

Supreme Court Grapples With Complex Issue of Fair Use and Appears Uncertain as to How to Rule, and Thereafter How to Proceed

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by Bruce R. Ewing

It is not every day that Supreme Court oral arguments include references to *The Lord of the Rings* (both the books and the movies!), the Syracuse University athletic program, *Mork and Mindy*, *All in the Family*, Norman Lear (inaccurately characterized as having passed away, when he just celebrated his 100th birthday), the Mona Lisa (in a red dress, yet), photos of Abraham Lincoln and biographies of George Washington, but today's oral argument in the case of *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith* included all of that and plenty more.

Prior readers of this blog will be familiar with the underlying facts of this matter, but the core question in the case is whether the use of a copyrighted photograph taken of the artist Prince by the photographer Lynn Goldsmith, subsequently modified by the artist Andy Warhol to create what was referred to during the argument as the "Orange Prince," qualifies as a fair use under Section 107 of the U.S. Copyright Act. Goldsmith says no, the Andy Warhol Foundation says yes, and the Office of the Solicitor General of the U.S. Justice Department has sided (mostly) with Goldsmith.

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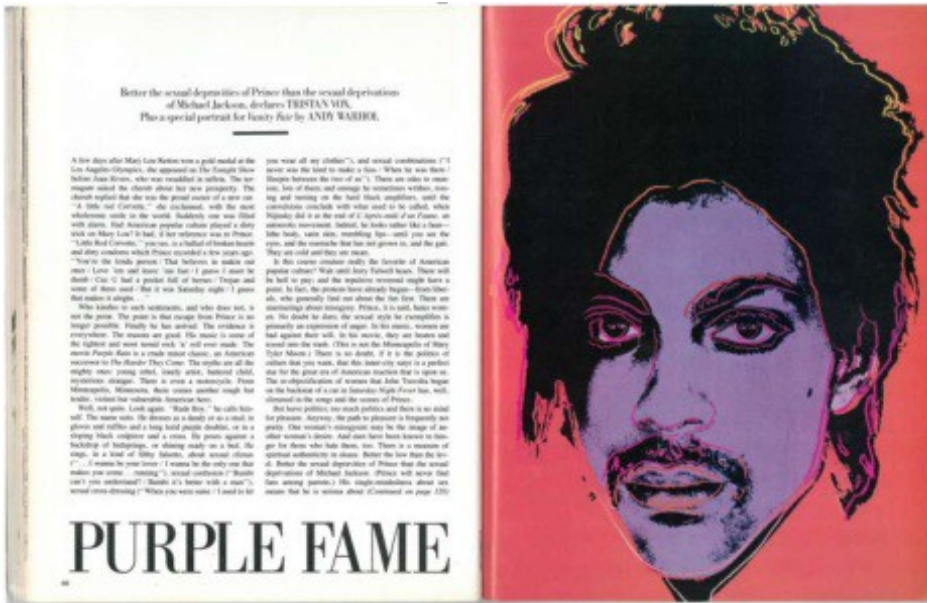
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Goldsmith



Warhol

So how did the argument go? The Court peppered the Foundation's counsel with a wide range of questions, and at times expressed great concern that the test advocated by the Foundation for the first of the Section 107 fair use factors – the purpose and character of the use – cannot just focus on the “meaning or message” of the new work without severely limiting the rights of original creators. Justice Thomas asked the Foundation's counsel if he took Warhol's image, added the words “Go Orange,” and used it to promote the Syracuse University Athletic program (selling posters based on this new work at the same time), whether that use would be fair under the Foundation's test, since the meaning and message of this new work were different from Warhol's. When the Foundation's counsel said probably not, Justice Thomas suggested that the Foundation's position was both inconsistent and incapable of being practically applied. For her part, Goldsmith's counsel attacked the Foundation's position as putting the interests of copycats above the purposes of copyright.

