No.

IN THE
Supreme Court of the United States

ALAN WOFSY and ALAN WOFSY & ASSOCIATES,
Petitioners,

v.

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

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

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

Petitioner Alan Wofsy reproduced documentary photographs of Pablo Picasso's artwork for inclusion in a comprehensive, annotated series of reference books on the artist's works. Wofsy's undertaking was authorized by Picasso's estate, which held the copyright in the works of art. However, the owner of the copyright in a previously published book series that included the reproduced photographs successfully sued Wofsy for copyright infringement in France. Two district judges denied recognition of the French judgment, but the Ninth Circuit wrongly reversed the district court each time. In reversing the district court the second time, the Ninth Circuit concluded that Wofsy's use of the disputed photographs did not constitute fair use, parting ways with its sister circuits regarding the meaning of the first three fair use factors under 17 U.S.C. § 107, and raising the following questions:

(1) Under the first fair use factor, is a scholarly book that is "offered for sale" for use in academic and related settings a non-commercial work, as held by the Second Circuit, or a commercial work, as held by the Ninth Circuit?

(2) For purposes of the second fair use factor, is a work's level of creativity a distinct inquiry from whether that work is sufficiently original to be copyrightable, as held by the Fifth and Eleventh Circuits, or is a work that meets the threshold for

copyrightability automatically considered creative, as held by the Ninth Circuit?

(3) Where a representational photograph is reproduced in its entirety because a partial photograph would not be a useful depiction of its subject, is the third fair use factor neutral, as held by the First, Second, Seventh, and Eleventh Circuits, or does it weigh against fair use, as held by the Ninth Circuit?

CORPORATE DISCLOSURE STATEMENT

Petitioner Alan Wofsy is a natural person. Petitioner Alan Wofsy & Associates is not publicly traded and has no corporate parent, and no publicly held corporation owns 10% or more of its stock.

PROCEEDINGS BELOW

U.S. District Court for the Northern District of California, Case No. 5:13-cv-05957-EJD, *Vincent Sicre de Fontbrune, et al. v. Alan Wofsy, et al.*, Judgment entered September 12, 2019.

U.S. Court of Appeals for the Ninth Circuit, Case No. 14-15790, *Vincent Sicre de Fontbrune, et al. v. Alan Wofsy, et al.*, Judgment entered September 26, 2016.

U.S. Court of Appeals for the Ninth Circuit, Case Nos. 19-16913 and 19-17024, *Vincent Sicre de Fontbrune, et al. v. Alan Wofsy, et al.*, Judgment entered July 13, 2022.

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Statutes and Constitutional Provisions

Alan Wofsy and Alan Wofsy & Associates ("Wofsy") respectfully petition for a writ of certiorari to review the judgment of the United States Court of Appeals for the Ninth Circuit.

OPINIONS BELOW

The opinion of the court of appeals for which review is sought by this petition, App. 1a, is reported at 39 F.4th 1214. The order of the district court challenged in that appeal, App. 48a, is reported at 409 F.Supp.3d 823.[1]

JURISDICTION

The district court had subject matter jurisdiction under 28 U.S.C. § 1332.

The court of appeals had jurisdiction pursuant to 28 U.S.C. § 1291. The court of appeals issued its opinion on July 13, 2022, and denied rehearing on September 6, 2022. App. 92a.

This Court has jurisdiction under 28 U.S.C. § 1254(1).

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[1] The opinion of the court of appeals in an earlier appeal of which review is not sought by this petition is published at 838 F.3d 992. The order of the district court challenged in that appeal is not reported but is available at 2014 WL 1266999.

STATUTORY PROVISION

17 U.S.C. § 107 provides as follows:

Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include--

(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.

The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.

INTRODUCTION

Having received permission from Pablo Picasso's estate to produce a comprehensive reference series on the artist's work, California resident Alan Wofsy compiled thousands of photographs depicting Picasso's art, including photographs from an old French publication that had entered the public domain in the United States (the "*Zervos Catalogue*"). In 2001, Yves Sicre de Fontbrune, the copyright holder in the *Zervos Catalogue*, obtained a judgment against Wofsy in France that, among other things, prohibited Wofsy from using the images from the *Zervos Catalogue*. In 2011, de Fontbrune, who had by then sold the copyright in the *Zervos Catalogue*, found two copies of Wofsy's books at a bookstore in Paris and sued Wofsy for violating the 2001 French judgment. De Fontbrune failed to serve Wofsy, and in 2012, secured a default judgment against Wofsy for 2 million Euros.

