NOTHING COMES FROM NOTHING: ANDY WARHOL AND THE INADEQUACY OF THE FAIR USE ANALYSIS OF CONTEMPORARY ART

KRISTEN PARK*

INTRODUCTION

Andy Warhol looms large—not just within the ivory tower of contemporary visual arts, but in American culture. To many, his colorful silkscreen portraits of such celebrities as Marilyn Monroe or Elizabeth Taylor are paradigmatic of contemporary art. Yet, despite the near-universal reach of his work and his significant celebrity in his own right, the theoretical and conceptual underpinnings of his work remain less accessible to casual viewers.

In 1984, Lynn Goldsmith, a celebrity portrait photographer, licensed a 1981 photograph she took of the musical artist Prince (the "Goldsmith Photograph") to Vanity Fair Magazine for use as an artist reference in an illustration that appeared twice in the magazine, with attribution back to Goldsmith for the "source photograph."[1] Vanity Fair hired Andy Warhol to create a silkscreen portrait of Prince based on the Goldsmith Photograph to accompany an article about Prince's music and newfound celebrity. Unbeknownst to Goldsmith until she discovered "Orange Prince," an orange silkscreen portrait of the singer, on the cover of Condé Nast's posthumous tribute to Prince in 2016, Warhol created fifteen additional works based on her photograph (the "Prince Series") before his death. Goldsmith sued for copyright infringement, and the district court for the Southern District of New York (the "*Warhol* district court") initially found the Prince Series was transformative and granted summary judgment to the Andy Warhol Foundation for the Visual Arts ("AWF") on its fair use defense. The Second

* Senior Editor, *Southern California Law Review*, Volume 97; J.D. 2024, University of Southern California Gould School of Law; Bachelor of Arts 2019, Williams College.

1. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 143 S. Ct. 1258, 1266 (2023).

Circuit reversed upon concluding that each of the four statutory fair use factors[2] weighed in favor of Goldsmith. The Supreme Court granted certiorari to examine the first fair use factor, ultimately finding in a 7-2 decision that the first factor favored Goldsmith and counseled against fair use because the purpose of Orange Prince was substantially the same as the Goldsmith Photograph and AWF's licensing of Orange Prince to Condé Nast's special issue commemorating Prince was of a commercial nature.[3] Justice Kagan, joined by Chief Justice Roberts, penned a sharply-worded dissent in defense of Warhol's transformative use of his source material, accusing the majority of leaving the Court's first factor inquiry "in shambles"[4] and "our world poorer."[5]

Warhol's fame complicates the fair use analysis in the case at hand ("*Warhol*") because it raises questions of "celebrity-plagiarist privilege"[6] and how the Supreme Court's ruling may influence less established artists in future copyright suits. The *Warhol* district court and the Second Circuit, amici for both parties, and Supreme Court Justices have all debated the proper role, or the absence thereof, that Warhol's fame might play in the Court's analysis of whether Orange Prince could be protected as fair use of the Goldsmith Photograph. Despite the fact that this case is far from the first time Warhol's appropriation of photographs for his silkscreen work has embroiled him in copyright disputes with the photographers of the underlying works (most disputes were settled out of court),[7] this case promised to be of unprecedented significance because of the myriad of ways in which *Warhol* epitomizes the challenges that appropriation art,[8] and the contemporary visual arts more broadly, have historically posed for the fair use doctrine.

The task of formulating a clear standard for evaluating fair use in cases involving appropriation art has only become more challenging in our digital age, in which the use of appropriation in art is no longer limited to the

2. *See infra* Part I.

3. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 143 S. Ct. at 1278, 1280.

4. *Id.* at 1292 (Kagan, J., dissenting).

5. *Id.* at 1312 (Kagan, J., dissenting).

6. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 31, 43 (2d Cir. 2021) ("[T]he more established the artist and the more distinct that artist's style, the greater leeway that artist would have to pilfer the creative labors of others.").

7. Kate Donohue, *Andy the Appropriator: The Copyright Battles You Won't Hear About at the Whitney's Warhol Exhibit*, COLUM. J.L. & ARTS (Aug. 2, 2019), https://journals.library.columbia.edu/index.php/lawandarts/announcement/view/112 [https://perma.cc/73LG-4FNT].

8. Appropriation art refers to the practice of using preexisting images or objects to create new artwork with minimal physical transformations to the originals; often to challenge traditional notions of authenticity, creativity, and authorship. *Appropriation*, TATE, https://www.tate.org.uk/art/art-terms/a/appropriation [https://perma.cc/B8UL-VH45].

"relatively small segment of creators who practice 'appropriation art.' "[9] The practice of copying has become "both the topic of contemporary art and its technique" and "now permeates art in an extraordinarily diverse range of ways."[10] Accordingly, *Warhol* represented a crucial opportunity for the Supreme Court to tailor a more specialized and better-informed standard of fair use in the context of the conceptual visual arts so that the fair use doctrine may continue to evolve alongside advancements in the arts.

This Note proposes that the Supreme Court should have vacated and remanded *Warhol* to the district court to supplement its evaluation of the first and fourth fair use factors with an evidentiary analysis of the perspective of an art market consumer or magazine editor. Part I of this Note offers an overview of the legislative intent of the fair use defense and the four statutory factors, then traces subsequent articulations of the doctrine in U.S. fair use jurisprudence. Part II discusses the issues of scope and incompatibility that arise from the fraught application of the Second Circuit's analysis of "transformativeness" under the first factor to conceptual art. Part III explores how adapting the substantial similarity analysis to fair use by allowing courts to consider the perspective of the art market consumer under the first and fourth factors can contribute to a more equitable and informed application of the fair use doctrine.

I. HISTORY AND BACKGROUND: THE MANY LIVES OF THE FAIR USE DEFENSE

Section 107 of the Copyright Act of 1976 codified a four-factor statutory framework for determining fair use: (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work.[11] The statutory factors reflected the "purpose and general scope of the judicial doctrine of fair use" at the time of its ratification, but the analysis was intended to remain flexible to evolve with ongoing technological advancements and to further the objective of copyright to promote progress: "[T]he endless variety of situations and combinations of circumstances that can rise in particular cases precludes the formulation of exact rules in the statute. . . . [T]here is no disposition to freeze the doctrine in the statute, especially during a period of rapid

9. Amy Adler, *Fair Use and the Future of Art*, 91 N.Y.U. L. REV. 559, 571 (2016).
10. *Id.* at 571–72.
11. 17 U.S.C. § 107.

technological change."[12] This Note will primarily focus on the first and fourth factors.

Notwithstanding the statutory formulation of the fair use factors, Judge Pierre Leval recognized the enduring lack of a clear consensus on the contours and meaning of fair use in a seminal 1990 article.[13] Judge Leval suggested that an evaluation of the first factor (purpose and nature of the work) turned primarily on "whether, and to what extent, the challenged use is *transformative*."[14] Advocating for the need to focus on the "utilitarian, public-enriching objectives of copyright," Judge Leval called for a careful consideration of whether the challenged use of a copyrighted work revealed a transformative purpose that would advance the progress of the arts.[15] He articulated transformative use as one that "adds value to the original—if the quoted matter is used as raw material, transformed in the creation of new information, new aesthetics, new insights and understandings . . . ."[16] Four years later, the Supreme Court adopted Judge Leval's articulation of transformativeness in *Campbell v. Acuff-Rose Music*, focusing its inquiry into the first factor on whether and to what extent the secondary work "alter[ed] the first with new expression, meaning, or message . . . ."[17] While *Campbell* did not find transformative use to be dispositive of fair use, the Court echoed Leval's emphasis on balancing the statutory factors together in light of the objective of copyright to promote the progress of science and the arts.[18]

Yet, notwithstanding the articulation of a new standard of transformativeness to guide the analysis of the first factor, the inquiry into whether "the meaning or message" of the original work has been transformed continues to "suffer[] from [the] absence of rules for how broad the categories of expressive uses should be,"[19] giving rise to the critique that the " 'standard has become all things to all people.' "[20] Though courts have been applying the doctrine for centuries, the enduring open-endedness of the inquiry and the wide range of contexts to which it has been applied have

12. Copyright Law Revision, H.R. REP. NO. 94-1476, at 66 (2d Sess. 1976).
13. Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1106 (1990).
14. *Id.* at 1111.
15. *Id.* at 1135.
16. *Id.* at 1111.
17. Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 579 (1994).
18. *Id.*
19. MELVILLE B. NIMMER & DAVID NIMMER, 4 NIMMER ON COPYRIGHT § 13F.05[A][2], [B] (2023).
20. *Id.* at § 13F.10[F][2][a].

yielded decisions that are not governed by established principles, but rather "result from intuitive reactions to individual fact patterns."[21]

In a case the Second Circuit has since designated the "high-water mark of [its] recognition of transformative works," *Cariou v. Prince*, the court applied the fair use exception in favor of appropriation artist Richard Prince.[22] *Cariou* established a model for a more objective transformativeness analysis by shifting the focus away from the artist's professed intent behind his work towards an inquiry into "how the work in question appears to the *reasonable observer*," with an emphasis on the aesthetic qualities of the work.[23] The Second Circuit ultimately ruled that twenty-five of the thirty works in Prince's series were transformative because they "give Cariou's photographs a new expression, and employ new aesthetics with creative and communicative results distinct from Cariou's," and manifest an entirely different aesthetic from their source material.[24] The Second Circuit remanded the remaining five works to the district court as they "do not sufficiently differ from the photographs" incorporated for the Second Circuit to confidently determine their transformative nature.[25]

Judge Wallace's dissenting opinion challenged the *Cariou* majority's "murky and subjective" standard and its subsequently dubious value to the splintered tradition of fair use jurisprudence.[26] Making repeated references to his limited art experience and unsuitability to make "fact- and opinion-intensive decisions" on the artworks at issue, Judge Wallace questions how the Second Circuit can confidently make a "principled" distinction between the twenty-five transformative works and the five works the majority identifies as "close calls."[27] Judge Wallace suggests all thirty works should be remanded to the district court on an "open record to take such additional testimony as needed," because the district court is "best situated" to make factual determinations on transformativeness and apply the correct legal standard in fair use cases.[28]

---

21. Leval, *supra* note 13, at 1107.

22. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 38 (2d Cir. 2021) (quoting TCA Television Co. v. McCollum, 839 F.3d 168, 181 (2d Cir. 2016)).

