No. 22-531

IN THE
Supreme Court of the United States

ALAN WOFSY and ALAN WOFSY & ASSOCIATES,
Petitioners,

v.

VINCENT SICRE DE FONTBRUNE; LOAN SICRE DE FONTBRUNE; ADELE SICRE DE FONTBRUNE; ANAIS SICRE DE FONTBRUNE, IN THEIR CAPACITY AS THE PERSONAL REPRESENTATIVES OF THE ESTATE OF YVES SICRE DE FONTBRUNE,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

REPLY IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

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INTRODUCTION

In opposing certiorari, de Fontbrune fails to refute the basis for Wofsy's petition, namely, that the Ninth Circuit created stark circuit splits in interpreting three of the four statutory fair use factors under 17 U.S.C. § 107. Instead, de Fontbrune attempts to muddy the waters by raising issues of state law that this Court does not have to reach or resolve.

The Ninth Circuit's opinion turns on that court's mistaken interpretation of federal copyright law. Based on that mistaken interpretation of federal law, the Ninth Circuit concluded that de Fontbrune's French judgment was not repugnant to California or United States public policy for purposes of California's Uniform Foreign-Country Money Judgments Recognition Act (UFCMJRA). The issue that warrants this Court's review is not the application of the UFCMJRA, but rather the Ninth Circuit's erroneous determinations on the fair use factors, each of which diverged from the law of other circuits. Those determinations involve pure issues of federal law, and no less so because they will inform the lower court's application of the UFCMJRA. Once this Court resolves the important federal law issues to determine whether Wofsy's use of photographic reproductions qualifies as fair use, then the lower court can decide whether a foreign judgment that denies fair use protection is repugnant to the public policy of California or the United States.

That this Court's resolution of the circuit split regarding the fair use factors will not immediately resolve the case does not detract from the suitability of the case for certiorari. Indeed, this Court often grants certiorari to resolve contested issues of federal law with the knowledge and expectation that it will then remand for a lower court to decide the case in light of the newly clarified law. Wofsy's petition calls upon this Court to resolve circuit splits regarding federal fair use doctrine. Wofsy does not ask the Court to interpret or apply the California UFCMJRA, and the Court does not need to address any aspect of the California UFCMJRA in order to resolve the correct interpretation of the fair use factors.

ARGUMENT

I. The Ninth Circuit's Decision Turned on Federal Copyright Law, Not State Law

Although the fair use issues in this case arose in the context of an action for recognition of a foreign judgment under California's UFCMJRA, the opinion of the Ninth Circuit turned on federal copyright law, and the questions presented in the petition relate exclusively to federal copyright law. Despite de Fontbrune's arguments to the contrary, the interpretation of fair use is central to both the district court's and the Ninth Circuit's decisions in this case.

Under California's UFCMJRA, a court can decline to recognize a foreign judgment where "the judgment

or cause of action or claim for relief on which the judgment is based is repugnant to the public policy of [California] or of the United States." Cal. Code Civ. Proc. § 1716(c)(3). Here, the district court granted summary judgment for Wofsy on the ground that the French judgment is repugnant to U.S. public policy because Wofsy's use of photographic reproductions of the works of Picasso from the *Zervos Catalogue* would have been protected under the fair use doctrine had he been sued in the United States. App. 75a-84a. The decision of the district court thus turned on: (1) its determination under federal copyright law that Wofsy's use of the reproductions is protected under the fair use doctrine; and (2) that a foreign judgment denying fair use protection for such use was repugnant to California and U.S. public policy under the UFCMJRA.

The Ninth Circuit reversed the district court's decision on the first question under federal law, and it expressly did not decide the second question under California state law. The Ninth Circuit recognized that "Wofsy's public policy defense rests on two assertions: first, that the fair use doctrine of U.S. copyright law—a feature that France's copyright scheme lacks—would have protected the copying of the photographs at issue; and second, that a judgment imposing copyright liability based on copying that would qualify as fair use is repugnant to our public policy. For the reasons below, we reject the first of these contentions, and therefore *need not reach the second*." App. 19a (emphasis added). The

first assertion was a pure question of federal law; only the second question, which the Ninth Circuit did not reach, implicates California state law.

The court of appeals addressed the four statutory fair use factors under 17 U.S.C. § 107, and concluded that "it is at least highly debatable—if not absolutely clear—that a fair use defense would not protect the conduct underlying the judgment of which Sicre de Fontbrune seeks recognition." App. 20a-27a. On that basis, the Ninth Circuit granted partial summary judgment to de Fontbrune on Wofsy's defense of repugnancy to public policy. App. 26a-27a.

