No. 21-869

In The
Supreme Court of the United States

ANDY WARHOL FOUNDATION
FOR THE VISUAL ARTS, INC.,

Petitioner,

v.

LYNN GOLDSMITH AND LYNN GOLDSMITH, LTD.,

Respondents.

**On Writ Of Certiorari To The
United States Court Of Appeals
For The Second Circuit**

BRIEF OF AUTHORS ALLIANCE AS *AMICUS CURIAE* IN SUPPORT OF PETITIONER

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INTEREST OF *AMICUS CURIAE*[1]

Authors Alliance is a 501(c)(3) nonprofit organization that creates resources to help authors understand and enjoy their rights and promotes policies to enable knowledge and culture to be widely available and discoverable. The organization supports public-spirited authors by helping them achieve their dissemination goals and giving authors a voice in legal and policy debates affecting their work. Authors Alliance has more than 2,300 members, many of whom are nonfiction authors.

Authors Alliance has created a suite of guides for authors on navigating legal issues related to their writings. One is *Fair Use for Nonfiction Authors*, a guide to help nonfiction authors understand when they can rely on fair use in their works. A second is *Third-Party Permissions and How to Clear Them*, which helps authors understand how to go about obtaining permission to use parts of others' works when their intended use in new works goes beyond what fair use would permit. In this way, Authors Alliance helps authors to distinguish transformative fair uses from infringing derivative works. Nonfiction authors, who frequently build on works addressing the same subjects, rely on

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[1] Counsel for the parties did not author this brief in whole or in part. The parties have not contributed money intended to fund preparing or submitting this brief. No person other than *amicus curiae* and its counsel contributed money to fund preparation or submission of this brief. On May 2, 2022, counsel for both parties gave blanket consent to any timely filed briefs of *amicus curiae*.

the breathing space that fair use provides for ongoing creativity.

Authors Alliance's principal interest in this case is its ability to provide sound guidance to authors about the bounds of fair use. The Second Circuit's decision, if affirmed, would make authors more risk-averse and less certain about whether they can continue to rely on the transformative fair use doctrine articulated by this Court.

SUMMARY OF ARGUMENT

For nearly three decades, this Court's decision in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994), has guided the inquiry into whether the purpose and character of a secondary use of a copyrighted work weighs in favor of a fair use defense. Following *Campbell*, courts determine whether that use is transformative by looking to the new expression, meaning, or message of the secondary use. There are clear cases and close cases, but *Campbell* and its progeny have provided a blueprint for all cases. That blueprint leaves necessary breathing space for free expression and innovation.

The Second Circuit's decision below departs needlessly from that blueprint. Perhaps overcorrecting for critiques of its earlier decisions, the Second Circuit has fashioned a new test for transformativeness that is inconsistent with Sections 106 and 107 of the Copyright Act, with decisions of this Court and lower courts

distinguishing transformative fair use from infringing derivatives, and with the constitutional purpose of copyright. Left unaddressed, the decision would frustrate efforts to provide guidance to authors making use of earlier works and inhibit the publication of new expressive works.

The Second Circuit's decision inverts the relationship between the right to prepare derivative works and fair use's limitation on that exclusive right. By treating derivatives as an "entire class of works" that may infringe on authors' exclusive rights regardless of new expression, meaning, or message, the decision places undue weight on whether a secondary use involves a transformation in form. It also disregards decisions, including *Campbell*, in which a *prima facie* infringement of the derivative work right was not dispositive in the fair use inquiry.

This inversion is inconsistent with the guidance this Court and others have provided to distinguish transformative fair uses from infringing derivatives. In addition to establishing the new expression, meaning, or message of the secondary work, this Court's precedents teach that transformativeness is a matter of degree rather than an all-or-nothing proposition, is only the beginning of the fair use inquiry, and is to be assessed on a work-by-work basis. The Second Circuit's decision ignored these precedents as well as the Court's recent instruction in *Google LLC v. Oracle America, Inc.*, 141 S. Ct. 1183, 1203 (2021), to examine whether a secondary use furthers the creativity objectives of copyright law.

The decision replaces Section 107's nuanced inquiry into the purpose and character of the secondary use with an "overarching purpose and function" test that elevates superficial similarities above the secondary work's expression, meaning, and message. Given its disconnection from the statute and earlier fair use precedents, the uncertainty and unpredictability of the Second Circuit's test would undermine efforts to provide reliable fair use guidance to authors who build on earlier works, diminishing the supply of new expressive works and frustrating the core purposes of the Copyright Act.

ARGUMENT

I. The Second Circuit's Decision Inverts the Relationship Between Fair Use and the Right to Prepare Derivative Works

The Second Circuit's decision turns the relationship between fair use and the derivative work right on its head. Fair use is a limitation on the right to prepare derivative works. Courts do not even reach the issue of fair use unless copyright owners have made out a *prima facie* claim of infringement of the derivative work or other exclusive right under 17 U.S.C. § 106. By characterizing derivative works as an "entire class of secondary works that . . . may nonetheless fail to qualify as fair use" regardless of new expression, meaning, or message, Pet. App. 17a, the Second Circuit effectively treated the derivative work right as a limitation on fair use, rather than fair use as a limitation on the

derivative work right. That court compounded this error by then placing undue weight on whether the secondary use involved a change in form or was recognizably similar to the first work. The Second Circuit's decision departs from *Campbell* and many other cases in which a *prima facie* infringement of the derivative work right precedes, without displacing, the fair use inquiry.

