

# ASK PERMISSION: THE SECOND CIRCUIT'S TRANSFORMATIVE FAIR USE INQUIRY

**Abstract:** In 2021, in *Andy Warhol Foundation for Visual Arts, Inc. v. Goldsmith*, the U.S. Court of Appeals for the Second Circuit held that artist Andy Warhol's adaptation of a photograph depicting rock-and-roll star Prince was not a transformative fair use. In so holding, the Second Circuit declined to follow the Supreme Court's instruction that courts must consider whether and to what extent the use is "transformative"—that is, contributes something novel, with an added purpose or changed character, varying the original work with a unique aesthetic, tenor, or implication. This Comment argues that the Second Circuit rightly narrowed the scope of transformativeness, restoring meaning to Congress's prescribed balancing test and remedying an undue deprivation of property rights.

## INTRODUCTION

Copyright law seeks to stimulate public creativity by furthering two conflicting principles—the protection of artists' exclusive rights to their work and the public's access to that same output.<sup>1</sup> The fair use doctrine, an affirmative defense to copyright infringement, attempts to level these twin aims by allowing people, in certain instances, to copy and build on copyrighted works without permission.<sup>2</sup> This powerful allowance for permissionless copying manifests itself on a daily basis—anyone who has watched the news, a parodic late-night talk show, or a documentary, or freely copied from the internet has benefitted from fair use.<sup>3</sup> Because cultural advancement often comes through adaptations of existing art, the doctrine is inextricably linked to freedom of expres-

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<sup>1</sup> See Lauren Gorab, *A Fair Use to Remember: Restoring Application of the Fair Use Doctrine to Strengthen Copyright Law and Disarm Abusive Copyright Litigation*, 87 FORDHAM L. REV. 703, 703 (2018) ("The primary goal of copyright law is to benefit the public. By rewarding authors with exclusive rights, . . . copyright law accomplishes this goal.").

<sup>2</sup> See *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 36 (2d Cir. 2021) (explaining that the fair use doctrine developed through common law to further copyright's purpose of advancing the arts), *cert. granted*, 142 S. Ct. 1412 (mem.) (2022).

<sup>3</sup> See Paul Szyndl, *The Andy Warhol Case That Could Wreck American Art*, THE ATLANTIC (Oct. 1, 2022), <https://www.theatlantic.com/ideas/archive/2022/10/warhol-copyright-fair-use-supreme-court-prince/671599/> [<https://perma.cc/24LD-QHJP>] (describing how society benefits from the fair use doctrine); Joshua Lamel, *Why Fair Use Is Important for Everyone*, MEDIUM (Aug. 3, 2016), <https://medium.com/@jlamel/why-fair-use-is-important-for-everyone-88dff0f8e92d> [<https://perma.cc/GH8K-7EYT>] (explaining that fair use protects many routine activities, including posting on social media and scholarly pursuits).

sion and creative innovation.<sup>4</sup> Yet the Second Circuit recently narrowed the boundaries of fair use, effectively transferring certain rights from the public back to copyright owners.<sup>5</sup> The Supreme Court granted certiorari on the fair use inquiry, heard arguments in October 2022, and will soon render a decision.<sup>6</sup>

Part I of this Comment overviews the legal, factual, and procedural background of *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*.<sup>7</sup> Part II compares the Second Circuit's newfound approach to the fair use doctrine with the Ninth Circuit's approach.<sup>8</sup> Part III argues that the Second Circuit's curtailing of fair use is a commendable retreat to Congress's written word.<sup>9</sup>

## I. THE LEGAL, FACTUAL, AND PROCEDURAL BACKGROUND OF *ANDY WARHOL FOUNDATION FOR THE VISUAL ARTS, INC. V. GOLDSMITH*

In 2021, in *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*, the U.S. Court of Appeals for the Second Circuit arguably departed from the Supreme Court's instructions and appeared to split from the Ninth Circuit in its application of the fair use doctrine.<sup>10</sup> To decide whether the use of a copyrighted work is "fair" (non-infringing), courts consider, among other factors, whether the use is "transformative."<sup>11</sup> In assessing transformativeness, the Second Circuit ostensibly diverged from the Ninth Circuit by barring an inquiry into the intent or meaning behind the challenged work.<sup>12</sup> Section A of

<sup>4</sup> See Szynol, *supra* note 3 (arguing that fair use is a pillar of free expression and creativity).

<sup>5</sup> See generally *Goldsmith*, 11 F.4th at 37–51 (reevaluating the Second Circuit's fair use jurisprudence and holding that a secondary work must have a *distinct* artistic purpose to constitute a "transformative" fair use).

<sup>6</sup> *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*, SCOTUSBLOG, <https://www.scotusblog.com/case-files/cases/andy-warhol-foundation-for-the-visual-arts-inc-v-goldsmith/> [<https://www.scotusblog.com/case-files/cases/andy-warhol-foundation-for-the-visual-arts-inc-v-goldsmith/>]].

<sup>7</sup> See *infra* notes 10–44 and accompanying text.

<sup>8</sup> See *infra* notes 45–82 and accompanying text.

<sup>9</sup> See *infra* notes 83–102 and accompanying text.

<sup>10</sup> Compare *Goldsmith*, 11 F.4th at 41 (holding that "the intent behind or meaning of the works" cannot factor in determining whether a secondary work is a transformative fair use), with *Seltzer v. Green Day, Inc.*, 725 F.3d 1170, 1176–77 (9th Cir. 2013) (finding a secondary work transformative because it had a "meaning" distinct from the original copyrighted work), *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994) (explaining that a secondary work is a transformative fair use if it alters the "meaning[] or message" of its source material), and *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1202 (2021) (reaffirming the test used in *Campbell*).

<sup>11</sup> See 17 U.S.C. § 107 (providing four factors to be considered in determining whether a particular use is a fair one); *Google*, 141 S. Ct. at 1188 ("The inquiry into 'the purpose and character' of the use turns in large measure on whether the copying at issue was 'transformative,' *i.e.*, whether it 'adds something new, with a further purpose or different character.'" (quoting *Campbell*, 510 U.S. at 579)).

<sup>12</sup> See *Goldsmith*, 11 F.4th at 41–42 ("In conducting this [fair use] inquiry . . . the district judge should not assume the role of art critic and seek to ascertain the intent behind or meaning of the works at issue."); cases cited *supra* note 10 (comparing the Second Circuit's newfound transformative use test to that of the Ninth Circuit and Supreme Court).

this Part discusses the fair use doctrine with a focus on the standards for evaluating transformativeness.<sup>13</sup> Section B provides an overview of the factual and procedural history of *Goldsmith*.<sup>14</sup>

### *A. The Fair Use Doctrine and Confusion over “Transformativeness”*

Copyright law promotes the development of the arts by endowing artists with undivided intellectual property rights and the ability to enforce those rights through infringement actions.<sup>15</sup> Crucially, copyright protections extend to both original and derivative works.<sup>16</sup> Although an artist’s rights are exclusive, they are not unlimited—the fair use doctrine limits the scope of infringing acts and thus the artist’s ability to successfully assert their rights.<sup>17</sup> Fair use balances an original artist’s right to profit from their artistic feats with the desire to advance creative and academic pursuits more broadly by allowing the public to use original works as building blocks.<sup>18</sup> Courts achieve that balance by engaging in a fact-intensive inquiry designed to establish whether a use is a fair use (non-infringing) or a derivative use (infringing).<sup>19</sup>

Originally a creature of common law, Congress codified the fair use doctrine in the Copyright Act of 1976.<sup>20</sup> In addition to providing several presumptively fair uses, the statute recites four factors that courts must consider when evaluating a fair use defense: (1) “the purpose and character of the use,” (2) the distinctiveness of the copyrighted work, (3) the degree of copying, and (4) the

<sup>13</sup> See *infra* notes 15–31 and accompanying text.

<sup>14</sup> See *infra* notes 32–44 and accompanying text.

<sup>15</sup> See U.S. CONST. art. I, § 8, cl. 8 (“The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . .”); 17 U.S.C. §§ 106, 501 (providing copyright owners with exclusive rights and the ability to assert those rights through infringement actions).

