

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

**BRIEF OF *AMICI CURIAE* INSTITUTE FOR
INTELLECTUAL PROPERTY AND SOCIAL
JUSTICE AND INTELLECTUAL-PROPERTY
PROFESSORS IN SUPPORT OF
RESPONDENTS**

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INTEREST OF *AMICI CURIAE*¹

The Institute for Intellectual Property and Social Justice promotes social justice in the field of intellectual-property law and practice, both domestically and globally. Through core principles of access, inclusion, and empowerment, intellectual property social justice advances the social policy objectives that underlie intellectual-property protection: the broadest stimulation of creative and innovative endeavor and the widest dissemination of creative works and innovative accomplishments for the greater social good.

Amici also include intellectual-property law professors, a full list of whom is attached as Appendix 1.

INTRODUCTION AND SUMMARY OF ARGUMENT

Using a black-and-white studio photograph of Prince created by Lynn Goldsmith, Andy Warhol removed depth, added bright colors, and enhanced Goldsmith's lighting choices to create 16 silkscreens and sketches of Prince (the "Prince Series"). When Prince died in 2016, the Andy Warhol Foundation (Petitioner) licensed one of the silkscreen images to a magazine without permission from or payment and credit to Goldsmith. Petitioner now claims that Warhol intended to comment on "the dehumanizing nature of celebrity," contrary to the vulnerability

¹ The parties have consented to the filing of this *amicus* brief. No counsel for a party authored the brief in whole or in part. No party, counsel for a party, or any person other than *amici curiae* and their counsel made a monetary contribution intended to fund the preparation or submission of the brief.

Goldsmith intended to portray, Pet. Br. 44, and that under this Court’s fair-use jurisprudence—specifically under the first fair-use factor’s focus on the “meaning[] or message” of the secondary work—the Prince Series constitutes a transformative fair use that does not infringe Goldsmith’s copyright. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

Petitioner’s position violates principles of statutory interpretation by effectively conflating transformativeness with the separately enumerated, exclusive right of the copyright holder to authorize derivative works. 17 U.S.C. § 106(2). It allows subjective interpretations of artists’ intended messages to guide what should be an objective legal analysis. And it ignores the statutory distinction between noncopyrightable ideas and copyrightable expressions by linking the breadth of copyright protection to purported ideas behind artistic works rather than their concrete expressions. 107 U.S.C. § 102(b). Petitioner’s approach would also exacerbate the historical track record of the unjust and exclusionary impact that copyright fair use has had on the ability of marginalized and/or economically disadvantaged creators to create and reap the economic benefits of their creations.

We propose a different approach: When assessing transformativeness in the aesthetic-to-aesthetic context, this Court should ask whether a reasonable, objective observer would find that the secondary work subordinates, subverts, or extinguishes the message of the original work. Not only does this more precise standard alleviate the statutory tensions noted above, it also advances social justice within the copyright

regime, which in turn advances the economic and social utility goals of intellectual-property law. Copyright law, particularly fair use, has historically been applied—intentionally or not—to the advantage of dominant groups and at the expense of socially and/or economically disadvantaged groups, which effectively shrinks the pool of diverse creators contributing to the public discourse. This Court should refine the transformativeness inquiry in order to both confirm fair use as an exception to unauthorized exploitation of Section 106 rights, not the rule, and mitigate the exploitation of marginalized creators by providing a clearer, objective standard less susceptible to manipulation by dominant putative infringers.

Finally, our proposal comports with, perhaps even explains, the patchwork of fair-use decisions made by lower courts. Indeed, its consistency with existing law extends beyond the copyright domain, by embodying many of the principles that animate broader intellectual-property jurisprudence.

For these reasons, this Court should require that secondary aesthetic works subordinate, subvert, or extinguish the message of original aesthetic works before being deemed transformative. The Prince Series does not meet this test, so the first fair-use factor, upon which Petitioner relies, weighs against finding fair use here. The Court should affirm the Second Circuit's judgment.

ARGUMENT

I. Rules Of Statutory Interpretation Require That The Fair-Use Exception Not Be Construed So Broadly As To Swallow The Exclusive Right Of Copyright Owners To Derivative Works.

“In a copyright case, as in any other case, the language of the statute provides the starting point.” *Stewart v. Abend*, 495 U.S. 207, 239 (1990) (Stevens, J., dissenting). The Copyright Act enumerates a bundle of exclusive rights conferred on copyright owners as well as several limitations, including the fair-use exception underlying this case. 17 U.S.C. §§ 101-122. As always, these rights and limitations must be interpreted in tandem. *Corley v. United States*, 556 U.S. 303, 314 (2009) (“A statute should be construed so that effect is given to all its provisions, so that no part will be inoperative or superfluous, void or insignificant.” (alteration and quotation marks omitted)); *City of Chicago v. Fulton*, 141 S. Ct. 585, 591 (2021) (this canon “is strongest when an interpretation would render superfluous [or insignificant] another part of the same statutory scheme” (quotation marks omitted)).

One of the exclusive rights conferred on copyright owners is the right to prepare and authorize derivative works. 17 U.S.C. § 106(2). A “derivative work” is “a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgement, condensation, or any other form in which a work may be recast, transformed, or adapted.” *Id.* § 101. In codifying the

derivative-work right, Congress recognized that “the licensing of derivatives is an important economic incentive to the creation of originals.” *Campbell*, 510 U.S. at 593; see *Authors Guild v. Google, Inc.*, 804 F.3d 202, 225 (2d Cir. 2015) (“An author’s right to control and profit from the dissemination of her work ought not to be evaded by conversion of the work into a different form.”). This derivative-work right gives way, however, when the use of a preexisting work satisfies the fair-use exception.

