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COMMENT ON ANDY WARHOL FOUNDATIONS FOR THE VISUAL ARTS, INC. v. LYNN GOLDSMITH AND ORS (SUPREME COURT OF UNITED STATES)

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Abstract

The defense of Fair Use is one commonly raised in every possible trademark infringement across various jurisdictions. The factors construing a use as fair are also common and come down to four. A follow-on work is considered fair use only if it satisfies those four factors. The most critical factors among them are purpose and character of use. With the passage of time, the court developed the "meaning or message test" to determine the transformative nature of a use. Through the years, this defense has undergone several other alterations by different courts of law. A comment on fair use is never confined to a particular jurisdiction but rather has a sizeable effect on others too. Moreover, the provisions of the Copyright Act of India as well as those of the United States run parallel to each other. Thus, the case under analysis may have a primary position in future findings on similar domestic issues. The Supreme Court of the United States commented on the fair use defense and the purpose of rival works in the matter of Andy Warhol Foundations for the Visual Arts, Inc. versus Lynn Goldsmith and Ors. The Court opines in favor of the copyright owner's exclusive right to prepare derivative work over a use that adds new expression and meaning. It limits the power of the courts to assume the role of art critic and analyze the meaning of follow-on work. This may have a toll on artists as well as on art in general.

Keywords: Fair use, copyright infringement, purpose, Orange Prince, exclusive rights

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1. INTRODUCTION

The Supreme Court of the United States revisited the doctrine of fair use and certainly stirred things up a little bit in various other jurisdictions. Since the copyright provisions of US as well as Indian laws run parallel to one another, India is not spared from the effect of judgment in *Warhol'*s matter. The case under analysis involves two great artists, namely Andy Warhol and Lynn Goldsmith, who were famously known for their silk screen portraits and photographs, respectively. Art has been equally fair to them and to their works. The dispute revolves around the defense of fair use and mainly the first factor of fair use, "the purpose and character of the use". The principal factor of fair use is the purpose of the use, which was wrongfully connected to the fourth factor, i.e., market harm caused to the original creator. The Apex Court ruled in favor of the original creator, thus undermining the value of art and denying the rightful defense of fair use to the creator of derivative work. The pragmatic approach of the Court supersedes the exclusive rights of the copyright owner over creativity and freedom.

2. FACTS

Andy Warhol Foundation for the Visual Arts, Inc. is the Appellant which was established by the renowned visual artist Andy Warhol. He was well known for his silkscreen portraits of Monroe, which were created in 1967. Warhol's works are found in the premier collections in the Museum of Modern Art in New York and across the world. On the other hand, Lynn Goldsmith is the Respondent herein, who is an award-winning rock and roll photographer. She captured the 20th century's greatest pop artists, such as Bob Dylan, Roger Daltrey, Mick Jagger, Patti Smith, and so on. Goldsmith's works are often used as reference photographs in articles about the lives of the musicians, which were published in *Rolling Stone, People Magazine and Time.*

In 1981, the Respondent shot a photoshoot with the then-upcoming musician Prince Roger Nelson (popularly known as Prince), and it was featured in *Newsweek.* She owns the copyright to all her works and licenses them to different magazines under certain conditions. In 1984, *Vanity Fair* licensed one of the Respondent's photograph of Prince, which were to be used as an artist reference in its November issue, and the Respondent accepted the offer upon the condition that her photo would be used "only once". The *Vanity Fair* hired Andy Warhol to

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create a silk screen portrait of Prince. The same was published alongside an article about Prince, and the Respondent was credited as well as paid.

Thereafter, Andy Warhol derived 15 additional versions out of the Respondent's photograph, and they were called the *Prince Series.* Later, the Appellant licensed one of those works, "Orange Prince", to Conde Nast, again for the purpose of illustration in a special edition that would commemorate Prince upon his death. The Appellant was paid $10,000, whereas the Respondent was neither credited nor paid. When she learned about this special edition with one of her works as a cover, she informed the Appellant that this was an act of infringement of her copyrighted work. The Appellant sued them for a Declaratory Judgment of non-infringement or, in the alternative, Fair Use and the Respondent counterclaimed infringement.