<sup>16</sup> See 17 U.S.C. §§ 103, 106 (establishing that a copyright grants owners the undivided right to distribute copies of the original work and “to prepare derivative works based upon the copyrighted work”). The statute defines a derivative work as “a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgement, condensation, or any other form in which a work may be recast, transformed, or adapted.” *Id.* § 101 (emphasis added).

<sup>17</sup> See *id.* § 107 (“[T]he fair use of a copyrighted work, including such use by reproduction in copies . . . , for purposes such as criticism, comment, news reporting, teaching . . . , scholarship, or research, is not an infringement of copyright.”).

<sup>18</sup> See *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 36 (2d Cir. 2021) (explaining that the fair use doctrine is needed because virtually every cultural advancement or “new” work takes from prior work to some extent), *cert. granted*, 142 S. Ct. 1412 (mem.) (2022).

<sup>19</sup> See *id.* at 39 (observing that derivative works are not fair uses); *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1197 (2021) (explaining that fair use is elastic and fact-dependent).

<sup>20</sup> See Copyright Act, Pub. L. No. 94-553, § 101, 90 Stat. 2541, 2546 (codified as amended at 17 U.S.C. § 107) (codifying the fair use doctrine and the common law factors to be considered during the inquiry); H.R. REP. NO. 94-1476, at 65 (1976) (“The judicial doctrine of fair use, one of the most important and well-established limitations on the exclusive right of copyright owners, would be given express statutory recognition for the first time in section 107.”).

economic effect on the copyrighted material.<sup>21</sup> Still, the statute provides no guidance on how to weigh or apply the factors.<sup>22</sup>

In 1994, in *Campbell v. Acuff-Rose Music, Inc.*, the Supreme Court sought to clarify the fair use statute by explaining that the main inquiry for the first factor—purpose and character of the use—is whether the secondary work is “transformative.”<sup>23</sup> A transformative work contributes something novel, with an added purpose or changed character, varying the original work with a unique aesthetic, tenor, or implication.<sup>24</sup> Despite emphasizing the importance of transformativeness as it pertains to the first factor, the Court left much unexplained, including *how* or *how much* to weigh it in the fair use inquiry and what distinguishes a transformative use from a derivative use.<sup>25</sup> Accordingly, there is significant confusion within the judiciary over how to apply the fair use test, what consti-

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<sup>21</sup> 17 U.S.C. § 107 (outlining the fair use factors: (1) the “purpose and character of the use,” (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”).

<sup>22</sup> See *id.* (providing no direction to courts other than to consider the four factors). As a striking example of the doctrine’s unpredictability, the Ninth Circuit held that the rebroadcast of the same footage was a fair use in one instance but not in another. *Compare* *L.A. News Serv. v. KCAL-TV Channel 9*, 108 F.3d 1119, 1123 (9th Cir. 1997) (holding that a rebroadcast of footage was *not* fair use), *with* *L.A. News Serv. v. CBS Broad., Inc.*, 305 F.3d 924, 942 (9th Cir. 2002) (holding that a rebroadcast of the same footage was fair use). Whereas the infringing rebroadcast merely added voiceover to the copyrighted footage and continued to present it as news, the non-infringing rebroadcast creatively edited the footage for dramatic effect, used less of it than the infringing use, and used it for a purpose beyond news. See *CBS*, 305 F.3d at 938–42 (distinguishing *KCAL-TV* and finding fair use, in large part because the rebroadcast was unlikely to affect the relevant market).

<sup>23</sup> See *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)) (instructing that the transformative use inquiry is intended to distinguish infringing works that supplant the original from non-infringing works that “add[] something new, with a further purpose or different character”). Although courts may find fair use in the absence of transformativeness, transformative works “lie at the heart of the fair use doctrine’s guarantee of breathing space within the confines of copyright . . .” See *id.* (“[T]he goal of copyright, to promote science and the arts, is generally furthered by the creation of transformative works.”).

<sup>24</sup> See *id.* (instructing that a transformative use “adds something new, with a further purpose or different character, altering the first [work] with new expression, meaning, or message”); *Google*, 141 S. Ct. at 1202 (reaffirming the *Campbell* Court’s “meaning or message” test for transformativeness (quoting *Campbell*, 510 U.S. at 579)).

<sup>25</sup> See *Campbell*, 510 U.S. at 579 (neglecting to explain from whose perspective “meaning” or “message” are to be evaluated, to what extent other factors are to be discounted if a use is transformative, and how a transformative use is distinguished from a derivative use). Courts have recognized a tension between transformative uses (favoring non-infringement) and derivative uses (infringing) because derivative works are defined in part as works that “recast, transform[], or adapt[]” an original work. See 17 U.S.C. § 101 (emphasis added) (defining derivative works); *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 39 (2d Cir. 2021) (“[A]n overly liberal standard of transformativeness . . . risks crowding out statutory protections for derivative works.” (citing *Authors Guild v. Google, Inc.*, 804 F.3d 202, 216 n.18 (2d Cir. 2015))), *cert. granted*, 142 S. Ct. 1412 (mem.) (2022).

tutes a transformative fair use, and how a transformative use differs from a derivative use.<sup>26</sup>

Nevertheless, the transformative use test has exerted significant control over fair use jurisprudence since its inception.<sup>27</sup> Beyond appearing in almost every copyright infringement case, transformative uses are almost always ruled fair uses.<sup>28</sup> Because it is practically dispositive, whether a use is transformative is a question that generates significant interest and substantial controversy.<sup>29</sup> Nowhere is this phenomenon more salient than the Second Circuit and nowhere is it more controversial than in the context of appropriation art.<sup>30</sup> Enter

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<sup>26</sup> See, e.g., *Kienitz v. Sconnie Nation LLC*, 766 F.3d 756, 758 (7th Cir. 2014) (“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).”); *Google*, 141 S. Ct. at 1219 (Thomas, J., dissenting) (“[T]he 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 . . . is derivative, not transformative.”). See generally Jiarui Liu, *An Empirical Study of Transformative Use in Copyright Law*, 22 STAN. TECH. L. REV. 163 (2019) (describing fair use as the most uncertain area of copyright law and explaining that courts disagree on how to define transformativeness, with many expanding the test and applying it in situations far removed from its original intent). The difficulty of distinguishing between transformative and derivative works has led some scholars to consider whether courts should avoid fair use altogether and rest their decisions on simpler grounds. See Edward Lee, *Fair Use Avoidance in Music Cases*, 59 B.C. L. REV. 1873, 1923 (2018) (“Another advantage of fair use avoidance in music cases is avoiding the difficult doctrinal question about transformative works versus derivative works . . .”).

<sup>27</sup> See Liu, *supra* note 26, at 163 (noting that the transformative use doctrine has been applied in ninety percent of all cases involving fair use since its introduction).

<sup>28</sup> See *id.* (noting that courts find transformative uses to be fair uses in ninety-four percent of applicable cases).

<sup>29</sup> See Jacey Norris, *Art or Artifice: The Second Circuit’s Misapplication of the Fair Use Factors in Cariou v. Prince in Light of Kienitz v. Sconnie Nation*, 25 DEPAUL J. ART TECH. & INTELL. PROP. L. 429, 429–30 (2015) (explaining that an undisciplined transformativeness standard makes it difficult for litigants to assess the odds of trial success and jeopardizes artists’ rights).