Congress identified four factors that guide the inquiry into fair use: “(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.” 17 U.S.C. § 107. These factors are not assessed in isolation but rather “weighed together, in light of the purposes of copyright.” *Campbell*, 510 U.S. at 578.

In *Campbell*, this Court elaborated on the first factor, an often-determinative inquiry in fair-use analysis. The “central purpose” of it, the Court explained, is to determine “whether the new work merely supersedes 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.” *Id.* at 579 (emphasis added) (brackets and quotation marks omitted).

Determining whether a use is transformative is not straightforward, but the statutory scheme provides guidance. A secondary work cannot be deemed transformative merely because it “recast[s], transform[s], or adapt[s]” a preexisting work. 17 U.S.C. § 101 (defining “derivative work”). Otherwise, any derivative work would qualify as transformative and likely constitute a noninfringing fair use. In other words, the exception would swallow the rule. *See* Pet.App.17a (“an overly liberal standard of transformativeness ... risks crowding out statutory protections for derivative works”); Resp’t Br. 40. Section 107’s fair-use exception should not be construed so broadly as to render its neighboring provision of rights, section 106(2), “void or insignificant.” *Corley*, 556 U.S. at 314.

The importance of markets for derivative works is also reflected in the fair-use provision itself. As this Court has explained, the fourth fair-use factor “must take account not only of harm to the original but also of harm to the market for derivative works.” *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 568 (1985); *see also Campbell*, 510 U.S. at 593 (explaining how derivative markets incentivize original creations). Thus, just as an overly capacious conception of transformativeness would nullify the derivative-work right, it would also allow one fair-use factor to eclipse another. But courts are supposed to balance the factors—not eliminate the fourth in favor of the first. *See id.* at 578; *Harper & Row*, 471 U.S. at 566 (describing fourth factor as “the single most important element of fair use”).

To find that Warhol’s work is a fair use of Goldsmith’s photograph would require a construction of transformativeness that eliminates all of the above-mentioned safeguards. Moreover, Petitioner effectively replaces the statutory description of the first fair-use factor, which requires assessment of “the purpose and character of the use,” 107 U.S.C. § 107(1), with a singular focus on its intended “meaning or message,” a phrase that does not even appear in the Copyright Act. *See* Resp’t Br. 39-40. Rather than further muddying the doctrine, this Court should interpret the fair-use exception to preserve copyright holders’ full bundle of rights and give meaning to all the relevant statutory provisions.

II. The Court Should Refine The Transformativeness Inquiry In The Aesthetic-To-Aesthetic Context To Ask Whether A Secondary Work Subordinates, Subverts, Or Extinguishes The Message Of The Original Work.

The transformativeness inquiry asks “whether the new work merely supersedes 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.” *Campbell*, 510 U.S. at 579 (brackets and quotation marks omitted). For instance, when artistic or educational works are reproduced toward utilitarian ends, such as to facilitate online searches, the secondary work clearly serves a different purpose from the original. *E.g., Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1165 (9th Cir. 2007) (thumbnails of images in internet search results served different purpose).

This test is similarly straightforward to apply in cases like *Campbell*, where the secondary work expressly parodies the original work. *Id.* at 583, 588 (rap song “ridicule[d]” original ballad’s “naiveté” and took direct “aim at [the] particular original work” as “the object of its critical wit”). A parody subverts or subordinates the message of the subject work. *See, e.g., Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 802 (9th Cir. 2003) (photographic depictions of Barbie parodied Barbie as “the ideal American woman”); *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1270 (11th Cir. 2001) (novel *The Wind Done Gone* parodied *Gone With the Wind*).

Unlike the parody in *Campbell* or the searchable images in *Perfect 10*, this case involves two works that serve the same purpose: Goldsmith’s photograph and Warhol’s Prince Series both serve artistic or aesthetic ends. In this aesthetic-to-aesthetic context, *Campbell*’s transformativeness test is much trickier to apply. “[A]t a high level of generality, [both works] share the same overarching purpose”—“to serve as works of visual art.” Pet.App.20a. Indeed, when two works share the same aesthetic function, the secondary work is more likely to “supersede[]” or “supplant[]” the original and thus intrude on the derivative-work right. *Campbell*, 510 U.S. at 579; *see supra* 4-7.

The test articulated in *Campbell* fails to provide a workable standard when two works share an overarching aesthetic purpose. This Court should articulate a more precise standard for aesthetic-to-aesthetic transformations. *See Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1197 (2021) (fair use “is flexible” and “its application may well vary depending upon

context”). Specifically, it should require that the secondary work subordinate, subvert, or extinguish the message of the original work. This standard provides greater guidance than the existing articulation and clearly distinguishes derivative works from fair uses. *See infra* 11-14. It also accounts for social-justice impacts of fair use, which are intertwined with the social-utility goals of copyright, and better protects disadvantaged creators from exploitation. Moreover, as explained below, it harmonizes the transformiveness inquiry with the copyright regime at-large, makes sense of existing fair-use caselaw, and aligns with broader intellectual-property principles.

A. Our Proposed Test Harmonizes The Transformiveness Inquiry With The Copyright Regime At-Large.

Unlike Petitioner’s approach, our proposal coheres with the larger copyright ecosystem.

First, our proposal ensures the focus of transformiveness properly remains on the perspective of a reasonable, objective observer—not the subjective (and perhaps *ex post facto*) intent of the secondary creator. *See Campbell*, 510 U.S. at 583 (asking whether secondary work “reasonably could be perceived as commenting on the original or criticizing it”); Andrew Gilden & Timothy Greene, *Fair Use for the Rich and Fabulous?*, 80 U. Chi. L. Rev. Dialogue 88, 96-97 (2013) (explaining “the futility in trying to distinguish ‘real’ from ‘post-hoc’ artistic purposes”); Resp’t Br. 51-54 (providing examples of this problem).

