

No. 21-869

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**In The  
Supreme Court of the United States**

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ANDY WARHOL FOUNDATION FOR THE VISUAL  
ARTS, INC.,

*Petitioner,*

v.

LYNN GOLDSMITH, ET AL.,

*Respondents.*

*On Writ of Certiorari to the  
United States Court of Appeals for the First Circuit*

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**BRIEF OF SCREEN ACTORS GUILD-AMERICAN  
FEDERATION OF TELEVISION AND RADIO ARTISTS  
AS AMICUS CURIAE IN SUPPORT OF  
RESPONDENTS**

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## INTEREST OF THE *AMICUS CURIAE*<sup>1</sup>

*Amicus* Screen Actors Guild-American Federation of Television and Radio Artists (“SAG-AFTRA”) is the nation’s largest labor union representing working media artists. SAG-AFTRA represents more than 160,000 actors, announcers, broadcasters, journalists, dancers, DJs, news writers, news editors, program hosts, puppeteers, recording artists, singers, stunt performers, voiceover artists and other media professionals. SAG-AFTRA exists to secure strong protections for media artists.

The professionals represented by SAG-AFTRA are the faces and voices that entertain and inform America and the world. As the union that represents, among others, actors, radio artists, musical artists and other entertainment professionals, SAG-AFTRA has long fought for strong intellectual property rights, ranging from strong copyright to robust rights of publicity, including through legislative efforts and *amicus* briefs in other cases. SAG-AFTRA’s interest, and that of its members, lies at the very intersection of these two areas that are complementary in this case.

The artists SAG-AFTRA represents will be affected by the outcome of this case. They invest their

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<sup>1</sup> Pursuant to Rule 37.6, *Amicus* state that no counsel for a party authored this brief in whole or in part. No counsel or party made a monetary contribution to fund this brief’s preparation or submission and no person other than *amicus curiae* made a monetary contribution to it. The parties have provided written consent to the filing of *amicus* briefs, including this *amicus* brief.

entire lives in building their professional careers. While most may never be “famous,” their names, voices, images or likenesses – their very persona – have or will attain commercial value. These individuals and their beneficiaries rely on laws, such as right-of-publicity laws, to protect and prevent misappropriation of one of their greatest assets. Misuse of these assets can detrimentally impact a public figure’s career and reputation and, consequently, the economic value in their persona.

Their interest in this case arises primarily from the impact the outcome here eventually will have in how rights of publicity cases are decided. For over two decades, courts around the country have relied on a “transformative use” test derived from this Court’s fair use jurisprudence to balance a plaintiff’s intellectual property rights in their persona against a defendant’s free expression right. Given the test’s origins, courts are likely to look to the outcome of this case in applying the transformative use test in future rights of publicity cases. In that regard, SAG-AFTRA’s members, and countless other professionals who rely upon the right of publicity to protect their personas from unauthorized exploitation, potentially will be affected by the outcome of this case.

Accordingly, *Amicus* SAG-AFTRA has an interest in this litigation.

## SUMMARY OF ARGUMENT

Transformative works, generally, are an important form of expression; they must be created consistent with the four-factor fair use test in Section 107 lest they supplant the original creator's rights. However, Petitioner proposes a "meaning-or-message" test it distills from the Court's holding in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994) that lacks substantive support in either the text or legislative history of 17 U.S.C. § 107 ("Section 107"), or the common law from which it was derived.

Respondents, and neutral *amici* such as the Copyright Alliance, the Motion Picture Association, and the Authors Guild, have cogently explained the potential implications of Petitioner's proposed test, particularly on the statutory derivative works right. They further explore why the test would be unworkable. Additionally, Respondents have provided a brief history of the applicable common law. SAG-AFTRA, therefore, will not unnecessarily repeat this content and will focus primarily on the legislative history of Section 107 and the studies and reports included therein.

It is clear from both the plain language and the legislative history that Congress intended a relatively narrow, but evolving, test that would be analyzed on a case-by-case basis, with no single factor being determinative. A review of the theory incorporated into *Campbell* and the plain language of *Google* further supports this assessment. Critically, nothing in the history of Section 107 supports Petitioner's "meaning-or-message" test.

