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David Tan
National University of Singapore

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Cover Page Footnote

PhD (Melbourne); LLM (Harvard); LLB BCom (Melbourne). Vice Dean (Academic Affairs), Associate Professor, Faculty of Law, National University of Singapore. I would like to thank Professors Rochelle Cooper Dreyfuss, Graeme Dinwoodie, and Graeme Austin for their comments on an earlier draft presented at the Framing Intellectual Property Law in the 21st Century conference in Singapore, and Kenneth Wang Ye and Benjamin Foo for their research assistance.

The Lost Language of the First Amendment in Copyright Fair Use: A Semiotic Perspective of the "Transformative Use" Doctrine Twenty-Five Years On

David Tan*

It has been twenty-five years since Judge Pierre Leval published his iconic article, "Toward a Fair Use Standard," urging that courts adopt a new guiding principle of "transformative use" to determine whether an unauthorized secondary use of a copyrighted work is fair. The Supreme Court's emphatic endorsement of this approach in 1994 has resulted in a remarkable judicial expansion of the transformative use doctrine which today covers virtually any "creation of new information, new aesthetics, new insights and understandings." While the Supreme Court reiterated in Golan v. Holder *in 2012 that the fair use defense is one of copyright law's key "built-in First Amendment accommodations," the influence of the First Amendment on the transformative use doctrine remains largely unexplored over the years. This Article analyzes how the different theoretical underpinnings of the First Amendment and certain categories of First Amendment-protected speech have been accommodated within the transformative use doctrine, and shows how the First Amendment has been—and will continue to be—the invisible hand that shapes the development of copyright law. It also addresses the unre-*

* PhD (Melbourne); LLM (Harvard); LLB BCom (Melbourne). Vice Dean (Academic Affairs), Associate Professor, Faculty of Law, National University of Singapore. I would like to thank Professors Rochelle Cooper Dreyfuss, Graeme Dinwoodie, and Graeme Austin for their comments on an earlier draft presented at the *Framing Intellectual Property Law in the 21st Century* conference in Singapore, and Kenneth Wang Ye and Benjamin Foo for their research assistance.

lenting frustration in assessing transformative use and urges a consideration for assistance from a semiotic perspective of the First Amendment to illuminate what really are cultural contestations of semiotic signs masquerading as copyright disputes.

INTRODUCTION

First Amendment jurisprudence is replete with symbolic expression that qualifies for constitutional protection. The Supreme Court has explicitly acknowledged that burning the American flag

can be construed as a legitimate form of political protest,[1] and placing a burning cross on the fenced yard of a black family connotes "virulent notions of racial supremacy" but is nonetheless a protected expression of particular ideas.[2] However, in a copyright dispute, while spray-painting a red cross over the image of a screaming face in a music video was seen to convey a critical message about the hypocrisy of religion, there was no mention of the First Amendment.[3] Similarly, replacing the romantic lyrics of "Oh, Pretty Woman" with tawdry ones was perceived to be a "comment on the naiveté of the original of an earlier day, as a rejection of its sentiment that ignores the ugliness of street life and the debasement that it signifies,"[4] but there was no reference to its contribution to the marketplace of ideas.[5]

In 2014, the Supreme Court in *McCullen v. Coakley* reiterated that the primary purpose of the First Amendment is "to preserve an uninhibited marketplace of ideas in which truth will ultimately prevail."[6] In the same year, the Court also highlighted in *McCutcheon v. Federal Election Commission* that there is "no right more basic in our democracy than the right to participate in electing our political leaders"[7] and that the "First Amendment safeguards an individual's right to participate in the public debate through political expression and political association."[8] The Supreme Court has exhorted that First Amendment standards "must give the benefit of any doubt to protecting rather than stifling speech."[9]

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1 *E.g.*, Texas v. Johnson, 491 U.S. 397, 405 (1989) ("We have had little difficulty identifying an expressive element in conduct relating to flags . . . . The very purpose of a national flag is to serve as a symbol of our country; it is, one might say, the one visible manifestation of two hundred years of nationhood.").

2 Virginia v. Black, 538 U.S. 343, 356–57, 363, 389–91 (2003); R.A.V. v. City of St. Paul, 505 U.S. 377, 392, 394 (1992).

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

4 Campbell v. Acuff-Rose Music Inc., 510 U.S. 569, 583 (1994).

5 *Id.*

6 McCullen v. Coakley, 134 S. Ct. 2518, 2529 (2014) (citing FCC v. League of Women Voters of Cal., 468 U.S. 364, 377 (1984)).

7 McCutcheon v. Fed. Election Comm'n, 134 S. Ct. 1434, 1440–41 (2014).

8 *Id.* at 1448 (citing Buckley v. Valeo, 424 U.S. 1, 15 (1976)).

9 Citizens United v. Fed. Election Comm'n, 558 U.S. 310, 327 (2010); *see also* Fed. Election Comm'n v. Wis. Right to Life, Inc., 551 U.S. 449, 469 (2007); N.Y. Times Co. v. Sullivan, 376 U.S. 254, 269–70 (1964).

Although political speech, or conduct expressing a clear political message, enjoys heightened First Amendment protection, the Supreme Court has found that literature, music, and the visual and performing arts also qualify for constitutional protection even in the absence of conveying a clear political message or touching on a matter of public concern. In *Hurley v. Irish-American Gay, Lesbian and Bisexual Group of Boston*, the Supreme Court held that "a narrow, succinctly articulable message is not a condition of constitutional protection, which if confined to expressions conveying a particularized message would never reach the unquestionably shielded painting of Jackson Pollock, music of Arnold Schöenberg, or Jabberwocky verse of Lewis Carroll."[10]

Hurley poses some important theoretical questions about the rationale for extending First Amendment protection to literary, musical, dramatic and artistic works, and consequently the enforcement of copyright and its potential chilling effect on freedom of speech. However, while First Amendment case law, in terms of challenging the constitutional validity of state action, is filled with references to the constitutionally protected status of literary, musical, dramatic, and artistic works,[11] courts have rarely discussed the underlying rationales for such protection in copyright litigation. The tension between copyright interests and the First Amendment is apparent. The Copyright Act, enacted by Congress under the authority of the U.S. Constitution's Copyright Clause, grants individuals monopoly-like power to preclude others from using copy-

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[10] Hurley v. Irish-Am. Gay, Lesbian & Bisexual Grp. of Bos., 515 U.S. 557, 569 (1995) (internal citation omitted).

[11] *See* Nat'l Endowment of the Arts v. Finley, 524 U.S. 569, 602 (1998) ("Constitutional protection of artistic works turns not on the political significance that may be attributable to such productions, though they may indeed comment on the political, but simply on their expressive character."); Bery v. City of New York, 97 F.3d 689, 696 (2d Cir. 1996) ("Paintings, photographs, prints and sculptures . . . are entitled to full First Amendment protection."); Piarowski v. Ill. Cmty. Coll. Dist., 759 F.2d 625, 628 (7th Cir. 1985) ("The First Amendment has been interpreted to embrace purely artistic as well as political expression."); *see also* Joseph Burstyn, Inc. v. Wilson, 343 U.S. 495, 501 (1952) (protecting motion pictures that "may affect public attitudes and behavior in a variety of ways, ranging from direct espousal of a political or social doctrine to the subtle shaping of thought which characterizes all artistic expression"); David Greene, *Why Protect Political Art as "Political Speech"?*, 27 HASTINGS COMM. & ENT. L.J. 359, 362 (2005) (explaining that visual art falls under the aegis of the First Amendment).

righted material in their expression.[12] It is this "paradox" that creates the tension: copyright laws grant a copyright owner the right to suppress or abridge another person's freedom of speech when that person seeks to express copyrighted material. However, on a number of occasions, the Supreme Court has rejected any further independent consideration of the impact of the First Amendment on copyright law, pronouncing that "copyright law contains built-in First Amendment accommodations."[13] As a "traditional contour" of copyright law, the Court had held that the "fair use defense affords considerable latitude for scholarship and comment . . . even for parody."[14] Justice Ginsburg, delivering the opinion of the Court in *Golan v. Holder*, emphasized the "'speech-protective purposes and safeguards' embraced by copyright law"[15] and assured that the public may freely use the author's expression "in certain circumstances."[16] Unfortunately, in all the decisions concerning challenges to copyright legislation passed by Congress, the Supreme Court did not elaborate on how First Amendment jurisprudence might actually be relevant in determining the ambit of such safeguards.[17]

Indeed the Supreme Court's ruling in *Golan* makes it clear that the fair use defense has "constitutional import" and "reaffirms that copyright law poses a First Amendment paradox that cannot be ignored."[18] This Article adopts the premise that the key under-

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[12] Copyright Act of 1976, 17 U.S.C. § 106 (2012).

[13] Eldred v. Ashcroft, 537 U.S. 186, 219 (2003); *see also* Golan v. Holder, 132 S. Ct. 873, 890 (2012); Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 560 (1985).

[14] *Eldred*, 537 U.S. at 219–20.

[15] *Golan*, 132 S. Ct. at 890 (quoting *Eldred*, 537 U.S. at 219); *see generally* Matthew D. Bunker, *Adventures in the Copyright Zone: The Puzzling Absence of Independent First Amendment Defenses in Contemporary Copyright Disputes*, 14 COMM. L. & POL'Y 273 (2009); Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 UCLA L. REV. 1180 (1970); L. Ray Patterson, *Free Speech, Copyright, and Fair Use*, 40 VAND. L. REV. 1 (1987).

[16] *Golan*, 132 S. Ct. at 890 (citing *Eldred*, 537 U.S. at 219).

[17] *See Eldred*, 537 U.S. at 186 (concerning the 1998 Copyright Term Extension Act extending the duration of copyrights by twenty years); *see also Golan*, 132 S. Ct. at 873 (concerning section 514 of the Uruguay Round Agreements Act granting copyright protection to works protected in their country of origin, but lacking protection in the United States).

[18] Neil Weinstock Netanel, *First Amendment Constraints on Copyright after* Golan v. Holder, 60 UCLA L. REV. 1082, 1128 (2013).

lying rationales of the First Amendment are the promotion of a marketplace of ideas and the advancement of a democracy where the public can freely participate in deliberating issues important to decisionmaking in a democracy (a "participatory democracy"). It contends that in many decisions that have applied the transformative use doctrine in extending the fair use privilege to infringing works, the results are often compatible with, and perhaps even influenced by, covert First Amendment considerations.

A well-known literary or artistic work does much more than simply educate, inform, or entertain, but it also functions as a *signifier* of a set of *signified* meanings. As many famous copyrighted works are important semiotic signs in contemporary society, I further propose that the augmentation of these theories of the First Amendment with semiotic insights is likely to lead to better outcomes in cases because more speech of "greater" constitutional value is protected (i.e., speech that contributes to an increased awareness and debate of public issues). "Interdisciplinarity has become a transforming force within legal studies," and its advantages have been well canvassed.[19] Ideological discourses of a particular society can be classified and framed through semiotic signs represented by well-known copyrighted works. A particular work that is symbolic of a privileged public identity can be seen to represent a majoritarian ideological position—a form of "frozen speech"[20]—and is, therefore, open to a recoding challenge by others to express their cultural identities and convey their political ideologies.[21] For example, a challenge to the ideas embodied in the *Gone With The Wind* novel may be presented in the form of another novel titled *The Wind Done Gone* which uses the characters in the original novel but portrays them differently in order to make "a

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[19] *See* MATTHEW D. BUNKER, CRITIQUING FREE SPEECH: FIRST AMENDMENT THEORY AND THE CHALLENGE OF INTERDISCIPLINARITY xii (2001).

[20] ROLAND BARTHES, MYTHOLOGIES 124 (Annette Lavers trans., 1972) (1957).

[21] More recently, recoding—in a copyright context—has been defined to be "the appropriation of a copyrighted cultural object for new expression in a way that ascribes a different meaning to it than intended by its creator." *See* Note, *"Recoding" and the Derivative Works Entitlement: Addressing the First Amendment Challenge*, 119 HARV. L. REV. 1488, 1488 (2006); *see also* Anupam Chander & Madhavi Sunder, *Everyone's a Superhero: A Cultural Theory of "Mary Sue" Fan Fiction as Fair Use*, 95 CALIF. L. REV. 597 (2007).

critical statement that seeks to rebut and destroy the perspective, judgments, and mythology of [the original work]" and "to explode the romantic, idealized portrait of the antebellum South during and after the Civil War."[22] This Article suggests that free speech interests may be enhanced by a pragmatic understanding of semiotics that seeks to attain a "wide reflective equilibrium [that is] firmly grounded in constitutional reality."[23]

In U.S. fair use jurisprudence, the first statutory factor of fair use—the "purpose and character of the use"—is examined in the context of the transformative nature of the infringing work. Generally, a transformative work is one that imbues the original "with a further purpose or different character, altering the first with new expression, meaning, or message."[24] According to the Supreme Court in *Campbell v. Acuff-Rose Music, Inc.*, transformativeness not only occupies the core of the fair use doctrine but also reduces the importance of all other factors such that "the more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use."[25] Part I examines the current scope of the first factor of fair use as codified in section 107 of the United States Copyright Act 1976. It traces the judicial development of the "transformative use" doctrine as articulated by Pierre Leval twenty-five years ago and highlights the dispositive force that this concept commands today in the fair use analysis. It further argues that copyright fair use jurisprudence today, in particular the decisions of the Second and Ninth Circuit Court of Appeals, despite having virtually no reference to the First Amendment, is nonetheless highly protective of speech.

Part II will show that First Amendment jurisprudence, especially Supreme Court decisions, while consistently paying tribute to a marketplace of ideas, inevitably supports an overarching approach to the First Amendment in terms of a participatory theory that places the highest constitutional value on political speech. It contends that that many works protected by copyright law also possess significant sets of established meanings and connotations to

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22 Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257, 1270 (11th Cir. 2001).
23 BUNKER, *supra* note 19, at 197.
24 Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 579 (1994).
25 *Id.*

the public which utilize these works in the expressive process of social identity formation and democratic discourse, with these secondary works falling clearly within protected categories of speech.

Part III interrogates how the prevailing test of whether the original copyrighted work was employed "in the creation of new information, new aesthetics, new insights and understandings" has not only adequately accommodated the First Amendment, but is in fact driven by an underlying free speech ethos that is evident in other areas of intellectual property like trademark and right of publicity laws. It postulates that viewing copyrighted works as semiotic signs can assist both the development of First Amendment and copyright jurisprudence. Using well-known cartoon and superhero characters, it illustrates how an evaluation of "transformative use" essentially embeds notions of sustaining a vibrant marketplace of ideas and promoting participatory democracy within copyright fair use analysis. It also highlights the recoding potential of famous works, especially as used by subaltern groups or counterpublics as an integral part of political and social identity formation. This Article concludes that this approach to fair use allows greater breathing space for the First Amendment within copyright jurisprudence, and it can better protect political speech in a manner that more effectively negotiates the competing right of the copyright owner to exploit the commercial value of his or her work, and the right of the public to use the work as an expressive communicative symbolic resource in a participatory democracy.

I. PIERRE LEVAL'S TRANSFORMATIVE USE DOCTRINE—THEN & NOW

The fair use defense is widely believed to have its American origins in Justice Story's test for a fair and bona fide abridgement as set out in his 1841 decision in *Folsom v. Marsh*.[26] If *prima facie* copyright infringement was found, the fair use defense as codified in section 107 of the 1976 Copyright Act can nonetheless provide a safe harbor for the defendant, especially if transformative elements may be discerned in the infringing work.

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[26] 9 F. Cas. 342, 349 (C.C.D. Mass. 1841) (No. 4901).

Section 107 states:

> [T]he fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—
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> (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.[27]

A. Pierre Leval's Transformative Use Doctrine in 1990

Pierre Leval, then a judge of the United States District Court for the Southern District of New York, published an influential article in 1990 that considered whether imprecision—the absence of a clear standard—in fair use doctrine was a strength or a weakness.[28] Leval noted that "throughout the development of the fair use doctrine, courts had failed to fashion a set of governing principles or values"[29] but was concerned that fair use "should be perceived not as a disorderly basket of exceptions to the rules of copyright, nor as a departure from the principles governing that body of law, but rather as a rational, integral part of copyright."[30] Referring to the Copyright Clause,[31] he argued that by lumping together authors and inventors, writings and discoveries, the express text suggests the rough equivalence of these two activities, and therefore

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27 Copyright Act of 1976, 17 U.S.C. § 107 (2012).
28 Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105 (1990).
29 *Id.* at 1105.
30 *Id.* at 1107.
31 U.S. CONST. art. I, § 8, cl. 8.

the goal of both copyright and patent laws is utilitarian in nature. More specifically, copyright law:

> [E]mbodies a recognition that creative intellectual activity is vital to the well-being of society. It is a pragmatic measure by which society confers monopoly-exploitation benefits for a limited duration on authors and artists (as it does for inventors), in order to obtain for itself the intellectual and practical enrichment that results from creative endeavors.[32]

Leval acknowledged that monopoly protection of intellectual property that restricted referential analysis and the development of new ideas out of the old would strangle the creative process, and thought that the idea-expression dichotomy, facts-exclusion rule and fair use doctrine all provided a counterbalance. In particular, he advocated instilling a coherent and useful set of principles in the fair use doctrine, such that "the use must be of a character that serves the copyright objective of stimulating productive thought and public instruction without excessively diminishing the incentives for creativity."[33]

In his analysis of the four statutory fair use factors, Leval was of the view that factor one—the "purpose and character of the use"—is the "soul of fair use."[34] Explaining that this consideration raises the question of justification (i.e., "Does the use fulfill the objective of copyright law to stimulate creativity for public illumination?"[35]), he emphasized that the answer turns primarily on whether, and to what extent, the challenged use is transformative. Leval frames the inquiry as follows:

> The use must be productive and must employ the quoted matter in a different manner or for a different purpose from the original . . . . [If] the secondary use 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

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32 Leval, *supra* note 28, at 1109.
33 *Id.* at 1109–10.
34 *Id.* at 1116.
35 *Id.* at 1111.

> and understandings—this is the very type of activity that the fair use doctrine intends to protect for the enrichment of society.[36]

Leval also provided some examples of transformative use which included "criticizing the quoted work, exposing the character of the original author, . . . or summarizing an idea argued in the original in order to defend or rebut it" and "parody, symbolism, [and] aesthetic declarations."[37] Interestingly, while Leval conceded that "copyright often results in suppression of speech,"[38] he avoided any discussion of the First Amendment and peremptorily declared "the Framers intended copyright . . . to be the engine of free expression"[39] and it "is intended to increase and not to impeded the harvest of knowledge."[40]

B. The Supreme Court's Endorsement of Transformative Use in 1994

The phrase "transformative use" has surged into prominence in fair use jurisprudence ever since the Supreme Court in 1994 embraced transformativeness as the cynosure of fair use in *Campbell v. Acuff-Rose Music, Inc.*[41] The decision is important in its emphasis on how a highly transformative use of an original work may qualify the secondary infringing work for fair use protection even if the latter was commercial in nature, rebutting earlier presumptions in cases like *Harper & Row, Publishers v. Nation Enterprises*[42] and *Sony Corp. of America v. Universal City Studios*.[43]

In 1964, Roy Orbison and William Dees wrote a rock ballad called "Oh, Pretty Woman" and assigned their rights in it to Acuff-Rose Music. In 1989, Luke Campbell, from the controversial

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36 *Id.* (internal citations omitted).