Here, the district court concluded that Warhol's work "transformed Prince from a vulnerable, uncomfortable person to an iconic, larger-than-life figure." Pet.App.72a. Petitioner similarly insists that Warhol's work "conveys the dehumanizing nature of celebrity." Pet. Br. 44, *id.* at 14, 30-31 (arguing, based on expert's opinion, that Warhol intended to "comment[] on society's conception of celebrities as products, not people"). But this supposed messaging is not reasonably perceptible to an objective observer, nor does it subordinate, subvert, or extinguish the message of Goldsmith's photograph. An objective observer could only perceive the Prince Series as commenting on the commodification of celebrity if they accepted Warhol's explanation of his intent (or, rather, what Petitioner's paid expert assumes was Warhol's intent). But "whether a work is transformative cannot turn merely on the stated or perceived intent of the artist or the meaning or impression that a critic ... draws from the work." Pet.App.22a.

What *is* reasonably perceptible to an objective observer is that Warhol created highly stylized visual depictions of Goldsmith's already-highly stylized photograph of Prince. There is no change in the message being communicated. *See* Resp't Br. 32-33. The only difference is the "imposition of [Warhol's] style." Pet.App.23a. But stylistic changes alone do not manifest a distinct purpose. Nor do they subordinate, subvert, or extinguish the message of the original, which remains just as it was even if the imposition of new style could overlay an additional message. Adopting our more precise standard thus mitigates the risk judges will "assume the role of art critic and seek to ascertain the intent behind ... the works," an

“inherently subjective” exercise—one that is particularly dangerous in the realm of artistic works. Pet.App.22a-23a.²

Second, our proposal ensures copyright owners retain the full bundle of rights contemplated by the Copyright Act, including the derivative-work right. As noted above (at 4), derivative works include follow-on works that “recast, transform[], or adapt[]” copyrighted works. 17 U.S.C. § 101. But not all derivative works are transformative for fair-use purposes. *See supra* 6-7. Our proposal provides a clear dividing line between derivative and transformative works.

Derivative works often make significant changes to the form or aesthetic of original works. Paradigmatic examples include “conversion of a novel into a film” and “adaptation of a musical composition for different instruments.” *Authors Guild*, 804 F.3d at 225; *see* 17 U.S.C. § 101 (other examples). These derivative works require authorization from the owner of the original copyright precisely because they are the types of works one anticipates would be derived from the original.

A derivative work may build substantially upon a preexisting work without rendering it a transformative fair use. *E.g.*, Pet.App.18a (film adaptations often combine characters, simplify plot elements, and add new scenes—all “filtered through the creative

² As explained below (at 19-20), considering the creator’s subjective intent or evaluating the work’s quality based on ideological judgments, intentionally or not, impedes the social-justice and social-utility aims of copyright law.

contributions of the screenwriter”); *Stewart v. Abend*, 495 U.S. 207, 238 (1990) (holding that *Rear Window* movie is not a fair use of preexisting magazine story, even though the story “constituted only 20% of the motion picture’s story line,” in part because movie “expressly uses the story’s unique setting, characters, plot, and sequence of events”). Even when the secondary creator adds significant new expression, they still must obtain permission from the original copyright’s owner.

Here, Warhol made far less significant changes to Goldsmith’s photograph than the changes in form and aesthetic that are commonplace in typical derivative works. Resp’t Br. 47-49. Unlike the conversion of a magazine story into a movie, which adds substantial new expression to the original “setting, characters, plot, and sequence of events,” *Stewart*, 495 U.S. at 238, Warhol literally replicated Goldsmith’s photograph³ and made solely stylistic changes to her expression, see Pet.App.25a (Warhol removed photograph’s depth and added bright colors and contrast). If adapting a story into a movie is not transformative, these purely stylistic changes certainly are not. As is typical of derivative works, one can anticipate that an artistic depiction of Prince would be derived from a photograph of Prince. Indeed, here, Warhol only had access to Goldsmith’s photograph because of a limited license for that express use of the photograph. Pet.App.6a-7a; Resp’t Br. 10-11.

³ Warhol’s usual techniques were to reproduce an image using a silkscreen printer or stencil a projected image onto paper. Pet.App.9a; Resp’t Br. 11-12.

Unlike Petitioner’s position, our proposed standard distinguishes clearly between derivative and transformative works. Even when a secondary work adds significant new expression or a distinct aesthetic, the original author should retain the authority to license such uses (or choose not to) unless the secondary work also subordinates, subverts, or extinguishes the original message. This standard captures precisely the types of uses one would *not* expect to be derived from a copyrighted aesthetic work. Here, because Warhol’s work does not add significant new expression to Goldsmith’s photograph—let alone subordinate, subvert, or extinguish its message—it is derivative, but not transformative.

Although Petitioner relies exclusively on the first fair-use factor, the others also support this analysis. *See supra* 5 (outlining statutory factors); *Campbell*, 510 U.S. at 578 (transformativeness must be assessed alongside other factors). Goldsmith’s studio photograph—not a photojournalistic “snapshot” but an artistic work created through expressive choices—lies at the “core of intended copyright protection,” *id.* at 586, as “an original work of art,” *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 60 (1884), so the second factor weighs against finding fair use. Justin Hughes, *The Photographer’s Copyright – Photograph as Art, Photograph as Database*, 25 Harv. J. L. & Tech. 339 (2012). The third factor also cuts against fair use where, as here, the secondary creator uses the “heart” of the original work. *Harper & Row*, 471 U.S. at 565-66 (publishing the “heart” of an unpublished work and thus supplanting the copyright holder’s first-publication right was not fair use). As to the fourth factor, Goldsmith negotiated a license for a

specific and limited use of her photograph, Pet.App.6a-7a; a finding of fair use would effectively destroy the ability of *any artist* to grant limited licenses for the preparation of derivative works. See Resp't Br. 10-11, 47.