Petitioner’s formulation is particularly concerning in light of the role “transformative use” has played in right of publicity jurisprudence. This important state law property right in one’s persona has been recognized for well over a century. At times, however, it conflicts with the rights of creators, including photographers and appropriation artists.

Acknowledging the similarities in the goals of copyright and the right of publicity, as this Court did decades earlier, the California Supreme Court borrowed from *Campbell* to balance this inherent economic and property right in one’s persona with the speech rights of creators. *See Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387 (2001). In the two decades since the transformative use test was first incorporated into right-of-publicity jurisprudence, it has been adopted by courts across the country. For these reasons, the outcome of this case has potential for broader impact, potentially harming this important state law right.

*Amicus* therefore urges this Court to affirm the lower court’s opinion.

## **ARGUMENT**

### **I. Petitioner’s “Meaning-Or-Message” Test Has No Substantive Support in The Law or the Legislative History of Section 107**

Petitioner argues that this Court’s holdings in *Campbell* and *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183 (2021), require application of a “meaning-or-message” test under the first fair use factor. Its

formulation of this test would render the other fair use factors all but meaningless when a work is transformative. Petitioner traces the English law of the 18<sup>th</sup> and early 19<sup>th</sup> centuries to explain why this test, judicially created in 1994, is faithful to the text of a 1976 U.S. law that requires courts to review “the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes,” without reference to “meaning or message.” 17. U.S.C. § 107.

*Campbell* did not establish such a specific test, nor did *Google*. Moreover, the legislative history of the Copyright Act of 1976 (“1976 Act”) does not require it. In particular, in the mid-1950s, leading up to passage of the 1976 Act, the Copyright Office commissioned a series of thirty-four (34) studies relating to copyright law. *Mills Music, Inc. v. Snyder*, 469 U.S. 153 (1985). These studies became part of the legislative history, together with reports issued by the Copyright Office and the House and Senate Judiciary Committees. *Id.*

**A. The Legislative History of Fair Use Confirms that Congress Intended It to Remain a Case-by-Case Analysis Consistent with Section 107’s Preamble**

Copyright law has always granted a work’s author “the exclusive right to make any new version” of a work, granting the author exclusive rights “sufficiently broad to include a change in the medium of expression of copyrighted material.” Alan Latman, *Fair Use of Copyright Works*, (1958), *reprinted as Study No. 14 in Copyright Law Revision Studies Nos. 14-16*, prepared for the Senate Committee on the

Judiciary, 86th Cong., 2d Sess. (“Latman, *Fair Use*”), at 8 (1960). It “is well within the bounds of reasonableness for the copyright owner to consider important a use which competes with his own work,” as it undermines copyright’s “quasi-monopolistic protection.” *Id.* at 15. Nonetheless, the concept of “fair use” was recognized in the common law long before its codification in the Copyright Act of 1976.

The Copyright Office’s study on fair use, completed in 1958, noted that there had never been a statutory fair use provision under U.S. law. Latman, *Fair Use* at 5. Quite the contrary, the “language of the statute, has always been positive in granting exclusive rights, apparently admitting of no exceptions,” leaving courts to grapple with the issue without statutory language as its guide. *Id.* The courts developed the “fair use” doctrine over many decades, establishing an implied exception. Report of the Register of Copyrights on the General Revision of the Copyright Law, 87th Cong., 1st Sess. (“1961 Report”), 1, at p. 24 (Comm. Print 1961). Therefore, in crafting 17 U.S.C. § 107, “Congress meant § 107 ‘to restate the present judicial doctrine of fair use, not to change, narrow, or enlarge it in any way’ and intended that courts continue the common-law tradition of fair use adjudication.” H.R. Rep. No. 94-1476 (“House Report”), at 66 (1976).