A. The Copyright Act makes the derivative work right "subject to" fair use and other exceptions and limitations.

The Second Circuit was understandably concerned that an "overly liberal standard of transformativeness" risked "crowding out statutory protections for derivative works." Pet. App. 17a. The panel's decision appropriately distinguished between transformation in form and transformation in purpose or character, but improperly treated these two types of transformations as mutually exclusive. In the panel's view, the Prince Series joined "an entire class of secondary works that add 'new expression, meaning, or message' . . . but may nonetheless fail to qualify as fair use" because they are derivative works. *Id*. Goldsmith may have made out a *prima facie* case that the Warhol works infringed the derivative work right because they were substantially similar to the Goldsmith photograph, but the fair use defense remains available under this Court's rulings.

The Copyright Act does not support treating derivative works as exempt from the inquiry into the new expression, meaning, or message of the secondary work. Derivative works and fair uses may be "discrete legal categories," *Keeling v. Hars*, 809 F.3d 43, 49 n.6 (2d Cir. 2015), but they are not mutually exclusive ones. The exclusive right "to prepare derivative works based upon the copyrighted work" is "[s]ubject to" fair use, as well as other statutory limitations and exceptions. 17 U.S.C. § 106. A mirror provision set forth in Section 107 of the Act reflects that limitation: "Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work . . . is not an infringement of copyright." *Id*. § 107; *see also Google*, 141 S. Ct. at 1199 (noting that authors of computer programs enjoy the exclusive right to prepare derivative works but that "[j]ust as fair use distinguishes among books and films, which are indisputably subjects of copyright, so too must it draw lines among computer programs").

When Congress intends an exception to apply to only some of the exclusive rights in Section 106, it says so. *See*, *e.g.*, 17 U.S.C. § 110 (providing limitations to performance and display rights). Its codification of fair use included no such limitation. Thus, declaring that a secondary use is a *prima facie* infringement of the derivative work right precedes but does not preclude the inquiry into the use's new expression, meaning, or message.

B. Many successful fair use rulings, including *Campbell*, have involved *prima facie* infringements of the derivative work right.

When evaluating a fair use claim for a secondary work that has changed the form of the original work, courts have appropriately treated transformation in form and transformation in purpose and character as distinct inquiries. For example, the secondary works in *Seltzer v. Green Day, Inc*., 725 F.3d 1170 (9th Cir. 2013), and *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605 (2d Cir. 2006), both involved transformations in form and arguably were "art reproductions," one of the exemplary derivatives listed in the Act. However, in both cases, the courts looked to the new expression, meaning, and message, or transformative purpose of the secondary work in their assessment of the fair use claim. *See Seltzer*, 725 F.3d at 1176-77; *Bill Graham Archives*, 448 F.3d at 610-11. Whether a secondary work falls within or is close to the exemplary derivatives listed in Section 101 properly informs whether the work is a *prima facie* infringement of the derivative work right. *See* Pamela Samuelson, *The Quest for a Sound Conception of Copyright's Derivative Work Right*, 101 Geo. L.J. 1505, 1527 (2013) (the nine exemplary derivatives inform the scope of the right to prepare derivative works); *see generally* R. Anthony Reese, *Transformativeness and the Derivative Work Right*, 31 Colum. J.L. & Arts 467 (2007) (analyzing transformativeness and transformation in fair use and derivative work cases). However, even when the

secondary work is a clear derivative work, courts have been able to distinguish a transformation in form for purposes of the derivative work right with transformativeness for purposes of Section 107. *See*, *e.g.*, *Lombardo v. Dr. Seuss Enters. L.P.*, 279 F. Supp. 3d 497 (S.D.N.Y. 2017) (dramatization of a children's book held to be fair use).

The recognizability of the original works in the alleged infringing derivatives also did not undermine the fair use defense in these cases. Indeed, "[r]ecognizability is often the pivot of creativity rather than its antithesis." Oren Bracha, *Not De Minimis*, 68 Am. U. L. Rev. 139, 186 (2018). The "street-art focused music video" in *Seltzer* required that the original work was identifiable as street art. *Seltzer*, 725 F.3d at 1176. Certain fair uses, such as parodies or reimplementing application programming interfaces, turn on recognizability and the use of essential elements of the original work. *See Campbell*, 510 U.S. at 588; *Google*, 141 S. Ct. at 1203. The Second Circuit overlooked these precedents when it placed decisive weight on whether "the secondary work remains both recognizably deriving from, and retaining the essential elements of, its source material." Pet. App. 23a-24a.