23. Cariou v. Prince, 714 F.3d 694, 707 (2d Cir. 2013) (emphasis added). Cariou, a photographer, filed a copyright infringement suit against Prince for appropriating several of his portraits of Rastafarians into a series of paintings and collages. In several of the photographs, Prince rendered Cariou's photographs barely detectable by heavily altering and obscuring his source material, while in others, the original photographs remain prominent with fewer apparent physical alterations.

24. *Id.* at 708.

25. *Id.* at 710–11.

26. Adler, *supra* note 9, at 604; *Cariou*, 714 F.3d at 713 (Wallace, J., concurring in part and dissenting in part).

27. *Cariou*, 714 F.3d at 713 (Wallace, J., concurring in part and dissenting in part).

28. *Id.* at 714.

The demonstrated absence of a clear standard of fair use has historically resulted in the inconsistent application of the doctrine to the detriment of artists who "lack a reliable guide on how to govern their conduct."[29] Nevertheless, the legislative intent of the Copyright Act and the four statutory factors suggests fair use was conceived as a "context-sensitive inquiry that does not lend itself to simple bright-line rules."[30] Under the broad statutory guidance of the four factors, courts were given significant freedom to "adapt the doctrine to particular situations on a case-by-case basis."[31] The rigid application of a bright-line standard that privileges predictability over the particular facts of a case risks "stifl[ing] intellectual activity to the detriment of the copyright objectives."[32] *Warhol* presents the Supreme Court with an opportunity to tailor its fair use inquiry to address the unique interests implicated by conceptual art.

II. CONTEMPORARY ART AND FAIR USE

A. TRANSFORMATIVE IN CONCEPT: ASKING THE WRONG QUESTIONS OF APPROPRIATION ART UNDER THE FIRST FACTOR

The first fair use factor asks courts to consider the "purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes."[33] Establishing that on a "high level of generality," the Prince Series and Goldsmith Photograph share the same overarching purpose, "to serve as works of visual art," the Second Circuit focuses its evaluation of the first factor on whether the secondary work manifests a transformative use.[34]

The *Warhol* district court's analysis of the first factor notes that whereas Goldsmith intended her photographic work to "center[] on helping others formulate their identities, which she aims to capture and reveal through her photography," Warhol's Prince Series "can reasonably be perceived to reflect the opposite," transforming Prince from a "vulnerable, uncomfortable person to an iconic, larger-than-life figure."[35] The *Warhol* district court details how Warhol's "alterations result in an aesthetic and character

29. *See* Leval, *supra* note 13, at 1135.
30. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 38 (2d Cir. 2021).
31. Copyright Law Revision, H.R. REP. NO. 94-1476, at 66 (2d Sess. 1976).
32. Leval, *supra* note 13, at 1135.
33. 17 U.S.C. § 107 (1).
34. *Andy Warhol Found. for the Visual Arts*, 11 F.4th at 40.
35. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 382 F. Supp. 312, 326 (S.D.N.Y. 2019).

different from the original," rendering the Prince Series works "immediately recognizable as a 'Warhol' " rather than as a realistic photograph of Prince.[36]

By decontextualizing and mischaracterizing the district court's use of the language of recognizability, the Second Circuit misconstrues the court's larger meaning to unfairly charge it with creating a "celebrity-plagiarist privilege."[37] The Prince Series works are recognizable as "Warhols," not as opposed to lesser-known conceptual artists or even Goldsmith (who is a celebrated artist in her own right), but rather in contrast with realistic photographic portraits.[38] The district court treats Warhol as synonymous with the field of conceptual art.[39] Thus, Warhol's work was transformative not because the Prince Series was recognizable as distinctively his, as the Second Circuit suggests, but because Warhol is paradigmatic of the practice of appropriation art, which transforms its source material by adding new conceptual meaning to express an original message. The district court was not identifying elements of Warhol's distinctive style so much as highlighting the visual elements of the Prince Series that, in their aesthetic departure from their source material, manifested a new character and distinct artistic purpose from the Goldsmith Photograph.[40] The district court identifies the visual elements of the Prince Series which made it clear to them that the purpose of Warhol's work was not to capture and reveal Prince's authentic identity, as Goldsmith's Photograph did, but to obscure the very elements that were emphasized in Goldsmith's work, transforming and masking over the private "human" Prince that Goldsmith captured in service of depicting Prince, the pop culture icon.[41]

The Second Circuit also cites the district court's observation of how Warhol transformed Prince from a "vulnerable, uncomfortable person to an iconic, larger-than-life figure,"[42] but reduces this difference in the fundamental purpose of each work to purely aesthetic differences. On the basis of this mischaracterization of Warhol's conceptual transformation of his source material as surface-level alterations, the Second Circuit proceeds to conclude that, notwithstanding these aesthetic changes, Warhol did not use the Goldsmith Photograph in service of a fundamentally different artistic purpose because the photograph remains the recognizable foundation of his

36. *Id.*

37. *Andy Warhol Found. for the Visual Arts*, 11 F.4th at 43.

38. *See Andy Warhol Found. for the Visual Arts*, 382 F. Supp. at 326.

39. "Conceptual art" refers to art in which the idea or concept being expressed in the work takes precedence over the finished art object. *Conceptual Art*, TATE, https://www.tate.org.uk/art/art-terms/c/conceptual-art [https://perma.cc/NDE2-S6FR].

40. *See Andy Warhol Found. for the Visual Arts*, 382 F. Supp. at 326.

41. *See id.*

42. *Andy Warhol Found. for the Visual Arts*, 11 F.4th at 41.

Prince Series.[43] The Second Circuit provides two conflicting explanations for why it cannot accept the district court's analysis of transformative use; it simultaneously suggests that (1) the district court's analysis of the transformative effect of Warhol's alterations to the Goldsmith Photograph was inappropriately grounded solely in Warhol's and Goldsmith's perceived or stated intent and (2) that the district court overstepped the scope of its judicial authority by independently interpreting the meaning of a work of visual art.[44]

The Second Circuit critiques the district court's "mere" reliance on Warhol's and Goldsmith's stated intent in its consideration of whether Warhol's Prince Series constituted a transformative use of its source material when "whether a work is transformative 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."[45] Rather, the Second Circuit designates the appropriate role of the judge as "examin[ing] whether the secondary work's use of its source material is in service of a 'fundamentally different and new' artistic purpose and character, such that the secondary work stands apart from the 'raw material' used to create it."[46] In determining the artistic purpose and character of the secondary work, the judge is closed off from assuming the role of art critic to determine the intent or meaning behind the work.[47]

The Second Circuit's reluctance to allow the artist's intent to exclusively guide the court's analysis has merit and echoes several key fair use precedents. Justice Holmes, in *Bleistein v. Donaldson Lithographing Co.*, first identified the risk of establishing the judge as the reasonable observer in the context of the visual arts, noting that "[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits."[48] In fact, treating the question of artist's intent as dispositive of or heavily weighing in favor of transformative use is not only inherently incompatible with contemporary art, but the artist's intent is also largely irrelevant to the meaning of the work.[49] Professor Amy Adler suggests visual artists are particularly "ill-suited" to the task of articulating the intent behind their work[50] in part because of the inherent difficulty of

43. *See id.* at 41–43.
44. *See id.* at 41.
45. *Id.* at 41.
46. *Id.* at 42.
47. *Id.* at 41.
48. Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 251 (1903).
49. *See* Adler, *supra* note 9, at 563.
50. *Id.* at 584–85.

reducing artworks that "seem to revel in their multiplicity of meaning" to simple messages in words and, increasingly because erasure of authorship and artistic intent has become a signature of contemporary art.[51] The decentralized theory of postmodern art rebels against any single definition of what art should be,[52] subsequently destabilizing the idea that the intent of the artist is controlling. This post-modernist shift towards the concept of art as a mass-produced consumer product seemingly untouched by the romantic hand of the artist was led by none other than Warhol himself.[53]

Scholars have similarly suggested that a leading factor that contributes to the tendency of fair use to "choke" on non-textual visual works[54] is the doctrine's dependence on the artist's ability to articulate his purpose in words, meaning that "results may be unpredictable or idiosyncratic, depending on whether the judge has . . . 'learned the new language in which [the artist] spoke.' "[55] This explanation lends weight to the theory that conceptual artist Jeff Koons was able to earn a more favorable finding in *Blanch v. Koons*, after being accused of piracy and losing his fair use claim a decade prior in *Rogers v. Koons*,[56] because in the time since his initial loss in *Rogers*, the artist had "learned how to testify in a way that pleased the court";[57] Koons defended his appropriation of the plaintiff's photograph to create his collage by incorporating the language of transformativeness ("new insights") into his statement of intent.[58] Other scholars similarly accredit the "capricious" concept of transformativeness that has historically been applied in visual arts fair use cases to courts' enduring "uneas[iness] about second-guessing artistic judgments."[59]

The Supreme Court in *Campbell* defined the "threshold question" of the fair use defense as whether a transformative character or use "may reasonably be perceived."[60] In announcing a shift away from treating the

51. *Id.* at 589.

52. *Postmodernism*, MUSEUM MOD. ART, http://www.moma.org/collection/terms/postmodernism [https://perma.cc/8JS6-HUBQ].

53. *See* Adler, *supra* note 9, at 592.

54. Rebecca Tushnet, *Worth a Thousand Words: The Images of Copyright*, 125 HARV. L. REV. 683, 752 (2012).

55. *Id.* at 754–55.

56. Rogers v. Koons, 960 F.2d 301, 311 (2d Cir. 1992) ("[I]t is not really the parody flag that appellants are sailing under, but rather the flag of piracy.").

57. Adler, *supra* note 9, at 581–82.

58. *Id.* Blanch v. Koons, 467 F.3d 244, 252 (2d Cir. 2006) ("Koons Aff. At P4 ('I want the viewer to think about his/her personal experience with these objects, products, and images and at the same time gain new insight into how these affect our lives.')").

59. Jane C. Ginsburg, *Fair Use in the United States: Transformed, Deformed, Reformed?*, 2020 SING. J. LEGAL STUD. 265, 280 (2020).

60. Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 582 (1994).

alleged infringer's articulation of their intent as dispositive of transformative use, the Second Circuit *Cariou* court narrowed the *Campbell* inquiry even further to focus on "how the work in question appears to the *reasonable observer*, not simply what an artist may say about a particular piece or body of work."[61] In *Cariou*, a decade after Koons lost his fair use claim in *Rogers*, Richard Prince likewise failed to testify to his transformative artistic intent in a way that was "palatable to the courts."[62] But rather than finding Prince's intent as dispositive of an absence of transformative use, the Second Circuit instead focused its analysis on the visual elements of the artworks themselves, and accordingly, "who should be doing the viewing," before establishing that the relevant viewer for the purpose of this inquiry was the reasonable observer.[63]

Yet, critics of the Second Circuit's approach have challenged the wisdom of condensing the more flexible language of the *Campbell* test into the fixed, universal viewpoint of the reasonable observer. Adler argues the Second Circuit's articulation of the reasonable observer test simultaneously leaves open and puts more pressure on the question of *who* should be characterized as the reasonable observer.[64] This question may have particularly profound consequences in the context of the contemporary visual arts because contemporary art is "an insider's game," that perennially runs the risk of "alienat[ing] the reasonable observer," with its opaque conceptual goals and jargon-heavy nature.[65] *Cariou* proposed a court should determine whether a reasonable observer would find a secondary work had transformed its source material by "looking at the artworks and photographs side-by-side . . . ."[66] The Second Circuit's transformativeness standard in *Cariou* thus shifted the focus from the artist's intent to an evaluation of the "facial differences"[67] between the source material and the secondary work to determine whether the appropriation artist's works "give Cariou's photographs a new expression, and employ new aesthetics with creative and communicative results distinct from Cariou's."[68] The *Cariou* court's choice to "arbitrarily"[69] remand five of the twenty-five images has been characterized as a testament to the inadequacy of the reasonable observer test

61. Cariou v. Prince, 714 F.3d 694, 707 (2d. Cir. 2013) (emphasis added).
62. Adler, *supra* note 9, at 583.
63. *See id.*
64. *Id.* at 609.
65. *Id.* at 610.
66. *Cariou*, 714 F.3d at 707.
67. Shoshana Rosenthal, *A Critique of the Reasonable Observer: Why Fair Use Fails to Protect Appropriation Art*, 13 COLO. TECH. L.J. 445, 452 (2015).
68. *See Cariou*, 714 F.3d at 708.
69. Rosenthal, *supra* note 67, at 453.

to consistently and fairly assess transformativeness in cases involving the visual arts.[70] The inadequacy of the test stems in part from its inherent incompatibility with appropriation art, a "medium [that] consists of extracting and building upon existing protected works . . . in ways that may not be *facially* apparent or visible."[71] A reasonable observer performing the Second Circuit's proposed side-by-side comparison of the works at issue would thus be unlikely to detect conceptual transformation in works of appropriation art "where an artist's conceptual innovation is the gesture of copying of an original work."[72]

The *Warhol* Second Circuit purports to clarify a transformativeness standard for the first fair use factor,[73] but only repeats the *Cariou* court's mistake under the guise of engaging in a more context-specific analysis. After conceding that its jurisprudence on fair use cases involving aesthetic-to-aesthetic comparisons offers "conflicting guidance,"[74] the court proposes that its analysis of the first factor could be simplified by comparing the works at issue in each case against their respective source materials.[75] The *Warhol* Second Circuit's familiar reliance on a side-by-side comparison of the works at issue and its subsequent fixation on their purely visual differences largely echoes the *Cariou* court's reasonable observer standard. Yet, it is unclear how the Second Circuit's allegedly clarified standard either effectively evaluates purpose or resolves the issues it raised with the district court's analysis. Not only is the Second Circuit's side-by-side comparison less compatible with the visual arts than relying on the artist's intent, but the court's proposed means of achieving a new artistic purpose are also far too limited and simplistic to allow for a meaningful analysis of the first factor.

The Second Circuit's proposed approach of comparing the works at issue in each case against their respective source materials distills the analysis of the first factor into an evaluation improperly based on " 'one relevant fact' . . . its observation, upon a side-by-side comparison of images in the briefs, that Goldsmith's photograph 'remain[ed] the recognizable foundation' for the Prince Series."[76] AWF argues that the Second Circuit's focus on visual similarity at the expense of a more nuanced inquiry into the meaning or message of the secondary work "conflates the

70. *Id.* 459.
71. *Id.* at 456 (emphasis added).
72. *See id.* at 458.
73. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 38 (2d Cir. 2021).
74. *Id.* at 40.
75. *Id.* at 41.
76. Brief for the Robert Rauschenberg Found. et al. as Amici Curiae Supporting Petitioner at 18, Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 143 S. Ct. 1258 (2023) (No. 21-869).

transformativeness and substantial similarity inquiries."[77] Goldsmith refutes this claim by asserting that the Second Circuit expressly asks whether the Prince Series "conveys a new meaning or message separate from its source material" in its search for a "distinct artistic purpose."[78] The Second Circuit includes this language alongside a disclaimer that it declines to "catalog all of the ways" in which an artist might achieve a distinct artistic purpose,[79] yet posits only one reductive way in which a secondary user might achieve this end:"[W]orks that have done so thus far have themselves been distinct works of art that draw from numerous sources, rather than works that simply alter or recast a single work with a new aesthetic."[80] The court's attempt to distill its analysis of purpose into a consideration of the *number* of sources the artist of the secondary work incorporated into their work only emphasizes the arbitrariness of the recognizability standard. By endorsing a standard that prioritizes the quantity of sources incorporated over a qualitative or conceptual change in meaning, the Second Circuit's formulation elides the possibility of an artist using a new aesthetic as a vehicle to communicate a new conceptual meaning or message, and creates a false binary between aesthetic changes and changes to meaning. To the contrary, art history informs us that "an artist can affect a work's meaning with nothing more than a few minor gestures."[81] To ground the meaning of a work in its purely visual resemblances to its source material that are facially discernable to a court when "some works of art . . . derive their meanings and value from historical precedent or some other cultural context, . . . not all of which may be so readily discerned by all viewers" is "to deny understandings that have been apprehended and appreciated by generations of artists, art historians, curators, collectors, and others."[82] Treating only the most obvious, surface-level distinctions that could be picked up by the reasonable observer's untrained eye as indicative of changed meaning or a distinct artistic purpose disregards the documented reality that " '[e]xtremely subtle changes can alter the whole design, feeling, or expression of a[n] [artwork].' "[83]

---

77. *See* Petition for Writ of Certiorari at 34, *Andy Warhol Found. for the Visual Arts*, 143 S. Ct. 1258 (No. 21-869).

78. Brief in Opposition at 18, *Andy Warhol Found. for the Visual Arts*, 143 S. Ct. 1258 (No. 21-869).

79. *Andy Warhol Found. for the Visual Arts*, 11 F.4th at 41.

80. *Id.*

81. Adler, *supra* note 9, at 605.

82. *See* Brief for the Andy Warhol Found. for the Visual Arts, Inc. and the Robert Rauschenberg Found. as Amici Curiae in Support of Further Evidentiary Proceedings for Purposes of Determining Fair Use on Remand at 6–7, Cariou v. Prince, No. 08 Civ. 11327 (DAB) (S.D.N.Y. Oct. 22, 2013), 2013 U.S. Dist. Ct. Briefs LEXIS 8850, at *11–13.

83. Adler, *supra* note 9, at 605 (citation omitted).

The Second Circuit's reductive distinction is particularly dangerous in the realm of the conceptual visual arts, which is defined by the practice of privileging the concept or idea behind an artwork over the visual elements of the finished object.[84] Conceptual art aspires to semantic representation, rather than illustrative, meaning the artist creates with the very intention to "represent something one cannot see with the naked eye."[85] Thus, the court's commitment to reducing a conceptual artwork to its aesthetic resemblance to its source material or the quantity of sources incorporated into it fundamentally asks the wrong questions of the works at the heart of this case. Critiques of the precedent set by the *Cariou* court's emphasis on recognizability are therefore particularly resonant here.[86] Prioritizing the recognizability of the source material over the meaning and message of the secondary work effectively unmoors the Second Circuit's analysis from the essence of the Supreme Court's *Campbell* test.

1. Challenging the Inadequacy of the Second Circuit's Transformativeness Analysis

The Second Circuit and the Supreme Court both recognize the limits of their ability to analyze works of visual art. Yet, a court's unsuitability to the task does not justify settling for a standard as reductive as recognizability in lieu of encouraging the district court to consider expert opinions bearing on the perspective of the intended audience of the works at issue in its evaluation of the first factor. After all, "a side-by-side comparison should be where the analysis starts, not where it stops."[87] The Second Circuit's side-by-side comparison analysis is especially damning in such contexts as ours, when transformative use is not immediately obvious, and the court would require more context to properly evaluate transformativeness.[88] Having determined that transformative use was not evident purely on the surface of the works, the Second Circuit should have proceeded to recognize that "the specialized nature of the work and audience require further fact development and expert testimony" to provide necessary context bearing on transformation, and remanded the case to allow the district court to avail

84. *See* TATE, *supra* note 39.

85. Elisabeth Schellekens, *Conceptual Art*, STAN. ENCYC. PHILOSOPHY (Mar. 23, 2022), https://plato.stanford.edu/entries/conceptual-art [https://perma.cc/M9KR-36TP].

86. Rosenthal, *supra* note 67, at 450–51 ("The precedent set in *Cariou v. Prince* infantilizes appropriation art by requiring courts to compare two works of art based on facially observable content alterations, as opposed to the purpose or conceptual innovation of the artist.").

87. Brief for the Robert Rauschenberg Found. et al. as Amici Curiae Supporting Petitioner, *supra* note 76, at 20 (emphasis omitted).

88. *See id.* at 22.

itself of these resources, rather than "be hamstrung by the Second Circuit's rigid side-by-side rule."[89]

Perhaps an even more fundamental flaw with the Second Circuit's distillation of its transformativeness inquiry into a question of whether essential elements of the source material remain recognizable within the secondary work is that it potentially negates the very function of the fair use defense: "If a prior work is not recognizably present in an accused work, there is no need for fair use in the first place."[90]

The Second Circuit's focus on recognizability also raises the potential risk of the court confusing the non-copyrightable elements of the Goldsmith Photograph (the familiar visage of the pop culture icon) with the protectible artistic choices that Goldsmith made in the process of shooting it (" 'such artistic elements as . . . lighting, . . . skin tone . . . , and the camera angle.' . . . [and their] selection and arrangement . . . .") [91] The Second Circuit's recognizability standard thereby puts pressure on a court to reliably make these distinctions (which is difficult, even for the artistically trained eye) when evaluating works of appropriation art for the reasons discussed above. Thus, not only does the Second Circuit's approach not resolve the problem of courts being put to a task they are not equipped to perform, but it even forecloses their ability to avail themselves of specialized guidance to more accurately evaluate transformativeness. This only perpetuates the inconsistent interpretation of the first factor to the detriment of artists seeking fair use protection.