If the Court determines, as it should, that Warhol's work infringes Goldsmith's derivative-work right, that does not mean artists like Warhol cannot copyright their creations: they simply must obtain permission from the original copyright owner. Had Warhol obtained permission from Goldsmith, his original contributions may have qualified for copyright protection as an authorized derivative work. See 17 U.S.C. § 103. Our proposal effectuates this sensible balance. It ensures that economically and/or socially disadvantaged creators can exploit the full benefits of copyright protection, including all potential licensing markets, without depriving other (often more privileged) creators from enjoying the economic benefits of their own contributions. As explained below (at 16-17), these social-justice considerations are critical to ensuring the copyright regime lives up to its constitutional mandate.

Third, our proposal preserves the distinction between ideas and expressions, only the latter of which are protected by copyright. See 107 U.S.C. § 102(b); *Google*, 141 S. Ct. at 1196 (“[C]opyrights protect ‘expression’ but not the ‘ideas’ that lie behind it.”); *Harper & Row*, 471 U.S. at 556 (“[C]opyright’s idea/expression dichotomy ‘[s]trikes a definitional balance between the First Amendment and the Copyright Act....’”). Under Petitioner’s view, a secondary work like Warhol’s would qualify as fair use, and thus

obtain independent copyright protection, if the creator claims an intent to portray a new idea—even without meaningful new expression. Consider an example: One artist paints a person standing atop a mountain to convey the monumental scope of nature. Another artist reproduces that painting but mutes the colors of the mountain, intending to convey a different message—that of human dominion over nature. The expressions in the paintings are almost identical, but the ideas are dramatically different. If such a subjective “new message” with insubstantial new expression constitutes a transformative use, it effectively affords copyright protection to a new idea alone, contrary to the prohibition on copyrighting ideas.

Our proposal, in contrast, comports with the idea/expression dichotomy. It is difficult to imagine a secondary work that subordinates, subverts, or extinguishes the meaning of an original without adding meaningful new expression. That is especially true considering this analysis is conducted from the perspective of a reasonable, objective observer without considering the creators’ asserted intent. *See supra* 9-11.

B. Our Proposal Furthers The Aims Of Intellectual-Property Social Justice, Which In Turn Furthers The Social-Utility Goals Of Copyright.

Affirming the Second Circuit’s decision and refining the transformativeness inquiry for aesthetic-to-aesthetic transformations as proposed also advances social-justice aims—an often overlooked, yet critical consideration in intellectual-property law and fair-

use jurisprudence. Copyright law is intended to “promote the progress of science and useful arts.” U.S. Const. art. I, § 8. For much of the last century, this goal was interpreted through an unduly narrow lens of economic utility. *See* Lateef Mtima, *The Idea Exclusions in Intellectual Property Law*, 28 Tex. Intell. Prop. L.J. 343, 374-75 (2020). But the constitutional goal of “progress” should not be so cramped. *See* Elizabeth Rosenblatt, *Copyright’s One-Way Racial Appropriation Ratchet (“One-Way Appropriation”)*, 53 U.C. Dav. L. Rev. 591, 599 & n.26 (2019) (arguing that “progress” should incorporate notions of “human flourishing,” and noting that creators equate “progress” with “equality and distributive justice”); Sean A. Pager, *Cultivating Capabilities for Creative Industry Upstarts*, 21 Mich. St. Int’l L. Rev. 547, 554 (2013) (critiquing theories that equate “progress” with “wealth maximization”).

A significant body of scholarship shows that the economic-utility goals of copyright cannot be divorced from considerations of social justice, equitable access, inclusion, and empowerment. *See, e.g.*, Mtima, *Idea Exclusions, supra* at 377 n.124, 381-82, 385; Elizabeth L. Rosenblatt, *Social Justice and Copyright’s Excess (“Excess”)*, 6 Tex. A&M J. Prop. L. 5 (2020). If the goal of copyright is to promote the broadest possible participation in the production, dissemination, and use of expressive works, then the legal system must explicitly consider the unjust effects and exclusionary impacts—whether intended or not—that result from the existing copyright regime. *See* Mtima, *supra*, at 386-87.

Logic dictates this approach: “When marginalized groups and communities have no expectation of reward from copyright protection, [they] lose the institutional incentive to produce artistic works.” Lateef Mtima, *Copyright Social Utility and Social Justice Interdependence: A Paradigm for Intellectual Property Empowerment and Digital Entrepreneurship*, 112 W. Va. L. Rev. 97, 127 (2009). Meanwhile, others can take advantage of marginalized creators’ preexisting work and thus have diminished incentives to develop their own expressive labor. *Id.* (explaining how marginalized creatives “become wary of sharing their works with the general public [and] losing control over their creations or the commercial profits their works might generate”). We are left with a smaller, less-diverse pool of authors and, consequently, a smaller, less-diverse array of works. Rosenblatt, *supra*, *Excess*, at 12. Turning a blind eye to copyright’s social-justice impacts impedes its economic and social efficacy. See Mtima, *Idea Exclusions, supra*, at 387.

Unfortunately, history shows that the copyright system—and the fair-use regime, specifically—has often failed to account for these social-justice impacts.