37 *Id.*

38 *Id.* at 1135.

39 *Id.* (citing Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 558 (1985)).

40 *Id.* (citing *Harper & Row*, 471 U.S. at 545).

41 Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569 (1994). The controversial rap group 2 Live Crew sampled the distinctive bass line from Roy Orbison's original hit song "Pretty Woman," used the same title for their parody song, and replaced the romantic lyrics with talk about a big hairy woman and her exploits. *Id.* at 582, 588.

42 *Harper & Row*, 471 U.S. 539.

43 Sony Corp. of America v. Universal City Studios, 464 U.S. 417 (1984).

rap group 2 Live Crew, wrote a song entitled "Pretty Woman," which was intended, "through comical lyrics, to satirize the original work."[44] The manager of 2 Live Crew wrote to Acuff-Rose offering to pay a license fee for the use of the original song, but Acuff-Rose refused permission. Nonetheless, 2 Live Crew proceeded to release records, cassette tapes, and compact discs of the parody song "Pretty Woman" in a collection of songs entitled *As Clean As They Wanna Be*. The albums and compact discs identify the authors of "Pretty Woman" as Orbison and Dees and its publisher as Acuff-Rose. Almost a year later, after nearly a quarter of a million copies of the recording had been sold, Acuff-Rose sued 2 Live Crew and its record company for copyright infringement. The district court granted summary judgment for 2 Live Crew on the ground of fair use and held that 2 Live Crew's version was a parody that "quickly degenerates into a play on words, substituting predictable lyrics with shocking ones" to show "how bland and banal the Orbison song" is. The court also found that 2 Live Crew had taken no more of the original than was necessary to "conjure up" the original in order to parody it, and that it was "extremely unlikely that 2 Live Crew's song could adversely affect the market for the original."[45] The Court of Appeals for the Sixth Circuit reversed and remanded, observing that the district court had put too little emphasis on the fact that "every commercial use . . . is presumptively . . . unfair,"[46] and that the effect on the potential market for the original (and the market for derivative works) is "undoubtedly the single most important element of fair use."[47]

On appeal to the Supreme Court, Justice Souter, writing for a unanimous court, examined the legislative history of 17 U.S.C. § 101 and concluded that the first factor in a fair use inquiry—"the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes"—should be examined with reference to its transformative nature in

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[44] *Campbell*, 510 U.S. at 572 (citing App. to Pet. for Cert. 80a).

[45] Acuff-Rose Music, Inc. v. Campbell, 754 F. Supp. 1150, 1154–55, 1157–58 (M.D. Tenn. 1991).

[46] *Sony Corp. of America*, 464 U.S. at 451.

[47] *Harper & Row*, 471 U.S at 566.

the manner that Pierre Leval has argued in his 1990 law review article. Justice Souter held:

> The central purpose of this investigation is to see . . . whether the new work merely "supersede[s] the objects" of the original creation ("supplanting" the original), or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is "transformative."[48]

More emphatically, Justice Souter laid the groundwork for the transformative use doctrine—especially for commercial parodies, appropriation art, and fan communities—to flourish over the next two decades:

> [T]he goal of copyright, to promote science and the arts, is generally furthered by the creation of transformative works. Such works thus lie at the heart of the fair use doctrine's guarantee of breathing space within the confines of copyright, . . . and the more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use.[49]

In response to the *Campbell* decision, Pierre Leval hailed Justice Souter's opinion as "perceptive and profound" and was delighted that it had "restored order and good sense to fair use"[50]; he also believed that it was "the finest opinion ever written on the subject of fair use."[51] In particular, Leval thought it was important that the Souter opinion "kills the canard that commercial use is presumptively unfair."[52] Although the *Campbell* decision downplayed the commerciality of the infringing use and directed the inquiry to the transformativeness of secondary work, it nevertheless

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[48] *Campbell*, 510 U.S. at 579 (citing Leval, *supra* note 28, at 1111 (internal citations omitted)).

[49] *Id.*

[50] Pierre N. Leval, *Nimmer Lecture: Fair Use Rescued*, 44 UCLA L. REV. 1449, 1451 (1997).

[51] *Id.* at 1464.

[52] *Id.*

generated tremendous confusion in respect of the application of the transformative use doctrine to parodic and satirical works. Unfortunately, the Supreme Court only provided one concrete example of a sufficiently transformative use that would clearly lead to a fair use determination, that of parody. Justice Souter usefully suggested that the "threshold question when fair use is raised in defense of parody is whether a parodic character may reasonably be perceived."[53] Regarding the "Pretty Woman" song in dispute, Justice Souter conceded that it would not be "assign[ed] a high rank to the parodic element here," but found that 2 Live Crew's song "reasonably could be perceived as commenting on the original or criticizing it, to some degree."[54]

Over the years, lower courts have bluntly asserted that because a parody targets and comments on the original work, it is therefore transformative; on the other hand, a satire uses the original work as a weapon to comment on something else and is thus not transformative.[55] But the *Campbell* court did not state that in order for a use to be transformative it must always comment on the original. Justice Souter explained that "[p]arody 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."[56]

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[53] *Campbell*, 510 U.S. at 582.

[54] *Id.* at 583. Justice Souter was of the view that:

> 2 Live Crew juxtaposes the romantic musings of a man whose fantasy comes true, with degrading taunts, a bawdy demand for sex, and a sigh of relief from paternal responsibility. The later words can be taken as a comment on the naiveté of the original of an earlier day, as a rejection of its sentiment that ignores the ugliness of street life and the debasement that it signifies.

Id.

[55] *See, e.g.*, Dr. Seuss Enters. L.P. v. Penguin Books USA, Inc., 109 F.3d 1394, 1401 (9th Cir. 1997) ("It is the rule in this Circuit that though the satire need not be only of the copied work and may . . . also be a parody 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.").

[56] *Campbell*, 510 U.S. at 580–81. Justice Souter also commented that "parody often shades into satire when society is lampooned through its creative artifacts, or that a work may contain both parodic and nonparodic elements." *Id.* at 581.

In a footnote, the Court clarified that:

> *[W]hen there is little or no risk of market substitution*, whether *because of the large extent of transformation of the earlier work*, the new work's minimal distribution in the market, the small extent to which it borrows from an original, or other factors, *taking parodic aim at an original is a less critical factor in the analysis*, and looser forms of parody may be found to be fair use, as may satire with lesser justification for the borrowing than would otherwise be required.[57]

This suggests that the degree or extent of transformation is the salient feature of the first factor of fair use regardless of whether the secondary use is classified as a parody, satire, or something else.

With respect to the first factor of fair use, this approach requires courts to examine the "purpose and character of the use," but neither "purpose" nor "character" is defined in the statute. Courts therefore may consider a kaleidoscope of relevant factors like what kind of transformation is present in the secondary work, the track record of the author of the secondary work, the extent of commentary or criticism present in the secondary work, the significance of the secondary use to research or study, as well as its public benefit.[58] Indeed, the transformative use doctrine in the first factor of fair use is a difficult one to elucidate. The phrase "the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes" suggests that (a) a change in the purpose of the secondary infringing work vis-à-vis the original work (i.e., from entertaining to educational) or a change in character (i.e., change in context or style) is transformative; (b) such changes should be considered in the light of the commerciality of the secondary infringing work, although this examination overlaps with the fourth factor on market impact; and (c) whether the secondary infringing work serves a commercial or nonprofit purpose, is a separate consideration from the "pur-

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[57] *Id.* at 580 n.14 (emphasis added).

[58] *See* U.S. CONST. art. I, § 8, cl. 8 ("To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.").

pose and character of the use." Courts do not usually observe a strict distinction between "purpose" and "character," preferring to assess whether the secondary work was sufficiently transformative according to the guidelines laid down by the Supreme Court in *Campbell*.

C. The Ascendancy of Transformative Use from 1994–2015

The transformative use test has become the defining standard for fair use, and it has risen to the top of the agenda of the copyright academic community in the United States in the last five years.[59] Jane Ginsburg, in her review of the most significant developments in copyright law in the period 1992–2012, concludes that the last twenty years have marked the "extraordinary expansion" of the fair use doctrine, and in particular, the concept of transformative use, with recent cases demonstrating a shift from focusing on finding a "transformative work" to discovering a "transformative purpose."[60]At least four empirical studies of United States fair use case law offer valuable insights to the transformative use doctrine.

Barton Beebe's pioneering empirical study of fair use decisions in the United States, which covered judicial opinions from 1978 to 2005,[61] and Matthew Sag's statistical analysis, which focused on the ex ante predictability of fair use based on 280 fair use cases decided between 1978 and 2011,[62] affirm the important role that transformative use—a judicial inquiry in the first statutory factor of the fair use inquiry when examining the "the purpose and character of the use"—plays in the evaluation of fair use. Beebe observed:

> [I]n those opinions in which transformativeness did play a role, it exerted nearly dispositive force not

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[59] *See, e.g.*, Matthew D. Bunker & Clay Calvert, *The Jurisprudence of Transformation: Intellectual Incoherence and Doctrinal Murkiness Twenty Years after* Campbell v. Acuff-Rose Music, 12 DUKE L. & TECH. REV. 92 (2014); Michael D. Murray, *What is Transformative? An Explanatory Synthesis of the Convergence of Transformation and Predominant Purpose in Copyright Fair Use Law*, 11 CHI.-KENT J. INTELL. PROP. 260 (2012).

[60] Jane C. Ginsburg, *Copyright 1992–2012: The Most Significant Development?*, 23 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 465, 487–89 (2013).

[61] Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978–2005*, 156 U. PA. L. REV. 549 (2008).

[62] Matthew Sag, *Predicting Fair Use*, 73 OHIO ST. L.J. 47 (2012).

> simply on the outcome of factor one but on the overall outcome of the fair use test. More specifically, the data suggest that while a finding of transformativeness is not necessary to trigger an overall finding of fair use, it is sufficient to do so.[63]

While courts have not demonstrated an overriding desire to find transformativeness in the cases before them, Beebe concludes that based on the regression analysis, if a use were found to be transformative, the defendant's chance of winning the fair use defense would be 94.9%.[64] Sag more confidently asserts that the evidence "confirms the centrality of transformative use" and when "[m]easured in terms of the variable Creativity Shift, it appears that transformative use by the defendant is a robust predictor of a finding of fair use."[65] Sag also concludes that an assessment of transformativeness is "not merely a question of the degree of difference between two works; rather, it requires a judgment of the motivation and meaning of those differences."[66]

However, it is Neil Netanel's study of U.S. district and circuit court cases decided between 2006 and 2010 that is more conclusive that "the transformative use paradigm ascended to its overwhelmingly predominant position only after 2005, following the period that Beebe studied."[67] Although courts have repeatedly asserted that a secondary use need not be transformative in order to be a fair use, and that transformativeness as encapsulated in the first statutory fair use factor is merely a part, albeit a central part, of the fair use inquiry, Netanel's data reveals that there is certainly a strikingly high correlation between judicial findings regarding transformativeness and fair use outcomes.[68] The leading cases also "make

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63 Beebe, *supra* note 61, at 605.

64 *Id.* at 606.

65 Sag, *supra* note 62, at 84.

66 *Id.* at 56.

67 Neil Weinstock Netanel, *Making Sense of Fair Use*, 15 LEWIS & CLARK L. REV. 715, 734 (2011).

68 *Id.* at 742. Twenty of the twenty-two opinions that found the defendant's use to be "highly," "certainly," or "significantly" transformative, or just simply "transformative," held that the defendant had engaged in fair use. All but three cases that characterized the secondary use in question as non-transformative, or only "minimally," "partly," or "somewhat" transformative, found no fair use. *Id.* at 740–41.

quite clear that, in effect, if the first factor favors fair use, that will trump the fourth factor."[69]

Finally, Michael Murray's explanatory synthesis methodology, a process of induction of principles of interpretation and application concerning the prevailing rules governing a specific legal issue, has been applied to the entire body of copyright fair use case law from the U.S. Circuit Courts of Appeals since 1994.[70] His study revealed that "placing [existing copyrighted work] in a new context so as to change the *predominant purpose and function* of the original material is transformative."[71] In Murray's explanatory synthesis of decisions rendered by the U.S. Circuit Courts of Appeals, he concludes:

> A change in context for an artistic work even without any changes to the content of the work may be sufficient if the predominant purpose and function of the new work is sufficiently different from the original work *and* fulfills one of the [principal] goals of the copyright laws.[72]

Although *Campbell* involved parody, where the rap group 2 Live Crew directly commented on the original "Oh, Pretty Woman" song by Roy Orbison, the Supreme Court did not hold or even suggest that transformativeness is limited to new works that parody the original or comment on it directly. In *Campbell*, the Court observed that section 107 "employs the terms 'including' and 'such as' in the preamble paragraph to indicate the 'illustrative and not limitative' function of the examples given, which thus provide only general guidance about the sorts of copying that courts and Congress most commonly had found to be fair uses."[73] It is clear that if Congress had intended to impose a requirement that all secondary

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[69] *Id.* at 743. This is likely to be a result of the conclusion that if a secondary use is unequivocally transformative, then, by definition, it causes no market harm to or has market substitution for the original work. Perhaps more controversially, Sag surmises that the near-perfect correlation between judicial findings on the fourth factor and fair use case outcomes must mean that the fourth factor is not really an independent variable in judges' fair use analysis. *See* Sag, *supra* note 62, at 63–64.

[70] Murray, *supra* note 59.

[71] *Id.* at 276 (emphasis added).

[72] *Id.* at 279.

[73] Campbell v. Acuff-Music, Inc., 510 U.S. 569, 577–78 (1994).

works must comment, it would have done so by adding a comment requirement as a conjunctive element, or by exclusively providing that only those activities listed in section 107 can qualify as fair use.

Most of the Circuit Court decisions in the last decade on fair use have hailed from the Second and Ninth Circuits, with a handful from the Federal,[74] First,[75] Third,[76] Fourth,[77] Tenth,[78] Seventh,[79] and Eleventh[80] Circuits, and virtually nothing of note from the Fifth, Sixth, and Eighth Circuits. The Second Circuit has considered a broader examination of transformation that does not require the presence of comment so long as the purpose in using the original work is "plainly different from the original purpose for which [it was] created"[81] and have "given weight to an artist's own explanation of their creative rationale when conducting the fair use analysis."[82] The Second Circuit found in *Blanch v. Koons* that Jeff Koons' use of Andrea Blanch's photograph to be transformative even though he was not commenting on the underlying work but using the original image "as fodder for his commentary on the social and aesthetic consequences of mass media."[83] The court expressly "disagree[d] with the suggestion that comment or criticism" is required to show transformative use,[84] and emphasized

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[74] *See, e.g.*, Oracle Am., Inc. v. Google, Inc., 750 F.3d 1339 (Fed. Cir. 2014).

[75] *See, e.g.*, Soc'y of Holy Transfiguration Monastery, Inc. v. Gregory, 689 F.3d 29 (1st Cir. 2012).

[76] *See, e.g.*, Murphy v. Millennium Radio Grp. LLC, 650 F.3d 295 (3d Cir. 2011).

[77] *See, e.g.*, Bouchat v. Balt. Ravens Ltd. P'ship, 737 F.3d 932 (4th Cir. 2013); A.V. *ex rel* Vanderhye v. iParadigms LLC, 562 F.3d 630 (4th Cir. 2009).

[78] *See, e.g.*, Shell v. DeVries, No. 07-1086, 2007 WL 4269047, at *1 (10th Cir. Dec. 6, 2007).

[79] *See, e.g.*, Kienitz v. Sconnie Nation LLC, 766 F.3d 756 (7th Cir. 2014); Brownmark Films LLC v. Comedy Partners, 682 F.3d 687 (7th Cir. 2012).

[80] *See, e.g.*, Cambridge Univ. Press v. Patton, 769 F.3d 1232 (11th Cir. 2014); Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257 (11th Cir. 2001).

[81] Blanch v. Koons (*Koons II*), 467 F.3d 244, 252–53 (2d Cir. 2006); Bill Graham Archives v. Dorling Kindersley Ltd., 448 F.3d 605, 609 (2d Cir. 2006).

[82] Bourne Co. v. Twentieth Century Fox Film Corp., 602 F. Supp. 2d 499, 507–08 (S.D.N.Y. 2009) (citing *Koons II*, 467 F.3d at 255).

[83] *Koons II*, 467 F.3d at 253. It may be argued that *Rogers v. Koons (Koons I)*, is of limited precedential value as it was decided before *Campbell*, and there was no requirement in law for a secondary work to comment on the original work so long as the intent of the secondary author was to recode the original expression into entirely new expression with new messages. 960 F.2d 301 (2d Cir. 1992).

[84] *Bill Graham Archives*, 448 F.3d at 609.

that the inquiry should be whether the secondary work may be reasonably perceived to have a meaning, message, or purpose that is "separate and distinct" from the original,[85] consistent with the judgment in *Campbell*.[86]

The Fourth and Ninth Circuits have also rejected a narrow requirement of commenting or criticizing the original work in order to qualify as transformative use, directing the court instead to examine whether the infringing work has employed the copyrighted work in a different manner or for a different purpose from the original, thus transforming it.[87] Such a broader interpretation that focuses judicial inquiry on evaluating a change in purpose or change in character can better unify the transformative use analysis for expressive parodic, satirical, or critical works and non-expressive works in a technological medium like format- or time-shifting. Moreover, from the Ninth Circuit's decision in *Perfect 10 v. Amazon.com*,[88] it appears that in evaluating the first statutory factor, courts may be inclined to assess the extent of the "transformative nature" of the defendant's secondary use "in light of its public benefit," and weigh that against the defendant's "superseding and commercial uses."[89] These decisions, taking a more permissive view of fair use, have collectively resulted in allowing a significant amount of expressive works to be made available to the public.

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[85] *Id.*; *see also Koons II*, 467 F.3d at 252; Castle Rock Entm't, Inc. v. Carol Publ'g Grp., Inc., 150 F.3d 132, 142 (2d. Cir. 1998).

[86] Campbell v. Acuff-Music, Inc., 510 U.S. 569, 579 (1994); *see also* Swatch Grp. Mgmt. Servs. Ltd. v. Bloomberg LP, 742 F.3d 17, 28 (2d Cir. 2014) ("In the context of news reporting and analogous activities, moreover, the need to convey information to the public accurately may in some instances make it desirable and consonant with copyright law for a defendant to faithfully reproduce an original work rather than transform it. In such cases, courts often find transformation by emphasizing the altered purpose or context of the work, as evidenced by surrounding commentary or criticism.").

