

2014

Does *Cariou v. Prince* Represent the Apogee or Burn-Out of Transformativeness in Fair Use Jurisprudence? A Plea for a Neo- Traditional Approach

Kim J. Landsman
Golenbock Eiseman Assor Bell & Peskoe LLP

Follow this and additional works at: <https://ir.lawnet.fordham.edu/iplj>



Part of the [Intellectual Property Law Commons](#)

Recommended Citation

Kim J. Landsman, *Does Cariou v. Prince Represent the Apogee or Burn-Out of Transformativeness in Fair Use Jurisprudence? A Plea for a Neo-Traditional Approach*, 24 *Fordham Intell. Prop. Media & Ent. L.J.* 321 (2015).

Available at: <https://ir.lawnet.fordham.edu/iplj/vol24/iss2/1>

This Article is brought to you for free and open access by FLASH: The Fordham Law Archive of Scholarship and History. It has been accepted for inclusion in *Fordham Intellectual Property, Media and Entertainment Law Journal* by an authorized editor of FLASH: The Fordham Law Archive of Scholarship and History. For more information, please contact tmelnick@law.fordham.edu.

Does *Cariou v. Prince* Represent the Apogee or Burn-Out of Transformativeness in Fair Use Jurisprudence? A Plea for a Neo-Traditional Approach

Cover Page Footnote

Partner, Golenbock Eiseman Assor Bell & Peskoe LLP. A.B. Vassar College, M.A. Oxford University, J.D. Yale Law School. The views expressed in this article are, of course, those of the author alone rather than of the firm. The author gratefully acknowledges the assistance of Ana-Claudia Roderick of the firm in researching and writing the article.

Does *Cariou v. Prince* Represent the Apogee or Burn-Out of Transformativeness in Fair Use Jurisprudence? A Plea for a Neo-Traditional Approach

Kim J. Landsman*

INTRODUCTION	322
I. HOW TRANSFORMATIVENESS BECAME THE HEART AND SOUL OF FAIR USE.....	325
II. PRIOR APPROPRIATION ART CASES.....	330
A. <i>Rogers v. Koons</i>	330
B. <i>Blanch v. Koons</i>	334
III. <i>CARIOU V. PRINCE</i>	339
A. <i>Facts</i>	339
B. <i>The Appellate Decision</i>	341
C. <i>Implications for the Transformative Use Test</i>	346
IV. THE TRANSFORMATIVE USE TEST IN RIGHT OF PUBLICITY CASES	349
V. THE ASCENDANCY OF TRANSFORMATIVENESS AND THE TILT TOWARDS FAIR USE.....	351
A. <i>The Academic Analysis</i>	352
B. <i>Criticism in the Treatises</i>	355
VI. THE DOCTRINAL FAILURES	

* Partner, Golenbock Eiseman Assor Bell & Peskoe LLP. A.B. Vassar College, M.A. Oxford University, J.D. Yale Law School. The views expressed in this article are, of course, those of the author alone rather than of the firm. The author gratefully acknowledges the assistance of Ana-Claudia Roderick of the firm in researching and writing the article.

OF TRANSFORMATIVENESS	356
A. <i>The Dubious Distinction Between an Infringing Derivative Work and a Transformative Fair Use</i> ...	356
B. <i>The License Granted Parody to Override the Other Statutory Fair Use Factors Should Not Apply to the Broader Concept of Transformativeness</i>	361
VII. RETURNING TO A NEO-TRADITIONAL BALANCING APPROACH	365
A. <i>First Factor</i>	370
B. <i>Second Factor</i>	372
C. <i>Third Factor</i>	373
D. <i>Fourth Factor</i>	374
VIII. THE IMPLICATIONS OF THE NEO-TRADITIONAL APPROACH, WITH ONE MODERN TWIST	377

INTRODUCTION

In a much-cited Harvard Law Review article twenty-three years ago, Judge Pierre N. Leval criticized the state of fair use doctrine as lacking “a set of governing principles or values.”¹

Judges do not share a consensus on the meaning of fair use. Earlier decisions provide little basis for predicting later ones. Reversals and divided courts are commonplace. The opinions reflect widely differing notions of the meaning of fair use. Decisions are not governed by consistent principles, but seem rather to result from intuitive reactions to individual fact patterns.²

Judge Leval introduced “transformativeness,” a concept not explicitly mentioned in the Copyright Act, as a way to assess the first statutory fair use factor—“the purpose and character of the use.”³ Rather than examine, as the statute suggests, whether the use “is of a commercial nature or is for nonprofit educational

¹ Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1105 (1990).

² *Id.* at 1106–07.

³ 17 U.S.C. § 107(1) (2012).

purposes,” courts should assess, as the test was later adopted by the Supreme Court, “whether and to what extent the new [allegedly infringing] work is ‘transformative’” of the copied work.⁴ To be transformative, “[t]he use must be productive and must employ the quoted matter in a different manner or for a different purpose from the original.” If the new work does not “merely ‘supersede the objects’ of the original,” but instead “adds value to the original—if the quoted matter is used as raw material, transformed in the creation of new information, new aesthetics, new insights and understandings—this is the very type of activity that the fair use doctrine intends to protect for the enrichment of society.”⁵

Transformative use has, by steady accretion, come to dominate fair use case law, but has failed to provide the hoped-for consistent governing principles. It has, to the contrary, led courts to highly idiosyncratic results. Nowhere is this more apparent than in the way the Second Circuit—considered the leading copyright court—has handled the fair use issues of appropriation art.

Cariou v. Prince,⁶ the third appropriation art case decided by an appellate court (all in the Second Circuit), was eagerly anticipated by the art world for its potential impact on the future of appropriation art and the rights of photographers, and by copyright practitioners interested in the direction of the fair use doctrine. It should disappoint all those constituencies, though for different reasons. The plaintiff photographer lost as a matter of law on twenty-five of the thirty artworks.⁷ The decision to remand five works of art was consistent with Prince’s appellate argument for considering each work separately rather than the collection as a whole,⁸ but it may still cause considerable chagrin to the champions of appropriation art who argue that context alone transforms and therefore all thirty works were equally transformative and fair use.

⁴ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

⁵ Leval, *supra* note 1, at 1111.

⁶ 714 F.3d 694 (2d Cir. 2013), *cert. denied*, 134 S. Ct. 618 (2013). The opinion was published a little more than eleven months after it was argued.

⁷ *Id.* at 707.

⁸ *Id.* at 710–11.

Of greatest concern to those who practice or follow copyright law is the extent to which transformativeness has become virtually a one-factor test by over-powering factors that would otherwise weigh against fair use, the extent to which that concept has become a euphemism for aesthetic and other value judgments that judges claim to eschew, and the failure of the appellate decision to explain why some works were more transformative than others. *Cariou v. Prince* confirms what academics have long noted and practitioners recognized: that the ascendancy of transformative use analysis has coincided with and become a justification for a judicial tilt toward fair use, but has failed to bring greater clarity and predictability to fair use decisions and has instead become an empty buzz-word.

This Article will briefly summarize the ascendancy of transformativeness to provide a context for a review of the three appropriation art cases—two against Jeff Koons and one against Richard Prince. It will show the diverse and even inconsistent legal analyses the courts have used, that transformativeness is inadequate to explain the results, and, ultimately, that, as leading copyright academics have noted, transformativeness has decayed into a conclusory label that substitutes for, rather than enhances, thoughtful analysis.⁹ As such, it does not make prediction of legal outcomes any easier than the statutorily based multi-factor balancing test it is supposed to be a part of, but has in practice often dominated or replaced. I ultimately conclude that if transformative use is to retain any utility in the overall fair use analysis, it must return to a more modest role as part of the first fair use factor to be weighed in more traditional fashion with or against, without effectively swamping, the other factors.

Given the correlation—and likely causal relation—between the rise of transformativeness and an increase in favorable fair use determinations, returning to a more traditional fair use multi-factor balancing test would likely tilt decisions in a pro-copyright-owner direction. It would most likely not, however, be a sharp tilt

⁹ See 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.05[A][1] [b] (2012).

because of the trend favoring fair use in public and judicial attitudes.

Furthermore, the impact of that doctrinal shift would not be as large as it might have been in the past because it would be mitigated by the demise of the automatic remedy of injunctions in copyright infringement that was started by the Supreme Court seven years ago in the *eBay* case,¹⁰ which the Second Circuit flagged in its remand of five of the works at issue in *Cariou v. Prince*.¹¹ Without routine injunctions against copyright infringements, a judgment that something is not a fair use will not necessarily or likely mean that the secondary work will be suppressed, but will instead mean that the appropriator (intended as a neutral term, not a moral judgment) will have to pay for the reasonable value of what has been taken.¹²

I. HOW TRANSFORMATIVENESS BECAME THE HEART AND SOUL OF FAIR USE

Fair use in copyright began as a common law concept whose basic precepts were not codified into statute until the Copyright Act of 1976.¹³ It has since been considered primarily, if not exclusively, a matter of statute.¹⁴ Section 107 of the Copyright Act

¹⁰ *eBay, Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 391 (2006).

¹¹ *Cariou*, 714 F.3d at 712 n.5.

¹² This may have been what the Second Circuit was implicitly encouraging by clearing twenty-five works and remanding five in *Cariou v. Prince*. See *infra* text accompanying notes 241–42 and 280–81.

¹³ 17 U.S.C. § 107 (2012). For a succinct summary of the process and of Professor Nimmer’s attempt to “include only a spare recognition of the fair use defense” rather than the four-factor test that ultimately prevailed, see Richard Dannay, *Factorless Fair Use? Was Melville Nimmer Right?*, 60 J. COPYRIGHT SOC’Y U.S.A. 127, 128–32 (2013).

¹⁴ There is a First Amendment basis for fair use because it is a matter of protecting freedom of expression. The courts have held, however, that the statutory fair use test, together with other copyright doctrines, is adequate to protect First Amendment rights. See, e.g., *Eldred v. Ashcroft*, 537 U.S. 186, 219, 221 (2003) (The “traditional contours of copyright protection,” that is, the “idea/expression dichotomy” and the “fair use” defense, moreover, serve as “built-in First Amendment accommodations.” (citing *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 556, 560 (1985))); *Roy Export Co. v. CBS, Inc.*, 672 F.2d 1095, 1099 (2d Cir. 1982) (“No circuit that has considered the question . . . has ever held that the First Amendment provides a privilege in the copyright

of 1976 requires a court to consider four factors in determining whether use of a copyrighted work is fair and therefore not infringement:

- (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.¹⁵

The first factor initially turned, as the statute would indicate, on whether a use was for a commercial or nonprofit purpose. In a 1984 case on home video recording of television programs (the “*Sony*” case), the Supreme Court reasoned that “every commercial use of copyrighted material is presumptively an unfair exploitation of the monopoly privilege that belongs to the owner of the copyright.”¹⁶

Ten years later when dealing with a parody song recorded for profit in *Campbell v. Acuff-Rose Music, Inc.*,¹⁷ the Court effectively discarded that presumption in the guise of limiting *Sony* to its facts.¹⁸ It held that no such presumption could have been intended in the statute because “nearly all of the illustrative uses listed in the preamble paragraph of § 107, including news

field distinct from the accommodation embodied in the ‘fair use’ doctrine.”). Professor Netanel notes and criticizes this view. See Neil W. Netanel, *Locating Copyright Within the First Amendment Skein*, 54 STAN. L. REV. 1, 3 (2001) (“[C]ourts have almost never imposed First Amendment limitations on copyright, and most have summarily rejected copyright infringement free speech defenses. In almost every instance, courts have assumed that First Amendment values are fully and adequately protected by limitations on copyright owner rights within copyright doctrine itself.”).

¹⁵ 17 U.S.C. § 107 (2012).

¹⁶ *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 451 (1984).

¹⁷ 510 U.S. 569 (1994).

¹⁸ *Id.* at 584–85, 591.

reporting, comment, criticism, teaching, scholarship, and research . . . ‘are generally conducted for profit.’”¹⁹

The Court explained that *Sony*’s statement that commercial use was “presumptively” unfair had been meant to apply to that case’s specific context of wholesale duplication.²⁰ *Sony* involved potential vicarious liability of distributors of video tape recorders to “time-shift”—to record complete television shows and other material exhibited on television to view at some other time.²¹ As we will see, however, *Campbell*’s holding relevant to the specific issue of parody—the freedom to use large amounts of the original work that parody requires—was soon expanded beyond that limited context to all transformative uses.²²

There was even a time when the fourth factor was considered preeminent. In *Harper & Row v. Nation Enterprises*,²³ the Supreme Court pronounced the fourth factor “undoubtedly the single most important element of fair use. ‘Fair use, when properly applied, is limited to copying by others which does not materially impair the marketability of the work which is copied.’”²⁴ That too was rejected by, or reinterpreted in light of, the ascendancy of transformative use. *Campbell* held that a parody could destroy the marketability of its target, just as a bad review

¹⁹ *Id.* at 584 (quoting *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 592 (1985) (Brennan, J., dissenting)); see *NXIVM Corp. v. Ross Inst.*, 364 F.3d 471, 477–78 (2d Cir. 2004) (quoting *Campbell*, 510 U.S. at 584). The statement is a bit of an exaggeration, since most people would not consider “comment, criticism, teaching, [and] scholarship” to be activities conducted for profit. The distinction between doing something for which one is compensated (for example, scholarship and teaching) and doing it for profit may be subtle but nevertheless not difficult to understand. It may be true that, as the Court quoted from Samuel Johnson, “[n]o man but a blockhead ever wrote, except for money.” *Campbell*, 510 U.S. at 584 (quoting 3 JAMES BOSWELL, *THE LIFE OF SAMUEL JOHNSON*, 19 (G. Hill ed., 1934)). It is probably also true, however, that only a blockhead would be motivated to become a writer or scholar by the thought of being well compensated for it.

²⁰ *Id.* at 591 (“[W]hat Sony said simply makes common sense: when a commercial use amounts to mere duplication of the entirety of an original, it clearly ‘supersede[s] the objects.’” (quoting *Folsom v. Marsh*, 9 F. Cas. 342, 348 (C.C.D. Mass. 1841))).