De Fontbrune then brought suit in California to obtain recognition of the 2012 French judgment. The district court granted summary judgment to Wofsy on the basis that the foreign judgment was repugnant to U.S. public policy because Wofsy's use of the photographs would be protected as fair use under U.S. law—a defense that is grounded in the First Amendment and is not available in France.

The Ninth Circuit reversed, concluding that reproducing the photographs in order to depict

Picasso's art did not constitute fair use. Notably, the Ninth Circuit did not simply reverse the summary judgment in favor of Wofsy; it granted partial summary judgment in favor of de Fontbrune on the fair use issue. The Ninth Circuit made its decision notwithstanding the fact that, in the district court, de Fontbrune had never contested Wofsy's position that his use of the disputed images would qualify as fair use under U.S. law.[2]

In granting partial summary judgment to de Fontbrune, the Ninth Circuit created circuit splits with multiple other circuits on three of the four statutory fair use factors. First, the court of appeals held that Wofsy's books, produced for use as a reference for academics, museums, libraries and art collectors, were "commercial" simply because they were offered for sale. Second, the court held the photographs in question were relatively "creative" based solely on a French court's determination that the photographs were sufficiently original to be copyrightable under French law. Third, the court of appeals held that copying an entire photograph weighs against fair use even where the purpose of reproducing the photograph is to depict the photograph's subject, i.e., the underlying artwork by Picasso. To the best of Wofsy's knowledge, no other

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[2] De Fontbrune had argued only that a foreign judgment that denied fair use protection was not repugnant to U.S. public policy.

circuit court has published an opinion taking these positions, and multiple circuits have held just the opposite.

Were such a split to arise in another field of law, it might make sense to wait for the split to further develop. However, the First Amendment rights protected by the fair use doctrine are easily stifled in the face of uncertainty. In addition, this case provides an ideal vehicle to clarify not just one, but three of the fair use factors.[3] This Court should take this opportunity to resolve the confusion created by the Ninth Circuit and give guidance to Americans who wish to exercise their right to free speech by making fair use of copyrighted works.

STATEMENT OF THE CASE

Between 1932 and his death in 1970, the Greek-French art critic and publisher Christian Zervos produced a compilation of photographic reproductions of the works of Pablo Picasso (a *catalogue raisonné*) that eventually comprised 33 volumes,[4] published by his company Cahiers d'Art and often referred to as the *Zervos Catalogue*. 4-ER-566, 807; 5-ER-817; 7-

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[3] The court of appeals also misapplied the fourth fair use factor, but that error did not generate a circuit split in the law.

[4] The second volume was published in two parts, making for a total of 34 books. 5-ER-816.

ER-1247.[5] Zervos worked with Picasso and solicited photographs of Picasso's works from art collectors and galleries to include in his *catalogue raisonné*, and there is no evidence that anyone who provided photographs to Zervos ever assigned copyrights in the photographs to Zervos or to Cahiers d'Art. 4-ER-800-07. In 1979, Yves Sicre de Fontbrune purchased the Cahiers d'Art business from Zervos's heirs. 4-ER-517, 675-82.

The Picasso estate forbade de Fontbrune from reproducing any of Picasso's works.[6] *See* 5-ER-863. In contrast, the Picasso estate expressly authorized Wofsy to create a publication illustrating and describing the artist's work—specifically including reproductions of the works of Picasso shown in the *Zervos Catalogue*—and in 1995, Alan Wofsy Fine Arts LLC[7] produced the first two volumes of *The*

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[5] "ER" refers to the Excerpts of Record filed in the Ninth Circuit, located at Dkt. No. 13. "SER" refers to the Supplemental Excerpts of Record filed in the Ninth Circuit, located at Dkt. No. 23. "FER" refers to the Further Excerpts of Record filed in the Ninth Circuit, located at Dkt. No. 51.

