

# Alert

## Intellectual Property/Media

Second Circuit Gives More Leeway to Appropriation Art: In *Cariou v. Prince*, the appeals court clarifies that secondary uses need not comment on an original work for copying to be a fair use

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On April 25, the 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 imposed an incorrect legal standard when it concluded that, in order to qualify for a fair use defense, Prince's work must 'comment on Cariou, on Cariou's Photos, or on aspects of popular culture closely associated with Cariou or the Photos.'"<sup>1</sup> The appellate court held that there is no requirement "that a secondary use comment on the original artist or work, or popular culture."<sup>2</sup> The court concluded that 25 of Prince's 30 works at issue made fair use of Cariou's photographs and remanded the remaining claims to the district court for consideration of Prince's fair use defense under the proper standard.

### Background

Cariou is a professional photographer who spent part of the 1990s living and working among Rastafarians in Jamaica. In 2000, he published a series of portraits and landscape photographs in a book titled *Yes Rasta*. Cariou described *Yes Rasta* as "extreme classical photography [and] portraiture," and he testified that he did not "want that book to look pop culture at all."<sup>3</sup> *Yes Rasta* enjoyed limited commercial success and is now out of print. Cariou's publisher paid him just over \$8,000 from sales of the book, and "except for a handful of sales to personal acquaintances, he has never sold or licensed the individual photographs."<sup>4</sup>

The work of appropriation artists such as Prince involves "more or less direct taking over into a work of art a real object or even an existing work of art."<sup>5</sup> Prince's work, for decades, has involved taking photographs and images produced by others and incorporating them into his own paintings and collages. Prince has described his work as trying to change another artist's work "into something that's completely different."<sup>6</sup> In 2007 and 2008, Prince created dozens of artworks incorporating partial or whole images taken from *Yes Rasta*. The portions of Cariou's photographs used, and the extent of the modification, varied significantly from piece to piece. In each instance, the Prince works were much larger than the pages of *Yes Rasta*, and modifications to Cariou's photographs included enlarging them, tinting them, and painting over portions of them. In some of Prince's works, Cariou's

photographs were “almost entirely obscured”; in others, “Cariou’s original work is readily apparent: Prince did little more than paint blue lozenges over the subject’s eyes and mouth, and paste a picture of a guitar over the subject’s body.”<sup>7</sup> Prince never sought or received permission from Cariou to use his photographs.

In 2008, the Gagosian Gallery, which represents Prince, exhibited his *Canal Zone* series, a collection of collages incorporating Cariou’s photographs, and it published and sold an exhibition catalog with images of Prince’s works. Shortly after Cariou learned about the *Canal Zone* show, he sued Prince, the Gagosian Gallery, and its owner, Larry Gagosian, for copyright infringement. Among other defenses, the defendants asserted that Prince’s appropriation of Cariou’s copyrighted 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 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.”<sup>8</sup> The fair use doctrine is essential to prevent “rigid application” of copyright law protections from “stifl[ing] the very creativity which that law is designed to foster.”<sup>9</sup>

Section 107 of the Copyright Act instructs courts to evaluate invocations of fair use on a case-by-case basis by considering the following non-exclusive factors:

- (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.<sup>10</sup>

As fair use is an affirmative defense, the burden is on the defendant to prove that an otherwise infringing use is fair.

## The Southern District of New York Decision

In March 2011, Judge Deborah A. Batts held that Prince had infringed Cariou’s copyrights and rejected Prince’s fair use defense. Addressing the first factor of the four-factor fair use analysis – the purpose and character of the use – the court observed that the “central purpose of the inquiry . . . is to determine . . . 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; it asks, in other words, whether and to what extent the new work is transformative.”<sup>11</sup> The court, however, took a narrow view of transformativeness. The court observed 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” and focused its first-factor inquiry on whether or not Prince’s use expressed “transformative comment” on Cariou’s original work.<sup>12</sup> Judge Batts expressly “decline[d] Defendants’ invitation to find that appropriation art is *per se* fair use, regardless of whether or not the new artwork in any way comments on the original works appropriated.”<sup>13</sup>

The district court found that, on balance, Prince’s works were not transformative, because they did not comment on Cariou’s photographs. Judge Batts acknowledged that the extent to which Prince’s collages were transformative varied from piece to piece, stating that there was “vanishingly little, if any, transformative element” in pieces that utilized entire photographs, and recognizing that there might be more transformation in works using less of Cariou’s original works.<sup>14</sup> The court, however, 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.”<sup>15</sup> Overall, the court found that “because the transformative content of Prince’s paintings is minimal at best, and because that element is not consistent throughout,” the transformative-use prong of the first fair use factor “weighs heavily against a finding of fair use.”<sup>16</sup> The court then considered the extent to which the secondary use was commercial in nature and whether the defendants had acted in bad faith. Its findings that the use was highly commercial, with paintings sold or exchanged for other works at a total value of more than \$20 million, and that Prince and Gagosian acted in bad faith by failing to respond to a cease and desist notice, contributed to its determination that the first factor weighed against a finding of fair use.

