a component of what is essentially a street-art focused music video about religion" and thus, is transformed.⁴⁹

In a more recent 2020 decision, the Ninth Circuit derived "benchmarks of transformative use" from *Campbell*, described as "our north star," and *Seltzer*:

- (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."⁵⁰

Like in *Seltzer*, the Ninth Circuit has held in other instances that secondary works are transformative despite little physical change to the original. In *Tresóna Multimedia, LLC v. Burbank High School Vocal Music Association*, 953 F.3d 638 (9th Cir. 2020), the circuit held a music rearrangement was transformative because it "did not 'simply omit portions' of the original work while retaining the 'same intrinsic entertainment value.'"⁵¹ Rather, the rearrangement added "new expression, meaning, [and] message" through its use in the musical, effectively creating a "new work with new meaning."⁵² The primary physical change between the original and secondary work involved omission of original sections, but when combined with the new expressive value from context, the secondary work was sufficiently transformed in purpose and

46. *Seltzer*, 725 F.3d at 1176.

47. *Id.* at 1176–77.

48. *See id.* at 1177.

49. *Id.* at 1176.

50. *Dr. Seuss Enters., L.P. v. ComicMix LLC*, 983 F.3d 443, 453 (9th Cir. 2020).

51. *Tresóna Multimedia, LLC v. Burbank High Sch. Vocal Music Ass'n*, 953 F.3d 638, 649 (9th Cir. 2020).

52. *Id.* at 650.

character. The Sixth,⁵³ First,⁵⁴ Fourth,⁵⁵ Third,⁵⁶ and Federal Circuits⁵⁷ have similarly concluded that addition of new meaning or message transforms a secondary work under the first factor.

Once the second use is determined to be transformative, the other three factors are less influential. This is because “[transformative] works . . . lie at the heart of the fair use doctrine’s guarantee of breathing space within the confines of copyright, and the more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use.”⁵⁸ Indeed, the Court noted that when the second use is transformative, it is more difficult to prove an unfavorable fourth factor because “market substitution is at least less certain,” and thus, “market harm may not be so readily inferred.”⁵⁹

This assessment about the weight of the factors has been adopted in most circuits.⁶⁰ Empirical analysis suggests the first factor, and specifically the transformation analysis, overwhelmingly decides the fair use result.⁶¹ From 2011 to 2017, nearly ninety percent of all copyright fair use opinions applied the transformative use doctrine.⁶² In one recent study, researchers found that of the 152 decisions where the use was transformative, 138 were successfully deemed fair use.⁶³ In the Ninth and Second Circuits, success rates for transformative users were 91.84 percent and 93.48 percent respectively.⁶⁴ Justice Thomas has remarked that “[a]lthough ‘transformative use is

53. See *Balsley v. LFP, Inc.*, 691 F.3d 747 (6th Cir. 2012). The Sixth Circuit held that the use of a photograph by a magazine was not transformation because “(1) the defendant ‘did not add any creative message or meaning to the photograph’; (2) the purpose of the ‘[d]efendant’s use of the photograph was the same as [the plaintiff’s] original use—to shock, arouse, and amuse’; and (3) the photograph was not being used ‘as a social commentary.’” Petition for Writ of Certiorari, *supra* note 8, at 38–39 (quoting *Balsley*, 691 F.3d at 759).

54. See *Núñez v. Caribbean Int’l. News Corp.*, 235 F.3d 18, 23 (1st Cir. 2000). The First Circuit found that an exact reproduction of pictures in a newspaper was transformative based on the intent and meaning of the pictures to not just “titillate, but also to inform.” *Id.* at 21–22.

55. See *Brammer v. Violent Hues Prods., LLC*, 922 F.3d 255, 263 (4th Cir. 2019) (“[E]ven a wholesale reproduction may be transformed when placed in a ‘new context to serve a different purpose,’” if it “imbu[es] the original with new . . . meaning.”).

56. See *Murphy v. Millennium Radio Grp. LLC*, 650 F.3d 295 (3d Cir. 2011). The Third Circuit held that defendant’s work was not transformed and did not possess “any new meaning” where there was an “absence of any broader commentary—whether explicit or implicit.” *Id.* at 307.

57. See *Gaylord v. United States*, 595 F.3d 1364, 1373 (Fed. Cir. 2010) (A second work “transform[s] the purpose or character of the [original] work by incorporating the work into a larger commentary or criticism.”).

58. *Campbell v. Acuff-Rose Music, Inc.* 510 U.S. 569, 579 (1994).

59. *Id.* at 591.

60. See *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 608 (2d Cir. 2006) (“Most important to the court’s analysis of the first factor is the ‘transformative’ nature of the work.”).

61. See *Asay*, *supra* note 23, at 912–13.

62. See *id.* at 931.

63. See *id.* at 941.

64. *Id.*

not *absolutely* necessary' every time, as a general matter 'the fair use doctrine has always precluded a use that "supersedes the use of the original."⁶⁵ While the factors must be weighed together, it is clear that the purpose and character analysis is doing significant work in the legal application of the fair use doctrine.⁶⁶

B. *The New Second Circuit Approach*

The Second Circuit similarly considers the purpose and character of the works when evaluating the extent to which a secondary work is transformative in the fair use context.⁶⁷ In contrast to other circuits, however, the Second Circuit recently held that some alterations in meaning may not be sufficient transformation. "[W]here a secondary work does not obviously comment on . . . 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."⁶⁸ Rather, the Second Circuit declared that the new work must be perceived as "embodying a distinct artistic purpose" that "conveys a new meaning or message separate from its source material."⁶⁹

This appears to be an evolution from the Second Circuit's earlier decisions. In *Bill Graham Archives v. Dorling Kindersley, Ltd.*, the court found held that use of another's photos in a biography of the Grateful Dead constituted fair use under 17 U.S.C. § 107.⁷⁰ There, sufficient transformation under the first factor derived from the new use of the photos both as historical artifacts documenting the concert timeline and as supplements to the reader's understanding of the accompanying biographical text.⁷¹ The circuit held that "both types of uses fulfill [defendant's] transformative purpose of enhancing the biographical information in [the biography], a purpose separate and distinct from the original artistic and promotional purpose for which the images were created."⁷² The conclusion regarding fair use was supplemented by the manner in which the defendant displayed the images. Defendant significantly reduced the size of the reproductions and "minimized the expressive value of the

65. *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1218 n.10 (2021) (Thomas, J., dissenting) (citations omitted).

