

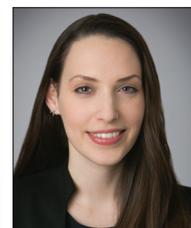
COPYRIGHT COMMENT

The artful dodger

The US Second Circuit Court provides more leeway to appropriation art in a long-awaited ruling, **Benjamin E Marks** and **Olivia J Greer** discuss



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On 25 April 2013, the US Second Circuit reversed in part and remanded in part a district court's determination that the well-known appropriation artist Richard Prince, infringed Patrick Cariou's copyrights when he used Cariou's photographs in a series of collages. The Second Circuit held that the district court erred in concluding that Prince's work must comment on Cariou, his photographs, or on aspects of popular culture closely associated with Cariou or his photographs, for the use to be fair. The appellate court clarified that a secondary use need not comment on the original artist or work, or popular culture, and it concluded that 25 of Prince's 30 works at issue made fair use of Cariou's photographs. The appellate court remanded the remaining claims to the district court for consideration of Prince's fair use defence under the proper standard.

Background

Cariou is a professional photographer. In 2000, he published a series of portraits of Rastafarians and landscape photographs of Jamaica in a book titled *Yes Rasta*. *Yes Rasta* enjoyed limited commercial success and is now out of print.

Like other appropriation artists, Prince takes photographs and images produced by others and incorporates them into his own work. In 2007 and 2008, Prince created dozens of artworks incorporating partial or whole images taken without permission from *Yes Rasta*. The portions of Cariou's photographs used, and the extent of alteration, varied

significantly from piece to piece.

In 2008, the Gagolian Gallery exhibited a series of Prince's collages incorporating Cariou's photographs. Cariou promptly sued Prince, the gallery, and the gallery's owner for copyright infringement. Among other defences, the defendants asserted that Prince's appropriation of Cariou's photographs was protected by the fair use doctrine. At the close of discovery, the parties cross-moved for summary judgment.

The fair use doctrine

As the US Supreme Court has explained, "[f]rom the infancy of copyright protection, some opportunity for fair use of copyrighted materials has been thought necessary to fulfill copyright's very purpose" of promoting "the progress of science and useful arts".¹ The fair use doctrine is essential to prevent "rigid application" of copyright law from "stiffl[ing] the very creativity which that law is designed to foster".²

Section 107 of the Copyright Act instructs courts to evaluate invocations of fair use by considering four non-exclusive factors:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for non-profit 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 defendant bears the burden of proving that an otherwise infringing use is fair.

The Southern District of New York decision

In March 2011, the district court rejected Prince's fair use defence and found his use of Cariou's photographs infringing. Addressing the purpose and character of the use, the court observed that the centre of the first-factor inquiry is whether, and to what extent, the new work is transformative. The court took a narrow view of transformativeness. It acknowledged that the extent to which Prince's collages borrowed from Cariou varied from piece to piece and recognised that there might be more transformation in works using less of Cariou's photographs. However, the court found Prince's subjective intent in creating the works damning, noting that Prince had conceded that "he has no interest in the original message of the photographs he uses", and that "he doesn't 'really have a message' he attempts to communicate when creating art".³ Observing that "all of the precedent this court can identify imposes a requirement that the new work in some way comment on, relate to the historical context of, or critically refer back to the original works",⁴ the district court found that Prince's works were not transformative because they did not comment on Cariou's photographs.

The court found that each of the remaining statutory factors also weighed against fair use. The court weighed the second factor – the nature of the copyrighted work – in Cariou's favour, because his photographs were highly

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original and creative and thus within the core of what copyright seeks to protect. The third factor – the extent of the taking – weighed against Prince, because many of his works utilised entire photographs and others used the central figures from Cariou’s portraits. The fourth factor – the effect of the use upon the potential market for or value of the copyrighted work – weighed against the defendants based on the evidence that another gallery owner, upon learning of the Prince exhibition, had cancelled a planned exhibition of Cariou’s work to avoid showing work that had been “done already” at a nearby gallery.⁵

The court granted Cariou’s motion for summary judgment, enjoined the defendants from infringing Cariou’s copyrights, and required delivery of the infringing works for impounding, destruction, or other disposition.

The Second Circuit decision

The Second Circuit reversed in part and remanded in part. The appellate court found that, for most of the works at issue, three of the four statutory factors, and the overall balance, favoured fair use.

