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 FOR PETITIONER

ANDREW GASS
JOSEPH R. WETZEL
LATHAM & WATKINS LLP
505 Montgomery Street
San Francisco, CA 94111
(415) 391-0600

SAMIR DEGER-SEN
PETER TROMBLY*
LATHAM & WATKINS LLP
1271 Avenue of the Americas
New York, NY 10020
(212) 906-1200

ROMAN MARTINEZ
Counsel of Record
SARANG VIJAY DAMLE
ELANA NIGHTINGALE DAWSON
CHERISH A. DRAIN
LATHAM & WATKINS LLP
555 11th Street, NW
Suite 1000
Washington, DC 20004
(202) 637-3377
roman.martinez@lw.com

Counsel for Petitioner

QUESTION PRESENTED

This Court has repeatedly made clear that a work of art is "transformative" for purposes of fair use under the Copyright Act if it conveys a different "meaning[] or message" from its source material. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994); *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1202 (2021). In the decision below, the Second Circuit nonetheless held that a court is in fact forbidden from trying to "ascertain the intent behind or meaning of the works at issue." Pet. App. 22a-23a. Instead, the court concluded that even where a new work indisputably conveys a distinct meaning or message, the work is not transformative if it "recognizably deriv[es] from, and retain[s] the essential elements of, its source material." *Id.* at 24a. The question presented is:

Whether a work of art is "transformative" when it conveys a different meaning or message from its source material (as this Court, the Ninth Circuit, and other courts of appeals have held), or whether a court is forbidden from considering the meaning of the accused work where it "recognizably deriv[es] from" its source material (as the Second Circuit has held).

PARTIES TO THE PROCEEDINGS BELOW

Petitioner The Andy Warhol Foundation for the Visual Arts, Inc. was a plaintiff-counter-defendant-appellee in the U.S. Court of Appeals for the Second Circuit.

Respondents Lynn Goldsmith and Lynn Goldsmith, Ltd. were defendants-counter-plaintiffs-appellants in the U.S. Court of Appeals for the Second Circuit.

RULE 29.6 DISCLOSURE STATEMENT

Petitioner The Andy Warhol Foundation for the Visual Arts, Inc. has no parent corporation, and no publicly held corporation owns 10 percent or more of its stock.

RELATED PROCEEDINGS

The proceedings directly related to this case are:

Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith, No. 19-2420, U.S. Court of Appeals for the Second Circuit. Amended judgment entered on August 24, 2021. Petition for rehearing en banc denied on September 10, 2021.

Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith, No. 1:7-cv-02532-JGK, U.S. District Court for the Southern District of New York. Judgment entered July 15, 2019. Notice of appeal filed August 7, 2019.

TABLE OF CONTENTS

Page

QUESTION PRESENTED i

PARTIES TO THE PROCEEDINGS BELOW..... ii

RULE 29.6 DISCLOSURE STATEMENT ii

RELATED PROCEEDINGS ii

TABLE OF AUTHORITIES..... vi

OPINIONS BELOW.....1

JURISDICTION.....1

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED.....1

INTRODUCTION.....2

STATEMENT OF THE CASE.....4

A. The Copyright Act's Protection Of Free Expression.....4

B. Warhol's Prince Series.....9

C. Procedural History.....22

SUMMARY OF ARGUMENT.....29

ARGUMENT 33

I. The Prince Series Is Transformative 33

A. Under *Campbell*, A Follow-On Work Is Transformative If It Can Reasonably Be Perceived As Communicating A New Meaning Or Message 33

TABLE OF CONTENTS—Continued

Page

B. *Campbell*'s Meaning-Or-Message Test Aligns With The Copyright Act's Text, Purpose, And History 37

C. The Prince Series Can Reasonably Be Perceived To Communicate A New Meaning Or Message 44

II. The Second Circuit Wrongly Departed From *Campbell*'s Meaning-Or-Message Test 46

A. The Second Circuit's Approach Violates This Court's Precedent And Is Unworkable 46

B. The Second Circuit's Cramped Understanding Of Transformative Use Would Harm Artists And The Public 53

CONCLUSION 57

ADDENDUM

U.S. Const. art. I, § 8, cl. 8 ..... 1a

U.S. Const. amend. I 2a

17 U.S.C. § 101 ..... 3a

17 U.S.C. § 102 ..... 5a

17 U.S.C. § 103 ..... 6a

17 U.S.C. § 106 ..... 7a

17 U.S.C. § 107 ..... 8a

17 U.S.C. § 109(a), (c) 9a

17 U.S.C. § 502 ..... 11a

TABLE OF CONTENTS—Continued

Page

17 U.S.C. § 503 ..... 12a

17 U.S.C. § 504 ..... 14a

17 U.S.C. § 507(b) 17a

TABLE OF AUTHORITIES

Page(s)

CASES

Acuff-Rose Music, Inc. v. Campbell,
972 F.2d 1429 (6th Cir. 1992).....34

Authors Guild v. Google, Inc.,
804 F.3d 202 (2d Cir. 2015), *cert. denied*,
578 U.S. 941 (2016).....52

Authors Guild, Inc. v. HathiTrust,
755 F.3d 87 (2d Cir. 2014).....51

Baker v. Selden,
101 U.S. 99 (1879).....5

Burrow-Giles Lithographic Co. v. Sarony,
111 U.S. 53 (1884).....5

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

Cary v. Kearsley,
170 Eng. Rep. 679 (1803).....39

Eldred v. Ashcroft,
537 U.S. 186 (2003).....4, 30, 42, 43

Emerson v. Davies,
8 F. Cas. 615 (C.C.D. Mass. 1845).....39

Feist Publications, Inc. v. Rural Telephone Service Co.,
499 U.S. 340 (1991).....6

TABLE OF AUTHORITIES—Continued

Page(s)

Folsom v. Marsh,
9 F. Cas. 342 (1841) 37, 39

Fox Film Corp. v. Doyal,
286 U.S. 123 (1932).....40

Golan v. Holder,
565 U.S. 302 (2012).....5, 8, 42, 43

Google LLC v. Oracle America, Inc.,
141 S. Ct. 1183 (2021).....*passim*

Gyles v. Wilcox,
26 Eng. Rep. 489 (1740).....39

Harper & Row Publishers, Inc. v. Nation Enterprises,
471 U.S. 539 (1985).....4, 8, 38

Litchfield v. Spielberg,
736 F.2d 1352 (9th Cir. 1984), *cert. denied*, 470 U.S. 1052 (1985).....50

Maxtone-Graham v. Burtchaell,
803 F.2d 1253 (2d Cir. 1986), *cert. denied*, 481 U.S. 1059 (1987).....42

Mills Music, Inc. v. Snyder,
469 U.S. 153 (1985).....5

Nutt v. National Institute Inc. for the Improvement of Memory,
31 F.2d 236 (2d Cir. 1929) 42

TABLE OF AUTHORITIES—Continued

Page(s)

Peter F. Gaito Architecture, LLC v. Simone Development Corp., 602 F.3d 57 (2d Cir. 2010) 50

Police Department of the City of Chicago v. Mosley, 408 U.S. 92 (1972).....43

Rentmeester v. Nike, Inc., 883 F.3d 1111 (9th Cir. 2018), *cert. denied*, 139 S. Ct. 1375 (2019).....6, 50

Rogers v. Koons, 960 F.2d 301 (2d Cir.), *cert. denied*, 506 U.S. 934 (1992).....5

Sampson & Murdock Co. v. Seaver-Radford Co., 140 F. 539 (1st Cir. 1905) 40

Sony Corp. of America v. Universal City Studios, Inc., 464 U.S. 417 (1984).....4, 8, 40

Stewart v. Abend, 495 U.S. 207 (1990).....8, 39

Suntrust Bank v. Houghton Mifflin Co., 268 F.3d 1257 (11th Cir. 2001).....43

Twentieth Century Music Corp. v. Aiken, 422 U.S. 151 (1975).....40

TABLE OF AUTHORITIES—Continued

Page(s)

CONSTITUTIONAL AND STATUTORY PROVISIONS

U.S. Const. art. I, § 8, cl. 8 ..... 4, 38

17 U.S.C. § 101 ..... 6, 51

17 U.S.C. § 102(a) 5

17 U.S.C. § 102(b) 5

17 U.S.C. § 103(a) 7, 54

17 U.S.C. § 106(2) 6, 51

17 U.S.C. § 106(3) 6, 55

17 U.S.C. § 106(5) 6, 55

17 U.S.C. § 107 ..... 8, 41, 51

17 U.S.C. § 107(1) 33, 37

17 U.S.C. § 109(a) 6, 55

17 U.S.C. § 109(c) 6, 55

17 U.S.C. § 503 ..... 7, 56

17 U.S.C. § 504(b) 7

17 U.S.C. § 504(c) 7

17 U.S.C. § 507(b) 23

TABLE OF AUTHORITIES—Continued

Page(s)

28 U.S.C. § 1254(1).....1

Act of May 31, 1790, 1 Stat. 124.....4

OTHER AUTHORITIES

8 Anne C.19 (1710).....38

Blake Gopnik, *Warhol* (2020) 11, 14

Blake Gopnik, *Warhol a Lame Copier? The Judges Who Said So Are Sadly Mistaken*, N.Y. Times (updated Sept. 24, 2021), https://www.nytimes.com/2021/04/05/arts/design/warhol-copyright-appeals-court.html.....54

H.R. Rep. No. 60-2222 (1909) 4

H.R. Rep. No. 94-1476 (1976) 8, 41

Pierre N. Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105 (1990).....9, 38, 39

Naomi Martin, *Andy Warhol Portraits: A Definitive Guide*, Artland Magazine, https://magazine.artland.com/andy-warhol-portraits-a-definitive-guide/ (last visited June 8, 2022).....14

TABLE OF AUTHORITIES—Continued

Page(s)

Masterworks Fine Art Gallery, Andy Warhol Marilyn Monroe, https://www.masterworksfineart.com/artists/andy-warhol/marilyn-monroe (last visited June 8, 2022) 12

Museum of Modern Art, *Andy Warhol, Campbell's Soup Cans*, 1962, https://www.moma.org/collection/works/79809 (last visited June 8, 2022) 28

Museum of Modern Art Learning, *Pop Art*, https://www.moma.org/learn/moma_learning/themes/pop-art/ (last visited June 8, 2022) 10

National Gallery of Art, Andy Warhol, *Green Marilyn,* 1962, https://www.nga.gov/collection/art-object-page.72039.html (last visited June 8, 2022) 54

National Gallery of Art, Roy Lichtenstein, *Look Mickey*, 1961, https://www.nga.gov/collection/art-object-page.71479.html (last visited June 8, 2022) 54

4 Melville Nimmer & David Nimmer, *Nimmer on Copyright* (2022) 6, 29, 36, 50

TABLE OF AUTHORITIES—Continued

Page(s)

L. Ray Patterson, *Understanding the Copyright Clause*, 47 J. Copyright Soc'y USA 365 (2000) 38

Platon, *Prince*, http://www.platonphoto.com/gallery/portraits/music/prince/ (last visited June 8, 2022) 17

Robin Pogrebin, *Warhol's 'Marilyn,' at $195 Million, Shatters Auction Record for an American Artist*, N.Y. Times (May 9, 2022), https://www.nytimes.com/2022/05/09/arts/design/warhol-auction-marilyn-monroe.html 55

Karen Rosenberg, *For Andy Warhol, Faith and Sexuality Intertwined*, N.Y. Times (Dec. 2, 2021), https://www.nytimes.com/2021/12/02/arts/design/warhol-religion-museum-review-catholic.html 14

Tony Scherman & David Dalton, *POP: The Genius of Andy Warhol* (Harper 2009) 10

Kenneth Silver, *Modes of Disclosure: The Construction of Gay Identity and the Rise of Pop Art*, https://aestheticapperceptions.files.wordpress.com/2013/01/silver_modes_of_disclosure.pdf 13

TABLE OF AUTHORITIES—Continued

Page(s)

Smithsonian Institution, CollectionsSearchCenter, https://collections.si.edu/search/ (last visited June 8, 2022) 10

Ned Snow, *The Forgotten Right of Fair Use*, 62 Case W. Res. L. Rev. 135 (2011) 43

Brianne Tracy, *Prince Like You've Never Seen Him Before*, People (July 15, 2019), https://people.com/music/prince-rare-photos-jeff-katz-exclusive/ 17

Tristan Vox, *Purple Fame*, Vanity Fair (Nov. 1984), https://archive.vanityfair.com/article/1984/11/purple-fame 18

Webster's New World Dictionary of the American Language (1970) 41

OPINIONS BELOW

The amended panel decision (Pet. App. 1a-52a) is reported at 11 F.4th 26 (2d Cir. 2021), and the original decision (JA601-51) is reported at 992 F.3d 99 (2d Cir. 2021). The order denying rehearing en banc (Pet. App. 84a-85a) is unpublished. The district court's order granting summary judgment to petitioner (Pet. App. 53a-83a) is published at 382 F. Supp. 3d 312 (S.D.N.Y. 2019).