[87] *See, e.g.*, Bouchat v. Balt. Ravens Ltd. P'ship, 619 F.3d 932, 301 (4th Cir. 2010); A.V. *ex rel.* Vanderhye v. iParadigms, LLC, 562 F.3d 630, 638 (4th Cir. 2009); Perfect 10, Inc. v. Amazon.com, Inc., 508 F.3d 1146, 1165 (9th Cir. 2007); Kelly v. Arriba Soft Corp., 336 F.3d 811, 819 (9th Cir. 2003).

[88] *Perfect 10*, 508 F.3d at 1165.

[89] *Id.* at 1166.

The transformative use doctrine, as consistently articulated by the Second Circuit for over a decade, was succinctly stated by the court in 2013:

> If the secondary use adds value to the original—if [the original work] 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.[90]

This formulation was lifted verbatim from Leval's 1990 article.[91] The Second Circuit did not require the secondary work to comment on the original work or on the original author/artist, so long as a transformative nature may "reasonably be perceived."[92] This approach is consistent with the Supreme Court's holding in *Campbell* that the 2 Live Crew version of "Pretty Woman" could "reasonably be perceived as commenting on the original or criticizing it, to some degree" because "2 Live Crew juxtaposes the romantic musings of a man whose fantasy comes true, with degrading taunts, a bawdy demand for sex, and a sigh of relief from paternal responsibility."[93] More importantly, the Ninth Circuit aligned itself with the Second Circuit in adopting Leval's formulation—whether "the quoted matter is used as raw material, transformed in the creation of new information, new aesthetics, new insights and understandings"—in *Seltzer v. Green Day* in 2013.[94] All Circuit Courts have either directly cited the Leval formulation, *Campbell*, or the Second Circuit's 1998 decision of *Castle Rock Entertainment, Inc. v. Carol Publishing Group, Inc.* as authority for the evaluation of fair use. Generally, courts have found a transformative purpose both where the defendant combines copyrighted expression with

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90 Cariou v. Prince, 714 F.3d 694, 706 (2d Cir. 2013) (quoting *Castle Rock*, 150 F.3d at 142); *see also Koons II*, 467 F.3d at 251–52. A recent decision of the Seventh Circuit was less enamored with this approach. *See* Kienitz v. Sconnie Nation LLC, 766 F.3d 756, 758 (7th Cir. 2014) ("We're skeptical of *Cariou*'s approach, because asking exclusively whether something is "transformative" not only replaces the list in [section] 107 but also could override 17 U.S.C. § 106(2), which protects derivative works.").

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

92 *Cariou*, 714 F.3d at 707.

93 Campbell v. Acuff-Music, Inc., 510 U.S. 569, 583 (1994).

94 Seltzer v. Green Day, 725 F.3d 1170, 1176 (9th Cir. 2013).

original expression to produce a new creative work, and where the defendant uses a copyrighted work in a different context to serve a different function than the original.[95] When an "allegedly infringing work is typically viewed as transformative as long as new expressive content or message is apparent" (Ninth Circuit),[96] or when "[w]hat is critical is how the work in question appears to the reasonable observer" (Second Circuit),[97] the effect of this modified Leval test of transformative use is highly protective of speech.

There are five broad categories of transformative uses that can be said to demonstrate a change in "purpose" or "character" as articulated in 17 U.S.C § 107. In summary, the following types of uses have been found to be transformative:

(1) Directly commenting on or criticizing the original work, or targeting the original work for ridicule or parody;[98]
(2) Using the original work to comment on something else or in a satire, but the secondary

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[95] Warner Bros. Entm't, Inc. v. RDR Books, 575 F. Supp. 2d 513, 541 (S.D.N.Y. 2008).

[96] *Seltzer*, 725 F.3d at 1177.

[97] *Cariou*, 714 F.3d at 707.

[98] *See Campbell*, 510 U.S. 569 (holding that the 2 Live Crew song can be taken as a comment on the naiveté of the original of an earlier day, as a rejection of its sentiment that ignores the ugliness of street life and the debasement that it signifies, and is therefore transformative); NXIVM Corp. v. Ross Inst., 364 F.3d 471 (2d Cir. 2006) (finding that analyses and critiques of course manuals are transformative); Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257 (11th Cir. 2001) (finding that, despite borrowing substantially from Margaret Mitchell's original novel, *The Wind Done Gone* was found to be a transformative use of *Gone With the Wind* as it is a direct critique of Mitchell's depiction of slavery and the Civil-War era American South); Leibovitz v. Paramount Pictures Corp., 137 F.3d 109 (2d Cir. 1998) (finding that the parody ad may reasonably be perceived as commenting on the seriousness, even the pretentiousness, of the original). *But see* Dr. Seuss Enters., L.P. v. Penguin Books, USA, Inc., 109 F.3d 1394 (9th Cir. 1997) (finding that a poetic account of the O.J. Simpson double-murder trial entitled *The Cat NOT in the Hat! A Parody by Dr. Juice* was not transformative as *The Cat in the Hat* is not conjured up by the focus on the Brown-Goldman murders or the O.J. Simpson trial); Salinger v. Colting, 641 F. Supp. 2d 250 (S.D.N.Y. 2009) (finding that a fictional novel recounting a meeting of *Catcher in the Rye*'s Holden Caulfield at the age of seventy-six with the author of that same book, J.D. Salinger, was a substantial copy of the original novel and was unlikely to constitute fair use).

work nonetheless contains some underlying critical relevance to the original work;[99]

(3) Recontextualizing the original work without modification but changing the meaning of the original work, often in an appropriation art context;[100]

(4) Changing the purpose of the original work within an expressive context (e.g., from entertainment to education or research);[101] and

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[99] *See Koons II*, 467 F.3d 244, 253 (2d Cir. 2006) (finding that the use of an already published photograph in a painting was transformative because it had an entirely different purpose and meaning); Mattel Inc., v. Walking Mountain Prods., 353 F.3d 792 (9th Cir. 2003) (finding that photographs portraying nude Barbie dolls juxtaposed with vintage kitchen appliances are transformative as they comment on Barbie's influence on gender roles and the position of women in society). It has also been argued that fan fiction and fan remix works belong in this category and should be protected as transformative fair use. *See generally* David Tan, *Harry Potter and the Transformation Wand: Fair Use, Canonicity and Fan Activity*, *in* AMATEUR MEDIA: SOCIAL, CULTURAL AND LEGAL PERSPECTIVES 94 (Dan Hunter et al. eds., 2012); Sonia Katyal, *Performance, Property, and the Slashing of Gender in Fan Fiction*, 14 AM. U.J. GENDER SOC. POL'Y & L., 461 (2006); Rachel L. Stroude, *Complimentary Creation: Protecting Fan Fiction as Fair Use*, 14 MARQ. INTELL. PROP. L. REV. 191 (2010).

[100] *See, e.g.*, Bill Graham Archives v. Dorling Kindersley Ltd., 448 F.3d 605 (2d Cir. 2006) (finding that the use of promotional posters in a rock biography was a purpose separate and distinct from the original artistic and promotional purpose for which the images were created, and was transformative). There is arguably an overlap between categories (c) and (d). Courts have yet to decide if appropriation art, in particular Sherrie Levine's rephotographs—where there is no modification to the original photograph, but there is a transformation in meaning between the original and the secondary work that may be reasonably perceived by the audience—qualify as transformative use. *See generally* JOHANNA BURTON & ELISABETH SUSSMAN, SHERRIE LEVINE: MAYHEM (2012); HOWARD SINGERMAN, ART HISTORY, AFTER SHERRIE LEVINE (Stephanie Fay et al. eds. 2011).

[101] This category overlaps with the next one. The courts usually focus on whether there was a change in purpose and whether there was significant public benefit to be gained from the secondary infringing use. *See, e.g.*, Perfect 10, Inc. v. Amazon.com Inc., 508 F.3d 1146 (9th Cir. 2007) (finding that the automated processing and display of thumbnails of copyrighted photos as part of a visual search engine was a change in purpose and transformative); Kelly v. Arriba Soft Corp., 336 F.3d 811 (9th Cir. 2003) (finding that, despite the fact that Arriba made exact replications of Kelly's images, the thumbnails served an entirely different function than Kelly's original images and the use of the images in the search engine was transformative); Warner Bros. Entm't, Inc. v. RDR Books, 575 F. Supp. 2d 513, 539 (S.D.N.Y. 2008) (finding that, even though the overall secondary work was found not to be consistently transformative, by "condensing, synthesizing, and reorganizing the preexisting material in an A-to-Z reference guide, the Lexicon does not recast the material in another medium to retell the story of *Harry Potter*,

(5) Changing the purpose of the original work within a technological context and with significant social benefit.[102]

The types of uses in categories (1) to (5) are not mutually exclusive and they often overlap.[103] For example, one may construe the secondary work, *The Wind Done Gone*, by Alice Randall as a change in character compared to *Gone With The Wind* (since it is a critical comment that sets out to "demystify [*Gone With The Wind*] and strip the romanticism from Mitchell's specific account of this period of our history"[104]), but not as a change in purpose (since both are novels that entertain). Alternatively, one may perceive *The Wind Done Gone* as being educational in purpose (since it is "principally and purposefully a critical statement that seeks to rebut and destroy the perspective, judgments, and mythology" of *Gone With The Wind*[105]), hence demonstrating a change in purpose. Indeed, the Eleventh Circuit intimated that categorization of a secondary

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but instead gives the copyrighted material another purpose"). More recently, the Second Circuit has unanimously held that "the purpose of Google's copying of the original copyrighted books is to make available significant information *about those books*, permitting a searcher to identify those that contain a word or term of interest, as well as those that do not include reference to it," and the search function and snippet views were therefore transformative. *See* Authors Guild v. Google, Inc., 804 F.3d 202, 217 (2d Cir. 2015).

[102] *See* Sony Corp. of America v. Universal City Studios, Inc., 464 U.S. 417 (holding that the manufacturer of a videocassette recorder was not liable for copyright infringement in part because consumer time-shifting of broadcast television for later viewing was transformative and was fair use); A.V. *ex rel.* Vanderhye v. iParadigms, LLC, 562 F.3d 630 (4th Cir. 2009) (finding that the automated processing of the plaintiff students' work in defendant's plagiarism detection software was transformative); Recording Indus. Ass'n of America v. Diamond Multimedia Sys., Inc., 180 F.3d 1072 (9th Cir. 1999) (strongly suggesting that transferring music from compact disc to MP3 for personal use would be fair use). *See also* Matthew Sag, *Copyright and Copy-Reliant Technology*, 103 NW. U.L. REV. 1607 (2009) (discussing the application of the fair use doctrine to automatic copying, data-processing, and other non-expressive uses).

[103] There have been several attempts to organize different fair uses into clusters or categories, but none of them have discovered or claimed to have discovered a comprehensive formula to explain or predict all fair use outcomes. *See, e.g.*, Michael J. Madison, *A Pattern-Oriented Approach to Fair Use*, 45 WM. & MARY L. REV. 1525 (2004); Pamela Samuelson, *Unbundling Fair Uses*, 77 FORDHAM L. REV. 2537 (2009).

[104] Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257, 1270 (11th Cir. 2001).

[105] *Id.*

work is not important for fair use analysis, and the focus ought to be on whether there was a change in purpose or character.[106]

The ascendancy of the transformative use doctrine, and in particular the modified Leval test embraced by the Second Circuit—whether the secondary work may reasonably be perceived to have transformed the original in the creation of new information, new aesthetics, new insights and understandings—that is fast gaining acceptance in numerous other Circuit Courts, has attracted a fair share of criticisms.[107] Matthew Bunker and Clay Calvert are especially concerned with how the *Campbell* court had, in a cursory manner, "turned the transformative use doctrine loose into copyright law, where it quickly became an enormously important, albeit undertheorized, component in lower court fair-use determinations."[108] They observed that "the Supreme Court has repeatedly held that fair use, along with the separation of facts and ideas from expression, obviates the need for First Amendment scrutiny of copyright law by providing an internal statutory safeguard for free-speech interests."[109] They also argued that this "doctrinal murkiness is particularly disturbing because fair use is a key proxy for free-expression interests in copyright law."[110] Bunker and Calvert identified three different ways in which courts since *Campbell* have conceptualized the transformative use doctrine—transformation as new insights, creative metamorphosis, and new purpose—and charged that not only are these multiple models of transformativeness incompatible, but they "create a disturbing First Amendment

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[106] *Id.* at 1274 n.27. Samuelson also argues that "makes little sense to organize the fair use caselaw around [categories]" and that one should focus on the three main underlying policies of "promoting free speech and expression interests of subsequent authors and the public, the ongoing progress of authorship, and learning." Samuelson, *supra* note 103, at 2544.

[107] *See, e.g.*, Thomas Cotter, *Transformative Use and Cognizable Harm*, 12 VAND. J. ENT. & TECH. L. 701 (2010); Kim J. Landsman, *Does* Cariou v. Prince *Represent the Apogee or Burn-out of Transformativeness in Fair Use Jurisprudence?*, 24 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 321 (2014); Kathleen K. Olson, *Transforming Fair Use Online: The Ninth Circuit's Productive-Use Analysis of Visual Search Engines*, 14 COMM. L. & POL'Y 153 (2009); Rebecca Tushnet, *Judges as Bad Reviewers: Fair Use and Epistemological Humility*, 25 LAW & LITERATURE 20 (2013).

[108] Bunker & Calvert, *supra* note 59, at 94–95.

[109] *Id.* at 95.

[110] *Id*.

chilling effect."[111] To the contrary, this Article argues that the rising prominence of the transformative use doctrine in copyright law today represents an inconscient drift into the territory of definitional balancing firmly in favor of First Amendment ideals, and the preponderance of decisions in recent years—finding transformativeness and fair use in cases involving satire and appropriation art—are very much protective of expressive interests.

II. THE FIRST AMENDMENT AND COPYRIGHT

It has been noted by free speech scholar Rodney Smolla that "[c]ontemporary free speech doctrines are extraordinarily detailed and often confusing" and that "[m]odern First Amendment law abounds in three-part and four-part tests of various kinds."[112] Similarly, Lillian BeVier expressed despair at how "First Amendment theories have multiplied, the case law has become ever more chaotic, and consensus on fundamental issues has remained elusive both on and off the Court,"[113] and Thomas McCarthy pointed out that the rules are "often maddeningly vague and unpredictable."[114] While it is not the purpose of this Article to propose a systematic reconciliation or reconstruction of the contentious doctrines and rules of the First Amendment, this Part argues that an instrumental understanding of the First Amendment is critical to a more

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[111] *Id.* at 126. This categorization is arguably accurate as the courts, in particular the Second Circuit, have used different formulations for different fact scenarios. Where appropriation art is concerned, like in *Cariou v. Prince* and *Seltzer v. Green Day*, the "new information, new aesthetics, new insights and understandings" test is used. In other scenarios, for instance where search engines are involved, the courts look for a "different purpose." *See, e.g.*, Authors Guild, Inc., v. Google, Inc., 804 F.3d 202 (2d Cir. 2015); Authors Guild, Inc., v. HathiTrust, 755 F.3d 87 (2d Cir. 2014). However, it has also been argued that behavioral studies suggest that clearer rules can induce even greater chilling effects. *See* Edmund T. Wang, *The Line Between Copyright and the First Amendment and Why Its Vagueness May Further Speech Interests*, 13 U. PA. J. CONST. LAW. 1471, 1484–98 (2011).

[112] RODNEY A. SMOLLA & MELVILLE B. NIMMER, SMOLLA AND NIMMER ON FREEDOM OF SPEECH: A TREATISE ON THE FIRST AMENDMENT § 2:13 (3d ed. 2008); *see also* Robert C. Post, *Reconciling Theory and Doctrine in First Amendment Jurisprudence*, 88 CALIF. L. REV. 2353, 2355 (2000).

[113] Lillian R. BeVier, *The First Amendment on the Tracks: Should Justice Breyer Be at the Switch?*, 89 MINN. L. REV. 1280, 1280 (2005).

[114] J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY § 8:9 (2d ed. 2015).

nuanced interpretation of the modified Leval test of transformative use as presently applied in copyright law.

A. Goals and Theories of the First Amendment

Courts are generally concerned that the enforcement of private rights, including intellectual property rights, does not have a "chilling effect"[115] on free speech. While earlier commentator writings have identified four separate values served by the First Amendment's protection of speech,[116] more recent scholarship has narrowed the theories for the First Amendment to three distinct yet interdependent goals: sponsoring enlightenment or the discovery of truth, self-fulfillment, and citizen participation in a deliberative democracy.[117] There are numerous writings by political philosophers and jurists advocating the protection of free speech principles, but this Article will not be revisiting the arguments by theorists such as John Stuart Mill, Alexander Meiklejohn, Thomas Emerson, and Ronald Dworkin.[118] Instead this Section will focus

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[115] Dombrowski v. Pfister, 380 U.S. 479, 487 (1965); *see also* ERIC BARENDT, FREEDOM OF SPEECH 38 (2d ed. 2005); FREDERICK SCHAUER, FREE SPEECH: A PHILOSOPHICAL ENQUIRY 80–85 (1982). The term "free speech" shall be taken to mean the freedom of speech and of the press as protected by the First Amendment. It is well-accepted that "in modern First Amendment jurisprudence the Press Clause has largely been subsumed into the Speech Clause." SMOLLA & NIMMER, *supra* note 112, §§ 22:6, 22:10, 22:18.

[116] *See* THOMAS I. EMERSON, THE SYSTEM OF FREEDOM OF EXPRESSION 6–7 (1970) ((1) "[A]ssuring individual self-fulfillment"; (2) "[A]dvancing knowledge and discovering truth"; (3) "[P]rovid[ing] for participation in decisionmaking by all members of society"; and (4) "[A]chieving a more adaptable and hence a more stable community . . . maintaining the precarious balance between healthy cleavage and necessary consensus.").

[117] Rodney Smolla argues that all three theories should be understood "not as *mutually exclusive* defenses of freedom of speech, but rather as *mutually supportive* rationales." SMOLLA & NIMMER, *supra* note 112, § 2:7. *See also* BARENDT, *supra* note 115, at 7–21; MCCARTHY, *supra* note 114, §§ 8:2–8:8; RODNEY A. SMOLLA, FREE SPEECH IN AN OPEN SOCIETY 14–17 (1992). There have been different variations of the goals advanced by the First Amendment, but they cover essentially the same themes. *See* Whitney v. California, 274 U.S. 357, 375 (1927) (Brandeis, J., concurring); C. EDWIN BAKER, HUMAN LIBERTY AND FREEDOM OF SPEECH 47 (1989); Martin H. Redish, *The Value of Free Speech*, 130 U. PA. L. REV. 591, 593 (1982).

[118] For an excellent review of such works, see BARENDT, *supra* note 115, at 1–36; SCHAUER, *supra* note 115, at 35–46. *See also* RONALD M. DWORKIN, FREEDOM'S LAW (1996); THOMAS I. EMERSON, TOWARD A GENERAL THEORY OF THE FIRST AMENDMENT (1966); ALEXANDER MEIKLEJOHN, FREE SPEECH AND ITS RELATION TO SELF-GOVERNMENT (1948); JOHN STUART MILL, ON LIBERTY AND OTHER ESSAYS (John Gray ed., 1998).

only on how the First Amendment is traditionally viewed as essential for the protection of speech from governmental regulation, and how the courts have determined a hierarchy of different types of speech with the highest protection accorded to political speech and a lower level of protection for commercial speech.