²¹ *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 421 (1984).

²² See discussion *infra* Part VI.B.

²³ 471 U.S. 539 (1985).

²⁴ *Id.* at 566–67 (1985) (quoting 1 NIMMER, *supra* note 9, § 1.10[D]).

could attempt to do so, because “there is no [protectable] derivative market for criticism.”²⁵

Two years before *Campbell*, Judge Leval’s law review article argued for a different way to look at the first factor: whether the accused work was “transformative.”²⁶ Considering “‘the purpose and character of the use’ raises the question of justification. Does the use fulfill the objective of copyright law to stimulate creativity for public illumination?”²⁷ “[T]he answer to the question of justification,” he argued, “turns primarily on whether, and to what extent, the challenged use is transformative. The use must be productive and must employ the quoted matter in a different manner or for a different purpose from the original.”²⁸

The article and the Supreme Court’s approval of its advocacy of the transformativeness concept in analyzing parody several years later sent the law down a path different from the Supreme Court’s prior emphasis on commercial use as presumptively unfair.²⁹ Although both the article and the case link the concept, without directly attributing it, to *Folsom v. Marsh*,³⁰ an early American copyright opinion authored by Joseph Story (as Circuit Justice), neither the word “transformative” nor, I would argue, the concept, is used in that opinion.³¹

²⁵ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 591–92 (1994).

²⁶ Leval, *supra* note 1, at 1111.

²⁷ *Id.*

²⁸ *Id.*

²⁹ *Campbell*, 510 U.S. at 583–85, 590–92.

³⁰ 9 F. Cas. 342 (C.C.D. Mass. 1841).

³¹ In arguing “[t]he irrelevance of the morality of the secondary user’s conduct” to fair use, Judge Leval invokes the authority of *Folsom v. Marsh*: “There Justice Story emphasized not only the good faith and ‘meritorious labors’ of the defendants, but also the usefulness of their work. Finding no ‘bona fide abridgement’ (what I have described as a transformative use), Justice Story nonetheless concluded with ‘regret’ that good faith could not save the secondary work from being ‘deemed in law a piracy.’” Leval, *supra* note 1, at 1127. I would not equate usefulness with transformativeness. In *Campbell v. Acuff-Rose*, the Supreme Court contrasted a transformative use with one that, “in Justice Story’s words, . . . merely ‘supersede[s] the objects’ of the original creation.” *Campbell*, 510 U.S. at 579 (quoting *Folsom*, 9 F. Cas. at 348). There, Justice Story was discussing what ultimately became the fourth fair use factor and contrasting a summary or commentary on a work with producing a substitute for reading the work. See 17 U.S.C. § 107(4) (2012).

More importantly, several limitations that Judge Leval would have put on the power of transformativeness were lost in subsequent doctrinal development. Though he called the first factor “the soul of fair use,” Judge Leval considered it a necessary but not sufficient condition for finding fair use: “A finding of justification under this factor seems indispensable to a fair use defense.”³² Two years later in *Campbell v. Acuff-Rose*, the Supreme Court agreed with the first part of Judge Leval’s statement by holding that “transformative works . . . lie at the heart of the fair use doctrine’s guarantee of breathing space within the confines of copyright.”³³ Contrary to Judge Leval’s second statement, however, it held that transformativeness was *not necessary* to a fair use determination while hinting that it might be *sufficient*.³⁴

Although later decisions gave this factor power to diminish or completely override the significance of the other factors, Judge Leval did not believe that transformativeness led inexorably to a fair use determination: “The existence of any identifiable transformative objective does not, however, guarantee success in claiming fair use. The transformative justification must *overcome* factors favoring the copyright owner.”³⁵ Alluding to the third factor, he added that “the secondary user’s claim under the first factor is weakened to the extent that her takings exceed the asserted justification. The justification will likely be outweighed if the takings are excessive and other factors favor the copyright owner.”³⁶

The emphasis on transformativeness has certainly engendered creativity on the part of copyright lawyers, if not on the part of artists. Arguments that any given use is transformative have increasingly become strained, and the concept has come in some cases to simplistically overpower the other fair use factors rather than engage with them.

³² Leval, *supra* note 1, at 1116.

³³ *Campbell*, 510 U.S. at 579.

³⁴ *See id.* (emphasis added).

³⁵ Leval, *supra* note 1, at 1111 (emphasis added).

³⁶ *Id.* at 1112.

As will be shown in Part II below, the concept of transformative use came to dominate the way in which appropriation art was judged—a doctrinal trend criticized by academics and treatise writers, as noted in Part III below, and the subject of snarky remarks by practitioners. The increase in doctrinal power has corresponded with an increase in fair use determinations but also a decrease in explanatory power and coherence.

II. PRIOR APPROPRIATION ART CASES

A. *Rogers v. Koons*

Rogers v. Koons, decided in 1992, involved a sculptural adaptation of a folksy photograph of a couple holding their eight new German shepherd puppies.³⁷ Among its copyrightable elements were that Rogers “selected the light, the location, the bench on which the [human couple] are seated and the arrangement of the small dogs. He also made creative judgments concerning technical matters with his camera and the use of natural light.”³⁸

Koons bought a postcard of that photograph, tore the copyright notice off—considered to show bad faith—and sent it to a studio with instructions to his artisans to copy it faithfully in a sculpture of polychromed wood, albeit with specified colors and (apparently though not mentioned in the opinion) some daisies strategically added.³⁹ The Rogers photo and a photo of the Koons sculpture are shown on the next page:

³⁷ 960 F.2d 301, 303 (2d Cir. 1992).

³⁸ *Id.* at 304.

³⁹ *Id.* at 305.



As a transformation from photo to sculpture, the Koons work would obviously be an infringing derivative work if not considered fair use. The court noted that Koons “works in an art tradition dating back to the beginning of the twentieth century . . . [that] . . . defines its efforts as follows: when the artist finishes his work, the meaning of the original object has been extracted and an entirely new meaning set in its place.”⁴⁰ This would now be interpreted as a defense of the work’s transformative use of the prior material, albeit in a conceptual sense without necessarily any physical change. The changed context alone is transformative. Transformativeness was not, however, mentioned in the opinion.

The Court of Appeals’ discussion of the first fair use factor focused solely on, and Koons was sharply criticized for, his commercial purpose and artistic arrogance in copying the photo as closely as possible:

The copying was so deliberate as to suggest that defendants resolved so long as they were significant players in the art business, and the copies they produced bettered the price of the copied work by a thousand to one, their piracy of a less well-known artist’s work would escape being sullied by an accusation of plagiarism.⁴¹

⁴⁰ *Id.* at 304.

⁴¹ *Id.* at 303. The district and appellate courts expressed outrage at Koons’ disobedience of the lower court’s order to turn over his fourth and last copy of *String of Puppies* by spiriting it out of the country to a museum in Germany. *Id.* at 306, 313. Since

The opinion acknowledged that “String of Puppies” was “a satirical critique of our materialistic society,” but said “it is difficult to discern any parody of the photograph ‘Puppies’ itself.”⁴² That is a peculiar holding in at least three respects:

(1) The opinion at that point correctly distinguished parody from satire in the manner later done by the Supreme Court’s *Campbell* decision: parody comments on the specific work used, while satire uses “another’s copyrighted work to make a statement on some aspect of society at large.”⁴³ At other points, however, the opinion completely muddies that distinction and uses the two concepts interchangeably: “Parody or satire, as we understand it, is when one artist, for comic effect or social commentary, closely imitates the style of another artist and in so doing creates a new art work that makes ridiculous the style and expression of the original.”⁴⁴

(2) Having noted that the cases hold that “parody and satire are valued forms of criticism, encouraged because this sort of criticism itself fosters the creativity protected by the copyright law,” the court then again confused the two concepts and seemingly held that only parody is entitled to fair use protection. For the copied work to be the object of the parody or ridicule, the copyist must conjure it up, which requires and “entitles its creator under the fair use doctrine to more extensive use of the copied work than is ordinarily allowed.”⁴⁵

that would have been preparatory to its potential destruction, getting the work out of the country was a desperate attempt to save the remaining unsold copy. Impoundment and destruction of an infringement is explicitly authorized in the Copyright Act, 17 U.S.C. § 503, and a remedy that did not appear unusual in *Rogers v. Koons*. An indication of how times change is that this common remedy for common infringements seemed sufficiently shocking to the appellate court in *Cariou v. Prince*, at least as applied to artwork, that plaintiff’s counsel decided at oral argument not to defend the district court’s adoption of that remedy. *See Cariou v. Prince*, 714 F.3d at 704 n.4.

⁴² *Rogers v. Koons*, 960 F.2d 301, 310 (2d Cir. 1992).

⁴³ *Id.* “Parody needs to mimic an original to make its point, and so has some claim to use the creation of its victim’s (or collective victims’) imagination, whereas satire can stand on its own two feet and so requires justification for the very act of borrowing.” *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580–81 (1994).

⁴⁴ *Rogers*, 960 F.2d at 309–310.

⁴⁵ *Id.* at 310.

It is the rule in this Circuit that though the satire [actually parody] need not be only of the copied work and may, as appellants urge of “String of Puppies,” also be a parody [actually satire] of modern society, the copied work must be, at least in part, an object of the parody, otherwise there would be no need to conjure up the original work.⁴⁶

The problem is that the distinction is one of degree rather than dichotomy. Commenting on and ridiculing the prior work (that is, parody) requires greater use, conjuring more, of the prior work. Satire, however, also has to conjure an original work even without commenting on it. Satirical songs, for example, use a well-known melody with different, preferably funny but sometimes merely crude words. Satire needs to conjure less of the original, but still needs to conjure some of it.⁴⁷

(3) In considering the appropriation to be satire rather than parody, and therefore lacking justification for the copying, the Second Circuit panel was too dismissive of the extent to which Koons commented on Rogers’ specific photo and too ready to restrict his justification for using it to his “acting within an artistic tradition of commenting upon the commonplace.”⁴⁸ “String of Puppies” did seem, from the objective perspective later adopted by *Cariou v. Prince*, to comment on and ridicule Rogers’ work. The mere fact that the sculpture was part of something called the “Banality Show” says that the earnest folksiness of Rogers’ photo was an object of derision.⁴⁹ Moreover, the changes in the depiction of the humans in the sculpture—primarily the facial expressions and teeth—make them look far more like hicks than does the photograph.

The court noted that the copied work need not be the exclusive focus of comment or ridicule—it need only be “at least in part” the object.⁵⁰ Under that standard, Koons’ work should have been

⁴⁶ *Id.*

⁴⁷ *Campbell*, 510 U.S. at 580–81.

⁴⁸ *Rogers*, 960 F.2d at 310.

⁴⁹ *See id.* at 304.

⁵⁰ *Id.* (citing *MCA, Inc. v. Wilson*, 677 F.2d 180, 185 (2d Cir. 1981)).

considered both parody and satire, which, under subsequent doctrinal development, would deserve some respect and ability to copy Rogers' work under the first fair use factor.

Notwithstanding its confusion at some points of the difference between parody and satire, *Rogers v. Koons* ultimately showed great insight in teasing out why parody is justified in using more of the original than is satire. It noted that the function of the rule that the prior work be "at least in part" an object of the parody

is to insure that credit is given where credit is due. By requiring that the copied work be an object of the parody, we merely insist that the audience be aware that underlying the parody there is an original and separate expression, attributable to a different artist. This awareness may come from the fact that the copied work is publicly known or because its existence is in some manner acknowledged by the parodist in connection with the parody.⁵¹

That is, the parodied work must be well known for the parody to succeed.

What perhaps kept "String of Puppies" from being parody as the court conceived that concept is not that it did not ridicule Rogers' photograph but that the object of its ridicule was neither acknowledged nor well enough known to be recognized.⁵² This subtlety seems to have gotten lost in future cases.

Koons was sued on two other works in his Banality Show, and lost both cases in district court opinions that followed the Second Circuit's opinion in the *Rogers* case.⁵³

B. *Blanch v. Koons*

⁵¹ *Id.*

⁵² *Id.* ("By requiring that the copied work be an object of the parody, we merely insist that the audience be aware that underlying the parody there is an original and separate expression, attributable to a different artist. This awareness may come from the fact that the copied work is publicly known or because its existence is in some manner acknowledged by the parodist in connection with the parody.")

⁵³ See *Campbell v. Koons*, No. 91 Civ. 6055 (RO), 1993 WL 97381 (S.D.N.Y. Apr. 1, 1993); *United Feature Syndicate v. Koons*, 817 F. Supp. 370 (S.D.N.Y. 1993).

Sixteen years later, Koons was again sued for using a photographer's work in one of a group of seven paintings called "Easyfun-Ethereal."⁵⁴ The appropriated photograph below on the left was a fashion photo by Andrea Blanch entitled "Silk Sandals by Gucci" that had appeared in *Allure* magazine.⁵⁵ It shows a woman's feet in a man's lap in the first class section of an airplane and was intended to have an erotic content.⁵⁶ The painting on the right below, called "Niagara," "depicts four pairs of women's feet and lower legs dangling prominently over images of confections—a large chocolate fudge brownie topped with ice cream, a tray of donuts, and a tray of apple danish pastries—with a grassy field and Niagara Falls in the background."⁵⁷



Having learned the lesson from the prior case, his lawyers drafted an affidavit for Koons explaining the need to copy the extracted portion of Blanch's fashion photo the way he did, rather than to construct his own photograph of women's feet in sandals.⁵⁸ The court quoted approvingly his stated justification for using the specific Blanch photo:

⁵⁴ Blanch v. Koons, 467 F.3d 244, 247 (2d Cir. 2006).

⁵⁵ *Id.* at 247–48.

⁵⁶ *Id.* at 248.

⁵⁷ *Id.* at 247.

⁵⁸ *Id.* at 255.

