

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

REPLY BRIEF FOR PETITIONER

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

SAMIR DEGER-SEN
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

TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES	ii
INTRODUCTION	1
ARGUMENT	1
I. The Second Circuit Flouted <i>Campbell</i>	1
II. The Circuit Split Is Real.....	6
III. The Question Presented Is Exceptionally Important	9
CONCLUSION.....	12

TABLE OF AUTHORITIES

Page(s)

CASES

<i>Balsey v. LFP, Inc.</i> , 691 F.3d 747 (6th Cir. 2012), <i>cert.</i> <i>denied</i> , 568 U.S. 1124 (2013).....	9
<i>Brammer v. Violent Hues Products,</i> <i>LLC</i> , 922 F.3d 255 (4th Cir. 2019).....	8, 9
<i>Campbell v. Acuff-Rose Music, Inc.</i> , 510 U.S. 569 (1994).....	1, 2, 5, 6, 9
<i>Dr. Seuss Enterprises, L.P. v. ComicMix</i> <i>LLC</i> , 983 F.3d 443 (9th Cir.), <i>cert. denied</i> , 141 S. Ct. 2803 (2020).....	8
<i>Easter Unlimited, Inc. v. Rozier</i> , 2021 WL 4409729 (E.D.N.Y. Sept. 27, 2021).....	10
<i>Fioranelli v. CBS Broadcasting Inc.</i> , 2021 WL 3372695 (S.D.N.Y. July 28, 2021).....	10
<i>Google LLC v. Oracle America, Inc.</i> , 141 S. Ct. 1183 (2021).....	6
<i>Grant v. Trump</i> , 2021 WL 4435443 (S.D.N.Y. Sept. 28, 2021).....	10

TABLE OF AUTHORITIES—Continued

	Page(s)
<i>National Academy of Television Arts & Sciences, Inc. v. Multimedia System Design, Inc.</i> , 2021 WL 3271829 (S.D.N.Y. July 30, 2021)	10
<i>Núñez v. Caribbean International News Corp.</i> , 235 F.3d 18 (1st Cir. 2000)	9
<i>Seltzer v. Green Day, Inc.</i> , 725 F.3d 1170 (9th Cir. 2013).....	6, 7

OTHER AUTHORITIES

Museum of Modern Art Learning, <i>Pop Art: Appropriation</i> , https://www.moma.org/learn/moma_learning/themes/pop-art/appropriation/ (last visited Feb. 17, 2022)	12
4 <i>Nimmer on Copyright</i> (2021)	2
David E. Shipley, <i>A Transformative Use Taxonomy: Making Sense of the Transformative Use Standard</i> , 63 Wayne L. Rev. 267 (2018).....	11

INTRODUCTION

Certiorari is warranted because the Second Circuit interpreted the fair use doctrine to forbid consideration of the *meaning* of a work of visual art, where it looks too much like the original work it borrows from. That new Second Circuit rule departs from this Court’s precedent, splits from the Ninth Circuit and other courts of appeals, and threatens massive restrictions on First Amendment expression. Goldsmith’s efforts to pretend otherwise all fail. As numerous and diverse *amici* confirm, the doctrinal errors and harmful effects of the Second Circuit’s ruling require this Court’s urgent attention. The petition should be granted.

ARGUMENT

I. The Second Circuit Flouted *Campbell*

1. This Court’s decision in *Campbell v. Acuff-Rose Music, Inc.* makes clear that the linchpin of the “transformativeness” inquiry under the first fair use factor is whether the new work “adds something new, with a further purpose or different character, altering the first with new expression, *meaning, or message.*” 510 U.S. 569, 579 (1994) (emphasis added). Here, there is no dispute that the Prince Series *does* communicate a different meaning and message than Goldsmith’s original. As Goldsmith explained, her photograph conveys the message that Prince himself was “a really vulnerable human being” with “immense fears.” CA2 Joint Appendix (“JA”) 1553, 1557-58; *see also* Opp. 3-5. By contrast, Warhol used that same image, transforming its appearance in subtle but unmistakable respects, for a different purpose—not to “portray” Prince at all, but to

comment on society’s portrayal of celebrity. JA1370-73; Pet. App. 72a, 77a-78a.