1. Discovery of Truth/Marketplace of Ideas

There is a wealth of literature on the truth-seeking function and the marketplace of ideas, and this Article will not seek to reconcile differing versions of it, but will only highlight the fundamental tenets and their relevance to copyright law. In its earlier conceptions, the First Amendment goal of enlightenment or the discovery of truth is represented most prominently by Oliver Wendell Holmes' theory of a "marketplace of ideas" expressed most forcefully in *Abrams v. United States*:

> But when men have realized that time has upset many fighting faiths, they may come to believe even more than they believe the very foundations of their own conduct that the ultimate good desired is better reached by free trade in ideas—that the best test of truth is the power of the thought to get itself accepted in the competition of the market, and that truth is the only ground upon which their wishes safely can be carried out. That at any rate is the theory of our Constitution.[119]

The marketplace theory is perhaps "the most famous and rhetorically resonant of all free speech theories,"[120] but it also exhibits a strong underlying democratic theory, evident in the oft-quoted phrase from *New York Times v. Sullivan* that there is a "profound national commitment" to the principle that "debate on public issues should be uninhibited, robust, and wide-open."[121] However, the First Amendment case law offers an important lesson: the Su-

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[119] Abrams v. United States, 250 U.S. 616, 630 (1919); *see also Whitney*, 274 U.S. at 375.

[120] SMOLLA & NIMMER, *supra* note 112, § 2:4.

[121] N.Y. Times Co. v. Sullivan, 376 U.S. 254, 270 (1964); *see also* Boos v. Barry, 485 U.S. 312, 318 (1988); NAACP v. Claiborne Hardware Co., 458 U.S. 886, 913 (1982). The democratic variant of the marketplace of ideas theory was first discussed in *Thornhill v. Alabama*, 310 U.S. 88, 96, 101–12 (1940).

preme Court's discussion of the relationship between truth, knowledge, and the First Amendment has been inconsistent. The Court sometimes posits that the discovery of truth within the marketplace of ideas is a vital justification for the First Amendment. At other times, however, it subordinates that rationale to other concerns, such as democratic legitimacy. It is worth noting that the truth-seeking justification, and its accompanying marketplace of ideas metaphor, have become far less influential in contemporary free speech scholarship, and "the free speech literature appears increasingly to have detached itself from the empirical and instrumental epistemic arguments made by Mill and others, focusing instead on the other justifications . . . such as arguments from democracy or autonomy."[122]

This "marketplace" model features most prominently in scenarios where state action is challenged, and is the cornerstone of the content discrimination doctrine that subjects governmental acts to judicial strict scrutiny.[123] It mandates that speakers should be free from government control or censorship, so that truth and falsehood may battle it out in public discourse. In *Texas v. Johnson*, the Supreme Court, in the plurality opinion, reiterated that "[i]f there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreea-

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[122] Paul Horwitz, *The First Amendment's Epistemological Problem*, 87 WASH. L. REV. 445, 453 (2012) (referring to Frederick Schauer, *Facts and the First Amendment*, 57 UCLA L. REV. 897, 909–10 (2010)).

[123] *See* Brown v. Entm't Merchants Ass'n, 131 S. Ct. 2729, 2733 (2011) (citing Ashcroft v. Am. Civil Liberties Union, 535 U.S. 564, 573 (2002)) ("As a general matter, the First Amendment means that government has no power to restrict expression because of its message, its ideas, its subject matter, or its content."); United States v. Playboy Entm't Grp., Inc., 529 U.S. 803, 818 (2000) ("It is rare that a regulation restricting speech because of its content will ever be permissible."); R.A.V. v. City of St. Paul, 505 U.S. 377, 387 (1992) (content discrimination "raises the specter that the Government may effectively drive certain ideas or viewpoints from the marketplace"). The Supreme Court has long held that regulations enacted for the purpose of or that have the effect of restraining speech on the basis of its content presumptively violate the First Amendment. On the other hand, so-called "content-neutral" time, place, and manner restrictions are acceptable so long as they are designed to serve a substantial governmental interest and do not unreasonably limit alternative avenues of communication. *See* Clark v. Cmty. for Creative Non-Violence, 468 U.S. 288, 293 (1984); Heffron v. Int'l Soc'y for Krishna Consciousness, Inc., 452 U.S. 640, 647–48 (1981).

ble."[124] The value of literature or the arts in the marketplace of ideas stems from its persuasive or analytic capabilities with respect to a particular idea or point of view, and the protection of expression is often limited to the audience's ability to understand or assimilate the underlying idea.[125]

In terms of its potential relevance to copyright law, the marketplace of ideas doctrine is usually more compatible with protection of visual expression that privileges political art, but the Supreme Court in *Hurley* importantly suggests that no particularized message, let alone a political one, is required for protection. Furthermore, Professor Alexander Meiklejohn, an original exponent of the marketplace theory, remarked, "the people do not need novels or dramas or paintings or poems, because they will be called upon to vote."[126]

2. Self-fulfillment Function/Individual Autonomy

In contrast, the self-fulfillment function or individual autonomy rationale shifts the attention from the ideas marketplace to individual dignity.[127] While the Supreme Court has acknowledged that "the human spirit . . . demands self-expression,"[128] there have been relatively few decisions discussing this as a central goal of the First Amendment.[129] This theory would potentially afford greater

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[124] Texas v. Johnson, 491 U.S. 397, 414 (1989). It is noted that "[e]very idea, no matter how misguided, and every speaker, no matter how ill-equipped, stands on equal footing." Horwitz, *supra* note 122, at 471.

[125] Genevieve Blake, *Expressive Merchandise and the First Amendment in Public Fora*, 34 FORDHAM URB. L.J. 1049, 1059 (2007).

[126] Alexander Meiklejohn, *The First Amendment is an Absolute*, 1961 SUP. CT. REV. 245, 263; Blake, *supra* note 125, at 1059.

[127] *See, e.g.*, C. Edwin Baker, *Scope of the First Amendment Freedom of Speech*, 5 UCLA L. REV. 964, 990–91 (1978); Blake, *supra* note 125, at 1081–83; David A.J. Richards, *Free Speech and Obscenity Law: Toward a Moral Theory of the First Amendment*, 123 U. PA. L. REV. 45, 62 (1974).

[128] Procunier v. Martinez, 416 U.S. 396, 427 (1974).

[129] *See* Cohen v. California, 403 U.S. 15, 26 (1971); Stanley v. Georgia, 394 U.S. 557, 565 (1969). For a useful discussion of this theory of the First Amendment, see Brian C. Murchison, *Speech and the Self-Realization Value*, 33 HARV. C.R.-C.L. L. REV. 443 (1998). There has also been much criticism that individual self-actualization or autonomy cannot provide a sound basis for the First Amendment. *See* Patrick M. Garry, *The First Amendment and Non-Political Speech: Exploring a Constitutional Model that Focuses on the Existence of Alternative Channels of Communication*, 72 MO. L. REV. 477, 514 (2007);

First Amendment protection to secondary expressive works that may reasonably be perceived to have created new information, aesthetics, insights, and understandings because it would eliminate the need for a particularized analysis of the author's message, focusing instead on the function of the expression with regard to the author's assertion of self in cultural space or other "extrarational value[s]."[130] Nevertheless, it has been argued that although this theory might regard a right to express personal beliefs and political attitudes as a reflection of what it means to be human, the exercise of free speech might also be of value to democracy in "leading to the development of more reflective and mature individuals and so benefitting society as a whole."[131]

3. Participatory Democracy & Distrust of Government

The Supreme Court has more recently embraced a "participatory theory of democracy"[132] that is concerned with the enlightenment of public decisionmaking in a democracy through enabling public access to information and promoting public discourse.[133] In *McCutcheon v. Federal Election Commission*, Chief Justice Roberts, delivering the plurality opinion, commented:

> The First Amendment "is designed and intended to remove governmental restraints from the arena of public discussion, putting the decision as to what views shall be voiced largely into the hands of each of us, . . . in the belief that no other approach

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Stanley Ingber, *Rediscovering the Communal Worth of Individual Rights: The First Amendment Institutional Contexts*, 69 TEX. L. REV. 1, 19 (1990).

[130] Marci A. Hamilton, *Art Speech*, 49 VAND. L. REV. 73, 110 (1996); Martin H. Redish, *The Value of Free Speech*, 130 U. PA. L. REV. 591, 604 (1982).

[131] Tom Campbell, *Rationales for Freedom of Communication*, *in* FREEDOM OF COMMUNICATION 33–34 (Tom Campbell & Wojciech Sadurski eds., 1994); *see also* BARENDT, *supra* note 115, at 13.

[132] *See* Post, *supra* note 112, at 2371; *see also* BARENDT, *supra* note 115, at 18–21; DWORKIN, *supra* note 118, at 15–26. Smolla refers to this as the "democratic self-governance" rationale. SMOLLA & NIMMER, *supra* note 112, § 2:28.

[133] *See, e.g.*, Virginia v. Black, 538 U.S. 343, 365 (2003); Reno v. Am. Civil Liberties Union, 521 U.S. 844, 885 (1997); Hustler Magazine, Inc. v. Falwell, 485 U.S. 46, 53 (1988); Va. Bd. of Pharmacy v. Va. Citizens Consumer Council, 425 U.S. 748, 765 (1976); *see also* King v. Fed. Bureau of Prisons, 415 F.3d 634, 637 (7th Cir. 2005); Prometheus Radio Project v. FCC, 373 F.3d 372, 435 (3d Cir. 2004); United States v. Rowlee, 899 F.2d 1275, 1278 (2d Cir. 1990).

> would comport with the premise of individual dignity and choice upon which our political system rests." . . . . [It] safeguards an individual's right to participate in the public debate . . . .[134]

This theory of participatory democracy has been viewed as drawing on elements of the other two theories: that the minorities in a representative democracy have the right to contribute to political debate as they may have better ideas than the majority, and that the right of individuals to dignity and self-fulfillment may be expressed through their engagement in public discourse. It has also been called the "most important theoretical approach to freedom of speech in the twentieth century."[135] Often known as the Madisonian ideal of deliberative democracy, different but related versions of this theory have been prominently championed by constitutional scholars like Robert Post,[136] Cass Sunstein,[137] and Jack Balkin.[138] Post believes that democratic self-government is the primary end of the First Amendment, arguing "[i]t is plain that within public discourse the value of democratic legitimation enjoys lexical priority."[139]

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[134] McCutcheon v. Fed. Election Comm'n, 134 S. Ct. 1434, 1448 (2014) (quoting *Cohen*, 403 U.S. at 24).

[135] Jack M. Balkin, *Digital Speech and Democratic Culture: A Theory of Freedom of Expression for the Information Society*, 79 N.Y.U. L. REV. 1, 28 (2004).

[136] *See* Post, *supra* note 112; Robert C. Post, *Meiklejohn's Mistake: Individual Autonomy and the Reform of Public Discourse*, 64 U. COLO. L. REV. 1109 (1993); Robert C. Post, *The Constitutional Concept of Public Discourse: Outrageous Opinion, Democratic Deliberation, and* Hustler Magazine v. Falwell, 103 HARV. L. REV. 601 (1990) [hereinafter Post, *Constitutional Concept*].

[137] *See* CASS R. SUNSTEIN, DEMOCRACY AND THE PROBLEM OF FREE SPEECH 17–23, 241–52 (1993) [hereinafter SUNSTEIN, PROBLEM OF FREE SPEECH]; CASS R. SUNSTEIN, DESIGNING DEMOCRACY: WHAT CONSTITUTIONS DO 6–9, 96–101, 239–43 (2001).

[138] Balkin argues that the purpose of free speech is to promote a "democratic culture" that is even broader than deliberation about public issues such that each individual has "a fair chance to participate in the production of culture, and in the development of the ideas and meanings that constitute them and the communities and subcommunities to which they belong." Balkin, *supra* note 135, at 4; *see also* Jack M. Balkin, *Populism and Progressivism as Constitutional Categories*, 104 YALE L.J. 1935, 1948–49 (1995).

[139] ROBERT C. POST, DEMOCRACY, EXPERTISE, AND ACADEMIC FREEDOM: A FIRST AMENDMENT JURISPRUDENCE FOR THE MODERN STATE 34 (2012).

The participatory theory is also supported by the more philosophical writings of Meiklejohn,[140] Dworkin,[141] and Owen Fiss.[142] Although the Supreme Court has never ruled that to qualify for the highest levels of constitutional protection speech must relate to self-government,[143] Justice Stephen Breyer, speaking in an extrajudicial capacity, has advocated an approach to constitutional adjudication centred on "active liberty" similar to Post's participatory theory.[144] An acceptance of the participatory theory has important implications for the continuing development of the transformative use doctrine in resolving the tension between free speech values and property rights when arguing fair use in a copyright infringement claim as it focuses on not an abstract notion of the quest for truth, but on how the nature and content of communication can "ensure that the individual can effectively participate in and contribute to our republican system of self-government"[145] where "national identity [is understood] to be endlessly controversial."[146] This democratic rationale of the First Amendment is usually intertwined with a deep distrust of government. In *United States v. Stevens*, Chief Justice Roberts commented, "[t]he First Amendment itself reflects a judgment by the American people that the benefits of its restrictions on the Government outweigh the costs. Our Constitution forecloses any attempt to revise that judgment simply on the basis that some speech is not worth it."[147] Similarly, in *Brown v. Entertainment Merchants Association*, Justice Scalia emphasized that "esthetic and moral judgments about art and literature . . . are for the individual to make, not for the Government to

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140 *See* ALEXANDER MEIKLEJOHN, POLITICAL FREEDOM: THE CONSTITUTIONAL POWERS OF THE PEOPLE 19–28 (1965).

141 *See* DWORKIN, *supra* note 118, at 15–26.

142 *See* Owen M. Fiss, *Free Speech and Social Structure*, 71 IOWA L. REV. 1405, 1409–10 (1986).

143 Garry, *supra* note 129, at 519; *see also* SMOLLA & NIMMER, *supra* note 112, § 2:46.

144 Stephen Breyer, *Our Democratic Constitution*, 77 N.Y.U. L. REV. 245, 246 (2002). The participatory theory also appears to have the support of Brian Murchison who, through an analysis of judgments of the Supreme Court, contends that the "self-governance value" underpins the First Amendment. *See* Brian C. Murchison, *Speech and the Self-Governance Value*, 14 WM. & MARY BILL RTS. J. 1251, 1291 (2006).

145 Globe Newspaper Co. v. Superior Court, 457 U.S. 596, 604 (1982).

146 Post, *supra* note 112, at 2369; *see also* BARENDT, *supra* note 115, at 48–49.

147 United States v. Stevens, 130 S. Ct. 1577, 1585 (2010).

decree, even with the mandate or approval of a majority."[148] The Supreme Court has never made an "official choice" among competing theories.[149] But "where the doctrinal implications of different prominent theories . . . collide, courts will tend to give priority to the participatory theory of democracy."[150] The implication is that an infringing work that contains some form of political speech that advances democratic debate should warrant heightened First Amendment protection, and this status should be acknowledged when evaluating the fair use defense.

B. Infringing Works Can Also Be Expressive Works

While this Section does not cover all the different kinds of transformative uses, it will attempt to show that in at least three categories of transformative uses—(1) to (3) as identified in Part I—First Amendment considerations are important in guiding the evaluation of transformative use to ensure that the end-result advances not only the goals of the Copyright Clause, but also those of the Free Speech Clause.[151] Such uses tend to comment on or present a different way of viewing familiar iconography, societal archetypes, public obsessions, and majoritarian beliefs, and, as such, they fall within the First Amendment categories of protected speech, such as political speech, art, entertainment, and matters of public interest.

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[148] Brown v. Entm't Merchants Ass'n, 131 S. Ct. 2729, 2733 (2011); *see also* Playboy Entm't Grp, Inc., 529 U.S. 803, 818 (2000).

[149] Cass R. Sunstein, Foreward, *The Supreme Court, 1995 Term: Leaving Things Undecided*, 110 HARV. L. REV. 4, 13 (1996).

[150] Post, *supra* note 112, at 2371; *see also* Richard H. Fallon, Jr., *How to Choose a Constitutional Theory*, 87 CALIF. L. REV. 535, 577–78 (1999). According to Frederick Schauer, the "narrowness of the argument from democracy is also its greatest strength . . . it does furnish several strong reasons for giving special attention and protection to political speech." SCHAUER, *supra* note 115, at 44. It is noted that the opposition to the participatory theory comes most strongly from those who argue from a position of individual autonomy. *See* C. Edwin Baker, *Harm, Liberty and Free Speech*, 70 S. CAL. L. REV. 979, 981 (1997); David Strauss, *Persuasion, Autonomy and Freedom of Expression*, 91 COLUM. L. REV. 334, 354–55 (1991).

[151] It should be noted that Rebecca Tushnet has previously presented a complementary analysis of how copying often has substantial speech value, and how pervasive copying may be necessary to convey a persuasive message or to participate in a group's activities. Rebecca Tushnet, *Copy this Essay: How Fair Use Doctrine Harms Free Speech and Copying Saves It*, 114 YALE L.J. 535 (2004).

A parody must invoke or copy a significant proportion of the original copyrighted work in order for the parody to be effective; it will invariably satisfy the substantial similarity test for copyright infringement. The question that follows is whether the parody can nevertheless claim to be fair use. Parody enjoys an exalted protected status in intellectual property jurisprudence. The First Circuit Court of Appeals described parody as "a humorous form of social commentary and literary criticism . . . [that] seeks to ridicule sacred verities and prevailing mores,"[152] thus implicating First Amendment concerns. The Second Circuit noted "the broad scope permitted parody in First Amendment Law,"[153] and that "in today's world of unrelieved solemnity, copyright law should be hospitable to the humor of parody."[154] In a more rigorous examination of the First Amendment's influence on the fair use defense, the Ninth Circuit Court of Appeals has more overtly considered the status of parody under the Free Speech Clause in *Mattel v. Walking Mountain Productions.*[155] The court was of the view that parody has "socially significant value as free speech under the First Amendment."[156] More importantly, the court ruled that while individuals may disagree on the success or extent of a parody, parodic elements that may "reasonably be perceived" in a work will often justify fair use protection.[157] Parody may thus be seen as contributing valuable commentary and criticism to the marketplace of ideas, or advancing democratic debate on matters of public interest through the use of irreverent humor.

In *Campbell*, the Supreme Court underscored the importance of protecting parody as fair use, but did not explicitly refer to the First Amendment. Justice Souter merely asserted that "parody has an obvious claim to transformative value."[158] In *Hustler Magazine v. Falwell*, where Jerry Falwell sued Hustler Magazine alleging that the publisher had intentionally inflicted emotional distress on him

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[152] L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 28 (1st Cir. 1987).