As to the first factor, the appellate court held that the district court applied the wrong legal standard, and it clarified that a secondary use does not need to provide comment on the original work or its author to be fair. The only requirement is that the new work “generally must alter the original with new expression, meaning, or message”.⁶

The appellate court found most of Prince’s paintings were transformative as a matter of law, as they manifested an entirely different aesthetic from the *Yes Rasta* photographs. The photographs were “deliberately composed” depictions of specific people and landscapes, while Prince’s “crude and jarring works” were “hectic and provocative”.⁷ The media used in the works differed, as Cariou’s works are photographs in a book and Prince’s works are mixed-media collages on canvas on a much larger scale. Whereas the district court considered Prince’s testimony as to his lack of intended message as an indication that his work was not transformative, the Second Circuit found that it was more critical to determine “how the work in question appears to the reasonable observer, not simply what an artist might say about a particular piece or body of work”.⁸ The test of transformativeness, in other words, is objective, not subjective.

The appellate court then turned to the fourth factor – the effect of the secondary use upon the potential market for the copyrighted work – and again reached a different conclusion from the one reached by the district court. The appellate court was unpersuaded by the evidence that another gallery had abandoned plans to exhibit the *Yes Rasta* photographs. The court noted that the fourth-factor inquiry examines “not whether the secondary use suppresses or even destroys the market for the original work or its potential derivatives, but whether the secondary use usurps the market of the original work”.⁹ Contrasting what it perceived to be dramatically different audiences for the two works, and noting the minimal efforts made by Cariou to develop a market for his works, the court found no evidence that Prince’s work “ever touched – much less usurped – either the primary or derivative market for Cariou’s work”.¹⁰

The appellate court then briefly dispensed with the second factor, agreeing that it weighed against fair use because Cariou’s photographs were both creative and already published, and moved on to the third-factor inquiry into the amount and substantiality of the portion of the original work used. The court began by observing that “neither our court nor any of our sister circuits has ever ruled that the copying of an entire work favours fair use”,¹¹ but then – surprisingly – proceeded to do just that. It found that the extent of transformation tipped the third factor in favour of fair use as well. The appellate court also took issue with the district court’s assessment that Prince took more than was necessary, observing that “the law does not require that the secondary artist may take no more than is necessary”.¹²

After balancing the factors, the Second Circuit held that Prince’s copying was fair use in 25 of the 30 works, and it remanded the remaining claims because those paintings were too close to the original photographs to be transformative as a matter of law.

Key takeaways

There are several important takeaways from the Second Circuit’s ruling that apply beyond the limited context of appropriation art. First, the fair use analysis does not require that the work challenged as infringing provide commentary on the underlying work. Secondly, by clarifying that the standard for evaluating transformativeness is objective, rather than

subjective, the court has lessened the burden on alleged infringers to explain the intended message of their work. Moreover, employing an objective standard helps to address the concern articulated by Justice Kennedy in his concurring opinion in the landmark fair use case of *Campbell v Acuff Rose*, that clever post-hoc rationalisations, rather than genuine intent to transform an underlying work, could enable copyright infringers to escape liability through an unjustifiably broad application of the fair use doctrine.¹³ Thirdly, the widely divergent views of the district court and the appellate majority demonstrate that whether a given use is fair, often depends on the eye of the beholder. While an important legal standard has been clarified by the decision, the fair use doctrine remains less susceptible to bright-line rules than most other areas of law.

Footnotes

1. *Campbell v Acuff-Rose Music, Inc*, 510 US 569, 575 (1994) (quoting US Const, Art I, sec 8 cl 8) (additional citations omitted).
2. *Id* at 577.
3. *Cariou v Prince*, 784 F Supp 2d 337, 349 (SDNY 2011) (quoting deposition testimony).
4. *Id* at 347-349.
5. *Id* at 353 (quoting deposition testimony).
6. *Cariou v Prince*, No 11-1197, 2013 WL 1760521, at *5 (2d Cir 25 Apr 2013) (quotation omitted).
7. *Id* at *6.
8. *Id*.
9. *Id* at *8.
10. *Id*.
11. *Id* at *9 (citing *Bill Graham Archives v Dorling Kindersley Ltd*, 448 F3d 605, 613 (2d Cir 2006)).
12. *Id* at *10.
13. *Campbell*, 510 US at 599-600 (Kennedy, J concurring) (“Almost any revamped modern version of a familiar composition can be construed as a ‘comment on the naiveté of the original.’”); see also Benjamin Ely Marks, ‘Parody, Fair Use, and the Artful Dodger: A Critical Commentary on *Leibovitz v Paramount Pictures Corporation*,’ 7 *Bright Ideas* 12, 12-13 (Spring 1998) (criticising reliance on post-hoc rationalisations rather than evidence of actual intent).