B. THE PRINCE SERIES: DERIVATIVE OR TRANSFORMATIVE?

The Second Circuit's side-by-side comparison approach and recognizability standard also pose problems for the notoriously blurry distinction between derivative works and transformative fair use of copyrighted works. Evaluations of fair use have long been complicated by the "inherent tension" between derivative works protected under section 106 of the Copyright Act and the transformative fair use of copyrighted works permitted under section 107.[92] The Copyright Act recognizes the exclusive right of the copyright holder to prepare derivative works based upon the copyrighted work (subject to 17 U.S.C. § 107).[93] 17 U.S.C. § 101 defines a derivative work as "a work based upon one or more preexisting works . . . in

89. *See id.* at 25.

90. Brief of Copyright Law Professors as Amici Curiae in Support of Petitioner at 17, Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 143 S. Ct. 1258 (2023) (No. 21-869).

91. *Id.* at 21 (quoting Leibovitz v. Paramount Pictures Corp., 137 F.3d 109, 116 (2d Cir. 1998)).

92. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 39 (2d Cir. 2021).

93. 17 U.S.C. § 106 (Westlaw through Pub. L. 117–262).

which a work may be recast, transformed, or adapted."[94] But a work is not necessarily derivative "simply because it is 'based upon' the preexisting works."[95] Rather, subsequent case law has limited the statutory protection of derivative works to works that are " 'recast, transformed, or adapted' into another medium, mode, language, or revised version, while still representing the 'original work of authorship.' "[96]

Under this revised definition, a court's analysis of whether a secondary work constitutes a derivative work focuses on whether the work sufficiently transforms the original work to manifest a distinct purpose from the original work of authorship. In *Warner Bros. Entertainment Inc. v. RDR Books*, a reference guide to the fictional world of Harry Potter was not proven to be a derivative work despite retaining substantial amounts of its source material (J.K. Rowling's original seven novels and two companion books), because the guide did not merely "recast the material in another medium to retell the story of Harry Potter," but instead, by "condensing, synthesizing, and reorganizing the preexisting material . . . [it] g[a]ve the copyrighted material another purpose" and thereby "no longer 'represent[ed] [the] original work[s] of authorship.' "[97]

In the same vein, the *Cariou* court distinguishes the derivative works that "merely present[] the same material but in a new form" from the twenty-five works by Prince that were deemed transformative because they "have a different character, give Cariou's photographs a new expression, and employ new aesthetics with creative and communicative results distinct from Cariou's."[98] Prince's appropriation artworks were transformative and not derivative because the artist's aesthetic alterations to the original conveyed a distinct expressive purpose from Cariou's photographs. Though the *Warhol* Second Circuit acknowledges that the *Cariou* court's decision was "correct[] on its own facts," it charges the *Warhol* district court with stretching *Cariou*'s conclusions too far and "risk[ing] crowding out statutory protections for derivative works."[99]

Yet, it remains unclear whether the Second Circuit's own analysis succeeds at clarifying the distinction between derivative and transformative works of visual arts. The *Warhol* district court's determination of transformativeness appears to hew closely to the language used in *Cariou*. The court identifies alterations made by Warhol in the Prince Series—adding

94. 17 U.S.C. § 101 (Westlaw through Pub. L. 117–262).
95. Warner Bros. Ent. Inc. v. RDR Books, 575 F. Supp. 2d 513, 538 (S.D.N.Y. 2008).
96. *Id.*
97. *Id.* at 539.
98. Cariou v. Prince, 714 F.3d 694, 708 (2d Cir. 2013).
99. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 38–39 (2d Cir. 2021).

"loud, unnatural colors, in stark contrast with the black-and-white original photograph" and softening his bone structure (emphasized in the Goldsmith Photograph)—to determine whether they "result in an aesthetic and character different from the original."[100] The court's analysis thus remains true to the *Cariou* standard, which found that twenty-five of Prince's works were transformative, and not derivative, because Prince " 'add[ed] something new' and presented images with a fundamentally different aesthetic."[101] In fact, the *Warhol* district court's analysis seems to interpret the *Cariou* test more narrowly than the Second Circuit does in its own, rather vague evaluation of whether the Prince Series was derivative. The Second Circuit concedes that altering an original with " 'new expression, meaning, or message' whether by the use of 'new aesthetics,' [or] by placing the work 'in a different context,' . . . is the *sine qua non* of transformativeness," but nevertheless concludes that evidence of a secondary work "add[ing] a new aesthetic or new expression to its source material" is not dispositive of transformativeness as "there exists an entire class of secondary works that add 'new expression, meaning, or message' but may nonetheless fail to qualify as fair use: derivative works."[102] While it does not go so far as to characterize the Prince Series as derivative, the Second Circuit applies the standard for derivative works it established in *Cariou* to the Prince Series and finds the works are "much closer to presenting the same work in a different form, . . . than they are to being works that make a transformative use of the original."[103] The court thereby proceeds to narrow the *Cariou* standard for derivative works even further to deny fair use protection to "many derivative works that 'add something new' to their source material . . . ."[104]

Far from resolving the tension between derivative and transformative works, the Second Circuit collapses the distinction even further by complicating the characterizations of derivative works that have been established in past cases. The court falls back on its recognizability analysis to characterize the Prince Series as more derivative than they are transformative; it observes that despite Warhol's alterations, the Goldsmith Photograph "remains the recognizable foundation upon which the Prince Series is built," and therefore Warhol's work cannot be held to be transformative as a matter of law.[105] Rather than clarifying the standard for

100. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 382 F. Supp. 3d 312, 326 (S.D.N.Y. 2019).

101. *Cariou*, 714 F.3d at 708.

102. *Andy Warhol Found. for the Visual Arts*, 11 F.4th at 38–39 (internal citations omitted).

103. *Id.* at 43.

104. *See id.* at 39.

105. *See id.* at 43.

transformativeness as it set out to do in its decision, the Second Circuit seems to fall into the very trap it sought to avoid—forcing judges to "assume the role of art critic."[106] Under the Second Circuit's standard, in lieu of inquiring into artistic intent or meaning, a judge must instead evaluate transformativeness by performing the more demanding task of identifying the "essential elements" of an artwork and evaluating such abstract qualities as their "cumulative effect" and the "tenor" or "impression" the work creates. It is difficult to see how judges, likely with limited knowledge of the arts, are better equipped to perform this analysis than they are to evaluate whether artworks presented a "new expression, meaning, or message" under the guidance of the *Campbell* test.

Perhaps then, it is unsurprising that courts tasked with a highly abstract analysis yet limited to a surface-level side-by-side comparison of the visual elements of the work, turn to reductive, formulaic methods of evaluating transformativeness, such as counting the number of sources incorporated into the new work. As discussed above, recognizing artworks that incorporate numerous sources into a secondary work as sufficiently transformative, but not works that "alter or recast a single work with a new aesthetic,"[107] dismisses the possibility of a secondary user recasting their source material with a new aesthetic as an act of *conceptual* transformation. This standard improperly narrows the Second Circuit's own articulation of the distinction between derivative and transformative works in *Cariou*, as well as the case law on derivative works and their limits. Secondary works that give an original work a new purpose by "condensing, synthesizing, and reorganizing the preexisting material," even without incorporating additional sources, have been held to be non-derivative when the inquiry properly focuses on whether the secondary work manifested a distinct purpose from its source material, and not simply whether the secondary work is recognizable "based upon" the preexisting works.[108]

The Second Circuit's reductive standard therefore has the destructive potential to police and chill creative expression. Under this standard, artists seeking the protection of the fair use doctrine, must make every act of conceptual innovation objectively and facially manifest to the untrained eye. The Second Circuit's approach to fair use would thus deny the doctrine of its very purpose—to "permit[] courts to avoid rigid application of the copyright statute when . . . it would stifle the very creativity which that law is designed to foster."[109] By attempting to prevent courts from performing qualitative

106. *Id.* at 41.
107. *Id.*
108. Warner Bros. Ent. Inc. v. RDR Books, 575 F. Supp. 2d 513, 538–39 (S.D.N.Y. 2008).
109. Harper & Row, Publishers, Inc., et al. v. Nation Enters. et al., 471 U.S. 539, 550 n.3 (1985).

inquiries into artistic meaning that they are not equipped to make, the Second Circuit risks more heavy-handedly infringing on the creative process that gives rise to artistic meaning or purpose. This risk signals a dangerous inconsistency in the court's understanding of the scope of its own role when analyzing fair use in cases involving the visual arts.

But courts can still find transformative use even without deciphering the opaque language of the Second Circuit's proposed standard. While the Second Circuit neglects to define what the tenor or impression of a work might be and forecloses the possibility of courts availing themselves of resources that would provide necessary guidance on the visual arts, it establishes that these considerations nevertheless cannot outweigh a determination that the secondary work retains the *essential elements* of its source materials (yet another ambiguous phrase the court neglects to define).[110] Thus, a basic finding of the recognizability of the source material within the secondary work could foreclose the more nuanced (albeit ill-defined) analysis of transformative use the Second Circuit claims to perform. The court's willingness to end its transformative use inquiry upon finding that the original work remains recognizable as the source of the secondary work without proceeding to an evaluation of whether the secondary work is nonetheless "meaningfully and expressively distinct"[111] from the primary work flouts the Supreme Court's precedent in *Campbell*:

> *Campbell* teaches that the degree of resemblance between a new and old work is the beginning of the fair use analysis, not the end. A court must ask whether the resemblance has a novel expressive function. Where a reasonable observer can discern a new meaning . . . the work is transformative, not derivative.[112]

III. ADAPTING SUBSTANTIAL SIMILARITY TO FAIR USE

A. THE ARTIST FORMERLY KNOWN AS PRINCE: A SUBSTANTIAL SIMILARITY ANALYSIS OF THE PRINCE SERIES AND THE GOLDSMITH PHOTOGRAPH

While the *Warhol* district court did not consider the issue of substantial similarity because "it [was][] plain that the Prince Series works are protected by fair use,"[113] the Second Circuit performs a brief substantial similarity analysis in response to a request by AWF to remand the case on the grounds

110. *See Andy Warhol Found. for the Visual Arts*, 11 F.4th at 31.