Historically, our legal system has tacitly condoned white artists’ appropriation of Black artistic expression. See Justin Hughes & Robert P. Merges, *Copyright and Distributive Justice*, 92 Notre Dame L. Rev. 513, 549 (2016) (“[I]ntellectual property laws have not rewarded African Americans for the creation of styles of music and dance—ragtime, jazz, blues, R&B, and many specific dances—which were appropriated by white artists.” (footnotes omitted)). Indeed, Black artists’ work has been so extensively

appropriated that some describe it as “essentially dedicate[d] ... into the public domain.” K.J. Greene, “Copynorms,” *Black Cultural Production, and the Debate Over African-American Reparations*, 25 *Cardozo Arts & Ent. L.J.* 1179, 1206 (2008).

One paradigmatic example is so-called “mirror cover recordings.” In the 1940s through 1960s, white musicians regularly imitated recorded performances of Black vocalists, replicating their distinctive vocal styles, and sold the “new” recordings to white audiences for sizable profits. Robert Brauneis, *Copyright, Music, and Race: The Case of Mirror Cover Recordings*, in *Cambridge Handbook of Intell. Prop. & Soc. Just.* (Steven D. Jamar & Lateef Mtima, eds. forthcoming 2022), <https://tinyurl.com/yskue42>. When a Black-owned record label sued,⁴ the court sided with the defendant. *See Supreme Records, Inc. v. Decca Records, Inc.*, 90 F. Supp. 904 (S.D. Cal. 1950).

Reading the *Supreme Records* decision today, the judge’s personal and racially biased musical tastes are readily apparent. *See Brauneis, supra*, at 14-15. The judge described the Black artist’s vocals as “thi[c]k, mechanical, [and] lacking inspiration,” compared to the white recording, which was “rich, ... full, meaty, [and] polished.” *Supreme Records*, 90 F. Supp. at 912. The court held that the two recordings could not be confused because, among other racially tinged observations, they differed in the “quality of the voices of the artists,” including the white vocalist’s “clearer

⁴ This lawsuit was based on unfair-competition law, but the reasoning translates to copyright infringement. *See Brauneis, supra*, at 14.

intonation and expression.” *Id.* After *Supreme Records*, “mirror cover recordings” became ubiquitous. Brauneis, *supra*, at 19 (placing Elvis Presley, the Beatles, the Rolling Stones, and Eric Clapton in this history).⁵

This same type of subjective, ideologically driven reasoning infects contemporary fair-use jurisprudence. Secondary creators from dominant groups claim they intended to transform a preexisting work, and because these claims are typically judged by members of the majority, they are often accepted. The innately subjective nature of the evaluation of expressive works, and their transformativeness in particular, means the commercial prospects of marginalized artists are often subject to the cultural tastes and racial biases of gatekeepers, including judges. See Anjali Vats, *The Racial Politics of Fair Use Fetishism*, 1 LSU L.J. for Soc. Just. & Pol’y 67, 81 (2022) (arguing that fair use is used to “subordinate[] Black brilliance to ... a federal judiciary that reflects Euro-American notions of race and creatorship”); *id.* at 77 (warning that “judicial approaches to fair use produce a category of second class creatorial citizenship”). No matter how neutral the fair-use doctrine is on its face, in practice it can “reinforce and feed on biases of lawmakers, judges, and juries about the cultural value of certain

⁵ The Rolling Stones’ 1964 hit “Time Is on My Side” copied Irma Thomas’s preexisting recording, including the tempo, arrangement, and even ad-libs. Eric Schaal, *Is the Rolling Stones’ ‘Time Is on My Side’ Different From Irma Thomas’ Earlier Version?*, Showbiz CheatSheet (Feb. 22, 2021), <https://tinyurl.com/4dzfbmwj>.

kinds of expression and creative practices.” Rosenblatt, *One-Way Appropriation*, *supra*, at 598.

Fair-use caselaw bears this out. An empirical study of nearly 300 fair-use decisions revealed “an overdog effect”: Underprivileged litigants tend to lose fair-use cases no matter which side of the “v” they appear on. Matthew Sag, *Predicting Fair Use*, 73 Ohio St. L.J. 47, 78 (2012). Well-known fair-use decisions reflect this pattern. *See, e.g.*, Vats, *supra*, at 84-86 (analyzing “how transformativeness disparately benefit[ed] white men” in *Blanch v. Koons*, 467 F.3d 244 (2d Cir. 2006) and *Cariou v. Prince*, 714 F.3d 694 (2d Cir. 2013)). The risk of ideological influence is particularly high in cases like this, where the secondary user has garnered popular acclaim. *See* Gilden & Greene, *supra* at 102 (“Jeff Koons’s work was unfair when he was exhibiting at relatively small galleries, but he wins fair use arguments once he makes it to the Museum of Modern Art (MOMA) and the Met[.]” (footnotes omitted)); Pet.App.27a (noting risk of “celebrity-plagiarist privilege” under Petitioner’s view); Resp’t Br. 57.

The facially neutral procedures that govern fair-use disputes can also produce social inequities. Oftentimes, as here, fair use is asserted via declaratory judgment actions brought by secondary creators rather than as a defense to an infringement action. *See* JA-80-81 (Complaint).⁶ This procedural posture is

⁶ *See, e.g.*, *Leadsinger, Inc. v. BMG Music Publ’g*, 512 F.3d 522 (9th Cir. 2008) (fair use dispute with same posture); *Lombardo v. Dr. Seuss Enters., L.P.*, 729 F. App’x 131 (2d Cir. 2018)

part of the problematic power dynamic in at least two ways.

First, it allows fair use to be weaponized against socially and/or economically disadvantaged creators. Secondary creators often have the resources to wield the legal system to their benefit—here, as a permission slip for infringement. *See* Rosenblatt, *One-Way Appropriation*, *supra* at 593 (describing “long tradition of musicians who obtain copyright on works that build on ‘folk’ sources, but threaten legal action when others use their work as the basis for similarly transformative art”). These secondary creators can sue for declaratory judgment and intimidate the original creator into a settlement or license, or even use their legal arsenal to litigate to a favorable judgment—warranted or not. *See id.* at 637 (“backing down in the face of a copyright threat, even a spurious one, may seem a superior—or the only—option” for marginalized creators); Vats, *supra*, at 78 (observing that “fair use still tends to disproportionately benefit corporate entities over individual ones”).