JURISDICTION

On March 26, 2021, the Second Circuit reversed the district court's judgment. JA601-51. On August 24, 2021, the court granted petitioner's petition for panel rehearing, withdrew the original opinion, and issued an amended opinion. Pet. App. 1a-52a. On September 10, 2021, the court denied petitioner's petition for rehearing en banc. Pet. App. 84a-85a. This Court has jurisdiction under 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

The relevant constitutional and statutory provisions are set out in the addendum to this brief.

INTRODUCTION

This case presents the question whether a creative work that conveys a new meaning or message is transformative for purposes of the Copyright Act's fair use defense. Sharply breaking with this Court's precedent, the Second Circuit found that Andy Warhol's Prince Series—a set of hand-crafted artistic works that have been displayed in museums and galleries for decades—was not transformative, even though all agree it conveyed a message distinct from its photographic source material. In so holding, the court expressly rejected a transformativeness test that considers the meaning or message of an artistic work as part of the fair use analysis—and instead mandated an inquiry focused on the degree of visual similarity between the two works. That approach has no basis in this Court's precedent or in the text, purpose, or history of the Copyright Act. If embraced by this Court, it would upend settled copyright principles and chill creativity and expression at the heart of the First Amendment. The decision below should be reversed.

In *Campbell v. Acuff-Rose Music, Inc.*, this Court made clear that a follow-on work is considered "transformative"—and thus satisfies the first factor of the statutory fair use defense—if it "adds something new, with a further purpose or different character, altering the first [work] with new expression, meaning, or message.'" 510 U.S. 569, 579 (1994); *see also Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1202 (2021). This straightforward meaning-or-message test corresponds with the core purpose of the fair use defense, which is to provide "breathing space" for creators to use pre-existing material to communicate innovative ideas to the public.

Campbell, 510 U.S. at 579. It also aligns with the text, history, and purpose of the Copyright Act, which all ensure that genuinely novel expression is encouraged—not suppressed—by law, just as the First Amendment envisions.

The Second Circuit's decision below threatens those foundational principles. It holds that a court conducting the fair use inquiry is actually *forbidden* from "seek[ing] to ascertain" the "meaning" of a follow-on work. Pet. App. 22a-23a. Instead, even where a new work indisputably conveys a distinct meaning or message, the work is not transformative if it "recognizably deriv[es] from, and retain[s] the essential elements of, its source material." *Id.* at 23a-24a. On that basis, the Second Circuit found that Andy Warhol's Prince Series was unlawful, because it bore too close a visual resemblance to a source photograph by rock-and-roll photographer Lynn Goldsmith. That was the outcome below even though the Second Circuit and the district court both recognized that the Prince Series communicated a fundamentally different idea from the photograph.

If adopted by this Court, the Second Circuit's rule would chill artistic speech by substantially foreclosing an entire category of creative expression from the protection of the fair use doctrine. That result defies this Court's precedent, subverts the purposes of the Copyright Act, and strikes at core First Amendment values. Copyright law is designed to foster innovation and creativity—even when that innovation recognizably builds on the achievements of others. This Court should reaffirm its historical commitment to free expression and reverse the decision below.

STATEMENT OF THE CASE

A. The Copyright Act's Protection Of Free Expression

1. The Constitution provides that "Congress shall have Power . . . To promote the Progress of Science and useful Arts[] by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. Const. art. I, § 8, cl. 8.

This Court has long recognized that the "monopoly privileges that Congress may authorize" under the Copyright Clause "are neither unlimited nor primarily designed to provide a special private benefit." *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984). Instead, the "limited grant" of copyright protection "rewards the individual author" instrumentally, in order to "benefit the public." *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 546 (1985); *cf.* H.R. Rep. No. 60-2222, at 7 (1909) (noting that copyrights are granted "[n]ot primarily for the benefit of the author, but primarily for the benefit of the public").

The core public interest served by copyright law is "the creation and publication of free expression." *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003). The limits of copyright protection accordingly must be "construed in light of th[e] basic purpose" of "stimulat[ing] artistic creativity for the general public good." *Sony Corp.*, 464 U.S. at 432.

2. In 1790, the First Congress enacted the country's first copyright statute. Act of May 31, 1790, § 1, 1 Stat. 124, 124. Subsequent Congresses substantially revised the statute in 1831, 1870, and 1909. The most recent major overhaul culminated in

the Copyright Act of 1976. *Mills Music, Inc. v. Snyder*, 469 U.S. 153, 159-61 (1985).

Under the 1976 Act, "[c]opyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression." 17 U.S.C. § 102(a). But copyright protection does not "extend to any idea, . . . concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work." *Id.* § 102(b). This reflects the common law's historic differentiation between ideas, which are not copyrightable, and the form in which those ideas are expressed, which is protectable. *See Golan v. Holder*, 565 U.S. 302, 328 (2012); *see also Baker v. Selden*, 101 U.S. 99, 100-06 (1879).

Photographs present difficult questions under copyright law because they typically include *non*-copyrightable elements, making it hard to identify precisely what the photographer's copyrightable creativity encompasses. In *Burrow-Giles Lithographic Co. v. Sarony*, the Court concluded that photographs are protected only "so far as they are representatives of original intellectual conceptions of the author." 111 U.S. 53, 58 (1884). Specifically, the Court identified the photographer's selection and arrangement of the subject's attire, arrangement of "light and shade," and evocation of "the desired expression" on the part of the subject as the "original," and therefore copyright-protected, portions of the photograph. *Id.* at 60. Since then, courts have likewise held that elements of originality "may include posing the subjects, lighting, angle, selection of film and camera, evoking the desired expression," among other things. *Rogers v. Koons*, 960 F.2d 301, 307 (2d Cir. 1992). But if the photograph depicts an

individual, a photographer may not copyright the subject of the photograph, including their facial features, nor can the photographer "copyright the pose itself and thereby prevent others from photographing a person in the same pose." *Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1119 (9th Cir. 2018).

The copyright statute grants a copyright holder certain "exclusive rights," including to reproduce, distribute, and display the copyrighted work, as well as to prepare "derivative works based upon the copyrighted work." 17 U.S.C. § 106(2). A "derivative work" is one "based upon one or more preexisting works, such as a translation, . . . motion picture version, . . . art reproduction, . . . or any other form in which a work may be recast, transformed, or adapted." *Id.* § 101.

To prove copyright infringement, a plaintiff must establish: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original and protectable. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991). To qualify as "actionable copying" under the second prong, the follow-on work must be "substantially similar" to the original. 4 Melville Nimmer & David Nimmer, *Nimmer on Copyright* § 13.03[A] (2022). In the context of visual art, publicly displaying a work deemed to infringe the rights of another, such as by hanging an infringing painting on the wall of a museum, is independently actionable, 17 U.S.C. §§ 106(5), 109(c), and the owner of an infringing painting cannot lawfully resell it, *id.* §§ 106(3), 109(a).

The Copyright Act authorizes a range of remedies for infringement. These include "impoundment" and

"destruction" of objects that embody infringing material. *Id.* § 503. A plaintiff can also seek either (1) actual damages plus the follow-on user's profits, *id.* § 504(b), or (2) statutory damages of up to $30,000 for non-willful infringement and $150,000 for willful infringement, *id.* § 504(c). Creators of infringing works have no right to reap any reward from their incremental contributions, and no ability to prevent others from exploiting them. *Id.* § 103(a).

3. Copyright law has always recognized that creative works often build on pre-existing material. When they do, even if the incorporation of such material constitutes a *prima facie* act of infringement of one of Section 106's exclusive rights, the new work is not actionable if it qualifies as a "fair use."

The Copyright Act recognizes this common-law fair use defense as an express limitation on copyright owners' exclusive rights:

> Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, 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—
>
> (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.

17 U.S.C. § 107.

The fair use doctrine, which dates back at least to the 19th century, reflects the longstanding recognition that a "rigid application of the copyright statute" would "stifle the very creativity which that law was designed to foster." *Campbell*, 510 U.S. at 577 (quoting *Stewart v. Abend*, 495 U.S. 207, 236 (1990)); *see also Google*, 141 S. Ct. at 1196. The doctrine is not susceptible to "bright line" rules, but must instead be applied as an "equitable rule of reason," *Sony Corp.*, 464 U.S. at 448 n.31, 454-55 & n.40, with each case "decided on its own facts," *Harper & Row*, 471 U.S. at 560 (quoting H.R. Rep. No. 94-1476, at 65 (1976)). By providing a safety valve to liability for innovation and creative expression, fair use protects essential First Amendment values that would otherwise be burdened by copyright. *Golan*, 565 U.S. at 328-29.

4. This case centers on the first statutory fair use factor, addressing the "purpose and character of the use." The factor is designed to assess whether the use of pre-existing content in a follow-on work "fulfill[s] the objective of copyright law to stimulate creativity

for public illumination" and, as a result, "is vitally important to the fair use inquiry." Pierre N. Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105, 1111 (1990) (hereinafter "Leval").

In *Campbell*, this Court set forth the test for assessing whether the first factor is satisfied. The Court explained that the central question is "whether the new work merely 'supersede[s] the objects' of the original creation, . . . or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message." *Campbell*, 510 U.S. at 579. Where a follow-on work meets that criteria, it is considered "transformative." *Id.* (quoting Leval 1111).

Although transformative use is not required for fair use, "the more transformative the new work, the less will be the significance of the other factors . . . that may weigh against a finding of fair use." *Id.* Moreover, as this Court has explained, "the four statutory factors [cannot] be treated in isolation, one from another." *Id.* at 578. Indeed, a finding of transformative use will typically make it easier to satisfy the third and fourth factors, because it justifies a greater degree of copying and renders the new work less likely to operate as a market substitute for the original it borrows from. *Id.* at 586-87, 591.

B. Warhol's Prince Series

1. Andy Warhol is one of the most significant and innovative American artists of the twentieth century. As one expert put it, "[N]o museum gallery on the planet could consider itself representative of Contemporary Art without a Warhol somewhere on its walls." JA449. Warhol's works are found in premier collections across the world, including those

of the Museum of Modern Art in New York and the Tate Modern in London. JA450. The Smithsonian collection likewise includes many dozens of different works by Warhol. *See* Smithsonian Institution, CollectionsSearchCenter, https://collections.si.edu/search/ (last visited June 8, 2022).