[6] The Picasso Estate (Succession Picasso) holds a copyright interest in photographs of Picasso's works. *See* www.museepicassoparis.fr/en/image-rights ("**All commercial or non-commercial** use must receive express prior permission from the Picasso Administration," and "reproduced work must always be accompanied by its caption and by the copyright notice '© Succession Picasso 202.. (year of print date)'.").

[7] The members of Alan Wofsy Fine Arts LLC comprise Petitioners Alan Wofsy and Alan Wofsy & Associates.

Picasso Project, covering Picasso's work from 1917 to 1921. 5-ER-816-17, 827, 833, 857. Wofsy included photographs from Volumes III and IV of the *Zervos Catalogue*, having first concluded that the Zervos volumes had entered the public domain in the United States and therefore were not subject to copyright protection. 5-ER-816, 824; *see also* 4-ER-813, 5-ER-966.

The unrebutted expert testimony introduced in the district court showed that the purpose of the photographs in a *catalogue raisonné* such as the *Zervos Catalogue* is the faithful reproduction the artist's oeuvre, not original artistic expression by the photographer. 7-ER-1258. Accordingly, the photographs in a *catalogue raisonné* serve a technical purpose of documenting the artwork of others; the photographs themselves are not art and are not meant to be art. 7-ER-1258. In this case, the expert provided his unchallenged opinion that the photographs in the *Zervos Catalogue* accurately reproduce the works of Pablo Picasso as documentary images, and the reproductions are not—and are not intended to be—art. 7-ER-1259. In the art world, it is not unusual for one *catalogue raisonné* to use images from another. 7-ER-1259.

Unlike the *Zervos Catalogue*, which was a very expensive and out-of-print collector's item, Wofsy's books, known collectively as "*The Picasso Project*," are sold for a much lower price that makes them accessible to libraries, art historians, and educational

institutions. 7-ER-1247, 1249. *The Picasso Project* is more comprehensive than the *Zervos Catalogue* and, unlike the *Zervos Catalogue*, *The Picasso Project* is carefully arranged in chronological order, includes literature references, and provides information on provenance, the location where Picasso created the work, current ownership when public, and sales. 5-ER-820-21; 7-ER-1247-49.

In 1996, at de Fontbrune's request, French officials seized two volumes of *The Picasso Project* from the invited American "booth of honor" at the *Salon du Livre* in Paris. 5-ER-817. De Fontbrune sued Wofsy for copyright infringement, and in 1998 the *Tribunal de Grande Instance de Paris* ruled in favor of Wofsy, finding that the photographs reproduced in *The Picasso Project* were ineligible for copyright protection. 5-ER-817, 854-66. In 2001, the French *Cour d'Appel* reversed the lower court's findings of fact and law, stating the photographs incorporated creative features that made them copyrightable. 1-SER-1369-81. The French appellate court found Wofsy "guilty of infringement of copyright," awarded damages, and imposed an *astreinte,* under which Wofsy would have to pay 10,000 francs for every future unauthorized use of the photographs. 1-SER-1380-81.

In the decade that followed, de Fontbrune sold the Cahiers d'Art business, including its copyrights. 4-ER-517, 715-78. He subsequently prompted a bailiff to seize two volumes of *The Picasso Project* that

included photographs from the *Zervos Catalogue* from a Paris bookstore and, based on that seizure, he initiated a new lawsuit in 2011 against Wofsy to enforce the *astreinte* from the 2001 French judgment. 1-SER-1399; 4-ER-793-97. Wofsy was not served in that action, and he did not learn of it until after the French court had already decided the merits, awarding de Fontbrune 2 million Euros in 2012 without Wofsy ever appearing in the case.[8] 5-ER-818-19, 898-901; 1-SER-1399-400. De Fontbrune then sought recognition of the 2012 French judgment in Alameda County Superior Court. 1-SER-1348.

Following removal, the district court granted Wofsy's motion to dismiss because the French judgment was a fine or penalty not covered by California's Uniform Foreign-Country Money Judgments Recognition Act (UFCMJRA), Cal. Code Civ. Proc. §§ 1713-1725. De Fontbrune appealed and the Ninth Circuit reversed. *De Fontbrune v. Wofsy*, 838 F.3d 992, 1007 (9th Cir. 2016).[9] On remand, the

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[8] Wofsy here recites the aspects of the procedural history relevant to this petition. The complex procedural history of this case is described in greater detail in the court of appeal's opinion. App. 9a-14a.