[153] Groucho Marx Prods. v. Day & Night Co., 689 F.2d 317, 319 n.2 (2d Cir. 1982).

[154] Elsmere Music v. Nat'l Broad. Co., 623 F.2d 252, 253 (2d Cir. 1980).

[155] Mattel Inc. v. Walking Mountain Prods., 353 F.3d 792, 801 (9th Cir. 2003).

[156] *Id.* (quoting Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc., 109 F.3d 1394, 1400 (9th Cir. 1997)).

[157] *Id.*

[158] Campbell v. Acuff-Music, Inc., 510 U.S. 569, 579 (1994).

through a parody advertisement depicting him as drunk, immoral, and hypocritical, the Supreme Court reiterated that:

> At the heart of the First Amendment is the recognition of the fundamental importance of the free flow of ideas and opinions on matters of public interest and concern. "[T]he freedom to speak one's mind is not only an aspect of individual liberty—and thus a good unto itself—but also is essential to the common quest for truth and the vitality of society as a whole."[159]

Although the case concerned offensive political cartoons and vulgar caricatures of public figures, Chief Justice Rehnquist's concerns about stifling political discourse comports with prevailing judicial sentiments about the importance of parody (defined broadly).[160]

While the critical message in a parody that comments directly on the original work or its author can be easily discerned, the ideas expressed in other forms of artistic works may be more obtuse. The famous comment by the Supreme Court in *Hurley* that "a narrow, succinctly articulable message is not a condition of constitutional protection"[161] appears to have been implicitly subsumed within the modified Leval test—*whether the secondary work may reasonably be perceived to have transformed the original in the creation of new information, new aesthetics, new insights and understandings*—that presently holds sway over the Second and Ninth Circuits. This broader approach to transformative use allows for uses of the original work that do not comment on the original or may not even have a critical bearing on the original, so long as the original has been used in the creation of something *new*. From the perspective of the First Amendment, this new creation inevitably adds to the marketplace of ideas, and certain situations can stimulate political discourse or discussion of public issues. The protection of speech—which gen-

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[159] Hustler Magazine, Inc. v. Falwell, 485 U.S. 46, 50–51 (1987) (quoting Bose Corp. v. Consumers Union of U.S., Inc., 466 U.S. 485, 503–04 (1984)).

[160] *Id.* at 51–55.

[161] Hurley v. Irish-Am., Lesbian & Bisexual Grp. of Bos., 515 U.S. 557, 569 (1995).

erally includes symbolic or expressive conduct[162]—by the First Amendment depends on its position in a hierarchy of protectable speech, the applicable level of scrutiny of the governmental action, and the nature of the other rights it is in conflict with.[163] However, the Supreme Court has not established "a clear theory to explain why and when speech qualifies for the top tier,"[164] with the plurality opinion in *Dun & Bradstreet v. Greenmoss Builders* conceding that the inquiry "must be determined by [the expression's] content, form and context."[165] In *Brown v. Entertainment Merchants Association*, Justice Scalia, delivering the majority judgment, emphasized:

> The Free Speech Clause exists principally to protect discourse on public matters, but we have long recognized that it is difficult to distinguish politics from entertainment, and dangerous to try. "Everyone is familiar with instances of propaganda through fiction. What is one man's amusement, teaches another's doctrine."[166]

In *National Endowment for the Arts v. Finley*, Justice Souter commented that the "constitutional protection of artistic works turns not on the political significance that may be attributable to such productions, though they may indeed comment on the political, but simply on their expressive character, which falls within a spectrum of protected 'speech' extending outward from the core of overtly political declarations."[167] From the First Amendment perspective, art has the potential to "affect public attitudes and behavior in a variety of ways, ranging from direct espousal of a political or social doctrine to the subtle shaping of thought which characterizes all artistic expression."[168] Hence, when appropriation art

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[162] *See* R.A.V. v. City of St. Paul, 505 U.S. 377, 382 (1992) (cross-burning); Texas v. Johnson, 491 U.S. 397, 405–06 (1989) (flag-burning); Tinker v. Des Moines Indep. Cmty. Sch. Dist., 393 U.S. 503, 505 (1969) (wearing black armbands); Ayres v. City of Chicago, 125 F.3d 1010 (7th Cir. 1997) (wearing t-shirts).

[163] BARENDT, *supra* note 115, at 75; *see also* SCHAUER, *supra* note 115, at 89–92; William Van Alstyne, *A Graphic Review of the Free Speech Clause*, 70 CALIF. L. REV. 107 (1982).

[164] SUNSTEIN, PROBLEM OF FREE SPEECH, *supra* note 137, at 11.

[165] Dun & Bradstreet v. Greenmoss Builders, Inc., 472 U.S. 749, 761 (1985).

[166] Brown v. Entm't Merchants Ass'n, 131 S. Ct. 2729, 2733 (2011) (quoting Winters v. New York, 333 U.S. 507, 510 (1948)).

[167] Nat'l Endowment for the Arts v. Finley, 524 U.S. 569, 602–03 (1998).

[168] Joseph Burstyn, Inc. v. Wilson, 343 U.S. 495, 501 (1952).

is found to infringe the copyright in an original antecedent work that is used as a referential device, there is a clash of two sets of expressive interests. The attempt to resolve this conflict through a simplistic invocation of the transformative use doctrine in the fair use defense—as evident in *Blanch v. Koons* and *Cariou v. Prince*—sidesteps the important First Amendment considerations of whether the secondary artistic use espouses a particular political viewpoint or a different social shaping of thought that would allow it to trump the right of the original author.

Appropriation art, as a genre of contemporary art, is often an ideological critique that takes or hijacks "dominant words and images to create insubordinate, counter messages."[169] Appropriation art has been defined as "[t]he practice or technique of reworking the images or styles contained in earlier works of art, esp[ecially] (in later use) in order to provoke critical re-evaluation of well-known pieces by presenting them in new contexts, or to challenge notions of individual creativity or authenticity in art."[170] It is identified closely with the practice of "recoding" or "a shift in meaning" which occurs purely due to the fact that an original word, image, or object has been appropriated.[171] The Second Circuit recognized the genre of appropriation art as a "tradition [which] 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. An example is Andy Warhol's reproduction of multiple images of Campbell's soup cans."[172]

In *Rogers v. Koons* ("*Koons I*"), although the Second Circuit thought that Jeff Koons' earlier work of a stainless steel casting of an inflatable rabbit holding a carrot belonged to this genre,[173] it found Koons' sculpture, *String of Puppies*, which was based on Art Rogers' photograph, *Puppies*, displayed at an art gallery, to be in-

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[169] David Evans, *Introduction: Seven Types of Appropriation*, *in* APPROPRIATION 12, 13 (2009); *see also* E. Kenly Ames, *Beyond* Rogers v. Koons*: A Fair Use Standard for Appropriation*, 93 COLUM. L. REV. 1473 (1993).

[170] Emily Meyers, *Art on Ice: The Chilling Effect of Copyright on Artistic Expression*, 30 COLUM. J.L. & ARTS 219, 220 (2007).

[171] Isabelle Graw, *Fascination, Subversion and Dispossession in Appropriation Art*, *in* APPROPRIATION, *supra* note 169, at 214.

[172] *Koons I*, 960 F.2d 301, 304 (2d Cir. 1992).

[173] *Id.*

sufficiently transformative and hence infringing the copyright in the original photograph *Puppies* on which the sculpture was based. True to the tradition of appropriation art, there must exist a significant degree of exact reproduction of the original object (i.e, Warhol's reverential treatment of the Campbell's soup cans) in order for the artist to convey his or her comment or criticism of a particular cultural or social phenomenon. It may be just a subtle shift in context, medium, motif or style which delivers that postmodern critique. In *Koons I*, it is arguable that Koons did just that. He wanted every feature of the photograph by Art Rogers of a typical American scene—a smiling husband and wife holding a litter of eight charming puppies—copied faithfully in the sculpture.[174] The minutiae of Koons' craft itself is a critical commentary of the meticulous obsession of the media with, and the general interest of the public in, banality. The court accepted Koons' argument that he had drawn upon "the artistic movements of Cubism and Dadaism, with particular influence attributed to Marcel Duchamp, who in 1913 became the first to incorporate manufactured objects (readymades) into a work of art, directly influencing Koons' work and the work of other contemporary American artists."[175] The court also agreed that Koons:

> [B]elongs to the school of American artists who believe the mass production of commodities and media images has caused a deterioration in the quality of society, and this artistic tradition of which he is a member proposes through incorporating these images into works of art to comment critically both on the incorporated object and the political and economic system that created it.[176]

But the Second Circuit's issue with Koons was that he failed to comment critically on the original photograph that was incorporated into his work. Decided before the Supreme Court's landmark decision on fair use in *Campbell* in 1994, the court in *Koons I* found

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[174] *Id.* at 305, 307; *see also* Campbell v. Koons, No. 91 CIV. 6055 (RO), 1993 WL 97381, at *1 (S.D.N.Y. Apr. 1, 1993) (holding that Jeff Koons' sculpture "Ushering in Banality," based on Barbara Campbell's photograph "Boys with Pig," was not a fair use).

[175] *Koons I*, 960 F.2d at 311.

[176] *Id.*

against Koons, noting that "even given that *String of Puppies* is a satirical critique of our materialistic society, it is difficult to discern any parody of the photograph *Puppies* itself."[177]

However, post-*Campbell*, and fourteen years after *Koons I* was handed down, Jeff Koons was back before the Second Circuit again, but this time, the result was in his favor, despite the absence of parody. In *Koons II*, the court demonstrated a greater willingness to embrace appropriation art and its postmodernist technique of recontextualizing or repurposing objects and images in mainstream media or familiar to the public at large. The decision resonates with the Supreme Court's willingness to protect artistic expression as demonstrated in *Hurley* and *Finley*, where the First Amendment was explicitly considered. Koons' use of Andrea Blanch's photograph *Silk Sandals by Gucci* published in a fashion magazine for his collage *Niagara*—one of the artworks in the *Easyfun-Ethereal* series exhibited at the Deutsche Guggenheim Berlin—was held to be transformative.[178] Koons did not intend to parody or comment on the original Blanch photograph; but he claimed that he created the painting to "comment on the ways in which some of our most basic appetites—for food, play and sex—are mediated by popular images."[179] He also intended to "compel the viewer to break out of the conventional way of experiencing a particular appetite as mediated by mass media,"[180] and he used Blanch's photograph because it represented "a particular type of woman frequently presented in advertising" and that this typicality "further[ed] his purpose of commenting on the commercial images . . . in our consumer culture."[181] The Second Circuit applied the modified Leval test and found sufficient transformation to qualify Koons for the fair use defense.

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[177] *Id.* Relying on *Koons I*, the New York district court also found against Koons when United Feature Syndicate sued Koons for copyright infringement in his sculptural work "Wild Boy and Puppy" that featured the Odie cartoon dog character from the *Garfield* series. Judge Leisure did not even attempt to examine issues of parody, satire, or critical commentary, but simply cited *Koons I* as authority that the $125,000 sculptures were nothing but "high-priced art." United Feature Syndicate, Inc. v. Koons, 817 F. Supp. 370, 379 (S.D.N.Y. 1993).

[178] *Koons II*, 467 F.3d 244, 247 (2d Cir. 2006).

[179] *Id.*

[180] *Id.*

[181] *Id.* at 248 (internal citations omitted).

After *Koons II*, it is arguable that courts should focus instead on examining the appropriation artist's "justification for the very act of borrowing"[182] and the artist's explanation of how "the use of an existing image advanced his artistic purposes."[183] This line of inquiry is very much aligned with the First Amendment ethos of promoting self-actualization and advancing the marketplace of ideas; it treats the secondary work not just as aesthetic art but also as critical commentary on matters of public concern.[184]

In *Cariou v. Prince*, there is much similarity between Richard Prince's and Koons' intent in reproducing original photographs in order to successfully convey new meanings through repurposing preexisting works. The Second Circuit's focus on "artistic purpose" is consistent with the line of Supreme Court decisions that has affirmed that the First Amendment's protection extends even to artistic expression that does not convey a "particularized message."[185] Robert Kausnic hints at this postmodern turn in copyright law:

> Koons expressed the purpose of allowing the viewer to create the meaning from his or her own "personal experience with these objects, products, and images and at the same time gain new [and unspecified] insight into how these affect our lives." In a sense, Koons carefully refused to infuse particular meaning to the work, but rather empowered the viewer with establishing his or her own relative meaning.[186]

Similarly, Peter Jaszi suggests that *Koons II* "may signal a general loosening of authors' and owners' authority over, by now, not quite so auratic works, allowing greater space for the free play of meaning on the part of audience members and follow-up users who

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[182] Campbell v. Acuff-Music, Inc., 510 U.S. 569, 581 (1994); *Koons II*, 467 F.3d at 255.

[183] *Koons II*, 467 F.3d at 255. The court also cautioned that "Koons's clear conception of his reasons for using 'Silk Sandals,' and his ability to articulate those reasons, ease our analysis in this case. We do not mean to suggest, however, that either is a *sine qua non* for a finding of fair use—as to satire or more generally." *Id.* at 255 n.5.

[184] *See* Katz v. Google, Inc., 802 F.3d 1178, 1182–83 (11th Cir. 2015).

[185] Hurley v. Irish-Am. Gay, Lesbian & Bisexual Grp. of Bos., 515 U.S. 557, 569 (1995).

[186] Robert Kausnic, *The Problem of Meaning in Non-Discursive Expression*, 57 J. COPYRIGHT SOC'Y U.S.A. 399, 421 (2010).

bring new interpretations."[187] This kind of art—typical of the oeuvre of contemporary artists like Warhol, Koons, and Prince—has been termed "nonpropositional art" because it conveys "no single representation or message."[188] Randall Bezanson contends that such art yields "a message or meaning that is the creation not of the artist's propositional intention but the viewer's independent construction."[189] Referring to Warhol's *Campbell's Soup Cans* and Prince's *Cowboys* series, Benzanson argues that "their 'message' is their value as an instrument that unleashes the viewer's own, perhaps idiosyncratic, leap of imagination and perception."[190] But more importantly, even a visually non-transformative work may be contextually transformative because it has introduced *new ideas* fundamentally different from the original. Referring to Sherrie Levine's rephotographing of Walker Evans' photographs in her series titled *After Walker Evans*, Emily Meyers argues that "[i]n this regard, authorship is tantamount, for it infuses the appropriated or derivative work with vastly different significance. A derivative or appropriating use in this regard will never substitute for the original."[191] Levine's attempt has been lauded by art critics:

> Levine's re-presentation of the Evans works as her own is an astute artistic strategy that questions not only the power relations inscribed in the action of the "master" photographer Evans but also the subsequent art-historical canonization and market value of the original works. Property relations, patriarchal authority, authorship and originality are all brought under scrutiny.[192]

Although the original image by Evans and the second by Levine may be indistinguishable from one another, "[t]he roles each plays in the history of art continuum are unique."[193] Evans' image clearly

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[187] Peter Jaszi, *Is There Such a Thing as Postmodern Copyright?*, 12 TUL. J. TECH. & INTELL. PROP. 105, 116 (2009).

[188] RANDALL P. BEZANSON, ART AND FREEDOM OF SPEECH 280 (2009).

[189] *Id.* at 280.

[190] *Id.* at 285.

[191] Meyers, *supra* note 170, at 239.

[192] Polly Staple, *Switzerland*, FRIEZE MAG. (June–Aug. 2008), http://www.frieze.com/issue/article/switzerland/ [http://perma.cc/F8CG-Z74F].

[193] Meyers, *supra* note 170, at 239.

has a different purpose and character from Levine's.[194] Indeed, "[w]hether the creator of a transformative work is an unsuccessful artist on a shoestring budget like Forsythe or a hugely successful public figure with funding from Deustche Bank and the Solomon R. Guggenheim Foundation like Koons, fair use allows artists to further the generation of new meaning through repurposing preexisting works."[195] One does not need to like what Richard Prince does, but it is quintessential not only to the progress of the arts[196] but also to the marketplace of ideas that one has the opportunity to learn about and discuss the diversity of styles and perspectives. Guggenheim art curator Nancy Spector commented, "Prince's appropriations of existing photographs are never merely copies of the already available. Instead, they extract a kind of photographic unconsciousness form the image, bringing to the fore suppressed truths about its meaning and its making."[197]

III. REDISCOVERING THE LOST FIRST AMENDMENT WITHIN TRANSFORMATIVE USE

A. Copyright and the Issue of Its First Amendment Immunity

Copyright law as enshrined in the Copyright Act is viewpoint neutral and generally applies on its face to all individuals and firms regardless of their identity and ideology, and regardless of the content of the speech. While the copyright statute does not target the use of another's copyrighted work to advocate or oppose war, gay marriage, abortion rights, drug use, pornography, gun control, and governmental policies, it clearly abridges speech through the imposition of civil liability for an unauthorized use of a work protected under copyright law.

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[194] Art historians have highlighted "the political and feminist underpinnings of the exclusively masculine works by seminal male artists Levine chose to appropriate." Meyers, *supra* note 170, at 224; *see also* Sherrie Levine, *After Walker Evans 2* (1981), http://www.metmuseum.org/toah/works-of-art/1995.266.2 [http://perma.cc/R25Y-EVMH].

[195] Matt Williams, *Silence and Postmodern Copyright*, 29 CARDOZO ARTS & ENT. L.J. 47, 70 (2011).

[196] *See* U.S. CONST. art. I, § 8, cl. 8.

[197] NANCY SPECTOR, RICHARD PRINCE 26 (2007).

The Supreme Court has highlighted that while freedom of speech has been recognized "as indispensable to a free society and its government . . . [it] has not meant that the public interest in free speech . . . always has prevailed over competing interests of the public."[198] Most existing First Amendment jurisprudence is concerned with governmental action that abridges speech,[199] with less attention given to discussing how private action can also significantly restrict speech.[200] In the area of intellectual property, particularly copyright and trademark laws, instead of subjecting the relevant legislation to an intermediate scrutiny analysis, courts have traditionally preferred to "accommodate" First Amendment interests within existing intellectual property doctrine. For example, the twin rulings of the Supreme Court in *Eldred* and *Golan* have steadfastly refused to consider separate First Amendment arguments outside the internal structures of copyright law, namely the idea/expression dichotomy and fair use.[201] In trademark law, courts have denied First Amendment protections to advertisers who violate section 43(a) of the Lanham Act, reasoning that such

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[198] Smith v. Daily Mail Publ'g Co., 443 U.S. 97, 106 (1979). Regarding the protection of private property as a competing interest, see PruneYard Shopping Ctr. v. Robins, 447 U.S. 74, 82–88 (1980) and Lloyd Corp. v. Tanner, 407 U.S. 551, 569–70 (1972).