Although the legs in the Allure Magazine photograph [“Silk Sandals”] might seem prosaic, I considered them to be necessary for inclusion in my painting rather than legs I might have photographed myself. The ubiquity of the photograph is central to my message. The photograph is typical of a certain style of mass communication. Images almost identical to them can be found in almost any glossy magazine, as well as in other media. To me, the legs depicted in the Allure photograph are a fact in the world, something that everyone experiences constantly; they are not anyone’s legs in particular. By using a fragment of the Allure photograph in my painting, I thus comment upon the culture and attitudes promoted and embodied in Allure Magazine. By using an existing image, I also ensure a certain authenticity or veracity that enhances my commentary—it is the difference between quoting and paraphrasing—and ensure that the viewer will understand what I am referring to.⁵⁹

To compare the appropriation of a photograph to quoting or paraphrasing in a written work is odd, because doing either in a written work would require citation. In stating that “images almost identical to” Blanch’s photo are ubiquitous, a point “central to [his] message,” and that the photograph was “a fact in the world,” Koons was attacking the creativity of the photograph which, was at least an attempt to lessen its protection against fair use under the second factor, and could be construed as challenging any copyright protection at all.⁶⁰ More importantly, his assertion of the importance of the fact that at least one of the photos was a real fashion magazine photo assumes without explanation that his audience would recognize those particular feet and shoes as coming from a fashion magazine. Recognition or citation, which

⁵⁹ *Id.*

⁶⁰ *Id.*

should be the essence of parody as per *Rogers v. Koons*, was again missing.⁶¹

Undoubtedly with the assistance of legal ghost-writing, Koons' affidavit invoked the talismanic language of transformative use: "I transformed the meaning of these legs (as they appeared in the photograph) into the overall message and meaning of my painting. I thus suggest how commercial images like these intersect in our consumer culture and simultaneously promote appetites, like sex, and confine other desires, like playfulness."⁶²

The case shows the remarkable extent to which the transformative use concept superseded the commercial/nonprofit dichotomy in determining which side the first factor favors. The district court opinion devoted almost 900 words of its consideration of the first factor to whether Koons' use of the Blanch photograph was transformative.⁶³ Its entire consideration of the commercial versus non-profit distinction was to state that "[b]oth works were created for commercial purposes" before the *non sequitur*: "The first factor favors defendants."⁶⁴

The Court of Appeals' decision was not so unbalanced, but its discussion of the first factor immediately delved into whether Koons' use of Blanch's photograph was transformative, which, echoing *Campbell*, it termed the "heart of the fair use inquiry."⁶⁵ It concluded after lengthy discussion that it was indeed transformative because Koons used "Blanch's image as fodder for his commentary on the social and aesthetic consequences of mass media."⁶⁶ In other words, it was satire rather than parody.⁶⁷

That Koons' use was commercial was cursorily acknowledged to be relevant, though "secondary" to transformativeness and ultimately insignificant.⁶⁸ It balanced Koons' and his gallery's

⁶¹ *Rogers v. Koons*, 960 F.2d 301, 310 (2d Cir. 1992).

⁶² *Blanch v. Koons*, 396 F. Supp. 2d 476, 481 (S.D.N.Y. 2005).

⁶³ *Id.* at 480–81.

⁶⁴ *Id.* at 481.

⁶⁵ *Blanch*, 467 F.3d at 251.

⁶⁶ *Id.* at 253.

⁶⁷ *Id.* at 254–55.

⁶⁸ *Id.* at 254.

economic gains not against other fair use factors but against a perceived public interest in the exhibition of art.⁶⁹ The most telling sentence is this: “Notwithstanding the fact that artists are sometimes paid and museums sometimes earn money, the public exhibition of art is widely and we think properly considered to ‘have value that benefits the broader public interest.’”⁷⁰

What explains the difference in results of the two *Koons* cases? Each of the two *Koons* cases dealt with only one work of art, so each decision was binary. The second case was a victory for Koons, and much of the theory of appropriation art was accepted in relation to the work at issue, but it was not what such artists and their defenders would have hoped for, which is an acceptance that when an artist appropriates an element of common culture, that very act transforms it into a new work sufficient by itself to be fair use even if little other than context is physically changed.

The most likely explanations for the difference between the two decisions are that:

(1) Koons and appropriation art in general had become more established in the art world and seemed less outrageous in the sixteen years between the two opinions.

(2) *Blanch v. Koons* was written by a Manhattan-based former first amendment lawyer (Judge Sacks) rather than the more personally conservative, upstate Judge Cardamone, who wrote *Rogers v. Koons*.

(3) There was a vast quantitative difference in the extent of the photograph that was used and the extent of its use in Koons’ artwork. In other words, the second case could have been decided primarily by a relatively standard application of the third statutory fair use factor.

(4) In the sixteen-year interval between the two cases, the Supreme Court in *Campbell* had downgraded the significance of commercial use in the first factor analysis in favor of an emphasis

⁶⁹ *Id.*

⁷⁰ *Id.* (quoting *Am. Geophysical Union v. Texaco, Inc.*, 60 F.3d 913, 922 (2d Cir. 1994)).

on transformative use championed in Judge Leval's law review article.⁷¹

(5) Correlated with (4) and potentially causally related, a substantial judicial tilt toward finding fair use.⁷²

All likely played a role, with the last three of greatest importance from the perspective of the doctrinal development of fair use extended in *Cariou v. Prince*.

III. CARIOU V. PRINCE

A. *Facts*

Patrick Cariou spent six years living among Rastafarians in Jamaica developing a trusting relationship that “allowed him to take a series of portraits and landscape photographs” that were published in 2000 in a book called “Yes Rasta.”⁷³ He described the photographs as “extreme classical photography and portraiture,” with a respectful attitude toward his subjects.⁷⁴ As the Court of Appeals for the Second Circuit noted, “the book enjoyed limited commercial success.”⁷⁵ The publisher printed 7,000 copies and sold 5,791 of them.⁷⁶

Four of those sales were to well-known appropriation artist, Richard Prince.⁷⁷ His work “has involved taking photographs and other images that others have produced and incorporating them into paintings and collages that he then presents, in a different context, as his own.”⁷⁸ Prince tore photographs from “Yes Rasta,”

⁷¹ See discussion *supra* text accompanying notes 17–34.

⁷² See, e.g., discussion of Professor Netanel's study *infra* text accompanying notes 149–67.

⁷³ *Cariou v. Prince*, 714 F.3d 694, 698–99 (2d Cir. 2013), *cert. denied*, 134 S. Ct. 618 (2013).

⁷⁴ *Id.* at 699.

⁷⁵ *Id.*

⁷⁶ *Id.*

⁷⁷ *Id.*

⁷⁸ *Id.*

altered them “significantly,” and made thirty works of art in a collage called “Canal Zone.”⁷⁹

The district court dealt with all thirty works as a whole,⁸⁰ though, as the appellate court noted, “[t]he portions of Yes Rasta photographs used, and the amount of each artwork that they constitute, vary significantly from piece to piece.”⁸¹ In some, “Cariou’s work is almost entirely obscured,” showing little more than the Rastafarian’s hair.⁸² In others, “Prince did little more than paint blue lozenges over the subject’s eyes and mouth, and paste a picture of a guitar over the subject’s body.”⁸³

Cariou sued Prince for direct copyright infringement and the art gallery that sold his works and the publisher of the Canal Zone book for vicarious or contributory infringement.⁸⁴ The two sides cross-moved for summary judgment, and Judge Batts of the Southern District of New York ruled for the plaintiff.⁸⁵ The district judge “imposed a requirement that to qualify for a fair use defense, a secondary use must ‘comment on, relate to the historical context of, or critically refer back to the original works.’”⁸⁶ Since Prince testified that he “do[es]n’t really have a message,” that he was not “trying to create anything with a new meaning or a new message,” and that he “do[es]n’t have any . . . interest in [Cariou’s] original intent,” the district court held that Prince’s “Canal Zone” was not transformative.⁸⁷ That conclusion, plus the facts that Prince made commercial use of a large portion of Cariou’s creative photography that harmed Cariou’s ability to get a gallery

⁷⁹ *Id.*

⁸⁰ *Cariou v. Prince*, 784 F. Supp. 2d 337, 346, 349–53, 355 (S.D.N.Y. 2011).

⁸¹ *Cariou*, 714 F.3d at 699–700.

⁸² *Id.* at 700.

⁸³ *Id.* at 701. One of the most helpful aspects of the opinion and one essential to future discussion of its determinations is that the Court of Appeals posted high-quality images of all 30 works in an Appendix available at <http://www.ca2.uscourts.gov/11-1197apx.htm>.

⁸⁴ Amended Complaint at ¶¶ 26–37, *Cariou v. Prince*, 784 F. Supp. 2d 337 (S.D.N.Y. 2011) (No. 108CV11327), 2009 WL 956547.

⁸⁵ *Cariou*, 784 F. Supp. 2d at 342–43.

⁸⁶ *Cariou*, 714 F.3d at 706 (quoting *Cariou*, 784 F. Supp. 2d at 348).

⁸⁷ *Id.* at 707.

to show his work, led to the conclusion that all thirty works of “Canal Zone” were not fair use.⁸⁸

B. The Appellate Decision

The Second Circuit held that the district court erred in making the definition of parody or satire—that the new work comment on the copied work or at least on popular culture—a requirement of transformative use:

The law imposes no requirement that a work comment on the original or its author in order to be considered transformative, and a secondary work may constitute a fair use even if it serves some purpose other than those identified in the preamble to the . . . [statutory section on fair use—i.e., (criticism, comment, news reporting, teaching, scholarship, and research)].⁸⁹

Perhaps hedging his bet on whether commentary was required, while staying consistent with the tenets of appropriation art by disavowing any specific intent in the works, Prince’s counsel explained on appeal the development process of the “Canal Zone” works as having:

[e]volved in part from a creative screenplay that Prince began writing in 2007 entitled *Eden Rock*, which is a fantastical account of survivors of a nuclear holocaust who create their own post-apocalyptic society in the Caribbean. Prince stated in an interview, “The rastas and the lesbians started starring in these pictures and were kind of like bands—there are, like, five people to a picture, and

⁸⁸ *Cariou*, 784 F. Supp. 2d at 351–54.

⁸⁹ *Cariou*, 714 F.3d at 706. Judge Batts noted that transformative use was not required for a use to be fair but stated that “all of the precedent this Court can identify” that dealt with use of “raw ingredients” to create a new work, as in appropriation art, “imposes a requirement that the new work in some way comment on, relate to the historical context of, or critically refer back to the original works.” *Cariou*, 784 F. Supp. 2d at 348. Her opinion acknowledged “some minimal transformative element intended in Prince’s use” but held that that factor weighed against fair use because it was “minimal at best” and varies inconsistently from work to work. *Id.* at 350.

every picture has a title to it. It sort of becomes an allegory.” By adding guitars depicting the Rastafarian’s as reggae musicians, Prince wanted to convey music as “the surviving, if not redeeming, fact of life in the post-apocalyptic world.”⁹⁰

Elsewhere, perhaps more candidly but still trying to fashion the explanation for using Cariou’s photographs that Prince himself declined to provide, the defendants’ appellate brief stated without reference to a “post-apocalyptic world” that:

Prince desecrates Cariou’s reverential portraits by defacing them, cutting them up, and splicing them together with erotic nudes, electric guitars and other detritus of our tawdry pop culture. The noble Rastafarian who occupied a pure, natural world, removed from contemporary culture is now debased, plunged into the degraded and commercialized space of sex, drugs and popular music that American culture stereotypically associates with Rastafarians.⁹¹

The commingling in most of “Canal Zone” of photographs of naked women with Rastafarians in varying stages of alteration was not explained in any greater detail.⁹²

The appellate opinion was not concerned by that. It held that what matters is not whether the artist tries “to explain and defend his use as transformative” or even cares about the issue, but instead “how the artworks may ‘reasonably be perceived.’”⁹³ Based on its

⁹⁰ Joint Brief and Special Appendix for Defendants-Appellants at 30, *Cariou v. Prince*, 784 F. Supp. 2d 337 (S.D.N.Y. 2011) (No. 11-1197), 2011 WL 5325288.

⁹¹ *Id.* at 5.

⁹² *See id.*

⁹³ *Cariou*, 714 F.3d at 707 (citing *Brownmark Films, L.L.C. v. Comedy Partners*, 682 F.2d 687 (7th Cir. 2012), which held that a South Park episode could be held to be a protectable parody of an internet video on a motion to dismiss purely by the court’s comparison of the two videos). The dissent claimed that *Brownmark* was an extreme case where parody was obvious and where, due to the odd procedural posture of “a motion to dismiss based on a non-pleaded fair use affirmative defense converted into a motion for summary judgment on appeal.” *Cariou*, 714 F.3d at 713 (Wallace, J., dissenting).

own examination as a “reasonable observer,” the appellate opinion held that all but five of Prince’s works were not just transformative, but sufficiently so to override the significance of factors that might otherwise have weighed against fair use.⁹⁴ Two of the three judges on the appellate panel, at least, found the following objectively determined transformation:

These twenty-five of Prince’s artworks manifest an entirely different aesthetic from Cariou’s photographs. Where Cariou’s serene and deliberately composed portraits and landscape photographs depict the natural beauty of Rastafarians and their surrounding environs, Prince’s crude and jarring works, on the other hand, are hectic and provocative. Cariou’s black-and-white photographs were printed in a 9 1/2” x 12” book. Prince has created collages on canvas that incorporate color, feature distorted human and other forms and settings, and measure between ten and nearly a hundred times the size of the photographs. Prince’s composition, presentation, scale, color palette, and media are fundamentally different and new compared to the photographs, as is the expressive nature of Prince’s work.⁹⁵

The opinion engaged in the requisite balancing of the four statutory factors, but its conclusion that the uses were transformative enough in twenty-five of the works inexorably led to the determination that all factors favoring the plaintiff did not matter as much and to the ultimate conclusion of fair use.⁹⁶ The essentially commercial nature of Prince’s artwork was dismissed as of little significance “due to the transformative nature of the work.”⁹⁷ So too was the fact “that Cariou’s work is creative and published.”⁹⁸ The district court’s determination “that Prince’s

⁹⁴ *Id.* at 707.