Warhol is one of many artists who made up the Pop Art movement that emerged in Britain and the United States in the mid- to late-1950s. Museum of Modern Art Learning, *Pop Art*, https://www.moma.org/learn/moma_learning/themes/pop-art/ (last visited June 8, 2022). Members of the movement "made art that mirrored, critiqued, and, at times, incorporated everyday items, consumer goods, and mass media messaging and imagery." *Id.*

From the outset of his career, "Warhol was an avid student of media: he was acutely aware of the way images are produced, distributed, and consumed in contemporary culture." JA452. Warhol's art reflects those observations and insights, depicting images of diverse subjects, from everyday objects like soup cans and bicycles to celebrities and other public figures. JA453. From his depictions of money, which "operates as a cultural sign," to celebrities of the "movie industry," the power of images and the role they play in contemporary life are some of the dominant themes of Warhol's art. JA453-54.

While other members of the Pop Art movement sometimes "cast a[] contemptuous . . . eye on commercial culture," Warhol "adopted a very different perspective." Tony Scherman & David Dalton, *POP: The Genius of Andy Warhol* at 51 (Harper 2009). His art "unapologetically depicted [celebrities] as idols." *Id.* at 52; *see also* JA241 (expert testimony noting that Warhol's work reflects the "major characteristics of

recent consumer society and the way it works in people's subjective imaginations").

Warhol's celebrity depictions are among his best known works. JA458. His subjects ranged from Marilyn Monroe to Muhammad Ali. In crafting these renditions of people famous in popular culture, Warhol often utilized techniques that were pioneering in the world of fine art—but applied them to subjects that had often been viewed as too low-brow to warrant inclusion in the Western canon. *See* Blake Gopnik, *Warhol* 272 (2020) (discussing Warhol's use of silkscreening).

For example, to create his now-ubiquitous depictions of Monroe, Warhol started with a black-and-white photorealistic image. JA459; JA157-58. He then cropped Monroe from the neckline up, essentially "severing the head from the shoulders and bust," which "produc[ed] the disembodied effect of a cinematic close-up." JA459. Whereas the source photograph recorded the full range of color tones, Warhol eliminated that graded spectrum; instead, he created high-contrast images for his silkscreens, reducing the gray scale to produce an exaggerated, unnatural distinction between black and white, with nothing in between. JA460; JA164. This process would flatten the appearance of the underlying subject and remove all realism and depth. JA461; JA214.

The outline of the cropped image was then hand-drawn by Warhol on a canvas and painted over using bright, artificial, and exotic-colored synthetic polymer paints that had a flat consistency and industrial appearance. JA465; JA165. Warhol then used the high-contrast silkscreen he had created to screen the image onto the painted canvas. JA164-66. Below are

the silkscreen portraits of Monroe that Warhol created in 1967 using that technique, beneath the original promotional image:

See JA158; Masterworks Fine Art Gallery, Andy Warhol Marilyn Monroe, https://www.masterworksfineart.com/artists/andy-warhol/marilyn-monroe (last visited June 8, 2022).

Warhol utilized a similar process for his depiction of Muhammad Ali, taking an image of Ali's torso and focusing in narrowly on just the subject's fist before remaking the image:

JA173; JA170. "In the repetition of images, the off-register printing, and the general lack of nuance, Warhol's portraits of stars reveal their source in the daily newspaper and the fan magazines, those halfway houses between fact and fiction." Kenneth Silver, *Modes of Disclosure: The Construction of Gay Identity and the Rise of Pop Art* 197, https://aestheticapperceptions.files.wordpress.com/2013/01/silver_modes_of_disclosure.pdf.

Warhol's celebrity images are the subject of countless art history treatises, exhibitions, and commentaries. They are often understood to comment on the nature of fame in 20th century American society, beyond simply depicting a famous person. Warhol was working in "the wake of a boom of mass-consumption," where celebrity imagery proliferated unlike any time previously—making celebrities at once a familiar feature of daily life, and another "consumable and expendable

product." Naomi Martin, *Andy Warhol Portraits: A Definitive Guide*, Artland Magazine, https://magazine.artland.com/andy-warhol-portraits-a-definitive-guide/ (last visited June 8, 2022).

By presenting a disembodied head, or body part, and doing so with wholly unrealistic colors—yet still giving the viewer enough to identify the subject and evoke essentially all he knows about them—Warhol showed that the viewer sees celebrities not as real people, but as icons and totems of fame itself. JA238 (expert stating the images do not portray "the actual individual in any kind of depth"); *see also* Gopnik, *supra*, at 268 (Warhol's silkscreen of Elizabeth Taylor "turned the painted face of a human being . . . into something as 'blank, blunt, bleak, stark' as any consumable product—which was precisely what Hollywood's media machine had made of Liz"). The meaning and message in Warhol's works has been studied, identified, and articulated by generations of art history scholars, curators, journalists, and everyday museum-goers. *See, e.g.*, Karen Rosenberg, *For Andy Warhol, Faith and Sexuality Intertwined*, N.Y. Times (Dec. 2, 2021), https://www.nytimes.com/2021/12/02/arts/design/warhol-religion-museum-review-catholic.html.

2. Lynn Goldsmith is a self-described "rock-and-roll photographer," who sells her work primarily through galleries focusing on pictures of rock stars and to collectors interested in realistic photographs of musicians. JA478; JA589-90. Goldsmith's goal in creating her works is to connect with her subjects to "help[] [them] formulate their identities" and "capture her subjects' 'true selves.'" Pet. App. 55a; JA478-83; JA267-68. Goldsmith thus seeks to humanize those she photographs. JA479.

In December 1981, Goldsmith photographed the pop singer Prince at her studio while on assignment for *Newsweek* magazine. JA488. Prince arrived wearing makeup and the same clothes and hairstyle shown in the photographs taken, except for a black sash that Prince selected from Goldsmith's clothing room. Pet. App. 56a; JA490-91; JA276-79. Goldsmith testified that she gave Prince lip gloss to let him know she was "looking after him," and applied additional eyeshadow because of her "feeling [that] Prince was in touch with the female part of himself." JA489-90. By her own account, Goldsmith intended to capture a "vulnerable human being." Pet. App. 57a (quoting JA494). Goldsmith explained that the photographs from the shoot show Prince as "fragile" and "not a comfortable person." *Id.*; JA283-84.

JA320; JA501.

Goldsmith is not the only (or even the first) photographer to shoot a front-on photograph of Prince's face and torso. For example, Prince's cover art for his 1981 album, Controversy, was taken by the photographer Allen Beaulieu.

JA397.

In addition to that album cover, there have been scores of front-on photographs taken of Prince, four of which are reproduced below:

Platon, *Prince*, http://www.platonphoto.com/gallery/portraits/music/prince/ (last visited June 8, 2022); Brianne Tracy, *Prince Like You've Never Seen Him Before*, People (July 15, 2019), https://people.com/music/prince-rare-photos-jeff-katz-exclusive/; JA399-400.

In 1984, *Vanity Fair* was preparing a magazine article on Prince, to be entitled "Purple Fame." JA524. The piece focused on Prince's ascendancy to celebrity, asserting that "escape from Prince is no longer possible," and culminating in the punch-line, "he presents a dream." *Id.*; Tristan Vox, *Purple Fame*, Vanity Fair (Nov. 1984), https://archive.vanityfair.com/article/1984/11/purple-fame. In light of these themes, the magazine commissioned Warhol to create art depicting Prince to accompany the article. After all, "Warhol was known, more than any other artist, to have made fame his defining subject." JA221.

Vanity Fair wanted to give Warhol an "artist's reference" to start from. JA499; JA505. It chose one of Goldsmith's photographs of Prince from the 1981 shoot. JA505. Goldsmith's company, in turn, granted *Vanity Fair* the express right to use the photograph as "an artist reference for an illustration to be published in Vanity Fair November 1984 issue," further providing that "it can appear one time full page and one time under one quarter page. No other usage right granted." JA85 (capitalization normalized). There is no record evidence of any written engagement between *Vanity Fair* and Warhol, or that *Vanity Fair* communicated to Warhol the terms of its license from Goldsmith.

Warhol proceeded to create twelve silkscreen paintings, two screen prints on paper, and two drawings (collectively, the "Prince Series"). All of the works depicted Prince's head and a small portion of his neckline in Warhol's characteristic style. Pet. App. 60a; JA505-06. Starting from Goldsmith's photograph, Warhol cropped the image to remove Prince's torso, resized it, altered the angle of Prince's face, and changed tones, lighting, and detail. JA222-

23. Warhol also added layers of bright and unnatural colors, conspicuous hand-drawn outlines and line screens, and stark black shading that exaggerated Prince's features. JA223-24. The result in all the Prince Series works is a flat, impersonal, disembodied, mask-like appearance. Pet. App. 77a-78a.

See JA505-06.

As Dr. Thomas Crow, a leading Warhol scholar at New York University's Institute of Fine Arts, later explained, the Prince Series used the tools of visual art to express a completely different message than Goldsmith's original photograph. While based on the photo as an initial referent, Warhol's works reflect distinctive changes that communicate a comment on the dehumanizing nature of celebrity. JA227. Using his characteristic techniques, Warhol created "an image of Prince as a kind of icon or totem of something rather than just being the actual human being that made the music." JA257. Whereas Goldsmith's photograph had focused on Prince's "unique human identity," Warhol's work "sought to use the flattened, cropped, exotically colored, and unnatural depiction of Prince's disembodied head to communicate a message about the impact of celebrity and . . . the contemporary conditions of life," turning an intimate image of Prince into a "mask-like simulacrum of his actual existence." JA227; JA249. In doing so, Warhol created "a kind of barrier between [the] viewer and whatever [Prince's] inner life might be." JA255.

3. Vanity Fair ultimately published one of the Prince Series works alongside the "Purple Fame" article in its November 1984 edition. Pet. App. 58a; JA524.

Better the sexual depravities of Prince than the sexual deprivations of Michael Jackson, declares TRISHA VOO. Plus a special portrait for *Vanity Fair* by ANDY WARHOL.

PURPLE FAME

JA325.

Since 1984, works from the Prince Series have been displayed more than 30 times in museums, galleries, books, magazines, and other public locations. Pet. App. 60a-61a; JA526-38. They have also been prized by collectors and others. For example, the most recent sale of a work in the Prince Series was for $173,664 in October 2015. JA546-56.[1] Though the Prince Series works have been sold several times since Warhol's death in 1987, The Andy Warhol Foundation ("AWF") retains ownership of the copyright in the Prince Series (subject to the outcome of this litigation). JA526-30.

---

[1] Warhol's other works generally garner even higher prices. In 2014, Warhol works collectively sold at public auction for $653 million, representing nearly 5% of the entire global art market that year. JA542. From 2004 through 2014, Warhol auction sales exceeded $3 billion. *Id.*

Prince died in April 2016. Soon afterwards, *Vanity Fair* published an online version of the November 1984 "Purple Fame" article. Pet. App. 61a; JA343-44. Condé Nast also published a commemorative magazine titled "The Genius of Prince," with a different one of the Prince Series works licensed from AWF:

Pet. App. 62a; JA352; JA565-66.

C. Procedural History

1. In July 2016, Goldsmith contacted AWF, claiming that the Prince Series infringed her copyright. Pet. App. 61a; JA355. In April 2017, AWF filed a declaratory judgment action seeking, among other things, a judgment that (1) none of the works in the Prince Series used copyrightable elements of Goldsmith's 1981 photograph; and (2) the Prince Series is protected as fair use. JA41-43.