Nonetheless, the Second Circuit held that when assessing transformativeness under the first fair use factor, courts should *not* analyze alleged differences in meaning between two artworks that share a close visual resemblance. Pet. App. 22a-25a. That holding constitutes a doctrinal turn so stark and unsupported that it demands this Court’s intervention.

Goldsmith tries to downplay the significance of this ruling, asserting the panel simply “applied the Court’s longstanding test for transformativeness.” Opp. 15. In her telling, even when a work conveys a distinct meaning or message from the original, it does not “automatically qualif[y]” as transformative unless it also reflects a “fundamentally different and new’ artistic purpose.” *Id.* at 16-17 (citation omitted).

Goldsmith is mistaken. Under *Campbell*, a new work has “a further purpose or different character” whenever it “alter[s] the first [work] with new expression, *meaning, or message.*” 510 U.S. at 579 (emphasis added). There is no supervening requirement that the new “meaning, or message” also serve some more “fundamentally different artistic purpose.” Fair use, after all, is a defense that becomes relevant *only once two works are “substantially similar”* (*i.e.*, once a *prima facie* act of infringement occurs). See 4 *Nimmer on Copyright* § 13.05 (2021) (“[F]air use is a defense not because of the absence of substantial similarity but rather despite the fact that the similarity is substantial.”). Suggesting that the fair use doctrine kicks in only when the two works have divergent fundamental purposes precludes application of the doctrine in the primary circumstance in which it is needed.

2. Although the Second Circuit paid lip service to *Campbell*, Pet. App. 13a, the court then created a new test for transformative use that does the opposite of what *Campbell* instructs—it *forbids* inquiry into meaning and message, and instead focuses narrowly on visual similarity. Goldsmith asserts that AWF “mischaracterizes” the Second Circuit’s decision, Opp. 1, but the words of the opinion speak for themselves.

First, the Second Circuit defined “purpose” at a level of generality so high that it treats works with materially *different* meanings or messages as having the same purpose: “[T]here 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.” Pet. App. 24a-25a (footnote omitted).

Second, the court forbade judicial inquiry into meaning or message: “[T]he district judge should not assume the role of art critic and seek to ascertain the intent behind or meaning of the works at issue. That is so both because judges are typically unsuited to make aesthetic judgments and because such perceptions are inherently subjective.” *Id.* at 22a-23a.

Third, the court held that visual similarity—not added meaning or message—drives the transformativeness inquiry: “[T]he 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.” *Id.* at 23a-24a (emphasis added).

Taken together, these holdings mean (1) when two works of art depict the same subject, (2) a court is forbidden from trying to “ascertain the intent behind or meaning of the works at issue,” and (3) “must” find no transformativeness if the later work “recognizably deriv[es] from, and retain[s] essential elements of, its source material.” *Id.* at 21a-24a. That new test departs from *Campbell’s* meaning-or-message inquiry, in “defiance” of “settled law.” Copyright Law Professors *Amici* Br. 3-4.

3. This case is a perfect vehicle to correct that error, because Goldsmith does not dispute that the Prince Series added new “meaning or message.” As the district court found, the Prince Series “transformed” Goldsmith’s portrayal of a vulnerable Prince into “an iconic, larger-than-life figure,” to comment on the manner in which society encounters and consumes celebrity. Pet. App. 71a-72a. It accordingly “reflect[ed] the opposite” message of Goldsmith’s photograph. *Id.* at 71a; *see also* JA1373; CA2 Appellants Br. 31 (conceding that Prince Series “[a]dds [n]ew [e]xpression”).