111. Brief for the Robert Rauschenberg Found. et al. as Amici Curiae Supporting Petitioner, *supra* note 76, at 14 (emphasis omitted).

112. *Id.* at 15.

113. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 382 F. Supp. 3d 312, 324 (S.D.N.Y. 2019).

that the Prince Series and Goldsmith Photograph are not substantially similar.[114] Offered the opportunity to remand the issue of substantial similarity to the district court, as has been its "distinctly preferred practice," the Second Circuit declines to do so here in part "because the factors we have already discussed with respect to fair use go a considerable way toward resolving the substantial similarity issue . . . ."[115] As discussed above, the Second Circuit's oversimplified fair use analysis should not foreclose the district court's independent evaluation of substantial similarity on remand.

Like fair use, substantial similarity inhabits a fraught space in the copyright regime—"[t]he determination of the extent of similarity that will constitute a *substantial*, and hence infringing, similarity presents one of the most difficult questions in copyright law, . . . the entire exercise delves into judge-made law, as Congress has never legislated the appropriate standard—and the Supreme Court itself has not weighed in to give definition to the field, ..."[116] Substantial similarity in a copyright infringement case is a question of fact for the jury.[117] Circuit courts have fundamentally followed the approach established by the Second Circuit in *Arnstein v. Porter* to evaluate whether the degree of similarity between the works at issue amounts to copyright infringement. To resolve the question of whether a singer improperly appropriated the plaintiff's musical compositions, *Arnstein* defined the proper inquiry as whether the singer "took from plaintiff's works so much of what is pleasing to the ears of lay listeners, who comprise the audience for whom such popular music is composed . . . ."[118] The *Arnstein* analysis thus appears to establish that the relevant audience to determine substantial similarity is the typical consumer of the work; substantial similarity is a question for the jury, which the *Arnstein* court saw as "representative of the consumer," as opposed to the judge, who was less likely be a consumer of popular music.[119] *Arnstein* expressed a willingness to permit expert testimony to weigh on the question of improper appropriation, only if used to assist the jury in determining the reactions of ordinary lay listeners.[120] The court's designation of the relevant audience as a typical consumer of the work reflects a recognition that consumers in the field to which the copyrighted work belongs often are able to perceive

114. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 53 (2d Cir. 2021).

115. *Id.* at 52, 55–56.

116. NIMMER & NIMMER, *supra* note 19, at § 13.03[A].

117. Arnstein v. Porter, 154 F.2d 464, 473 (2d Cir. 1946).

118. *Id.*

119. Jeanne C. Fromer & Mark A. Lemley, *The Audience in Intellectual Property Infringement*, 112 MICH. L. REV. 1251, 1269 (2014).

120. *Arnstein*, 154 F.2d at 473.

qualities of the work that the lay observer cannot and that this specialized knowledge has a rightful place in the infringement analysis.

Subsequent Second Circuit substantial similarity cases applying *Arnstein* consistently rely on a more universal audience construct to determine appropriation: "the ordinary observer."[121] The Second Circuit's departure from the tradition of establishing the typical consumer as the relevant audience to determine substantial similarity demonstrates a familiar inclination towards reducing complex analyses that benefit from flexibility into rigid, oversimplified inquiries. The court carves out an exception to its dependence on the ordinary observer for infringement cases involving software and designates the software expert as the proper audience to evaluate substantial similarity.[122] The Second Circuit bases this departure on "the highly complicated and technical subject matter" of computer programs and the reality that they "are likely to be somewhat impenetrable by lay observers . . . and, thus, seem to fall outside the category of works contemplated by those who engineered the *Arnstein* test."[123] Though the Second Circuit has suggested "more generally that expert testimony might be relevant when dealing with 'art forms [that are not] readily comprehensible and generally familiar to the average lay person,' "[124] it applies this exception sparingly.[125]

Perhaps unsurprisingly, the Second Circuit declined to apply a more discerning observer test to evaluate the substantial similarity of the Prince Series and the Goldsmith Photograph. AWF and its amici advocated for this test by highlighting the unique challenge an ordinary observer would face in applying the substantial similarity test to photographs, which contain both protectable and unprotectable elements.[126] The court nonetheless rejected this argument on the grounds that works that receive the more discerning observer test typically contain a larger share of non-copyrightable elements, whereas photographs do not contain any more non-copyrightable elements than other expressive works, such as books or paintings.[127] The Second Circuit's misplaced focus on quantifying the individual non-copyrightable elements distracts from a qualitative consideration of the heightened difficulty a lay observer with an untrained eye might experience in extracting the protectable elements from the unprotectable elements in works of

121. Fromer & Lemley, *supra* note 119, at 1269.
122. *Id.* at 1271.
123. Comput. Assocs. Int'l, Inc. v. Altai, Inc., 982 F.2d 693, 713 (2d Cir. 1992).
124. Fromer & Lemley, *supra* note 119, at 1271.
125. *See* Rosenthal, *supra* note 67, at 462.
126. *See* Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 53 (2d Cir. 2021).
127. *Id.*

appropriation art, which transform their source material in less overt and more conceptual ways. If the average lay person cannot accurately exclude the non-protectable elements from their analysis of whether the protectable elements of the works at issue are substantially similar, the ordinary observer might be improperly "inclined to view the entire work—consisting of protectable and unprotectable elements—as one whole."[128]

The Second Circuit confronted the importance of using a more discerning observer who could distinguish protectable original elements from unprotectable elements to determine similarity where a work is not "wholly original" in *Boisson v. Banian*.[129] The risk of conflating the protectable and unprotectable elements of a work of art is only exacerbated in the context of appropriation art, where an ordinary reasonable observer is even more susceptible to confusing the unprotectable elements of the source material (such as the subject's visage) with its protectable elements. Further, even if an average lay observer can recognize and extract the *individual* artistic choices Goldsmith made in her original photograph (relatively prominent elements like cropping or camera angle), it is her "selection and arrangement of the photo's otherwise unprotected elements" that is protected by copyright, "not any of the individual elements standing alone."[130]

B. APPLYING THE SUBSTANTIAL SIMILARITY AUDIENCE TO FAIR USE

As AWF argues in its Petition for Certiorari, the Second Circuit's narrow focus on recognizability and the visual similarities between the works at issue "has collapsed the transformativeness inquiry into the

128. Rosenthal, *supra* note 67, at 462.

129. Boisson v. Banian, Ltd., 273 F.3d 262, 272 (2d Cir. 2001). Boisson brought suit alleging that Banian infringed on her copyrighted quilt designs. On appeal, Banian attempted to invalidate Boisson's copyrights by arguing that her designs combined original design elements and unprotectable elements from the public domain. The Second Circuit concluded there was insufficient evidence to support Banian's claim and ultimately held that two of Banian's designs infringed on Boisson's copyright.

130. Rentmeester v. Nike, Inc., 883 F.3d 1111, 1119 (9th Cir. 2018). ("[P]hotos can be broken down into objective elements that reflect the various creative choices the photographer made in composing the image—choices related to subject matter, pose, lighting, camera angle, depth of field, and the like. But none of those elements is subject to copyright protection when viewed in isolation.") (citation omitted). In a decision that "triggered extensive debate about the scope of copyright protection for photographs," the Ninth Circuit held that Nike had not infringed on photographer Jacobus Rentmeester's copyright in a photograph of Michael Jordan by commissioning a photograph of Jordan that later inspired Nike's iconic "Jumpman" logo. Luke Nikas & Maaren Shah, *Rentmeester v. Nike: Copyright Protection for Photography*, QUINN EMMANUEL URQUHART & SULLIVAN, LLP (Jan. 9, 2019), https://www.quinnemanuel.com/the-firm/publications/rentmeester-v-nike-copyright-protection-for-photography [https://perma.cc/CG5E-LMY7]. The court observed that while the two photos shared "undeniable similarities at the conceptual level . . . Nike's photographer made choices regarding selection and arrangement that produced an image unmistakably different from Rentmeester's photo in material details." Rentmeester v. Nike, Inc., 883 F.3d at 1122–23.

antecedent substantial similarity analysis."[131] The substantial similarity doctrine asks a court to determine that a defendant's copying is "quantitatively and qualitatively enough like the original to render it actionable as infringement" by conducting a "simple comparison of the two works."[132] The language of quantitative similarity to the original is highly reminiscent of the *Warhol* Second Circuit's emphasis on recognizability and its attempts to enumerate Warhol's alterations to the Goldsmith Photograph. Much like how the substantial similarity doctrine tasks the jury with evaluating the degree of similarity by comparing the works at issue, the *Warhol* Second Circuit evaluates transformative purpose using a side-by-side comparison of the secondary work and its source material.

Although the Second Circuit ultimately concluded that the Prince Series and the Goldsmith Photograph were substantially similar because the enduring recognizability of the Goldsmith Photograph within Warhol's work made it so that "any reasonable viewer . . . would have no difficulty identifying the [Goldsmith Photograph] as the source material for Warhol's Prince Series"[133] works, the substantial similarity analysis may still guide the fair use doctrine in productive ways. The Fourth Circuit's approach to substantial similarity resolves the issues stemming from the lay observer's unsuitability to the task of evaluating similarity by orienting the inquiry toward the copyrighted work's intended audience. The Fourth Circuit has consistently identified the typical consumer as the relevant audience in copyright infringement cases.[134] In *Dawson v. Hinshaw Music, Inc.*, the Fourth Circuit embraced the *Arnstein* audience and recognized the need to evaluate similarity from the intended consumer's perspective in order to achieve "copyright law's purpose of protecting a creator's market."[135] The Fourth Circuit's substantial similarity analysis thereby interprets *Arnstein* as "requir[ing] that where the intended audience is significantly more specialized than the pool of lay listeners, the reaction of the intended audience would be the relevant inquiry."[136]

Professors Jeanne C. Fromer and Mark A. Lemley have noted the potential benefit of applying the "hybrid audience" model for substantial similarity to fair use, which "would also benefit from an explicit appreciation of both consumer and expert views."[137] In recognition of the similarities

131. Petition for Writ of Certiorari, *supra* note 77, at 34.

132. Shyamkrishna Balganesh, Irina D. Manta & Tess Wilkinson-Ryan, *Judging Similarity*, 100 IOWA L. REV. 267, 268–269 (2014).

133. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 54 (2d Cir. 2021).