Goldsmith filed counterclaims for copyright infringement. JA90-124. She sought damages for AWF's use of her photograph in the Warhol Prince Series work on the April 2016 Condé Nast cover, which was the only infringing use alleged within the three-year limitations period. JA119; 17 U.S.C. § 507(b). She also sought broader declaratory, injunctive, and monetary relief implicating *all* of the Prince Series works, requesting: (1) a "[f]inding" that AWF could not "assert copyright protection" in the Prince Series; (2) "permanent injunctive relief, enjoining [AWF] from further reproducing, modifying, preparing derivative works from, selling, offering to sell, publishing or displaying" those same works; and (3) "all profits earned by [AWF] attributable to infringement." JA120-21.

2. The parties filed cross-motions for summary judgment. The district court granted AWF's motion, concluding that all of the Prince Series works were protected fair use. Pet. App. 68a.

For purposes of the first fair use factor, the court applied *Campbell* and found that the Prince Series is "transformative" because the original and follow-on works conveyed distinct messages. The court emphasized Goldsmith's admission that her work conveys that "Prince is 'not a comfortable person' and he is a 'vulnerable human being,'" noting that "Warhol's Prince Series, in contrast, can reasonably be perceived to reflect the opposite." Pet. App. 71a (quoting JA394). The court highlighted that Warhol cropped out Prince's torso and brought his face and a small portion of his neck to the forefront. *Id.* Removing the "humanity" in Goldsmith's photograph, Warhol created a "flat, two-dimensional figure" unlike "the detailed, three-dimensional being in

Goldsmith's photograph." *Id.* at 71a-72a. Warhol also removed the photograph's "crisp[]" details that "Goldsmith sought to emphasize" and added "loud, unnatural colors, in stark contrast with the black-and-white original photograph." *Id.*

The district court thus concluded that "the Prince Series works are transformative" because "[t]hey add something new to the world of art" by turning a "realistic photograph[]" of a "vulnerable, uncomfortable person" into a depiction of "an iconic, larger-than-life figure." *Id.* at 72a. This change in "communicative result[]" provided the "new expression, meaning, or message" needed to satisfy *Campbell*. *Id.* at 69a (quoting 510 U.S. at 579), 72a.

The court then considered the other three fair use factors. As to the second factor—the nature of the copyrighted work—the court emphasized that Goldsmith had made her photograph available for licensing, which undercut the ordinary protection an unpublished work would receive. *Id.* at 73a-74a. The court concluded that the third factor—the amount and substantiality of the portion used—likewise favored AWF because (1) "Warhol's alterations wash away the vulnerability and humanity Prince expresses in Goldsmith's photograph and Warhol instead presents Prince as a larger-than-life icon" and (2) "[e]ach Prince Series work contains little, if any, of the copyrightable elements of the Goldsmith Prince Photograph." *Id.* at 78a. "[T]o the extent that Prince's facial features remain in Warhol's works," the district court explained, "the features themselves are not copyrightable." *Id.* And because Warhol "transformed Goldsmith's work 'into something new and different[,] . . . this factor weigh[ed] heavily' in AWF's favor." *Id.* at 79a.

Finally, the court concluded that the fourth factor—the effect of the Prince Series on the market for or value of Goldsmith's photograph—also favored AWF. *Id.* at 79a-82a. The court found that "the markets for a Warhol and for a Goldsmith fine-art or other type of print are different." *Id.* at 80a. There was no evidence that "the Prince Series works are market substitutes for her photograph," or that "a magazine or record company would license a transformative Warhol work in lieu of a realistic Goldsmith photograph." *Id.* at 81a.

3. The Second Circuit reversed. JA644. The panel's original opinion began by quoting *Campbell*'s meaning-or-message test and acknowledging the importance of the transformative use inquiry in evaluating "the purpose and character of the use." JA612. The panel also recognized that Goldsmith's photograph and Warhol's Prince Series effectively expressed different messages: Whereas Goldsmith "portray[ed] Prince as a 'vulnerable human being,'" Warhol deliberately "strip[ped] Prince of that humanity and instead display[ed] him as a popular icon." JA620.

Notwithstanding its quotation of *Campbell* and the concededly different messages of the works at issue, however, the panel departed sharply from *Campbell*'s transformative use test and determined the Prince Series was not transformative based on three interrelated holdings.

First, the panel categorically barred courts from assessing a follow-on work's meaning or message, holding that "the district judge should not assume the role of art critic and seek to ascertain the intent behind or meaning of the works at issue." JA621. In the panel's view, "judges are typically unsuited to

make aesthetic judgments and . . . such perceptions are inherently subjective." *Id.* Based on that premise, the panel declined to offer any further assessment of the different meanings embodied in the original and follow-on works, and nowhere relied on those differences in its opinion.

Second, the panel reasoned that, instead of discerning a work's meaning or message in the first factor of the fair use analysis, a court should—at least in the context of visual art—focus on whether the works are visually similar. In the panel's view, "the secondary work's transformative purpose and character *must*, *at a bare minimum*, comprise something more than the imposition of another artist's style on the primary work such that the secondary work remains both recognizably deriving from, and retaining the essential elements of, its source material." JA621-22 (emphasis added).

Third, the panel found that Warhol's work was not transformative for the additional reason that it had the same "purpose" as the Goldsmith photograph. The panel claimed that "there can be no meaningful dispute that the overarching purpose and function of the two works at issue here is identical, not merely in the broad sense that they are created as works of visual art, but also in the narrow but essential sense that they are portraits of the same person." JA622.

After concluding that the Prince Series was not transformative as a matter of law, the panel held that the remaining fair use factors favored Goldsmith—largely resting on the same considerations that underpinned its transformativeness ruling. JA629; JA634; JA639 & n.11. The panel concluded that the second factor favored Goldsmith because of the photograph's "unpublished and creative" nature, and

that this factor was more important because of the supposedly non-transformative nature of the follow-on work. JA628-29. The panel concluded that the third factor favored Goldsmith because, in its view, "the Warhol images are instantly recognizable as depictions or images of the Goldsmith Photograph itself." JA632. Finally, the panel found for Goldsmith on the fourth factor too, which it deemed "closely linked" to the first factor, because it believed the Prince Series poses a threat to Goldsmith's licensing market. JA635. The panel thus held that the "defense of fair use fails as a matter of law" and that Warhol could no longer "claim" the Prince Series "as his own." JA640; JA625.[2]

Judge Jacobs concurred, contending that the "opinion of the Court does not necessarily decide" whether the "original [Warhol] works infringe," and suggesting that the panel's analysis may instead be limited to commercial licenses to reproduce the Warhol originals. JA649-50. But he identified nothing in the opinion that would preclude application of the court's holding to the original Prince Series. And he explicitly recognized the chilling effect of the court's decision on artists, noting that "our holding may alarm or alert possessors of other artistic works," and that "uncertainty about an artwork's [legal] status can inhibit the creativity that is a goal of copyright." JA650.

---

[2] Although the district court had not formally reached whether there was a *prima facie* act of infringement of protected elements of the Goldsmith photograph at all, the panel also held that the Prince Series and the Goldsmith photograph were "substantially similar" in the relevant sense as a matter of law, "given the degree to which Goldsmith's work remains recognizable within Warhol's." JA643-44.

4. Ten days later, this Court issued its decision in *Google*, which considered the application of the fair use doctrine to the "precise[]" copying of computer code. 141 S. Ct. at 1203. As part of that inquiry, the Court explored whether the "copying was transformative" under *Campbell*'s meaning-or-message test. *Id.* at 1202-04.

Explaining how that test functions in the context of visual art, the Court observed that "[a]n 'artistic painting' might, for example, fall within the scope of fair use even though it *precisely replicates* a copyrighted advertising logo to make a comment about consumerism.'" *Id.* at 1203 (emphasis added). That statement was an unmistakable allusion to Warhol's famous *Campbell's Soup Cans* paintings, which identically replicated the company's logo:

See JA153-55; *see also* Museum of Modern Art, *Andy Warhol, Campbell's Soup Cans*, 1962, https://www.moma.org/collection/works/79809 (last visited June 8, 2022).

5. AWF petitioned the Second Circuit for panel rehearing and rehearing en banc based on the conflict between the panel's opinion and this Court's decisions in *Google* and *Campbell*.

The panel granted rehearing and issued an amended opinion. The court purported to limit *Google* to its facts, stating that the "unusual context of that case, which involved copyrights in computer code, may well make its conclusions less applicable to [other] contexts." Pet. App. 44a. In a footnote, the court attempted to distinguish *Google*'s *Soup Cans* example from the Prince Series, because Warhol's "artistic painting" purportedly had a different "purpose[]" from an "advertising logo." *Id.* at 24a n.5. The court also generally asserted that it was not adopting a bright-line categorical rule for analyzing whether a work is transformative. *Id.* at 43a-44a. But it did not revise the core substance of its opinion, including the three holdings described above. *Id.*; *supra* at 25-27.

SUMMARY OF ARGUMENT

I. The Prince Series is transformative under a straightforward application of this Court's precedent.

Campbell held that a work is transformative if it can "reasonably be perceived" as "add[ing] something new, with a further purpose or different character, altering the first with new expression, *meaning, or message*," and carefully applied that test. 510 U.S. at 578-86 (emphasis added). Just last year in *Google*, this Court confirmed that this meaning-or-message test governs the transformative use inquiry even in circumstances far afield from *Campbell*'s facts. *See* 141 S. Ct. at 1202-03. Indeed, the Court even used an example drawn from Warhol's work to illustrate how an "'"artistic painting" might . . . fall within the scope of fair use even though it precisely replicates"' a prior work, so long as it modifies the meaning or message. *Id.* at 1203 (quoting 4 *Nimmer on Copyright*

§ 13.05[A][1][b]). In its holdings and reasoning alike, this Court has thus established that the transformativeness inquiry focuses on what a follow-on work *means*, not how much of the original is discernible.

That approach properly reflects the text, purpose, and history of copyright law. The fair use doctrine has always served as a safeguard to ensure that copyright does not unduly "stifle" creativity. *Id.* at 1195. For that doctrine to fulfill its historic purpose, it must ensure that works conveying genuinely new and distinctive ideas are not suppressed by copyright-created monopolies. Indeed, if works conveying undisputedly new meanings or messages were generally *not* considered transformative, the fair use doctrine would lose much of its vitality in protecting new contributions to the marketplace of ideas. That would plunge copyright into conflict with the First Amendment: While copyright-law restrictions on speech may be justified when the follow-on work merely replicates "other people's speech[]," *Eldred*, 537 U.S. at 221, such restrictions cannot properly block follow-on works that provide new and innovative meanings or messages. *Campbell*'s meaning-or-message test is thus essential to maintain harmony between copyright's restrictions on speech and core First Amendment values.

Here, there is no serious dispute that the Prince Series is transformative under a faithful application of *Campbell*. Both courts below recognized that the Prince Series conveys a new meaning or message distinct from Goldsmith's photograph. While Goldsmith portrayed Prince as a vulnerable human, Warhol made significant alterations that erased the humanity from the image, as a way of commenting on

society's conception of celebrities as products, not people. The Prince Series is thus transformative.

II. The Second Circuit found otherwise by jettisoning the meaning-or-message test in favor of a novel visual similarity test with no basis in this Court's precedent. That decision rested on three fatally flawed premises.

First, the Second Circuit held that a "district judge should not assume the role of art critic and seek to ascertain the intent behind or meaning of the works at issue." Pet. App. 22a-23a. That approach *forbids* a court from even trying to assess the very thing that *Campbell requires* it to evaluate: meaning or message. The Second Circuit grounded that remarkable holding in nothing but its own intuition—and it cannot be reconciled with this Court's precedents.

Second, the court incorrectly held that visual similarity drives the transformativeness inquiry, concluding that the follow-on work "must, at a bare minimum, comprise something more than the imposition of another artist's style . . . such that the secondary work remains both recognizably deriving from, and retaining the essential elements of, its source material." *Id.* at 23a-24a. That approach cannot be squared with *Campbell* and *Google*, where the follow-on works both "recognizably derived from, and retain[ed] essential elements" of their predecessors. And it ends up conflating the fair use inquiry with the antecedent "substantial similarity" question of whether one work borrows enough copyrightable elements of a pre-existing work to constitute a *prima facie* act of infringement in the first place.