Goldsmith argues this new meaning and message is *irrelevant* because the works share a common purpose in that they are both “portraits” of Prince. Opp. 19. But Goldsmith examines “purpose” at an arbitrarily high level of generality that effectively forecloses what should be the operative inquiry. Sure, the two works can be characterized as sharing the same general “purpose” in the sense that they are “portraits of the same person.” *Id.* (quoting Pet. App. 24a-25a). But they can equally be characterized as having very different “purposes,” because—as the

trial court found—Goldsmith’s aim was to convey a message about Prince, while Warhol’s was to convey a message about society. Pet. App. 71a-72a. Goldsmith’s abstract invocation of “purpose” therefore obscures the fundamental question: Does a concededly new meaning or message constitute a distinct purpose?

The Second Circuit says *no*, but this Court’s precedent says *yes*—a different “meaning[] or message” is enough. *Campbell*, 510 U.S. at 579. In *Campbell*, for example, the two songs shared the same high-level purpose (in Goldsmith’s sense), in that both were popular musical compositions addressing the same topic. *Id.* at 579-80. The second song also “recognizably deriv[ed] from, and retain[ed] the essential elements of, its source material,” Pet. App. 23a-24a, due to “cop[ying] the characteristic opening bass riff (or musical phrase) of the original, and . . . the words of the first line,” *Campbell*, 510 U.S. at 588. Under the Second Circuit’s test, that would be the end of the matter. But this Court deemed the second song transformative because it added new “meaning.” *Id.* at 579, 583.

Goldsmith tries to distinguish *Campbell* by asserting that because the new “song objectively had a different purpose—to ‘comment[] on the original or criticiz[e] it’—that purpose transformed the original into something new.” Opp. 16-17 (alterations in original) (quoting 510 U.S. at 583). But the same is true here: Warhol’s Prince Series *also* had a different purpose than the Goldsmith photograph—it sought to comment on society’s view of celebrity. And there is no logical distinction between adding commentary on the original work and commentary that relates to society in general. The very thing that renders

parody transformative—the addition of a distinct “meaning[] or message,” *Campbell*, 510 U.S. at 579—likewise renders works of social commentary, like the Prince Series, equally transformative.

4. Goldsmith’s treatment of *Google LLC v. Oracle America, Inc.*, 141 S. Ct. 1183 (2021), fares no better. Goldsmith asserts that *Google* is distinguishable because the “purposes” of the original and new software codes were different. Opp. 17. But, again, under the Second Circuit’s approach, both would have been characterized as embodying the same general purpose. Indeed, this Court itself stated that the second work copied the code “in part for the same reason” as the original was created. *Google*, 141 S. Ct. at 1190, 1195, 1203.

Goldsmith’s attempts to recharacterize this Court’s precedent to salvage the Second Circuit’s decision thus simply reinforce the doctrinal schism it created. Under *Campbell* and *Google*, a court must ascertain whether there is added “meaning or message” to determine whether works’ purposes are different. The Second Circuit’s decision wrongly disclaims that inquiry.

II. The Circuit Split Is Real

1. Goldsmith contends (at 23) that the split with the Ninth Circuit is illusory. But in *Seltzer v. Green Day, Inc.*, the Ninth Circuit made unmistakably clear that new works are “viewed as transformative as long as *new expressive content or message* is apparent.” 725 F.3d 1170, 1177 (9th Cir. 2013) (emphasis added). That contradicts the Second Circuit’s approach here.

Goldsmith ignores *Seltzer*’s holding, instead contending that the result in that case turned on “the . . . purpose [of the image there being] changed from

street art to ‘raw material in the . . . video backdrop.’” Opp. 23 (alteration in original) (quoting 725 F.3d at 1176-77). But she does not explain why that purported change in form should control the transformative use inquiry. Indeed, Goldsmith elsewhere asserts that film adaptations from novels are *not* transformative, notwithstanding a change in form. Opp. 16.