134. Fromer & Lemley, *supra* note 119, at 1272.

135. Dawson v. Hinshaw Music, Inc., 905 F.2d 731, 734 (4th Cir. 1990) (emphasis added).

136. *Id.*

137. Fromer & Lemley, *supra* note 119, at 1300.

between these two fields of copyright inquiry, this Note proposes a novel approach to fair use analysis in the context of the visual arts that would allow district courts to supplement their evaluation of the fair use factors with a formal consideration of the perspective of the copyrighted work's intended audience: here, the typical art market consumer or magazine editor. By modeling their fair use analysis after the Fourth Circuit's substantial similarity analysis, district courts could avail themselves of survey evidence or expert testimony reflecting the prevailing views of art market consumers on the expressive and commercial distinctiveness of the works at issue.

The need to consider the vantage point of an informed observer with a specialized understanding of the field is particularly urgent in fair use cases touching contemporary conceptual art. Despite Warhol's familiarity to most, the fact remains that a vast majority of the public continues to find the field of contemporary art "impenetrable and even perverse."[138] Warhol's intended audience is thus significantly more specialized than the pool of lay observers, so the art market consumer's perception of the works at issue would be the relevant inquiry for an analysis of transformative use or market effect. The art market consumer would be the most relevant audience with respect to the first and fourth fair use factors[139] because their familiarity with different fields of art would allow them to identify relevant distinctions between the works at issue that would go undetected by the untrained or uninterested eye. Under the first factor, expert testimony and survey evidence would bear on whether an art market consumer perceives a difference in purpose between the works at issue. Under the fourth factor, the evidentiary analysis would reflect whether an active participant in the current art market believes that each of the images at issue could act as a substitute for the other in the relevant market.

Whereas substantial similarity is a question of fact for the jury,[140] courts generally regard fair use as a "mixed question of law and fact."[141] Where the district court has "found facts sufficient to evaluate each of the statutory factors"[142] and resolved all issues of fact, an appellate court can conclude that the challenged use does not qualify as fair use of the copyrighted work.[143] Here, the *Warhol* district court did not find facts sufficient to properly evaluate the first and fourth statutory factors. Though the court

138. Adler, *supra* note 9, at 614–15.

139 *See supra* Part I (The first factor looks at the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes. The fourth factor concerns the effect of the use upon the potential market for or value of the copyrighted work.).

140. Arnstein v. Porter, 154 F.2d 464, 473 (2d Cir. 1946).

141. Harper & Row, Publishers, Inc., et al. v. Nation Enters. et al., 471 U.S. 539, 560 (1985).

142. *Id.*

143. Pac. & S. Co. v. Duncan, 744 F.2d 1490, 1495 (11th Cir. 1984).

ultimately concluded that Warhol's use of the Goldsmith Photograph was transformative, its analysis was grounded in its own lay judgments of the differences between conceptual appropriation artworks and photorealistic portraits. Thus, as Judge Wallace suggests in his *Cariou* dissent, much like how an appellate court would remand a case for reconsideration upon correcting an erroneous legal standard employed by the district court, this standard "should apply . . . where factual determinations must be reevaluated—and perhaps new evidence or expert opinions will be deemed necessary by the fact finder . . . ."[144]

1. The Art Market Consumer as a Reasonable Observer

District courts typically do not formally consider survey evidence and expert testimony to determine the perspective of a work's intended audience in evaluating fair use. While fair use case law has rejected the use of survey evidence reflecting consumers' perceptions of the copyrighted work's meaning in which a consideration of majority viewpoints risked "silenc[ing] artistic creativity."[145] In *Mattel Inc. v. Walking Mountain Productions*, the Ninth Circuit declined to consider Mattel's use of surveys of the public in its evaluation of whether photographs that incorporated Mattel's famous Barbie doll qualified as parody because doing so defies the purpose of fair use.[146] However, courts have not ruled on the question of whether to grant the use of survey evidence or expert testimony that would protect or even bolster creative expression. Encouraging district courts to supplement their statutory analysis with consumer survey evidence or expert testimony can help resolve the inconsistency that has long plagued the application of the fair use doctrine in cases that concern "art forms [that are not] readily comprehensible and generally familiar to the average lay person."[147] A better informed and more predictable application of the fair use doctrine would, in turn, more faithfully serve the utilitarian objectives of copyright by incentivizing the progress of a wider range of useful arts.

Conceptual art, and appropriation art in particular, pose unique challenges to an ordinary reasonable observer bound by the Second Circuit's

144. Cariou v. Prince, 714 F.3d 694, 712 (2d Cir. 2013) (Wallace, J., dissenting).

145. Mattel Inc. v. Walking Mountain Prods., 353 F.3d 792, 801 (9th Cir. 2003).

146. *Id.* ("Mattel offered into evidence a survey in which they presented individuals from the general public in a shopping mall with color photocopies of Forsythe's photographs and asked them what meaning they perceived. . . . Use of surveys in assessing parody would allow majorities to determine the parodic nature of a work and possibly silence artistic creativity. Allowing majorities to determine whether a work is a parody would be greatly at odds with the purpose of the fair use exception and the Copyright Act.").

147. *See* Fromer & Lemley, *supra* note 119, at 1271 (quoting Comput. Assocs. Int'l, Inc. v. Atlai, 982 F.2d 693, 713 (2d Cir. 1992)).

side-by-side comparison analysis under the first factor. The lay observer's inability to fully appreciate the various means by which appropriation artists can conceptually distinguish their work from their source material only "aggravates the inconsistency" that plagues the evaluation of transformative use.[148] Consequently, under the side-by-side comparison approach, works of appropriation art where the artist's conceptual innovation is not abundantly apparent on its surface or necessitates more significant physical copying of the source material will continue to be denied fair use protection.

Yet, the Second Circuit's continued insistence on allowing expert testimony to bear on its fair use analysis solely in cases involving software speaks to its enduring reluctance to recognize the heightened risk of a reasonable observer failing to discern "facially undifferentiated distinctions"[149] in works of appropriation art. In *Google LLC v. Oracle America, Inc.*, the last major fair use decision the Supreme Court heard prior to *Warhol* , the Court did not "rely on its own gut instinct about software,"[150] but deferred to the significant evidence the jury heard at trial to find that Google's incorporation of Oracle's copyrighted code into its new program constituted fair use. In its analysis of the first factor, the Court emphasized that Google's precise copying was transformative because it furthered the development of computer programs, thereby promoting the spirit of progress at the heart of copyright.[151] The *Warhol* Second Circuit, however, was adamant in dismissing the applicability of *Oracle* to "contexts such as ours," which it distinguishes from the "unusual context of [*Oracle*], which involved copyrights in computer code"[152] by citing the Court's suggestion that "copyright's protection may be stronger where the copyrighted material . . . serves an artistic rather than a utilitarian function."[153] The Second Circuit's hostility to the prospect of supplementing its fair use analysis in cases involving the visual arts is representative of a general inclination of courts to supplement the reasonable observer test "when the subject matter at issue is *technically* complex, but not when the subject matter is philosophically or conceptually difficult to discern on the surface of the works."[154] Notwithstanding the undisputed difference in subject matter in *Oracle* and *Warhol*, the *Oracle* Court's deference to expert guidance in its analysis of the first factor should inform the approach that

148. Rosenthal, *supra* note 67, at 455.

149. *Id.* at 462.

150. Brief for the Robert Rauschenberg Found. et al., as Amici Curiae Supporting Petitioner, *supra* note 76, at 20.

151. *See* Google LLC v. Oracle Am., Inc., 141 S. Ct. 1183, 1188 (2021).

152. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 51 (2d Cir. 2021).

153. *Oracle Am.*, 141 S. Ct. at 1197.

154. Rosenthal, *supra* note 67, at 462 (emphasis added).

courts take to fair use cases in the arts that similarly involve a specialized audience or demand industry-specific knowledge.

Further, treating the conceptual visual arts as the Court would "any other fact-bound inquiry that requires specialized knowledge" by "allowing consideration of context and opinion testimony" reduces the risk of the judge "assum[ing] the role of the expert."[155] In fact, encouraging courts to hear expert testimony on whether a typical art market consumer would find a secondary work sufficiently transformative could relieve courts of their unease about "second-guessing artistic judgments,"[156] thereby addressing a key factor in the inconsistent application of the fair use doctrine to the visual arts. *Warhol* provided the Court an opportunity to refine the fair use analysis by allowing courts to make informed, context-specific determinations that in turn cement a less capricious understanding of transformativeness in the contemporary visual arts. A clarified legal standard for transformativeness that is shaped in part by the perspective of an art market consumer with an understanding of conceptual art could extend fair use protection to artists in cases "where transformative meanings found in secondary works 'arise less out of visible differences than on differences in [sic] context.' "[157]

Adopting the Fourth Circuit's substantial similarity analysis to fair use would allow courts to supplement their comparison of the visual elements of the works at issue with an appreciation of the acts of *conceptual* innovation within them that may not meet the untrained eye but still imbue the secondary work with a distinct meaning and message from its source material. Encouraging courts to avail themselves of survey evidence or expert testimonies might help remedy the inherent incompatibility of the task of looking for transformative meaning purely in the visual elements of works of art when "within the context of art history, the 'purely' visual has never been the measure of how meaning is created."[158] Experts could testify that an art market consumer likely perceives that the expressive aim of Goldsmith's celebrity portraiture differs from that of Warhol's conceptual art. The art market consumer's understanding of appropriation art thus could bring Warhol's conceptual innovation to the surface—allowing courts to evaluate transformativeness with an understanding of the key conceptual changes Warhol made to the meaning or message of the Goldsmith

155. *See* Brief for the Robert Rauschenberg Found. et al. as Amici Curiae Supporting Petitioner, *supra* note 76, at 24.

156. Ginsburg, *supra* note 59, at 280.

157. Rosenthal, *supra* note 67, at 466.

158. Brief for the Andy Warhol Found. for the Visual Arts, Inc. and the Robert Rauschenberg Found. as Amici Curiae in Support of Further Evidentiary Proceedings for Purposes of Determining Fair Use on Remand, *supra* note 82, at 7.

Photograph that went undetected in the Second Circuit's side-by-side comparison of the purely facial resemblances between the works at issue.

