

No. 21-869

IN THE
Supreme Court of the United States

THE ANDY WARHOL FOUNDATION
FOR THE VISUAL ARTS, INC.,

Petitioner,

v.

LYNN GOLDSMITH AND LYNN GOLDSMITH, LTD.,

Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES
COURT OF APPEALS FOR THE SECOND CIRCUIT

**BRIEF OF *AMICUS CURIAE* NEW YORK
INTELLECTUAL PROPERTY LAW ASSOCIATION
IN SUPPORT OF NEITHER PARTY**

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INTEREST OF AMICI CURIAE¹

This amicus curiae brief is submitted on behalf of the New York Intellectual Property Law Association (“NYIPLA”).

The NYIPLA is a bar association of attorneys who practice in the area of patent, copyright, trademark, and other intellectual property (“IP”) law. It is one of the largest regional IP bar associations in the United States.

The NYIPLA’s members include various attorneys specializing in copyright law, including in-house counsel for businesses that own, enforce, and challenge copyrights, as well as attorneys in private practice who advise a wide array of clients on copyright matters and procure copyright registrations through the U.S. Copyright Office. NYIPLA’s members represent inventors, entrepreneurs, businesses, universities, and industry and trade associations.

The NYIPLA’s members and their clients have a strong interest in this case and regularly participate in copyright litigation on behalf of both plaintiffs and

¹ Pursuant to Supreme Court Rule 37.6, counsel for *amicus curiae* states that no counsel for a party authored this brief in whole or in part, and no one other than *amicus curiae* or its counsel made a monetary contribution intended to fund the preparation or submission of this brief. The parties have consented in writing to the filing of this brief by blanket consent.

defendants in federal court. The NYIPLA supports strong copyright protection, while acknowledging the importance of fair use, and is committed to ensuring that Congress strikes a balance between the exclusive rights of original creators and a meaningful fair use doctrine. The NYIPLA hereby submits its *amicus curiae* brief in support of neither party.²

SUMMARY OF THE ARGUMENT

This Court's test for transformativeness in the fair use analysis of a copyrighted work has been in place for nearly three decades and has been interpreted and applied in various forms to myriad scenarios by circuit and district courts across the country. This case affords an opportunity to clarify the standard and set forth a flexible rubric to accommodate for the various scenarios and applications to which it applies.

² The arguments made in this brief were approved by an absolute majority of the officers and members of the NYIPLA's Board of Directors, but do not necessarily reflect the views of a majority of the members of the Association, or of the law or corporate firms with which those members are associated. After reasonable investigation, the NYIPLA believes that no officer or director or member of the Amicus Briefs Committee who voted in favor of filing this brief, nor any attorney associated with any such officer, director or committee member in any law or corporate firm, represents a party to this litigation. Some officers, directors, committee members or associated attorneys may represent entities, including other *amici curiae*, which have an interest in other matters that may be affected by the outcome of this litigation.

As explained below, the NYIPLA respectfully asks this Court to clarify the transformative test outlined in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994), consistent with its other rulings, and undertake a “totality of circumstances” approach instead of holding that any one factor in the transformative test is necessarily dispositive. In particular, this Court should consider artistic intent and change of meaning as just one factor among many to determine the “purpose and character of the use” under the first prong of the Copyright Act’s fair use test. Such an approach would be consistent with how most circuit and district courts across the country have followed this Court’s jurisprudence to decide these fact-specific inquiries over the past three decades.

Here, however, the Second Circuit went too far by concluding that the artist’s subjective intent should not be considered as part of a fair use analysis. While courts should not become art critics, they are well suited to consider evidence of artistic intent and other factors from the artist herself as well as from other evidence, including from experts in the pertinent field. At the same time, the Second Circuit correctly noted that not all changes that add new aesthetics or expressions to the source materials necessarily satisfy the transformative inquiry. Indeed, the change in meaning must be sufficient *to change the purpose or character of the use* in order to differentiate between a

permitted fair use and a derivative work for which a license is needed.

While the proposed flexible rubric will make the transformativeness test more robust, the fair use inquiry should not end on that finding alone. Instead, the inquiry must necessarily consider whether the appropriation of a copyrighted work was necessary to accomplish the alleged transformative work. This prong of the analysis will ensure that the secondary work is in fact a justified fair use and strikes the appropriate balance of protecting both copyright owners and secondary users alike.

This approach will provide a highly flexible and thorough test for the fact-specific transformativeness analysis while at the same time ensuring the promotion of creativity, progress, and enrichment of the public with artistic works.