[199] The Supreme Court has employed a "heightened scrutiny methodology" drawn from the Fourteenth Amendment jurisprudence where governmental regulation has to satisfy the relevant strict, intermediate, or rational scrutiny standards, depending on whether it was content-neutral or content-based. Content-neutral time, place, and manner restrictions are usually permitted if they serve a substantial governmental interest, but content-based restriction of protectable speech will be subject to strict scrutiny, which is usually fatal to the challenged regulation. *See* SMOLLA & NIMMER, *supra* note 112, §§ 2:12, 3:1–3:2; *see also* United States v. Playboy Entm't Grp., Inc., 529 U.S. 803, 817 (2000); Reno v. Am. Civil Liberties Union, 521 U.S. 844, 874–79 (1997); R.A.V. v. City of St. Paul, 505 U.S. 377, 382 (1992); City of Renton v. Playtime Theatres, Inc., 475 U.S. 41, 46–47 (1986); Martin H. Redish, *The Content Distinction in First Amendment Analysis*, 34 STAN. L. REV. 113 (1981); Susan Williams, *Content Discrimination and the First Amendment*, 139 U. PA. L. REV. 615 (1991).

[200] On the impact of the enforcement of private intellectual property rights on the public domain, see generally, Keith Aoki, *Authors, Inventors and Trademark Owners: Private Intellectual Property and the Public Domain Part II*, 18 COLUM.-VLA J.L. & ARTS 191 (1994); Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CALIF. L. REV. 127 (1993).

[201] Golan v. Holder, 132 S. Ct. 873, 890–91 (2012); Eldred v. Ashcroft, 537 U.S. 186, 219 (2003). Rebecca Tushnet has criticized this approach, see *supra* note 151, at 590 ("Denied a presence in the main body of copyright law, the First Amendment returns as fair use. This back-door approach has several troublesome effects.").

laws pose no constitutional problems because they regulate only false and misleading commercial speech; the likelihood of confusion test and the artistic relevance defense readily shield expressive uses like parody from liability.[202] Even for trademark dilution claims, the First Amendment operates through broadly crafted statutory defenses like the non-commercial exception and the parody defense.[203]

According to Melville Nimmer, courts applying the method of "definitional balancing" weigh the objectives and policy considerations that underlie the speech-burdening legal doctrine against those that underlie the First Amendment in order to set out generally applicable definitional rules governing which forms of speech the legal doctrine in question may constitutionally burden and which it may not.[204] Although courts today are employing the content-based/content-neutral distinction—with the consequent application of a strict scrutiny or intermediate scrutiny standard—when evaluating government action that abridges the freedom of

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[202] *See, e.g.*, Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252, 263 (4th Cir. 2007) (holding that "Chewy Vuiton" dog toys is an obvious parody of "Louis Vuitton" handbags and on balance, does not cause confusion); Lamparello v. Falwell, 420 F.3d 309, 314–15 (4th Cir. 2005) (stating that the "likelihood-of-confusion test [for trademark infringement] generally strikes a comfortable balance between the First Amendment and the rights of [trade]mark holders" (internal quotation marks omitted)); Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894, 900 (9th Cir. 2002) (observing that the likelihood of confusion test generally strikes a comfortable balance between the trademark owner's property rights and First Amendment interests); *see also* Rogers v. Grimaldi, 875 F.2d 994, 999 (2d Cir. 1989) (prohibiting application of the Lanham Act to titles of artistic works unless the title "has no artistic relevance to the underlying work whatsoever or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work"); Jordache Enters., Inc. v. Hogg Wyld, Ltd., 828 F.2d 1482, 1486–87 (10th Cir. 1987) (finding the use of "Lardashe" jeans for larger women to be a successful and permissible parody of "Jordache" jeans); L.L. Bean v. Drake Publishers, Inc., 811 F.2d 26, 32 (1st Cir. 1987) ("It offends the Constitution, however, to invoke the anti-dilution statute as a basis for enjoining the noncommercial use of a trademark by a defendant engaged in a protected form of expression").

[203] Trademark Dilution Revision Act of 2006, 15 U.S.C. § 1125(c); *see also* Bosley Med. Inst., Inc. v. Kremer, 403 F.3d 672, 677–80 (9th Cir. 2005) (holding that the defendant's use of a trademark in the name and content of its website to criticize the trademark holder is a noncommercial use protected by the First Amendment).

[204] Melville B. Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?*, 17 UCLA L. REV. 1180, 1184–93 (1970).

speech,[205] there remain important areas of private causes of action where this definitional balancing is applied. Examples of this definitional balancing are evident in the "actual malice" rule in the laws of defamation and intentional infliction of emotional distress[206] and the definition of "obscenity" in exclusionary categories of speech falling fully outside the protection of the First Amendment.[207] Nimmer has argued previously that copyright law already contains a de facto definitional balance, located in the idea/expression dichotomy and fair use.[208]

Although the Supreme Court's plurality decision in *Eldred* commented that not all copyright laws are "categorically immune" from First Amendment challenges,[209] the essential thrust of Justice Ginsburg's opinion is that "[as long as] Congress has not altered the traditional contours of copyright protection, further First Amendment scrutiny is unnecessary."[210] In *Golan*, Justice Ginsburg again delivered the opinion of the Court and reaffirmed the holding in *Eldred*, noting that "some restriction on expression is the inherent and intended effect of every grant of copyright,"[211] but there was no necessity for heightened scrutiny if Congress has not interfered with the built-in First Amendment accommodations—mainly the idea/expression distinction and fair use defense—embraced by copyright law.[212] David Lange and Jefferson Powell argue that what Justice Ginsburg and the majority see as speech-protective safeguards "make no sense as a justification for infringement of free expression under the First Amendment."[213] As

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[205] *See* Leslie Kendrick, *Content Discrimination Revisited*, 98 VA. L. REV. 231 (2012); Geoffrey R. Stone, *Free Speech in the Twenty-First Century: Ten Lessons from the Twentieth Century*, 36 PEPP. L. REV. 273 (2009); Susan H. Williams, *Content Discrimination and the First Amendment*, 139 U. PA. L. REV. 615 (1991).

[206] *See* Hustler Magazine, Inc. v. Falwell, 485 U.S. 46 (1988); Gertz v. Robert Welch, Inc., 418 U.S. 323 (1974); N.Y. Times Co. v. Sullivan, 376 U.S. 254 (1964).

[207] Miller v. California, 413 U.S. 15, 24 (1973).

[208] Nimmer, *supra* note 204, at 1189–93; Netanel, *supra* note 18, at 1085–86.

[209] Eldred v. Ashcroft, 537 U.S. 186, 221 (2003).

[210] *Id.* For a detailed criticism of the opinion, see DAVID L. LANGE & H. JEFFERSON POWELL, NO LAW: INTELLECTUAL PROPERTY IN THE IMAGE OF AN ABSOLUTE FIRST AMENDMENT 114–24 (2009).

[211] Golan v. Holder, 132 S. Ct. 873, 889 (2012).

[212] *Id.* at 890–91.

[213] LANGE & POWELL, *supra* note 210, at 123.

it stands today, "copyright law inverts the ordinary presumptions of First Amendment analysis . . . . In the world of *Eldred*, it is the intrusion of the First Amendment into a vast regulatory scheme against which the Court must be on guard, not the government's invasion of the domain of free expression."[214]

Moreover, Justice Ginsburg's passing comment that "fair use defense affords considerable latitude for scholarship and comment, . . . even for parody"[215] suggests rather flippantly that the much revered First Amendment merits even no further *internal* examination when it clashes with copyright. Is the fair use defense sufficiently robust to accommodate the different speech-protective rationales of, and the different hierarchies of, speech recognized by the First Amendment? The deafening silence of any reference to the First Amendment is startling in judicial fair use analysis, especially when the transformative use doctrine provides the most appropriate entry point for discussing whether recognizing an infringing use as "transformative"—and ultimately fair—properly balances the goals of copyright as an "engine of free expression" and "to assure contributors to the store of knowledge a fair return for their labors."[216]

Lange and Powell lament over "intellectual property's increasing dominance over expression"[217] and disparagingly point out that "it is copyright against the First Amendment in a game the First Amendment is slated to lose."[218] This Article disagrees with such an apocalyptic view of the influence of the First Amendment on intellectual property laws, and argues, to the contrary, that the spirit of the First Amendment has in fact been guiding the rise of the transformative use doctrine in the copyright fair use defense. In order to better understand the covert operation of the First Amendment within the strictures of copyright law—as well as in trademark law—one must first appreciate how copyrighted works, like trademarks, can function as semiotic signs which are encoded

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214 *Id.* at 123.

215 *Golan*, 132 S. Ct. at 890 (quoting Eldred v. Ashcroft, 537 U.S. 186, 220 (2003)).

216 *Id.* at 890 (quoting Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 558 (1985)).

217 LANGE & POWELL, *supra* note 210, at 124.

218 *Id.* at 123.

with specific meanings or viewpoints either ascribed to them by the original author or by the public.

When an infringer uses these copyrighted works to express a different viewpoint, or to comment or criticize the original work or the author, such a use, in copyright parlance, may signify a change in purpose or character of the original work.[219] Alternatively, in the words of Leval, the original work has been "transformed in the creation of new information, new aesthetics, new insights and understandings."[220] If one were to deconstruct this doctrine through the lens of the First Amendment, the transformative use test clearly advances the marketplace of ideas and the democratic rationale through the creation of "new information" and "new insights and understandings," as well as the self-fulfillment function through the creation of "new aesthetics."[221] In view of the contemporary cultural significance of many well-known copyrighted works, this Article urges a consideration of copyrighted works as semiotic signs in order to comprehend how courts have already embarked on a covert First Amendment rescue to ensure that copyright accommodates itself to the freedom of speech rather than the reverse.

B. The "Work" as a Semiotic Sign

Copyright law is often premised on the identification of an author of a literary, dramatic, musical, or artistic work, and then giving this author monopoly rights for a limited period to control the commercial exploitation of his or her intellectual creation. However, the hegemonic position of the authorial text has been challenged by scholars like Roland Barthes, who argues that "a text's unity lies not in its origin but in its destination" and that "the birth of the reader must be at the cost of the death of the Author."[222] Barthes' work, controversial at the time of publication with its assault on

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[219] *See* Copyright Act of 1976, 17 U.S.C. § 107 (2012).

[220] Leval, *supra* note 28, at 1111.

[221] *See* Tushnet, *supra* note 151, at 558 ("[T]ransformative uses fit comfortably in an older, constitutionalized discourse about criticism, contrarianism, protest, offensiveness, and unpopularity . . . transformative use can easily borrow from First Amendment theories to bolster its economic argument.").

[222] Roland Barthes, *The Death of the Author*, *in* IMAGE-MUSIC-TEXT 142, 148 (Stephen Heath trans. 1977).

modernity and the primacy of authorial control, has nonetheless laid the groundwork for an important body of scholarship on interpretive communities. Interdisciplinary legal writings, especially in the area of intellectual property and personality rights, have also actively engaged such themes in recent years.[223] For example, Nathaniel Noda contends that copyright law ought to "keep pace with changing times and practices by recognizing that an author implicitly cedes certain interpretive rights to the general public when he or she introduces a work into the stream of public discourse."[224]

Contemporary cultural studies are concerned with the practices of popular culture, the relationships between audiences and producers, the formation of identity, and the nature of consumption. In particular, the application of semiotics to assist the development of intellectual property laws relating to logos, images, and literary works has received significant scholarly attention. For example, Barton Beebe, in his seminal works on a semiotic account of trademark doctrine,[225] has persuasively demonstrated that "semiotic concepts can be applied to clarify and ameliorate fundamental areas of trademark doctrine and policy."[226] His analysis of "sign value" as a "Saussurean structural value" that involves a "conspicuous display of distinctions, of 'marginal differences'"[227] has a parallel relevance to well-known literary, dramatic, musical, and artistic works. I have also investigated the influence of semiotics on the laws relating to famous marks, and the commercial appropriation of the celebrity personality in the right of publicity.[228]

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[223] *See* Justin Hughes, *"Recoding" Intellectual Property and Overlooked Audience Interests*, 77 TEX. L. REV. 923 (1999); Mark A. Lemley, *Romantic Authorship and the Rhetoric of Property*, 75 TEX. L. REV. 873 (1997).

[224] Nathaniel T. Noda, *Copyright Retold: How Interpretive Rights Foster Creativity and Justify Fan-Based Activities*, 57 J. COPYRIGHT SOC'Y U.S.A. 987, 991 (2010).

[225] *See* Barton Beebe, *The Semiotic Account of Trademark Doctrine and Trademark Culture*, *in* TRADEMARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH 42 (Graeme B. Dinwoodie & Mark D. Janis eds., 2008) [hereinafter Beebe, *Semiotic Account*]; Barton Beebe, *The Semiotic Analysis of Trademark Law,* 51 UCLA L. REV. 621 (2004).

[226] Beebe, *Semiotic Account*, *supra* note 225, at 42.

[227] *Id.* at 62.

[228] David Tan, *The Semiotics of Alpha Brands: Encoding/Decoding/Recoding/Transcoding of Louis Vuitton and Implications for Trademark Laws*, 32 CARDOZO ARTS & ENT. L.J. 221 (2013) [hereinafter Tan, *Semiotics of Alpha Brands*]; David Tan, *Political Recoding of the Contemporary Celebrity and the First Amendment*, 2 HARV. J. SPORTS & ENT. L. 1 (2011)

Umberto Eco describes semiotics as a social science discipline that studies "everything that can be taken as a sign."[229] A sign is simply a thing that stands for something else. Although it has its origins in the study of language, semiotic analysis is a translinguistic activity[230] that can be applied to the inquiry of "[a system] of structural codes . . . that engages with culture, consumption, and communication in the marketplace."[231] The Swiss linguist, Ferdinand de Saussure is widely credited as the most influential scholar in the field of semiotics. He emphasized the nature of the sign as the coded association of a material *signifier*, such as the sound of a word, with a *signified* or preconceived meaning.[232] In his oft-cited work on the semiotic analyses of consumer cultures, *Mythologies*, Roland Barthes explains that "any semiology postulates a relation between two terms, a signifier and a signified"[233] and that a sign "is the associative total of the first two terms."[234] A well-known literary or artistic work does much more than simply educate, inform, or entertain, but it also functions as a *signifier* of a set of *signified* meanings. While there is much debate over the extent of copyright protection given to fictional literary characters *outside* of the context of the works in which they appear, cartoon characters in meticulously drawn comic books usually have no problem being categorized as pictorial or graphic works[235] that fall within "the core of the copyright's protective purposes."[236] Mickey Mouse, Barbie, Captain America, and Superman are just some of the iconic characters from the last century that are universally recognized today; each is emblematic of a unique set of character values and semiotic significance and has become a "common [point] of refer-

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[hereinafter Tan, *Political Recoding*]; David Tan, *Affective Transfer & the Appropriation of Commercial Value: A Cultural Analysis of the Right of Publicity*, 9 VA. SPORTS & ENT. L.J. 272 (2010).

229 UMBERTO ECO, THE THEORY OF SIGNS 7 (1979).

230 ROLAND BARTHES, ELEMENTS OF SEMIOLOGY 11 (Annette Lavers & Colin Smith trans., 2000) (1964).

231 LAURA R. OSWALD, MARKETING SEMIOTICS: SIGNS, STRATEGIES, AND BRAND VALUES 47 (2012).

232 *See generally* FERDINAND DE SAUSSURE, THE COURSE IN GENERAL LINGUISTICS (Roy Harris trans., 1983) (1916).

233 BARTHES, *supra* note 20, at 111.

234 *Id.*

235 Copyright Act of 1976, 17 U.S.C. § 102(a)(5) (2012).

236 Campbell v. Acuff-Music, Inc., 510 U.S. 569, 586 (1994).

ence for millions of individuals who may never interact with one another, but who share, by virtue of their participation in a mediated culture [as the audience], a common experience and a collective memory."[237] The representative fictional characters from the works—for example, Mickey Mouse, Snow White, and Sleeping Beauty from the canonical universe of Disney's works—may function as signifiers of both individualized and a shared set of meanings. A "myth" is thereby created when meaning within a semiological system is transformed into form as represented by a sign;[238] each sign becomes naturally associated with a set of meanings or "historical intention"[239] which is ultimately consumed. Like famous trademarks, the copyrighted character signifier/signified relationship would have become universally codified for the audience; the audience will automatically and consistently think of the coded meanings and values (the signified) when they are exposed to the character signifiers. In other words, the fictional character becomes a sign for a predetermined set of cultural codes and audience experiences associated with the work or the author of the work.[240] It has been noted:

> If anyone who wanted to could appropriate a cultural object, transform it according to her own whims, and rerelease it into society, the result could be a win-win scenario for First Amendment values: significantly improved personal autonomy combined with democracy-reinforcing political expression . . . .
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> . . . More fundamentally, the loss of radical voices and ideas hurts the marketplace of ideas and the First Amendment maxim "that everything worth saying shall be said."[241]

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[237] JOHN B. THOMPSON, IDEOLOGY AND MODERN CULTURE: CRITICAL SOCIAL THEORY IN THE ERA OF MASS COMMUNICATION 163 (1990).

[238] *Id.* at 131.

[239] *Id.* at 142.

[240] *See* Tan, *Semiotics of Alpha Brands, supra* note 228, at 227.

[241] Note, *supra* note 21, at 1497–99 (internal citations omitted).

Referring to Barthes' work on modern myths,[242] as well as to Antonio Gramsci[243] and Claude Lévi-Strauss,[244] Stuart Hall discusses the politics of signification[245] and how ideological discourses of a particular society are classified and framed through semiotic signs.[246] Like Barthesian myths, cartoon characters such as Mickey Mouse and Snow White, well-known superhero characters such as Superman, Captain America, and Wonder Woman, as well as fictional characters from popular television series like Star Trek, all contain subject positions and models for identification that are heavily coded ideologically. These iconic copyrighted works can have an ideological function of not only reiterating dominant values, but also concealing prevalent contradictions or social problems. More generally, it has been said that "identities can function as points of identification and attachment only *because* of their capacity to exclude, to leave out, to render 'outside' abjected."[247] In particular, Eleanor Byrne and Martin McQuillan argued that the "Disney [text] has become synonymous with a certain conservative, patriarchal, heterosexual ideology which is loosely associated with American cultural imperialism."[248] The canon of Disney films has been said to "open themselves onto the entire history of the West and act as a symptomatic concentration of all the ideological

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[242] BARTHES, s*upra* note 20, at 50.

[243] ANTONIO GRAMSCI, SELECTIONS FROM THE PRISON NOTEBOOKS (Quintin Hoare & Geoffrey Nowell Smith trans., 1971).

[244] CLAUDE LÉVI-STRAUSS, THE ELEMENTARY STRUCTURES OF KINSHIP (James Harle Bell & John Richard von Sturmer trans., 1969); CLAUDE LÉVI-STRAUSS, THE SCOPE OF ANTHROPOLOGY (Sherry Ortner Paul & Robert A. Paul trans., 1967).

[245] *See* Stuart Hall, *The Rediscovery of "Ideology": Return of the Repressed in Media Studies*, *in* CULTURE, SOCIETY AND THE MEDIA 56, 64–74 (Michael Gurevitch et al. eds., 1982).