⁹⁵ *Id.* at 706.

⁹⁶ *See id.* at 708–11.

⁹⁷ *Id.* at 708.

⁹⁸ *Id.* at 710.

‘taking was substantially greater than necessary’” was rejected as mistaken.⁹⁹ The court cited parody cases for the principle that “[t]he secondary use ‘must be [permitted] to “conjure up” at least enough of the original’ to fulfill its transformative purpose,”¹⁰⁰ and then held that the large extent of copying actually “weighs heavily in Prince’s favor.”¹⁰¹

The fourth fair use factor—the effect of the use on the potential market for the original work—received more than the perfunctory analysis given factors two and three. The district court had credited an art dealer who considered but then decided “against putting on a Yes Rasta show because it had already been done at Gagosian” gallery due to her mistaken belief that “Cariou had collaborated with Prince on the Gagosian show.”¹⁰² The district court’s analysis was held to have misunderstood the nature of the inquiry, which “is not whether the secondary use suppresses or even destroys the market for the original work or its potential derivatives, but whether the secondary use usurps the market of the original work.”¹⁰³

The fourth factor was held to favor Prince because “Prince’s work appeals to an entirely different sort of collector than Cariou’s.”¹⁰⁴ There was “nothing in the record to suggest that Cariou would ever develop or license secondary uses of his work in the vein of Prince’s artworks” or “that Prince’s artworks had any impact on the marketing of the photographs.”¹⁰⁵ The Court of Appeals’ decision on that factor was marred by a certain whiff of snobbery when elaborating on the different “sort of collector” for Prince’s work:

⁹⁹ *Id.*

¹⁰⁰ *Id.* (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 588 (1994), which involved a parody of Roy Orbison’s *Oh Pretty Woman* song; and citing *Leibovitz v. Paramount Pictures Corp.*, 137 F.3d 109, 114 (2d Cir. 1998), which involved a parody of a *Vanity Fair* magazine cover photo of pregnant Demi Moore).

¹⁰¹ *Id.* at 710.

¹⁰² *Id.* at 709.

¹⁰³ *Id.* at 708 (emphasis in original) (quoting *Blanch v. Koons*, 467 F.3d 244, 258 (2d Cir. 2006), and citing *NXIVM Corp. v. Ross Inst.*, 364 F.3d 471, 481–82 (2d Cir. 2004)).

¹⁰⁴ *Id.* at 709.

¹⁰⁵ *Id.*

Certain of the *Canal Zone* artworks have sold for two million or more dollars. The invitation list for a dinner that Gagosian hosted in conjunction with the opening of the *Canal Zone* show included a number of the wealthy and famous such as the musicians Jay-Z and Beyonce Knowles, artists Damien Hirst and Jeff Koons, professional football player Tom Brady, model Gisele Bundchen, *Vanity Fair* editor Graydon Carter, *Vogue* editor Anna Wintour, authors Jonathan Franzen and Candace Bushnell, and actors Robert DeNiro, Angelina Jolie, and Brad Pitt . . . Cariou on the other hand has not actively marketed his work or sold work for significant sums, and nothing in the record suggests that anyone will not now purchase Cariou's work, or derivative non-transformative works (whether Cariou's own or licensed by him) as a result of the market space that Prince's work has taken up. This fair use factor therefore weighs in Prince's favor.¹⁰⁶

The passage above puts in stark relief just how far the Second Circuit has come from its first *Koons* opinion that berated the artistic arrogance of believing that creating expensive works for well-heeled buyers gave the artist a free pass to copy:

The copying was so deliberate as to suggest that defendants resolved so long as they were significant players in the art business, and the copies they produced bettered the price of the copied work by a thousand to one, their piracy of a less well-known artist's work would escape being sullied by an accusation of plagiarism.¹⁰⁷

Judge Wallace, sitting by designation from the Ninth Circuit, dissented.¹⁰⁸ Although he agreed with most of the majority's legal analysis and, specifically, that the fair use defense did not require

¹⁰⁶ *Id.*

¹⁰⁷ *Rogers v. Koons*, 960 F.2d 301, 303 (2d Cir. 1992).

¹⁰⁸ *See Cariou*, 714 F.3d at 712 (Wallace, J., dissenting).

the allegedly infringing work to comment on the original works, he would have remanded all thirty of Prince's paintings to the district court to apply the correct legal standard upon further factual development.¹⁰⁹

The dissent also disagreed with the majority's disregard of Prince's testimony as to his intent (or lack thereof) in using Cariou's work.¹¹⁰ Noting that he is "not an art critic or expert," Judge Wallace "fail[ed] to see how the majority in its appellate role can 'confidently' draw a distinction between the twenty-five works that it has identified as constituting fair use and the five works that do not readily lend themselves to a fair use determination."¹¹¹

C. *Implications for the Transformative Use Test*

The opinion's division of the Prince artworks into twenty-five that were fair use as a matter of law and five that were not and were therefore remanded will probably not make either side entirely happy.¹¹² Champions of appropriation art did not get the complete victory that their theory of art would dictate because five works they would consider transformative by context were remanded for further analysis, but the fair use analysis will not give the plaintiff much cause for optimism on the works remaining to be decided under the correct legal standard.¹¹³ Most importantly, however, as the dissent complained, the opinion does not provide much future guidance for distinguishing among the works that were at issue or in deciding future cases.¹¹⁴ The

¹⁰⁹ *Id.* at 712–13.

¹¹⁰ *Id.* at 713.

¹¹¹ *Id.*

¹¹² *See id.* at 712 (majority opinion).

¹¹³ *See id.*

¹¹⁴ *Id.* at 713 (Wallace, J., dissenting). The split decision clearing all but five works may have been a subtle attempt by the appellate court to encourage settlement and tilt that settlement toward a fairly low amount of compensation by remanding only five works. The case did indeed settle almost a year after the appellate decision. However laudable the encouragement of settlement may be, it is problematic, to say the least, to attempt that in an appellate opinion whose language and reasoning will set the law—at least in the Second Circuit but also beyond—and thereby influence future unrelated cases.

distinctions at the extremes—where little is recognizable of Cariou’s photographs or where little was changed—may be understandable, but it may be difficult to differentiate among the many works in the middle where much was changed but much also remains intact.¹¹⁵

Consider, for example, two of the works at issue: one entitled “Tales of Brave Ulysses,” which was determined to be fair use as a matter of law, and another called *Graduation*, which was remanded for determination. “Tales of Brave Ulysses” (on the left below) intersperses the same unaltered Cariou photograph of a Rastafarian four times between naked women. “Graduation” (on the right below) uses the same photograph, with Prince having done “little more than paint blue lozenges over the subject’s eyes and mouth, and paste a picture of a guitar over the subject’s body.”¹¹⁶



Or compare “Back to the Garden” on the left below, which held to be a sufficiently transformative fair use as a matter of law, with “Charlie Company” on the right, which was remanded for further factual development.¹¹⁷

¹¹⁵ See *id.* at 699–704, 706–08, 710–11 (majority opinion).

¹¹⁶ *Id.* at 701.

¹¹⁷ See *id.* at 702.



Why are the works on the left a more transformative use of Cariou's photographs than those on the right? When the five remanded are compared to the twenty-five held to be fair use, what seems to differentiate them is not the degree of transformiveness as the court defined it,¹¹⁸ but instead an almost quantitative comparison of the third fair use factor—"the amount and substantiality of the portion used in relation to the copyrighted work as a whole"¹¹⁹—with what has been added.¹²⁰ That is, it is a matter of looking at the proportion of the copyrighted work that was appropriated and the percentage of the secondary work that the appropriated works comprises.¹²¹ The same amount or more of Cariou's photography is used in the two works to the left above as is in the works on the right above, but his photography comprises

¹¹⁸ *Id.* at 706–08.

¹¹⁹ 17 U.S.C. § 107(1) (2012).

¹²⁰ *Cariou*, 714 F.3d at 710.

¹²¹ *See id.* at 710–11.

and a far greater proportion of the works on the right.¹²² That fairly quantitative approach explains more than does the conceptual discussion of transformativeness and would make fair use law marginally more predictable, but it is not a test that the Second Circuit, at least, was willing to acknowledge.

IV. THE TRANSFORMATIVE USE TEST IN RIGHT OF PUBLICITY CASES

It is interesting at this point to look at how transformative use has spilled into another intellectual property area, the right of publicity, which generally prevents the commercial appropriation of an individual's name or likeness.¹²³ As we will see, however, its adoption in the analysis of right of publicity has been accompanied by different, potentially significant limitations. Interpreting New Jersey's right of publicity, the Third Circuit recently endorsed what it referred to as the "Transformative Use Test,"¹²⁴ borrowed from copyright law by way of the California Supreme Court,¹²⁵ as a way "to balance the interest protected by the right of publicity against those interests preserved by the First Amendment."¹²⁶

In *Hart v. Elec. Arts, Inc.*, the plaintiff Ryan Hart was a Rutgers football star who sued over use of his likeness and biographical information in Electronic Arts' NCAA Football series of video games.¹²⁷ The Third Circuit used the Transformative Use

¹²² *See id.*

¹²³ *See* RESTATEMENT (SECOND) OF TORTS § 652(C) (1977).

¹²⁴ *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 153 (3d Cir. 2013).

¹²⁵ *Comedy III Prods. Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808, 811 (Cal. 2001) (holding that the sale of t-shirts and prints bearing a charcoal drawing of the Three Stooges violated their rights of publicity because there was no discernible "transformative or creative contribution" and "the marketability and economic value of [the work] derive[s] primarily from the fame of the celebrit[ies] depicted"). In *Winter v. DC Comics*, the California Supreme Court rejected a right of publicity case brought by the rock musicians Johnny and Edgar Winter against use of their likeness in two "villainous half-worm, half-human" creatures in a comic book because the drawings, to the extent they resembled the brothers, were "distorted for purposes of lampoon, parody, or caricature." *Winter v. DC Comics*, 69 P.3d 473, 479 (Cal. 2003).

¹²⁶ *Hart*, 717 F.3d at 163.

¹²⁷ *Id.* at 145–47.

Test to conclude that the built-in ability of the game user to make “minor alterations” to an avatar of the football player’s “unaltered likeness” that “is central to the core of the game experience” was not sufficiently transformative for First Amendment protection of artistic expression to prevail over the right of publicity.¹²⁸

In a significant departure from the appropriation art copyright cases, the many creative things added to the game did not change the analysis: “while we recognize the creative energies necessary for crafting the various elements of *NCAA Football* that are not tied directly to reality, we hold that they have no legal significance.”¹²⁹ “To hold otherwise” would mean that “[a]cts of blatant misappropriation would count for nothing so long as the larger work, on balance, contained highly creative elements in great abundance.”¹³⁰

Limiting transformative use to a transformation of the prior work itself and not counting what is added—as in the Third Circuit right of publicity case—has the potential to limit fair use. If that analysis had been used in *Cariou v. Prince*, then many of Prince’s “Canal Zone” works—certainly more than the five remanded—would not only not have been remanded but would have been held not transformative as a matter of law. As with *Hart v. Elec. Arts, Inc.*,¹³¹ Prince added much to the photos of Rastafarians, but in many works held to be fair use, he did not change the photos of the subjects,¹³² and in many more he did little more than add lozenges to their eyes and mouths and put guitars in their hands.¹³³ Where that is all he did, then the artwork would not be a protected Transformative Use under the test applied by the Third Circuit.

Another major point of differentiation of right of publicity from copyright cases is that courts have not imported other factors from copyright’s fair use analysis and therefore do not balance

¹²⁸ *Id.* at 168.

¹²⁹ *Id.* at 169.

¹³⁰ *Id.*

¹³¹ *Id.*

¹³² *Cariou v. Prince*, 714 F.3d 694, 707–08, 710–11 (2d Cir. 2013), *cert. denied*, 134 S. Ct. 618 (2013).

¹³³ *Id.* at 701.

transformativeness against specific factors; they instead directly balance a celebrity's right to commercialize his or her identity against a defendant's First Amendment right to artistic expression.¹³⁴ Given the way in which transformativeness has come to dominate fair use analysis in Copyright law and to render the other factors insignificant, the outcomes in right of publicity and in copyright cases might not be noticeably different or more predictable, but the right of publicity analysis of *Hart* at least provides greater conceptual clarity and frankness by dispensing with what has become mostly a charade in the copyright cases of considering other factors.

V. THE ASCENDANCY OF TRANSFORMATIVENESS AND THE TILT TOWARDS FAIR USE

As previously noted, the concept of transformative use began as a way to analyze the first statutory fair use factor: "the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes."¹³⁵ The presumptive unfairness of commercial uses had a short life in the Supreme Court, and a more nuanced concept than commercial versus nonprofit was needed.¹³⁶ The transformative use inquiry was intended to satisfy that need by asking the question thought to

¹³⁴ See *Hart*, 717 F.3d at 159 ("After briefly considering whether to import the 'fair use' analysis from copyright, the *Comedy III* court decided that only the first fair use factor, 'the purpose and character of the use,' was appropriate." (quoting *Comedy III Prods. Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808 (Cal. 2001))); *id.* at 163 ("the Transformative Use Test maintains a singular focus on whether the work sufficiently transforms the celebrity's identity or likeness").

¹³⁵ 17 U.S.C. § 107(1) (2012).

¹³⁶ See, e.g., Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978-2005*, 156 U. PA. L. REV. 549, 571-72 (2008) (citing the *Campbell* Court's rejection of the presumption raised in *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 449 (1984) that "[e]very commercial use of copyrighted material is presumptively unfair" while it explicitly demoted commerciality as one issue among others that a court may consider in its analysis of the "purpose and character" of a defendant's use." *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 583-84 (1994)). To illustrate the point, in the first appropriation art case to come to the Second Circuit involving Jeff Koons two years before *Campbell*, the word "transformative" does not appear. See generally *Rogers v. Koons*, 960 F.2d 301 (1992).

go to the heart of the constitutional objective of Copyright law “to promote the Progress of . . . useful Arts”¹³⁷: “whether the new work” does not “merely ‘supersede[s] the objects of the original creation’ . . . [but] instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message.”¹³⁸

Commentators have uniformly noted the increasing influence of the transformativeness inquiry on fair use analysis, but with somewhat different views on the extent of its dominance or worth. It would be fair to say, however, that there is a growing recognition among academics and practitioners that transformativeness is being used for more than it can handle.