The Register noted that “fair use” is difficult to define. 1961 Report at 24. In general terms, it means that “a reasonable portion of a copyrighted work may be reproduced without permission when necessary for a legitimate purpose which is not competitive with the copyright owner’s market for his work.” *Id.* Until

recently, the fourth factor — focusing on the impact on the market—was not as quickly dismissed as Petitioner argues it should be. Quite the opposite, as the 1961 Report notes that “the competitive character of the use...is often the most decisive.” *Id.* at 25.

Latman explored prior case law, examining situations in which the courts previously had found fair use. Notably, uses such as Petitioner’s do not appear within the study. The uses examined include: incidental use, such as excerpts of song lyrics used within a literary work or material incidentally appearing in a newscast; excerpts used in review and criticism; parody and burlesque, which necessarily include an element of criticism and/or humor; scholarly works and compilations; personal or private use; news; use in litigation; and nonprofit or governmental purposes. Latman, *Fair Use* at 8-13. These categories of use are consistent with the list of illustrative uses in the 1961 Report which the House Judiciary Committee described as a non-exhaustive list of the “sort of activities the courts might regard as fair use under the circumstances.” House Report at 65. Like Latman’s study, neither of these reports mention the type of art at issue here.

Of note, many early fair use cases dealt with fact-based or textual works and, prior to the mid-1960s, most dealt with questions more akin to infringing versus non-infringing uses, rather than productive or transformative use. *See generally*, Laura G. Lape, *Transforming Fair Use: The Productive Use Factor in Fair Use Doctrine*, 58 Alb. L. Rev. 677 (1995) (examining the history of fair use relating to a “productive use” test). In fact, many of

these cases dealt with taking “themes” or “ideas” or insubstantial copying. *Id.* at 689. At that time, the focus tended to be on “whether the use would substitute for the original.” *Id.* at 690. Moving into the 1960s, courts often looked to the public interest, particularly in the dissemination of information. *Id.* at 695-96.

Latman pointed to the “Mutt and Jeff” case, noting that “the copyright owner is protected not only against uses having an unfavorable competitive effect, but also a use with a competitive purpose or potential.” Latman, *Fair Use* at 15. The case, *Hill v. Whalen & Martell, Inc.*, 220 F. 359 (S.D.N.Y. 1914), involved a dramatic production in which two characters were almost identically named to the famous cartoon characters whose dialogue included direct quotations and catchphrases. The court found it “to be ordinarily decisive... whether or not so much as has been reproduced as will materially reduce the demand for the original,” which would necessarily harm the copyright owner. *Id.*, 220 F. at 360. The approach urged by Petitioner would ignore this concept, embodied in the statute, to assess the impact its works had and would have on the market for —and value of — Goldsmith’s photographs.

The 1961 Report distilled four factors courts generally used to determine fair use. 1961 Report at 24. These four factors were later incorporated into Section 107, almost verbatim. *See* 17 U.S.C. § 107. One notable alteration between the earlier reports and the final language of Section 107 was the inclusion of the commercial or non-profit character of an activity, which the Committee indicated “should be

weighed along with other factors in fair use decisions.” House Report at 66. As with the market harm factor, Petitioner’s approach would ignore this express statutory command.

**B. *Campbell* Does Not Mandate a “Meaning-or-Message” Test**

Petitioner looks to *Campbell*, arguing that its purported “meaning-or-message” test is determinative in transformative use cases. Brief for Petitioner (“Pet. Br.”) at 35, *Andy Warhol Foundation for the Visual Arts, Inc. v. Lynn Goldsmith, et al.*, No. 21-869. This test, according to Petitioner, turns on whether the allegedly infringing work “‘c[ould] reasonably be perceived’ to convey a meaning or message distinct from the... original.” *Id.* Specifically, Petitioner describes the test thusly: 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.’” *Id.* at 36 (cleaned up).

While that test, in the broader context of the four fair use factors, seems laudable, it is Petitioner’s next statement that underlies its true intent. Petitioner states that the test “trains the inquiry on what a... work means, not on how much of the original material is discernible.” *Id.* at 37. Petitioner’s brief, and the test it proposes, ignores the fact that the Second Circuit’s opinion rested on a weighing of all four fair use factors as *Campbell* commands. *Campbell*, 510 U.S. at 578 (requiring that all four factors “be explored, and the results weighed together,

in light of the purposes of copyright”). The Second Circuit did this and reached the conclusion that *all four factors* favored Goldsmith. *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 51 (U.S. 2d Cir. 2021).