<sup>30</sup> See *id.* (citing *Kienitz*, 766 F.3d at 758) (describing how the Second Circuit’s increased reliance on transformativeness in the context of appropriation art may support artistic expression but it does so at the expense of copyright owners’ rights, which the Seventh Circuit has criticized). The largest portion of copyright cases are filed in New York and California, where copyright-intensive industries like art museums, film and music studios, and production companies tend to operate. See *Just the Facts: Intellectual Property Cases—Patent, Copyright, and Trademark*, U.S. CTS. (Feb. 13, 2020), <https://www.uscourts.gov/news/2020/02/13/just-facts-intellectual-property-cases-patent-copyright-and-trademark> [<https://perma.cc/NZ3M-47GM>] (highlighting that California (22%) and New York (15%) account for the largest percentages of copyright filings in the United States). Because New York is a global art hub, many art-related claims are filed there and then appealed to the Second Circuit. See *U.S. Copyright Office Fair Use Index*, U.S. COPYRIGHT OFF., <https://www.copyright.gov/fair-use/index.html> [<https://perma.cc/X4XS-RG7F>] (select “Search Index”; then select “Painting/Drawing/Graphic”) (Feb. 2023) (showing that thirteen of thirty-one federal copyright cases involving a “Painting/Drawing/Graphic” were filed within the Second Circuit; nine of those cases turned on fair use and thus transformativeness); *Art Capitals of the World*, VISTAJET (Oct. 3, 2022), <https://www.vistajet.com/en-us/stories/art-capitals-of-the-world/> [<https://perma.cc/WC4V-B6LN>] (citing New York as the number one art capital of the world with 546 art galleries and ninety-six art museums, more than any other city); *Top 10 Cases on Appropriation Art and the Law*, FORDHAM NEWS (Feb. 25, 2014), <https://news.fordham.edu/arts-and-culture/top-10-cases-on-appropriation-art-and-the-law-2/> [<https://>

*Goldsmith*, the latest copyright infringement case involving appropriation art to appear before the Second Circuit.<sup>31</sup>

### *B. Factual and Procedural Background of Goldsmith*

Lynn Goldsmith has made a living photographing celebrities since the 1960s.<sup>32</sup> On December 3, 1981, Goldsmith took twenty-three photos of rock-and-roll hall of famer Prince during a photoshoot for *Newsweek* magazine.<sup>33</sup> She licensed one of those photos to *Vanity Fair* in 1984, allowing the magazine to publish an illustration derived from it.<sup>34</sup> Unbeknownst to Goldsmith, *Vanity Fair* then commissioned Andy Warhol, a world-renowned artist known for appropriations, to create an illustration that ran in its November 1984 issue.<sup>35</sup> Of

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perma.cc/FR7Q-JS7B] (citing seven cases filed within the Second Circuit as among the ten most important cases involving appropriation art). Appropriation art is the “intentional borrowing, copying, and alteration of preexisting images, objects, and ideas.” *Appropriation*, MoMA, <https://www.moma.org/collection/terms/appropriation> [<https://perma.cc/YPK5-MC2B>]. By copying without permission, appropriation art infringes copyright by its very nature. Niels Schaumann, *Fair Use and Appropriation Art*, CYBARIS, Spring 2015, at 112, 120. So, if sued for infringement, appropriation artists generally must prove fair use and thus transformativeness to avoid liability. *See id.* at 123–24 (explaining that most infringement suits involving appropriation art turn on fair use, pitting exclusive rights and creative advancement against one another). The reason that appropriation art is so controversial in the context of transformativeness is because, aesthetically, the works are rarely transformed. Azmina Jasani & Emelyne Peticca, *The Tension Between Copyright Law and Appropriation Art: Where Is the Line Between Artistic Innovation and Stealing?*, ART NEWSPAPER (Sept. 29, 2021), <https://www.theartnewspaper.com/2021/09/29/the-tension-between-copyright-law-and-appropriation-art-where-is-the-line-between-artistic-innovation-and-stealing> [<https://perma.cc/M8XA-HE58>] (highlighting that appropriation artists add minimal or even no changes to an original piece, generating a decades-long legal debate over the status of their outputs). Where aesthetics go largely unchanged, as with appropriation art, transformativeness must turn, if at all, on intangible factors such as subjective intent or hidden meaning while limiting (or not) a bias that favors works produced by famous artists over unknown ones. *See id.* (“[D]rawing a line between permissible use and copying is hardly straightforward not least because this is an ever-evolving area of the law that is often guided by cultural norms, market forces and the subjective beliefs of judges, and where applicable, juries.”).

<sup>31</sup> *See* Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 34–35, 42 (2d Cir. 2021) (describing the challenged artwork and raising the bar for transformative fair use), *cert. granted*, 142 S. Ct. 1412 (mem.) (2022).

<sup>32</sup> *Id.* at 33. Goldsmith established the first photo agency (named “LGL”) specializing in celebrity photography and her photos have been widely featured on album covers. *Id.*

<sup>33</sup> *Id.* Prince was a world-famous musician and repeat Grammy winner. Jon Pareles, *Prince, an Artist Who Defied Genre, Is Dead at 57*, N.Y. TIMES (Apr. 21, 2016), <https://www.nytimes.com/2016/04/22/arts/music/prince-dead.html> [<https://perma.cc/Q6AA-849C>]. Prior to his death in 2016, he created a legacy through his mastery of vocals, multiple instruments, and ability to create hits within multiple genres. *Id.* Prince was a major influence on musicians of all varieties. *Id.*

<sup>34</sup> *Goldsmith*, 11 F.4th at 34.

<sup>35</sup> *Id.* Although Goldsmith and LGL were unaware that Warhol would be creating the illustration, *Vanity Fair* credited Goldsmith for the source photograph. *Id.* Prince, in Warhol’s featured portrait, appears against a red backdrop, his face purple with various features accentuated by red lining, an ode to his song *Purple Rain* and fitting for an article named *Purple Fame*. *See* Tristan Vox, *Purple Fame*, VANITY FAIR (Nov. 1984), <https://archive.vanityfair.com/article/1984/11/purple-fame> [<https://perma.cc/FM78-GGQJ>] (displaying Andy Warhol’s colorful adaptation of Goldsmith’s original photograph).

his own accord, Warhol appropriated the Goldsmith photograph and used it to create fifteen additional prints.<sup>36</sup>

The Andy Warhol Foundation for the Visual Arts, Inc. (AWF) obtained title to and copyright in the collection of sixteen works known as the *Prince Series* following Warhol's death in 1987.<sup>37</sup> After Prince died in 2016, *Vanity Fair* contacted the AWF about relicensing the Warhol print featured in the 1984 issue, intending to reuse it in a tribute memorializing Prince's life.<sup>38</sup> When *Vanity Fair* discovered that Warhol had created fifteen other renditions, it secured a license for a different print and placed it on the tribute's cover.<sup>39</sup> Upon realizing the full extent of the *Prince Series* after the magazine's release, Goldsmith notified the AWF of its alleged infringement and registered the original picture with the U.S. Copyright Office.<sup>40</sup>

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Andy Warhol played a pivotal role in the 1960s pop art movement by both parodying and reveling in what he perceived to be this country's obsession with materiality and fame. See Carl I. Belz, *Pop Art and the American Experience*, CHI. REV., No. 1, 1964, at 104, 110–11 (discussing the contributions of pop artists, including Warhol); *Pop Art*, MoMA, <https://www.moma.org/collection/terms/pop-art> [<https://perma.cc/9K9V-FX6Z>] (“Pop artists borrowed imagery from popular culture—from sources including television, comic books, and print advertising—often to challenge conventional values propagated by the mass media, from notions of femininity and domesticity to consumerism and patriotism.”). Warhol's most famous paintings are likely his depictions of Campbell's soup cans, but many of his other works have gained notoriety. See *Andy Warhol*, BIOGRAPHY, <https://www.biography.com/artist/andy-warhol> [<https://perma.cc/UM5W-AMK5>] (Mar. 11, 2022) (identifying Warhol's paintings, particularly the soup cans, as the primary driver behind the pop art movement). Warhol also found success with celebrity portraits—an Elvis painting sold for \$100 million. See *id.* (classifying *Eight Elvises* as one of the most valuable paintings ever). With a focus on the culture around him, Warhol made a habit of appropriating works from other artists and brands leading to at least three lawsuits by photographers for copyright infringement. See Kate Donohue, *Andy the Appropriator: The Copyright Battles You Won't Hear About at the Whitney's Warhol Exhibit*, COLUM. J.L. & ARTS (Aug. 2, 2019), <https://journals.library.columbia.edu/index.php/lawandarts/announcement/view/112> [<https://perma.cc/23Q6-WU37>] (explaining that Warhol settled with these photographers but committed to stop copying others' photographs). Interestingly, Warhol appropriated the Campbell's Soup logo; Campbell's, however, declined to pursue legal action because of the free advertising. See *id.* (citing two of Warhol's most famous works—the Campbell's soup cans and a series of prints depicting Marilyn Monroe—as examples of appropriation art).