A. *The Academic Analysis*

Several academics have engaged in extensive readings of every fair use case they could find in a given period and published their conclusions. The pioneer is Professor Beebe, who read all of the over-300 published federal opinions from 1978 to 2005 that made substantial use of the statutory four-factor fair use test.¹³⁹ He concluded from it “that much of our conventional wisdom about our fair use case law . . . is wrong.”¹⁴⁰ That “conventional wisdom,” he said, comes from the “anecdotal method”: “one essentially of connoisseurship . . . from a limited aristocracy of hand-picked opinions.”¹⁴¹

Professor Beebe’s conclusions about transformativeness from large-scale reading—as opposed to reviewing a small selection of influential opinions that he calls connoisseurship—were somewhat ambivalent. On the one hand, he concluded “that courts and commentators have exaggerated the influence of transformativeness doctrine on our fair use case law” because (a)

¹³⁷ *Campbell*, 510 U.S. at 575 (quoting U.S. CONST. art. I, § 8, cl. 8).

¹³⁸ *Id.* at 569 (quoting *Folsom v. Marsh*, 9 F. Cas. 342, 348 (C.C.D. Mass. 1841)).

¹³⁹ See Beebe, *supra* note 136, at 554.

¹⁴⁰ *Id.*

¹⁴¹ *Id.* at 553. This article could, of course, be characterized as using the “connoisseurship” method but it is used, I would argue, for precisely the purpose it suits, which is to critically analyze doctrinal development.

“41.2% of the district court opinions following *Campbell* failed even to the refer to the doctrine . . . ;” and (b) although only 18.6% of appellate cases “failed to invoke the concept,” citation of the doctrine began a downward trend in the early 1990s.¹⁴²

Notwithstanding those reasons, there was another, more important reason to believe that the influence of transformativeness had not been exaggerated and to recognize its dominance. Professor Beebe found that “in those opinions in which transformativeness did play a role, it exerted nearly dispositive force not simply on the outcome of factor one¹⁴³ [“the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes”]¹⁴⁴ but on the overall outcome of the fair use test.”¹⁴⁵

Professor Sag took a slightly different approach.¹⁴⁶ He examined over 280 fair use cases decided in district court opinions from 1978 through May 31, 2011, by comparing the outcomes with a coding of the facts.¹⁴⁷ His analysis “reinforce[d] the dominance of transformative use over other factors” in determining case outcomes.¹⁴⁸

Professor Netanel began chronologically where Professor Beebe left off and looked at 79 opinions from 68 fair use cases from 1996 through 2010.¹⁴⁹ He came to a number of interesting conclusions.

First, “the transformative use paradigm, as adopted in *Campbell*, overwhelmingly drives fair use analysis in the courts today.”¹⁵⁰ Decisions since 2005 “that unequivocally characterize the defendant’s use as transformative almost universally find fair

¹⁴² *Id.* at 604–05.

¹⁴³ *Id.* at 605.

¹⁴⁴ 17 U.S.C. § 107(1).

¹⁴⁵ Beebe, *supra* note 136, at 605.

¹⁴⁶ See Matthew Sag, *Predicting Fair Use*, 73 OHIO ST. L.J. 47 (2012).

¹⁴⁷ *Id.* at 52–53.

¹⁴⁸ *Id.* at 84.

¹⁴⁹ See Neil Weinstock Netanel, *Making Sense of Fair Use*, 15 LEWIS & CLARK L. REV. 715, 731 (2011).

¹⁵⁰ *Id.* at 734.

use.”¹⁵¹ The dominance is a relatively recent phenomenon, though the trend is not.¹⁵² Adoption of the transformativeness analysis “increased measurably during the period 2006-2010, even if it was already quite high previous to that period.”¹⁵³ “[Eighty-five percent] of district court opinions and 93.75%, or all but one, of appellate opinions” considered whether the challenged use was transformative.¹⁵⁴ Consistent with Professor Beebe’s prior study, “decisions that unequivocally characterize the defendant’s use as transformative almost universally find fair use.”¹⁵⁵

Equally important, a finding of transformativeness shifts the analysis of the other factors so as to render them insignificant.¹⁵⁶ There was, for example, “a sharp decline in the weight that courts say they are giving to whether a use is commercial.”¹⁵⁷ Transformativeness does not overwhelm factors three and four so much as it reinterprets them toward inevitably favoring fair use.¹⁵⁸ The factor three issue “becomes a question not of whether the defendant took what is the most valuable part of the plaintiff’s work,” which would be the traditional way of evaluating the factor, “but rather whether the defendant used more than what was reasonable in light of the expressive purpose driving the transformative use.”¹⁵⁹ As seen in *Cariou v. Prince*, that almost inevitably shifts the balance to fair use because it allows the potential infringer to define how much is reasonable to take.¹⁶⁰

It also radically reinterprets the market analysis that drives factor four. It is no longer “whether the use falls within a conceivable licensing market for the copyright owner.”¹⁶¹ It instead “effectively delimits the legally relevant market for the

¹⁵¹ *Id.* at 740.

¹⁵² *Id.* at 734.

¹⁵³ *Id.* at 736.

¹⁵⁴ *Id.*

¹⁵⁵ *Id.* at 740.

¹⁵⁶ *Id.* at 742.

¹⁵⁷ *Id.*

¹⁵⁸ *Id.* at 743–46.

¹⁵⁹ *Id.* at 745.

¹⁶⁰ See *Cariou v. Prince*, 714 F.3d 694, 708–11 (2d Cir. 2013), *cert. denied*, 134 S. Ct. 618 (2013).

¹⁶¹ Netanel, *supra* note 149, at 745.

fourth factor. If a use is unequivocally transformative, then, *by definition*, it causes no market harm since the copyright holder does not have a right to exclude others from the market for transformative uses.”¹⁶²

Professor Netanel found “a remarkable shift in favor of finding fair use in such cases at the district court level since 1995.”¹⁶³ The success rate of defendants claiming fair use went from 22.73% between 1995 and 2000, to 40.91% between 2001 and 2005, to 58.33% between 2006 and 2010.¹⁶⁴ In other words, there was a close correlation between the ascendancy of the transformativeness analysis and decisions favoring fair use.¹⁶⁵ The trend toward fair use and the close correlation of that trend with the ascendancy of transformativeness can be seen in another quantitative observation: a “sharp increase” over the time period from 1995 to 2010 in the percentages of cases where judges considered transformativeness, where they found such a use, where defendants won upon such a finding, and in overall wins by defendants.¹⁶⁶ Where there was also a causal connection could not be determined empirically but, as argued below, it is very likely.¹⁶⁷

Lastly, Professor Reese looked at all forty-one published appellate fair use opinions from the *Campbell* decision through 2007.¹⁶⁸ He noted that the transformation that mattered in fair use was in the purpose of the use rather than alterations to the content itself.¹⁶⁹ This, of course, renders the third factor powerless to counteract the conclusion of transformativeness.

B. Criticism in the Treatises

The Goldstein treatise notes that “[i]n the years since it was first announced [in *Campbell v. Acuff-Rose*] the transformative use

¹⁶² *Id.* at 744 (emphasis added).

¹⁶³ *Id.* at 752.

¹⁶⁴ *See id.*

¹⁶⁵ *See id.*

¹⁶⁶ *See id.* at 754–55.

¹⁶⁷ *See id.* at 751.

¹⁶⁸ *See* R. Anthony Reese, *Transformativeness and the Derivative Work Right*, 31 COLUM. J. L. & ARTS 101, 105 (2008).

¹⁶⁹ *See id.* at 119.

doctrine has come to dominate fair use jurisprudence. Not coincidentally—but not necessarily, either—the doctrine’s sweep has markedly tilted decision in favor of defendants.”¹⁷⁰ Professor Goldstein is critical of the doctrine’s tilt toward fair use as “ha[ving] little support in principle, and still less in precedent.” As to the former, he notes that it “threatens to undermine the balance that Congress struck in section 106(2)’s derivative rights provision to give copyright owners exclusive control over transformative works to the extent that these works borrow copyrightable expression from the copyrighted work.”¹⁷¹

Noting the dominance of transformative use analysis, the Nimmer treatise came to the bluntly critical conclusion that many applications of the concept are conclusory—they appear to label a use “not transformative” as a shorthand for “not fair,” and correlatively “transformative” for “fair.” Such a strategy empties the term of meaning—for the “transformative” moniker to guide, rather than follow, the fair use analysis, it must amount to more than a conclusory label. One should perform the transformative inquiry on its own merits, bearing in mind that just because a given use qualifies as “transformative” does not even mean that defendants prevail under the first factor, much less that they prevail altogether on the fair use defense.¹⁷²

The next section will explore these two principal doctrinal criticisms at greater length.

VI. THE DOCTRINAL FAILURES OF TRANSFORMATIVENESS

A. *The Dubious Distinction Between an Infringing Derivative Work and a Transformative Fair Use*

If creating a transformative work is considered socially and legally good, there is an inevitable conflict with the Copyright Act’s definition of an infringing derivative work as “a work based

¹⁷⁰ 2 PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHTS § 12.2.2 at 12:33 (3d ed. 2012 Supp.).

¹⁷¹ *Id.* at 12:34.1–12:35.

¹⁷² 4 NIMMER, *supra* note 9, § 13.05[A][1][b].

upon one or more preexisting works” that includes any “form in which a work may be recast, *transformed*, or adapted.”¹⁷³ “Transformative” is the adjective form of the verb “transform,” for which the first two (most used) definitions are “1. To change in form, appearance, or structure; metamorphose. 2. To change in condition, nature, or character; convert.”¹⁷⁴

Therein lies the problem the Goldstein treatise recognized: If transformative use is a positive element of factor one weighing in favor of fair use, it will sweep into fair use what Congress deemed infringing derivative works.

An amicus brief from the American Society of Media Photographers in *Cariou v. Prince* made that point.¹⁷⁵ It argued that the only way to reconcile the problem of the related definitions

¹⁷³ 17 U.S.C. § 101 (2012) (emphasis added).

¹⁷⁴ RANDOM HOUSE WEBSTER’S UNABRIDGED DICTIONARY 2420 (2 ed. 1997). *Cf.* MERRIAM-WEBSTER, THIRD INTERNATIONAL DICTIONARY 2427 (1986):

a: to change completely or essentially in composition or structure: METAMORPHOSE;
b: to change the outward form or appearance of: ALTER
c: to change in character or condition: convert

The Oxford American Dictionary defines transform as “make a thorough or dramatic change in the form, appearance, or character of.” *Transform Definition*, OXFORD AMERICAN DICTIONARY, http://www.oxforddictionaries.com/us/definition/american_english/transform (last visited Nov. 20, 2013). If so, then it is somewhat tautological to speak of degrees or extent of transformativeness, since any transformation is “thorough or dramatic.” Trademark and statutory interpretation cases are two examples of disputes that often involve arguments over the meaning of words and the extent to which dictionaries are definitive. They inevitably delve into theories of language and lexicography and debates over whether words have core meanings or, to paraphrase Humpty Dumpty, mean what people mean when they use the words. Adam Liptak of The New York Times has provided a useful commentary on the ongoing debate concerning the Supreme Court’s use of dictionaries, juxtaposing legendary justices who did not rely on dictionaries with today’s justices, whose collection of over 120 dictionaries seem to suggest “cherry picking.” See Adam Liptak, *Justices Turning More Frequently to Dictionary, and Not Just for Big Words*, N.Y. TIMES (June 3, 2011), <http://www.nytimes.com/2011/06/14/us/14bar.html?r=0>. I prefer to avoid that debate and simply to make the point that the difference between the verb transform and the adjective transformative is, if such exists, one created by copyright lawyers, not by general usage.

¹⁷⁵ Brief of Amici Curiae American Society of Media Photographers, Inc. and Picture Archive Council of America, Inc. in Support of Plaintiff-Appellee and Affirmance, *Cariou v. Prince*, 714 F.3d 694 (2d Cir. 2013) (No. 11-1197-cv), 2012 WL 435238 at *11–12. See also 17 U.S.C. § 107 (2012).

of “transforms” and “transformative” is for courts to interpret the latter in light of, and therefore arguably restricted by, the preamble examples of fair use in § 107; “guidance as to what sort of purposes will suffice to differentiate between a fair use and an infringing derivative work,” the brief argued, “may be found in the list of illustrative examples set forth in [s]ection 107, which includes “criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research.”¹⁷⁶ All have in common a “necessary and deliberate relation back to, and dependence on, pre-existing copyrightable works.”¹⁷⁷

That was a plausible way to justify the district court’s holding that the second work must comment on the first to be a transformative use, and not just parody, while prudently paying the necessary obeisance to transformative use analysis.¹⁷⁸ But it was rejected by the Second Circuit.¹⁷⁹ Moreover, the Supreme Court has already held that the preamble uses are just examples and not meant to limit fair use.¹⁸⁰ Some other way to differentiate a derivative work from a fair use must therefore be found.

As seen in the discussion above, what the Second Circuit seemed to mean by transformiveness in *Blanch v. Koons* and *Cariou v. Prince* was not so much that the prior work was changed—Blanch’s photograph and most of Cariou’s photographs were redacted, albeit to greatly varying extents—as that something else was added: some new artistic or other expressive use protected by the First Amendment.¹⁸¹

Elsewhere, the Second Circuit has interpreted transformiveness in terms of the purpose of the allegedly infringing work rather than on transformation of the work itself.¹⁸² In *Castle Rock Entertainment v. Carol Publishing*, which held that

¹⁷⁶ *Id.*

¹⁷⁷ *Id.* at *12.