### **1. The Genesis of the *Campbell* Transformative Use Test Does Not Support Petitioner’s Formulation**

The *Campbell* Court established its transformative use test with reference to prior judicial decisions and the copyright reform studies discussed above. It noted the admonition in the House Report that Section 107 did not “change, narrow, or enlarge” fair use, that the analysis must not “be simplified with bright-line rules” because the statute requires it be done case-by-case.” *Campbell*, 510 U.S. at 577. In doing so, the courts “may be guided by the examples given in the preamble to § 107, looking to whether the use is for criticism, or comment, or news reporting. *Campbell*, 510 U.S. at 578.

The test formulated in *Campbell* derives largely from a Harvard Law Review commentary by Judge Leval, who proposed transformativeness as a way to assess the first factor of the fair use inquiry. Pierre N. Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105 (1990). Judge Leval posited that the underlying work must be used “in a different manner or for a different purpose from the original” and must not “supersede the objects’ of the original.” *Id.* at 1111. According to Leval, the inquiry should include whether “the secondary use *adds value to the*

*original* -- if the quoted matter is used as raw material.” *Id.*

Notably, in discussing the boundaries of transformative use, Judge Leval cautioned:

“The existence of any identifiable transformative objective does not, however, guarantee success in claiming fair use... The creator of a derivative work based on [another’s] may claim absolute entitlement because of the transformation. Nonetheless, extensive takings may impinge on creative incentives. And the secondary user’s claim under the first factor is weakened to the extent that her takings exceed the asserted justification.” *Id.* at 1111-12.

In fact, Judge Leval rejected a test as conclusory as the one Petitioner advocates. He eschewed a test based solely on “the overall character of the challenged work,” as it “tells little about whether” the individual components “have a fair use purpose or merely supersede.” *Id.* at 1112. The first factor, according to Judge Leval, requires “careful evaluation whether” each component used “is of the transformative type that advances knowledge and the progress of the arts or whether it merely repackages, free riding on another’s creations.” *Id.* at 1116. Further, the “transformative justification must overcome factors favoring the copyright owner.” *Id.* at

1111. If the use is excessive and other factors favor the copyright owner, the use is not fair. *Id.* at 1112.

Such is the case here, as the Second Circuit determined.

**2. *Campbell* Involved a Parody and Does Not Have the Breadth Petitioner Ascribes to It.**

The *Campbell* transformative use formulation arose out of a parodic song that “substitut[e]d predictable lyrics with shocking ones to show how bland and banal the [original] song is.” *Campbell*, 510 U.S. at 573. While it has since been applied to other contexts, including by this Court, that history provides important context to the right.

As noted by at least some commentators, the test’s “radical potential has been greatly exaggerated,” particularly in its emphasis on necessity. Mark Bartholomew and John Tehranian, *An Intersystemic View of Intellectual Property and Free Speech*, 81 *Geo. Wash. L. Rev.* 1, 14 (2013). The authors note that the *Campbell* Court took time to point out, in dicta, the distinctions between parody and satire—where the former borrows from the work to comment on it, the latter is commenting more broadly. *Id.* at 15-16 (citing *Campbell*, 510 U.S. at 580-81). As they note, the *Campbell* Court actually went much farther, in its comparison between parody and satire. *Id.* Specifically, the *Campbell* Court stated that when “the commentary has no critical bearing on the substance or style of the original” and it is used “to get attention or to avoid the drudgery in working up

something fresh, the claim to fairness in borrowing from another's work diminishes accordingly (if it does not vanish)."

By its own admission, this description of satire fits how Petitioner described Warhol's works. "Warhol's works reflect distinctive changes that communicate a comment on the dehumanizing nature of celebrity" and Warhol "sought to use the ... depiction of Prince's disembodied head to communicate a message about the impact of celebrity and . . . the contemporary conditions of life." Pet. Br. at 20. Put simply, Warhol was commenting on the nature of celebrity, perhaps on Prince, which is satirical; he was not commenting on Goldsmith's photograph of Prince as would be required for it to qualify as parody.