<sup>36</sup> *Goldsmith*, 11 F.4th at 34. The sixteen individual prints that make up the Prince Series are all color variations of the same Prince headshot. See Nina Totenberg, *The Supreme Court Meets Andy Warhol, Prince and a Case That Could Threaten Creativity*, NPR (Oct. 12, 2022), <https://www.npr.org/2022/10/12/1127508725/prince-andy-warhol-supreme-court-copyright> [<https://perma.cc/6V22-BF3K>] (displaying Warhol's entire Prince Series next to Goldsmith's original photograph).

<sup>37</sup> *Goldsmith*, 11 F.4th at 35. Warhol died at the age of 58 and left almost his entire estate for the establishment of a foundation devoted to the “advancement of visual arts.” *HISTORY*, ANDY WARHOL FOUND. FOR THE VISUAL ARTS, <https://warholfoundation.org/about/history/> [<https://perma.cc/4H6B-XSDA>]. Per Warhol's wish, the AWF was created to fund novel artistic initiatives and safeguard his legacy. *Id.*

<sup>38</sup> *Goldsmith*, 11 F.4th at 35.

<sup>39</sup> *Id.* Notably, the AWF was the only entity credited for the cover image. *Id.*

<sup>40</sup> *Id.* The U.S. Copyright Office administers the national copyright system. *Overview*, U.S. COPYRIGHT OFF., <https://www.copyright.gov/about/> [<https://perma.cc/8V59-F82P>]. Its responsibilities

On April 7, 2017, the AWF brought action against Goldsmith seeking a declaratory judgment of non-infringement or fair use.<sup>41</sup> Goldsmith countersued, claiming infringement.<sup>42</sup> On July 1, 2019, the U.S. District Court for the Southern District of New York granted summary judgment for the AWF, finding the *Prince Series* works to be fair uses, because they transformed Prince from a seemingly insecure figure in Goldsmith's photograph to an idol.<sup>43</sup> Goldsmith appealed to the Second Circuit.<sup>44</sup>

## II. TRANSFORMATIVENESS: AN OBJECTIVE OR SUBJECTIVE INQUIRY?

Judicial disagreement over the proper scope of transformativeness has led to inconsistent judgments, making it difficult for artists to anticipate what uses are allowed and generating calls for reform.<sup>45</sup> Section A of this Part overviews the Supreme Court's instruction on how to weigh transformativeness.<sup>46</sup> Section B considers the U.S. Court of Appeals for the Ninth Circuit's application of transformativeness.<sup>47</sup> Finally, Section C traces the Second Circuit's application of transformativeness.<sup>48</sup>

### A. The Supreme Court's Transformativeness Instruction

In 1994, in *Campbell v. Acuff-Rose Music, Inc.*, the U.S. Supreme Court instructed that altering an original work with a "new expression, meaning, or message" is sufficient to render a secondary work transformative.<sup>49</sup> Where a

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include registering copyright claims, documenting claims, and advising Congress on copyright policies. *Id.*

<sup>41</sup> *Goldsmith*, 11 F.4th at 35.

<sup>42</sup> *Id.*

<sup>43</sup> See *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 382 F. Supp. 3d 312, 325–31 (S.D.N.Y. 2019) (finding that a holistic evaluation of the fair use factors necessitated a finding of non-infringement), *rev'd in part, vacated in part*, 11 F.4th 26 (2d Cir. 2021), *cert. granted*, 142 S. Ct. 1412 (mem.) (2022). In finding the *Prince Series* works transformative, the district court stressed that the work was distinctly a "Warhol" and highlighted aesthetic alterations like Warhol's splash of color and a softening of Prince's facial features from the Goldsmith photograph. See *id.* at 326 (explaining that Warhol's aesthetic alterations drained Prince of the humanity accentuated by Goldsmith's photograph and concluding that the works "add something new to the world of art and the public would be deprived of this contribution if the works could not be distributed").

<sup>44</sup> *Goldsmith*, 11 F.4th at 36.

<sup>45</sup> See generally Rachel Isabelle Butt, *Appropriation Art and Fair Use*, 25 OHIO ST. J. ON DISP. RESOL. 1055 (2010) (noting the varying outcomes in copyright infringement cases involving appropriation art and arguing that the lack of consistency hinders the useful arts).

<sup>46</sup> See *infra* notes 49–52 and accompanying text.

<sup>47</sup> See *infra* notes 53–57 and accompanying text.

<sup>48</sup> See *infra* notes 58–82 and accompanying text.

<sup>49</sup> See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994) (explaining that a transformative use "adds something new, with a further purpose or different character, altering the first [work] with new expression, meaning, or message"). In *Campbell*, an infringement suit involving a song parodying another song, the first question was whether the "parodic character may reasonably be

work is transformative, the purpose and character of the use weighs in favor of noninfringement and the remaining factors take on diminished importance.<sup>50</sup> Even so, the Supreme Court has instructed that the proper fair use inquiry requires courts to weigh all four statutory factors, meaning transformativeness is never supposed to be dispositive.<sup>51</sup> Because the inquiry is flexible and highly fact-dependent, however, the Supreme Court's guidance often gets lost in translation as fact patterns shift, fueling circuit confusion and splits.<sup>52</sup>

### B. The Ninth Circuit's Transformativeness Application

In applying *Campbell's* transformative use test, the Ninth Circuit and district courts within the Ninth Circuit have considered the secondary work's underlying meaning.<sup>53</sup> In 2013, in *Seltzer v. Green Day, Inc.*, the Ninth Circuit

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perceived." *Id.* at 572, 581–83. Crucially, this inquiry did not involve judging the worth—artistic or otherwise—of the secondary work. *See id.* (explaining that whether a parody is in “good taste or bad does not and should not matter to fair use”). Artistic merit is irrelevant, but courts *should* consider the extent of parody (or presumably any unique purpose) and the extent of copying. *See id.* at 582 n.16 (expounding that a secondary work with minimal parodying and excessive copying is more likely to supplant the copyrighted work than be transformative). Although *Campbell* was decided in the context of parodies, the Court's reasoning has broader application, as it makes clear excessive copying with insufficient novelty is probably not transformative. *See Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1202–03 (2021) (affirming the *Campbell* meaning-or-message test in the context of software and explaining that “transformative” describes a “copying use that adds something new and important”); Brian Sites, *Fair Use and the New Transformative*, 39 COLUM. J.L. & ARTS 513, 519 (2016) (describing how transformative uses, at their core, promote novelty in copyright without replacing original works, because they serve a different purpose and often a different market than the original work).

<sup>50</sup> *See 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.”).

<sup>51</sup> *See id.* at 578 (“[T]he four statutory factors [may not] be treated in isolation, one from another. All are to be explored, and the results weighed together . . . .” (first citing *Leval*, *supra* note 23, at 1110–11; and then citing William F. Patry & Shira Perlmutter, *Fair Use Misconstrued: Profit, Presumptions, and Parody*, 11 CARDOZO ARTS & ENT. L.J. 667, 685–87 (1993))); *Google*, 141 S. Ct. at 1197–98 (acknowledging that fair use is a flexible doctrine whose application depends on the context, adding that copyright's protection may be stronger where the original work serves an artistic or creative purpose rather than a utilitarian or non-creative purpose). Regardless, transformativeness is a critical, often dispositive, part of *any* fair use inquiry. Sites, *supra* note 49, at 519.

<sup>52</sup> *See Google*, 141 S. Ct. at 1197 (acknowledging the context-specific nature of fair use determinations and that copyright's protections are generally stronger where the output serves an “artistic rather than a utilitarian function”); *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 51 (2d Cir. 2021) (reasoning that the court's decision aligns with Supreme Court precedent because *Google* recognized that “determinations of fair use are highly contextual and fact specific, and are not easily reduced to rigid rules”), *cert. granted*, 142 S. Ct. 1412 (mem.) (2022).