¹⁷⁸ *Cariou v. Prince*, 784 F. Supp. 2d 337, 347–50 (S.D.N.Y. 2011).

¹⁷⁹ *Cariou v. Prince*, 714 F.3d 694, 668–69 (2d Cir. 2013), *cert. denied*, 134 S. Ct. 618 (2013).

¹⁸⁰ *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 561 (1985).

¹⁸¹ *See Cariou*, 714 F.3d at 708; *Blanch v. Koons*, 467 F.3d 244, 253 (2d Cir. 2006).

¹⁸² *See Castle Rock Entm’t, Inc. v. Carol Publ’g Grp., Inc.*, 150 F.3d 132 (2d Cir. 1998).

a trivia book on *Seinfeld* episodes was not fair use, the court noted the “potential source of confusion in our copyright jurisprudence over the use of the term ‘transformative,’”¹⁸³ that Professor Goldstein criticized¹⁸⁴ and purported to resolve that confusion by emphasizing the purpose of the use rather than the content. To that extent, *Cariou v. Prince* could be seen as reintroducing the confusion, because there was no discernible difference (and certainly none explained) between the works remanded and those cleared as fair use.

Hart v. Elec. Arts, Inc. applied transformativeness differently in the context of right of publicity.¹⁸⁵ It imposed a crucial and very useful limit on what could be called transformative that has been absent in the appropriation art cases and can return the concept to a more modest and appropriate role as an element of balancing factors: The original work itself had to be artistically changed; adding artistic elements around it was not transformative.¹⁸⁶ Thus, Electronic Arts could not justify taking Ryan Hart’s identity by making him one discreet part of a complex, creative video game.¹⁸⁷ To give “legal significance” to the surrounding creative elements would mean that “[a]cts of blatant misappropriation would count for nothing so long as the larger work, on balance, contained highly creative elements in great abundance.”¹⁸⁸ That limitation would have led to a very different result in the Second Circuit’s last two appropriation art cases.

What also sabotages the attempt to differentiate “transforms” in the derivative work sense from a transformative fair use is that there can be much creativity in types of works that have long been considered and will presumably remain characterized as derivative works.¹⁸⁹ Creative transformation therefore cannot be what makes use of a prior work legally fair.¹⁹⁰

¹⁸³ *Id.* at 143.

¹⁸⁴ *See supra* text accompanying notes 170–71.

¹⁸⁵ *See Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 159–69 (3d Cir. 2013).

¹⁸⁶ *See id.* at 168–70.

¹⁸⁷ *See id.* at 169.

¹⁸⁸ *Id.*

¹⁸⁹ The Supreme Court has noted that “the fair use doctrine was predicated on the author’s implied consent to ‘reasonable and customary’ use when he released his work

Translation of a literary work is a prime example of use of a work that requires great creativity and is highly transformative, yet is squarely derivative.¹⁹¹ Literary translation is, at its best, a retelling of a story in a different language that requires a rare combination of skill and creativity to communicate meanings not only across languages but also across cultures.¹⁹² It does not supplant the market for the original because all but a few of those who buy and read translations are unable or unwilling to read the works in their original language.

More importantly, translations employ highly creative and idiosyncratic uses of language. A glimpse at the radical differences in language, interpretation, and meaning that different translations convey can be seen in comparative reviews of works major enough to have more than one translation. A recent article on two recent translations of Dante's *Inferno*, adding to the hundreds already done, can serve as an example.¹⁹³ It compares the translations of an early scene when the pilgrim first realizes that Virgil is his guide.¹⁹⁴ One translates the Italian into "Are you Virgil? Are you the spring, the well, / The fountain and the river in full flow / Of eloquence that sings like a seashell / Remembering the sea and the rainbow?"¹⁹⁵ The review notes: "I love '[that]

for public consumption." See *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 550 (1985). What is "reasonable and customary" can, of course, change over time.

¹⁹⁰ See *Hart*, 717 F.3d at 168–70.

¹⁹¹ See 4 *NIMMER*, *supra* note 9, §13.05[A][1][b]; see also *Nihon Keizai Shimbun, Inc. v. Comline Bus. Data, Inc.*, 166 F.3d 65, 72 (2d Cir. 1999) (creating abstracts of Japanese business articles and then translating them into English is "not in the least 'transformative'"). Indeed, translation is listed in the Copyright Act as an example of a derivative work. 17 U.S.C. § 101 (2012).

¹⁹² Gabriel Garcia Marquez is said to have praised Gregory Rabassa's English translation of *One Hundred Years of Solitude* as better than the Spanish original and to have said that "Rabassa read 'One Hundred Years of Solitude,' sat down and then rewrote it in English." Andrew Bast, *A Translator's Long Journey, Page by Page*, N.Y. TIMES, May 25, 2004, <http://www.nytimes.com/2004/05/25/books/a-translator-s-long-journey-page-by-page.html>.

¹⁹³ See Joan Acocella, *What the Hell: Dante in Translation and in Dan Brown's New Novel*, NEW YORKER (May 27, 2013), http://www.newyorker.com/arts/critics/books/2013/05/27/130527crbo_books_acocella.

¹⁹⁴ *Id.*

¹⁹⁵ *Id.*

seashell,’ and ‘the rainbow,.’” but “[n]either is in Dante.” The translator was “a poet, doing a poet’s work.”¹⁹⁶

As this demonstrates, neither the degree of originality nor creativity—nor, more precisely, a judge’s assessment of such things—distinguishes transformed derivative works from transformative fair uses.

B. The License Granted Parody to Override the Other Statutory Fair Use Factors Should Not Apply to the Broader Concept of Transformativeness

As the Nimmer treatise recognizes, the emphasis on transformativeness has skewed the fair use analysis by dominating the first factor and making the others almost disappear.¹⁹⁷ It does not, using Professor Beebe’s phrase, “stampede” the other factors—making other factors align with it.¹⁹⁸ It simply renders them insignificant to the outcome.¹⁹⁹ In doing so, it has appropriated the privileged status of parody within fair use jurisprudence without its justifications.

The virtual demise of the second factor—whether the targeted work is primarily creative or factual—is an object lesson. In the seminal parody case, *Campbell*, the Supreme Court held that the fact that the copied work is creative “is not much help in this case, or ever likely to help much in separating the fair use sheep from the infringing goats *in a parody case*, since parodies almost invariably copy publicly known, expressive works.”²⁰⁰ Parody comprises a small subset of transformative uses with very special needs. It generally needs to use creative works to succeed at all. One can certainly make fun of facts, as shown by the popularity of the Daily Show, but it is difficult to parody them.

Also, as the Supreme Court noted, parody generally needs to conjure up more of the original (implicating the third fair use

¹⁹⁶ *Id.*

¹⁹⁷ 4 NIMMER, *supra* note 9, §13.05[A][1][b].

¹⁹⁸ *See* Beebe, *supra* note 136, at 588–93.

¹⁹⁹ *See id.*

²⁰⁰ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 586 (1994) (emphasis added).

factor) than other uses might because it must ensure that the original is fully recognizable:

Parody's humor, or in any event its comment, necessarily springs from recognizable allusion to its object through distorted imitation. Its art lies in the tension between a known original and its parodic twin. When parody takes aim at a particular original work, the parody must be able to "conjure up" at least enough of that original to make the object of its critical wit recognizable What makes for this recognition is quotation of the original's most distinctive or memorable features, *which the parodist can be sure the audience will know*.²⁰¹

Finally, parody has a unique entitlement not merely to harm, but destroy, the market for the original (neutering the fourth fair use factor) by holding it up to ridicule:

[W]hen a lethal parody, like a scathing theater review, kills demand for the original, it does not produce a harm cognizable under the Copyright Act. Because "parody may quite legitimately aim at garroting the original, destroying it commercially as well as artistically," . . . the role of the courts is to distinguish between "[b]iting criticism [that merely] suppresses demand [and] copyright infringement[, which] usurps it."²⁰²

That the parodied work would almost inevitably be "publicly known" would tend to make the potentially "lethal parody" at least the result of a fair fight.²⁰³ A lethal transformative use of a relatively *unknown* work, on the other hand, should engender the legal equivalent of the schoolyard

²⁰¹ *Id.* at 588 (emphasis added) (internal citations omitted). The italicized language shows that, as seen in *Rogers v. Koons*, you cannot effectively parody a relatively unknown work. *See Rogers v. Koons*, 960 F.2d 301, 310 (2d Cir. 1992).

²⁰² *Campbell*, 510 U.S. at 591–92 (quoting B. KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 69 (1967); and *Fisher v. Dees*, 794 F.2d, 432, 438 (9th Cir. 1986)).

²⁰³ *See id.* at 587, 591.

phrase used to shame bullies: “Pick on someone your own size.”

In sum, parody uniquely needs to be able to override the other fair use factors to assure its existence at all. It also has to victimize a well-known popular work to have the desired impact.²⁰⁴ “Pretty Woman” is an appropriate object of parody;²⁰⁵ “String of Puppies” is not.²⁰⁶ Putting a sculptural transformation of it in the “Banality Show” may be a critical commentary on schmaltzy culture and may be protectable as such, but it should require greater justification than parody.

Parody is one subset of transformative use, however, and its imperatives do not necessarily apply to all transformative use. The Supreme Court has not expanded this characteristic of parody to all transformative uses, but the Second Circuit has, and that has led to the displacement of the statutory balancing in a broad swath of fair use cases.²⁰⁷ Moreover, the Second Circuit has done so without explicitly acknowledging or justifying the extension.²⁰⁸

In *Bill Graham Archives v. Dorling Kindersley Ltd.*, the Second Circuit noted that “the creative nature of artistic images typically weighs in favor of the copyright holder,” but “recognized . . . that the second factor may be of limited usefulness where the creative work of art is being used for a transformative purpose.”²⁰⁹ Its support for that was a quote from *Campbell* that was specific to parody that the Second Circuit expanded to transformative use in general. It characterized *Campbell* as holding “that the second factor is not ‘likely to help much in separating the fair use sheep from the infringing goats’ in cases involving transformative copying of ‘publicly known, expressive

²⁰⁴ See, e.g., *id.* at 588 (indicating that the “parody must be able to ‘conjure up’ at least enough of that original to make the object of its critical wit recognizable”).

²⁰⁵ See *id.* at 594.

²⁰⁶ See *Rogers*, 960 F.2d at 310.

²⁰⁷ See, e.g., cases cited *infra* notes 208–19 and accompanying text.

²⁰⁸ See *supra* note 207.

²⁰⁹ 448 F.3d 605, 612 (2d Cir. 2006).

works.”²¹⁰ As shown above, however, the Supreme Court did not say or imply that this was true generally “in cases involving transformative copying;” the limiting language was “*in a parody case*.”²¹¹

Cariou v. Prince took *Bill Graham Archives*’s characterization of the Supreme Court’s holding one step further by quoting it as authority without any indication of its derivation from *Campbell* and its limited application to parody: the second “factor ‘may be of limited usefulness where,’ as here, ‘the creative work of art is being used for a transformative purpose.’”²¹²

It also expanded to transformative use as a whole *Campbell*’s recognition of the special need of parody to take more from the original than would be justified in other fair uses.²¹³ As *Bill Graham Archives* did with the second factor, *Cariou v. Prince* lifted a quote from *Campbell* that was specific to parody and changed it to refer to transformative use: “[t]he secondary use ‘must be [permitted] to “conjure up” at least enough of the original’ to fulfill its transformative purpose.”²¹⁴ The actual quote from *Campbell* is “[w]hen parody takes aim at a particular original work, the parody must be able to “conjure up” at least enough of that original to make the object of its critical wit recognizable.”²¹⁵

It is a big leap from a parody needing to use enough of the “original to make the object of its critical wit recognizable”²¹⁶ to allowing *any* transformative use to conjure up as much as it needs of an original work, especially one that is not likely or intended to be recognized.²¹⁷ It allows the defendant’s explanation for the taking to justify the extent of it rather than putting the burden on the defendant to argue a credible justification.

²¹⁰ *Id.* (citing *Campbell*, 510 U.S. at 586) (emphasis added).

²¹¹ *Campbell*, 510 U.S. at 586 (emphasis added).

²¹² *Cariou v. Prince*, 714 F.3d 694, 710 (2d Cir. 2013), *cert. denied*, 134 S. Ct. 618 (2013) (quoting *Bill Graham Archives*, 448 F.3d at 612).

²¹³ *See id.*

²¹⁴ *Id.* (quoting *Campbell*, 510 U.S. at 588) (emphasis added).

²¹⁵ *Campbell*, 510 U.S. at 588.

²¹⁶ *Id.*

²¹⁷ *See Cariou*, 714 F.3d at 710.

The appellate court in *Cariou v. Prince* held that the district court erred in expanding to transformative use in general the more specific requirement that parody comment on and ridicule the original.²¹⁸ After correcting that legal error, the appellate court compounded a different legal error by expanding to transformative use in general the special “privilege” of parody to override the other fair use factors.²¹⁹ What both courts should have held is a more nuanced concept: not that commenting on the original work *defines* what is transformative, but that commenting on the original *justifies*—and in most cases would be required to justify—a large-scale taking of a prior work. Transformative uses other than parody need to justify their taking *at all* as well as the extent of the taking. *Cariou v. Prince* assumed away, rather than providing such justification.²²⁰

This is not a specific fault of *Cariou v. Prince* because it was already part of Second Circuit fair use jurisprudence, but it is a fault that must be corrected to return transformativeness to a more appropriate, modest role in analyzing one among many factors rather than dominating the entire fair use analysis.

VII. RETURNING TO A NEO-TRADITIONAL BALANCING APPROACH

Judge Leval’s 1990 article noted that “[a] definite standard would champion predictability at the expense of justification and would stifle intellectual activity to the detriment of the copyright objectives. We should not adopt a bright-line standard unless it were a good one—and we do not have a good one.”²²¹

As shown above, the Second Circuit has made transformative use the primary test of fair use and has endowed it with the power to override the other, potentially

²¹⁸ *Id.* at 706.