ARGUMENT

I. The Court Should Clarify That Its Transformative Test Employs a Totality of the Circumstances Approach

This Court's decisions in *Campbell* and *Google* set forth the central inquiry focused on whether a secondary work "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.’” *Campbell*, 510 U.S. at 579; *see also Google LLC v. Oracle America, Inc.*, 141 S. Ct. 1183, 1208-09 (2021). The instant case offers this Court the opportunity to clarify that its transformative test should consider artistic intent and change of meaning, not as the sole determinative factor as to whether the copying constitutes fair use, but as one factor among many to determine the “purpose and character of the use” under the first prong of the Copyright Act’s fair use test. 17 U.S.C. § 107.

Although the Court should not take on the role of an art critic in conducting its transformative analysis, courts are well suited to consider evidence of artistic intent, including through expert opinions in the field, and other extrinsic factors. To that end, this Court should adopt a holistic approach to the analysis akin to a totality of the circumstances approach. Here, the Second Circuit declined to consider the artist’s subjective intent as part of a fair use analysis, thereby limiting its inquiry to solely examining “whether the secondary work’s use of its source material is in service of a ‘fundamentally different and new’ artistic purpose and character, such that the secondary work stands apart from the ‘raw material’” used to create it. *Andy Warhol Foundation for Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 42 (2d Cir. 2021) (citing *Cariou v. Prince*, 714 F.3d 694, 706 (2d Cir. 2013)). In so doing, the Second Circuit’s approach unnecessarily truncated the analysis and did not consider that Andy Warhol, for instance, was widely known for creating

artwork that commented on how society views and consumes celebrity, such that the Prince Series might comprise a commentary on celebrity consistent with Mr. Warhol's reputation in the art community.

At the same time, however, the Second Circuit correctly held that not all changes that add a new aesthetic or new expression to its source material are necessarily transformative. *Id.* at 38. The change in meaning or purpose resulting from the transformation must change the purpose or character of the use. *Id.* at 42. This distinction is necessary to differentiate between a permissible fair use and derivative work for which a license is needed. As the Second Circuit correctly pointed out, the Copyright Act of 1976 defines a "derivative work" as a work based on one or more pre-existing works "in which a work may be recast, *transformed* or adapted." *Id.* at 36 (quoting 17 U.S.C. §101) (emphasis added).

Absent a transformation that changes the meaning or purpose of the underlying work, the line between derivative works and transformative fair use becomes hopelessly blurred. Consider, for example, a classic example of a derivative work, the stage or screen adaptation of a novel. A test for transformativeness that improperly considers only whether the meaning or message of the adaptation has changed from the original novel, without considering whether the fundamental character or purpose of the underlying

novel also has changed, renders any such screen or stage adaptation a possible fair use. Such a result will add confusion and uncertainty into the markets for such content, rather than the needed clarity.

By contrast, a holistic, totality of the circumstances test would allow for the necessary flexibility to account for the various situations that arise in connection with the first fair use factor. Indeed, Congress intended flexibility in the fair use test when it adopted a broad construction that left the courts “free to adapt the doctrine to particular situations on a case-by-case basis.” (H. R. Rep. No. 94-1476, 94th Cong., 2d Sess. 66 (1976)). Consistent with the Congressional intent, this Court has explained that the fair use analysis was an “equitable rule of reason” that “permits courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster.” *Stewart v. Abend*, 495 U.S. 207, 236 (1990).

II. The Court Should Delineate the Factors for Inclusion Under a Totality of the Circumstances Transformativeness Test

This case presents an opportunity for the Court to clarify the factors courts must consider when examining transformativeness under a totality of the circumstances approach. The foundation begins with this Court’s transformative test that courts across the country have applied through the consideration of

numerous and differing factors because such inquiries are necessarily highly fact-specific. These factors, outlined below, would provide the requisite guidance for courts to decide this fact-based inquiry based on the rubric the NYIPLA proposes:

- consideration of the secondary work with respect to its context or the particular circumstances relating thereto, *see Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1165 (9th Cir. 2007) (thumbnails of photographs for information purpose changed the context of the work for transformative purposes); *Brammer v. Violent Hues Prods. LLC*, 922 F.3d 255, 263 (4th Cir. 2019) (“even a wholesale reproduction may be transformed when placed in a new context to serve a different purpose”) (internal quotations omitted);
- the artistic intent (i.e., a subjective analysis), *Balsey v. LFP, Inc.*, 691 F.3d 747, 759 (6th Cir. 2012) (finding no transformative use because defendant “did not add any creative message or meaning to the photograph”);
- how the “work in question appears to the reasonable observer, not simply what an artist might say about a particular piece or body of work” (i.e., an objective analysis), *see Cariou*, 714 F.3d 694, 707 (2d Cir. 2013);
- whether there is “new information, new aesthetics, new insights and understandings,” *see Blanch v. Koons*, 467 F.3d 244, 251-52 (2d