[9] Wofsy petitioned for rehearing because the French judgment awarding de Fontbrune 2 million Euros punished Wofsy for an alleged failure to comply with judicial authority, and the amount awarded bore no relation to any actual harm suffered by de Fontbrune. The Ninth Circuit modified its opinion and denied panel rehearing, as well as Wofsy's

parties cross-moved for summary judgment. The district court granted summary judgment for Wofsy (and denied it for de Fontbrune) based on the defense that the French judgment is repugnant to U.S. public policy because Wofsy's use of photographs from the *Zervos Catalogue* would have been protected by the fair use doctrine under the First Amendment had he been sued in the United States. App. 75a-84a. In his motion for summary judgment in the district court, de Fontbrune had not addressed any of the fair use factors, arguing only that a foreign judgment denying fair use protection would not be repugnant to U.S. public policy. FER-66-68.

The Ninth Circuit again reversed, holding that three of the four statutory fair use factors weighed against fair use, that there were thus "serious doubts that a fair use defense would protect the copying of the photographs at issue," and that the French judgment was therefore not repugnant to U.S. public policy. App. 20a-27a. The Ninth Circuit went beyond reversing the judgment in favor of Wofsy and granted partial summary judgment to de Fontbrune on the fair use issue.[10] App. 26a-27a. The Ninth

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alternative request to certify a question to the California Supreme Court. Wofsy did not petition for certiorari because, unlike the current appeal, the earlier decision turned on an issue of California state law.

[10] This did not lead to judgment for de Fontbrune because Wofsy may have other defenses to recognition of the French judgment by a U.S. court.

Circuit declined to address whether a defendant's inability to assert a meritorious fair use defense would render a foreign judgment repugnant to U.S. public policy. App. 27a n.11.

REASONS FOR GRANTING THE PETITION

This case presents an excellent vehicle to resolve circuit splits on three aspects of the fair use doctrine on a clean summary judgment record. For the reasons discussed below, the Ninth Circuit has placed itself at odds with multiple other circuits on these issues, and this Court should take this opportunity to establish uniformity in this critical area of law.

Although the fair use issues in this case arose in the context of an action for recognition of a foreign judgment under California's UFCMJRA, the opinion of the Ninth Circuit turned on federal copyright law, and the questions presented relate exclusively to federal copyright law. This Court need not rule on any aspect of the UFCMJRA; rather, if this Court grants this petition, it can resolve the circuits' divergent interpretations of the fair use factors and then remand for the lower courts to apply that federal law to the UFCMJRA.

I. The Ninth Circuit Split with the Second Circuit by Holding that Offering a Scholarly Book for Sale Automatically Renders It "Commercial," Making the First Factor Weigh against Fair Use

The Ninth Circuit's opinion departs from the law of the Second Circuit by characterizing a scholarly reference work intended for libraries, schools, museums, collectors and auction houses as "commercial" for purposes of the first fair use factor simply because the work is offered for sale. The first factor looks at "the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes." 17 U.S.C. § 107(1). This Court has held the inquiry under this factor "may be guided by the examples given in the preamble to § 107." *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578 (1994). The preamble provides that "fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching . . ., scholarship, or research, is not an infringement of copyright." 17 U.S.C. § 107.

The Ninth Circuit's opinion acknowledges that "the district court observed that *The Picasso Project* was 'intended for libraries, academic institutions, art collectors, and auction houses,' and concluded that *The Picasso Project*'s purpose aligned with the 'criticism, comment, news reporting, teaching . . ., scholarship, or research' purposes that Section 107 characterizes as non-infringing." App. 21a. The

opinion then rejects the district court's conclusion on the first fair use factor simply because *The Picasso Project* is "a book offered for sale." App. 21a.