Even fair use cases involving no transformation in form have involved *prima facie* infringements of the derivative work right. *Campbell* begins its analysis by noting that it was "uncontested here that 2 Live Crew's song would be an infringement of Acuff-Rose's rights in 'Oh, Pretty Woman,' under the Copyright Act of 1976, 17 U.S.C. Section 106 but for a finding of fair use

through parody." 510 U.S. at 574. In the footnote accompanying this sentence, the Court included not only the rights enumerated in Section 106 but also the Act's definition of "derivative work" in Section 101. *Id.* at n.4. The Court also discussed the potential market for "rap derivatives" of the original. *Id.* at 590, 593.

Similarly, in *Suntrust Bank v. Houghton Mifflin Co.*, the Eleventh Circuit noted that the copyright owner of *Gone With the Wind* had licensed at least two derivative literary works based on the original work. 268 F.3d 1257, 1274 (11th Cir. 2001). The secondary work fell in the broad category of derivative literary works and was recognizably similar to the first, but its transformative use of elements of the original overcame whatever effect that label might have. *See id.* at 1272 (discussing the "transformative uses of elements of [*Gone With the Wind*] in [*The Wind Done Gone*]"). The Second Circuit's decision in *Blanch v. Koons*, 467 F.3d 244 (2d Cir. 2006), likewise suggested that the secondary work fell within a general category of derivative works. The court described the secondary work, which like Warhol's Prince Series was a work of visual art, as an "adaptation" of Blanch's photograph. *Id*. at 253. It nonetheless found the use was transformative given the "changes of its colors, the background against which it is portrayed, the medium, the size of the objects pictured, the objects' details and, crucially, their entirely different purpose and meaning." *Id*.

Collectively, these cases establish that transformation within the meaning of the derivative work right and transformativeness in the fair use inquiry

are separate, distinct inquiries. A secondary work can be both a derivative work and a fair use even if courts use one term or the other as shorthand for the success or failure of a fair use defense, just as it can be both a reproduction and a fair use, or a public performance and a fair use. By characterizing derivative works as an "entire class" separate from fair use regardless of the secondary work's expression, meaning, or message, the Second Circuit's decision reverses the statutory relationship between exclusive rights and limitations on those rights, making the derivative work right a limitation on fair use. This inversion is unsupported by the Act and unnecessary in view of this Court's guidance in distinguishing transformative fair uses from infringing derivatives.

II. This Court's Guidance About How to Distinguish Transformative Fair Uses and Infringing Derivatives Went Unheeded

Amicus discerns in this Court's most recent fair use rulings, *Campbell* and *Google*, significant guidance about how courts can distinguish transformative fair uses and infringing derivative works. As this Court now reviews the *Goldsmith* decision, it should bear in mind several lessons from its prior rulings.

The first and most important lesson is that a key test of transformativeness is whether a secondary work has a "new expression, meaning, or message," the presence or absence of which makes a finding of fair use more or less likely. *Campbell*, 510 U.S. at 579;

Google, 141 S. Ct. at 1202. If a secondary work does not contribute new expression, meaning, or message, the use may be considered non-transformative, which may tilt the calculus against fair use.

Second, *Campbell* recognized that transformativeness is a matter of degree. The more transformative a secondary work is, the more likely is a finding of fair use. Conversely, the more modest the transformative purpose is, the more weight will be accorded to other factors when determining whether the use was fair or infringed the derivative work right. Transformativeness is not an all-or-nothing concept.

Third, *Campbell* directed courts to consider the transformativeness of a secondary use in relation to the other fair use factors. If a secondary user has taken more than was reasonable in light of a transformative purpose, usurped an actual or derivative market, or otherwise engaged in wrongful conduct, a transformative purpose may not suffice to save a challenged use from being found an infringing derivative.

Fourth, numerous decisions interpret *Campbell* as requiring courts to engage in a work-by-work assessment of transformativeness and of fair use. The Second Circuit treated the Prince Series as one work and decided against transformativeness and fair use as to all sixteen works as if they were a single work.

Fifth, this Court's *Google* decision directed courts to distinguish transformative fair uses from infringing derivatives by assessing whether a secondary use has

enabled ongoing creativity that fulfills the constitutional purpose of copyright.

A. This Court has directed courts to assess whether a secondary work has a "new expression, meaning, or message" and hence is transformative.

This Court's *Google* decision reaffirmed *Campbell*'s directive that courts in fair use cases consider "whether the copier's use 'adds something new, with a further purpose or different character, altering' the copyrighted work 'with new expression, meaning or message.'" *Google*, 141 S. Ct. at 1202 (quoting *Campbell*, 510 U.S. at 579). The *Google* decision agreed with Judge Leval that courts should ask whether the secondary use "fulfill[s] the objective of copyright law to stimulate creativity for public illumination." *Google*, 141 S. Ct. at 1203 (quoting Pierre N. Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105, 1111 (1990)). In answering that question, the Court noted that it had "used the word 'transformative' to describe a copying use that adds something new and important." *Google*, 141 S. Ct. at 1203 (citing *Campbell*, 510 U.S. at 579).