The District Court considered the four factors of Fair use and granted judgment in favor of the Appellant. The Court of Appeals reversed the finding and ordered in favor of the Respondent. Thus, this appeal is preferred before the Supreme Court of the United States.

3. ISSUES

The main question presented before the Supreme Court was:

Whether the first fair use factor, "the purpose and Character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes", weighs in favor of the Appellant's recent licensing to Conde Nast ?

4. ARGUMENTS

4.1. Submissions made by the Appellant

The Appellant raised the following contentions in their Brief for Appellant:

Andy Warhol's work conveyed a different message than Goldsmith's photograph. She portrayed him as a vulnerable person trapped in the clutches of existence. Andy portrayed him as a reference to the ways in which pop culture dehumanizes celebrities. The Appellant relied on the straightforward rule established that "a follow-on work is transformative when it can

reasonably be perceived to add something new by altering the first with a new expression, meaning, or message".[1]

The Appellant's work has made necessary alterations to convey a message that is distinguishable from the Respondent's message. Goldsmith's photograph was a portrait of Prince in black and white, whereas Warhol removed his torso and brought his face to the forefront with a loud orange color. Appellant did not fail to bring it to the attention of the Apex Court that Respondent, in her counter claim, did not dispute that Andy's work conveyed a different message. The amount of original work used by the Appellant was reasonable to convey a different idea to the audience.

The main contention of the Appellant was that the Appellate Court wrongfully departed from the ruling in *Acuff-Rose Music, Inc. v. Campbell*[2] and wrongfully concluded that the visual similarity of the rival works was a factor in deciding whether the work was transformative. The Court brushed aside the extensive changes made by Warhol and shed light only on the recognizable elements of Goldsmith's work present in his work to establish the visual similarity between the rival works.

The Appellant claimed that the Meaning or message test, which was rejected by the Court of Appeals, runs parallel to the text and purpose of the Copyright Act. The Country's Copyright Act was formulated in such a way to prevent the stifling effects of exclusive rights and to give a breathing space to creativity. The provisions of Section 107 of the Copyright Act[3], impose limitations on the exclusive rights and thereby permit borrowing to some extent.

Finally, the Appellant expressed their concerns about the ruling of the Court of Appeals and the toll that it could take on the artist as well as art in general.

4.2. Submissions made by the Respondent

The Respondent raised the following grounds to dispose of the Appellant's claim of fair use:

Her main contention was that the Appellant's work does not qualify the test of necessity to copy original work. The Respondent relied on various precedents of this Court to establish her

[1] *Google LLC v. Oracle America Inc.*, 141 S. Ct. 1183 (2021); *Acuff-Rose Music, Inc. v. Campbell*, 510 U.S. 569, 579 (1994)
[2] *Acuff-Rose Music, Inc. v. Campbell*, 510 U.S. 569, 579 (1994)
[3] The Copyright Act of 1976

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case. In one of the cases, Justice Woodbury explained that the leading inquiry was whether new uses eclipsed the original "in the market with the same class of readers and purchasers".[4] Thus, she established that this court has linked the first and fourth fair use factors.

Her concern was that the Appellant's work stands contrary to the goals of copyright laws to strike a balance between rewarding the author's creation and enabling others to build on that work. Both are works of visual art depicting Prince. Thus, the overlay of the Appellant's style did not render his work anything less than a plain adaptation of the Respondent's work, which is substantially similar to each other.

The Respondent emphasized the fact that the Appellant did not challenge the Appellate Court's findings on other factors of fair use. The Appellant does not dispute that licensing Orange Prince supplants the Respondent's original photograph and that being an obvious market substitute goes against fair use. According to Section 107, the unpublished nature of a work is critical in refusing the defense of fair use. Since the Respondent's work is unpublished and creative, the case is weighed in favor of Respondent. She alleged that the Appellant did copy a substantial amount of the Respondent's photograph and further maimed her market presence by licensing the work to Conde Nast magazine.