The Ninth Circuit's position conflicts with the opinion of the Second Circuit in *Wright v. Warner Books, Inc.*, 953 F.2d 731 (2d Cir. 1991). There, the court considered whether a biographer had fairly used excerpts and paraphrases from her subject's letters, journal entries, books, and an essay. The court determined that as a scholarly biography, the work "fit[] comfortably" into the categories of fair use listed in the preamble to section 107 even though the biography was offered for sale. *Id.* at 736. "[I]f a book falls into one of these categories [i.e., criticism, scholarship or research], assessment of the first fair use factor should be at an end, *even though, as will often be the case, the biographer and publisher anticipate profits*." *Id.* at 736-37 (emphasis added, brackets in original, citations and internal quotes omitted). The Second Circuit's holding accords with the this Court's observation in *Campbell v. Acuff-Rose Music, Inc.* that "the illustrative uses listed in the preamble paragraph of § 107, including news reporting, comment, criticism, teaching, scholarship, and research, . . . 'are generally conducted for profit in this country.'" 510 U.S. at 584.

The Ninth Circuit's opinion reduces the commerciality question to whether an allegedly infringing work is "offered for sale," App. 21a, ignoring every other relevant consideration, and

ignoring the reality that most scholarly books are offered for sale. By contrast, the Second Circuit, consistent with *Campbell*, holds that a book's nature as a work of "scholarship or research" weighs in favor of fair use even though the author and publisher anticipate profits. *See Wright*, 953 F.2d at 736-37. This Court should resolve this conflict.

II. The Ninth Circuit's Conflation of Creativity Sufficient for Copyrightability with Creativity under the Second Fair Use Factor Conflicts with Opinions from the Fifth and Eleventh Circuits

The Ninth Circuit also departed from the law in other circuits in its interpretation of the second fair use factor. The second factor assesses "the nature of the copyrighted work." 17 U.S.C. § 107(2). "This factor calls for recognition that some works are closer to the core of intended copyright protection than others, with the consequence that fair use is more difficult to establish when the former works are copied." *Campbell*, 510 U.S. at 586. Functional and factual works are more likely to be subject to fair use than fictional or other highly creative works. *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1197 (2021) ("Thus, copyright's protection may be stronger where the copyrighted material is fiction, not fact, where it consists of a motion picture rather than a news broadcast, or where it serves an artistic rather than a utilitarian function.").

The Ninth Circuit's opinion concludes that a copyrighted work is "creative" under this factor whenever the work is creative enough to be copyrightable. To understand the court's glaringly circular analysis, one must start in the opinion's factual background discussion, where it notes that the French trial court concluded in 1998 "that the photographs in the *Zervos Catalogue* were documentary in nature and therefore ineligible for copyright protection." App. 10a. It then explains that in 2001, the French appellate court reversed, determining that the photographs were copyrightable under French law because of "deliberate choice[s] of lighting, the lens, filters, [and] framing or angle of view." App. 10a; 1-SER-1378. These qualities (lighting, filters, etc.) identified by the French appellate court went to copyrightability, not to whether the photographs were any more or less creative than other copyrightable works. These factors can also be relevant to copyrightability of a photograph under U.S. law. *See Rogers v. Koons*, 960 F.2d 301, 307 (2d Cir. 1992) ("Elements of originality in a photograph may include posing the subjects, lighting, angle, selection of film and camera, evoking the desired expression, and almost any other variant involved," which can "suffice[] to meet the original work of art criteria."); *accord Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 60 (1884). In other words, those factors might support the

copyrightability of a photograph, but that is not the same as determining whether a photograph is "creative" for purposes of the fair use doctrine.[11]

Instead of evaluating the "nature of the work" under the second fair use factor, the Ninth Circuit's opinion observes that photographs "can merit copyright protection" and then simply states that "the French *Cour d'Appel* recognized that the photographs have creative elements reflecting deliberate choices of lighting, filters, framing, and angle of view." App. 24a. Thus, the Ninth Circuit holds that because a French court found the photographs sufficiently original to be copyrightable under French law, they are also creative for purposes of the second fair use factor under U.S. law.