Wofsy's petition challenges the Ninth Circuit's analysis of the fair use factors—because that analysis diverges from the holdings of other circuits. Wofsy's petition does not address the repugnancy determination because the Ninth Circuit explicitly declined to reach the question of whether a judgment imposing copyright liability based on use that would qualify as fair use is repugnant to public policy under the UFCMJRA. App. 19a-27a. Thus, the Ninth Circuit stated: "We leave for another day the question of whether a defendant's lack of opportunity to assert a clearly *meritorious* fair use defense would render a foreign judgment repugnant to the public policy of the United States or of California." App. 27a n.11. Right or wrong, the Ninth Circuit's analysis was based on its interpretation of the statutory fair use factors, not California's UFCMJRA.

Wofsy's petition focuses on whether Wofsy's use of images of the works of Picasso would qualify as fair use under federal copyright law. To make that determination, this Court will have to decide between the Ninth Circuit's interpretation of the fair use factors and the competing interpretations of other circuits. But the Court will *not* have to decide, as the Ninth Circuit purported to do, whether a "highly debatable" fair use defense would render a foreign judgment repugnant to public policy.

De Fontbrune attempts to divert attention from the Ninth Circuit's fair use analysis by focusing on state law issues that the Ninth Circuit did not decide and this Court need not decide. De Fontbrune argues that the real question at issue in the case "was whether the French Judgment is 'repugnant', and the decision below held that it was not, at least when the 'fair use' dispute was 'highly debatable' as it is here." Opp. 7. Repugnancy may be the ultimate question to resolve the public policy defense under the UFCMJRA, but this Court can resolve the circuit split regarding the fair use doctrine under federal law without deciding on repugnancy.

II. Resolution of the Issues Raised in the Petition Does Not Require Determination of Contested Issues Under the UFCMJRA

This Court need not rule on any aspect of the UFCMJRA, and, notably, Wofsy did not request that the Court address such issues in his petition.

Rather, despite de Fontbrune's conclusory assertions to the contrary, if the Court grants this petition, it can resolve the circuits' divergent interpretations of the fair use factors and then remand for the lower courts to apply that federal law to the repugnancy issue under the UFCMJRA.

That resolution of the federal fair use issues will not dictate the final disposition of the case does not weigh against granting Wofsy's petition. It is not uncommon for the Court to resolve circuit splits and then remand to the lower court to correctly apply the law, even when that application implicates state law.[1] When application of state law depends on an accompanying interpretation of federal law, the proper course is to decide the issue of federal law and then remand to a lower court (state or federal as the case may be) so the lower court can reassess its decision on the state law question in light of the Supreme Court's decision on the predicate federal issue. *See, e.g. Sandoz Inc. v. Amgen Inc.*, 137 S. Ct. 1664, 1676 (2017) (deciding federal questions and remanding to lower federal court to determine state law question where case involves state-law holding resting on interpretation of federal law); *Three Affiliated Tribes of Fort Berthold Reservation v. Wold*

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[1] For example, in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 594 (1994), the Court held that the lower court erred in its fair use findings and remanded the case for further proceedings consistent with the opinion.

Engineering, P. C., 467 U.S. 138, 152 (1984) (explaining that, where state court misinterpreted federal law, proper course is to "review[] the federal question on which the state-law determination appears to have been premised" and that "[i]f the state court has proceeded on an incorrect perception of federal law, it has been this Court's practice to vacate the judgment of the state court and remand the case so that the court may reconsider the state-law question free of misapprehensions about the scope of federal law").

Here, resolution of the circuit split regarding federal copyright law will guide the lower court's analysis of the fair use factors, which in turn will affect how the lower court ultimately applies California's UFCMJRA. If the lower court corrects its analysis of the fair use factors and determines that the French judgment was contrary to the fair use doctrine, the court can then determine whether that renders the French judgment repugnant to U.S. or California public policy. But, as discussed, this Court need not interpret or apply the UFCMJRA. Rather, the Court need only resolve the circuit split regarding the fair use factors. That resolution will satisfy the purpose of Wofsy's petition and clarify important questions under the fair use doctrine, providing guidance for Wofsy and others whose use of copyright protected materials should be protected.