In any event, Goldsmith’s explanation of *Seltzer* simply does not square with the Ninth Circuit’s own reasoning. The court explicitly evaluated the message of each work, finding that the subsequent work could reasonably be perceived to convey “new information, new aesthetics, new insights and understandings” about “the hypocrisy of religion.” 725 F.3d at 1176-77. As the Ninth Circuit held: “In the typical ‘non-transformative’ case, the use is one which makes no alteration to the *expressive content or message* of the original work.” *Id.* at 1177. That has nothing to do with the change from “street art” to a “video backdrop.”

The Ninth Circuit then juxtaposed that definition of non-transformative works against transformative works, which include “*new expressive content or message*” even where there are “few physical changes to the original” or where the new work “fails to comment on the original.” *Id.* (emphasis added). *Seltzer* thus clearly undertakes the very “meaning or message” inquiry the Second Circuit disclaimed, even where the works are visually similar. Goldsmith’s attempt to characterize *Seltzer* as turning on some change in form fails.

Goldsmith also relies on *Dr. Seuss Enterprises, L.P. v. ComicMix LLC*, to assert that the Ninth Circuit focuses its inquiry solely on “purpose.” 983

F.3d 443 (9th Cir.), *cert. denied*, 141 S. Ct. 2803 (2020). That case actually confirms the conflict. There, the court evaluated the use of Dr. Seuss’s book, *Oh, the Places You’ll Go! (Go!)*, in a “mash-up” book that features a figure from *Star Trek* as well as the content from Dr. Seuss. *Id.* at 448. The defendant contended that the introduction of “new content,” *i.e.* visual alteration, rendered the second work transformative. *Id.* at 453. But the court concluded that the “new content” “d[id] not alter [the original work] with new expression, meaning, or message.” *Id.* at 454. That *lack* of added meaning and message drove the court’s analysis.

2. As to the other circuits, Goldsmith attacks a strawman. Goldsmith asserts that AWF is “incorrect that other circuits focus exclusively on whether the secondary use changed the meaning and message of the original.” Opp. 25. But AWF has never argued that meaning and message are the only relevant factors. Instead, the petition explained that while “the Second Circuit emphasized that a court should *not* ‘seek to ascertain the intent behind or meaning of the works at issue,’ Pet. App. 22a-23a, most other circuits *require* that inquiry.” Pet. 29.

And Goldsmith cannot dispute that the courts in those cases explicitly considered meaning and message. For example, the Fourth Circuit in *Brammer v. Violent Hues Products, LLC*, first asked whether a new work incorporating a photograph had “alter[ed] the original with ‘new expression, meaning or message.’” 922 F.3d 255, 263 (4th Cir. 2019) (quoting *Campbell*, 510 U.S. at 579). While the court then considered the defendant’s argument that “by placing the image in a list of tourist attractions” it had given the work a different purpose, the court returned

to the issue of meaning or message, noting that while a “wholesale reproduction may be transformed when placed in a ‘new context to serve a different purpose,’ . . . the secondary use still must . . . imbu[e] the original *with new function or meaning*.” *Id.* at 263 (emphasis added). The touchstone of the court’s transformative use analysis was thus added meaning or message. *Id.*; see also *Balsey v. LFP, Inc.*, 691 F.3d 747, 759 (6th Cir. 2012) (work not transformative because, in part, it “did not add any creative message or meaning to the photograph”), *cert. denied*, 568 U.S. 1124 (2013); *Núñez v. Caribbean Int’l News Corp.*, 235 F.3d 18, 23 (1st Cir. 2000) (focusing on intent and meaning of new use of photographs).

III. The Question Presented Is Exceptionally Important

A wide range of *amici*—including artists, museums, foundations, and academics—have confirmed that the question presented is exceptionally important. Goldsmith’s efforts to downplay the harmful consequences of the Second Circuit’s decision for artistic expression all fail.