This holding conflicts with the law in the Fifth and Eleventh Circuits, both of which recognize that creativity sufficient for copyrightability does not establish creativity under the second fair use factor. As the Fifth Circuit explained, "[i]n order to be copyrightable, a work must contain a certain modicum of originality." *Compaq Computer Corp. v. Ergonome Inc.*, 387 F.3d 403, 410 (5th Cir. 2004). The court went on to hold that "because fair use

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[11] Notably, the photographs are useful—to Wofsy and to Wofsy's audience—not because of any creative choices about lighting, lenses, filters or framing, but rather because they accurately depict the works of Picasso.

excuses otherwise actionable infringement . . . , a work will always be found 'original' for copyrightability purposes before the fair use analysis is applied. *The second statutory fair use factor, then, refers to the 'nature' of the work beyond this initial inquiry*." *Id.* (emphasis added).

Similarly, the Eleventh Circuit has stated that "'the mere fact that the copied portions are themselves copyrightable cannot incline [the second] factor against fair use.' '[A] work will always be found "original" for copyrightability purposes before the fair use analysis is applied. The second statutory fair use factor . . . refers to the "nature" of the work beyond this initial inquiry.'" *Cambridge Univ. Press v. Patton*, 769 F.3d 1232, 1268 n.25 (11th Cir. 2014) (alterations in original, citation omitted). Where a photograph has factual elements (such as the photographs in the *Zervos Catalogue*, which conveyed the facts about how Picasso's artwork appeared), the Eleventh Circuit compares the photograph's creative and factual components against each other in order to determine which way the second fair use factor leans. *Katz v. Google Inc.*, 802 F.3d 1178, 1183 (11th Cir. 2015) (assessing whether "the creative gilt of the Photo predominate[s] over its plainly factual elements").

Under the Fifth and Eleventh Circuits' reasoning, even if the photographs at issue here were sufficiently original to warrant copyright protection under U.S. law, that would only trigger, not decide,

the creativity inquiry under the second fair use factor. In contrast, the Ninth Circuit's opinion essentially treated copyrightability (as determined by a foreign court under foreign law) as dispositive of the fair use creativity factor.

It bears mentioning that the photographs in question here may not have even been sufficiently original to be copyrightable under U.S. law, much less creative for purposes of the second fair use factor. As the Second Circuit has held, in order for the reproduction of a work of art to be copyrightable, "there must be at least some substantial variation, not merely a trivial variation such as might occur in the translation to a different medium." *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 491 (2d Cir. 1976). Even if the *Zervos Catalogue* photographs would be copyrightable in the U.S., any such copyright would be "thin" because they primarily convey factual information about the appearance of Picasso's paintings. *See* 7-ER-1258-59; *Google*, 141 S. Ct. at 1198.

If a work barely qualifies for copyright protection because of its marginal creativity, then it is certainly not creative in comparison to other copyrightable works, and its lack of creativity weighs in favor of fair use. *See id.* at 1202 (holding that where a work is "further . . . from the core of copyright," the second factor "points in the direction of fair use"). By conflating creativity under the second fair use factor with copyrightability in the first instance, the Ninth

Circuit produced a break in the law, which this Court should resolve.

III. The Ninth Circuit Split with the First, Second, Seventh, and Eleventh Circuits by Holding that Copying an Entire Photograph Tilts the Third Factor Against Fair Use Even Where the Purpose of Reproducing the Photograph is to Depict the Photograph's Subject

The Ninth Circuit also departs from its sister circuits in construing the third fair use factor, which addresses "the amount and substantiality of the portion used in relation to the copyrighted work as a whole." 17 U.S.C. § 107(3). The Ninth Circuit concluded that the relevant copyrighted works were the individual photographs (not the *Zervos Catalogue* as a whole) and that *The Picasso Project* copied the photographs in their entirety. App. 25a. The opinion notes that "the purpose of the copying informs the analysis," and then concludes that it was "unpersuaded that this is a case . . . in which copying the entirety of each photograph was necessary." App. 25a. Thus, the opinion holds, the third "factor weighs against fair use." App. 25a. In so holding, the Ninth Circuit places itself at odds with a number of other circuits, which have held that representational photographs must be reproduced in their entirety in order to be useful depictions of their subjects.