The court found that each of the remaining statutory factors also weighed against a finding of fair use. As to the second factor – the nature of the copyrighted work – the court held that Cariou’s photographs were “highly original and creative artistic works,” constituting “creative expression for public dissemination” and therefore falling within “the core of the copyright’s protective purposes.”<sup>17</sup> The third fair use factor – the extent of the taking – weighed “heavily” against Prince because many of his works utilized entire photographs and others used the “central figures” from Cariou’s portraits.<sup>18</sup> The fourth fair use 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 a gallery owner had canceled a planned exhibition of Cariou’s work upon learning of the Gagosian Gallery’s *Canal Zone* exhibition, “because she did not want to appear to be capitalizing on Prince’s Paintings and did not want to show work which had been ‘done already’” at a nearby gallery.<sup>19</sup>

Having determined that each of the four factors weighed against a finding of fair use, there was no need for the sensitive balancing often required in cases involving a fair use defense. 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, as Plaintiff determines.”<sup>20</sup>

## 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 favored a finding of fair use.

As to the first factor, the appellate court held that the district court had applied the wrong legal standard, and it clarified that a secondary use does not need to provide comment on the original artist or work, or on popular culture more generally, to qualify as fair use. The court held that “[t]he law imposes no requirement that a work comment on the original or its author in order to be considered transformative, and a secondary work may constitute a fair use even if it serves some purpose other than those (criticism, comment, news reporting, teaching, scholarship, and research) identified in the preamble to the statute.”<sup>21</sup> All that is required is that the new work “generally must alter the original with ‘new expression, meaning, or message.’”<sup>22</sup>

Examining the broader context of appropriation art as a movement in which artists aim to change the work of other artists into “something that’s completely different,” the court found that 25 of the 30 works at issue made transformative uses of the *Yes Rasta* photographs.<sup>23</sup> In the view of the Second Circuit, these paintings were transformative as a matter of law, as they “manifest[ed] an entirely different aesthetic from Cariou’s photographs.”<sup>24</sup> The photographs were “deliberately composed” depictions of specific people and landscapes, while Prince’s “crude and jarring works” were “hectic and provocative.”<sup>25</sup> The media used in the works differed, as Cariou’s works are photographs in a book and Prince’s are collages on canvas incorporating mixed media on a much larger scale. The artists’ approaches to their work, and their personal aesthetics, were also “drastically different.”<sup>26</sup> 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.”<sup>27</sup>

The test of transformativeness, in other words, is objective, rather than subjective.

The appellate court's determination was not undermined by its consideration of the commercial aspects of Prince's works and the Gagosian Gallery's promotion of them, and it did not address the district court's finding of bad faith at all. The court noted that most of the illustrative fair uses listed in the preamble paragraph of section 107 of the Copyright Act tend to be conducted for profit, and cautioned that the "commercial/nonprofit dichotomy" cannot be applied in a bright-line manner. The court quoted the US Supreme Court's landmark fair use decision in *Campbell v. Acuff-Rose* for the proposition that "[t]he more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use."<sup>28</sup>

The appellate court then turned to the fourth fair use factor – the effect of the secondary use upon the potential market for the copyrighted work – and again reached a conclusion different 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 after the owner learned of Gagosian's *Canal Zone* exhibit. The court noted that the cancellation of the *Yes Rasta* show was based on the gallery's mistaken belief that Cariou was collaborating with Prince on the *Canal Zone* exhibit and that Cariou had failed to correct that misimpression. In any event, 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."<sup>29</sup> 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."<sup>30</sup>

The appellate court then briefly dispensed with the second fair use 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 favors fair use," but "courts have concluded that such copying does not necessarily weigh against fair use because copying the entirety of a work is sometimes necessary to make a fair use of the image."<sup>31</sup> Surprisingly, after acknowledging that no other appellate court has ever found that the third factor favors a defendant who has copied an entire work, the court proceeded to do just that. The court moved methodically through the works at issue, discussing the extent of the copying. With respect to 25 of the works, the court found that Prince had used "key portions" of Cariou's photographs, but because he transformed them "into something new and different," the third factor "weighs heavily in Prince's favor."<sup>32</sup> The court also took issue with the district court's assessment that Prince took more than was necessary, and clarified that "the law does not require that the secondary artist may take no more than is necessary."<sup>33</sup>