<sup>53</sup> *See, e.g., Seltzer v. Green Day, Inc.*, 725 F.3d 1170, 1176–77 (9th Cir. 2013) (finding a secondary work transformative because it had a “meaning” distinct from the original copyrighted work: specifically, it had a religious meaning whereas the original work did not); *Morris v. Young*, 925 F. Supp. 2d 1078, 1086 (C.D. Cal. 2013) (concluding that an adaptation of an appropriated photograph was “not transformative because it lack[ed] any significant expression, meaning, or message that [was] unique vis à vis the works' original purpose” (citing *Campbell*, 510 U.S. at 579)); *Monge v. Maya Mags., Inc.*, 688 F.3d 1164, 1175–76 (9th Cir. 2012) (considering artistic purpose before find-

ruled that a band's use of an artist's illustration in a music video was a transformative fair use, in part because the music video had a religious *meaning* distinct from the original work.<sup>54</sup> The court explained that non-transformative or derivative uses usually leave the "expressive content or message" of the original work intact, whereas transformative uses provide a new expression or a distinct message.<sup>55</sup> This is true even where the secondary work does not aesthetically alter the original to any significant degree.<sup>56</sup> In essence, the Ninth Circuit's transformative use test looks to the subjective meaning or message of the secondary work as compared to the original.<sup>57</sup>

### C. The Second Circuit's Transformativeness Application

The Second Circuit, by contrast, discounts subjective meaning and instead focuses on aesthetics through the lens of a reasonable spectator.<sup>58</sup> In 2013, in *Cariou v. Prince*, the Second Circuit held that an artist's appropriation of black-and-white photographs was fair use because it transformed the photo-

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ing a secondary work non-transformative because it retained the intrinsic qualities of its source material).

<sup>54</sup> *Seltzer*, 725 F.3d at 1176–77 (factoring the original artist's testimony about the meaning and message of his work and finding that the secondary work altered that meaning such that it conveyed "new information, new aesthetics, new insights and understandings" in favor of transformativeness (quoting Leval, *supra* note 23, at 1111)). The original work, entitled *Scream Icon*, was an illustration of a screaming and misshapen face. *Id.* at 1173. The secondary work was a music video for "a song about the hypocrisy of religion" containing a modified version of the *Scream Icon*, which appeared with a spray-painted cross over its face, "black streaks running down" one cheek, and a new color scheme. *Id.* at 1174, 1177. With the adoption of religious iconography and themes, the secondary work conveyed a distinct message that made it transformative. *See id.* at 1177 (finding the secondary work's religious message to be distinct).

<sup>55</sup> *Id.* at 1177.

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

<sup>57</sup> *See id.* (considering the precise language of the law review article that the Supreme Court cited when it first introduced the transformative use test in *Campbell*); Leval, *supra* note 23, at 1111 (advancing that a fair use ought to depend on whether and to what extent the use is transformative—that is, uses the original work as building blocks in the "creation of new information, new aesthetics, new insights and understandings"). In determining whether the meaning of a secondary work is distinct from the original, the Ninth Circuit allows accused artists to testify to their creative purpose. *See Monge*, 688 F.3d at 1176 (recognizing a separate artistic purpose as an important consideration but one that does not necessarily *transform* a work by delivering a new aesthetic, meaning, or message). In 2020, in *Dr. Seuss Enterprises, L.P. v. ComicMix LLC*, the Ninth Circuit reaffirmed the *Seltzer* approach and held that a mash-up of *Star Trek* and a Dr. Seuss book was not a transformative fair use of the Dr. Seuss book. 983 F.3d 443, 453–55 (9th Cir. 2020), *cert. denied*, 141 S. Ct. 2803 (mem.) (2021). The infringing artist only overlaid the original work with *Star Trek* characters, thus altering the context but ultimately delivering the same meaning as the original work. *See id.* at 454 ("While [the accused work] may have altered *Star Trek* by sending Captain Kirk and his crew to a strange new world, [Dr. Seuss's world] remains intact.").

<sup>58</sup> *See Cariou v. Prince*, 714 F.3d 694, 707 (2d Cir. 2013) ("What is critical [in the transformative use inquiry] is how the work in question appears to the reasonable observer, not simply what an artist might say about a particular piece or body of work.").

graphs into a new and drastically different visual attraction.<sup>59</sup> The inquiry focused not on any meaning or message as stated by the artist or understood by the judge but rather on how the works may reasonably be perceived.<sup>60</sup> Because cosmetic changes are easy to conjure and even easier to perceive, critics of *Cariou* warned that placing undue weight on aesthetic judgments would lower the bar for fair use, thereby diminishing copyright owners' right to profit from derivative works.<sup>61</sup> The *Cariou* court tried to preempt this criticism by noting that superficial alterations do not automatically establish fair use.<sup>62</sup> Indeed, the court explained that secondary works with *only* aesthetic alterations tend to be non-transformative derivative works, precisely because they merely present the same material in a different form without adding "something new."<sup>63</sup> This holding set the stage for *Andy Warhol Foundation for Visual Arts, Inc. v. Goldsmith* by creating a question of what constitutes "something new," especially with regard to secondary works that recognizably derive from their source material and are created for the same general purpose, such as for art.<sup>64</sup>

The Southern District of New York applied the analysis from *Cariou* to the *Goldsmith* case, and held that the Prince Series was transformative as a matter of law because the works, by altering the visual effect and essential el-

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<sup>59</sup> See *id.* at 706–08 (finding the accused works transformative because they added something new in the form of a wholly different visual). The photographs transformed “serene and deliberately composed portraits and landscape photographs” into “crude and jarring works . . . that incorporate[d] color, feature[d] distorted human and other forms and settings, and measure[d] between ten and nearly a hundred times the size of the photographs.” *Id.* at 706.

<sup>60</sup> See *id.* at 706–07 (explaining that a work can be transformative if it can “reasonably be perceived” as such, even where an accused artist has no intention of transforming *per se*).

<sup>61</sup> See *TCA Television Corp. v. McCollum*, 839 F.3d 168, 181 (2d Cir. 2016) (“*Cariou* might be thought to represent the high-water mark of our court’s recognition of transformative works”); *Kienitz v. Sconnie Nation LLC*, 766 F.3d 756, 758 (7th Cir. 2014) (criticizing the Second Circuit’s reliance on transformativeness as a substitute for statutory factors); Sergio Muñoz Sarmiento & Lauren van Haften-Schick, *Cariou v. Prince: Toward a Theory of Aesthetic-Judicial Judgments*, 1 TEX. A&M L. REV. 941, 946–48 (2014) (framing the *Cariou* decision as undermining Supreme Court precedent and noting that the decision drew significant criticism for judging aesthetics rather than applying the law). There is a fine line between objectively judging extreme aesthetic alterations and judging artistic merit, and fair use considerations in the context of art often invite questions about which the court is engaging in. See *Bleistein v. Donaldson Lithographing Co.*, 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.”).

<sup>62</sup> See *Cariou*, 714 F.3d at 708 (noting that aesthetic changes do not necessarily give rise to fair use and explaining that a “secondary work may modify the original without being transformative”).

<sup>63</sup> See *id.* (explaining that derivative works, unlike transformative works, tend to alter *only* aesthetics without adding “something new”).