1. Goldsmith suggests that, because some district courts in the Second Circuit have “found fair use in other cases,” the Second Circuit’s decision has not actually hollowed out the fair use defense. Opp. 20-21. But the cases she cites do not implicate the troubling aspects of the Second Circuit’s ruling, because the new works were clearly transformative by any measure. See *Easter Unlimited, Inc. v. Rozier*, 2021 WL 4409729, at *14 (E.D.N.Y. Sept. 27, 2021) (finding second-in-time work was transformative because it had “a significantly different use and purpose,” and because second work qualified as both

parody and satire); *Fioranelli v. CBS Broad. Inc.*, 2021 WL 3372695, at *27 (S.D.N.Y. July 28, 2021) (finding use of brief snippet of September 11 footage in a docudrama was transformative). Even then, one of the cases Goldsmith relies on demonstrates the danger of the Second Circuit’s decision, because it applied the decision below to *deny* fair use protection as to a subset of the material at issue. *Id.* at *24 (finding some works non-transformative because there were no “visual differences” between the original and secondary works).

AWF’s point, of course, is not that the decision below will lead to the wrong result in *every* case—just that it will lead district courts astray in the significant number of cases where its novel rule will be dispositive. Indeed, Goldsmith ignores other decisions from district courts in the Second Circuit where that is precisely what happened. *See Grant v. Trump*, 2021 WL 4435443, at *4, 8 (S.D.N.Y. Sept. 28, 2021) (finding work not transformative, because song was “instantly recognizable,” and “the additional audio . . . does nothing to obscure the [original] song”); *National Acad. of Television Arts & Scis., Inc. v. Multimedia Sys. Design, Inc.*, 2021 WL 3271829, at *2, 4-5 (S.D.N.Y. July 30, 2021) (not transformative despite different message, because “Defendant has made no substantial alterations to the Emmy Statuette” and “a simple side-by-side comparison” shows that the secondary work “retains the dominant and essential aesthetic elements of the Emmy Statuette”). In any event, the fact that at least five district courts have *already* relied on the Second Circuit’s ruling when analyzing transformative use highlights the decision’s importance.

2. Goldsmith also denies the significance of the decision because transformativeness is only one element of the four-factor fair use test. Opp. 29. In practice, though, transformativeness is virtually always dispositive of the fair use question. See David E. Shipley, *A Transformative Use Taxonomy: Making Sense of the Transformative Use Standard*, 63 Wayne L. Rev. 267, 276-77 (2018). Goldsmith cannot seriously deny the central role transformativeness plays in copyright law.

3. Goldsmith next asserts the ruling will not have a substantial effect because the Second Circuit purported to differentiate between the original Prince Series and commercial reproductions. Opp. 31-32. But as AWF's *amici* point out, the distinction between a work and a commercial reproduction "finds no footing in the Copyright Act or this Court's precedent." Robert Rauschenberg Found. et al. *Amici* Br. ("Rauschenberg Br.") 26 n.6. Nor does it "make[] . . . sense" given that the Second Circuit's "reasoning focused on whether the Prince Series *itself* was a fair use." *Id.* As a result, the purported distinction will *itself* sow confusion—as artists and owners of art attempt to parse out what aspects of the Second Circuit's ruling might apply to them.

Moreover, Goldsmith's assertion that the opinion will not have a chilling effect defies common sense. "[T]he intentional borrowing, copying, and alteration of existing images and objects," has been "used by artists for millennia." Museum of Modern Art Learning, *Pop Art: Appropriation*, https://www.moma.org/learn/moma_learning/themes/pop-art/appropriation/ (last visited Feb. 17, 2022). Even if the Second Circuit's decision is narrowly cabined to commercial reproductions—and there is no

reason to think it will be—the ability to reproduce works is of central importance to artists, galleries, and museums. *See* Rauschenberg Br. 26 n.6.

4. Finally, as *amici* emphasize, the threat to galleries and museums is real, not imagined. *See id.* at 27 (collecting cases where galleries were sued “just for displaying allegedly infringing art”). The Second Circuit’s decision, which conflicts with this Court’s precedent and creates a circuit split, threatens not only the production of future pieces of art, but also the availability and enjoyment of current seminal works. That result should not stand.

CONCLUSION

The petition for certiorari should be granted.

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

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

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

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