²¹⁹ *Id.*

²²⁰ *See id.*

²²¹ Leval, *supra* note 1, at 1135.

countervailing factors.²²² It has not, however, proven to be either a definite or bright-line standard, and its contribution to predictability is no more than a correlation with an increase in the likelihood of fair use being found.²²³ It has decayed into a buzzword—a label rather than an explanation.

The problem is not confined to the Second Circuit, as shown by the Ninth Circuit’s recent decision in *Seltzer v. Green Day*, which involved the use of a street-art poster called “Scream Icon” as a backdrop for a music video for the song “East Jesus Nowhere” performed by Green Day.²²⁴ The fact that “the center of the frame is dominated by an unchanging, but modified, *Scream Icon* [t]hroughout the video”²²⁵ would probably have been enough to find infringement before the judicial tilt toward fair use.²²⁶

While “[t]he plethora of cases addressing this topic means there is no shortage of language from other courts elucidating (or obfuscating) the meaning of transformation,”²²⁷ it did not deter the Ninth Circuit from using it as the principal basis for concluding that the music video constituted a fair use of the prior work:

Green Day used the original as “raw material” in the construction of the four-minute video backdrop. It is not simply a quotation or a republication; although Scream Icon is prominent, it remains only a component of what is essentially a street-art focused music video about religion and especially about Christianity (images of Jesus Christ appear—

²²² See discussion *supra* Part VI.B.

²²³ See Beebe, *supra* note 136, at 604–06.

²²⁴ *Seltzer v. Green Day, Inc.*, 725 F.3d 1170, 1174 (9th Cir. 2013).

²²⁵ See *id.*

²²⁶ See, e.g., *Ringgold v. Black Entm’t Television, Inc.*, 126 F.3d 70, 72–74, 83 (2d Cir. 1997), where a poster of Faith Ringgold’s artwork appeared fleetingly in the background of a scene in a television sitcom. Its partial visibility, not in focus, in nine sequences ranging from two to four seconds for a total of 27 seconds could not be determined as a matter of law on summary judgment to be either *de minimis* or fair use.

²²⁷ *Seltzer*, 725 F.3d at 1176.

and are defaced—several times during the course of the video).²²⁸

As in *Cariou v. Prince* and unlike *Hart v. Electronic Arts*, the Ninth Circuit seems to have accepted that adding surrounding material to an unaltered original work is transformative, even if it is not used for a different purpose.²²⁹ The Scream Icon was considered transformative although it retained its function as street art in “essentially a street-art focused music video” and even though “the allegedly infringing work ma[de] few physical changes to the original [and] fail[ed] to comment on the original” because “new expressive content” was added so that it was part of a music video “about religion and especially about Christianity.”²³⁰

Judges seem oblivious to the flaws and to the low level of esteem to which transformiveness has sunk among practitioners and academics. To the extent that the judges clue into that, what can the courts do to return the concept to a more modest and appropriate role as simply one aspect of analyzing the first factor? We should first look at how the law’s course might reasonably be corrected, and then examine what that correction would look like.

A recent article by a leading copyright practitioner, Richard Dannay, noted the large variety of alternatives to the four factors that have been proposed over the years, including Professor Melville Nimmer’s original suggestion that no factors be mentioned at all.²³¹ Nimmer recommended that the statute’s fair

²²⁸ *Id.* at 1176–77.

²²⁹ *Id.*

²³⁰ *Id.*

²³¹ See Dannay, *supra* note 13, at 134–42. Dannay’s exhaustive summary was as follows:

Apply fewer factors, namely, the first and forth; apply more factors, including anything reasonably bearing on the issue of what’s “fair” such as customary practices and broader social values; consult readers’ responses; abandon fair use and injunctions in favor of monetary damages for unauthorized derivative works; enhance the second factor’s role and importance in the fair use analysis; apply the fair use factors more flexibly and to the extent they respond to recurring categories of cases such as parody and new technologies, to enhance fair use predictability and uniformity; reserve fair use for

use provision simply read that “the fair use of a copyrighted work, as such phrase has heretofore been judicially defined and recognized, is not an infringement of copyright.”²³²

A Congressional amendment to the Copyright Act is possible, and there has been some movement toward a comprehensive look at copyright law,²³³ but the distortion was introduced by case law and does not rely on any statutory language. It would also likely embroil a generally ineffective Congress in a complex task.

The preferable response to the first issue of how to correct the over-reliance on transformativeness lies in the possibility of the Supreme Court reversing course, as it did when first adopting the transformative use test.²³⁴ The Court’s statement in the *Sony* case that all commercial uses were presumptively unfair was clarified or disowned (depending on your tolerance for euphemism) ten years later in *Campbell* to make Copyright law safe for parody.²³⁵ The Supreme Court has not addressed fair use other than in passing references since then, so it has not expressed a view on whether the

situations in which true market failure has occurred; rely on non-binding fair use arbitration, with a de novo court determination available on liability but with some effect, up or down, on damages depending on the outcome; institute an administrative procedure (a Fair Use Board in the Copyright Office) to provide anticipatory, nonprecedential adjudications offering immunity from suit; rely on Supreme Court’s *eBay* four-factor test for a rigorous and consistent evaluation of the propriety of injunctive relief in fair use cases; develop “best practices” for categories of works such as documentaries, poetry, and others, to introduce greater predictability and reduce litigation risks.

Id. at 141–42 (citations omitted).

²³² STAFF OF H. COMM. ON THE JUDICIARY, 89TH CONG., COPYRIGHT LAW REVISION, Part 5, 1964 REVISION BILL WITH DISCUSSIONS AND COMMENTS 316 (Comm. Print 1965); see also Dannay, *supra* note 13 (Dannay’s thoughtful discussion of this idea is the subject of the article cited).

²³³ Congressman Goodlatte, Chairman of the House Judiciary Committee, announced in April 2013 that the Judiciary Committee will conduct a comprehensive review of U.S. copyright law. Press Release, Bob Goodlatte, Chairman, H. Judiciary Comm., Chairman Goodlatte Announces Comprehensive Review of Copyright Law (Apr. 24, 2013), available at http://judiciary.house.gov/news/2013/04242013_2.html. It remains to be seen, however, what, if anything, Congress is capable of doing.

²³⁴ See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

²³⁵ See *id.* at 583–92.

expansion of parody's arguably unique position in fair use law should extend to all transformative uses.

How might the fair use standard get to the Supreme Court again? To the extent that other circuits back away from the extreme use of transformativeness that has come to dominate Second Circuit decisions, that could increase the likelihood of the Supreme Court taking up the issue. After all, a split in the circuits is considered the easiest path to a grant of certiorari. As noted above, however, the Second Circuit's view has received an uneven acceptance in the Third Circuit in *Hart v. Electronic Arts*²³⁶ and in the Ninth Circuit in *Seltzer v. Green Day*.²³⁷

Rejection of Second Circuit cases by a sister circuit might even persuade the Second Circuit to reverse course, either explicitly or *sotto voce*. The appellate court need not necessarily go en banc to reverse course, nor would it even have to take the odd tactic adopted when it reversed a mistaken view of trademark law in its *Rescuecom Corp. v. Google, Inc.* decision.²³⁸ It could "limit" *Cariou v. Prince* "to its facts" and note that it would be the rare case where transformativeness alone could obliterate the statutory fair use factors.²³⁹

²³⁶ *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 165–69 (3d Cir. 2013).

²³⁷ *Seltzer v. Green Day, Inc.*, 725 F.3d 1170, 1176–78 (9th Cir. 2013).

²³⁸ In *Rescuecom Corp. v. Google, Inc.*, the Second Circuit effectively reversed a prior decision in *1-800 Contacts, Inc. v. WhenU.Com, Inc.*, 414 F.3d 400 (2d Cir. 2005), on what constitutes "use in commerce." It did so through the novel use of an Appendix to the opinion that states that it was read and agreed to by the prior panel in *1-800 Contacts* as well as the unanimous panel in *Rescuecom*, but is "dictum and not a binding opinion of the Court." *Rescuecom Corp. v. Google, Inc.*, 562 F.3d 123, 124, 140–41 (2d Cir. 2009).

²³⁹ This is, to some extent, what it did with two decisions in rapid succession on *de minimis* use in copyright. See *Sandoval v. New Line Cinema*, 147 F.3d 215, 216 (2d Cir. 1998) (involving the use of ten photographic transparencies mounted on a light box in the background of one scene from the film "Seven." The longest uninterrupted view lasted six seconds and the total time in which the photographs appeared, not in focus and in the distant background, was thirty-five seconds. The court ruled that to be *de minimis*.) *But see*, *Ringgold v. Black Entm't Television*, 126 F.3d 70, 72–73 (2d Cir. 1997) (involving the appearance in a television sitcom of a poster of Faith Ringgold's artwork in the background of a scene in a church social hall. Its partial visibility, not in focus, in nine sequences, ranging from two to four seconds for a total of 27 seconds, was held not to be *de minimis*.)

As to the second issue, a return to a real application of the statutory four-factor test would require, with respect to each of the four factors, the following types of changes in legal analysis.

A. First Factor

Whether or not it was appropriate for the Supreme Court to retreat from the proposition that commercial uses are presumptively unfair, the plain language of the first factor demands that the commercial nature of the secondary use at least *matter* and count against a finding of fair use.²⁴⁰

There is little possibility of or justification for returning to a bright-line rule based on distinguishing commercial from nonprofit uses, and the line between them can be permeable anyway, but Congress wanted the difference to matter and it makes sense that it would. There is a difference worth noting, for example, between a university using a work of art to teach a course and a company selling t-shirts or posters of the artwork. There is also a significant difference between a gallery promoting and selling a work and a museum displaying it—even if the museum also sells posters or t-shirts of it.

The idea is firmly ensconced in the law that judges should weigh whether allowing the secondary use encourages the useful arts more than calling it infringement. *Campbell* held that “[t]he fair use doctrine . . . ‘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.’”²⁴¹ Basing a decision on what is more likely to encourage or stifle creativity is, however, a perilous proposition, if not a fool’s errand, for at least the following reasons.

(a) That encouraging parody will not unjustifiably deprive an author of his or her creative rewards is a relatively easy proposition, especially because a parody will generally be of a well-known work that has presumably already reaped rewards for

²⁴⁰ See 17 U.S.C. § 107(1) (2012).

²⁴¹ *Campbell v. Acuff–Rose Music, Inc.*, 510 U.S. 569, 577 (1994) (citations omitted) (second bracketed portion in original).

its author. Taking it beyond parody to any transformative use takes the court into trickier territory in having to decide whether depriving the plaintiff of the right to control his work or to be compensated for its use will stifle future authorship.

(b) That decision is all the more tricky since *eBay* eliminated any presumption that a finding of infringement leads inevitably to an injunction.²⁴² The court no longer necessarily chooses between allowing and forbidding the secondary user; the secondary user can build on the original work by paying a royalty or other form of compensation.²⁴³ This raises the price of the secondary use but does not prohibit it or even inhibit it to anywhere near the extent that an injunction and impoundment order would.

(c) Determining whether an adverse decision will deter a defendant from future creativity is not just more difficult but also requires the type of decision about what constitutes greater or lesser creativity that judges claim to be loath to engage in. Being held an infringer did not stop Jeff Koons from producing other pieces of appropriation art,²⁴⁴ nor did it appear to hinder Richard Prince in creating “Canal Zone.”²⁴⁵ Prince said that he could have used stock images and, had he lost, presumably he would in the future.²⁴⁶ Whether that would be a good or bad thing for art, or whether the result would have been more or less creative than what he actually did and was sued for is a question on which reasonable art critics might disagree.

(d) The standard of copyrightability is originality.²⁴⁷ While that may imply some minimal amount of creativity, judges have

²⁴² See *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 394 (2006); *Salinger v. Colting*, 607 F.3d 68, 80 (2d Cir. 2010).

²⁴³ See, e.g., *Salinger*, 607 F.3d at 80; Richard Dannay, *Copyright Injunctions and Fair Use: Enter eBay—Four-Factor Fatigue or Four-Factor Freedom?*, 55 J. COPYRIGHT SOC’Y 449, 458–59 (2008).

²⁴⁴ See discussion *supra* Part B.2.

²⁴⁵ See *Cariou v. Prince*, 714 F.3d 694, 698 (2d Cir. 2013), *cert. denied*, 134 S. Ct. 618 (2013).

²⁴⁶ See Brief for Plaintiff-Appellee at 12, *Cariou v. Prince*, No. 11-1197 (2d Cir. Jan. 25, 2012) (citing testimony).

²⁴⁷ See 17 U.S.C. § 102(a) (“Copyright protection subsists . . . in original works of authorship.”).

long disclaimed any competence or authority to assess the degree of creativity or artistic merit in any given work.²⁴⁸ The two concepts are far from equivalent. Determining what type of art in any given situation is more worthwhile and to be encouraged puts judges exactly where they claim they do not want to be—in the role of art critic rather than arbiter of legal rights.²⁴⁹

B. *Second Factor*

The second factor is the most easily and objectively determined. Is the copied work published or unpublished, creative or factual?²⁵⁰ Nevertheless, at least where published creative works are at issue, it would be difficult to come up with any example of a case where this factor has tipped the balance against fair use.

The impotence of the second factor is readily apparent in the appropriation art cases. That the appropriated work was creative rather than factual should have weighed against fair use, but the Second Circuit opinions have done little more than pay lip service to that intuitive and statute based principle.

In *Blanch v. Koons*, the appellate court disagreed with the district court's conclusion that the photograph used was “‘banal rather than creative,’” and noted that “‘the creative nature of artistic images typically weighs in favor of the copyright holder,’ but nevertheless dismissed ‘the second factor [as having] limited usefulness where the creative work of art is being used for a transformative purpose.’”²⁵¹ In *Cariou v. Prince* the defendant

²⁴⁸ See 1 NIMMER, *supra* note 9, § 2.01[B] (quoting *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251–52 (1903) (Holmes, J.)).