66. *But see Kienitz v. Sconnie Nation LLC*, 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 . . . § 106(2), which protects derivative works.").

67. *See, e.g., Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 41 (2d Cir. 2021); *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 608 (2d Cir. 2006); *Cariou v. Prince*, 714 F.3d 694, 698 (2d Cir. 2013).

68. *Andy Warhol Found.*, 11 F.4th at 41 (quoting *Rogers v. Koons*, 960 F.2d 301, 310 (2d Cir. 1992)).

69. *Id.* at 41.

70. 448 F.3d 605 (2d Cir. 2006).

71. *See id.* at 609–10.

72. *Id.* at 610.

reproduced images by combining them with [other material] to create a collage of text and images on each page of the book.”⁷³

The Second Circuit further elaborated on transformation in *Cariou v. Prince*, 714 F.3d 694 (2d. Cir. 2013). In *Cariou*, the court found that an artist made fair use of the plaintiff’s photographs when he altered and incorporated the photographs into a series of paintings and collages.⁷⁴ Reversing the district court, the Second Circuit held the law imposes no requirement that a secondary work comment on or critique the original to be eligible for fair use.⁷⁵ Citing *Campbell*, the circuit emphasized that “a new work generally must alter the original with ‘new expression, meaning, or message.’”⁷⁶ Defendant’s artwork manifested “an entirely different aesthetic” from the plaintiff’s photographs due to changes in the composition, presentation, scale, color palette, and media, transforming the expressive nature of the work.⁷⁷ The circuit was careful to note, however, that cosmetic changes do not necessitate fair use.⁷⁸ In cases of derivative works where the material merely changes form, the transformation may be insufficient.⁷⁹ Distinguishing defendant’s paintings from mere derivative works, the court highlighted how defendant “‘add[ed] something new’ and presented images with a fundamentally different aesthetic.”⁸⁰

In *Andy Warhol Foundation for the Visual Arts v. Goldsmith*, 11 F.4th 26 (2d Cir. 2021), however, the Second Circuit clarified its reasoning from *Cariou*. The case concerned Andy Warhol’s Prince Series, which is a collection of silkscreen prints and pencil illustrations.⁸¹ The prints are based on photographer Lynn Goldsmith’s copyrighted 1981 picture of Prince.⁸² *Vanity Fair* licensed the photograph from Goldsmith and commissioned Warhol to create an illustration for the magazine article, titled “Purple Fame.”⁸³ Outside of his specific commission, Warhol also used the photograph to create fifteen more images of Prince without requesting a license from Goldsmith.⁸⁴ When Prince died in 2016, magazine *Condé Nast* paid the Andy Warhol Foundation (“AWF”) to use “Orange Prince,” a different print from the Prince Series, on the cover of the magazine.⁸⁵ Unaware of Warhol’s Prince Series, Goldsmith contacted AWF

73. *Id.* at 611.

74. *See Cariou v. Prince*, 714 F.3d 694, 698 (2d Cir. 2013), *cert. denied*, 143 S. Ct. 618 (2013).

75. *See id.* at 706.

76. *Id.* at 706 (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994)).

77. *Id.* at 706.

78. *See id.* at 708.

79. *See id.*

80. *Id.* at 708 (quoting *Leibovitz v. Paramount Pictures Corp.*, 137 F.3d 109, 114 (2d Cir. 1998)).

81. *See* Petition for Writ of Certiorari, *supra* note 8, at 52.

82. *See id.* at 53.

83. *See id.* at 9.

84. *See id.* at 10.

85. *See* Jeannie Suk Gersen, *The Supreme Court’s Self-Conscious Take on Andy Warhol*, *NEW YORKER* (Oct. 19, 2022), <https://www.newyorker.com/news/daily-comment/the-supreme-courts-self-conscious-take-on-andy-warhol>.

regarding copyright infringement upon seeing “Orange Prince” on the *Condé Nast* cover.⁸⁶ A few months later, AWF sued Goldsmith in the United States District Court for the Southern District of New York for a declaratory judgment that (a) the Prince Series did not infringe Goldsmith’s copyright or (b) the Prince Series was fair use.⁸⁷

The District Court for the Southern District of New York granted summary judgment for the AWF on its fair use claim, concluding that Andy Warhol’s Prince Series was transformative under factor one because the Prince Series portrays Prince as an “iconic, larger-than-life figure,” in contrast to the Goldsmith portrayal of Prince as “not a comfortable person” and a “vulnerable human being.”⁸⁸ The Second Circuit promptly reversed, holding the Prince Series was not sufficiently transformative to establish fair use.⁸⁹ In its rebuke, the Second Circuit suggested the district court had misinterpreted *Cariou* to hold that “any secondary work is necessarily transformative as a matter of law ‘[i]f looking at the works side-by-side, the secondary work has a different character, a new expression, and employs new aesthetics with [distinct] creative and communicative results.’”⁹⁰

Overturing the district court, the Second Circuit instead held that such an addition is the “*sine qua non* of transformativeness” but does not require a court to find that the work is transformative as a matter of law.⁹¹ Indeed, derivative works may include similar elements without receiving the protection of fair use. Further, when looking to the work’s “purpose,” as required by 17 U.S.C. § 106(1), the Second Circuit suggests a high level of generality; for visual works like Goldsmith’s photograph and Warhol’s Prince series, the overarching purpose is “to serve as works of visual art.”⁹² In such circumstances where the original and secondary works share a broader purpose, the court compares the secondary work to the source material of the original work.⁹³

86. See Brief for Petitioner at 22, *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 598 U.S. 508 (2023) (No. 21-869).

87. See Brief in Opposition at 11, *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 598 U.S. 508 (2023) (No. 21-869).

88. *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 382 F.Supp. 3d 312, 326 (S.D.N.Y. 2019).

89. See *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 38–39 (2d Cir. 2021).

90. *Id.* at 38 (citation omitted). The Second Circuit acknowledged that a literal reading of *Cariou* may support the district court’s interpretation but suggested that the district court “stretches the decision too far.” *Id.*

91. *Id.* at 38–39.

92. *Id.* at 40.