Bartholomew and Tehranian posit that the parody-satire discussion in *Campbell* indicates the Court's intent was that merely adding something to "the world of expression" would be insufficient for a finding of fair use. Bartholomew and Tehranian, 81 Geo. Wash. L. Rev. at 15. Instead, the underlying "work must be necessary to the defendant's expressive point." *Id.* This interpretation of the *Campbell* Court's reasoning contrasts with Petitioner's proposed meaning-or-message test.

In a footnote, the *Campbell* Court reemphasizes the underlying parodic nature of the work and further reinforces the importance of balancing the factors, particularly the first and the fourth. The court states that if a parody's "wide dissemination" risks becoming a substitute for the original or licensed derivatives...

it is more incumbent on one claiming fair use to establish the extent of transformation and the parody's *critical relationship to the original*." *Campbell*, 510 U.S. at 580, fn 14 (emphasis added). It goes on to add that "when there is little or no risk of market substitution... taking parodic aim at an original is a less critical factor in the analysis" allowing that "looser forms of parody" and satire require less justification for borrowing from the original than typically required. *Id.*

Taking the Petitioner's explanation of Warhol's intent at face value, the unlicensed use of the specific underlying work was not necessary to the expressive point he was trying to make with his art. Further, Warhol's work did serve as a potential market substitute, as evidenced by the very facts underlying this case.

**C. *Google* Was a Complex and Unique Case That Does Not Support Petitioner's Proposed Test**

*Google* involved application of the fair use doctrine to computer code which, as this Court noted, serves a functional rather than purely expressive role. *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1198 (2021). The code at issue in the case was "declaring code" that performed a functional role, as "part of an interface between human beings and a machine." *Id.* at 1192. Unlike the photograph underlying the artwork at issue here, the code "if copyrightable at all" was "further than are most computer programs... from the core of copyright," raising questions as to its relevance to this case. *Id.* at 1202. Nonetheless, as

Petitioner relies on it, it is worth addressing why that reliance is wrongly placed.

Petitioner draws attention to the *Google* Court’s passing reference of an “artistic painting” that “precisely replicates a copyrighted advertising logo to make a comment about consumerism” in a series of examples. Pet. Br. 35-36 (cleaned up). Petitioner’s inclusion of this example—an attempt to distract the Court with a likely reference to a Warhol work—ignores its origin. The Court drew this example from a treatise that, in turn, drew it from a law review article. *Google*, 141 S. Ct. at 1203. In that article, the author discussed two possible, and conflicting, interpretations of the transformative use test formulated in *Campbell*. Neil Weinstock Netanel, *Making Sense of Fair Use*, 15 Lewis & Clark L. Rev. 715, 746 (2011). Netanel laments that, far from the strict “meaning-or-message” test proposed by Petitioner, the “*Campbell* definition leaves unclear whether either, both, or some combination of transforming content and transforming message are required to constitute a transformative use.” *Id.*

It is worth noting that the dissent in *Google* described the “purpose and character of the use” as only the “second-most” important factor for purposes of the fair use inquiry, the first being the harm to the value or potential market. *Google*, 141 S. Ct. at 1216-18 (Thomas, J. dissenting). As Justice Thomas notes: “[t]o be transformative, a work must do something *fundamentally different* from the original. A work that simply serves the same purpose in a new context...is derivative, not transformative.” *Id.* at 1219. Such is the case here.

Petitioner argues for a transformative use test that would eviscerate the other factors as well as the derivative works right under 17 U.S.C. §106(2), at a time when the pendulum has begun swinging back toward a more reasoned analytical process. *See, e.g., Kienitz v. Sconnie Nation LLC*, 766 F.3d 756 (7th Cir. 2014) (expressing concern that the transformative use test as enumerated by the Second Circuit in *Cariou v. Prince*, 714 F.3d 694 (2d Cir. 2013) both ignores the other factors and risks the derivative work right). Other *amici* have provided more detailed analysis on this point that need not be repeated.