At the same time, multiple Justices expressed concern that treating the “meaning or message” of new works as irrelevant, as the appellate court below had (arguably) done, was a step too far. Indeed, several Justices, notably Justice Kagan, appeared to argue for an approach in which a new work's meaning or message could be considered as *part* of the inquiry into the purpose and character of the new use, but not as shorthand for that factor as a whole.

A recurring theme of the arguments was the nature of the “use” the Court was supposed to be considering for purposes of the fair use analysis. Was it Warhol's original creation of the “Orange Prince” back in 1984, when he made a number of changes to Goldsmith's photo, with her permission, for publication of the “Orange Prince” in a *Vanity Fair* article? Was it Warhol's subsequent creation of fourteen additional works based on the Goldsmith Photo, dubbed the “Prince Series,” that now hang in museums and on the walls of collectors? Or was it the Foundation's decision to license the “Orange Prince” to *Vanity Fair* again in 2016 for inclusion in another article about Prince following his death, this time without Goldsmith's permission and without paying her? Goldsmith and the Solicitor General see this case as being about only (or at least primarily) the last of these uses, with the licensing of the “Orange Prince” essentially usurping a market Goldsmith actually exploits – the licensing of her images to media outlets – without compensation. But to the Foundation, the underlying meaning and message of Warhol's “Orange Prince” – to comment on the reductive and dehumanizing nature of modern celebrity – was not diminished by the appearance of the “Orange Prince” in a *Vanity Fair* article published after Prince died. And, per the Foundation, the case is also about the original act of creation and the need to foster the ability of future artists to make use of preexisting works to communicate their own messages on subjects of their choosing.

Another source of dispute between the parties and, at times, the Justices themselves, was what the purpose of the use of the “Orange Prince” was. To the Solicitor General and Goldsmith, the purpose of the two images was the same – to show Prince as Prince, unlike Warhol’s prior use of Campbell’s Soup cans to comment on consumerism, not to sell food products – such that no further inquiry into that aspect of the first fair-use factor was necessary. But Justice Roberts appeared to reject that argument, noting how different the two Prince images were, and that both communicated different messages. The Foundation argued on this point that, per the Supreme Court’s prior holding in *Campbell v. Acuff-Rose*, 510 U.S. 569 (1994), it was not necessary for any court to determine what **the** meaning or message was of a new work, but that what mattered was whether **a** new meaning or message could reasonably be perceived from the new work.

Both counsel for Goldsmith and the Solicitor General were asked for their own tests as to how to evaluate the first fair use factor, and both advocated, at various points and somewhat inconsistently, for a requirement that the second artist show that it was “essential,” “necessary” or “highly useful” for them to use the first work. But several Justices expressed concerns that these proposed tests were overly limiting and/or too vague, and the Foundation vigorously argued that a test based on “necessity” would eviscerate the fair use defense and chill both creativity and freedom of expression.

Finally, and for parties, perhaps most importantly, there is the question of what the effect of a Supreme Court holding will have on the case at hand. Several Justices asked what would or should happen if the Court ruled in favor of one side or the other on the first fair use factor, since none of the other three fair-use factors had been briefed. The Court gave no clear sense about what would happen next if it ruled for either side, although the prospect of a remand to the Second Circuit or the District Court was brought up by a number of Justices, depending on how the case was decided.

In the end, what this case boils down to is balancing two equally important rights: the right of original creators to safeguard their copyrights and be compensated for their expression, and the right of secondary creators to innovate and build upon preexisting works, even if they are copyrighted. The Supreme Court argument did not clarify whether the balance is likely to tip in favor of one right or the other, or how to demarcate the boundaries between a use that is infringing and a use that is fair. Equally unclear is whether the Court will issue a limited ruling that does little more than address either the specific facts of this dispute or the interpretation of the first fair-use factor, or offer a broader balancing test capable of wider applicability in copyright cases that covers fair use as a whole. The decision, when it comes down, likely in 2023, will surely be an interesting and important read regardless of the outcome.