93. See *Andy Warhol Found.*, 11 F.4th at 41. In *Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992), the secondary sculpture was a three-dimensional colorized version of the original photograph. See *Andy Warhol Found.*, 11 F.4th at 41 (citing *Rogers*, 960 F.2d at 305). In *Blanch v. Koons*, 467 F.3d 244 (2d Cir. 2006), the artist used plaintiff’s photograph as part of a larger work set among similar photographs with changes of color, background, and size. See *Andy Warhol Found.*, 11 F.4th at 41 (citing *Blanch*, 467 F.3d at 253). In *Cariou*, the copyrighted works were largely combined with other photographs and “obscured and altered to the point that *Cariou*’s

Looking to previous cases, the Second Circuit derived a common principle wherein secondary works that do not obviously comment on, relate back to, or use the original for a different purpose may not be transformative due to the “bare assertion of a ‘higher or different artistic use.’”⁹⁴ While the original work may be physically recognizable in the secondary use, “the transformative purpose and character must . . . comprise something more than the imposition of another artist’s style on the primary work.”⁹⁵ In her assessment, the judge must examine whether the use of the original material by the secondary work works to provide a new purpose and character “such that the secondary work stands apart from the ‘raw material’ used to create it.”⁹⁶ Importantly, the judge “should not assume the role of art critic and seek to ascertain the intent behind or meaning of the works at issue.”⁹⁷ Judges are “unsuited” to make aesthetic decisions and “such perceptions are inherently subjective.”⁹⁸ The meaning of the secondary work is therefore not the primary consideration in the Second Circuit’s transformation analysis.

Under this framework, the Second Circuit concluded the Prince Series was not adequately transformed. The works were deemed to share both an overarching purpose as visual works, but also a narrower shared purpose as “portraits of the same person.”⁹⁹ Further, the Prince Series retained the “essential elements of its source material” and did not contain enough alteration to readily distinguish its works from the original photographs.¹⁰⁰ Despite exhibiting Warhol’s distinctive style and aesthetic, the transformation of the Prince Series was of insufficient purpose and character to establish fair use of the Goldsmith photograph.

As mentioned above, the impact of derivative works largely influenced this decision. Derivative works, defined in § 101 of the Copyright Act, are works based in part on preexisting material.¹⁰¹ These works are copyrightable,

original [was] barely recognizable.” *Andy Warhol Found.*, 11 F.4th at 41 (quoting *Cariou v. Prince*, 714 F.3d 694, 710 (2d Cir. 2013)).

94. *Andy Warhol Found.*, 11 F.4th at 41. The Second Circuit noted that previous works that sufficiently embodied a distinct artistic purpose have been drawn from numerous sources, rather than simply modifying a single work with a new aesthetic. *See id.*

95. *Id.* at 42. “We merely insist that, just as artists must pay for their paint, canvas, neon tubes, marble, film, or digital cameras, if they choose to incorporate the existing copyrighted expression of other artists in ways that draw their purpose and character from that work (as by using a copyrighted portrait of a person to create another portrait of the same person, *recognizably derived from the copyrighted portrait*, so that someone seeking a portrait of that person might interchangeably use either one), they must pay for that material as well.” *Id.* at 52 (emphasis added).

96. *Id.* at 42 (quoting *Cariou*, 714 F.3d at 706).

97. *Id.* at 41.

98. *Id.* at 41–42.

99. *Id.* at 42.

100. *Id.* at 43. The Second Circuit distinguished the Prince Series from the works in *Cariou* by arguing that the *Cariou* works possessed more substantial changes and “added material that pulled [the photographs] in new directions.” *Id.*

101. *See* FROMER & SPRIGMAN, *supra* note 10, at 44. According to 17 U.S.C. § 101, a derivative work is “a work based upon one or more preexisting works, such as a translation, musical

but only to the extent that new and individual parts of these works satisfy the originality requirement.¹⁰² The existing copyrighted material remains protected under the rights of the original author. Thus, derivative works are infringing if the pre-existing material has been taken without the consent of the original author.¹⁰³ This analysis is further illustrated in § 106(2), which grants authors the exclusive right to prepare derivative works based on their copyrighted material.¹⁰⁴

The distinction between derivative works and transformative works granted fair use protection becomes narrower when fair use is predicated upon the addition of new meaning. As the Second Circuit described current doctrine, “[t]here exists an entire class of secondary works that add ‘new expression, meaning, or message’ to their source material, but may nonetheless fail to qualify as fair use: derivative works.”¹⁰⁵ Derivative works necessarily combine existing material with new content.

“[W]hen a novel is converted to a film . . . [t]he invention of the original author combines with the cinematographic interpretive skills of the filmmaker to produce something that neither could have produced independently.” Despite the extent to which the resulting movie may transform the aesthetic and message of the underlying literary work, film adaptations are identified as a paradigmatic example of derivative works.¹⁰⁶

If such works were considered transformative under fair use, it would severely limit the copyright protections given to authors by “crowding out statutory protections for derivative works.”¹⁰⁷ In remaining cautious about what transformations are suitable, the Second Circuit intends to protect against exploitation of original works by secondary works that are more similar to unlawful derivatives than to new and creative works borrowing source material.

Rather than *breaking* from precedent, the Second Circuit believes it is *returning* to precedent in an approach more consistent with the decision of the Supreme Court in *Campbell*. In multiple cases, the Supreme Court has recognized the fair use inquiry is context-sensitive and thereby unsuitable for

arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted.” *Id.* (quoting 17 U.S.C. § 101).

102. 1 NIMMER ON COPYRIGHT, *supra* note 14, at § 3.01.

103. *Id.*

104. 17 U.S.C. § 106(2) (providing the right “to prepare derivative works based upon the copyrighted work”).

105. *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 39 (2d Cir. 2021) (quoting *Campbell*, 510 U.S. at 579).

106. *Id.* at 39–40 (quoting *Authors Guild, Inc. v. HathiTrust*, 804 F.3d 202, 216 n.18 (2d Cir. 2014)).