Finally, the Second Circuit compounded these errors by claiming that the Prince Series could not be transformative because it had the same "overarching purpose and function" as the Goldsmith photograph, since both were "created as works of visual art" and were "portraits of the same person." *Id.* at 24a-25a. That approach considered the "purpose" of the Prince Series at so high a level of generality as to be meaningless. Almost any two works can be categorized as having the same "purpose and function" in some general sense. Indeed, the two works at issue in *Campbell* were both popular musical compositions addressing the same topic—yet this Court had no difficulty finding the follow-on work transformative. 510 U.S. at 579-80. The central question is not whether the respective works can be defined in such a way as to fall into the same broad category, but whether the follow-on work communicates a different meaning or message. *Id.* at 579. The Second Circuit erred in holding otherwise.

These errors have enormous practical consequences. If adopted by this Court, the Second Circuit's approach would work a sea change in the art world and to copyright law more generally—overturning decades of settled expectations, and chilling core First Amendment expression. Works long held by museums, galleries, and collectors could be imperiled, and the creation of new works would be chilled. That would run directly counter to the purpose of the fair use doctrine, which is to offer "breathing space" for innovators building from existing works to generate, express, and disseminate new ideas. *Id.* The decision below should be reversed.

ARGUMENT

I. The Prince Series Is Transformative

Ever since *Campbell v. Acuff-Rose Music, Inc.*, this Court has interpreted the first fair use factor to turn on whether the follow-on work is "transformative"—*i.e.*, whether it conveys a "new expression, meaning, or message" different from the original. 510 U.S. 569, 579 (1994). Here, the Prince Series is transformative because it indisputably has a distinct meaning or message from the Goldsmith photograph: While Goldsmith's work conveyed that Prince was a vulnerable person (unlike his larger-than-life persona), Warhol's works conveyed a very different message about the ways in which popular culture dehumanizes those it elevates to celebrity. The Second Circuit's decision misapplied *Campbell* and should be reversed.

A. Under *Campbell*, A Follow-On Work Is Transformative If It Can Reasonably Be Perceived As Communicating A New Meaning Or Message

1. Section 107(1) of the Copyright Act requires courts considering a fair use defense to address the "purpose and character of the [follow-on] use." 17 U.S.C. § 107(1). This Court defined the contours of that inquiry in *Campbell*. There, the Court addressed whether 2 Live Crew's parody of the Roy Orbison song, "Oh, Pretty Woman," was sufficiently transformative to justify copying significant protected elements of that song.

The Sixth Circuit had concluded that 2 Live Crew's song was not transformative based on the *amount* of copying at issue. According to that court, 2 Live Crew's song reflected "excessive borrowing"; the

court held that, "by 'taking the heart of the original and making it the heart of a new work,' 2 Live Crew had, qualitatively, taken too much." 510 U.S at 572, 574 (quoting *Acuff-Rose Music, Inc. v. Campbell*, 972 F.2d 1429, 1438 (6th Cir. 1992)).

This Court reversed. The relevant question, the Court explained, was not the amount of material copied, but whether the follow-on work can "reasonably be perceived" as "*add[ing]* something new, with a further purpose or different character, altering the first with new expression, *meaning, or message*.'" *Id.* at 579, 582 (emphasis added). Under that approach, the Court explained, a parody has "an obvious claim to transformative value," because as a work of "comment or criticism," it can "provide social benefit, by shedding light on [the] earlier work." *Id.* at 579. By contrast, if the follow-on work was instead simply a way of "get[ting] attention or avoid[ing] the drudgery in working up something fresh," the claim to transformativeness would "diminish[]." *Id.* at 580.

Applying those principles, the Court found that, although 2 Live Crew took heavily from Orbison's original—for example, copying "the characteristic opening bass riff (or musical phrase) of the original" and "the words of the first line"—it also altered other lyrics to "juxtapose[] 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." *Id.* at 583, 587. Those alterations shifted the *message* of the original, from a song that "ignores the ugliness of street life and the debasement that it signified" to a song that "reasonably could be perceived as commenting on the original or criticizing it to some degree." *Id.* at 583;

see also id. at 582 (citing district court's description of 2 Live Crew's transformation of Orbison's song).

The Court's analysis in *Campbell* thus turned on whether 2 Live Crew's follow-on song "c[ould] reasonably be perceived" to convey a meaning or message distinct from the Orbison original. And because 2 Live Crew's song could be so perceived, the Court found it transformative.

2. *Campbell*'s meaning-or-message test governs the transformative use inquiry generally, not just in parody cases. Last year, this Court applied *Campbell*'s test in *Google LLC v. Oracle America, Inc.*, 141 S. Ct. 1183 (2021), to the alleged infringement of copyrighted computer software. There, Google "precisely" copied a portion of an Oracle computer program "that enables a programmer to call up prewritten software that, together with the computer's hardware, . . . carr[ies] out a large number of specific tasks." *Id.* at 1190, 1203. The Court explained that, "[i]n the context of fair use, we have considered whether the copier's use 'adds something new, with a further purpose or different character, altering' the copyrighted work 'with new expression, meaning, or message.'" *Id.* at 1202 (quoting *Campbell*, 510 U.S. at 579); *see also id.* at 1203 ("[W]e have used the word 'transformative' to describe a copying use that adds something new and important.").

The Court offered two examples of transformative uses, one of which is especially apposite here. First, it observed that "[a]n 'artistic' painting might, for example, fall within the scope of fair use even though it precisely replicates a copyrighted 'advertising logo to make a comment about consumerism'"—a clear reference to Warhol's *Campbell's Soup Cans* work. *Id.*

at 1203 (quoting 4 *Nimmer on Copyright* § 13.05[A][1][b], which states in full that transformative use can occur by "modifying the meaning or message of the original work, in whatever form that may occur" and providing the *Soup Cans* painting as an example). Second, it pointed to *Campbell*, noting that "a parody can be transformative because it comments on the original or criticizes it, for '[p]arody needs to mimic an original to make its point.'" *Id.* (quoting 510 U.S. at 580-81). In both illustrations, the follow-on works recognizably resembled the originals. Notwithstanding those similarities, it was the difference in meaning or message that rendered the new works transformative.

Applying these principles, the Court found that Google's use of the copyrighted work was "transformative" because of the socially productive purpose for which the copying was done. *Id.* (noting that the copying "was consistent with that creative 'progress' that is the basic constitutional objective of copyright itself"). And this was so in spite of the fact that both the original and follow-on works were the same type of content (computer software), deployed for commercial profit, in the service of the same high-level purpose (providing tools for third-party developers to create applications). *Id.*

Campbell and *Google* thus establish a straightforward rule: A follow-on work is transformative—and has a different "purpose and character" under Section 107(1)—when it can "reasonably be perceived" to "add[] something new," by "altering the first with new expression, meaning, or message.'" *Campbell*, 510 U.S. at 578-79, 582. That principle applies to visual art, as *Google*'s

Warhol example made clear. And it appropriately trains the inquiry on what a follow-on work *means*, not on how much of the original material is discernible.

B. *Campbell*'s Meaning-Or-Message Test Aligns With The Copyright Act's Text, Purpose, And History

Campbell's meaning-or-message test properly implements the text and purpose of the Copyright Act. Indeed, that test provides a vital safeguard, ensuring the copyright laws do not unduly impede core expression protected by the First Amendment.

1. Section 107(1) requires courts to consider the "purpose and character of the [follow-on] use" as the first factor of the fair use inquiry. 17 U.S.C. § 107(1). It draws directly from Justice Story's formulation of the fair use test, which considered "the nature and objects of the selections made." *Campbell*, 510 U.S. at 578 (quoting *Folsom v. Marsh*, 9 F. Cas. 342, 348 (1841)). As this Court explained in *Campbell*, Section 107(1) was intended to capture the longstanding common-law approach to fair use. *See id.* at 576. Under that approach, the fair use doctrine empowered courts to apply an equitable rule of reason that would prevent copyright protection from "stifl[ing] the very creativity [the copyright laws]" were "designed to foster." *Id.* at 577. *Campbell*'s meaning-or-message test faithfully carries out that historic mission.

Copyright ultimately rests on a "pragmatic," utilitarian bargain: "[S]ociety confers monopoly-exploitation benefits for a limited duration on authors and artists" to incentivize and promote "the intellectual and practical enrichment that results

from such creative endeavors." Leval 1109; *see also Google*, 141 S. Ct. at 1195 (noting that copyrights are granted "not as a special reward" to creators, but rather "to encourage the production of works that others might reproduce more cheaply"); *Harper & Row Publishers, Inc. v. Nation Enters.* 471 U.S. 539, 545 (1985) (copyright protection is "intended to increase and not to impede the harvest of knowledge"); *supra* at 4. In other words, copyright protection for creators serves the ultimate end of securing for the public a rich marketplace of ideas.

This purpose was reflected in the first modern copyright statute, Britain's Statute of Anne, which Parliament enacted in 1710 "to destroy the booksellers' monopoly of the booktrade and to prevent its recurrence" by vesting copyright in books in their authors, who could then communicate new ideas without fear of censorship, thereby promoting "'the encouragement of learning,'" L. Ray Patterson, *Understanding the Copyright Clause*, 47 J. Copyright Soc'y USA 365, 379 (2000) (quoting 8 Anne C.19 (1710)). That same goal underpins the Constitution's Copyright Clause, which expressly states that the goal of Congress's copyright power is "[t]o promote the Progress of Science and useful Arts." U.S. Const. art. I, § 8, cl. 8; Leval 1108.

Courts have long recognized that the "exclusive rights" awarded by copyright have "negative features." *Google*, 141 S. Ct. at 1195. They "can sometimes stand in the way of others exercising their creative powers" by preventing the use of existing expression as a basis for innovation. *Id.* It has thus been understood since "the infancy of copyright protection" that, for copyright to serve rather than undermine the public good, some borrowing must be

permitted. *Campbell*, 510 U.S. at 575. As Justice Story explained nearly two centuries ago, "[e]very book in literature, science and art, borrows, and must necessarily borrow, and use much which was well known and used before." *Emerson v. Davies,* 8 F. Cas. 615, 619 (No. 4,436) (C.C.D. Mass. 1845).

The doctrine of fair use has always ensured that copyright monopolies do not unduly "stifle" creativity. *Campbell*, 510 U.S. at 577 (quoting *Stewart v. Abend*, 495 U.S. 207, 236 (1990)). Under the common law, a creator was allowed to make "justifiable use of the original materials, such as the law recognizes as no infringement of the copyright" held by the materials' author. *Folsom*, 9 F. Cas. at 348. A follow-on work that reflected "intellectual labor and judgment," rather than "merely the facile use of the scissors," constituted a justifiable use worthy of protection. *Id.* at 345. The doctrine avoids "put[ting] manacles upon science," and thus provides leeway for follow-on users to rely on existing expression to develop works communicating new ideas. *Cary v. Kearsley*, 170 Eng. Rep. 679, 680 (1803). Fair use thus advances the core purpose of the copyright laws—"to stimulate activity and progress in the arts for the intellectual enrichment of the public." Leval 1107.