<sup>64</sup> See *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 38 (2d Cir. 2021) (speculating that the district court appeared to have read *Cariou* as having announced a bright-line rule that a secondary work is necessarily transformative if it has a “different character, a new expression, and employs new aesthetics” to create a novel advance (quoting *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 382 F. Supp. 3d 312, 325–26 (S.D.N.Y. 2019), *rev’d in part, vacated in part*, 11 F.4th 26 (2d Cir. 2021), *cert. granted*, 142 S. Ct. 1412 (mem.) (2022))).

ements of Goldsmith's photograph, could reasonably be perceived to have transformed Prince from a mere human to a demigod.<sup>65</sup> On appeal, the Second Circuit attributed this holding to an incorrect reading of *Cariou* and reiterated that a secondary work that alters the aesthetic of its source material is not transformative per se.<sup>66</sup>

From there, the Second Circuit established that a transformative use, unlike a derivative use, *objectively* embodies an inherently distinct artistic purpose that readily distinguishes itself from its source material.<sup>67</sup> First, the court declared that a transformativeness standard turning only on "something new" risks swallowing copyright owners' right to derivative works.<sup>68</sup> Because derivative works can add something new to their source material without becoming transformative, whether a use is derivative or transformative ultimately depends on its purpose and character relative to the copyrighted work.<sup>69</sup> But an inquiry into purpose is less revealing where the secondary work shares the same general objective as the original one—in this case, to function as art.<sup>70</sup>

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<sup>65</sup> See *Goldsmith*, 382 F. Supp. 3d at 325–26 (applying a broad interpretation of *Cariou*, and reasoning that where a secondary work has a "'different character, . . . a new expression, and employ[s] new aesthetics with creative and communicative results distinct' from the original, the secondary work is transformative as a matter of law" (alterations in original) (quoting *Cariou*, 714 F.3d at 707–08)).

<sup>66</sup> See *Goldsmith*, 11 F.4th at 38–39 (highlighting that the *Cariou* court could not confidently rule that five of the thirty works at issue were transformative despite the fact that some significantly altered the aesthetics of the original work).

<sup>67</sup> See *id.* at 42–43 (explaining that a transformative work must set itself apart from its source material by adopting a "different and new" artistic makeup, which requires more than overlaying a copyrighted work with a unique aesthetic flair such that the fundamental makeup of the original work remains recognizably intact).

<sup>68</sup> See *id.* at 39 (acknowledging that an overly permissive transformativeness standard risks subordinating derivative works and explaining that the court's previous characterization of derivative works as lacking "something new" is useful shorthand but cannot be interpreted too broadly); *Cariou*, 714 F.3d at 708 (characterizing derivative works as secondary works that merely present the same material in a new form without adding "something new").

<sup>69</sup> See *Goldsmith*, 11 F.4th at 39 (observing that the *Cariou* court's description of derivative works is likely to be applied too broadly, depriving copyright owners of their right to profit from derivative works). For example, a film adapted from a novel may add something new by significantly altering the aesthetic and message of the underlying novel, but nevertheless it is a derivative work. *Id.* at 39–40.

<sup>70</sup> See *id.* ("But purpose is perhaps a less useful metric where, as here, our task is to assess the transformative nature of works of visual art that, at least at a high level of generality, share the same overarching purpose (*i.e.*, to serve as works of visual art)."). The Second Circuit admitted that a survey of its prior cases involving appropriation art, cases where the works at issue serve the same general purpose, yielded "conflicting guidance." *Id.* at 40. In 1992, in *Rogers v. Koons*, the court denied a fair use defense to a defendant who appropriated a photograph to create a sculpture even though the artist claimed that he was commenting on society. See 960 F.2d 301, 309–11 (2d Cir. 1992) ("If an infringement of copyrightable expression could be justified as fair use solely on the basis of the infringer's claim to a higher or different artistic use . . . there would be no practicable boundary to the fair use defense."). But in 2006, in *Blanch v. Koons*, the court held a painting derived from a copyrighted photograph to be transformative after the same artist testified that he intended to use the image as "fodder for his commentary on the social and aesthetic consequences of mass media." See 467 F.3d

After reviewing its prior case law, the court concluded, “a [transformative] secondary work itself must reasonably be perceived as embodying a distinct artistic purpose, one that conveys a new meaning or message separate from its source material.”<sup>71</sup> In determining meaning or message, however, a court may *not* inquire into the subjective meaning or purpose behind a work.<sup>72</sup> Rather, a judge must ask whether the infringing use inherently supports an original creative objective and aesthetic, such that it readily distinguishes itself from its source material.<sup>73</sup> Thus, where a secondary work plainly originates from a copyrighted work, it must *objectively* include more than a stylistic alteration to be transformative.<sup>74</sup>

Having clarified the distinction between transformative and derivative works, the Second Circuit held that the district court erred in holding the *Prince Series* transformative on the *subjective* impression that Warhol transformed Prince into a transcendent figure.<sup>75</sup> The court then concluded that the *Prince Series* was non-transformative because it preserved the core features of

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244, 253 (2d Cir. 2006) (finding that the artist’s stated aim was not to rehash the source material but to use it in the formation of new visuals, ideas, and outputs). Finally, in *Cariou v. Prince*, the court found that a series of works were transformative as a matter of law despite the accused artist’s testimony that he had no interest in the original photographer’s intent and was not attempting to create anything different. 714 F.3d at 706–08.

<sup>71</sup> *Goldsmith*, 11 F.4th at 41. The court highlighted how earlier works that satisfied the standard are “distinct works of art that draw from numerous sources, rather than works that simply alter or recast a single work with a new aesthetic.” *Id.* Moreover, the court refused to credit any express artistic intent, presumably because it immunizes appropriation artists willing to testify to a “higher or different artistic use” from infringement. *See id.* (“A common thread running through these cases is that . . . the bare assertion of a ‘higher or different artistic use’ is insufficient to render a work transformative.” (citation omitted) (quoting *Rogers*, 960 F.2d at 310)).

<sup>72</sup> *See id.* (“[T]he district judge should not assume the role of art critic and seek to ascertain the intent behind or meaning of the works at issue.”).

<sup>73</sup> *See id.* at 42 (“[T]he judge must examine 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 [it] stands apart from the ‘raw material’ used to create it.” (quoting *Cariou*, 714 F.3d at 706)).

<sup>74</sup> *See id.* (“[T]he 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.”). In other words, a transformative use adds “something new” in the sense that it can “reasonably be perceived” as embodying a distinct artistic purpose (for example, comment or criticism), whereas derivative works tend to change only the original work’s “form” often by altering its style or objectively retaining its artistic purpose. *See Cariou*, 714 F.3d at 708 (explaining that a derivative work that presents the source material in a new form is not transformative because it does not add something new); *Authors Guild v. Google, Inc.*, 804 F.3d 202, 215–16 (2d Cir. 2015) (“The statutory definition suggests that derivative works generally involve transformations in the nature of *changes of form*.” (citing 17 U.S.C. § 101)).

<sup>75</sup> *See Goldsmith*, 11 F.4th at 41 (holding that “whether a work is transformative cannot turn merely on the stated or perceived intent of the artist or the meaning or impression that a critic—or for that matter, a judge—draws from the work” for risk of undercutting rights to derivative works).

Goldsmith's photograph without adding something new.<sup>76</sup> Indeed, the *Prince Series* recognizably derives from the Goldsmith photograph and can reasonably be perceived to have the same artistic purpose—that is, the *Prince Series* works merely alter the form of the Goldsmith photograph, making them closer to derivative than transformative works.<sup>77</sup> Although the *Prince Series* may carry significant artistic worth, the court held it non-transformative as a matter of law.<sup>78</sup>

Because the *Prince Series* was deemed non-transformative, the remaining statutory factors took on increased importance.<sup>79</sup> After considering each factor in turn, the court held that the weight of the evidence favored Goldsmith and that Warhol's *Prince Series* was not a fair use.<sup>80</sup> Further, the court rejected the AWF's argument that the decision was contrary to Supreme Court precedent, reasoning that fair use analysis is necessarily flexible and context-specific.<sup>81</sup> The Supreme Court granted certiorari to *Goldsmith* and heard arguments about

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<sup>76</sup> See *id.* at 43 (“Crucially, the Prince Series retains the essential elements of the Goldsmith Photograph without significantly adding to or altering those elements.”).

<sup>77</sup> See *id.* (reasoning that despite stylistic changes, the Goldsmith photograph remains wholly recognizable within the Prince Series and both works are directed to the same broad purpose of serving as works of art and the same narrow purpose of serving as portraits of the same person).