107. *Id.* at 39. *See also Authors Guild*, 804 F.3d at 216 n.18 (2d Cir. 2014) (“[T]he word ‘transformative,’ if interpreted too broadly, can also seem to authorize copying that should fall within the scope of an author’s derivative rights.”).

the application of simple bright-line rules.¹⁰⁸ The Second Circuit argued this recognition has been diluted, however, by the interpretation of *Cariou* by district courts. These courts have wrongly read *Cariou* as declaring that “any secondary work is *necessarily* transformative as a matter of law ‘[i]f looking at the works side-by-side, the secondary work has a different character, a new expression, and employs new aesthetics with [distinct] creative and communicative results.’”¹⁰⁹

Indeed, the criticisms here echo those expressed in Justice Thomas’s earlier *Google* dissent. There, the Court found that Google’s copying of code was protected under the fair use doctrine.¹¹⁰ In his dissenting opinion, Justice Thomas argued the majority improperly assessed the first factor, the nature of the copyrighted work.¹¹¹ While the analysis in *Google* rested upon the distinction between declaring and implementing code, a difference largely irrelevant here, Justice Thomas raised doubts regarding the majority’s interpretation of transformative use doctrine. He suggested the majority “transforms” the definition of transformative, consequently “eviscerat[ing]” copyright protections for original works.¹¹² In particular, Justice Thomas criticized the fair use inclusion of secondary works which both incorporate the original material and retain similar purposes and functions. “[T]here is nothing fair about taking a copyrighted work verbatim and using it for the same purpose and function as the original . . .”¹¹³

And, similarly to the Second Circuit, Justice Thomas suggested the *Google* majority’s interpretation of transformation has unfavorable consequences on the relationship between fair use and derivative use.

Ultimately, the majority wrongly conflates transformative use with derivative use. To be transformative, a work must do something fundamentally different from the original. A work that simply serves the same purpose in a new context—which the majority concedes is true here—is derivative, not transformative. Congress made clear that [the original author] holds “the exclusive rights . . . to prepare derivative works.”¹¹⁴

Considering these kinds of secondary works to be transformative under the fair use doctrine dilutes the § 106 derivative work right of the original author. The result, according to Justice Thomas, is companies who “profit[]

108. *Andy Warhol Found.*, 11 F.4th at 38. For this point, the Second Circuit points to the Supreme Court decisions in *Campbell* and *Google*. *Id.*

109. *Id.* (original emphasis).

110. *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183 (2021).

111. *Id.* at 1214 (Thomas, J., dissenting).

112. *Id.* at 1219.

113. *Id.* (quoting *Google LLC, Oracle Am., Inc.*, 886 F.3d 1179, 1210 (Fed. Cir. 2018)).

114. *Id.*

from exploitation of the copyrighted material without paying the customary price."¹¹⁵

In sum, the Second Circuit approach largely differs from that of the other circuits because the court has become reluctant to consider changes in purpose and expression, particularly when the secondary work remains recognizably derived from the original. This reticence stems from both desire to avoid bright-line rules, as encouraged by the Supreme Court in this area, and caution regarding the derivative work right.

III. ON SUPREME COURT APPEAL: ANDY WARHOL FOUNDATION V. GOLDSMITH

A. Facts, Procedural Background & Party Arguments

Andy Warhol Foundation for the Visual Arts, Inc., v. Goldsmith concerns the Prince Series, a collection of silkscreen prints and pencil illustrations created by the famous artist, Andy Warhol.¹¹⁶ As described in Section II-B, the prints are based on a copyrighted picture of Prince taken by photographer Lynn Goldsmith in 1981.¹¹⁷ Warhol was commissioned by *Vanity Fair*, who had licensed Goldsmith's photograph, to create an illustration for a magazine article.¹¹⁸ He subsequently used the photograph to create fifteen more images of Prince without permission from Goldsmith.¹¹⁹ One of the Warhol prints, "Orange Prince," was later used on the cover of a *Condé Nast* magazine when Prince died.¹²⁰ Unlike the original commission used in *Vanity Fair*, this article did not credit or pay Goldsmith.¹²¹

115. *Id.* (quoting *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 562 (1985)).

116. *See* Petition for Writ of Certiorari, *supra* note 8, at 9–14.

117. *See id.* at 9.

118. *See id.*

119. *See id.* at 10.

120. *See* Gersen, *supra* note 85.

121. *See id.*

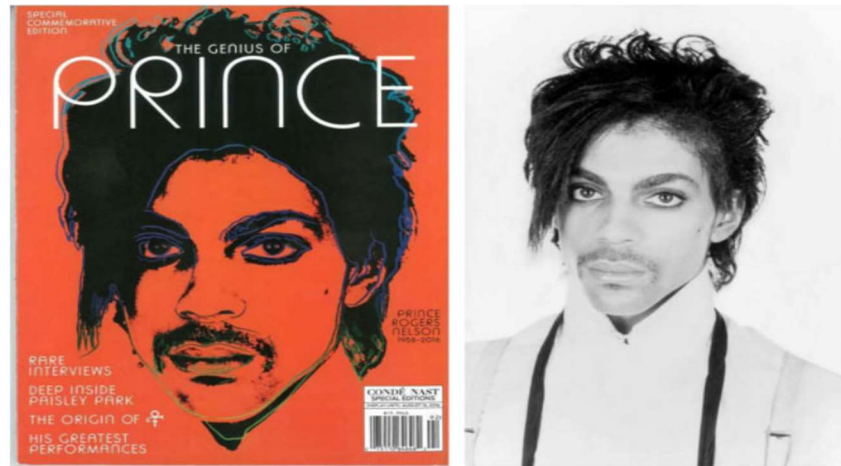


Image 1. On the left appears “Orange Prince” as the cover of Condé Nast magazine’s tribute article to Prince. On the right is Goldsmith’s copyrighted photograph of Prince.¹²²

Upon seeing “Orange Prince” on the *Condé Nast* cover, Goldsmith contacted AWF regarding copyright infringement through the Prince Series.¹²³ In April 2017, AWF sued Goldsmith in the United States District Court for the Southern District of New York for a declaratory judgment that (a) the Prince Series did not infringe Goldsmith’s copyright or (b) the Prince Series was fair use.¹²⁴ The district court granted summary judgment for AWF, concluding Warhol had “transformed” the original photograph by giving it a new meaning and message through “aesthetic and character different from the original.” The Second Circuit reversed, holding the secondary work had failed to transform and was thus not fair use.¹²⁵ The Supreme Court then granted certiorari to clarify what test should be used to determine if works are transformative, and what role this analysis should play in fair use decisions.

122. See *Justices Debate Whether Warhol Image Is “Fair Use” of Photograph of Prince*, SCOTUSBLOG (Oct. 14, 2022), <https://www.scotusblog.com/2022/10/justices-debate-whether-warhol-image-is-fair-use-of-photograph-of-prince/>.