[246] *Id.* at 74; *see also* Tan, *supra* note 99, at 94.

[247] Stuart Hall, *Introduction: Who Needs "Identity"?*, *in* QUESTIONS OF CULTURAL IDENTITY 1, 5 (Stuart Hall & Paul Du Gay eds., 1996); *see also* JUDITH P. BUTLER, BODIES THAT MATTER: ON THE DISCURSIVE LIMITS OF SEX (1993); ERNESTO LACLAU, NEW REFLECTIONS ON THE REVOLUTION OF OUR TIME (1990); Stuart Hall, *The Local and the Global: Globalization and Ethnicity*, *in* CULTURE, GLOBALIZATION AND THE WORLD SYSTEM: CONTEMPORARY CONDITIONS FOR THE REPRESENTATION OF IDENTITY 19 (Anthony D. King ed., 1997).

[248] ELEANOR BYRNE & MARTIN MCQUILLAN, DECONSTRUCTING DISNEY 1–2 (1999); *see also* HENRY A. GIROUX, THE MOUSE THAT ROARED: DISNEY AND THE END OF INNOCENCE 30–32 (1999).

contests which are currently being fought in our world today."[249] Indeed many of Disney's texts present fertile opportunities for opposite or subversive readings that disrupt the hegemony of a hyperrealist utopian escapism. In terms of recoding, scholars like John Fiske have emphasized the potential of audience reconstruction of dominant symbols of a culture. Fiske coined the term "semiotic democracy" to describe a world where empowered audiences freely and widely engage in the use of cultural symbols to express meanings that are different from the ones intended by their creators.[250] Sarah Trombley had also expressed concerns about why, in order to be able to speak effectively, one needs to be able to appropriate and transform the work of others:

> In the United States, more and more powerful, widely-recognized symbols and icons have become private property even as corporations invest billions of dollars in ensuring that they saturate public discourse. We are in danger of creating an impoverished "look, but don't touch" world, one in which the very public whose enthusiastic response to certain symbols and icons gives them their resonance cannot use those symbols and icons themselves to communicate—a sad inversion of the copyright regime's original goal of enriching the stock of American culture.[251]

The writings of Rosemary Coombe[252] and Michael Warner[253] on subaltern groups and counterpublics have approached the constitution and politics of social and individual identity as being predicated on a power struggle between dominant and subordinate groups. The terms "subaltern" or "subculture" are frequently

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[249] BYRNE & MCQUILLAN, *supra* note 248, at 168.

[250] JOHN FISKE, TELEVISION CULTURE 239 (1987); *see also* Sonia K. Katyal, *Semiotic Disobedience*, 84 WASH. U.L. REV. 489, 489–90 (2006); Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CALIF. L. REV. 127, 139 (1993).

[251] Sarah Trombley, *Visions and Revisions: Fanvids and Fair Use*, 25 CARDOZO ARTS & ENT. L.J. 647, 681–82 (2007).

[252] ROSEMARY J. COOMBE, THE CULTURAL LIFE OF INTELLECTUAL PROPERTIES: AUTHORSHIP, APPROPRIATION, AND THE LAW 277 (1998).

[253] MICHAEL WARNER, PUBLICS AND COUNTERPUBLICS (2002).

used in cultural studies to denote the subordination of particular identities by a dominant ideological hegemony; the "subaltern's place [in society] is subsumed within . . . an experience of oppression which privileges particular exemplars as the 'proper' figures of identity."[254] Warner's analysis of the struggles that bring individuals together as a public postulates that "subaltern counterpublics" usually articulate alternative power relations with the dominant public defined by race, gender, sexual orientation, and other subordinated status.[255] According to Warner, a counterpublic maintains "an awareness of its subordinate status . . . [with respect] not just to ideas or policy questions but to the speech genres and mode of address that constitute the public."[256]

Stuart Hall has also defined the taking of an existing meaning and reappropriating it for new meanings as "trans-coding."[257] He explained that repressed groups may use trans-coding strategies to reverse stereotypes, substitute negative portrayals with positive ones, or contest subordinate representations from within.[258] This notion of recoding is arguably applicable to the transformation doctrine in the fair use defense of copyright law. In copyright fair use, the pertinent inquiry for transformativeness is whether the secondary work "adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message."[259] Many trans-coding practices, especially in appropriation art, can be said to be "transformative" in this way.[260] A countercultural or counterpublic agenda may be best communicated to

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[254] *Id.* at 92.

[255] *Id.* at 44–63, 117–20.

[256] *Id.* at 119.

[257] Stuart Hall, *The Spectacle of the "Other," in* REPRESENTATION: CULTURAL REPRESENTATIONS AND SIGNIFYING PRACTICES 223, 270 (1997). The term "transfunctionalize" has also been used to describe how subcultures assign new and often contradictory meanings to signs as understood by mainstream society. *See* PAUL NATHANSON, OVER THE RAINBOW: THE WIZARD OF OZ AS A SECULAR MYTH OF AMERICA 241 (1991).

[258] Hall, *supra* note 257, at 270–75.

[259] Campbell v. Acuff-Music, Inc., 510 U.S. 569, 579 (1994).

[260] *See generally* David Tan, *What Do Judges Know About Contemporary Art?: Richard Prince and Reimagining the Fair Use Test in Copyright Law*, 16 MEDIA & ARTS L. REV. 381 (2011); William M. Landes & Richard A. Posner, *The Legal Protection of Postmodern Art*, *in* THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW 254 (2003).

mainstream society through the use of widely recognized semiotic signs to which the public have ascribed particular representative values or characteristics. Hence "recoding, like flag burning, may advance an 'associative' type of discourse using the currency of symbolic referents . . . [realizing] its potential for promoting personal expression, self-government, and the pursuit of truth."[261] In the area of copyright, parodies, fan fiction, and appropriation art are the best examples of trans-coding practices where an irreverent portrayal of an iconic literary, dramatic, musical, or artistic work has recoded its semiotic meanings to express a different or counter-viewpoint that creates new insights and understandings, thus rendering the secondary use "transformative" in nature. Rebecca Tushnet explains that fans add new characters, stories, or twists to the existing versions of novels and television programs:

> Rather than displacing sales of the original, fanworks encourage and sustain a vibrant fan community that helps authorized versions thrive—Harry Potter, CSI, Star Trek, and other successful works are at the center of enormous creative fandoms containing hundreds of thousands of fanworks . . . . Transformativeness in fanworks takes many forms, from critique to celebration to reworking a text so that it better addresses the concerns of a specific audience.[262]

Indeed, one of the most prevalent creative practices of fan communities is "transformation by excavation,"[263] where new fan works creatively illuminate something about the originals by reworking the canonical versions. I have previously maintained that "in their interpretive activities, fans may arguably, as fair use, comment or criticize the canonical universe of the original author, create parodies of the original works or to express their own creative teleologies that draw on the primacy of the canon."[264] As Tushnet contends, if a work was used as a building block for an ar-

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[261] Note, *supra* note 21, at 1499.

[262] Rebecca Tushnet, *User-Generated Discontent: Transformation in Practice*, 31 COLUM. J.L. & ARTS 497, 503 (2008); *see generally* Noda, *supra* note 224.

[263] Tushnet, *supra* note 262, at 503.

[264] Tan, *supra* note 99, at 96.

gument, it should be understood as possessing a transformative purpose, in contrast to a work that was created purely for its entertainment value.[265] Randall Bezanson similarly argues that adopting other people's speech should be protected by the First Amendment when it is "sufficiently transformative to support the assertion of intent to speak for oneself and, as importantly, to identify a new expression that justifies calling the First Amendment into play."[266]

C. Advancing First Amendment Goals Through Semiotic Transformation

In trademark law, courts have often directly engaged with the First Amendment, whether in an infringement or a dilution claim, as trademark law does not have a built-in First Amendment safeguard. Hence, courts have resorted to accommodating the First Amendment within doctrinal grounds, like in the likelihood of confusion analysis for infringement and the non-commercial use and parody exceptions for dilution actions.[267] For instance, the Second Circuit noted that since the likelihood of confusion test "is at best awkward in the context of parody, which must evoke the original and constitutes artistic expression," courts should apply the factors "with proper weight given to First Amendment considerations."[268] The Ninth Circuit in *Mattel v. MCA Records* commented that when marks "transcend their identifying purpose" and "enter public discourse and become an integral part of our vocabulary," they "assume[] a role outside the bounds of trademark law."[269]

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[265] Tushnet, *supra* note 262, at 506.

[266] Randall P. Bezanson, *Speaking Through Others' Voices: Authorship, Originality, and Free Speech*, 38 WAKE FOREST L. REV. 983, 1056 (2003).

[267] The canon of constitutional avoidance dictates that courts should "construe the statute to avoid such problems unless such a construction is plainly contrary to the intent of Congress." Edward J. DeBartolo Corp. v. Fla. Gulf Coast Bldg. & Const. Trades Council, 485 U.S. 568, 575 (1988). Courts must first attempt to resolve any conflict between trademark law and the First Amendment by interpreting trademark claims narrowly and trademark defenses broadly in ways that protect expression. *See* Lisa P. Ramsey, *Increasing First Amendment Scrutiny of Trademark Law*, 61 S.M.U. L. REV. 381, 448; *see generally* Tan, *Semiotics of Alpha Brands*, *supra* note 228.

[268] Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., 886 F.2d 490, 495 n.3 (2d Cir. 1989).

[269] Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894, 900 (9th Cir. 2002). In 1997, Aqua produced the parody song "Barbie Girl" on the album *Aquarium* and the song made it

Where a mark assumes such cultural significance, First Amendment protections come into play. In these situations, the Ninth Circuit observed that "the trademark owner does not have the right to control public discourse whenever the public imbues his mark with a meaning beyond its source-identifying function."[270] More broadly, the court cautioned: "Were we to ignore the expressive value that some marks assume, trademark rights would grow to encroach upon the zone protected by the First Amendment."[271] Similarly, the First Circuit shares the view that "[t]rademark rights do not entitle the owner to quash an unauthorized use of the mark by another who is communicating ideas or expressing points of view."[272]

Mattel, through impressive marketing, has established Barbie as "the ideal American woman" and a "symbol of American girlhood" for many.[273] To sell its product, Mattel uses associations of beauty, wealth, and glamour. In *Mattel v. Walking Mountain Productions*, artist Thomas Forsythe turns this image on its head by displaying carefully positioned, nude, and sometimes frazzled looking Barbies in often ridiculous and apparently dangerous situations. In finding that Thomas Forsythe's photographs, which portrayed a nude Barbie doll in danger of being attacked by vintage household appliances, was transformative, the Ninth Circuit reasoned that "Forsythe presents the viewer with a different set of associations and a different context for this plastic figure."[274] The court commented:

> It is not difficult to see the commentary that Forsythe intended or the harm that he perceived in Barbie's influence on gender roles and the position of women in society . . . . By developing and transforming associations with Mattel's Barbie doll, Forsythe has created the sort of social criticism and pa-

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onto "Top 40" music charts. The defendants, MCA Records and a number of other music companies, produced, marketed, and sold "Barbie Girl." *Id.*

[270] *Id.*; *see also* New Kids on the Block v. News Am. Publ'g Inc., 971 F.2d 302, 307 (9th Cir. 1992).

[271] *MCA Records, Inc.*, 296 F.3d at 900.

[272] L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 29 (1987).

[273] *MCA Records, Inc.*, 296 F.3d at 898.

[274] Mattel, Inc. v. Walking Mountain Prods., 353 F.3d 792, 802 (9th Cir. 2003).

> rodic speech protected by the First Amendment and promoted by the Copyright Act.[275]

Courts rarely refer to the First Amendment when evaluating transformative use in copyright disputes. However, the Ninth Circuit *Mattel* decisions are notable for their more overt mention of the protection that the First Amendment confers over commentary, criticism, and parody that may be affected by engaging with a copyrighted work as a semiotic sign infused with established connotations. The Fourth Circuit alluded to the marketplace of ideas and participatory democracy rationales of the First Amendment when it posited that fair use "protects filmmakers and documentarians from the inevitable chilling effects of allowing an artist too much control over the dissemination of his or her work" and "is crucial to the exchange of opinions and ideas."[276]

It seems that the Supreme Court is not too concerned about keeping the marketplace of ideas and the participatory democracy theory distinct, as evident in its frequent pronouncements. For example, the Court stated that the First Amendment "was fashioned to assure unfettered interchange of ideas for the bringing about of political and social changes desired by the people"[277] and to enable "the practice of persons sharing common views banding together to achieve a common end is deeply embedded in the American political process."[278] Generally, political speech covers all discussion on public issues, especially if intended by the speaker to influence governmental action.[279] Political speech has been defined by commentators as speech that falls into one of the following categories: either it (1) is "a reasoned, cognitive connection to some identifiable political issue that has the potential of entering the legislative arena";[280] (2) is that "which bears, directly or indirectly, upon issues with which voters have to deal";[281] or (3) occurs "when it is

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[275] *Id.* at 803.

[276] Bouchat v. Balt. Ravens Ltd. P'ship, 737 F.3d 932, 944 (4th Cir. 2013).

[277] Connick v. Myers, 461 U.S. 138, 145 (1983); N.Y. Times Co. v. Sullivan, 376 U.S. 254, 269 (1964); Roth v. United States, 354 U.S. 476, 484 (1957).

[278] NAACP v. Claiborne Hardware Co., 458 U.S. 886, 906 (1982).

[279] *Id.* at 913–14; Garrison v. Louisiana, 379 U.S. 64, 74–75 (1964); *N.Y. Times*, 376 U.S. at 270.

[280] Garry, *supra* note 126, at 516.

[281] MEIKLEJOHN, *supra* note 118, at 79.

both intended and received as a contribution to public deliberation about some issue."[282] Although art and entertainment, as embodied in literary, musical, dramatic, and artistic works, are protected by the First Amendment as having value in themselves, courts often examine their "political value." This is demonstrated by decisions that assess their contribution to public debate through the articulation of a particular viewpoint or through critical commentary or parody.[283] The transformative use doctrine can clearly accommodate the First Amendment rationales of marketplace of ideas and participatory democracy, where greater protection may be given to unauthorized uses of copyrighted works that promote attention to public issues and engender public debate.

In order for speech to be *accommodated* adequate breathing space, it would be beneficial to understand the free speech issues in the copyright fair use defense within the context of a First Amendment theory that "preserves the independence of public discourse so that a democratic will within a culturally heterogeneous state can emerge under conditions of neutrality, and so that individuals can use the medium of public discourse to persuade others to experiment in new forms of community life."[284] Instead of burning a flag or a cross, or wearing black armbands, one might draw Mouseketeer caps on President Obama's head or depict Superman being crushed by foreign powers when engaging in political commentary. Gays and lesbians may subvert conventional portrayals of Disney's princes and princesses to highlight their social marginalization. A number of commentators have alluded to this possibility. For example, Trombley suggests that the view put forth in "slash fanvid" may "require a radical reappraisal of characters' motives, the plot, and authorial intent . . . [and] also demonstrates the ways in which such transformative use edges towards political commentary that may deserve protection under the First Amendment."[285]

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[282] SUNSTEIN, PROBLEM WITH FREE SPEECH, *supra* note 137, at 130.

[283] In a right of publicity context, see ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915 (6th Cir. 2003); Estate of Presley v. Russen, 513 F. Supp. 1339 (D.N.J. 1981).

[284] Post, *Constitutional Concept*, *supra* note 136, at 684.

[285] Trombley, *supra* note 251, at 665–66. The fan-made music video, or "fanvid," comprises of the re-cutting of footage from a television or film source to a new soundtrack, thus producing a sequence resembling a movie trailer (although normally

In the United States, the "structural barriers or limits of class [that] would obstruct [the] process of cultural absorption" have not assisted the "democratic enfranchisement of all citizens within political society."[286] Reading copyrighted works semiotically can reveal how such signs can "reproduce the existing social struggles in their images, spectacle, and narrative."[287] Indeed, there is a significant emphasis in contemporary cultural studies on the notion of audience participation—be it their complicity or resistance—in the hegemony of cultural texts propagated by their authors or producers.[288] It is in these studies of semiotic disruptions that one may find the relevant tools for establishing a conceptual framework within the transformative use doctrine that addresses the political agenda of the active audience.

In right of publicity jurisprudence, the First Amendment defense is a shield against liability for the commercial appropriation of identity.[289] There are different articulations of the First Amendment defense in myriad state jurisdictions, but the "transformative elements" test, also known as the "transformative use" test, initiated by the California Supreme Court in *Comedy III Productions v. Saderup*[290] has been widely adopted.[291] It draws from the first factor

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omitting dialogue or voice-over narration) or the "musical montage," which often ends episodes of television dramas. The popular subgenre of "slash" fanvids explores the possibility of reading relationships between presumptively (by mainstream standards) heterosexual characters as queer. Fanvids are therefore perceived as a form of cultural appropriation by individual artists who transform the works of others for different ends. *Id.* at 650–52.

[286] Stuart Hall, *supra* note 245, at 56, 60.

[287] DOUGLAS KELLNER, MEDIA CULTURE: CULTURAL STUDIES, IDENTITY AND POLITICS BETWEEN THE MODERN AND THE POSTMODERN 56 (1995).

[288] *See* NICK ABERCROMBIE & BRIAN LONGHURST, AUDIENCES: A SOCIOLOGICAL THEORY OF PERFORMANCE AND IMAGINATION (1998); IEN ANG, DESPERATELY SEEKING THE AUDIENCE (1991); AUDIENCES AND PUBLICS: WHEN CULTURAL ENGAGEMENT MATTERS FOR THE PUBLIC SPHERE (Sonia Livingstone ed., 2005); JOHN FISKE, MEDIA MATTERS: EVERYDAY CULTURE AND POLITICAL CHANGE (1996); JONATHAN GRAY, WATCHING WITH THE SIMPSONS: TELEVISION, PARODY, AND INTERTEXTUALITY (2006).

[289] *See* MCCARTHY, *supra* note 114, §§ 3:1, 8:22–:39 (2014); Tan, *Political Recoding*, *supra* note 228, at 17–30.

[290] Comedy III Prods. v. Saderup, 21 P.3d 797 (Cal. 2001).

[291] *See* Keller v. Elec. Arts, Inc., 724 F.3d 1268 (9th Cir. 2013); Hart v. Elec. Arts, Inc., 717 F.3d 141 (3d Cir. 2013); Hilton v. Hallmark Cards, 599 F.3d 894 (9th Cir. 2010); ETW Corp. v. Jireh Publ'g, Inc., 332 F.3d 915 (6th Cir. 2003).

of the fair use defense in copyright law:[292] an unauthorized use of celebrity identity would be permitted if it was "transformative." In adjudging what might qualify as "transformative" and hence protected by the First Amendment, literal depictions like Andy Warhol's silkscreens of celebrities have been said to be transformative because they convey a particular critical viewpoint.[293] The California Supreme Court commented that despite a low degree of visual transformation in the silkscreens, "[t]hrough distortion and the careful manipulation of context, Warhol was able to convey a message that went beyond the commercial exploitation of celebrity images and became a form of ironic social comment on the dehumanization of celebrity itself."[294] This suggests that contextual transformations—like the recoded use of a celebrity identity to challenge the majoritarian values that the celebrity sign represents—would merit First Amendment protection.