III. Had the Ninth Circuit Interpreted the Fair Use Factors Correctly, There Would Be No Debate That Wofsy's Use Satisfies the Legal Standard

Finally, although de Fontbrune attempts to gloss over the substance of the Ninth Circuit's opinion, there can be no doubt that the Ninth Circuit's interpretation of the fair use factors at issue in the petition unquestionably diverges from the law in other circuits.[2] The Ninth Circuit did not simply misapply settled law; it misinterpreted the fair use doctrine under 17 U.S.C. § 107, and thereby created circuit splits on three of the four factors. If the Ninth Circuit had interpreted the fair use factors in line with other circuits, there would have been no "serious doubt," and it would not have been "highly debatable," that Wofsy's use of the photographs was fair use under U.S. law.

On the first fair use factor, regarding the commercial nature of the work, the Ninth Circuit reduced the inquiry to whether an allegedly infringing work is "offered for sale."[3] App. 21a. That

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[2] As noted in the petition, the Ninth Circuit also erred with respect to the fourth fair use factor (effect of the use on the market for the copyrighted work), but that error involved misapplication of settled law and therefore did not give rise to a circuit split. *See* Pet. 5 n.3.

[3] In his opposition, de Fontbrune claims that Wofsy conceded that *The Picasso Project* "is a commercial venture." Opp. 9. De

interpretation of the commerciality factor contravenes the law in the Second Circuit, which held that a book's nature as a work of "scholarship or research" weighs in favor of fair use even where the author and publisher anticipate profits. *Wright v. Warner Books, Inc.*, 953 F.2d 731, 736-37 (2d Cir. 1991). In contrast, the Ninth Circuit's interpretation, which de Fontbrune misleadingly suggests is consistent with settled law, automatically decides the commerciality inquiry against fair use, including for a scholarly or research work, simply because it is sold for money.

The Ninth Circuit interpreted the second fair use factor, the nature of the copyrighted work, to mean that mere copyrightability of the underlying work automatically prevents this factor from tipping in favor of fair use, without further inquiry regarding creativity. App. 24a. Because the photographs in the *Zervos Catalogue* were considered sufficiently creative for copyright protection under the law of France, the Ninth Circuit held they were relatively creative under the second fair use factor. De

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Fontbrune cites the Ninth Circuit's opinion to support this supposed concession, but the Ninth Circuit was simply referring to the fact that the books are offered for sale. App. 21a. Wofsy has never conceded that his reference books are "commercial" for purposes of the first fair use factor, and, as explained in the petition, the mere fact that a book is sold for money does not automatically make it "commercial"—at least not under the law of the Second Circuit. Pet. 12-14.

Fontbrune falsely claims that there is no real dispute that the photographs are creative works, and again, that the Ninth Circuit did not go against the law of other circuits. Opp. 9. But as explained in the petition, the Ninth Circuit's conflation of creativity sufficient for copyright protection (under French or U.S. law) and creativity for purposes of a fair use analysis conflicts with the law in the Fifth and Eleventh Circuits, both of which recognize that creativity sufficient for copyrightability does not establish creativity under the second fair use factor. *See Compaq Computer Corp. v. Ergonome Inc.*, 387 F.3d 403, 410 (5th Cir. 2004); *Cambridge Univ. Press v. Patton*, 769 F.3d 1232, 1268 n.25 (11th Cir. 2014).

Finally, the Ninth Circuit held that the third fair use factor, the amount and substantiality of the portion used in relation to the copyrighted work as a whole, weighed against fair use because Wofsy reproduced the photographs in their entirety. App. 25a. In his opposition, de Fontbrune similarly reduces the inquiry to whether the photographs were copied in their entirety. Opp. 9. However, the salient issue, where the Ninth Circuit diverged from other circuits, is not whether Wofsy reproduced entire photographs, but rather whether doing so should weigh against fair use when copying anything less than the entirety of each photograph would defeat the purpose of the use. The petition explains that the decision of the Ninth Circuit on this issue conflicts with the law in the First, Second, Seventh, and Eleventh Circuits. Pet. 19-22.

If interpreted consistently with the law in other circuits, these three fair use factors would support a finding of fair use in this case. At a minimum, this Court should clarify the proper interpretation of the three fair use factors at issue and direct the lower court to apply the fair use factors correctly as a prerequisite to determining whether the French judgment is repugnant to public policy under the UFCMJRA. Failure to resolve the circuit splits would perpetuate uncertainty and variability in the law, which in turn would encourage forum shopping and chill protected expression.

CONCLUSION

This Court should grant the petition for a writ of certiorari.

Respectfully submitted,

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