²⁴⁹ Judges consistently disclaim the role of art critic, but often nevertheless assume it. See, e.g., *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 154 (3d Cir. 2013) (criticizing one view of balancing right of publicity and freedom expression as “call[ing] upon judges to act as both impartial jurists and discerning art critics. These two roles cannot co-exist.”). To the extent that transformativeness is seen as a proxy for artistic merit one might question whether judges have been or will be as reluctant to assert artistry as they claim they have been.

²⁵⁰ See 17 U.S.C. § 107 (2) (2012).

²⁵¹ *Blanch v. Koons*, 467 F.3d 244, 257 (2d Cir. 2006) (quoting *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 608, 612 (2d Cir. 2006)).

attacked the creativeness of Cariou's photographs in the district court,²⁵² but wisely abandoned that argument on appeal. The Second Circuit noted that there was "no dispute that Cariou's work is creative and published" but, like *Blanch v. Koons*, dismissed the importance of the second factor due to its conclusion about the transformative use made of it.²⁵³ The second factor's significance in weighing against fair use in *Rogers v. Koons* cannot be assessed because all the factors were said to disfavor fair use.²⁵⁴

The second factor should be rehabilitated to return to meaning and significance in the fair use determination. Aside from parody and satire, creative works should receive greater protection, and the statutory tilting toward greater protection for creative works should not be so easily dismissed with the statement that it is "of limited usefulness where the creative work of art is being used for a transformative purpose."²⁵⁵ The transformative purpose of the secondary use may outweigh the creativity of the original work where little of the original work is used (third factor) or it is a small part of the secondary work (which is part of the transformativeness determination), but the appropriation of a creative work should not be so lightly dismissed.

C. Third Factor

Taken alone, the third factor focuses solely on "the proportion of the original work used, and not how much of the secondary work comprises the original."²⁵⁶ Balanced against the first factor, however, "how much of the secondary work comprises the original," and, more importantly, the justification for it, can cancel out any significance of the third factor.²⁵⁷ This, as shown above, is

²⁵² The district court rejected Prince's contention "that Cariou's Photos are mere compilations of facts concerning Rastafarians and the Jamaican landscape, arranged with minimum creativity in a manner typical of their genre, and that the Photos are therefore not protectable as a matter of law" *Cariou v. Prince*, 784 F. Supp. 2d 337, 346 (S.D.N.Y. 2011).

²⁵³ *Cariou v. Prince*, 714 F.3d 694, 710 (2d Cir. 2013), *cert. denied*, 134 S. Ct. 618 (2013).

²⁵⁴ *See* *Rogers v. Koons*, 960 F.2d 301, 309–312 (2d Cir. 1992).

²⁵⁵ *Blanch*, 467 F.3d at 257 (citing *Bill Graham Archives*, 448 F.3d at 612).

²⁵⁶ *Cariou*, 714 F.3d at 710.

²⁵⁷ *Id.* at 706–07.

primarily due to the importation of parody standards into transformativeness.²⁵⁸

Parody does indeed need to conjure up a significant amount of its object to achieve its parodic purpose.²⁵⁹ Transformative use other than parody does not necessarily *need* to do that. Where a parody is not at issue, there should generally be an *inverse* relationship between “the amount and substantiality of the portion used in relation to the copyrighted work as a whole” and the degree of transformation in the accused work.²⁶⁰

The Second Circuit has recognized this, albeit in the language of transformativeness, in holding that the third factor “recognizes that fragmentary copying is more likely to have a transformative purpose than wholesale copying.”²⁶¹ The decision in *Cariou v. Prince* can, to some extent, be interpreted primarily through the third factor.²⁶² Many of the works held to be fair use used very little of Cariou’s photographs, but many of them also contained significant and fairly intact images from the photographs.²⁶³ An appropriately calibrated transformative use test would reinforce the significance of the third factor and make it more predictable because the proportion of the original work used is reasonably susceptible to objective determination.

D. Fourth Factor

The statute requires the court to consider “the effect of the use upon the potential market for or value of the copyrighted work.”²⁶⁴ That is the language of degree and a continuum: Is there likely to be an effect and, if so, how bad? It has been distorted from a continuum to a high threshold by holding that the issue is not whether the secondary use affects the potential market for the copyrighted work—or even whether it destroys it—but whether it

²⁵⁸ *See id.* at 710.

²⁵⁹ *See id.* (citing *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 588 (1994)).

²⁶⁰ *See* 17 U.S.C. § 107(3) (2012).

²⁶¹ On *Davis v. The Gap*, 246 F.3d 152, 175 (2d Cir. 2001).

²⁶² *See Cariou*, 714 F.3d at 710.

²⁶³ *Id.* at 710–11.

²⁶⁴ 17 U.S.C. § 107(4).

“usurps” it.²⁶⁵ Again, that is a matter of expanding *Campbell*’s limited holding about parody that it cannot, by definition, usurp the market for the original because there is no secondary market for ridicule. The special status of parody in being allowed not just to affect but also to destroy the value of the original should not govern all fair use or even all transformative use.

Moreover, the assumption that no one would be willing to license ridicule²⁶⁶ needs to be challenged. Whether that is true should be a factual determination in the individual case rather than assumed, even in parody cases, but especially if it is transformativeness in general that is being assessed. That not everyone is so lacking in a sense of humor or so averse to a potential licensing fee is belied by instances where artists do give permission for parody. After all, Weird Al Yankovic does parodies only by permission of the artist mocked.²⁶⁷

What has also gotten lost in the recent cases is the principle from *Sony* reiterated in *Harper & Row* that it is not just the harm of the potential use directly in front of the court that matters, but, more importantly, the harm if that specific practice were to become common. “[T]o negate fair use one need only show that if the

²⁶⁵ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 592 (1994) (“This distinction between potentially remediable displacement and unremediable disparagement is reflected in the rule that there is no protectible derivative market for criticism.”).

²⁶⁶ *See, e.g., id.* (“[T]he unlikelihood that creators of imaginative works will license critical reviews or lampoons of their own productions removes such uses from the very notion of a potential licensing market.”).

²⁶⁷ *See FAQ*, “Weird Al” Yankovic (2013), <http://www.weirdal.com/faq.htm> (last visited Mar. 12, 2014). Weird Al Yankovic’s website has the following “FAQs”:

Does Al get permission to do his parodies?

Al does get permission from the original writers of the songs that he parodies. While the law supports his ability to parody without permission, he feels it’s important to maintain the relationships that he’s built with artists and writers over the years. Plus, Al wants to make sure that he gets his songwriter credit (as writer of new lyrics) as well as his rightful share of the royalties.

What do the original artists think of the parodies?

Most artists are genuinely flattered and consider it an honor to have Weird Al parody their work. Some groups (including Nirvana) claim that they didn’t realize that they had really “made it” until Weird Al did a parody of them!

Id.

challenged use ‘should become widespread, it would adversely affect the potential market for the copyrighted work.’”²⁶⁸ *Cariou v. Prince* failed to deal with this variant of the elementary school teacher’s question—“what if everyone did it?”—in analyzing the fourth factor; it did not take into account the damage to photographers not just from Prince’s specific use of Cariou’s photographs, but the harm if that practice within appropriation art and other similar types of art became prevalent.²⁶⁹ It may be that appropriation art should still win in those instances, but the choice and the factors involved in that choice need to be squarely faced.

The other problem with the fourth factor is one of avoiding two competing circular arguments—one favoring and one disfavoring a fair use determination. The pro-defendant circularity is noted by Professor Netanel, who pointed out that transformativeness “effectively delimits the legally relevant market” by defining it away: “If a use is unequivocally transformative, then, by definition, it causes no market harm since the copyright holder does not have a right to exclude others from the market for transformative uses.”²⁷⁰

The pro-plaintiff circularity is discussed in the Nimmer treatise.²⁷¹ It points out that if the potential market considered under the fourth factor is defined by nothing more than the manner in which the secondary artist used the copyrighted work, then, by that definition, a potential licensing opportunity has been lost.²⁷² “[I]t is a given in every fair use case that plaintiff suffers a loss of a potential market if that potential market is defined as the theoretical market for licensing the very use at bar.”²⁷³ The Second Circuit has tried to avoid this circularity by “limiting the universe of potential effect on [cognizable] licensing revenues . . .

²⁶⁸ *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 568 (1985) (quoting *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 451 (1984)).

²⁶⁹ *See Cariou v. Prince*, 714 F.3d 694, 708–09 (2d Cir. 2013), *cert. denied*, 134 S. Ct. 618 (2013).

²⁷⁰ Netanel, *supra* note 149, at 744.

²⁷¹ *See NIMMER*, *supra* note 9, § 13.05[A][1][d][4].

²⁷² *See id.*

²⁷³ *Id.*

to ‘traditional, reasonable, or likely to be developed markets.’”²⁷⁴ There is, of course, always room for debate over what is traditional or reasonable.²⁷⁵

Another way in which the transformativeness analysis has unfairly redefined the fourth factor is shown in the Second Circuit’s analysis of Prince’s effect on Cariou’s market or the value of his photographs.²⁷⁶ The court’s description of the difference in a manner that seems fascinated by the astronomical prices of Prince’s artwork and the glitz of his potential customers defines the market by social demographic more than by similarity of the goods.²⁷⁷ It could also, in another context, have provided the rationale for dismissing “Canal Zone” as shamelessly commercial.²⁷⁸

VIII. THE IMPLICATIONS OF THE NEO-TRADITIONAL APPROACH, WITH ONE MODERN TWIST

Quantitative academic studies have shown a correlation between the increasing dominance of the transformative use analysis and increasing decisions in favor of fair use.²⁷⁹ They have been cautious about reaching any conclusions about a causal connection,²⁸⁰ but the evolution of appropriation art cases, though not necessarily one-directional, strongly suggests that there is. The doctrinal shift is not necessarily causing the shift in outcomes, or vice-versa. They may also be just enabling each other.

²⁷⁴ *Id.* (quoting *American Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 930 (2d Cir. 1994)).

²⁷⁵ *See id.*

²⁷⁶ *See Cariou v. Prince*, 714 F.3d 694, 708–09 (2d Cir. 2013), *cert. denied*, 134 S. Ct. 618 (2013).

²⁷⁷ *See id.*

²⁷⁸ *Id.* at 709 (“Certain of the *Canal Zone* artworks have sold for two million or more dollars. The invitation list for a dinner that Gagosian hosted in conjunction with the opening of the *Canal Zone* show included a number of the wealthy and famous such as the musicians Jay-Z and Beyonce Knowles, artists Damien Hirst and Jeff Koons, professional football player Tom Brady, model Gisele Bundchen, *Vanity Fair* editor Graydon Carter, *Vogue* editor Anna Wintour, authors Jonathan Franzen and Candace Bushnell, and actors Robert DeNiro, Angelina Jolie, and Brad Pitt.”).

²⁷⁹ *See* Netanel, *supra* note 149, at 740.

²⁸⁰ *See id.* at 740–42; *see also* Beebe, *supra* note 136, at 597, 604–06.

While there are many potential explanations other than the ascendancy of transformativeness to explain the difference in results from the first to the second *Koons* cases—including the very different quantity and quality of the original photograph taken—it is difficult to imagine the fairly radical shift from the first *Koons* case to *Cariou v. Prince* without not just the transformative analysis, but, just as importantly, its ability to beat all other factors into submission.

That they correlate means that a return to balancing the traditional factors is likely to lead to or correlate with a reduction in outcomes favoring fair use, but there is one modern doctrinal innovation that could go a long way toward mitigating the effect of reducing fair use determinations. It is lurking in *Cariou v. Prince* and may explain what the appellate court was, *sotto voce*, trying to do when it pointed out that under the Supreme Court’s *eBay* decision, as further elaborated in *Salinger v. Colting*,²⁸¹ the district court would have to reconsider whether an injunction was appropriate if it concluded that any of the five remanded works of art infringed.²⁸²

By not declaring all the works of “Canal Zone” fair use and remanding five of them rather than holding them to be infringements as a matter of law, and in reminding the district court that an injunction would not necessarily follow a finding of infringement, the Court of Appeals was probably suggesting that the parties settle the remaining issue with a payment to Cariou—

²⁸¹ See *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 392–94 (2006) (relying on an analogy to copyright law, the Court held that there is no presumption of irreparable harm in patent cases and therefore no general rule that an injunction will follow from an adjudication of infringement). Recognizing that prior case law presumptions that “a plaintiff likely to prevail on the merits of a copyright claim is also likely to suffer irreparable harm if an injunction does not issue” had been abrogated by *eBay*, *Salinger v. Colting*, 607 F.3d 68 (2d Cir. 2010), held that *eBay* dictated that a “court must not adopt a ‘categorical’ or ‘general’ rule or presume that the plaintiff will suffer irreparable harm Instead, the court must actually consider the injury the plaintiff will suffer if he or she loses on the preliminary injunction but ultimately prevails on the merits, paying particular attention to whether the ‘remedies available at law, such as monetary damages, are inadequate to compensate for that injury.’” *Id.* at 80 (quoting *eBay*, 547 U.S. at 393–94).

²⁸² See *Cariou*, 714 F.3d at 712 n.5.

not necessarily a large payment but something approaching what a reasonable royalty would have been if negotiated in the first place. The case did indeed settle before the district court made further substantive rulings. The terms of the agreement were not, of course, revealed, other than that Prince and the galleries are free and clear of any claim by Cariou.

And that may well be where fair use law should be going. Plaintiffs are not going to regain the favored status they had when the first *Koons* decision came down, which included not just a judgment against Koons but an order requiring him to deliver his remaining work to be impounded and potentially destroyed, but the law will also not be as pro-defendant as *Cariou v. Prince* would indicate. Counterbalancing a more pro-plaintiff view of fair use that would come from closer congruence with the statute and its multi-factor balancing test will be a reluctance to grant injunctions and therefore greater focus on damages and royalty calculations. Like *Cariou v. Prince*, this direction may not make either side happy, but it will at least bring some of the conceptual clarity that fair use law has lost.