123. See Brief for Petitioner, *supra* note 86, at 22.

124. See Brief in Opposition, *supra* note 87, at 11.

125. See *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 39 (2d. Cir. 2021). AWF argues that the question presented is “[w]hether a work of art is ‘transformative’ when it conveys a different meaning or message from its source material (as this Court, the Ninth Circuit, and other courts of appeals have held), or whether a court is forbidden from considering the meaning of the accused work where it ‘recognizably deriv[es] from’ its source material (as the Second Circuit has held).” Brief for Petitioner, *supra* note 86, at i. In contrast, Goldsmith argues that the question presented upon certiorari is “whether the Second Circuit correctly held that Warhol’s silkscreens of Prince did not constitute a transformative use, where Warhol’s silkscreens shared the same purpose as Goldsmith’s copyrighted photograph and retained essential artistic elements of Goldsmith’s photograph.” Brief in Opposition, *supra* note 87, at I.

AWF argued that (1) the Prince Series is “transformative under a straightforward application of this Court’s precedent” and (2) “[t]he Second Circuit found otherwise by jettisoning the meaning-or-message test in favor of a novel visual similarity test with no basis in this Court’s precedent.”¹²⁶ *Campbell* suggests secondary works are transformative if the work can “reasonably be perceived” as adding a new “meaning[] or message.”¹²⁷ AWF contended the Prince Series conveys this new message. “While Goldsmith communicated the message of a vulnerable Prince, Warhol’s Prince Series conveys the dehumanizing nature of celebrity.”¹²⁸

As the district court explained, Warhol removed Prince’s torso and brought his face and a small part of his neckline “to the forefront.” The details of Prince’s bone structure “are softened” in some of the works or “outlined or shaded” in others. And Warhol rendered Prince as a “flat” and “two-dimensional figure” rather than the “three-dimensional portrayal” in Goldsmith’s photograph, and introduced “loud, unnatural colors” rather than the black-and-white of the original.¹²⁹

These alterations resulted in the new meaning and expression of the secondary work. “Whereas Goldsmith’s photograph portrayed Prince as ‘uncomfortable’ and ‘vulnerable,’ the Prince Series ‘reflect[ed] the opposite’ message by portraying Prince as ‘an iconic, larger-than-life figure.’”¹³⁰ As noted by AWF in their brief, the Second Circuit even acknowledged that “the cumulative effect of [Warhol’s] alterations may change the Goldsmith Photograph in ways that give a different impression of its subject.”¹³¹

In contrast, Goldsmith proposed that (1) the Second Circuit’s decision “[f]aithfully [f]ollows” Supreme Court precedent; (2) the case does not implicate a circuit split; and (3) AWF exaggerates the implications of the Second Circuit’s decision.¹³² Goldsmith suggested the Second Circuit correctly declined to find transformation because Warhol’s Prince depiction retained the same overarching purpose and function as the Goldsmith photograph: both works of visual art are portraits of the rockstar Prince.¹³³ “When two works share such a specialized purpose, secondary works that unnecessarily copy the original do not embody a different ‘purpose or character.’”¹³⁴ Use of Warhol’s distinctive style did not render the work transformative. Rather, the Prince

126. See Brief for Petitioner, *supra* note 86, at 29–31.

127. See *id.* at 29 (citing *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577–78 (1994)).

128. *Id.* at 44.

129. *Id.* (citations omitted) (quoting *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 382 F. Supp. 3d 312, 326 (S.D.N.Y. 2019)).

130. *Id.* at 44 (quoting *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 382 F. Supp. 3d 312, 326 (S.D.N.Y. 2019)).

131. *Id.* at 45 (quoting *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 43 (2d Cir. 2021)).

132. See Brief in Opposition, *supra* note 87, at 15, 23, 29.

133. See Brief for Respondents at 32, *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*, 598 U.S. 508 (2023) (No. 21-869).

134. *Id.* at 35.

series is “closer to presenting the same work in a different form,” like the adaptation of a novel into a movie.¹³⁵

Further, Goldsmith argued that AWF misrepresented the holding of the Second Circuit decision. Instead of forbidding the consideration of new meaning and expression, the Second Circuit simply determined it was not dispositive under the purpose and character prong of the analysis.¹³⁶ There is a split regarding the *kind* of meaning considered, however, Goldsmith acknowledged the Second Circuit rejected giving weight to “subjective” impressions of meaning.¹³⁷ The intentions of the artist, particularly when later parsed out in legal battle, insufficiently provide a new meaning or expression of the work.

B. Critical Analysis: Why the Ninth Circuit Approach is More Defensible

Section II’s discussion of the two approaches makes it clear that both theories have distinct benefits. Even so, this Note argues the Ninth Circuit approach is more defensible and should have been upheld by the Supreme Court. First, the Ninth Circuit interpretation is more consistent with the Supreme Court precedent established in *Campbell* and *Google* under (1) a direct reading of caselaw; (2) the intended purpose of the fair use exception; and (3) the flexible analysis required by the doctrine. Second, the Second Circuit’s contention regarding recognizably derived works and derivative works is incompatible with the fair use doctrine as a whole.

1. The Ninth Circuit Approach is More Consistent with Precedent

To my first point, the Ninth Circuit’s approach seems to be more consistent with the interpretation of “transformative” established in *Campbell* and *Google* by the Supreme Court. When looking to the direct language of the cases, it seems evident that the Supreme Court intended fair use transformations to encompass secondary works within the “purpose transformed” category.¹³⁸ In *Campbell*, the court defined something to be transformative when it added “something new, with a further purpose or different character.”¹³⁹ By imbuing the work with a further purpose or different character, the copyrighted content within the secondary work thus is altered “with new expression, meaning[,] or message.”¹⁴⁰

135. *Id.* at 32–33.

136. *Id.* at 33.

137. *Id.* The Second Circuit similarly recognized this objective/subjective distinction in its approach. “In particular, they argue that the district court’s conclusion that the Prince Series works are transformative was grounded in a *subjective evaluation of the underlying artistic message* of the works rather than an *objective assessment of their purpose and character*. We agree.” Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 32 (2d. Cir. 2021) (emphasis added).