In the nearly three decades since its formulation, the *Campbell* transformative use test has been applied in varying ways among the lower federal courts. Matthew D. Bunker and Emily Erickson, *Transformative Variations: The Uses and Abuses of The Transformative Use Doctrine in Right of Publicity Law*, 14 Wash. J.L. Tech. & Arts 138, 143 (2019). This has created an assortment of differing conceptions of transformative use, some of which contradicted each other. While transformative works, generally, are an important form of expression that further the goals of copyright, they must be created consistent with the four-factor fair use test in Section 107 which balance the value they add with the rights of the original work's creator.

As courts wrestled with how to apply the transformative use test in the context of copyright, others began importing variations of the test into other areas of law, including right of publicity. *Id.* at 144. It is this nexus that is of particular concern to SAG-AFTRA. While the transformative use test has

itself been transformed to fit the right of publicity context, the outcome of this case has the potential to impact how courts interpret it in cases involving state rights of publicity.

## **II. The Test Formulated by this Court in *Campbell* Has Been Imported into Right of Publicity Jurisprudence to Balance an Individual's Intellectual Property Rights with the First Amendment**

The right of publicity is the inherent right of every human being to control the commercial use of his or her identity. J. Thomas McCarthy, *The Rights of Publicity & Privacy*, § 1:3 (2015). It “recognizes legal injury because...unpermitted use causes loss of the financial rewards flowing from the economic value of a human identity.” *Id.* at § 2:2 (2d ed. 2021). Although derived originally from privacy laws, the right of publicity is now clearly recognized as a property right. *See, e.g., Hart v. Elec. Arts, Inc.*, 717 F. 3d 141 (3rd Cir 2013) (holding that a goal of the right of publicity is to protect the property interest in an individual's identity). Many courts, including this Court, have analogized it to other intellectual property rights, including copyright and patent. *See, e.g., Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977).

Two decades ago, the California Supreme Court was faced with the need to balance the intellectual property right in one's persona with the free expression rights of content creators. *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387 (2001). Recognizing the similar goals between

copyright and the right of publicity in protecting the fruits of intellectual and artistic labor, the court looked to Section 107. *Id.* at 404. The *Comedy III* transformative use test has since been adopted by courts across the country.

#### **A. The Right of Publicity Is a Century Old Property Right in One's Persona**

In 1953, the Second Circuit first coined the term, “right of publicity.” *Haelan Laboratories, Inc. v. Topps Chewing Gum*, 202 F.2d 866, 868 (2nd Cir. 1953). While many trace the right’s origin to *Haelan*, there is over a century of precedent recognizing it, often framed as an intellectual property right comparable to copyright. At least as early as 1894, a Massachusetts federal court declared “that a private individual has a right to be protected in the representation of his portrait in any form; that this is a property as well as a personal right.” *Corlis v. E. W. Walker Co*, 64 F. 280 (1894) (holding that the protection exists but finding no violation in the publication of a photograph in connection with a biography). The *Corlis* court analogized it to copyright, stating “that it belongs to the same class of rights which forbids the reproduction of a private manuscript or painting.” *Id.*

In a 1902 dissenting opinion, a New York court described the right in intellectual property terms, articulating that the “plaintiff has the same property in the right to be protected against the use of her face for defendants’ commercial purposes as she would have if they were publishing her literary

compositions.” *Roberson v Rochester Folding Box Co*, 64 N.E. 442, 450 (N.Y. 1902) (Gray, J. dissenting).<sup>2</sup>

### **B. The Supreme Court Recognized a Property Right in One’s Persona Nearly Half a Century Ago**

The Supreme Court confirmed the right of publicity as an individual’s proprietary right in his persona nearly a half century ago. In *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977), the Court expressed that the right of publicity “protect[s] the proprietary interest of the individual” and is “closely analogous to the goals of patent and copyright law, focusing on the right of the individual to reap the reward of his endeavors and having little to do with protecting feelings or reputation.” *Zacchini*, 433 U.S. at 573. The rationale given by the Court for protecting the right of publicity “is the straightforward one of preventing unjust enrichment by the theft of goodwill” as no “social purpose is served by having a defendant get free some aspect of the plaintiff that would have market value for which he