Cir. 2006) (quoting *Castle Rock Entm't v. Carol Publ'g Grp., Inc.*, 150 F.3d 132, 142 (2d Cir. 1998)); *Fox News Network, LLC v. Tveyes, Inc.*, 883 F.3d 169, 176 (2d Cir. 2018);

- the function of the new work, *see A.V. ex rel. Vanderhye v. iParadigms, LLC*, 562 F.3d 630, 139 (4th Cir. 2009); *Perfect 10*, 508 F.3d at 1165;
- any “apparent” new expressive content or message, *see Seltzer v. Green Day, Inc.*, 725 F.3d 1170, 1177 (9th Cir. 2013) (“an allegedly infringing work is typically viewed as transformative as long as new expressive content or message is apparent”);
- whether a justification exists for the use along with a changed meaning or message behind the new work, *see Authors Guild v. Google Inc.*, 804 F.3d 202, 215 (2d Cir. 2015);
- “[t]he extent to which unlicensed material is used in the challenged work,” *see Bill Graham Archives v. Doring Kindersley, Ltd.*, 448 F.3d 605, 611 (2d Cir. 2006);
- whether the work simply removes objectionable content, *see Disney Enterprises v. VidAngel, Inc.*, 869 F.3d 848, 861 (9th Cir. 2017);
- whether the change relates simply to format, *see Dr. Seuss Enterprises, L.P. v. ComicMix LLC*, 983 F.3d 443, 454 (9th Cir. 2020), cert. denied, 141 S. Ct. 2803, 210 L. Ed. 2d 933

(2021) (no transformative use found where a work was “merely repackaged into a new format”); and

- whether the change merely abridges content, *see Penguin Random House LLC v. Colting*, 270 F. Supp. 3d 736, 750 (S.D.N.Y. 2017) (“U.S. law no longer protects abridgements as fair use”); *see also Folsom v. Marsh*, 9 F.Cas. 342, 344–45 (C.C.D. Mass. 1841).

Although other factors can be derived from the various circuit and district court cases that have applied this Court’s *Campbell* test, the salient point is that numerous factors have been and should be considered based on the particular facts and circumstances presented to courts in each individual case. Under a totality of the circumstances analysis, courts can continue to conduct these fact-specific analyses by using the aforementioned factors to provide certainty and clarity and without undue restriction.

III. The Purpose and Character Inquiry Should Also Consider Whether the Use of the Copyrighted Work Was Necessary or Could Have Been Accomplished by Using Non-Protectable Material

While a totality of the circumstances approach is necessary, the determination of the first fair use factor should not terminate upon the inquiry of transformativeness. Rather, even if a work is transformative, the court should also require

consideration of whether the appropriation of the original work was necessary to accomplish the alleged transformative purpose. As commentators have explained, “while the preamble directs the courts to determine whether the use is of a type potentially qualifying as a fair use, the first factor directs the courts to examine whether the particular use made of copyrighted material was *necessary* to the asserted purpose of criticism, comment, etc., or instead, whether defendant’s purpose could have been accomplished by taking nonprotectable material such as facts, ideas, or less expression.” 2 William F. Patry, *Patry On Fair Use* § 3.1 (May 2018 ed.) (emphasis added).

By analyzing whether the appropriation was necessary, a court can determine whether the secondary work is in fact transformative or instead, simply a gratuitous use of the copyrighted work. This part of the analysis is crucial because “[i]n analyzing a fair use defense, it is not sufficient simply to conclude whether or not justification exists [but instead] [t]he question remains how powerful, or persuasive, is the justification, because the court must weigh the strength of the secondary user’s justification against factors favoring the copyright owner.” Pierre N. Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105, 1111 (1990).

As applied to the instant matter, once the Court determines whether Warhol’s works at issue are

transformative and have a different purpose or meaning than Ms. Goldsmith's photo, the question becomes whether the appropriation of Ms. Goldsmith's photo was necessary to accomplish Warhol's purpose. If Warhol's artistic purpose was to parody or comment on Ms. Goldsmith's photo or the understanding or presentation of celebrity in America as shown in her photo, then copying elements of the photo may be necessary to the purpose, as was made clear by this Court in the context of a parody. *See Campbell*, 510 U.S. at 581-83 (parody of Roy Orbison song). That said, if Warhol's purpose in creating the Prince Series was to comment on celebrity in America, how necessary to that purpose was Warhol's use of Ms. Goldsmith's photo? If it was not necessary, then using Ms. Goldsmith's photo may be an act for which a licensing fee would be appropriate.

CONCLUSION

For these reasons, the Court should clarify its prior jurisprudence regarding transformativeness.

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Respectfully submitted,

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