138. For a discussion of “purpose transformation,” see *supra* text accompanying notes 40–41.

139. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

140. *Id.*

Parody, which comments on and criticizes the original work, is an easy example of purpose transformation. The relevant parody in *Campbell* changed the message from one that “ignores the ugliness of street life and the debasement that it signified” to a song that “reasonably could be perceived as commenting on the original or criticizing it to some degree.”¹⁴¹ While parody naturally alters the content of the original work (providing content transformation), it also changes the meaning of the work. Intuitively, it seems that the changes to the parody’s meaning, rather than the content itself, provide the transformation necessary for the fair use doctrine: purpose transformation is thus at the heart of the first factor.¹⁴² And there is nothing in *Campbell* to suggest that this analysis is limited to parody or textual works. Indeed, the Supreme Court reiterated in *Google* that the word transformative is used “to describe a copying use that adds something new and important” regardless of the medium.¹⁴³ There, the Supreme Court found that Google’s use of the copyrighted code was transformative because of the “socially productive purpose for which the copying was done.”¹⁴⁴ The intended purpose changed, and so the secondary work was transformed. This was regardless of the fact that “both the original and follow-on works were the same type of content (computer software), deployed for commercial profit, in the service of the same high-level purpose (providing tools for third-party developers to create applications).”¹⁴⁵

Of course, this analysis suggests that purpose and meaning are concurrent. This is subject to interpretation, as observed in the Supreme Court’s oral argument for *Andy Warhol Foundation v. Goldsmith*. Justice Ketanji Brown Jackson inquired whether the altered message for the Warhol work was embedded within the new purpose or stemmed instead from the new character under the factor one purpose and character prong.¹⁴⁶ AWF argued that the purpose of the Prince Series was to convey a specific message through Warhol’s work, thus intertwining the two aspects.¹⁴⁷ Goldsmith, in contrast, purported that the purpose must be framed more broadly; rather, the purpose was to create a work of visual art.¹⁴⁸ Even more broadly, the purpose was to create a celebrity portrait for use in a magazine publication.¹⁴⁹ I think the better assessment is the narrower approach used by AWF because it is impractical to separate a work’s purpose—an artist’s intention in creating the piece—from the meaning the artist

141. Brief for Petitioner, *supra* note 86, at 34.

142. The desire to protect parody stems from parody’s objective to comment or criticize other works. This critical commentary provides a changed meaning, and a subsequently changed purpose. For example, if the parody were to instead quote the original material without providing the additional commentary (content transformation), it seems likely that the meaning would not have sufficiently changed to establish fair use protection under the purpose and character prong.

143. *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1203 (2021).

144. Brief for Petitioner, *supra* note 86, at 36.

145. *Id.*

146. Oral Argument at 13:58, *Andy Warhol Found. v. Goldsmith*, 598 U.S. 508 (2023) (No. 21-869), <https://www.oyez.org/cases/2022/21-869>.

147. *Id.* at 14:35.

148. See Brief for Respondents, *supra* note 133 at 19.

149. *Id.*

intended it to have. Under such a broad definition of purpose, all works of visual art would have the same purpose. This seems unnecessarily obscure, given that art museums all over the country easily create plaques describing the different purposes of each artist in creating the specific work. Once the relationship between purpose and meaning is clarified, it is evident that precedent allows for purpose transformation under the fair use doctrine.

In looking further to the language, it also appears that the Second Circuit approach inappropriately focuses on whether the secondary work is recognizably derived from the original. In *Campbell*, the Court rejected a lower court's transformation decision based on "excessive borrowing."¹⁵⁰ The Sixth Circuit had held that the parody had taken the "heart of the original" and made it into the "heart of a new work," effectively taking too much for it to constitute a sufficiently new and transformed secondary work.¹⁵¹ The Supreme Court, however, held that the relevant question "was not the amount of material copied, but whether the follow-on work can 'reasonably be perceived' as 'add[ing] something new, with a further purpose or different character, altering the first with new expression, meaning, or message.'"¹⁵² And in *Google*, when describing what transformation might look like, the Court provided two examples. One was an artistic painting that "precisely replicates a copyrighted 'advertising logo to make a comment about consumerism.'"¹⁵³ The second was a parody like in *Campbell*.¹⁵⁴ These examples suggest that recognition has no place in the transformation analysis. As AWF emphasized in their brief, Supreme Court precedent imposes no restrictions regarding similarities between the original and secondary work. "In both illustrations, the follow-on works recognizably resembled the originals. Notwithstanding those similarities, it was the difference in meaning or message that rendered the new works transformative."¹⁵⁵

Moreover, the consequences of the Ninth Circuit approach are more faithful to the expressed purpose of the fair use doctrine under *Campbell* and *Google* and of copyright protection itself. "Commentators have put the matter more broadly, asking whether the copier's use 'fulfill[s] the objective of copyright law to stimulate creativity for public illumination.'"¹⁵⁶ And as described in *Google*, the secondary use was "consistent with that creative 'progress' that is the basic constitutional objective of copyright itself."¹⁵⁷ The Ninth Circuit's definition of transformation meets these objectives because it

150. *Acuff-Rose Music, Inc. v. Campbell*, 972 F.2d 1429, 1438 (6th Cir. 1992), *rev'd* 510 U.S. 569 (1994).

151. Brief for Petitioner, *supra* note 86, at 34 (quoting *Acuff-Rose Music, Inc. v. Campbell*, 972 F.2d at 1429, 1438 (1992)).

152. *Id.* at 34 (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. at 579, 582).

153. *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1203 (2021).

154. *Id.*

155. Brief for Petitioner, *supra* note 86, at 36.

156. *Google*, 141 S. Ct. at 1203–04.