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<sup>2</sup> In *Roberson*, which pre-dated the passage of New York’s right of privacy statute, the Appellate Division of the Supreme Court of New York determined that the use of a woman’s picture on ads for flour manufactured and sold by the defendant was not a cognizable claim under the common law. *Roberson*, 64 N.E. 442, 447. However, as noted in *Canessa*, “[t]he dissenting opinion by Judge Gray... has received almost universal support” in its acknowledgement that “in the concept of ‘right of privacy’ there is implicit the right of property, at least in the instance of an appropriation by a defendant of another’s likeness.” *Canessa v. J. I. Kislak, Inc.*, 235 A.2d 62, 68-69 (1967).

would normally pay.” *Id.* at 576 (quoting Kalven, *Privacy in Tort Law – Were Warren and Brandeis Wrong?*, 31 *Law & Contemp. Prob.* 326, 331 (1966)).

Following *Zacchini*, courts have continued to identify rights of publicity as a form of individual proprietary rights. The Ninth Circuit noted that “[t]he cousinage between copyright liability and the right to publicity has long been recognized.” *Hilton v. Hallmark Cards*, 580 F.3d 874, 889 fn.12, (9th Cir. 2009), amended, 599 F.3d 894 (9th Cir. 2010). The Tenth Circuit has noted that the right of publicity is an “intellectual property right” and that, “[l]ike trademark and copyright, the right of publicity involves a cognizable property interest.” *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 967 (10th Cir. 1996) (holding that where trading cards parodied baseball players, balance between the right of publicity and First Amendment tipped in favor of the card manufacturers). Additionally, in *Allison v. Vintage Sports Plaques*, 136 F.3d 1443 (11th Cir. 1998), the Eleventh Circuit recognized the intellectual property nature of the right of publicity in applying the “‘first-sale doctrine,’ a well-established limitation on intellectual property rights,” to a right-of-publicity claim. In *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 928 (6th Cir. 2003), the Sixth Circuit held that “[t]he right of publicity is an intellectual property right of recent origin which has been defined as the inherent right of every human being to control the commercial use of his or her identity.”

A century of precedent makes clear that *Zacchini* is not an anomaly. As illustrated *supra*, federal and state courts around the country had

previously used similar analogies in equating the right of publicity to copyright law. And in the years since, it has become widely accepted that the right of publicity is an intellectual property right.

**C. The California Supreme Court Borrowed from *Campbell* to Create a “Transformative Use” Test to Balance Competing Interests in Right-of-Publicity Cases.**

In a case involving artistic sketches, the California Supreme Court found itself faced with how to balance the individual property rights in one’s persona under state law, with the expressive rights afforded under the First Amendment. *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387 (2001). Faced with the need to develop a workable test, the court noted that commentators had proposed importing copyright’s fair use test, although the concept was not without its critics. *Id.* at 403-04. The court acknowledged that “a wholesale importation of the fair use doctrine” would not work in the right of publicity context, in part because at least two factors lacked direct relevance.<sup>3</sup> *Id.*

Ultimately, the court concluded that the first fair use factor “the purpose and character of the use ... seem[ed] particularly pertinent to the task of reconciling the rights of free expression and publicity.”

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<sup>3</sup> In particular, the court noted that “the nature of the copyrighted work” and “the amount and substantiality of the portion used” seemed tailored to works of authorship and would not aid in evaluating uses of an individual’s likeness. *Comedy III*, 25 Cal. 4th at 404.

*Id.* at 404 (citing 17 U.S.C. §107(1)). In formulating and applying this test, the court’s aim was not to arm “the right of publicity holder [with] a right of censorship, but a right to prevent others from misappropriating the economic value generated by the celebrity’s fame...” *Id.* at 403. This concept is not far-removed from the goals of Section 107 in balancing the conflicting goals of encouraging new works while “protecting the creative fruits of intellectual and artistic labor.” *Id.* at 405.