While the Second Circuit did say that new expression, meaning, or message is the "*sine qua non* of transformativeness," Pet. App. 16a, it did not actually apply this test in its fair use analysis. *Id.* at 17a. In fact, it expressly criticized the lower court for having concluded that the Warhol works were transformative

because they had a different meaning or message than Goldsmith's photograph. *Id*. at 22a. The Second Circuit accepted that Goldsmith's "subjective intent [may have been] to portray Prince as a 'vulnerable human being' and Warhol's to strip Prince of that humanity and instead display him as a popular icon." *Id.* But that court insisted that transformativeness "cannot turn merely on the stated or perceived intent of the artist or the meaning or impression that a critic—or for that matter, a judge—draws from the work." *Id*. Its examination of the new expression, meaning, or message of the secondary work ended there.

Campbell emphasized that the proper inquiry was whether a new meaning or message to support a finding of transformativeness could "reasonably be perceived" in the secondary work. *Campbell*, 510 U.S. at 582. Works of visual art, such as the Warhol prints, do not necessarily have one settled message or meaning, so it is necessary to consider what the artist and members of the relevant artistic community, among others, could reasonably perceive the work's message or meaning to be.

B. In keeping with *Campbell* and its progeny, courts treat transformativeness as a matter of degree rather than an all-or-nothing proposition.

This Court in *Campbell* recognized that transformativeness is a matter of degree. For instance, it stated that Campbell's song could reasonably be

viewed as having a parodic message "to some degree." *Campbell*, 510 U.S. at 583. The Court observed that "the more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use." *Id.* at 579.

In keeping with *Campbell*'s sliding scale conception of transformativeness, courts have sometimes characterized a secondary use as only modestly or somewhat transformative. *See*, *e.g.*, *Fox News Network, LLC v. TVEyes, Inc.*, 883 F.3d 169, 178 (2d Cir. 2018) (TVEyes' uses of Fox News programs were "somewhat transformative"); *Sony Computer Entm't, Inc. v. Connectix Corp.*, 203 F.3d 596, 606 (9th Cir. 2000) (Connectix's reverse-engineered copies of Sony code were "modestly transformative").

At the other end of the spectrum, courts have found some uses of in-copyright materials, even those that involved exact copying of the entire contents of protected works, to be "highly transformative" because of the very different purpose the second author had in making use of the first work.[2] *See*, *e.g.*, *Authors Guild*

[2] Adding new expression, meaning, or message is not the only way that a use may be considered transformative. When a second author uses a first author's work for a different purpose or in a different context, transformativeness may be found. *See*, *e.g.*, *Authors Guild*, 804 F.3d at 216 n.17 (listing exemplary cases); *see also A.V. ex rel. Vanderhye v. iParadigms, LLC*, 562 F.3d 630, 638 (4th Cir. 2009) ("A 'transformative' use is one that 'employ[s] the quoted matter in a different manner or for a different purpose from the original,' thus transforming it.") (quoting Leval, *supra*, at 1111). The Second Circuit, however, imposed a more restrictive

v. Google, Inc., 804 F.3d 202, 216-17 (2d Cir. 2015) (copying of books to enable search functions was "highly transformative"); *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1165 (9th Cir. 2007) (thumbnail-sized images of photographs to enable search functions on the Internet held "highly transformative").

Of course, sometimes courts characterize a secondary use as transformative without qualifying adverbs. Applying the "new expression, meaning, or message" test for transformativeness, courts have often found a later visual artist's use of another artist's images to be transformative fair uses. *See*, *e.g.*, *Cariou v. Prince*, 714 F.3d 694, 708 (2d Cir. 2013); *Leibovitz v. Paramount Pictures Corp.*, 137 F.3d 109, 114 (2d Cir. 1998); *see also Seltzer*, 725 F.3d at 1177-78; *Blanch*, 467 F.3d at 253.

In *Goldsmith*, the Second Circuit recognized that Warhol had added to the works in the Prince Series some characteristic elements unique to the artist's style and a "distinct aesthetic sensibility." Pet. App. 24a. Yet, despite this, the court did not recognize any degree of transformativeness and instead merely concluded that "viewing the works side-by-side . . . the Prince Series is not 'transformative' within the meaning of the first factor." *Id.*

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standard, insisting that the second author's purpose must be "fundamentally different and new." Pet. App. 23a (quoting *Cariou*, 714 F.3d at 706).

C. Transformativeness is generally the beginning, not the end, of a fair use inquiry.

This Court in *Campbell* acknowledged that just because a secondary use is transformative, that does not necessarily mean the use will be found fair. Claiming a parodic purpose, for instance, does not allow the user to "skim the cream and get away scot free." *Campbell*, 510 U.S. at 589. Rather, this Court directed courts to consider evidence relevant to all four fair use factors and consider the factors "in light of the purposes of copyright." *Id.* at 578.