157. *Id.* at 1203. Cf. *Feist Publ'ns., Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 349–50 ("The primary objective of copyright is not to reward the labor of authors, but '[t]o promote the Progress of Science and useful Arts'" (quoting U.S. CONST., art. I, § 8, cl. 8)).

protects some uses of prior existing works in the creation of art. Art necessarily builds on other works because it is often impossible to separate influences from one's own creation. Such an approach protects the ability to do so and incentivizes creation. Critics of the Ninth Circuit approach suggest it causes judges to serve as "art critic[s]" in their assessment of the "intent behind or meaning of the works at issue."¹⁵⁸ The Second Circuit notes that "judges are typically unsuited to make aesthetic judgments," and that this approach causes difficulty because "such perceptions are inherently subjective."¹⁵⁹ This is commonly known as the *Bleistein* principle. Derived from *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903), the principle suggests judges should not look to the artistic merits of a work when determining whether it is deserving of copyright protection.¹⁶⁰ The very point of the fair use doctrine, however, is to avoid "rigid application" of the law and to provide an "equitable rule of reason."¹⁶¹ By its very nature, this sort of assessment is one that requires discretion and assessment by the judge. Trying to create a standard that avoids subjective perceptions by the judge is thereby antithetical to the very purpose of the fair use doctrine. This is further reflected in the character of a balancing test, as described by the Supreme Court in *Google*:

In applying this provision, we, like other courts, have understood that the provision's list of factors is not exhaustive (note the words "include" and "including"), that the examples it sets forth do not exclude other examples (note the words "such as"), and that some factors may prove more important in some contexts than in others.¹⁶²

Of course, the Second Circuit would likely argue that judging art itself on quality is different than having discretion to make a decision. Judges frequently do the second but are perhaps unprepared to do the first. In response, I would provide that the two are more similar than one might first expect. Judges place themselves in the position of a reasonably prudent person whenever they make legal decisions. They also ascertain subjective intent through evidence and testimony whenever required by the law. Assessing the purpose and meaning of art, through the intentions of the artist and the objective meaning of the work, is analogous to this earlier inquiry. Moreover, the Ninth Circuit's approach does not mandate that transformative meaning necessitates fair use; transformation is just one of the more significant factors in the inquiry. Indeed, it seems like the Court is almost serving as an art critic by deciding that some forms of art can be sufficiently transformed through meaning (parody) whereas visual art is incapable of doing so.

158. *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 41 (2d. Cir. 2021)).

159. *Id.* at 41–42.

160. *See* 188 U.S. 239, 251 (1903) ("It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.").

161. *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1196 (2021).

162. *Id.* at 1197.

2. The Second Circuit's Contention Regarding Recognizably Derived Works and Derivative Works is Incompatible with Fair Use Doctrine

To my second point, the Second Circuit's contention regarding recognizably derived works and derivative works is incompatible with the fair use doctrine. The Second Circuit suggests that the distinction between derivative works and transformative works granted fair use protection becomes narrower when fair use is predicated upon the addition of new meaning.¹⁶³ If many derivative works were considered transformative under fair use, it would severely limit the copyright protections given to authors by "crowding out statutory protections for derivative works."¹⁶⁴ In remaining cautious about what transformations are suitable, the Second Circuit intends to protect against exploitation of original works by secondary works that are more similar to unlawful derivatives than to new and creative works borrowing source material.

Justice Thomas also expresses concern about conflation between derivative works and transformed works in his *Google* dissent.¹⁶⁵ Ultimately, Justice Thomas is the one who conflates the two. This point of view misconstrues the relationship between fair use and derivative works. There should be no fear about collapsing derivative works into transformative works because both types of works are inherently infringing. Fair use is a defense to copyright infringement; secondary works protected under the fair use doctrine naturally infringe of an original work's copyright. It is unimportant that a work is recognizably derived because the whole point is that the work is likely infringing. If it is not recognizably derived, then the litigants might not have even reached the fair use defense. Indeed, it files down the teeth of the defense to suggest that it is improperly applied when a work is recognizably derived. Protecting sufficiently transformed derivative works under the fair use doctrine is more consistent with what fair use is designed to do as an affirmative defense to copyright infringement.

In comparing the Ninth and Second circuit approaches, one underlying issue may result from the fact that the relevant original work is a photograph. Photography and copyright possess a complicated history in a way distinct from

163. *Andy Warhol Found. for the Visual Arts*, 11 F.4th at 39–40. "When a novel is converted to a film . . . [t]he invention of the original author combines with the cinematographic interpretive skills of the filmmaker to produce something that neither could have produced independently." Despite the extent to which the resulting movie may transform the aesthetic and message of the underlying literary work, film adaptations are identified as a paradigmatic example of derivative works." (citations omitted).

164. *Id.* at 39. *See also* *Authors Guild v. Google, Inc.*, 804 F.3d 202, 216 n.18 (2d Cir. 2015) ("[T]he word 'transformative,' if interpreted too broadly, can also seem to authorize copying that should fall within the scope of an author's derivative rights.").

165. *See supra* Part II, Section B. "To be transformative, a work must do something fundamentally different from the original. A work that simply serves the same purpose in a new context—which the majority concedes is true here—is derivative, not transformative. Congress made clear that [the original author] holds 'the exclusive rights . . . to prepare derivative works.'" *Google*, 141 S. Ct. at 1219 (Thomas, J., dissenting).

other forms of art.¹⁶⁶ This seems largely due to the tendency of photography to blur lines between idea and expression. For example, how much of Goldsmith's portrait photograph is protectable expression and how much is merely Prince's face? While not explicitly relevant to the issue at hand, it surely complicates the assessment. Justice Roberts even inquired about the relationship between photography and purpose/meaning during the oral argument.¹⁶⁷ Here, however, there is no issue regarding copying-in-fact because there is evidence that Warhol used Goldsmith's image as a base for the painting.

IV. THE SUPREME COURT DECISION

On May 18, 2023, the Supreme Court released its opinion regarding *Andy Warhol Foundation for the Visual Arts Inc. v Goldsmith*. In a divided 7-2 decision authored by Justice Sotomayor, the Court found that the Andy Warhol Foundation (AWF) was not entitled to a fair use defense to copyright infringement.¹⁶⁸ In their assessment of the first factor of the defense, "the purpose and character of the use" is best determined by following the Second Circuit's approach.¹⁶⁹ There are four primary critiques to be made in response.

First, the decision fails to appreciate the connection between the aesthetics and purpose of an artistic work. Throughout the opinion, the Court reflected on the balancing of the different components within the first factor. A further purpose or different character of a work is a matter of degree which must be weighed against other considerations, like a commercial nature.¹⁷⁰ And critically, the Court held that a new purpose or expression alone does not render a work transformative. Rather, "[i]f an original work and a secondary use share the same or highly similar purposes, and the secondary use is of a commercial nature, the first factor is likely to weigh against fair use, absent some other justification for copying."¹⁷¹ Here, the Court found the purposes between Orange Prince and Goldsmith's photograph to be substantially the same: portraits of Prince used to depict Prince in magazines about Prince.¹⁷² The variation in aesthetics chosen for the portraits "did not stop the photos from serving the same essential purpose of depicting Prince in a magazine commemorating his life and career."¹⁷³ But this assessment of purpose falls short because it fails to observe how a change in aesthetics might thereby change the purpose. As the dissent notes, the difference of aesthetics and meaning between the Goldsmith photo and the Warhol portrait is crucial: the magazine editors knew about the photo but selected the portrait precisely because it

166. For a discussion on the copyrightability of photographs, see *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884).