Relying heavily on *Campbell*, the *Comedy III* Court thereby formulated a test that balances the equities between the artist and the individual depicted, granting the artist protection when the art does conflict with the economic value in the individual’s persona. *Id.* at 391 (“We formulate instead what is essentially a balancing test between the First Amendment and the right of publicity...”). The court recognized that “when a work contains significant transformative elements... it is also less likely to interfere with the economic interest protected by the right of publicity.” *Id.* at 405.

Two years after creating it, the California Supreme Court revisited the transformative use test. *Winter v. DC Comics*, 30 Cal. 4th 881, 888 (2003). In doing so, it reiterated that it intended the test to grant First Amendment protection to “alternative versions of celebrity images that are iconoclastic, irreverent, or otherwise attempt to redefine the [person’s] meaning,” not literal depictions of the type for which the individual would normally be compensated. *Id.* (citing *Comedy III*, 25 Cal. 4th at 405).

The *Winter* court underscored that the rationale for the test – that “[t]he right of publicity derived from public prominence does not confer a shield to ward off *caricature, parody and satire*. Rather, prominence invites *creative comment*.” *Id.* at 887 (citing *Comedy III*, 25 Cal. 4th at 397) (emphasis added). In this context, the right-of-publicity transformative use test already goes farther than that applied in copyright, often providing a complete or near complete defense to infringement without the need to balance other impacts. *See generally*, Bartholomew and Tehranian, 81 Geo. Wash. L. Rev. 1 (comparing the doctrinal evolutions of how copyright, rights of publicity and trademark balance the property rights and the First Amendment).

Of relevance to this case, and indicative of the difference in how the transformative use test has been applied in cases involving the right of publicity, the court referenced Warhol’s celebrity silkscreens, such as the ones at issue here. *Comedy III*, 25 Cal. 4th at 406-09. The court made clear that while the creation of “literal, conventional depictions of The Three Stooges,” created for commercial sale must give way to the right of publicity, works such as Warhol’s silkscreens *might* be protected “[a]lthough the distinction between protected and unprotected expression will sometimes be subtle.” *Id.* at 408-409.

The *Comedy III* court acknowledged that Warhol’s works were “a form of ironic social comment on the dehumanization of celebrity itself.” *Id.* In other words, the commentary is on issues *other than* the work, or even the individual depicted. While this might be an adequate justification when faced with

assessing the use of a celebrity's persona, the same does not hold true in the context of copyright.

In the two decades since its creation, the transformative use test has been applied by state and federal courts around the country. The most notable examples have been in cases involving video games, particularly in the Ninth and Third Circuit. *See, e.g., Hart*, 717 F.3d 141 (adopting California's transformative use test and finding that the games realistic depiction of the athletes in realistic settings did not satisfy it); *Keller v. Electronic Arts Inc.*, 724 F.3d 1268 (9th Cir. 2013) (holding that a video game that "realistically portrays college football players in the context of college football games" was not transformative as a matter of law). In a case involving artwork depicting golfer Tiger Woods, the Sixth Circuit, too, adopted the test. *ETW Corp. v. Jireh Publ., Inc.*, 332 F.3d 915 (6th Cir 2003) (holding that the artwork at issue was more than a "literal depiction" of Woods and "less likely to interfere with the economic interest protected by Woods' right of publicity).

These cases illustrate the importance of the transformative use test in the context of rights of publicity. They also illustrate the broader potential impact this case can have, even outside the context of copyright.

## CONCLUSION

As illustrated herein, Petitioner's distillation of the transformative use test into a "meaning-or-message" test is not supported by the plain language

or legislative history of Section 107. While those certainly may be factors to consider in assessing the nature and purpose of the purpose and character of a defendant's use, they are not the sole factors, nor should they be determinative.

Critically, what this Court holds in connection with transformative uses in copyright has potential to impact state-law rights of publicity. The right of publicity is an important individual property right and *amicus* respectfully urges caution in ensuring the outcome here does not upend it.

For the foregoing reasons, *amicus* respectfully urges the Court to AFFIRM the lower court's holding.

Respectfully submitted,

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