The Appellant's meaning or message test may send out the wrong message that any derivative work may claim protection under the blanket of fair use because that may deprive the copyright owners of their exclusive rights. He made a wrong presumption from the *Campbell's* ruling that any use conveying a new message or meaning could claim fair use protection. Since silkscreen portraits are a classic derivative work of photograph, it would entirely collapse the licensing market, which revolves around the derivative works of the copyright owners.

Moreover, the Appellant's message test is silent about the category of artists who believe that the lack of meaning is the intended meaning. Further, it ignores the shift in meaning over time and the fact that different uses of works convey different meanings.

4.3. Appellant's Rejoinder

While denying the submissions of the Respondent, the Appellant stated that she casually categorized the Appellant's silkscreen portraits as reproductions of her original work on the

[4] *Webb v. Powers*, 29 F. Cas. 511, 517 (C.C.D. Mass. 1847)

painted canvas and offered no argument that they were the same work. Further, the use that adds a new message or meaning does not "merely supersede" the objects of the original work, as claimed by the Respondent.

She wrongly clubbed the fourth and first factor of fair use to serve her interests. The Prince Series cannot be treated as less creative just because a licensing agreement exists with respect to that series. In fact, the District Court originally granted a declaration in favor of the Appellant in respect of all 16 works and not just the one-time licensing of Orange Prince. Thereafter, the Court of Appeals vacated the District Court's Judgment with respect to all 16 works. But the Respondent suddenly shifted the focus to the Orange Prince to distract from her frail position.

The Appellant emphasized that the Respondent is trying to entirely jettison the transformative rule and rely on her newly invented theory that "a follow-on work is transformative only if there is a necessity to copy from the original without superseding the original work". She also failed to cite a single precedent from any court imposing this theory. Further, she swiftly moves to the fourth factor in her pleadings without establishing any point.

Finally, the Appellant submits that the "message or meaning test" is imperative to maintain balance between the diverse goals of copyright law.

5. JUDGMENT

The Court opined in favor of the Respondent and held that the Appellant's work deprived her of the exclusive rights as a copyright owner. The specific use of the Respondent's photograph, which was alleged to have infringed her copyright, is the Appellant's licensing of Orange Prince to Conde Nast. The derivative work serves the same purpose as the original, to be used in magazines as a reference to articles. The original work as well as the follow-on work serve the same commercial purpose, which is not reasonably distinct. In majority's view, the Appellant's licensing of Orange Prince to a Conde Nast precludes fair use.

a) The Court rejected the Appellant's contention that his work conveys a different meaning or message. It was held that the first fair use factor focuses on whether there is a reasonable degree of difference between the rival works. Despite the new expression added to Respondent's photograph, the first fair use factor still favors the Respondent.

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b) The court opines that the Appellant's work merely overrides the object of the original work and does not add any new purpose or different character. The degree of transformation should go beyond what is required to qualify as derivative in order to be considered fair use. In this way, the derivative work as well as fair use can coexist. But the Appellant's work did not successfully answer the pivotal question of "whether and to what extent" in the first factor.
c) Since the two arts in question are portraits of Prince used in magazines to illustrate his stories, the use is of a commercial nature. It advocates against fair use because this is not an inquiry into the intention of the user but rather what a user does with an original work. The Appellant licensed the Orange Prince to Conde Nast, which was originally created from the licensed work of the Respondent.
d) The Court further rejected the contention that the recognizable element of original work present in follow-on is used as a medium to convey the new message and held that it is not justification enough.
e) Though commercial use, unlike nonprofit purpose, is an additional element of the first fair use factor, the rival works in this case share the same commercial purpose. Thus, there is no justification for the unauthorized use by the Appellant. The Court further stated that the four factors of fair use should not be treated in isolation from each other. They must be weighed together in light of the purpose of copyright.