Campbell noted that the "central purpose" of inquiring whether a secondary work is transformative is "to see . . . whether the new work merely 'supersede[s] the objects' of the original creation." *Id.* at 579 (quoting *Folsom v. Marsh*, 9 F. Cas. 342, 348 (1841)). This Court perceived a clear linkage between the purpose and harm factors. When a second use is transformative, the Court observed that "market substitution is at least less certain, and market harm may not be so readily inferred." *Campbell*, 510 U.S. at 591. For some types of uses, such as "parody pure and simple, it is more likely that the new work will not affect the market for the original in a way cognizable under this factor, that is, by acting as a substitute for it." *Id.* When two works "serve different market functions," *id.*, the market harm factor weighs less heavily. The Second Circuit did not give appropriate weight to the substantially different market functions that the works at issue in *Goldsmith* serve.

Campbell offered an example of the interplay among the factors, explaining that whether

> "a substantial portion of the infringing work was copied verbatim" from the copyrighted work is a relevant question, for it may reveal a dearth of transformative character or purpose under the first factor, or a greater likelihood of market harm under the fourth; a work composed primarily of an original, particularly its heart, with little added or changed, is more likely to be a merely superseding use, fulfilling demand for the original.

Id. at 587-88 (citation omitted) (quoting *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 565 (1985)).

A work can be transformative and yet be an unfair infringement of the derivative work right under some circumstances. For example, the secondary work may have drawn too heavily upon the original work or supplanted demand for a market that the plaintiff might foreseeably enter. In *Fox News Network v. TVEyes*, for instance, the Second Circuit agreed that TVEyes had a transformative purpose by making copies of Fox News programs efficiently and conveniently accessible in response to client searches, but decided TVEyes took too much and harmed the market because "the Watch function allows TVEyes's clients to see and hear virtually all of the Fox programming that they wish . . . [and] usurped a function for which Fox is entitled to demand compensation under a licensing agreement." *Fox News Network*, 883 F.3d at 178, 181. *See also Castle*

Rock Entm't, Inc. v. Carol Publ'g Grp., Inc., 150 F.3d 132, 142-43 (2d Cir. 1998) (publisher of *The Seinfeld Aptitude Test* drew too heavily upon the characters, dialogue, and scenes from the popular television show in formulating questions and answers, even though it added new expression in some questions).

Uses may also be transformative, yet other considerations, such as wrongful conduct, may defeat a claim of fair use. In *Monge v. Maya Magazines, Inc.*, 688 F.3d 1164, 1183-84 (9th Cir. 2012), for instance, the court was persuaded that the publication of wedding photos of a popular singer was minimally transformative, but the publisher knew the photographs were unpublished, its use of them was commercial, and the use supplanted the market the plaintiff could have exploited. Hence, the publication of the photographs was unfair. These decisions underscore the importance of a balanced and nuanced undertaking of the fair use analysis.

D. Fair use, as well as transformativeness, should be assessed on a work-by-work basis.

The Second Circuit failed to analyze the transformativeness, as well as the overall fairness, of the sixteen Warhol works at issue on a work-by-work basis. Instead, the Second Circuit directed its analysis to Warhol's Prince Series as a whole, Pet. App. 24a, even though each is a distinct work and has different

characteristics and expressions.[3] *See* Pet. Br. 19 (showing the sixteen Warhol works side-by-side). Under the "new expression, meaning, or message" criterion, at least some, and probably all, of the sixteen Warhol works at issue should have been considered transformative, some perhaps more than others.

In many post-*Campbell* cases, courts have taken care to analyze fair use on a work-by-work basis. This was true in the Second Circuit's decision in *Cariou*, 714 F.3d at 706-11, in which the court concluded that twenty-five of the Prince paintings derived from Cariou's photographs were transformative fair uses as a matter of law, but remanded five others for further consideration of Prince's fair use defense. *See also Cambridge Univ. Press v. Patton*, 769 F.3d 1232, 1251-52 (11th Cir. 2014) (recounting the trial court's assessment of fair use as to each of the book chapters claimed as infringements); *Am. Soc'y for Testing & Materials v. Public.Resource.Org, Inc.*, No. 13-cv-1215 (TSC), 2022 WL 971735 at *17 (D.D.C. Mar. 31, 2022) (finding fairness as to 184 standards in their entirety plus specified portions of 1 standard out of 217 total industry standards), *appeal filed*, No. 22-7063 (D.C. Cir. Apr. 29, 2022).

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[3] Nor did the Second Circuit acknowledge that at least one of the Warhol works was an authorized derivative of the Goldsmith photograph, as Vanity Fair gave it to him as an "artist reference" and commissioned him to create a new work for its magazine.

E. Consistent with *Google*, it is important to consider whether Warhol's use of the Goldsmith photograph furthered the creativity objectives of copyright law.

As this Court's *Google* decision reiterated, an important consideration when courts try to distinguish fair uses from infringing derivatives is whether the challenged use "was consistent with that creative 'progress' that is the basic constitutional objective of copyright itself." *Google*, 141 S. Ct. at 1203; *see also Campbell*, 510 U.S. at 575.