<sup>78</sup> See *id.* at 44 (explaining that it does not matter in the eyes of the law that the *Prince Series* is distinctly a Warhol or that it carries significant artistic merit). Although the *Prince Series* is distinctly a Warhol, it “retains the essential elements of its source material” and “the Goldsmith photograph remains the recognizable foundation upon which the Prince Series is built.” See *id.* at 43 (explaining that celebrity status is irrelevant to the fair use inquiry and even though the work is obviously a Warhol, it remains more of a Goldsmith).

<sup>79</sup> See *id.* at 45 (affording more weight to other factors after a non-transformative finding).

<sup>80</sup> See *id.* at 44–51 (finding that the “creative and unpublished” nature of Goldsmith’s photograph, the degree of Warhol’s unlicensed usage, and the ultimate effect on Goldsmith’s ability to license her photos all cut against fair use).

<sup>81</sup> *Id.* at 51 (reasoning that the aims of copyright law can sometimes be conflicting, and decisions are highly context-specific); *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1202–03 (2021) (affirming the meaning-or-message test used in *Campbell*). The AWF argued that barring a judge from interpreting the meaning or intent behind the works at issue directly contravenes the very thing that *Campbell* and *Google* require courts to evaluate: “meaning or message.” See Brief for Petitioner at 29–32, *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, No. 21-869 (U.S. filed Aug. 8, 2022) (“The central question is . . . whether the follow-on work communicates a different meaning or message.”). Crucially, the *Google* Court acknowledged that “copyright’s protection may be stronger where the copyrighted material . . . serves an artistic rather than a utilitarian function.” 141 S. Ct. at 1197; see also *Goldsmith*, 11 F.4th at 51–52 (distinguishing *Google* on the ground that it involved code serving a utilitarian purpose as opposed to art serving an aesthetic purpose). The degree of protection aside, a secondary work that duplicates a copyrighted work may still count as fair use if it is intended to comment on the original. See *Google*, 141 S. Ct. at 1203 (describing the different ways that a copying use can add something “new and important” to become transformative). The *Google* Court seemed to allude to Warhol’s *Campbell’s Soup Cans* as an example of a copying use that may still qualify as fair use. See *id.* (“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.’” (quoting 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.05(A)(1)(b) (Matthew Bender, rev. ed. 2021))).

the proper inquiry—specifically, whether a secondary work is transformative when it carries a different meaning or message than the original work, or whether a court is prohibited from analyzing the intent behind a secondary work where it clearly descends from an original copyrighted work.<sup>82</sup>

### III. THE SUPREME COURT SHOULD AFFIRM THE SECOND CIRCUIT’S NARROWING OF TRANSFORMATIVENESS

The Second Circuit’s decision in *Goldsmith* signaled a much-needed moderation of transformativeness and a return to the statutory factors.<sup>83</sup> Although the AWF argued that barring judges from assessing meaning or message undermines the Supreme Court’s instructions and practically outlaws appropriation art, the holding uplifted another class of artists—photographers—who are entitled to profit from their own creative efforts.<sup>84</sup> Prior to *Goldsmith*, the Second Circuit drew criticism for extending transformativeness to the point where it risked eliminating the copyright owner’s statutory right to derivative works.<sup>85</sup> If transformativeness turns on either an artist’s stated intent or a judge’s subjective impression of meaning or message, then any adaptation, no

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<sup>82</sup> SCOTUSBLOG, *supra* note 6. At oral arguments, the AWF argued that the *Prince Series* can reasonably be perceived to convey a meaning or message distinct from Goldsmith’s photograph, and that alone should be sufficient to find the *Prince Series* works transformative. Transcript of Oral Argument at 3, *Goldsmith*, No. 21-869 (U.S. argued Oct. 12, 2022). Goldsmith, on the other hand, argued that because fair use is an affirmative defense, the copier ought to explain their “purpose,” or need for copying, and simply imposing one’s unique artistic style on a copyrighted work is not a sufficient purpose to weigh in favor of the copier or vitiate the need for a license. *Id.* at 60–61. The Justices expressed concern about conflating “meaning and message” with “purpose and character” and the risk of transformative works swallowing derivative works. *See generally id.* (showing the Justices’ concern over the malleability of the AWF’s proposed test). Notably, both litigants used the economic effect factor to backstop their arguments. *See id.* at 5, 13, 77–78 (citing the economic effect factor as a critical portion of the fair use inquiry).

<sup>83</sup> *See* Jane C. Ginsburg, *US Second Circuit Court of Appeals Tames ‘Transformative’ Fair Use; Rejects ‘Celebrity-Plagiarist Privilege’; Clarifies Protectable Expression in Photographs*, 16 J. INTEL. PROP. L. & PRAC. 638, 645–46 (2021) (concluding that transformativeness had taken on dispositive weight in fair use jurisprudence at the expense of photographers and photojournalists).

<sup>84</sup> *See Goldsmith*, 11 F.4th at 52 (“The issue here does not pit novel forms of art against philistine censorship, but rather involves a conflict between artists each seeking to profit from his or her own creative efforts.”); Ginsburg, *supra* note 83, at 646 (“[T]he court’s exposition of protectable expression should reassure photographers, particularly photojournalists, whose art consists largely of knowing how and when to seize the moment.”).

<sup>85</sup> *See Kienitz v. Sconnie Nation LLC*, 766 F.3d 756, 758 (7th Cir. 2014) (criticizing the Second Circuit’s *Cariou v. Prince* decision as an over-reliance on transformativeness, reasoning “[t]o 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)” (citing 17 U.S.C. § 106(2))). The Seventh Circuit has refused to entertain the transformative use inquiry and has focused instead on the statutory factors while emphasizing market effect. *See id.* at 758 (disavowing transformativeness in fair use analysis because it is not an explicit statutory factor and because a transformative work seems to, by definition, conflate with a derivative work).

matter how slight, could be deemed transformative.<sup>86</sup> Beyond providing safe haven to any accused artist willing to testify to an eccentric purpose, a subjective standard propagates inequity in the arts and disincentivizes the creation of new source material.<sup>87</sup> Based on Congress's intent, the Supreme Court would be wise to affirm the Second Circuit.<sup>88</sup> To be sure, artists remain free to draw inspiration from others' works or use them as building blocks *with permission*.<sup>89</sup> But when one artist foregoes permission, at the expense of another, then neither celebrity status nor a distinct style should exempt their work from the rigors of the law—even Andy Warhol sometimes needs to ask for permission.<sup>90</sup>

Nevertheless, in the context of appropriation art, the Supreme Court should teach away from transformativeness as a touchstone.<sup>91</sup> Even the Second Circuit's objective formulation is confusing and will inevitably yield arbitrary results.<sup>92</sup> Even if a work is *objectively* transformative—that is, it can reasonably be perceived as embodying a distinct artistic purpose—it is still unclear how much weight to give that factor relative to others.<sup>93</sup>

Therefore, in the context of appropriation art, where a secondary work shares the same general purpose as its source material, courts should weigh the fair use factors with a focus not on transformativeness but instead on the fourth

<sup>86</sup> See *Goldsmith*, 11 F.4th at 39, 41 (reasoning that a subjective test could inflate the scope of fair use and eat away at a copyright owner's exclusive rights).

<sup>87</sup> Brief of *Amici Curiae* Inst. for Intell. Prop. & Soc. Just. & Intellectual-Property Professors in Support of Respondents at 4–19, *Goldsmith*, No. 21-869 (U.S. filed Aug. 15, 2022) (arguing to affirm the Second Circuit's decision in part because it protects the motive to create original material by preserving derivative works, but also because it advances egalitarian aims by uplifting historically underrepresented artists). A subjective standard favors artists who produce works that comport with the judiciary's preferences and disfavors artists who do not, which is potentially problematic because the judiciary is comprised of a narrow and arguably unrepresentative sample of the population. See *id.* at 19 (“The innately subjective nature of the evaluation of expressive works, and their transformativeness in particular, means the commercial prospects of marginalized artists are often subject to the cultural tastes and racial biases of gatekeepers, including judges.”).