Art world consumers value Warhol for his provocative conceptual experimentations. Warhol's use of his photographic source material strategically served his conceptual aim to make his audience aware of the sitters as "images or symbols through the manipulation of colour and shadow."[159] Close physical emulation of publicity photographs like the Goldsmith Photograph became the very means by which Warhol was able to turn the meaning of these photographs on their head: "Whereas pictorials in the media transformed the private into public spectacle. Andy Warhol displayed the public symbol as a straightforward aesthetic spectacle. He did not reveal the private, he elided it."[160] Though the Second Circuit weighed the recognizability of the Goldsmith Photograph within the Prince Series against a finding of transformative use under the first factor, the continued recognizability of the source material within Warhol's silkscreen work was key to conveying its transformed meaning.

In contrast, Goldsmith's Brief in Opposition cites Myra Kremian, a photo editor who worked with Goldsmith on Newsweek magazine, and characterizes Goldsmith's work as "very polished" and testifies to the photographer's ability to take shots that "brought out a feel for the person themselves,"[161] the person behind the public symbol. Survey evidence or expert testimony on behalf of both parties therefore could indicate that art market consumers or magazine editors perceive the purpose behind each of the works at issue as far more distinct than a quantitative analysis of their facial resemblances may suggest. Thus, allowing the perspective of the relevant audience to formally factor into the court's transformativeness analysis minimizes speculation and allows courts to ground their analysis in credible, context-specific evidence.

Though the Supreme Court does not dedicate as much of its opinion to a visual analysis of Orange Prince as the *Warhol* district court or Second Circuit, the majority consistently recognizes the aesthetic differences between Orange Prince and the Goldsmith Photograph, and their subsequently divergent expressive ends.[162] Nevertheless, because AWF licensed Orange Prince to Condé Nast, the majority found that the Goldsmith Photograph and AWF's specific "copying use" of it shared substantially the

159. Cécile Whiting, *Andy Warhol, the Public Star and the Private Self*, 10 OXFORD ART J. 58, 66 (1987).

160. *Id.*

161. Brief in Opposition, *supra* note 78, at 3.

162. *See* Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 143 S. Ct. 1258, 1268 n.1, 1270, 1278–79 n.11 (2023).

same purpose as "portraits of Prince used to depict Prince in magazine stories about Prince . . . ."[163] This shared purpose and the commercial nature of AWF's usage of Orange Prince both point towards the first factor weighing against fair use.[164] Though the majority briefly acknowledges the possibility that "a use's transformativeness may outweigh its commercial character,"[165] it proceeds to rely on the commercial licensing of Orange Prince to disregard expert opinions on the transformativeness of Warhol's use.

The majority advocates for a balanced evaluation of two considerations under the first fair use factor: (1) whether the use of a copyrighted work has a further purpose or different character (which is a matter of degree) and (2) whether the secondary use is of a commercial nature.[166] It cautions that endorsing "an overbroad concept of transformative use . . . that includes any further purpose, or any different character" would swallow the copyright owner's right to create derivative works,[167] yet dismisses the highly transformative nature of Warhol's work to give disproportionate weight to the commercial nature of its eventual licensing to Condé Nast. The majority may consider a secondary artist's new expression relevant to whether a copying use has a sufficiently distinct purpose or character, but "it is not, without more, dispositive of the first [statutory] factor."[168] Neither is the commercial nature of the work, but the opinion proceeds as if the commercial nature of the secondary use is the only relevant consideration under the first factor.

The majority's disproportionate emphasis on the commercial nature of AWF's usage of Goldsmith's work exists in an illuminating tension with two cardinal fair use cases that have given modern fair use jurisprudence a modicum of direction—*Campbell* and *Oracle*. While the fair use doctrine does not dictate how much weight should be given to commercial nature relative to the weight given to expression, the case law suggests the commercial nature of a work is not the totality of a court's analysis of the first factor—"a finding that copying was not commercial in nature tips the scales in favor of fair use. But the inverse is not necessarily true."[169] In the absence of any fixed metrics to guide the *Warhol* Court, a logical path forward would have been for the Court to follow the precedent it set in *Oracle*—counterbalancing the commercial nature of the secondary use

163. *Id.* at 1273.
164. *Id.* at 1280.
165. *Id.*
166. *Id.* at 1273.
167. *Id.* at 1275.
168. *Id.* at 1273.
169. Google LLC v. Oracle Am., Inc., 141 S. Ct. 1183, 1204 (2021).

against a consideration of the degree to which the secondary use was transformative, "add[ing] something new, with a further purpose or different character" as defined in *Campbell*.[170] As Justice Kagan writes in her dissent, the Court in *Oracle* found that Google's commercial use of Oracle's code was not dispositive of the first factor in light of the "inherently transformative role"[171] it played in Google's creation of "something new and important: a 'highly creative and innovative' software platform."[172] Justice Kagan further cites the Court's decision in *Oracle* as an illustration of "the difference it can make in the world to protect transformative works through fair use"[173] and as evidence of the Court's past willingness to consider "[t]he prospect of [the] loss to 'creative progress' "[174] if Google had not been afforded an "escape valve" to " 'build upon' copyrighted material, so as not to 'put manacles upon' creative progress."[175] Yet, here, because AWF entered into a commercial licensing transaction with Condé Nast, "all the creativity in the world could not save [Warhol]."[176] To this end, the majority echoes the Second Circuit's sympathy towards Goldsmith by painting her as "a self-starter"[177] that the Court must defend against a juggernaut of the art world wielding his celebrity-plagiarist privilege. In line with this narrative, the majority mischaracterizes the more nuanced distinctions drawn by the district court and Justice Kagan's dissent by suggesting they considered Orange Prince fair use simply because "[i]t's a Warhol" and not because it was a transformative work of conceptual art, as opposed to a photorealistic celebrity portrait.[178] Emphasizing AWF's eventual commercial licensing of Orange Prince and reducing the difference between the works at issue to one of artistic worth masks over their fundamentally distinct messages and meanings.

The Court's departure from its decision in *Oracle* speaks to an inconsistency in its analysis of the first factor and the weight the commercial nature of a usage is given in the fair use doctrine. In its unwillingness to engage with the images at the heart of this case and expert opinions on their divergent aesthetics and meaning, the majority adopts a dangerously inconsistent posture toward the weight given to the commercial nature of a

170. *Id.* at 1188.
171. *Id.* at 1204.
172. *Andy Warhol Found. for the Visual Arts*, 143 S. Ct. at 1304 (Kagan, J., dissenting) (quoting *Oracle Am.*, 141 S. Ct. at 1203–24).
173. *Id.*
174. *Id.* at 1300.
175. *Id.* at 1298.
176. *Id.* at 1292.
177. *Id*. at 1266 (majority opinion).
178. *See id.* at 1284 n.19.

secondary use under the first factor. The majority also does little to define or substantiate the Court's capacity to engage independently with the contemporary visual arts; the Court acknowledges that there are conceptual depths to postmodern artworks beyond the scope of its lay analysis, yet confidently dismisses the nuances introduced by expert testimonies to draw its own conclusions about the alleged similarity of their usage. Justice Kagan suggests the majority was only able to reach the conclusion that Orange Prince and the Goldsmith Photograph are "essentially fungible products in the magazine market" by "[i]gnoring reams of expert evidence" to the contrary[179]: "The majority does not see it. And I mean that literally. There is precious little evidence in today's opinion that the majority has actually looked at these images, much less that it has engaged with expert views of their aesthetics and meaning."[180] The Court's refusal to meaningfully engage with expert views bearing on the transformativeness of Warhol's use relegates fair use cases involving the contemporary visual arts to a liminal space in which the works at issue might benefit from specialized knowledge in the form of expert testimony or survey evidence, but do not demand it with the same urgency as more technical fields like software. The *Warhol* majority appears to interpret the ambiguity surrounding the relative importance of each consideration under the first factor as license to engage with and defer to expert testimony when the uses at issue concern fields which the Court deems objectively or technically difficult, and not more *conceptually* foreign fields with which the Court considers itself sufficiently familiar. While not technically intricate in the same way as the computer code at issue in *Oracle*, the subversive ethos and conceptual ambitions of postmodern art remain far from accessible to the lay observer. Thus, courts hearing fair uses cases involving the contemporary visual arts likewise would benefit from relying on experts with specialized knowledge.

The approach proposed by this Note also circumvents the aforementioned problems with relying solely on the artist's intent by shifting the burden away from artists so that a finding of transformative use does not hinge solely on their ability to strategically articulate the meaning behind their own work. Rather, courts could rely on experts from within the relevant community to weigh in on how an artist's work is valued and perceived by audiences familiar with their work or active in the pertinent market. Had the Second Circuit consulted experts well-versed in art history to weigh in on the significant, albeit potentially counterintuitive connection between Warhol's aesthetic alterations to the Goldsmith Photograph and his clear conceptual innovation in Orange Prince, perhaps the court would have been

179. *Id.* at 1301 (Kagan, J., dissenting).
180. *Id.*

less inclined to base its determination of transformativeness on a reductive, false binary between aesthetic changes and changes in meaning.

C. FACTOR FOUR: EVALUATING MARKET EFFECT FROM THE PERSPECTIVE OF THE ART MARKET CONSUMER

Pursuing a more discerning, better-informed analysis of transformativeness under the first fair use factor would also constitute a step toward a more balanced application of the statutory test in its totality. Scholars have warned of the worrying trend toward an overemphasis on the transformative use analysis under the first factor "foreordain[ing] the ultimate outcome, as the remaining factors, especially the fourth . . . withered into restatements of the first."[181]

In its original articulation of the transformativeness analysis, the *Campbell* Court was clear that a finding of transformative use was not a binary determination, but a question of whether and "to what extent" the new work was transformative.[182] Transformative use was not dispositive of fair use, but one factor to be weighed against the remaining three statutory factors: "[T]he more transformative the new work, the less will be the significance of other factors . . . ."[183] Observing the close link between the first and fourth factors, the *Campbell* court noted that "when . . . the second use is transformative, market substitution is at least less certain, and market harm may not be so readily inferred."[184] Ensuing fair use cases echo this correlation: "[T]he more the copying is done to achieve a purpose that differs from the purpose of the original, the less likely it is that the copy will serve as a satisfactory substitute for the original."[185]

Despite this, scholars have raised concerns about the disproportionate weight placed on a finding of transformative use under the first factor, flagging a potential risk of the transformative use analysis subsuming the remaining three statutory factors. Courts like the *Cariou* Second Circuit and the *Warhol* district court have been charged with "veer[ing] off the legislative rails" by "elevat[ing] 'transformativeness' to talismanic significance," over the remaining statutory factors.[186] Empirical studies of fair use opinions show that courts that found a transformative use held for

181. Ginsburg, *supra* note 59, at 266 ("If a transformative use exploits a transformative market and hence a market that does not encroach on the plaintiff's markets, then a court's acceptance of the 'transformativeness' of the use tends to pre-empt the fourth factor.").

182. Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 579 (1994).

183. *Id.*

184. *Id.* at 591.

185. Authors Guild v. Google, Inc., 804 F.3d 202, 223 (2d Cir. 2015).

186. Brief for Professors Peter S. Menell et al. as Amici Curiae in Support of Respondents at 2, Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 143 S. Ct. 1258 (2023) (No. 21-869).

fair use 94% of the time.[187] In *Kienitz v. Sconnie Nation LLC*, the Seventh Circuit critiques the disproportionate weight the *Cariou* court gave to the transformativeness inquiry; charging the Second Circuit with allowing the first factor to override the remaining factors and potentially extinguishing the copyright holder's exclusive right to derivative works, the Seventh Circuit calls for a return to a by-the-book analysis of the four statutory factors, "of which the most important usually is the fourth (market effect)."[188]

In its analysis of the fourth statutory factor, the *Warhol* district court found that the primary markets for "a Warhol and for a Goldsmith fine-art or other type of print are different." [189] Scholars criticize the court for improperly basing this finding in part on the assumption that "Warhol's celebrity sells his works, while Goldsmith shares Cariou's obscurity."[190] The Second Circuit likewise accepts the holding that "the primary market for the Warhol Prince Series . . . and the Goldsmith Photograph do not meaningfully overlap," but nonetheless rejects the district court's "implicit" rationale.[191]

The trickier question under the fourth factor is whether Warhol's Prince Series posed a threat to Goldsmith's derivative licensing markets. Goldsmith claimed that the Warhol prints usurped her licensing market because the Goldsmith Photograph and the Prince Series " 'are illustrations of the same famous musician with the same overlapping customer base' "—both works have appeared in magazines and on album covers.[192] The *Warhol* district court nonetheless dismissed Goldsmith's claim by holding that this alleged overlap does not suggest "that a magazine or record company would license a transformative Warhol work in lieu of a realistic Goldsmith photograph."[193] Seizing once more on the district court's claim that "the licensing market for Warhol prints is for 'Warhols',"[194] the Second Circuit and Goldsmith's amici once more reduced this argument into a superficial distinction between Warhol's celebrity and Goldsmith's relative obscurity when the district court actually identified a more substantial distinction between conceptual art, with its stylized aesthetic and subversive message,

187. Jiarui Liu, *An Empirical Study of Transformative Use in Copyright Law*, 22 STAN. TECH. L. REV. 163, 167 n.19 (2019).

188. Kienitz v. Sconnie Nation LLC, 766 F.3d 756, 758 (7th Cir. 2014).

189. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 382 F. Supp. 3d 312, 330 (S.D.N.Y. 2019).

190. Ginsburg, *supra* note 59, at 282.

191. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 48 (2d Cir. 2021).

192. *Id.* at 49 (quoting Brief for Appellant at 50).

193. *Andy Warhol Found. for the Visual Arts*, 382 F. Supp. 3d at 331.

194. *Id.*

and more traditional portrait photography.[195] Warhol and Goldsmith's derivative markets do not overlap, not, as scholars have suggested, because "Warhol may permissibly preempt Goldsmith's opportunities to license her work simply by being more famous and recognizable than she,"[196] but because even if Warhol's Prince Series works also are licensed for use in magazines and album covers, as Goldsmith claims, the "infringer's target audience and the nature of the infringing content"[197] are not the same as the original. Because editors design magazines and album covers to appeal to targeted consumer bases, they base their choice of art on an understanding of the distinct purposes and aesthetic appeals of a photorealistic portrait and a stylized screen print, respectively, rather than on the notoriety of the artist. Surveys of typical art market consumers could provide the district court guidance as to whether a typical art market consumer would perceive a stylized silkscreen print (or a work of conceptual appropriation art defined more broadly) as a substitute for the Goldsmith Photograph (or a photorealistic portrait). An art market consumer would most likely discern the clear distinctions in genre. Expert testimony could also inform the court that the current preferences of the art market make it nearly impossible to find that the work of one artist usurps the market of another, regardless of their degree of visual similarity.[198] Today, an artist's market is defined less by the visual elements or supposed aesthetic value of the artist's work, than by the artist's reputation or "brand."[199] Thus, expert testimony or survey evidence of consumers active in the current art market would demonstrate that consumers do not consider Warhol's Prince Series a substitute for the Goldsmith Photograph.

Although AWF did not challenge the Second Circuit's determination that the fourth factor favored Goldsmith, and the Supreme Court majority did not conduct its own evaluation of the fourth factor, Justice Kagan accuses the majority of conflating the first and fourth factors by placing a disproportionate emphasis on AWF's commercial licensing of Orange Prince. She proposes a thought experiment that invites the majority to step into the shoes of magazine editors presented with the option to include the Goldsmith Photograph or Orange Prince in an issue to illustrate the inherent unsuitability of the Court to the task and the consequent inadequacy of the

195. *Id.* at 330–31 ("[Goldsmith] provides no reason to conclude that potential licensees will view Warhol's Prince Series, consisting of stylized works manifesting a uniquely Warhol aesthetic, as a substitute for her intimate and realistic photograph of Prince.").

196. Ginsburg, *supra* note 59, at 282.

197. *Andy Warhol Found. for the Visual Arts*, 11 F.4th 26, at 49–50 (quoting Cariou v. Prince, 714 F.3d 694, 709 (2d Cir. 2013)).

198. *See* Adler, *supra* note 9, at 622.

199. *Id.*

majority's ruling. Justice Kagan suggests AWF's licensing of Orange Prince did not meaningfully affect the value of Goldsmith's work in the general magazine market because "the editors of Vanity Fair and Condé Nast understood . . . the gulf in both aesthetics and meaning—between the Goldsmith photo and the Warhol portrait. They knew about the photo; but they wanted the portrait. They saw that as between the two works, Warhol had effected a transformation."[200]

The majority concedes to Justice Kagan's prognosis of its prospects in the magazine business, but defends its decision to characterize both "photos" (Orange Prince is a silkscreen print) as serving the same essential purpose, despite their clear aesthetic dissimilarities, because the editors of magazines that printed memorial issues in commemoration of Prince's death chose to include a "variety of different photos of Prince."[201] If we follow the Court's reasoning to its end, it becomes clear that the logic underlying the majority's defense is limited to the exceedingly specific context of the use at issue here. AWF's licensing of Orange Prince would only pose a threat to Goldsmith in the magazine market in the rare instances that magazines seek to look beyond their usual target audience, the specific message they generally sought to convey, or art style they typically pursued. In the variety that the majority touts as evidence that Orange Prince and the Goldsmith Photograph serve the same purpose lies the proof that being published together in a special issue does not indicate that images of Prince generally serve as substitutes for one another in the magazine market. Rather, different images of Prince communicate distinct messages about the singer; the memorial issue juxtaposed these different images to reflect the exceptional range of his life and career. If these images served the same purpose and were perceived as substitutes that could be used equivalently to illustrate magazine stories, the editors of the Prince memorial issue would not have required such variety. Each image derives its unique value to the magazine and earns its place in the issue because each expresses a fundamentally unique message about the figure depicted—a message that would speak to a specific subsection of the magazine's readership. Thus, the majority's refusal to allocate fair weight to the transformativeness of the secondary use under the first factor only applies to the highly specific context of a work's commercial licensing for a commemorative issue of a magazine; lower courts should interpret the decision accordingly.

200. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 143 S. Ct. 1258, 1297 (2023) (Kagan, J., dissenting).

201. *Id*. at 1278 n.11 (majority opinion).

CONCLUSION

Andy Warhol Foundation for the Visual Arts v. Goldsmith marked a collision of one of the most inaccessible and opaque artistic practices with one of copyright law's most notoriously unpredictable doctrines. Contemporary visual arts have long been a disruptive presence in fair use jurisprudence, but this case stands apart in both its scale and its timing. The last Supreme Court decision on a fair use case centered on the use of computer code, a field that has consistently been recognized for its technical complexity and near-universal impenetrability. Thus, *Oracle* exists in an illuminating tension with the case at hand, *Warhol*. While contemporary art largely remains inaccessible or intellectually alienating to the general public, it has not quite risen to the level of objective complexity that inclines a court to recognize the limits of the uninterested lay observer and seek specialized guidance to supplement its fair use analysis. *Warhol* provided the Supreme Court with an unprecedented opportunity to acknowledge the error of this double standard and to refine a new approach modeled after the Fourth Circuit's substantial similarity analysis.

While the Court by no means fully leveraged this opportunity, the implications of its decision may not be as cataclysmic for the arts as the media coverage of the case and Warhol's prominence in the art world might suggest. As Justice Sotomayor's majority opinion disclaims and Justice Gorsuch's concurrence reinforces, the Court limits its analysis and decision to AWF's commercial licensing of Orange Prince to Condé Nast,[202] and does not rule on whether the work infringes on Goldsmith's copyright.[203] And yet, even if lower courts heed the Court's disclaimers and interpret this holding narrowly, the Court's decision leaves lower courts and the artists appearing before them with minimal guidance on fair use cases involving non-commercial uses. Even if this decision does not spell disaster for creative progress in the dramatic way Justice Kagan prophesies, continuing to allow for the subjectivity and unpredictability inherent in the fair use analysis of contemporary visual art works nonetheless risks chilling artistic expression and innovation, defeating the goal of copyright. The Court's inconsistent utilization of expert testimony or survey evidence in fair use cases that require specialized knowledge continues to disadvantage artists who dare to create, confronted with the knowledge that a court could decide to substitute its lay judgment of their work in lieu of an informed fair use analysis.

Thus, formally incorporating the perspective of the typical consumer of the works at issue into district courts' factual analysis of the first and fourth

202. *Id.* at 1266.
203. *Id.* at 1291 (Gorsuch, J., concurring).

fair use factors would allow creators in the arts to benefit from a more informed, consistent analysis of their use of copyrighted work. Artists could create with a degree of reassurance that courts would consult experts from the relevant fields when evaluating the transformativeness of their work. This Note uses the *Warhol* case as a backdrop to make a larger claim: an inherent friction exists between the centrality of conceptual innovation in the contemporary visual arts and a fair use analysis that privileges the purely visual similarities of the works at issue; the Court should address this conflict by supplementing its fair use analysis with an evidentiary analysis of the perspective of the art market consumer.