On the other hand, the dissenting opinion of the Court brought forward the majority's lack of appreciation for the Appellant's work, which differs in both aesthetics and message. Justice Kagan denied the majority's view and made the following observations:

a) No artists can create from vacuum. They cannot do what they do without borrowing from the works of others.
b) He resents the majority view for not giving credit to what the Appellant added to the original work. As an avatar of transformative copying, the use of essential elements of existing art is the modus operandi of the Appellant, which was not adequately recognized by the majority.
c) The majority view conveniently omitted the distinct message conveyed by the Appellant's work. The Orange Prince does not focus on a unique human identity but rather on the public image. Both of these images were put together as "portraits of the

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prince," which may have been used as a reference to an article about him. The Conde Nast magazine knew about the photo, but they chose the Appellant's portrait, which is more than enough to conclude that they are fundamentally different from each other.

d) He criticized the majority's rambling around all four factors of fair use. He brings forward the precedents[5] of this Court that, in cases where the four factors point in different directions, the fourth factor, i.e., the economic interest of the copyright owner, must be treated as the "most important". But the majority transplants the fourth factor into the first factor. The Appellant is denied a fair use defense merely on the basis of the presence of a licensing agreement between the Appellant and Conde Nast, irrespective of the fact that he created something new out of the Respondent's old photograph.

e) Finally, he states that the fair use analysis, in the majority's opinion, fails from top to bottom. The majority ignored the expert evidence that explained the painstaking labor and work of the Appellant that made his silkscreen portrait different from the original photo. Since he has made a creative contribution that is primarily protected by copyright law, his work is transformative and must be weighed against other factors, like commercialism.

6. ANALYSIS

One could only imagine the effect of this ruling on art and the future of artistic freedom. The majority view inclined towards pecuniary factors and moved away from artistic freedom, which was pivotal to the copyright law for the past 200 years. A copyright protection is intended to increase the harvest of knowledge. Unfortunately, the present stand of the Supreme Court of the United States will impede future creative endeavors, thus creating a monopoly by restricting the right to creative freedom. It retired from the century-old practice that every form of art must borrow and necessarily must borrow and build upon it. Such a practice was recognized and protected against the claims of copyright owners under the head of fair use. The Apex Court's decision has left little to no breathing space for creative works that are to be built upon the prior works. Thereby, it has left plenty of unanswered questions, which will apparently affect the creators. Departure from age-old precedents such as *Campbell*'s message or meaning test is only a step backwards. Worst of all is denying the artist his rightful credit for his labor in

[5] *Harper & Row v. Nation Enterprises*, 471 U.S. 539

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creating an exceptional piece of art. The Court has failed to acknowledge the newness and fresh elements of the follow-on work.

The Appellant asserted that modifications such as cropping and flattening were made to the original work to impart a different meaning and portray Prince as an icon rather than a vulnerable person. But a blanket cover of both works as portraits of Prince is directly contradictory to the goals of copyright law. It is also pertinent to mention that the Appellant did not make a deliberate copy of the original work but instead used a considerable amount of the original and created a different artwork that is visually dissimilar from the original work. The Apex Court failed to recognize the rights of the Appellant as a creator of the "Orange Prince" and denied his right to license the same. It is unfortunate that the Court failed to accept the submissions of Appellant to his rightful defense, which has only created anxiety in the hearts of creators.

7. CONCLUSION

The Supreme Court of the United States, in this landmark decision, revisited the doctrine of fair use and certainly stirred things up a little bit in various other jurisdictions. The present ruling in the United States seems to resemble the Indian version of the *Campbell case*[6], where the Court established three essential tests such as the quantum of the matter taken, purpose, and likelihood of competition. Though the amount of original work used to create a follow-up is crucial to deciding on fair use, it cannot be the sole criterion to refuse a fair use defense. With the evolution of branches of art in diverse mediums and spectrums, the present ruling has a serious hold on any kind of creator or artist, starting from social media influencers to film directors to chefs.

[6] *Civic Chandran & ors v. C. Ammini Amma & ors*, 1996 SCC Online Ker 63