

Andy Warhol's Prince Series Portraits Held Fair Use of Photograph

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by Charlene Krogh and Sandra Edelman



Earlier this summer, in *The Andy Warhol Foundation for the Visual Arts v. Goldsmith*, the federal district court for the Southern District of New York held that Andy Warhol's artwork series depicting the late singer Prince was protectable fair use of a photograph taken by Lynn Goldsmith.

Goldsmith photographed Prince in her studio in late 1981. Three years later, Condé Nast obtained a license to use one of Goldsmith's black and white photographs "for use as an artist's reference in connection with an article to be published in Vanity Fair Magazine." The invoice for the license did not specify which of Goldsmith's photos from the studio shoot was licensed and Goldsmith was not aware at

the time that her photograph had been licensed by her photography agency for use as an artist's reference. Vanity Fair commissioned Andy Warhol to create an illustration for an article titled "Purple Fame." Based on Goldsmith's photograph, Warhol created a full color illustration of Prince that ultimately appeared in the article that was published in November 1984. The article contained the following copyright attribution credit for the portrait: "source photograph (c) 1984 by Lynn Goldsmith."

Warhol also created the "Prince Series", comprised of 16 distinct pieces of artwork, including the one used in the November 1984 Vanity Fair "Purple Rain" article. The series was displayed multiple times in museums, galleries, books, magazines and other locations.

Goldsmith contended that she was not aware of Warhol's use of her photo until after

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Prince's death in 2016. The day after Prince died, Vanity Fair published an online copy of its November 1984 "Purple Rain" article, and then issued a commemorative magazine titled "The Genius of Prince". It obtained a license to use Warhol's Prince Series works as the cover of the magazine, and the commemorative issue published in May 2016 displayed a copyright credit only to Warhol, not to Goldsmith.

In response to Goldsmith's accusation of copyright infringement, the Warhol Foundation brought an action for declaratory judgment that none of the sixteen works in the Prince Series infringed Goldsmith's copyrighted photograph. It argued that the works were not substantially similar and, in any event, the Prince Series was protected by the fair use doctrine. Goldsmith counterclaimed for infringement, and the parties filed cross-motions for summary judgment.

In a decision dismissing Goldsmith's copyright infringement claim, Judge John Koeltl of the Southern district analyzed the four factors identified by Congress as relevant to the adjudication of a fair use defense: (1) the purpose and character of the use; (2) the nature of the copyrighted work; (3) the substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect on the potential market for or value of the copyrighted work.

Under the first factor, the court explained that the most important consideration is the "transformative" nature of the work at issue. A "transformative" work adds something new to the original copyrighted work, such as expression, meaning, message, character or aesthetics, with creative and communicative results distinct from the original. Judge Koeltl noted that the Prince Series depicted the singer as a flat, two-dimensional figure, rather than the three-dimensional being in Goldsmith's photograph. Furthermore, the Prince Series contains loud colors and undefined softened exteriors, in contrast to the original stark black and white photograph. Because of this different aesthetic and character, the court determined that the Prince Series was transformative.

An amusing footnote in the fair use analysis noted that during oral argument on the summary judgment motions, Goldsmith's counsel suggested that fair use is "almost like you know it when you see it" — an obvious allusion to Supreme Court Justice Potter Stewart's test for obscenity. Judge Koeltl commented in response that this analogy would not benefit Goldsmith: "If that were the test, it is plain that the Prince Series works are 'Warhols' and the Goldsmith Prince Photograph is not a 'Warhol.'" The first fair use factor accordingly weighed strongly in favor of the Warhol Foundation.

Under the second factor, the court considered whether Goldsmith's photograph was expressive or creative vs. factual or informational and whether the photograph was unpublished vs. published. Although Goldsmith's studio photo on which the Prince Series was based was creative and had never been published, the court found that it had been licensed as an artist's reference. Further, the court held that the second factor's significance in the fair use analysis is diminished where the secondary work is transformative. As a result, the second factor favored neither party.

As to the third factor, the court evaluated the substantiality of the portion used in relation

to Goldsmith's photograph as a whole. Goldsmith argued that Warhol's Prince Series contained "the essence" of her photograph, while the Warhol Foundation countered that Warhol used only a portion of the photograph and that the Prince Series, in final form, "contain none of the protectable elements of Goldsmith's photograph." The court concluded that the Series, in removing nearly all the photograph's protectable elements of the photograph, "transformed Goldsmith's work 'into something new and different and, as a result, this factor weighs heavily" in the Warhol Foundation's favor.

The fourth factor also favored the Warhol Foundation. In considering the effect on the value of the copyrighted work, the court observed that "It is plain that the markets for a Warhol's and for a Goldsmith fine-art or other type of print are different" and that Goldsmith had not established that the Prince Series works were market substitutes for her photograph.

In sum, undertaking a "holistic weighing" of the four fair use factors, the court concluded that the Prince Series was a protected fair use, and dismissed Goldsmith's claim for copyright infringement.

The decision provides fascinating insights into Warhol's creative process and also demonstrates the powerful significance of a finding that a work is transformative in the four factor fair use analysis.

Dorsey & Whitney summer associate Amy Jones contributed to this post.