Like Goldsmith, Oracle insisted that the challenged use was a non-transformative infringement of the derivative work right. Brief for Respondent at 18-19, *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183 (2021) (No. 18-956). Oracle argued that to qualify for fair use, a secondary work must be "different in kind from the transformation inherent in adapting a work to create a derivative, or else fair use would swallow the derivative-work right." *Id.* at 40. Oracle characterized the Android smartphone platform as "a sequel that adapted Oracle's software for an improved generation of devices." *Id.* at 41. This is similar to *Goldsmith*'s concept of transformativeness as limited to the creation of new works that have "a 'fundamentally different and new' artistic purpose" than the original, as well as the court's characterization of the Prince Series as a likely derivative work which, in the panel's view, foreclosed a transformative fair use defense. Pet. App. 23a-24a.

However, this Court rejected Oracle's argument, holding that Google's use of the Java API elements in Android was "highly creative and innovative" and enabled programmers to use their acquired skills with Java to create many new programs for that platform. *Google*, 141 S. Ct. at 1203. The Court in *Google* did so while mindful that copyright law is concerned with "the creative production of new expression." *Id.* at 1206. This Court should likewise reject the *Goldsmith* decision's effort to dramatically narrow the scope of what can be considered transformative for fair use purposes and consider whether Warhol's works are consistent with copyright's constitutional objectives.[4] As *Campbell*, its predecessors, and its progeny have long observed, the fair use doctrine "permits [and requires] courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster." *Campbell*, 510 U.S. at 577 (quoting *Stewart v. Abend*, 495 U.S. 207, 236 (1990)) (alteration in *Campbell*).

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[4] The Second Circuit was sufficiently troubled by Goldsmith's claims that it announced that Goldsmith could only recover money damages for the Foundation's commercial licensing of the Warhol works. Pet. App. 42a. It thereby implicitly ruled that Warhol's copyrights would remain intact, that museums and galleries would be free to continue to display Warhol's works, and that reproducing these works in books about Warhol and his oeuvre would be unaffected by its decision. This was an effort to achieve a Solomonic resolution of the dispute, but there is no such thing as a partial fair use. If Warhol's works are infringing derivatives of Goldsmith's photograph, as the Second Circuit suggests, then Warhol's copyrights are invalidated as a matter of law under 17 U.S.C. § 103(a).

III. The Second Circuit's Focus on "Overarching Purpose and Function" Is Inconsistent with the Copyright Act and Would Make Fair Use Determinations Less Certain

The Second Circuit's novel tests for transformativeness deviate significantly from this Court's precedents and would shrink the scope of what can be considered "transformative" in fair use cases. For nearly three decades, *Campbell*'s "new expression, meaning, or message" inquiry has been the precedential test for fair use. *See Google*, 141 S. Ct. at 1202-03 (quoting and applying test). Despite this, the Second Circuit held that for a secondary user's work to be considered transformative, "the secondary work itself must reasonably be perceived as embodying a distinct artistic purpose[.]" Pet. App. 22a. It also stated that the Prince Series was not transformative because it shared the same "overarching purpose and function" as Goldsmith's photograph, *id.* at 24a, adding that "viewing the works side by side, . . . the Prince Series is not 'transformative.'" *Id.* These statements make it difficult to ascertain the test or tests for transformativeness in the *Goldsmith* decision. Regardless, the framework deviates significantly from the one this Court articulated in *Campbell*, and would operate as a more stringent standard than the "new expression, meaning, or message" test.[5] The various tests the Second Circuit employed for assessing transformativeness would preclude many

[5] Indeed, the District Court in this case found Warhol's works in the Prince Series to be transformative under *Campbell*'s "new meaning or message" test. Pet. App. 69a-72a.

uses considered fair under *Campbell*. In particular, nonfiction authors would be less able to rely on fair use when drawing from existing works to create new works of authorship that advance public knowledge.

Goldsmith's standard for transformativeness poses two problems. First, the Second Circuit's decision substitutes "overarching purpose and function" for "purpose and character," departing from the language of the Copyright Act. The court failed to recognize that a secondary user can use parts of an existing work for the same *function*, such as when nonfiction authors draw on others' works to enrich the public's understanding of a given topic, and still be making a transformative fair use. It is when the secondary work's use shares the same purpose and character as the first that courts are likely to find that a use is not transformative.

Second, the proposed standards for transformativeness are untenably vague and unworkable for authors who rely on the fair use doctrine to create new works of authorship in the same genre of works from which they draw. Fair use can already be unpredictable for creators due to its context-sensitivity. Injecting additional uncertainty into the doctrine would chill creative expression. Authors Alliance represents the interests of authors, predominantly authors of nonfiction works, who would be harmed by the application of the *Goldsmith* framework. The uncertainty the alternative tests bring about would undermine Authors Alliance's ability to provide sound guidance to authors about the bounds of fair use.

A. Nothing in the Copyright Act or this Court's precedents supports substituting " overarching purpose and function" for Section 107's "purpose and character."