This procedural dynamic also affects the way marginalized creators produce original works. Because they cannot bear the risk of litigation, they tend to license preexisting works prophylactically or self-censor and restrict their own creative output. *See* Vats, *supra* at 86-88. This perpetuates an unjust system where those with fewer resources incur licensing

(same); *Veeck v. S. Bldg. Code Cong. Int’l, Inc.*, 293 F.3d 791 (5th Cir. 2002) (same); *Williams v. Gaye*, 895 F.3d 1106 (9th Cir. 2018) (same posture in copyright dispute over song “Blurred Lines”).

costs (or avoid certain forms of creativity entirely), while those with greater resources exploit preexisting works for free and use the threat of litigation as a shield against liability. The result is a system that makes it harder for disadvantaged groups to “use the expressive tools of dominant culture to ‘talk back’ to inequality.” Rosenblatt, *One-Way Appropriation*, *supra* at 594.

Our proposal mitigates these socially unjust effects. It better insulates courts from injecting subjective judgments into the fair-use analysis, thus reducing reinforcement of racial and cultural hierarchies. *See id.* at 607. Whether a secondary work subordinates, subverts, or extinguishes the message of a preexisting work is a more focused and objective inquiry than whether the secondary work “adds something new, with a further purpose or different character.” *Campbell*, 510 U.S. at 579. Moreover, by delineating three types of transformative effects (subordination, subversion, or extinction)—all of which take aim at the message of the preexisting work—our proposal better protects marginalized creators’ ability to “‘talk back’ to inequality.” Rosenblatt, *One-Way Appropriation*, *supra* at 594. Finally, by sharpening the transformativeness inquiry, our proposal provides greater guidance to courts and litigants, which in turn combats the uneven bargaining power noted above.

To be clear, the concept of fair use is not inherently unjust. But when courts ignore the effects of extrinsic social inequities, intellectual-property law—and the fair-use exception, specifically—can be used to undermine social justice and thus undermine copyright’s social and economic-utility goals. A fair-use

doctrine more attuned to these dynamics—one that holds secondary creators to our proposed standard and resists hegemonic views of what warrants protection—would prevent, or at least disincentivize, continued exploitation of marginalized creators.

C. Our Proposal Comports With, And Perhaps Explains, Existing Fair Use Caselaw In The Aesthetic-To-Aesthetic Context.

Adopting our proposal is not only critical to effectuating the policy aims of copyright and fair-use law, it is also consistent with established caselaw. Far from being a doctrinal change, our test puts a label on concepts that courts (including this one) have already been applying.

Assuming *Campbell* can be characterized as an aesthetic-to-aesthetic case, it is the only such case this Court has decided. There, this Court stressed the importance of subversion to a secondary work’s claim of parody. 2 Live Crew’s song was deemed a parody because its lyrical alterations to *Oh, Pretty Woman* amounted to a “rejection of [the latter’s] sentiment,” subverting the message that an ordinary listener would take from the original song. 510 U.S. at 583.

In *Suntrust Bank*, 268 F.3d 1257 (11th Cir. 2001), the Eleventh Circuit decided its own parody case, holding that *The Wind Done Gone* (*TWDG*) was a transformative fair use of *Gone with The Wind* (*GWTW*). *TWDG* relied on *GWTW*’s characters and story, but reframed the narrative from a different character’s perspective using a different style of

prose. The court held that this effectively “rebut[ted] and destroy[ed] the perspective, judgments, and mythology of *GWTW*,” which had presented a “romantic, idealized portrait of the antebellum South.” *Id.* at 1270. In other words, the apparent purpose of using *GWTW* in *TWDG* was to subordinate and subvert the former’s message.

Circuit courts have also applied *Campbell* to aesthetic-to-aesthetic cases beyond the parodic context. In *Dr. Seuss Enterprises, L.P. v. ComicMix LLC*, 983 F.3d 443 (9th Cir. 2020), *cert. denied*, 141 S. Ct. 2803 (2021), the Ninth Circuit held that *Oh, the Places You’ll Boldly Go!*, which placed *Star Trek* characters into the world of *Oh, the Places You’ll Go!*, was not transformative. The court explained that “[w]hile *Boldly* may have altered *Star Trek* by sending Captain Kirk and his crew to a strange new world, that world, the world of *Go!*, remains intact.” *Id.* at 454. Thus, despite adding original creative expression that was recognizable from *Star Trek*, the resulting book did not subordinate, subvert, or extinguish the meaning of the original.

In *Gaylord v. United States*, 595 F.3d 1364 (Fed. Cir. 2010), the Federal Circuit considered whether a postage stamp featuring a photograph of the Korean War Veterans Memorial was a fair use of the original sculpture. The photograph was taken after a snowstorm, so the soldiers and ground were covered in snow. The photographer chose angles, exposures, and lighting conditions to create a nearly monochromatic, grayer image. But the court held that “adding snow and muting the color” did not transform the sculpture enough to be transformative. *Id.* at 1373. Instead,

both works shared “a common purpose: to honor veterans of the Korean War.” *Id.* Despite the perceptible expressive differences between the two works, the stamp did not subordinate, subvert, or extinguish the meaning of the original.