Building on Jürgen Habermas' work on the public sphere,[295] Michael Warner's analysis of the struggles that bring individuals together as a public postulates that "subaltern counterpublics" usually articulate alternative power relations with the dominant public defined by race, gender, sexual orientation, and other subordinated status.[296] Counterpublics are "counter" to the extent that they try to supply different ways of imagining participation within a political or social hierarchy by which its members' identities are formed and transformed.[297] A counterpublic use of a particular well-known copyrighted work can acquire a political dimension, and may be seen as a "discursive space . . . for contesting and en-

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[292] Copyright Act of 1976, 17 U.S.C. § 107(1) (2012); *see also* Campbell v. Acuff-Music, Inc., 510 U.S. 569, 579–85 (1994); Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257, 1268–69 (11th Cir. 2011); *Koons II*, 467 F.3d 244, 251–56 (2d Cir. 2006); Castle Rock Entm't v. Carol Pub. Grp., Inc., 150 F.3d 132, 142–43 (2d Cir. 1998).

[293] *Comedy III*, 21 P.3d at 811. The court observed that "the transformative elements or creative contributions that require First Amendment protection are not confined to parody and can take many forms, from factual reporting to fictionalized portrayal, from heavy-handed lampooning to subtle social criticism." *Id*. at 809.

[294] *Id.* at 811.

[295] JÜRGEN HABERMAS, THE STRUCTURAL TRANSFORMATION OF THE PUBLIC SPHERE: AN INQUIRY INTO A CATEGORY OF BOURGEOIS SOCIETY (Thomas Burger trans., 1989).

[296] WARNER, *supra* note 253, at 44–63, 117–20.

[297] *Id.* at 121–22.

gendering the American character."[298] From a semiotics perspective, the political agenda of counterpublics or subaltern groups may be best communicated to mainstream society through the use of widely recognized copyrighted works as "signs" to which the public have ascribed particular representative values or characteristics. In particular, copyrighted works that are constitutive of cultural heritage—like Mickey Mouse, Superman, Captain America, and Barbie—each transcend the works that bear these names, and are symbolic of the ideological hegemonies of social identities in contemporary society. Their recoding by counterpublics may be viewed as "[p]ractices of articulating social difference [that] are central to democratic politics."[299]

Through recoding practices—which transform the original work through the creation of "new information, new aesthetics, new insights and understandings"[300]—subaltern groups are able to advance their political ideologies and assert alternative identities that "affirm both community solidarity and the legitimacy of their social difference by empowering themselves with cultural resources that the law deems the properties of others."[301] The rewriting of the well-known Roy Orbison hit song "Oh, Pretty Woman" to refer to a "big hairy woman" and a "bald headed woman" reasonably could be perceived as commenting on or criticizing the notions of beauty or naiveté suggested by the original work.[302] Similarly, the spoof of Annie Leibovitz's celebrity portrait,[303] the poignant

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[298] Madhavi Sunder, *Authorship and Autonomy as Rites of Exclusion: The Intellectual Propertization of Free Speech in* Hurley v. Irish-Am. Gay, Lesbian & Bisexual Grp. of Bos., 49 STAN. L. REV. 143, 164–65 (1996).

[299] COOMBE, *supra* note 252, at 295; *see also* WARNER, *supra* note 253, at 210.

[300] Leval, *supra* note 28, at 1111.

[301] COOMBE, *supra* note 252, at 366; *see also* Jacqueline D. Lipton & John Tehranian, *Derivative Works 2.0: Reconsidering Transformative Use in the Age of Crowdsourced Creation*, 109 NW. U.L. REV. 383, 401 (2015) ("transformative interactions with creative works also advance identity formation and expressive interests by mediating the development of cultural networks, regulating or undermining insider-outsider relationships, and demarcating or blurring social strata").

[302] Campbell v. Acuff-Music, Inc., 510 U.S. 569, 583 (1994).

[303] Leibovitz v. Paramount Pictures Corp. 137 F.3d 109, 115 (2d Cir. 1998) ("Apart from ridiculing pretentiousness, the ad might also be reasonably perceived as interpreting the Leibovitz photograph to extol the beauty of the pregnant female body, and rather unchivalrously, to express disagreement with this message.").

retelling of *Gone With The Wind*,[304] the subversive criticism of Mattel's depiction of the Barbie doll by Thomas Forsythe,[305] the new insights to Andreas Blanch's fashion photograph provided by Jeff Koons,[306] and the new aesthetics of Richard Prince's appropriation art[307] not only contribute significantly to the marketplace of ideas but also challenge majoritarian viewpoints and provoke public debate about American ideals and values. Although these decisions regarding fair use do not refer to the First Amendment, one can discern its subliminal presence guiding the interpretation of transformative use that impels a march toward finding more breathing space for secondary works that advance First Amendment goals.

Viewed in this light, the judgment handed down in 1978 by the Ninth Circuit in *Walt Disney Productions v. Air Pirates* would have been wrongly decided; in that case, the individual defendants published two issues of cartoon comics entitled *Air Pirates Funnies* which portrayed a number of well-recognized Disney characters in unflattering scenarios. The themes of defendants' publications differ markedly from those of Disney. The Ninth Circuit advanced the observation that:

> [T]he "Air Pirates" was "an 'underground' comic book which had placed several well-known Disney

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[304] Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257, 1270 (11th Cir. 2011) ("It is principally and purposefully a critical statement that seeks to rebut and destroy the perspective, judgments, and mythology of [the original novel].").

[305] Mattel Inc. v. Walking Mountain Prods., 353 F.3d 792, 796 (9th Cir. 2003) (stating that Forsythe, the defendant, described the message of his photographic series as "an attempt to 'critique [] the objectification of women associated with [Barbie], and [][to] lambast [] the conventional beauty myth and the societal acceptance of women as objects because this is what Barbie embodies.'" (internal citations omitted)).

[306] *Koons II*, 467 F.3d 244, 252 (2d Cir. 2006) ("The sharply different objectives that Koons had in using, and Blanch had in creating 'Silk Sandals' confirms the transformative nature of the use."). According to Jeff Koons, he was "using Blanch's image as fodder for his commentary on the social and aesthetic consequences of mass media" and he wanted "the viewer to think about his/her personal experience with these objects, products, and images and at the same time gain new insight into how these affect our lives." *Id.* at 252–53.

[307] Cariou v. Prince, 714 F.3d 694, 707 (2d Cir. 2013) ("Prince's *Canal Zone* artworks relate to a 'post-apocalyptic screenplay' Prince had planned, and 'emphasize themes [of Prince's planned screenplay] of equality of the sexes; highlight "the three relationships in the world, which are men and women, men and men, and women and women"; and portray a contemporary take on the music scene.'").

> cartoon characters in incongruous settings where they engaged in activities clearly antithetical to the accepted Mickey Mouse world of scrubbed faces, bright smiles and happy endings." It centered around "a rather bawdy depiction of the Disney characters as active members of a free thinking, promiscuous, drug ingesting counterculture."[308]

Each issue of the Pirates' books was marked "Adults Only." The cover of the first issue showed Mickey Mouse piloting an open-cockpitted, propeller-powered plane with two sacks labeled "Dope" tied to its fuselage. The image has been lifted from the cover of a Disney comic, *Mickey the Mail Pilot*, with the word "Dope" having replaced the original word, "Mail." The cover of the second issue depicted Mickey Mouse and Minnie Mouse on horseback, hands raised, confronted by a bat-winged, cloaked figure with a revolver in one hand and the "Dope" sacks in the other. The Ninth Circuit accepted that the *Air Pirates Funnies* had targeted the original Disney characters and had "parodied their personalities, their wholesomeness, and their innocence."[309] This is therefore unequivocally a target parody[310] and like 2 Live Crew's song "Pretty Woman" in *Campbell*, it "reasonably could be perceived as commenting on the original or criticizing it, to some degree."[311] In fact, the defense attorneys for Air Pirates argued that the creators of *Air Pirates Funnies* were respected parodists following in the footsteps of Cervantes, Swift, Whitman, Hemingway, and Faulkner, that the countercultural comics were aimed at adult hippies not children, that these comics were not competing with

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[308] Walt Disney Prods. v. Air Pirates, 581 F.2d 751, 753 (2d Cir. 1978) (quoting Note, *Parody, Copyrights and the First Amendment*, 10 U.S.F. L. REV. 564, 571, 582 (1976)).

[309] *Walt Disney*, 581 F.2d at 758. It was also noted that there were satirical elements present as well. *Id.* at 758 n.15 ("[T]he 'Air Pirates' were parodying life and society in addition to parodying the Disney characters. Such an effect is almost an inherent aspect of any parody.").

[310] Campbell v. Acuff-Music, Inc., 510 U.S. 569, 580 (1994) ("For the purposes of copyright law, the nub of the definitions, and the heart of any parodist's claim to quote from existing material, is the use of some elements of a prior author's composition to create a new one that, at least in part, comments on that author's works."). On the difference between target and weapon parodies, see Richard A. Posner, *When is Parody Fair Use?*, 21 J. LEGAL STUD. 67, 70–71 (1992).

[311] *Campbell*, 510 U.S. at 583.

any past, current, or future Disney creations, and that the Disney-buying public was unlikely to have its cravings for Mickey Mouse satisfied by an issue of *Air Pirates Funnies*.[312] In Dan O'Neill's affidavit, he said:

> [W]e approach Mickey Mouse as our major American mythology . . . . I chose to parody *exactly* the style of drawing and the characters to evoke the response created by Disney. My purpose in using the Mouse as a character is not to destroy the Disney product, but to deal with the image in the American consciousness that the Disney image *implanted*.[313]

Unfortunately, it was this close copying of the original Disney characters in *Walt Disney* that precluded the defendants from relying on the fair use defense, despite the high degree of transformativeness in terms of the parodic purpose of *Air Pirates Funnies*.

In 1978, the standards for applying the fair use defense in parody cases, like the standards for applying fair use in other contexts, have been a source of considerable attention and dispute, with a number of Second Circuit and Ninth Circuit decisions consistently focused on the substantiality of the taking.[314] In *Walt Disney*, the defendants presented a contrasting countercultural critical work that attacked the Disney myth. They argued that Mickey Mouse had become "part of the national collective unconscious" and an internationally known symbol of American culture and power; while Mickey is usually perceived as innocent and delightful, he has now been recoded in *Air Pirates Funnies* as a reactionary force devoted to Establishment values and an enthusiastic promoter of capitalism and unrestrained violence,[315] a representation which challenged the morality espoused by Disney. Today, such a use

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[312] BOB LEVIN, THE PIRATES AND THE MOUSE: DISNEY'S WAR AGAINST THE COUNTERCULTURE 98 (2003).

[313] *Id.* at 100. O'Neill was also reported to have said: "The closer you draw the parody, the greater the shock, the greater the criticism." *Id.* at 101.

[314] *E.g.*, Rosemont Enters., Inc. v. Random House, Inc., 366 F.2d 303 (2d Cir. 1966); Benny v. Loew's, Inc., 239 F.2d 532 (9th Cir. 1956).

[315] LEVIN, *supra* note 312, at 98–99.

would probably qualify as a form of "transformation by excavation."[316]

In the same vein, the placement of a Mouseketeer cap on the President of the United States or the former Chairman of the Chinese Communist Party would infringe Disney's copyright in the graphical image of Mickey Mouse. It is a perfect shorthand to express one's criticism of the incumbent political ideology.[317] Disney can connote "unquestioning patriotism, bourgeois moral nostrums, gauche middle-class taste, racist elitism, corporate profit-mongering, and bland standards of social conformity."[318] Such expressions also may, borrowing a phrase from the Supreme Court in *Campbell*, "reasonably be perceived as commenting on the original or criticizing it, to some degree,"[319] through the introduction of new insights and understandings into the Disney corporation's close connection with governments[320] and Disney's highly successful "mass-mediated utopian typifications . . . that structure personal values and ideology,"[321] much like how these two political leaders strive to advance democratic and communist dogmas respectively in their own countries.

Likewise, the myth of the American superheroes as portrayed in Marvel and DC Comics can also be read to encompass a secularization of religion and the themes of salvation and redemption.[322] The powers that are earlier reserved for God and his angelic beings are transferred to an Everyman, and the virtuous qualities associated with God now reside within the superheroes. Richard Rey-

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316 Tushnet, *supra* note 262, at 503.

317 Such countercultural merchandise is currently commercially available for purchase on websites. *See, e.g.*, THOSESHIRTS.COM, http://www.thoseshirts.com/mic.html [http://perma.cc/FG6P-XARR] (last visited Oct. 12, 2015); TSHIRTBORDELLO.COM, http://www.tshirtbordello.com/Mickey-Mao-T-Shirt [http://perma.cc/459W-Z4NZ] (last visited Oct. 12, 2015).

318 LEVIN, *supra* note 312, at 79; *see also* Lee Artz, *Monarchs, Monsters, and Multiculturalism: Disney's Menu for Global Hierarchy*, *in* RETHINKING DISNEY: PRIVATE CONTROL, PUBLIC DIMENSION 75, 82 (Mike Budd & Max H. Kirsch eds., 2005) (arguing that Disney's representations "promote capitalist hegemony and political quiescence").

319 Campbell v. Acuff-Music, Inc., 510 U.S. 569, 583 (1994).

320 *See* LEVIN, *supra* note 312, at 73.

321 MICHAEL REAL, MASS-MEDIATED CULTURE 84 (1973).

322 ROBERT JEWETT & JOHN SHELTON LAWRENCE, THE MYTH OF THE AMERICAN SUPERHERO 44 (2002).

nolds observes that "[f]or Americans, the historical path from Munich to Pearl Harbor coincides with the emergence of Superman and Captain America—solitary but socialized heroes who engage in battle from time to time as proxies of U.S. foreign policy."[323] These myths or semiotic connotations of Superman as the idealization of a heroic America, with its messianic overtones and both Captain America and Wonder Woman as emblems of American patriotism, are well-recognized by readers of DC and Marvel Comics around the world. Here, myths refer not simply to a falsehood, but to narrative tales which "function to express social values, norms of behaviors, and/or the consequences of deviating from them."[324] As themes of political content, power and responsibility, ability and disability, good and evil, as well as gender and eroticism continue to be explored through the semiotic signs of the superheroes, it is evident that different sets of moral, social, and ideological positions are personified by different superhero characters. It is upon the bedrock of the Golden Age of Superheroes created in the 1930s–1940s—like Superman, Batman, Captain America, and Wonder Woman—that other artistic works spring to challenge, deconstruct, and satirize these well-known modern myths. Artist R. Sumantri MS's controversial works in the *China New Supreme Power* series depict a number of battle scenes between the Golden Age superheroes and well-known Chinese deities all resulting in a devastating defeat of the American heroes.[325] This postmodern political commentary of the ascendancy of China and the decline of the United States as a global superpower is most effectively conveyed through the use of these superheroes whose semiotic meanings are arguably universally recognized. Such infringing uses of copyrighted characters in political speech would undoubtedly summon the attention of the First Amendment, and its recognition as such would add significantly to a more nuanced analysis of the fair use defense.

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[323] RICHARD REYNOLDS, SUPERHEROES: A MODERN MYTHOLOGY 17 (1994).

[324] STEPHEN L. HARRIS & GLORIA PLATZNER, CLASSICAL MYTHOLOGY: IMAGES AND INSIGHTS 13 (4th ed., 2004).

[325] For an analysis of the transformative use of the semiotic superhero signs, see David Tan, *The Transformative Potential of Countercultural Recoding in Copyright Law: A Study of Superheroes and Fair Use*, *in* DIVERSITY IN INTELLECTUAL PROPERTY: IDENTITIES, INTERESTS AND INTERSECTIONS 403 (Irene Calboli & Srividhya Ragavan eds., 2015).

CONCLUSION

It might be correct that "[b]ecause of the First Amendment principles built into copyright law through the idea/expression dichotomy and the doctrine of fair use, courts often need not entertain related First Amendment arguments in a copyright case."[326] But what this built-in accommodation entails is an obviation for the need for a separate or additional judicial scrutiny of copyright legislation so long as the doctrines of idea/expression dichotomy and fair use remain undisturbed. It does *not* mean that the rationales of the First Amendment or the degree of abridgment of speech should be completely ignored when evaluating fair use.

Leval's legacy has lasted twenty-five years and it is likely to continue to be the engine that will drive fair use jurisprudence in the Supreme Court and a majority of the Circuit Courts. The freedom to transformatively appropriate an original work in the service of creativity is not only compatible with the objectives of the Copyright Clause, but also advances the goals of the First Amendment. The first thing that usually springs to mind when one mentions books, songs, films, and art is how a restriction on their circulation might trespass on the First Amendment. Yet for the past two decades, the courts have deliberately skirted around any discussion of the First Amendment when addressing liability for copyright infringement.

The participatory theory of the First Amendment supports the protection of the making of "representations about self, identity, community, solidarity, and difference" or the articulation of political and social aspirations using these copyright signs within a "di-

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[326] Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257, 1265 (11th Cir. 2011); *see also* Eldred v. Reno, 239 F.3d 372, 376 (D.C. Cir. 2001) (holding that where the works in question are "by definition under copyright," the works are "on the latter half of the 'idea/expression dichotomy' [which] makes them subject to fair use. This obviates further inquiry under the First Amendment."); Nihon Keizai Shimbun, Inc. v. Comline Bus. Data, Inc., 166 F.3d 65, 74 (2d Cir. 1999) ("We have repeatedly rejected First Amendment challenges to injunctions from copyright infringement on the ground that First Amendment concerns are protected by and coextensive with the fair use doctrine."); L.A. News Serv. v. Tullo, 973 F.2d 791, 795 (9th Cir. 1992) ("First Amendment concerns are also addressed in the copyright field through the 'fair use' doctrine.").

alogic democracy"[327] as political speech. In First Amendment jurisprudence, certain recoded circulations can be viewed as a form of political activism characterized by their ability to "reverse perceptions of social devaluation or stigma, articulate alternative narratives of national understanding, and challenge exclusionary imaginaries of citizenship."[328] Propertizing expressive works enables the owner to restrict speech, impede the free flow of ideas, and control democratic dialogue. Copyright laws should ultimately aim to strike a balance between protecting, on the one hand, the proprietary right of the author/creator to economically exploit the fruits of his labor, and on the other hand, the right of others to proffer alternative insights, create new understandings, and express political viewpoints through connotative recoded uses of the copyrighted sign. It is only by reimagining the world of copyright as a semiotic universe that "the promise of First Amendment"[329] can be understood and its lost language recovered.

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[327] COOMBE, *supra* note 252, at 248–49.

[328] Raymen v. United Senior Ass'n, Inc., 409 F. Supp. 2d 15, 32 (D.D.C. 2006).

[329] LANGE & POWELL, *supra* note 210, at 124.