For the fair use doctrine to fulfill these purposes, it must ensure that works conveying genuinely new and distinctive ideas are not suppressed by copyright-created monopolies. Fair use has accordingly always placed significant emphasis on whether the new work conveys a distinct meaning or message from the source material. *See Gyles v. Wilcox*, 26 Eng. Rep. 489, 490 (1740) (explaining that copyright "must not be carried so far as to restrain persons from" creating follow-on works where the "invention, learning, and

judgment of the [follow-on work's] author is shewn in them, and in many cases [the follow-on works] are extremely useful"); *see also Sampson & Murdock Co. v. Seaver-Radford Co.*, 140 F. 539, 542 (1st Cir. 1905) ("[I]nstances may be easily cited where portions of a copyrighted book may be published for purposes other than those for which the original book was intended.").

In *Campbell*, this Court established the meaning-or-message test to implement these historic principles. That test creates a strong presumption that works conveying new meanings or messages will not be suppressed by law. In doing so, it implements this Court's prior teaching that the limits of copyright protection should be "construed in light of th[e] basic purpose" of encouraging "artistic creativity for the general public good." *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 432 (1984) (quoting *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975); citing *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127 (1932)).

If a work conveying a new meaning or message was generally *not* considered transformative, the fair use doctrine would lose much of its vitality in protecting new contributions to the marketplace of ideas. Even works that "add[ed] something new" to public understanding would be prohibited—leaving dangerously little "breathing space" for the elaboration of new concepts, in ways that recognizably build on prior contributions. *Campbell*, 510 U.S. at 579. A meaning-or-message test for transformativeness is thus crucial to ensuring that the fair use inquiry fulfills its core, historic function of protecting the marketplace of ideas.

2. *Campbell*'s meaning-or-message test is also faithful to Section 107(1)'s literal text. After all, a follow-on work that communicates a new meaning or message inherently has a different "purpose" and "character" than the original: By definition, it seeks to communicate something different to—and provoke a different response from—its audience.[3]

In addition, the meaning-or-message test tracks the list of examples that Congress provided in Section 107 as illustrations of possible fair uses of prior works, which this Court has noted can help "guide[]" the fair use inquiry. *Id.* at 578-79. These examples include "criticism, comment, news reporting, teaching, . . . scholarship, or research." 17 U.S.C. § 107; *see also* H.R. Rep. No. 94-1476, at 65 (also mentioning "parody"). While falling within one of these categories does not automatically confer fair use protection, they nonetheless provide "general guidance about the sorts of copying that courts and Congress most commonly had found to be fair uses." *Campbell*, 510 U.S. at 577-78.

And the unifying theme of those disparate categories is that, for each one, a follow-on work often conveys a new meaning or message different than the original it borrows from. For example, as this Court alluded to in *Google*, a copyrighted soup-can label is used in a transformative manner when it is used in a follow-on work to comment on "consumerism." 141 S. Ct. at 1203. That is because the label, even when

---

[3] *See Webster's New World Dictionary of the American Language* 1154 (1970) (defining "purpose" as "the object for which something exists or is done"); *id.* at 239 (defining "character" as "a distinctive trait, quality, or attribute; characteristic").

visually identical in the second work, communicates a new and distinct meaning when placed into a new context. Similarly, works of research and scholarship that quote prior works in their field qualify as transformative when the new works' authors do not simply replicate the messages of the prior works, but use pre-existing materials to convey the new authors' different ideas.[4]

3. Finally, the meaning-or-message test plays a key role in preventing the Copyright Act from impinging on core expressive activity protected by the First Amendment.

The Copyright Act directly curtails expression by making certain speech illegal. *See Golan v. Holder*, 565 U.S. 302, 327-28 (2012) ("[S]ome restriction on expression is the inherent and intended effect of every grant of copyright."). That raises fundamental First Amendment concerns. As this Court has explained, however, the fair use defense operates as a critical safeguard to ensure that the copyright laws do not abridge protected expression.

Twice in recent years, this Court has rejected First Amendment challenges to copyright statutes based on the "built-in First Amendment accommodation[]" provided by fair use. *Eldred*, 537 U.S. at 219-21 (rejecting challenge to Copyright Term Extension Act); *see also Golan*, 565 U.S. at 327-29 (rejecting challenge to extension of copyright protection to works protected in treaty-partner countries). Both times, the Court relied on *Campbell* to describe the "considerable latitude" afforded to follow-on users

---

[4] *Compare Nutt v. Nat'l Inst. Inc. for the Improvement of Memory*, 31 F.2d 236, 237-38 (2d Cir. 1929), *with Maxtone-Graham v. Burtchaell*, 803 F.2d 1253, 1260 (2d Cir. 1986).

seeking to use preexisting "expression itself" in new works. *Eldred*, 537 U.S. at 219; *Golan*, 565 U.S. at 329; *see also* Ned Snow, *The Forgotten Right of Fair Use*, 62 Case W. Res. L. Rev. 135, 138 (2011) (fair use "is intended to calm the strife between copyright and free speech").

For the fair use defense to properly safeguard the First Amendment, it must focus on whether the follow-on work makes an independent contribution to the marketplace of ideas. Copyright-law restrictions on speech may be justified when the follow-on work merely replicates "other people's speech[]" without adding anything new of significance. *Eldred*, 537 U.S. at 221. But such restrictions undermine First Amendment values—and are *not* justified—when they block follow-on works that express new and distinctive meanings or messages. The creation and dissemination of such messages promote "the continued building of our politics and culture." *Police Dep't of the City of Chicago v. Mosley*, 408 U.S. 92, 95-96 (1972).

Campbell's meaning-or-message test advances First Amendment values by "allow[ing] later authors to use a previous author's copyright to introduce new ideas or concepts to the public." *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1264 (11th Cir. 2001). At the same time, it gives no aid to copiers merely seeking to express the *same* message in a different form. In these ways, *Campbell* promotes innovation and prevents copyright law from suppressing original creative works that build on prior contributions.

C. The Prince Series Can Reasonably Be Perceived To Communicate A New Meaning Or Message

It is undisputed here that the Prince Series conveys a new meaning or message, as both courts below found. Pet. App. 26a, 71a-72a. While Goldsmith communicated the message of a vulnerable Prince, Warhol's Prince Series conveys the dehumanizing nature of celebrity. Not even Goldsmith has argued otherwise.

1. Both courts below recognized that Warhol's Prince Series thoroughly altered Goldsmith's source photograph in order to convey a fundamentally new and distinct meaning and message. As the district court explained, Warhol removed Prince's torso and brought his face and a small part of his neckline "to the forefront." *Id.* at 71a. The details of Prince's bone structure "are softened" in some of the works or "outlined or shaded" in others. *Id.* And Warhol rendered Prince as a "flat" and "two-dimensional figure" rather than the "three-dimensional portrayal" in Goldsmith's photograph, and introduced "loud, unnatural colors" rather than the black-and-white of the original. *Id.* at 71a-72a.

Taken together, "[t]hese alterations result[ed] in an aesthetic and character different from the original," which conveyed a new message. *Id.* at 72a. Whereas Goldsmith's photograph portrayed Prince as "uncomfortable" and "vulnerable," the Prince Series "reflect[ed] the opposite" message by portraying Prince as "an iconic, larger-than-life figure." *Id.* at 71a-72a.

The Second Circuit similarly recognized the different meanings and messages of the two works,

noting that that "the cumulative effect of [Warhol's] alterations may change the Goldsmith Photograph in ways that give a different impression of its subject." *Id.* at 26a. And in opposing certiorari, Goldsmith did not dispute that the Prince Series conveys a different message than the Goldsmith photograph. Indeed, below Goldsmith candidly acknowledged that Warhol's creations involved "substantial creativity and distinctive quality." *See* Resps. C.A. Br. 32.

2. Ample record evidence supports those conclusions. As Goldsmith herself testified, the message conveyed by her studio photographs was that Prince was a "vulnerable human being." Pet. App. 71a (quoting JA394). And the resulting images reflect that aim. As Goldsmith explained, the photographs from the photoshoot depict Prince as "fragile" and "not a comfortable person." Pet. App. 71a; JA283-84.

By contrast, as Professor Crow explained, Warhol's alterations convey the message that Prince is an "icon or totem of something rather than [an] actual human being." JA257. The "flattened, cropped, exotically colored, and unnatural depiction of Prince's disembodied head . . . communicate[d] a message about the impact of celebrity and defin[ed] the contemporary conditions of life." JA227. By flattening out the images, removing their natural aspects, and adding in their place exaggerated and unnatural colors, Warhol turned Goldsmith's portrayal of a vulnerable Prince into a "mask-like simulacrum of his actual existence," which reflects the dehumanizing effect of celebrity. JA249; *see also* JA255.

There is thus no reasonable dispute on this record that the meanings or messages of the two works are not remotely similar. Indeed, the messages here are

just as different—if not more different—than those in *Campbell*. As in that case, Warhol used a pre-existing work to convey a distinctive idea. While 2 Live Crew commented on Orbison's original song, Warhol used the original to comment on society—but in both cases the follow-on work offered a distinctive "meaning[] or message." *Campbell*, 510 U.S. at 579. And just as in *Campbell*, Warhol's work *needed* at least some aspects of the original image to be recognizable to the audience in order to convey the idea he sought to express.

The Prince Series is thus plainly transformative under a proper application of *Campbell*.

II. The Second Circuit Wrongly Departed From *Campbell*'s Meaning-Or-Message Test

The Second Circuit made this straightforward case complicated by jettisoning the meaning-or-message test in favor of a novel visual similarity test lacking any basis in this Court's precedent. As a result, it rejected AWF's fair use defense and granted summary judgment to Goldsmith. That decision should be reversed.

A. The Second Circuit's Approach Violates This Court's Precedent And Is Unworkable

Although the Second Circuit paid lip service to *Campbell*, it created a new test that directly contravenes *Campbell*'s central holding. The Second Circuit held that, when assessing transformative use under the first fair use factor, courts should *not* analyze differences in meaning between two artworks that are visually similar and share the same high-level "purpose." Pet. App. 22a-25a. That holding

rests on three flawed premises at odds with precedent.

1. *First*, the Second Circuit held that a "district judge should not assume the role of art critic and seek to ascertain the intent behind or meaning of the works at issue." *Id.* at 22a-23a. That approach thus *forbids* a court from even trying to "ascertain [the] meaning" of a follow-on work. But that makes it impossible for a court to assess the very thing that *Campbell requires* it to evaluate: meaning or message. 510 U.S. at 579. There is no way to reconcile the Second Circuit's flat-out prohibition on ascertaining meaning or message with *Campbell*'s unequivocal statement that the "central purpose" of the first factor is to assess whether a work is transformative because it can reasonably be perceived to "add[] something new, with a further purpose or different character, altering the first with new expression, meaning, or message." *Id.*

Nor is there any way to reconcile the panel's approach here with what this Court *did* in *Campbell*—which was to examine the content of the lyrics in the follow-on work to determine whether they expressed a distinct message from the original. *Id.* at 583 ("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 . . . ." (emphasis added)). If the Second Circuit is right that courts are forbidden from assessing a work's meaning, *Campbell*'s reasoning and overall approach would have made little sense.

The Second Circuit appeared to believe it necessary to bar courts from ascertaining meaning

because "judges are typically unsuited to make aesthetic judgments and because such perceptions are inherently subjective." Pet. App. 22a-23a. But that misapprehends *Campbell*'s meaning-or-message test. As this Court explained, the fact-finder is not required to make any subjective or aesthetic judgment regarding the "quality" of the respective works. *Campbell*, 510 U.S. at 582. Rather, it must determine whether a distinct meaning or message can "reasonably be perceived." *Id.*; *see also id.* at 583 (noting that it did not matter whether a court would "assign a high rank" to the new meaning or message). That is an objective question regarding what a reasonable person could identify in a follow-on work, with an answer discernible from the work's objective features, as potentially elucidated (if necessary) by expert testimony and other evidence. The question in *Campbell*, for example, was not whether the 2 Live Crew song was *effective* parody, but whether it could be seen as parody at all. This Court had no problem resolving that question. *Id.* at 582.