The Second Circuit's analysis of the Prince Series' transformativeness is inconsistent with Section 107's text. Rather than considering the "purpose and character of the use," the court focused its inquiry on "the overarching purpose *and function* of the two works[.]" Pet. App. 24a (emphasis added).[6] The court considered "purpose" at a "high level of generality," *id.* at 20a, and treated "function" as similar if not equivalent to "form." *Id.* at 24a. It concluded that Warhol's prints were not transformative because they served the same overarching purpose and function—being works of art and depictions of Prince—as Goldsmith's photograph. *Id.* at 24a-25a. But the function or form of a work is not a consideration under Section 107, nor does a focus on the overarching, high-level purpose of a work have any basis in this Court's fair use precedent. For instance, 2 Live Crew's song served the same function and overarching purpose as Roy Orbison's song in *Campbell* in that both were popular songs, but the parodic *character* of the use was what made it transformative. 510 U.S. at 582.

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[6] In addition to this misstatement, the Second Circuit further muddied the waters of the fair use inquiry by considering the overarching purpose and function of the two *works* rather than the two *uses*.

This Court's recent decision in *Google* demonstrates that a focus on "overarching purpose and function" is improper in fair use analysis, and shows how considering overarching purpose and function in lieu of purpose and character could shrink the scope of fair use. In that case, Google copied "portions of the Sun Java API . . . in part for the same reason that Sun created those portions, namely, to enable programmers to call up implementing programs that would accomplish particular tasks." 141 S. Ct. at 1203. In other words, Google used the relevant code for precisely the same overarching purpose as Oracle to produce a work of the same form. Yet this Court observed that because "virtually any unauthorized use of a copyrighted computer program (say, for teaching or research) would do the same, to stop here would severely limit the scope of fair use in the functional context of computer programs." *Id.*

Fair use decisions considering secondary uses in the context of other types of works further demonstrate the Second Circuit's error. In *Tresóna Multimedia, LLC v. Burbank High School Vocal Music Ass'n*, the Ninth Circuit considered the transformativeness of a high school choir's performance of portions of popular songs. 953 F.3d 638, 649-50 (9th Cir. 2020). Even though the secondary work took the same form as the first work and used the portions for the same overarching purpose as the original work—as expressive content in a song—the court concluded that the use was transformative based on its purpose and character. *Id.* at 652. Similarly, in *Fioranelli v. CBS Broadcasting,*

Inc., a court concluded that one of the uses of video footage of the events surrounding 9/11, in a film about the making of a 9/11 docudrama, was a transformative fair use based on "the different purposes of the two works," despite the fact that each functioned as a film clip. 551 F. Supp. 3d 199, 242 (S.D.N.Y. 2021).

Another example is *Suntrust Bank*, in which the Eleventh Circuit considered whether the creation of a literary "critique of [*Gone With the Wind*]'s depiction of slavery and the Civil–War era American South" was fair use. 268 F.3d at 1259. Its author took many parts of *Gone With the Wind* and used them for the same function and overarching purpose—namely, as part of a commercial, fictional literary work. Yet the court held the purpose and character of the use weighed in favor of the secondary user. *Id*. at 1271. This finding was due largely to the work's clear "parodic *character*," *id.* at 1269 (emphasis added), and that court's proper focus on the purpose and character of the use. As in *Google* and *Tresóna*, the similarities in the functions and forms of these works did not cut against fair use.

A focus on "overarching purpose and function" rather than the "purpose and character" of secondary uses would undermine fair use norms for authors of nonfiction literary works. Many nonfiction authors rely on fair uses when drawing upon other nonfiction works when the subsequent works have the same form and same "overarching purpose and function," Pet. App. 24a, in contributing to the progress of knowledge.

B. An "overarching purpose and function" standard would make fair use less certain for authors of nonfiction works.

Nonfiction authors depend on fair use to create new works of authorship drawing on others' creations and contribute to scholarly discourse. While fair use determinations are not entirely predictable, authors generally understand that under *Campbell* a secondary work's new expression, meaning, or message tips the first statutory fair use factor in their favor. Under *Goldsmith*, that factor—if not the entire fair use inquiry—turns instead on the secondary use's overarching purpose and function. That standard is not workable for nonfiction authors, particularly those who draw from earlier works on the same topic or in the same genre.

The Second Circuit's focus on overarching purpose and function would undermine decisions such as *Wright v. Warner Books*. In that case, the Second Circuit considered whether an author's use of unpublished letters and journal entries written by novelist Richard Wright in a biography about Wright constituted fair use. 953 F.2d 731, 734 (2d Cir. 1991). Finding that the purpose and character of the use weighed in favor of fair use, the court explained that the biography used the quotations for a different purpose than Wright wrote them, namely to "illustrate factual points or to establish [the biographer's] relationship with the author." *Id.* at 740. The court concluded that the use "further[ed] the goals of the copyright laws by adding value to prior intellectual

labor[.]" *Id.* at 736. This was the sort of "new expression, meaning, or message" that under *Campbell* would be considered transformative.