For example, the Eleventh Circuit has explained that when reproducing a photograph, "all or most of the work often must be used in order to preserve any meaning at all," which distinguishes a photograph from "a work such as a text or musical composition, where bits and pieces can be excerpted without losing all value." *Katz*, 802 F.3d at 1183-84. Thus, the court held that the alleged infringer did not use too much of a photograph of her landlord because "[t]hough ten blog posts reproduced the Photo in its entirety and without alteration, to copy any less of the image 'would have made the picture useless to [the alleged infringer's] story' that [the plaintiff] is a predatory commercial landlord." *Id.* at 1184. Similarly, the First Circuit has held that, in writing a story about a photograph, a newspaper had to print the entire photograph; "to copy any less than that would have made the picture useless to the story." *Nunez v. Caribbean Int'l News Corp.*, 235 F.3d 18, 24 (1st Cir. 2000). And the Second Circuit has concluded that reproducing entire concert promotion posters (albeit in reduced size) was "necessary to ensure the reader's recognition of the images as historical artifacts of Grateful Dead concert events." *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 613 (2d Cir. 2006).

Perhaps most on point is the Seventh Circuit's decision in *Ty, Inc. v. Publications Int'l Ltd.*, 292 F.3d 512, 515 (7th Cir. 2002), which considered whether a publisher of the *Beanie Babies Collector's Guide* made fair use of photographs of Beanie Babies. Each

page in the guide contained, "besides a photograph of a Beanie Baby, the release date, the retired date, the estimated value of the Beanie Baby, and other information relevant to a collector." *Id.* at 519. The court concluded that the third fair use factor did not weigh for or against fair use, explaining that, in depicting a Beanie Baby, "there can be no partial copying as a matter of fact (no one, we imagine, wants a photograph of part of a Beanie Baby)." *Id*. at 522.

Applying the Seventh (and First, Second, and Eleventh) Circuit's reasoning, the third fair use factor would have been neutral in this case. *See Bill Graham Archives*, 448 F.3d at 613 (explaining that, while no circuit "has ever ruled that the copying of an entire work *favors* fair use," the factor does not weigh against fair use where the use requires copying the entire work). Like the *Beanie Babies Collector's Guide*, *The Picasso Project* reproduces images in their entirety and provides information about the depicted works, including literature references, provenance, the location where Picasso created the work, current ownership, and sales. 5-ER-820-21; 7-ER-1247-49. The purpose of *The Picasso Project* is to document the works of Picasso, which Picasso's estate expressly authorized. 5-ER-827. It would be impossible to document a painting without showing a complete

image of that painting.[12] To paraphrase the Seventh Circuit, no one wants a photograph of part of a Picasso.

The Ninth Circuit, however, did not follow the reasoning of these other circuits. App. 25a. By holding that Wofsy's copying of the photographs in their entirety weighed against fair use, the Ninth Circuit created a division in the law, which this Court should rectify.

IV. The Legal Conflicts Created by the Ninth Circuit's Opinion Will Chill Expression among Those Who Wish to Make Fair Use of Copyrighted Works

Courts must be "mindful of the preferred position which the First Amendment occupies in the pantheon of freedoms." *Baker v. F & F Inv.*, 470 F.2d 778, 783 (2d Cir. 1972). The fair use doctrine is a "built-in First Amendment accommodation[]," *Golan v. Holder*, 565 U.S. 302, 328 (2012), and the development of fair use law must honor the sacred nature of free speech rights.

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[12] Indeed Wofsy had to reproduce the entire works. *See* www.museepicassoparis.fr/en/image-rights ("The works [of Picasso] must be reproduced as faithfully to the original as possible" and "any reproduction of a detail from the work" is only "permitted provided the entire work is itself reproduced inside the document, with the caption referring to it.").

Because it conflicts with the law of other circuits, the Ninth Circuit's opinion undermines and confuses fair use standards. "[U]ncertainty of speech-affecting standards has long been recognized as a First Amendment problem." *In re Tam*, 808 F.3d 1321, 1342 (Fed. Cir. 2015). When confusion in the law renders a speaker uncertain whether her speech will be protected, she is apt to refrain from speaking, producing a "chilling effect on speech." *Id.*

When the application of fair use law is unpredictable, speakers cannot calibrate their speech to respect others' copyrights while still fully exercising their own First Amendment rights. To protect these important rights, this Court should address and resolve the conflicts in fair use law created by the Ninth Circuit's opinion.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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