167. See Oral Argument, *supra* note 146 at 56:18.

168. *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 598 U.S. 508 (2023).

169. See *id.* at 516.

170. *Id.* at 515–16.

171. *Id.* at 532.

172. *Id.* at 533.

173. *Id.* at 535, n.11.

conveyed something different.¹⁷⁴ In essence, “Warhol had effected a transformation.”¹⁷⁵

In reference to new meaning or message, the majority was quick to note that a secondary work’s new meaning or message remains relevant to the work’s purpose.¹⁷⁶ The “reasonable perception” of the meaning of the work “should be considered to the extent necessary to determine whether the purpose of the use is distinct from the original.”¹⁷⁷ Thus, the Court suggests the new meaning analysis is inextricable from the work’s purpose. The mistake occurs when the majority focuses too little on the provision of new expression, meaning, or message. While the broader purposes of the works may be the same, the narrower purposes are distinct. This is critical because the narrower purpose is more clearly related to the meaning and message of the work. Rather than merely being a portrait for a magazine, the purpose of Warhol’s work was to convey “new messages about celebrity culture and its personal and societal impacts.”¹⁷⁸ And this new purpose was reflected in the “meaning that arose from replacing a realistic—and indeed humanistic—depiction of the performer with an unnatural, disembodied, masklike one.”¹⁷⁹

Consideration of commercialism and market opportunities additionally played a significant role in the majority’s decisionmaking. As the Court notes, a work’s commercial nature weighs against its transformative value under factor one.¹⁸⁰ Further, commercialism ties into the purpose of a work and the broader goals of copyright law.¹⁸¹ Using copied material for new, transformative purposes better serves the goal of enriching public knowledge. And on the other hand, it is less likely that the secondary work will be a substitute which shrinks the original work’s “protected market opportunities.”¹⁸² Here, the Court found the Warhol’s use to be “of a commercial nature” because of its later magazine publication.¹⁸³ I believe the Court errs in its assessment. Notably, the historical purpose of copyright law has been to provide “adequate incentives to engage in the production of new artistic and literary works.”¹⁸⁴ People are absolutely served by public access to the artistic creations of others, but the primary goal of copyright law is to encourage artists by protecting artistic and literary works. In turn, the artists eventually benefit societal culture and the public domain through their original creations. The order is important, however, because prioritizing public knowledge can often contradict artistic incentives, thereby depleting the artistic sphere. Moreover, the mere fact that Warhol’s work

174. *Id.* at 566–67 (Kagan, J., dissenting).

175. *Id.* at 567.

176. *See id.* at 537–38.

177. *Id.* at 544–45.

178. *Id.* at 573 (Kagan, J., dissenting).

179. *Id.*

180. *See id.* at 531.

181. *Id.*

182. *Id.*

183. *Id.* at 532–34.

184. FROMER & SPRIGMAN, *supra* note 10.

contained some commercial aspects should not have proven significant to the majority. Most artists, of course, intend to profit from their works. Deeming an artistic work to possess less creative and transformative value because it was sold or intended for commercial use is comparable to a *Bleistein* violation.¹⁸⁵

Echoing Justice Thomas's earlier comments, the majority was further concerned about the implications of transformation on the derivative work right. While noting that the right is subject to fair use, and that the two are compatible at times, the majority argues that "an overbroad concept of transformative use, one that includes that further purpose, or any different character, would narrow the copyright owner's exclusive right to create derivative works."¹⁸⁶ To avoid this result, "the degree of transformation required to make 'transformative' use of an original must go beyond that required to qualify as a derivative."¹⁸⁷ The Court refers to the parody in *Campbell* to illustrate this reasoning. There, merely adding lyrics and musical elements was not sufficient for fair use without the addition of parody (thereby creating a new purpose of commenting or criticizing on the original work).¹⁸⁸ The majority, however, was careful to note that derivative works with substantial copying from an original may still be eligible for fair use.¹⁸⁹ Warhol's Soup Cans provides one such example.¹⁹⁰ The Court argues that the Prince Series, in contrast, does not have justification for the use of Goldsmith's photograph, nor does it sufficiently transform the photograph.¹⁹¹ As noted above and in Section III, I disagree with this assessment. The derivative work right is not impaired because fair use is simply a defense to copyright infringement in limited and justified circumstances. A work that is transformative through a change in meaning and expression indeed goes beyond a mere derivative work; it becomes something new.

CONCLUSION

To conclude, the doctrine of fair use is a flexible defense to copyright infringement for works that are sufficiently "transformed" under the first factor. There was historically little Supreme Court guidance as to the correct test for transformation, and the Ninth and Second Circuits had subsequently split as to their interpretations as described in Part II. This note further suggested in Part III that the Ninth Circuit approach is instead more defensible because it is consistent with the Supreme Court precedent established in *Campbell* and *Google* under (1) a direct reading of caselaw; (2) the intended purpose of the fair use exception; and (3) the flexible analysis required by the doctrine. Moreover, the Second Circuit's contention regarding recognizably derived works and derivative works is largely incompatible with the fair use doctrine as a whole. After the Supreme Court's recent decision in *Andy Warhol Foundation*

185. *Andy Warhol Found.*, 598 U.S. 508, 544 (2023).

186. *Id.* at 529.

187. *Id.*

188. *Id.* at 529–30.

189. *Id.* at 538.

190. *Id.* at 539.

191. *Id.* at 540.

for the Visual Arts, Inc. v. Goldsmith, the Court has largely adopted the Second Circuit's approach. Part V demonstrates that the Supreme Court's decision possesses several weaknesses. Notably, the Court's new approach fails to appreciate the relationship between an artistic work's purpose and its expressive aesthetic. And further, it places undue importance on the work's commercial aspects and overestimates tensions between fair use and derivative work rights. As a result, copyright protection for existing artwork is stronger than ever, but incentives to create new works may be diminished.