Finally, in *Kienitz v. Sconnie Nation LLC*, 766 F.3d 756 (2014), the Seventh Circuit held that a t-shirt displaying an altered image of a city mayor was fair use because it removed the background, made the mayor’s face green, and surrounded it with multicolored writing that mocked his political position. The shirt removed so much from the original image that, “as with the Cheshire Cat, only the [subject’s] smile remain[ed].” *Id.* at 759. While the court did not rely on *Campbell*’s transformativeness analysis, its holding is nonetheless consistent with our test. The shirt’s message, criticizing the mayor’s political views, extinguished the message of the original photograph, which was simply to document the mayor’s inauguration.

Since *Campbell*, lower courts have begun to delineate the contours of transformativeness in aesthetic-to-aesthetic cases. But they have relied on different language and reasoning to reach their holdings. As demonstrated above, however, courts are unified in their substantive consistency with our test. This case provides the Court with an opportunity to recognize this inter-circuit coherence and announce a refined standard to guide lower courts in future cases.

III. Our Proposed Test (And The Second Circuit’s Approach) Aligns With Broader Intellectual-Property Principles.

Adopting the proposed test also ensures consistency between copyright law and other intellectual-property doctrines—a virtue this Court has historically pursued. *See, e.g., SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 137 S. Ct. 954 (2017) (eliminating laches in patent context shortly after doing so for copyright). While different types of intellectual property are protected in different ways, courts across the doctrinal spectrum consistently recognize that a new message or context is insufficient to insulate a secondary work from infringing its source material. And, like our proposal, other intellectual-property doctrines aim to protect smaller senior users and avoid subjective, aesthetic value judgments.

A. Right Of Publicity

The right of publicity—the “inherent right of every human being to control the commercial use of his or her identity”—is typically protected by state law. 1 McCarthy & Schechter, *Rights of Publicity and Privacy* §§ 1:3; 1:4 (2d ed.). While publicity-based claims have no statutory fair-use defense, courts have incorporated the concept of transformativeness when considering First Amendment affirmative defenses to such claims. And, in that context, a mere change in “meaning” is insufficient for protection.

The California Supreme Court, for example, developed a balancing test between the First Amendment and right of publicity that turns on

transformativeness: to warrant First Amendment protection, the work must add significant creative elements so as to transform the original into the defendant's own expression rather than simply appropriating a celebrity's likeness and economic value in a new context. *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387 (2001) (right-of-publicity claims are "especially worthy of First Amendment protection" when challenged work "contains significant transformative elements"); *see also* 2 McCarthy & Schechter, *Rights of Publicity and Privacy* § 8:23 (2d ed.) (*Comedy III's* flexible, "transformative use" approach has been adopted by "most courts" nationwide for cases involving artistic depictions of celebrities). "When artistic expression takes the form of a literal depiction or imitation of a celebrity for commercial gain, directly trespassing on the right of publicity without adding significant expression," the *Comedy III* Court explained, the state's "interest in protecting the fruits of artistic labor outweighs the expressive interests of the imitative artist." 25 Cal. 4th at 405. On the other hand, when "a product containing a celebrity's likeness is so transformed that it has become primarily the defendant's own expression rather than the celebrity's likeness," the First Amendment prevails. *Id.* at 406. On that basis, the California Supreme Court held that likenesses of the Three Stooges, as reproduced on t-shirts and lithographs from a charcoal drawing, were not entitled to First Amendment protection. *Id.*

The test we propose in the fair-use context requires nothing more, nothing less: a secondary work should do more than simply reproduce the aesthetic purpose of the original in order to be transformative.

Rather, a reasonable, objective observer must understand it to subordinate, subvert, or extinguish the message of the original. *See supra* § I.A. The stark contrast between the *Comedy III* principle and the approach Petitioner advances here is obvious: Under *Comedy III*, Warhol’s use of Prince’s likeness would likely be insufficiently transformative to protect against a publicity-rights claim. It makes no sense for Prince, the person depicted, to be able to recover for an unauthorized use of his likeness when Goldsmith, the person who took the original, authorized photograph, cannot.

B. Trademark Protection

Our proposal also squares with trademark law—in particular, the principle of reverse-confusion liability.

Trademark law ensures fair competition by preventing junior users from using marks identical or similar to marks already used by senior users in a manner likely to cause confusion about their source. *Banff, Ltd. v. Federated Dep’t Stores, Inc.*, 841 F.2d 486, 490-91 (2d Cir. 1988). In classic, direct-confusion trademark cases, junior users are said to trade on the goodwill of established senior users. *Id.* Reverse-confusion doctrine, as the name suggests, exists when a large, well-resourced company begins using a smaller, prior user’s mark in a confusing manner, likely leading consumers “to believe, erroneously, that the goods marketed by the prior user are produced by the subsequent user,” *Lang v. Ret. Living Publ’g Co., Inc.*, 949 F.2d 576, 583 (2d Cir. 1991); *see Dreamwerks Prod. Grp., Inc. v. SKG Studio*, 142 F.3d

1127, 1130 (9th Cir. 1998). Consumers may even believe the smaller, *senior* user is the one infringing. *Banff*, 841 F.2d at 490-91. In that posture, the harm is not only unjust enrichment of the defendant—the defendant’s use also *overwhelms* the plaintiff’s commercial identification with the mark by superimposing the defendant’s own identity thereon. *Id.*

The reverse-confusion doctrine illustrates the role of intellectual-property law in protecting smaller, senior users. In the leading case, for instance, “plaintiff Big O was a small regional tire wholesaler” and “Goodyear was the world’s largest tire manufacturer.” 6 Callmann on Unfair Comp., Tr. & Mono. § 22:13 (4th ed.) (discussing *Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co.*, 408 F. Supp. 1219 (D. Colo. 1976)). Their disparity in “size, notoriety and advertising power” meant that “when Goodyear infringed Big O’s Big Foot mark for tires and advertised its own Big Foot line of tires on national television, Big O’s customers thought Big O’s Big Foot product had emanated from Goodyear. They even thought Big O might be infringing Goodyear’s mark, instead of vice versa.” *Id.*; see also *Banff*, 841 F.2d at 490-91 (“Were reverse confusion not a sufficient basis to obtain Lanham Act protection, a larger company could with impunity infringe the senior mark of a smaller one.”).