2. *Second*, the Second Circuit incorrectly held that visual similarity—not the meaning-or-message test—drives the transformativeness inquiry. As the panel put it, "the secondary work's transformative purpose and character *must*, at a bare minimum, comprise something more than the imposition of another artist's style on the primary work such that the secondary work remains both recognizably deriving from, and retaining the essential elements of, its source material." Pet. App. 23a-24a (emphasis added). In other words, the Second Circuit found that a work cannot be transformative if the essential elements of its source material remain recognizable within it. That approach is mistaken.

a. The Second Circuit's singular focus on visual similarity directly contradicts *Campbell* and *Google*. In *Campbell*, this Court determined that the new work borrowed core features of the original's composition, including the recognizable "opening riff" and the opening line. 510 U.S. at 588. Those are clearly "essential elements" of the original song—indeed, the very *point* of the second work in *Campbell* was that it "recognizably derived from" the former, but placed those same essential elements in a distinctive context, in order to convey how the original "ignore[d] the ugliness of street life." *Id.* at 583; *id.* at 580-81 (noting that the later work "need[ed] to mimic [the] original to make its point").

Similarly, in *Google*, there was no dispute that the second work "recognizably deriv[ed] from, and retain[ed] the essential elements of," the original work. Pet. App. 23a-24a. There, Google had "precisely" "copied roughly 11,500 lines of code" and used it "for the same reason" as the original work, specifically to "enable programmers to call up implementing programs" that would accomplish particular tasks. 141 S. Ct. at 1191, 1203. Yet, again, the Court found that what mattered was that Google's work nonetheless embodied a distinct creative innovation, by developing "a new platform" for the "smartphone environment." *Id.* at 1203. The Second Circuit's visual similarity rule simply defies this Court's precedent.

b. That rule also collapses the transformative use inquiry into the distinct, threshold question of substantial similarity. To prove that a follow-on work infringes an exclusive right of the copyright owner in the first place, a plaintiff "must show . . . substantial similarity between the copyrighted work and the

defendant's work." *Litchfield v. Spielberg*, 736 F.2d 1352, 1355 (9th Cir. 1984). Courts assess substantial similarity based on the visual similarities between the works. *See Peter F. Gaito Architecture, LLC v. Simone Development Corp.*, 602 F.3d 57, 64 (2d Cir. 2010); *see also Rentmeester v. Nike, Inc.*, 883 F.3d 1111, 1121 (9th Cir. 2018).

Even if substantial similarity is found, however, courts must still determine whether the follow-on work constitutes fair use. As the leading treatise explains, "fair use is a defense not because of the absence of substantial similarity but rather despite the fact that the similarity is substantial." *See* 4 *Nimmer on Copyright* § 13.05[A]. Yet under the Second Circuit's recognizability framework, it is virtually inevitable that a substantially similar work will *not* be deemed transformative. *Compare* Pet. App. 49a (stating that the Prince Series and the Goldsmith photograph were substantially similar because of the "degree to which Goldsmith's work remains recognizable within Warhol's"), *with id.* at 23a-24a (stating that the Prince Series was not transformative because it "remains both recognizably deriving from, and retaining the essential elements of, its source material"). The Second Circuit failed to provide any workable dividing line to separate substantially similar visual works that are not transformative from those that differ enough to be transformative.

Instead, the panel impermissibly brushed aside Warhol's extensive changes, asserting that transformative use could not be found where there was "imposition of another artist's style on the primary work." *Id.* at 23a-24a. But Warhol's unique style is the very thing that gives the Prince Series its

distinct message, transforming Goldsmith's photograph into a comment on the dehumanizing effects of celebrity. The fact that some visual elements of Goldsmith's work (most or all of which are not properly copyrightable in any event) are still recognizable does not negate that transformation.

c. The Second Circuit also sought to justify its rule on the premise that an overly broad transformative use test would conflict with a copyright holder's "exclusive right[]" over "derivative works"—*i.e.*, works "such as a translation . . . [or] motion picture version," that are "based upon" the owner's prior work. 17 U.S.C. §§ 101, 106(2); *see* Pet. App. 24a-25a. In the panel's view, the Prince Series was no more transformative than a film adaptation of a novel. Pet. App. 24a.

That reasoning wrongly assumes that a work cannot be both derivative and fair use, which runs directly counter to the Copyright Act's text. Fair use is a defense even where the derivative work right is alleged to be infringed. 17 U.S.C. § 107; *see also Authors Guild, Inc. v. HathiTrust*, 755 F.3d 87, 95 (2d Cir. 2014). Indeed, that defense only becomes relevant once the creation of a new work has been deemed to constitute a *prima facie* act of infringement of an original (including as a derivative work). Thus, contrary to the Second Circuit's premise, a film adaptation *can* (under the right circumstances) be fair use, despite also being a derivative work within the meaning of 17 U.S.C. § 101. *See* 17 U.S.C. §§ 106(2), 107.

In any event, the Second Circuit's assertion that the Prince Series was less transformative than a film adaptation only highlights the problem with its misguided test, which elevates visual similarity to the

exclusion of whether there is a new meaning or message. An adaptation of a novel into a movie is typically not considered fair use precisely because it does *not* change the meaning or message of the original—even though it *does* significantly alter the work's form and function, and the original may even be "barely recognizable." Pet. App. 21a; *see also Authors Guild v. Google, Inc.*, 804 F.3d 202, 215 (2d Cir. 2015) ("[D]erivative works generally involve transformations in the nature of *changes of form*."). Thus, film adaptations, and other specified categories of "derivative works" (such as "translation" and "abridgment") only highlight that meaning or message—not literal resemblance—is the key to transformativeness for purposes of the fair use analysis.

3. *Finally,* the Second Circuit compounded these errors with another mistake, claiming that the Prince Series could not be transformative because it had the same "overarching purpose and function" as the Goldsmith photograph, since both were "created as works of visual art" and were "portraits of the same person." Pet. App. 24a-25a.

The panel erred in considering the "purpose" of the Prince Series at far too high a level of generality. The panel's observation that both works are "portraits of [Prince]" ignores what each work *says* through its respective portrayal: Whereas Goldsmith displayed Prince's unique human identity, Warhol depicted Prince to reflect back to the viewer his own skewed and dehumanizing view of celebrity. The two works thus had different "purposes" *because* they conveyed different meanings and messages. The panel's artificial approach ignores that a difference in meaning or message *is* a difference in "purpose."

The panel's level-of-generality error is also at odds with precedent. In *Campbell*, for example—just like here—the two songs could be described as sharing the same "purpose and function," in that both were popular musical compositions addressing the same topic. Nonetheless, this Court had no difficulty finding the follow-on work transformative. *Campbell*, 510 U.S. at 579-80. Similarly, in *Google*, the follow-on work copied the computer code "in part for the same reason" as the original was created. 141 S. Ct. at 1190, 1195, 1203. Yet again, this Court rightly deemed the follow-on work transformative. *Id.* at 1203. Indeed, the *Google* Court explicitly rejected an analysis of purpose that would define the purposes of works at too high a level of generality. *Id.* (refusing to "stop" at a definition of purpose limited to fact that both works "enable[d] programmers to call up implementing programs that would accomplish particular tasks").

The Second Circuit's "purpose and function" rationale is highly malleable and can be gerrymandered to obtain a preferred result. As *Campbell* and *Google* illustrate, it will virtually always be possible to identify *some* level of generality at which two works can be deemed to have the same "purpose and function." Such an approach provides no meaningful guidance in close cases—and could lead to chaotic and inconsistent results.

B. The Second Circuit's Cramped Understanding Of Transformative Use Would Harm Artists And The Public

If adopted by this Court, the Second Circuit's approach to transformative use would work a sea change in the art world and to copyright law more

generally—overturning decades of settled expectations, and chilling core First Amendment expression.

First, the Second Circuit's view renders presumptively unlawful numerous works of art that borrow from—but add to—preexisting works. A standard that treats the Prince Series as non-transformative would make illegal "[m]any great modern artists," whose works do not make the "kind of aesthetic change" that the Second Circuit's ruling requires. Blake Gopnik, *Warhol a Lame Copier? The Judges Who Said So Are Sadly Mistaken*, N.Y. Times (updated Sept. 24, 2021), https://www.nytimes.com/2021/04/05/arts/design/warhol-copyright-appeals-court.html; *see also* Robert Rauschenberg Found. et al. Cert. Amici Br. ("Rauschenberg Br.") 26 ("[A]ppropriation is widely recognized as a hallmark of modernist and contemporary art."); Kruger & Storr Cert. Amici Br. 13-24 (cataloguing numerous contemporary artists and works of art that utilize appropriation).

Numerous works that employ the time-honored practice of borrowing from existing works (including many Pop Art pieces) would be denied copyright protection and the rewards that accompany it. 17 U.S.C. § 103(a) (denying protection to works that "employ[] preexisting material" for "any part of the work in which such [copyrighted] material has been used unlawfully"). Many works, such as Warhol's *Green Marilyn* and Roy Lichtenstein's *Look Mickey* explicitly borrow from preexisting creations. *See* National Gallery of Art, Andy Warhol, *Green Marilyn,* 1962, https://www.nga.gov/collection/art-object-page.72039.html (last visited June 8, 2022); *see also* National Gallery of Art, Roy Lichtenstein, *Look*

Mickey, 1961, https://www.nga.gov/collection/art-object-page.71479.html (last visited June 8, 2022). That means countless artistic works could lose protection and be subject to exploitation by those who claim to have inspired their creation.

Second, the decision below could prevent museums, foundations, and galleries from displaying culturally significant artwork. Only a "lawfully made" painting or print of a copyrighted work may be publicly displayed by someone other than the copyright owner. 17 U.S.C. §§ 106(5), 109(c). Faced with a choice between copyright infringement litigation under the Second Circuit's circumscribed transformative use standard and removing artwork from public view, many institutions may choose the latter. Museums and galleries without significant financial resources are especially likely to err on the side of not displaying works that draw on pre-existing creations, depriving the public of the opportunity to interact with those pieces. As *amici* at the certiorari stage emphasized, the Second Circuit's decision threatens the livelihood of museums and galleries that many Americans rely on for "access to art and arts education." *See* Rauschenberg Br. 27 (collecting cases where galleries were sued "just for displaying allegedly infringing art").

Third, under the Second Circuit's approach, owners of many existing paintings and prints would not be allowed to lawfully resell them. 17 U.S.C. §§ 106(3), 109(a). For example, Warhol's 1964 silkscreen "Shot Sage Blue Marilyn" recently sold at auction for $195 million, breaking the auction record for an American artist. Robin Pogrebin, *Warhol's 'Marilyn,' at $195 Million, Shatters Auction Record for an American Artist*, N.Y. Times (May 9, 2022),

https://www.nytimes.com/2022/05/09/arts/design/warhol-auction-marilyn-monroe.html. If works that flunk the Second Circuit's test cannot be resold, the value of influential pieces previously purchased for significant sums, like Blue Marilyn, could tumble. Foundations that seek to preserve works through acquisition will be unable to do so lawfully.

Fourth, the Second Circuit's test could lead to the removal of seminal works of art from the public sphere. Under 17 U.S.C. § 503, allegedly infringing works can be "impound[ed]" and, following a final judgment, can be ordered destroyed. Although Goldsmith does not seek the destruction of the Prince Series in this particular case, JA120-21, the Second Circuit's ruling in no way limits the statutory remedies that can be sought in future cases.

Finally, and perhaps most fundamentally, the Second Circuit's rule would have a chilling effect on artists and would-be artists. Under that rule, many works in the last century's most significant artistic movement might never have been created in the first place. Going forward, artists will be deterred from drawing upon existing works to offer new, creative messages if their works will not be protected and cannot be displayed or sold. The effect will be particularly pernicious for less-established artists who cannot afford to pay royalties or to mount a legal defense. The damage to the creative process, and the creation of future works, will be substantial.