After balancing the factors, the Second Circuit held that Prince's copying was fair use in 25 of the works at issue, and it remanded review of the remaining five works to the district court because they did not differ enough from Cariou's photographs for the appellate court to "make a determination about their transformative nature as a matter of law."<sup>34</sup> The court stated that the district court was "best situated" to decide whether the "relatively minimal alterations" of Cariou's work in Prince's remaining five paintings rendered those works fair use.<sup>35</sup>

Judge John Clifford Wallace, a Ninth Circuit judge sitting by designation, concurred in part and dissented in part. He agreed that the district court had applied an incorrect standard, but he took issue with the majority's decision to remand only five of the works. He expressed the view that, upon correcting the erroneous legal standard employed by the district court, the proper course was to remand all of the works for reconsideration. Judge Wallace wrote, "while I admit freely that I am not an art critic or

expert, I fail to see how the majority in its appellate role can confidently draw a distinction between the twenty-five works that it has identified as constituting fair use and the five works that do not readily lend themselves to a fair use determination,” and cautioned that the court ought not use “personal art views” in determining the matter at hand.<sup>36</sup>

## Key Takeaways

There are several important takeaways from the Second Circuit’s ruling that have application well 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. Second, by clarifying that the standard for evaluating the transformative nature of a secondary use is objective, rather than subjective, the court has lessened the burden on alleged infringers to explain the intended message behind their work and use of copyrighted material. Moreover, employing an objective standard for evaluating whether a work is transformative, rather than placing the burden on secondary users to explain their intent, helps to address the concern articulated by Justice Kennedy in his concurring opinion in *Campbell* that clever post-hoc rationalizations, 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.<sup>37</sup> Third, the widely divergent views of the district court and the appellate majority – and the difficulty that Judge Wallace professed to having in trying to distinguish between fair uses and unfair ones – 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 capable of predicting the outcome of disputes than most other areas of law.

1 *Cariou v. Prince*, No. 11-1197, 2013 WL 1760521, at \*1 (2d Cir. Apr. 25, 2013) (quoting *Cariou v. Prince*, 784 F. Supp. 2d 337, 349 (S.D.N.Y. 2011)).

2 *Id.*

3 *Id.*

4 *Id.*

5 *Id.* at \*2. The Second Circuit has prior experience in grappling with the copyright implications of appropriation art, with mixed results for the artist. See *Blanch v. Koons*, 467 F.3d 244 (2d Cir. 2006) (finding Jeff Koons’s appropriation of a copyrighted photograph to be a fair use); *Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992) (finding Koons’s appropriation of a copyrighted photograph infringing).

6 *Cariou*, 2013 WL 1760521, at \*2.

7 *Id.*

8 *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 575 (1994) (quoting U.S. Const., Art. I, sec. 8 cl. 8) (additional citations omitted).

9 *Id.* at 577.

10 17 U.S.C. § 107.

11 *Cariou v. Prince*, 784 F. Supp. 2d at 347 (quoting *Salinger v. Colting*, 641 F. Supp. 2d 250, 256 (S.D.N.Y. 2009), *rev’d on other grounds*, 607 F. 68 (2d Cir. 2010) and citing *Campbell*, 510 U.S. at 579).

12 *Id.*

13 *Id.* at 348-349.

14 *Id.* at 350.

15 *Id.* (quoting deposition testimony)

16 *Id.*

17 *Id.* at 352.

18 *Id.*

19 *Id.* at 353 (quoting deposition testimony)

20 *Id.* at 355.

21 *Cariou*, 2013 WL 1760521, at \*5.

22 *Id.*

23 *Id.*

24 *Id.* at \*6.

25 *Id.*

26 *Id.*

27 *Id.*

28 *Cariou*, 2013 WL 1760521, at \*7 (quoting *Campbell*, 510 U.S. at 579).

29 *Id.* at \*8.

30 *Id.*

31 *Id.* at \*9 (citing *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 613 (2d Cir. 2006)).

- 32 *Id.*
- 33 *Id.* at \*10.
- 34 *Id.*
- 35 *Id.* at \*11.
- 36 *Id.* at \*13 (Wallace, J., concurring in part and dissenting in part) (quotation omitted).
- 37 *Campbell*, 510 U.S. at 599-600 (Kennedy, J. concurring) (“Almost any revamped modern version of a familiar composition can be construed as a ‘comment on the naivete 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) (criticizing reliance on post-hoc rationalizations rather than evidence of actual intent).

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