<sup>88</sup> See Brief for Respondents at 39–40, *Goldsmith*, (No. 21-869) (U.S. filed Aug. 8, 2022) (“Had Congress wanted to adopt AWF’s test, Congress could have swapped ‘the purpose and character of the use’ for ‘meaning or message of the works’ and made that consideration dispositive.”).

<sup>89</sup> See *Goldsmith*, 11 F.4th at 44 (“[T]he question we must answer is simply whether the law permits Warhol to claim it as his own, and AWF to exploit it, without Goldsmith’s permission.”).

<sup>90</sup> See *id.* at 43 (explaining that it is irrelevant for purposes of fair use that the Prince Series works are distinctly Warhol’s work because “[e]ntertaining 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 labor of others”); Brief for Respondents, *supra* note 88, at 39–40 (arguing that a standard resting on “meaning or message,” as opposed to “purpose and character,” impermissibly expands the bounds of fair use and is “a recipe for appropriating creative works without consent or payment”).

<sup>91</sup> See *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1196–97 (2021) (explaining that fair use is fact-specific and “some factors may prove more important in some contexts than in others”).

<sup>92</sup> See *Norris*, *supra* note 29, at 456–57 (arguing that the transformative use test confuses litigants, and the malleable standard makes it difficult to predict outcomes in lawsuits).

<sup>93</sup> See *id.* at 465 (concluding that modern copyright law is rife with ambiguity and the Supreme Court needs to clarify how to apply and balance each of the factors).

factor—market effect on the copyrighted work.<sup>94</sup> This approach respects the express word of Congress and incorporates an economic slant that yields predictable outcomes while furthering the goals of copyright law.<sup>95</sup> The purpose of copyright law is to further the creative arts, yet the Second Circuit’s transformative use test arguably threatens an entire artistic genre—appropriation art.<sup>96</sup> By shifting the focus to whether a secondary work is a substitute for (prohibited) or a compliment to (allowed) an original work in the marketplace, artists and litigants alike can find solace.<sup>97</sup> As a preliminary matter, a secondary work must experience a sufficient level of commercial recognition to render the inquiry a viable one.<sup>98</sup> At that threshold, however, a truly transformative work is likely to complement its source material by directing attention to it without diminishing licensing profits in any meaningful way.<sup>99</sup> By contrast, a non-transformative use is likely to replace the first work, which discourages photographers and other vic-

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<sup>94</sup> See *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 566 (1985) (recognizing that the secondary work’s market effect is “undoubtedly the single most important element of fair use” (citing 3 MELVILLE B. NIMMER, NIMMER ON COPYRIGHT § 13.05(A) (Matthew Bender, rev. ed. 1984))); *Kienitz v. Sconnie Nation LLC*, 766 F.3d 756, 758–59 (7th Cir. 2014) (distilling the fair use inquiry to, quite simply, whether the challenged use is a compliment to the original work (valid) or a replacement for the original work (invalid)).

<sup>95</sup> See Norris, *supra* note 29, at 453–57 (describing that fair use is an affirmative defense so the burden is on the alleged infringer to demonstrate that they did not injure the original artist’s market); *Harper*, 471 U.S. at 566–67 (detailing that fair use should only apply when the copying does not “materially impair the marketability of the work which is copied” (quoting 1 NIMMER, *supra* note 94, § 1.10(D))).

<sup>96</sup> See Brief for Petitioner at 54–56, *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, No. 21-869 (U.S. filed June 10, 2022) (arguing that discounting “meaning or message” threatens to eliminate a whole genre of art, deters innovation, and prevents museums from exhibiting socially important works that benefit the public).

<sup>97</sup> See William M. Landes, *Copyright, Borrowed Images, and Appropriation Art: An Economic Approach*, 9 GEO. MASON L. REV. 1, 23–24 (2000) (explaining that appropriation art can be justified as fair use under economic principles if an appropriation artist only makes a small number of duplicates for non-commercial use, because the reduced transaction costs (from appropriating rather than licensing) outweigh the harm to derivative works). In comparison, where an appropriation artist commercializes a use based on a copyrighted work, the harm to derivative works and in turn the incentive to create new source material outweighs lower transaction costs (unfair use). *Id.*

<sup>98</sup> See *id.* at 18–19 (explaining that the level of achievement in commercial production is particularly relevant to the fair use inquiry). In a case similar to *Goldsmith*, a French photographer sued Andy Warhol for producing a number of silkscreen prints from a copyrighted photograph, and then placing those silkscreens on a large array of commercially available products. See generally *Dauman v. Andy Warhol Found. for the Visual Arts, Inc.*, No. 96 CIV. 9219, 1997 WL 337488 (S.D.N.Y. June 19, 1997) (detailing the plaintiff’s complaint, which alleged that Warhol appropriated his photograph of Jackie Kennedy and used it to create “16 Jackies” which sold at auction for \$418,000). The case ultimately settled, but a court might have rejected a fair use defense because the photographer lost significant profit from licensing and transaction costs were so minimal that a license could have been negotiated. Landes, *supra* note 97, at 19. But if Andy Warhol had failed to sell the work, fair use would have made sense because a secondary artist’s personal use (even if the artist is Andy Warhol) has little impact on a copyright owner’s income and thus their incentive to create new works. *Id.*

<sup>99</sup> See Landes, *supra* note 97, at 10–11 (concluding that paradigmatic transformative works, such as parodies, are unlikely to replace the primary art or diminish its licensing profits).

tims of appropriation from producing new material in the first place.<sup>100</sup> Under this approach, appropriation artists would be free to continue generating works without paying licensing fees, but in the event that a given work experiences a sufficient level of commercial success, a court should determine fair use in large part based on market effect, that is, dollars and cents—a more objective measure than pure transformativeness.<sup>101</sup> Not only would an objective approach allow cases to settle earlier, sparing starving artists from soul-crushing litigation, it would maximize creative outputs by protecting artists' incentive to create.<sup>102</sup>

### CONCLUSION

Since its inception, transformativeness has dominated fair use jurisprudence. Despite its significance, courts disagree on how to assess it and how to weigh it relative to other fair use factors. While the Ninth Circuit inquired into the secondary work's subjective meaning or message, the Second Circuit discounted subjective meaning and focused instead on aesthetics through the lens of a reasonable observer. In *Andy Warhol Foundation for Visual Arts, Inc. v. Goldsmith*, the Second Circuit held that in the context of appropriation art, a transformative fair use, unlike a derivative use, objectively contains a fundamentally different and new artistic purpose. In ascertaining purpose, the Second Circuit considered only how the secondary work may reasonably be viewed, barring an inquiry into the artist's subjective intent or the judge's subjective impression. Ultimately, a transformative work adds "something new" in the sense that it can "reasonably be perceived" to embody a "distinct artistic purpose." Derivative works, on the other hand, tend to alter only aesthetics while retaining the source material's creative objective.

The Second Circuit's decision was a welcome relief for photographers and future litigants alike as it provided a much-needed injection of objectivity into fair use jurisprudence. Still, the Supreme Court would be wise to teach away from transformativeness in the context of appropriation art. Instead, the Court should assert market effect as the preeminent factor, particularly in the context of appropriation art, where the works are directed to the same general purpose and the issue of bias is particularly acute.

JOHN THURSTON

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<sup>100</sup> See William M. Landes & Richard A. Posner, *An Economic Analysis of Copyright Law*, 18 J. LEGAL STUD. 325, 353–57 (1989) (reasoning that non-transformative derivative works are reproductive by their very nature and diminish the incentive to create source material). Because photographers make a living licensing their photographs for unexpected reasons, allowing artists to appropriate images without limit would drive licensing costs to nothing and push photographers out of business. Landes, *supra* note 97, at 18–19.

<sup>101</sup> See *id.* at 19, 24 (concluding that appropriation art and copyright law can coexist in part because fair use, when used correctly, promotes greater access at lower costs without trade-offs).

<sup>102</sup> See Norris, *supra* note 29, at 464–65 (noting the harm that unpredictability does to litigants).