* * *

The fair use doctrine is meant to offer "breathing space" for innovators building from existing works to generate, express, and disseminate new ideas. *Campbell*, 510 U.S. at 579. The exclusion of meaning

and message from the transformativeness inquiry suffocates that vitally important space. Here, by forbidding consideration of meaning or message, the Second Circuit deemed Warhol's Prince Series non-transformative and thereby rejected AWF's fair use defense. *Supra* at 25-27. That result is incompatible with the role of fair use as a First Amendment safeguard and with copyright's core purpose of encouraging the contribution of genuinely new ideas. Because the Second Circuit's approach renders presumptively unlawful works that belong at the heart of fair use protection, it cannot stand.

CONCLUSION

The Second Circuit's judgment should be reversed.

Respectfully submitted,

ROMAN MARTINEZ
Counsel of Record
SARANG VIJAY DAMLE
ELANA NIGHTINGALE DAWSON
CHERISH A. DRAIN
LATHAM & WATKINS LLP
555 11th Street, NW
Suite 1000
Washington, DC 20004
(202) 637-3377
roman.martinez@lw.com

Counsel for Petitioner

ANDREW GASS
JOSEPH R. WETZEL
LATHAM & WATKINS LLP
505 Montgomery Street
San Francisco, CA 94111
(415) 391-0600

SAMIR DEGER-SEN
PETER TROMBLY*
LATHAM & WATKINS LLP
1271 Avenue of the Americas
New York, NY 10020
(212) 906-1200

June 10, 2022

* Admitted to practice in Virginia only.

ADDENDUM

TABLE OF CONTENTS

Page

U.S. Const. art. I, § 8, cl. 8 ..... 1a
U.S. Const. amend. I 2a
17 U.S.C. § 101 ..... 3a
17 U.S.C. § 102 ..... 5a
17 U.S.C. § 103 ..... 6a
17 U.S.C. § 106 ..... 7a
17 U.S.C. § 107 ..... 8a
17 U.S.C. § 109(a), (c) 9a
17 U.S.C. § 502 ..... 11a
17 U.S.C. § 503 ..... 12a
17 U.S.C. § 504 ..... 14a
17 U.S.C. § 507(b) 17a

U.S. Const. art. I, § 8, cl. 8

Section 8. The Congress shall have Power

* * *

To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries

* * *

U.S. Const. amend. I

Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances.

17 U.S.C. § 101

§ 101. Definitions

Except as otherwise provided in this title, as used in this title, the following terms and their variant forms mean the following:

* * *

A "derivative work" is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a "derivative work".

* * *

A "work of visual art" is—

(1) a painting, drawing, print, or sculpture, existing in a single copy, in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author, or, in the case of a sculpture, in multiple cast, carved, or fabricated sculptures of 200 or fewer that are consecutively numbered by the author and bear the signature or other identifying mark of the author; or

(2) a still photographic image produced for exhibition purposes only, existing in a single copy that is signed by the author, or in a limited edition of 200 copies or fewer that are signed and consecutively numbered by the author.

A work of visual art does not include—

(A)(i) any poster, map, globe, chart, technical drawing, diagram, model, applied art, motion picture or other audiovisual work, book, magazine, newspaper, periodical, data base, electronic information service, electronic publication, or similar publication;

(ii) any merchandising item or advertising, promotional, descriptive, covering, or packaging material or container;

(iii) any portion or part of any item described in clause (i) or (ii);

(B) any work made for hire; or

(C) any work not subject to copyright protection under this title.

* * *

17 U.S.C. § 102

§ 102. Subject matter of copyright: In general

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

(1) literary works;

(2) musical works, including any accompanying words;

(3) dramatic works, including any accompanying music;

(4) pantomimes and choreographic works;

(5) pictorial, graphic, and sculptural works;

(6) motion pictures and other audiovisual works;

(7) sound recordings; and

(8) architectural works.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

17 U.S.C. § 103

§ 103. Subject matter of copyright: Compilations and derivative works

(a) The subject matter of copyright as specified by section 102 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.

(b) The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

17 U.S.C. § 106

§ 106. Exclusive rights in copyrighted works

Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

(1) to reproduce the copyrighted work in copies or phonorecords;

(2) to prepare derivative works based upon the copyrighted work;

(3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;

(4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly;

(5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and

(6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

17 U.S.C. § 107

§ 107. Limitations on exclusive rights: Fair use

Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, 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—

(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.

The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.

17 U.S.C. § 109

§ 109. Limitations on exclusive rights: Effect of transfer of particular copy or phonorecord

(a) Notwithstanding the provisions of section 106(3), the owner of a particular copy or phonorecord lawfully made under this title, or any person authorized by such owner, is entitled, without the authority of the copyright owner, to sell or otherwise dispose of the possession of that copy or phonorecord. Notwithstanding the preceding sentence, copies or phonorecords of works subject to restored copyright under section 104A that are manufactured before the date of restoration of copyright or, with respect to reliance parties, before publication or service of notice under section 104A(e), may be sold or otherwise disposed of without the authorization of the owner of the restored copyright for purposes of direct or indirect commercial advantage only during the 12-month period beginning on—

(1) the date of the publication in the Federal Register of the notice of intent filed with the Copyright Office under section 104A(d)(2)(A), or

(2) the date of the receipt of actual notice served under section 104A(d)(2)(B),

whichever occurs first.

* * *

(c) Notwithstanding the provisions of section 106(5), the owner of a particular copy lawfully made under this title, or any person authorized by such owner, is entitled, without the authority of the copyright owner, to display that copy publicly, either directly or by the projection of no more than one image

at a time, to viewers present at the place where the copy is located.

* * *

17 U.S.C. § 502

§ 502. Remedies for infringement: Injunctions

(a) Any court having jurisdiction of a civil action arising under this title may, subject to the provisions of section 1498 of title 28, grant temporary and final injunctions on such terms as it may deem reasonable to prevent or restrain infringement of a copyright.

(b) Any such injunction may be served anywhere in the United States on the person enjoined; it shall be operative throughout the United States and shall be enforceable, by proceedings in contempt or otherwise, by any United States court having jurisdiction of that person. The clerk of the court granting the injunction shall, when requested by any other court in which enforcement of the injunction is sought, transmit promptly to the other court a certified copy of all the papers in the case on file in such clerk's office.

17 U.S.C. § 503

§ 503. Remedies for infringement: Impounding and disposition of infringing articles

(a)(1) At any time while an action under this title is pending, the court may order the impounding, on such terms as it may deem reasonable—

(A) of all copies or phonorecords claimed to have been made or used in violation of the exclusive right of the copyright owner;

(B) of all plates, molds, matrices, masters, tapes, film negatives, or other articles by means of which such copies or phonorecords may be reproduced; and

(C) of records documenting the manufacture, sale, or receipt of things involved in any such violation, provided that any records seized under this subparagraph shall be taken into the custody of the court.

(2) For impoundments of records ordered under paragraph (1)(C), the court shall enter an appropriate protective order with respect to discovery and use of any records or information that has been impounded. The protective order shall provide for appropriate procedures to ensure that confidential, private, proprietary, or privileged information contained in such records is not improperly disclosed or used.

(3) The relevant provisions of paragraphs (2) through (11) of section 34(d) of the Trademark Act (15 U.S.C. 1116(d)(2) through (11)) shall extend to any impoundment of records ordered under paragraph (1)(C) that is based upon an ex parte application, notwithstanding the provisions of rule 65 of the Federal Rules of Civil Procedure. Any references in

paragraphs (2) through (11) of section 34(d) of the Trademark Act to section 32 of such Act shall be read as references to section 501 of this title, and references to use of a counterfeit mark in connection with the sale, offering for sale, or distribution of goods or services shall be read as references to infringement of a copyright.

(b) As part of a final judgment or decree, the court may order the destruction or other reasonable disposition of all copies or phonorecords found to have been made or used in violation of the copyright owner's exclusive rights, and of all plates, molds, matrices, masters, tapes, film negatives, or other articles by means of which such copies or phonorecords may be reproduced.

17 U.S.C. § 504

§ 504. Remedies for infringement: Damages and profits

(a) IN GENERAL.—Except as otherwise provided by this title, an infringer of copyright is liable for either—

(1) the copyright owner's actual damages and any additional profits of the infringer, as provided by subsection (b); or

(2) statutory damages, as provided by subsection (c).

(b) ACTUAL DAMAGES AND PROFITS.—The copyright owner is entitled to recover the actual damages suffered by him or her as a result of the infringement, and any profits of the infringer that are attributable to the infringement and are not taken into account in computing the actual damages. In establishing the infringer's profits, the copyright owner is required to present proof only of the infringer's gross revenue, and the infringer is required to prove his or her deductible expenses and the elements of profit attributable to factors other than the copyrighted work.

(c) STATUTORY DAMAGES.—

(1) Except as provided by clause (2) of this subsection, the copyright owner may elect, at any time before final judgment is rendered, to recover, instead of actual damages and profits, an award of statutory damages for all infringements involved in the action, with respect to any one work, for which any one infringer is liable individually, or for which any two or more infringers are liable jointly and severally, in a sum of not less than

$750 or more than $30,000 as the court considers just. For the purposes of this subsection, all the parts of a compilation or derivative work constitute one work.

(2) In a case where the copyright owner sustains the burden of proving, and the court finds, that infringement was committed willfully, the court in its discretion may increase the award of statutory damages to a sum of not more than $150,000. In a case where the infringer sustains the burden of proving, and the court finds, that such infringer was not aware and had no reason to believe that his or her acts constituted an infringement of copyright, the court in its discretion may reduce the award of statutory damages to a sum of not less than $200. The court shall remit statutory damages in any case where an infringer believed and had reasonable grounds for believing that his or her use of the copyrighted work was a fair use under section 107, if the infringer was: (i) an employee or agent of a nonprofit educational institution, library, or archives acting within the scope of his or her employment who, or such institution, library, or archives itself, which infringed by reproducing the work in copies or phonorecords; or (ii) a public broadcasting entity which or a person who, as a regular part of the nonprofit activities of a public broadcasting entity (as defined in section 118(f)) infringed by performing a published nondramatic literary work or by reproducing a transmission program embodying a performance of such a work.

(3)(A) In a case of infringement, it shall be a rebuttable presumption that the infringement was committed willfully for purposes of determining

relief if the violator, or a person acting in concert with the violator, knowingly provided or knowingly caused to be provided materially false contact information to a domain name registrar, domain name registry, or other domain name registration authority in registering, maintaining, or renewing a domain name used in connection with the infringement.

(B) Nothing in this paragraph limits what may be considered willful infringement under this subsection.

(C) For purposes of this paragraph, the term "domain name" has the meaning given that term in section 45 of the Act entitled "An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of certain international conventions, and for other purposes" approved July 5, 1946 (commonly referred to as the "Trademark Act of 1946"; 15 U.S.C. 1127).

(d) ADDITIONAL DAMAGES IN CERTAIN CASES.—In any case in which the court finds that a defendant proprietor of an establishment who claims as a defense that its activities were exempt under section 110(5) did not have reasonable grounds to believe that its use of a copyrighted work was exempt under such section, the plaintiff shall be entitled to, in addition to any award of damages under this section, an additional award of two times the amount of the license fee that the proprietor of the establishment concerned should have paid the plaintiff for such use during the preceding period of up to 3 years.

17 U.S.C. § 507

§ 507. Limitations on actions

* * *

(b) CIVIL ACTIONS.—No civil action shall be maintained under the provisions of this title unless it is commenced within three years after the claim accrued.