Just as the doctrine of reverse confusion protects against a larger, junior user overwhelming a smaller, senior user’s mark, our proposal protects against unauthorized derivative works by prominent, deep-pocketed second-comers like Petitioner. That the public may instantly recognize Warhol’s distinctive style when viewing the Prince Series (or even look at

Goldsmith’s photograph and think to themselves, “Andy Warhol”) should not insulate Petitioner from infringement.

Importantly, courts assessing confusion consider not only the similarity between the parties’ goods, but also whether the senior user of *dissimilar* goods is likely to bridge that gap and expand into the junior user’s market. *See Polaroid Corp. v. Polarad Elecs., Corp.*, 287 F.2d 492, 496 (2d Cir. 1961) (assessing likelihood of confusion based not only on proximity of the products, but also likelihood the prior owner will bridge the gap). As one example, consider (as the Ninth Circuit did) the trend of entertainment studios expanding into merchandising. *Dreamwerks*, 142 F.3d at 1131 (junior user DreamWorks could not distinguish senior user Dreamwerks on ground that latter merely held sci-fi conventions). Similarly, in the realm of copyright, the fact that original and derivative works are different in character should not be determinative of transformativeness if the secondary work is an expected type of derivative work. *See supra* 6-7, 11-14 (discussing fourth fair-use factor).

C. Patent Law

This Court’s patent jurisprudence further confirms that adding trivial advances, new “meaning,” or new context to old material is not the kind of change that merits intellectual-property protection.

Patents are not granted for trivial advances over the prior art. Only inventions that represent a significant functional advance or advantage over existing technology receive patent protection. To this end,

35 U.S.C. § 103 provides that “[a] patent for a claimed invention may not be obtained ... if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious ... to a person having ordinary skill in the art to which the claimed invention pertains.” See *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 415-20 (2007) (discussing obviousness standard).⁷ In short, it is not enough for an invention to be non-identical to the prior art; to merit patent protection, it must bring something significantly new to the table.

In the copyright context, courts should likewise require a meaningful advance over prior work before a piece is deemed transformative. Secondary works that draw on source material without subordinating, subverting, or extinguishing the message of the original are no different from obvious inventions that simply use what is already known. To be sure, such works are not denied protection entirely in the copyright context, as in the patent space—but they may receive protection only as an authorized derivative work. *Supra* 14. In both the copyright and patent

⁷ Notably, courts engaging in an obviousness inquiry may also turn to “secondary considerations,” like how an invention is received in the marketplace, as evidence of whether an invention was obvious. *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 17 (1966). Such considerations are even more essential in the copyright space. In assessing fair use, one cannot look at the first factor alone but must also consider market impacts. See 107 U.S.C. § 107(4). Where works compete head-to-head in the marketplace, particularly where they are substitutes for one another (like Warhol’s and Goldsmith’s works), that weighs against finding fair use.

contexts, a trivial (or obvious) repackaging of existing work is not sufficient to warrant a grant of new rights.

Patent law also challenges the notion that new rights may be created by merely imposing new “meaning” atop an existing work. Discovering a new *use* for an old invention does not render that discovery patentable. *Atlas Powder Co. v. Ireco, Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999) (“[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art’s functioning, does not render the old composition patentably new to the discoverer.”). Likewise, employing an already-patented invention for a new *purpose* is still infringing, even if the new purpose was not recognized (much less intended) by the prior-art inventor. *Id.* at 1348-49; *Toro Co. v. Deere & Co.*, 355 F.3d 1313, 1320 (Fed. Cir. 2004). The same approach to newly imposed meaning and purpose is embodied by our proposal for the aesthetic-to-aesthetic context—where, unlike in the utilitarian or educational context, a new “purpose” is particularly prone to subjective interpretations. While Petitioner asserts that Warhol found new meaning or intent in Goldsmith’s photograph, the purpose, as reasonably perceptible to an objective observer, remained the same. Merely uncovering or even adding new purported meaning—without subordinating, subverting, or extinguishing the original message—should not erase Goldsmith’s rights any more than a new use would allow an inventor to re-patent an old composition.

Finally, patent-eligibility jurisprudence confirms that placing old ideas in new contexts does not merit intellectual-property protection. Courts have

consistently held that patent claims implementing a known process on a computer—say, a computer program that implements mail-sorting steps previously performed in corporate mailrooms—are not patent-eligible subject matter, even if the invention is novel and nonobvious. *E.g.*, *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017); *Intell. Ventures I LLC v. Cap. One Bank (USA)*, 792 F.3d 1363, 1370 (Fed. Cir. 2015). In such cases, the new, computerized invention may well have required creative labor, been unforeseeable by the original inventor, and added value to the world. *See Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591 (2013) (“Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.”). But the law nonetheless recognizes that, when an invention merely adds new context to an abstract idea, that is not the kind of innovation our intellectual-property laws are designed to protect.

The rationale for this policy applies equally here. Just as permitting an inventor to patent an abstract idea “might tend to impede innovation more than it would tend to promote it,” *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014), so too would an overly expansive fair-use doctrine hamper rather than support innovation and progress in the creative arts. *See supra* 14-15 (explaining how the Second Circuit’s approach protects the distinction between ideas and expressions).

CONCLUSION

This Court should refine the transformativeness standard in the aesthetic-to-aesthetic context and affirm the Second Circuit's judgment.

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