

## SCOTUS flinches at ‘extremes’ in Warhol ‘Prince’ case

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**Justices dance around the middle ground in fair use showdown | Court’s decision could ‘impact everything from the mundane to the sublime’ | Crowell & Moring | Sterne Kessler.**

The US Supreme Court is likely to find a middle ground between the two arguments set forth in a controversial copyright case involving the use of a photograph of Prince, lawyers have told *WIPR*.

Yesterday, the court heard oral arguments in *Andy Warhol Foundation for the Visual Arts v Goldsmith*, a case that could determine the application of the ‘fair use’ legal doctrine, and the definition of a ‘transformative’ work.

During the hearing, the court examined the Foundation’s view that artist Andy Warhol’s creation of 16 images of the late musician using a copyrighted photograph imbued the image with new expression, meaning, or message.

According to this argument, the work is transformative and qualifies as a new work under the 'fair use' doctrine. Photographer Lynn Goldsmith countered that the doctrine focuses on purpose, and requires the copier to provide an explanation and justification for using another's expression.

If the Foundation's definition of transformative is upheld, Goldsmith's counsel argued that the precedent would be "too easy to manipulate", placing copyrights at the mercy of infringers.

## **Tensions**

According to Bill Frankel, partner at Crowell & Moring, the court grappled with the need to protect copyright, while also enabling others to build on pre-existing works in creative pursuits.

"From the outset, the justices seemed to be struggling with where to draw the line between fair uses and derivative uses, the latter being controllable by the original copyright owner," he noted.

Justice Elena Kagan, Chief Justice Stephen Roberts, and Justice Ketanji Brown Jackson questioned Goldsmith's reading of *Campbell v Acuff Rose* as requiring the second work to comment on the original.

Justice Clarence Thomas asked for an example of a follow-on work that would *not* meet the Foundation's transformation test, while Justice Sonia Sotomayor, Chief Justice Stephen Roberts, and Justice Kagan all questioned why such derivative works couldn't be argued to present new expression and meaning.

Noted Frankel: "In one exchange with Justice Luis Estrella Martinez, Justice Sotomayor seemed to agree that the Second Circuit was wrong to conclude that there was nothing fundamentally different and new in the Prince Series images, but she rejected the notion that 'transformation standing alone' qualified as fair use."

And Justice Jackson noted that any visual artist can argue after the fact that their use involved communicating a new message through their work.

## **A grey area**

Frankel's colleague Preetha Chakrabarti, partner at Crowell & Moring, agreed that the Justices addressed the "meaty issues" of this case, while also having some fun, most notably when Justice Thomas raised chuckles after expressing admiration for Prince.

Laughs aside, she noted that it was clear that the court was seeking more guidance on how to understand "a change in meaning and message", in a piece of work.

"It almost seemed as though the court was considering some sort of spectrum of use, from derivative use that inures to the benefit of the copyright holder, to completely transformative use that is considered 'fair', and finding the grey space between those sides of the spectrum in need of greater clarity," she explained.

## **The middle ground**

According to Will Milliken, director in the trial and appellate practice group at Sterne Kessler the court appeared to be more attracted to the middle ground when it came to both arguments.

He noted that while predicting outcomes based on oral argument is a notoriously fraught business, the most extreme versions of both parties' legal tests received "significant pushback".

Instead, Milliken observed that the court seemed to be attracted to something along the lines of the test offered in the government's *amicus brief*, which argued that use must be "necessary or at least useful to make the second author's own expression clearer or more effective".

"It seems unlikely, therefore, that the court ends up adopting the strongest articulation of the Foundation's position that any work that can reasonably be perceived to convey a new message or meaning is transformative and presumptively fair use," he explained.

Similarly, the court is unlikely to endorse the strongest articulation of Goldsmith's position, that a use is transformative only when copying is strictly necessary to accomplish a distinct creative end from that of the original, added Milliken.

"If the court were to adopt such a middle-ground approach, the court could simply affirm the Second Circuit's decision that *Orange Prince* was not fair use or send the case back for the Second Circuit to apply whatever test the Supreme Court announces," said Milliken.

### **Back to the Second Circuit?**

Several Justices, noted Milliken, asked questions about this remedial issue towards the end of the argument.

"This focus on remedy, too, suggests that the court may not be inclined to fully endorse either the Foundation's or Goldsmith's position, since the remedial consequence of either extreme position would be quite obvious—reversal in the former case and affirmance in the latter," he explained.

Chakrabarti agreed that it was possible that the court may send the case back to the Second Circuit in search of clarity.

"Either way, artists and creators of all stripes will be watching closely for the outcome as it could impact everything from the mundane, for example, licensing rights, to the sublime, ie, who decides what 'art' is."

On balance, Chakrabarti noted that the Justices seemed to recognise Warhol's creative artistic enhancements to the Goldsmith photo as being more than a bare appropriation.

"They also seemed less inclined to adopt the rigid justification requirement advocated by Goldsmith,<sup>1</sup> albeit, disinclined to adopt an untethered transformation test," observed Chakrabarti.

"The court may attempt to reign in the transformation test by incorporating an objectively reasonable assessment of artistic or new expression rather than reliance on the subjective views of the creator or other individuals," she concluded.