The *Goldsmith* decision is also at odds with *Maxtone-Graham v. Burtchaell*. There, the Second Circuit considered whether a nonfiction essay critical of abortion made a fair use of a book of interviews with women who had undergone abortions. 803 F.2d 1253, 1255-56 (2d Cir. 1986). In the first work, "the interviewees 'told their stories in order to further understanding of the Pro-Choice view,'" *id.* at 1257, and in the second, the author's stated purpose was to "critique the published accounts of 'abortion veterans'" and "offer a framework for analysis of the women's experiences." *Id.* at 1256. But "at a high level of generality" under *Goldsmith*, Pet. App. 20a, both works in this case took the same form—nonfiction books—and shared the overarching purpose of educating readers about "the public debate on abortion[.]" *Maxtone-Graham*, 803 F.2d at 1256. Regardless, the court found the different meaning and purpose of the secondary use weighed in favor of fair use.

Under the Second Circuit's framework in *Goldsmith*, which found the secondary use had the same overarching purpose or function as the first, "in the broad sense that they are . . . works of visual art" and "in the narrow but essential sense that they are portraits of the same person," Pet. App. 24a-25a, decisions such as *Wright* and *Maxtone-Graham* might have come out differently. The unpublished journal entries and letters and the subsequent biography in *Wright* were

created as expressive literary works "in the broad sense," and both the unpublished writings and the biography were about the same person "in the narrow sense." The interviews and essays in *Maxtone-Graham* were also expressive literary works "in the broad sense" and both about the same specific topic "in the narrow sense." Yet the secondary uses in both cases made important contributions to the understanding of historical people and topics of public debate. The Second Circuit's new test thus creates an unworkable standard that threatens an author's ability to rely on fair use to contribute to the public's understanding of important topics.

If upheld, the panel's decision would make fair use determinations less certain and chill free expression by authors who incorporate existing works into new ones. In *Shloss v. Sweeney*, author Carol Shloss filed a declaratory judgment action against the James Joyce estate, alleging that Shloss's publisher had made the decision to remove unpublished writings by Joyce and his daughter from her manuscript on Joyce, following a barrage of letters of protest from the estate. 515 F. Supp. 2d 1068, 1074 (N.D. Cal. 2007). Despite the author and publisher's beliefs that the use of these writings were fair uses, *id.* at 1073, the threat of litigation was sufficient to lead the publisher to adopt a risk-averse stance. Following the work's publication, contemporaneous reviews were critical of the work, "remark[ing] on [the author's] lack of documentary support for her theories." *Id*.

Because Shloss was not able to rely on fair use or obtain permission to use the writings, her scholarship suffered. Further, her writings did not make as strong of a contribution to the understanding of Joyce as they would have otherwise. *Cf. Wright*, 953 F.2d at 740 (use of unpublished writings in a Richard Wright biography "contribute[d] to the public's understanding of this important Twentieth Century novelist"). In this way, constricted interpretations of fair use work against the aims of the Copyright Act, with a particularly detrimental effect on authors' ability to contribute to public understanding of important topics.

As *Shloss* shows, an author's hesitancy to rely on fair use despite a good faith belief that the use is fair can weaken that author's scholarship and diminish the public's benefit from it. Even before the Second Circuit's decision, large upfront costs, delayed returns, and the potentially devastating effect of an injunction have caused nonfiction authors and other secondary users to take a conservative approach to fair use even when they believe the law is with them. *See* James Gibson, *Risk Aversion and Rights Accretion in Intellectual Property Law*, 116 Yale L.J. 882, 890-891 (2007). If upheld, the Second Circuit's decision would undermine reliance on fair use and leave more authors in Carol Shloss's position.

The *Goldsmith* decision, if left undisturbed, would also impair the efforts of organizations like Authors Alliance that provide guidance to authors in making fair use determinations. Authors Alliance has published two separate guides designed to help nonfiction

authors understand fair use and how to clear permissions when uses are not permitted under fair use. Brianna L. Schofield & Robert Kirk Walker, *Fair Use for Nonfiction Authors* (2017), https://perma.cc/QH39-Q9RH; Rachel Brooke, *Third-Party Permissions and How to Clear Them* (2021), https://perma.cc/WB8S-VJE5. The Second Circuit's requirement that a secondary use must have a different overarching purpose and function has the potential to make fair use determinations much more difficult and undermine Authors Alliance's ability to provide sound fair use guidance to authors.

By limiting an author's ability to "add[] value to prior intellectual labor," *Wright*, 953 F.2d at 736, the Second Circuit's decision constricts the breathing space in copyright necessary to facilitate the development of new, creative works. In this way, the *Goldsmith* framework in fact works against the "creative 'progress' that is the basic constitutional object of copyright itself." *Google*, 131 S. Ct. at 1203 (citing *Feist Publ'ns v. Rural Tel. Serv. Co.*, 499 U.S. 340, 349-50 (1991)).

CONCLUSION

For the foregoing reasons, the Second Circuit's judgment should be reversed.

Respectfully submitted,

On the Brief

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