

# Supreme Court denies cert in Cariou fair use case: what next?

## THE CASE:

*Cariou v Prince*

Supreme Court of the United States

12 November 2013

Much like the paintings in dispute, the real meaning of the judgement in *Cariou v Prince* is a matter of interpretation. **Douglas W Kenyon** and **Stephen P Demm** investigate the case where everyone's a critic

**Over the past five years, the *Cariou v Prince*<sup>1</sup> case has drawn attention from the art world, the owners and users of photographs and other copyrighted material, and copyright practitioners. On 12 November, 2013, the US Supreme Court denied a cert petition in the case, leaving in place the 2nd US Circuit Court of Appeals' 25 April, 2013, decision holding that most of Richard Prince's paintings appropriating Patrick Cariou's photographs were "transformative", and were therefore fair use under Section 107 of the Copyright Act, regardless of whether those paintings commented on Cariou's photographs. Instead, it was sufficient that a "reasonable observer" would perceive Prince's paintings as adding new expression, meanings, or messages to the photographs. This article provides an update on *Cariou*, including the current proceedings in the Southern District of New York, and considers the impact of *Cariou* on fair use jurisprudence.**

### *Cariou* and its early progeny

Cariou published *Yes Rasta*, a book of original black-and-white portraits of Rastafarians, as well as Jamaican landscapes, taken in the style of "extreme classical photography [and] portraiture".<sup>2</sup> Prince, a well-known appropriation artist, took photographs from the *Yes Rasta* book and used them to create 30 paintings, the *Canal Zone* series. Prince altered Cariou's photographs and their settings, including painting "lozenges" over the subjects' faces, affixing headshots from the photos onto other figures from different sources, enlarging and tinting the photos, and adding paint and other elements, including images of nude women.<sup>3</sup> In some of Prince's paintings, Cariou's photos were "readily apparent". In others, they were "almost entirely obscured".<sup>4</sup> After being shown at a

New York gallery, eight *Canal Zone* paintings sold for \$10,480,000 and seven were traded for art valued at \$6m-\$8m.<sup>5</sup>

Cariou sued Prince, the gallery and others for copyright infringement in the Southern District of New York. The district court granted summary judgment to Cariou, rejecting Prince's fair use defence.<sup>6</sup> The court found Prince's use of Cariou's photographs not transformative and not fair use, because his paintings did not comment on or refer back to Cariou's photographs.<sup>7</sup> The court relied on Prince's deposition testimony that he generally had no interest in the meaning of the photographs he appropriated and did not intend his *Canal Zone* paintings to comment on Cariou's photographs.<sup>8</sup> The court entered an injunction, including possible destruction of Prince's paintings if elected by Cariou.<sup>9</sup>

**"In some of Prince's paintings, Cariou's photos were 'readily apparent'. In others, they were 'almost entirely obscured'."**

In April 2013, the 2nd Circuit reversed the district court's finding of infringement and partially remanded the case. It held that, to be transformative and qualify as fair use, Prince's paintings need not parody or even comment on Cariou's photographs.<sup>10</sup> Instead, Prince's paintings could be transformative as long as they altered Cariou's photographs with some "new expression, meaning, or message".<sup>11</sup> The 2nd Circuit gave little weight to Prince's statements that he did not intend his paintings to comment on Cariou's photos. "What is critical," the court found, "is how the work in question appears to the reasonable observer,

not simply what an artist might say about a particular piece or body of work."<sup>12</sup> Following this principle, the 2nd Circuit compared Cariou's photos and Prince's paintings "side-by-side", concluding that 25 of Prince's paintings were transformative and constituted fair use under the four factors set forth in Section 107 of the Copyright Act. The 2nd Circuit pointed to differences it found in the aesthetics of Cariou's and Prince's works: Cariou's were "serene and deliberately composed portraits and landscape photographs depict[ing] the natural beauty of Rastafarians and their surrounding environs," while Prince's were "crude and jarring" and "hectic and provocative"; Cariou's were "black-and-white-photographs... printed in a 9 1/2" x 12" book," while Prince's were "collages on canvas that incorporate colour, feature distorted human and other forms and settings, and measure between ten and nearly a hundred times the size of the photographs."<sup>13</sup> But the 2nd Circuit found that five of Prince's paintings were aesthetically closer to Cariou's photographs because, for example, they maintained the "pastoral" backgrounds and "lush greenery" of the photos. It remanded these five paintings so the district court could determine whether they were sufficiently transformative to constitute fair use.<sup>14</sup>

The Supreme Court's cert denial leaves the 2nd Circuit's decision standing, with the case proceeding in the Southern District of New York on the five remanded paintings. Recent pleadings in the district court demonstrate how litigants may attempt to prove or disprove fair use applying the *Cariou* test. Cariou is now pointing to visual and thematic similarities between his photographs and the five Prince paintings, and is arguing that the paintings are no more than minimally transformative.<sup>15</sup> In response, Prince is arguing that, because the 2nd Circuit could not determine as a matter of law if a reasonable observer would perceive

the paintings as transformative, that issue should be decided by a jury, aided by expert testimony from art curators and scholars.<sup>16</sup> And in an unusual step at the district court level, the Andy Warhol Foundation and 30 other arts groups filed an *amicus brief* asserting that experts in the arts should be heard in determining whether a reasonable observer would perceive an artwork as transformative, unless transformativeness is readily apparent from the side-by-side inspection.<sup>17</sup> The district court accepted the *amicus brief* and gave *Cariou* until 16 December, 2013, to respond.

Recent decisions within and outside the 2nd Circuit have followed *Cariou* in assessing transformativeness in their fair use analyses. In *Seltzer v Green Day, Inc.*,<sup>18</sup> the 9th US Circuit Court of Appeals found that defendants' use of plaintiff's Scream Icon drawing, with alterations, as part of a four-minute video backdrop for Green Day's concerts, was transformative and fair use, citing *Cariou* for the proposition that "an allegedly infringing work is typically viewed as transformative as long as the new expressive content or message is apparent... even where – as here – the allegedly infringing work makes few physical changes to the original or fails to comment on the original."<sup>19</sup> In *Kienitz v Scornie Nation LLC*,<sup>20</sup> a Wisconsin district court found defendants' use of plaintiff's photo of the mayor of Madison, Wisconsin, with alterations, on a t-shirt chiding the mayor for his opposition to an annual street party was transformative and fair use, quoting *Cariou's* reasoning that "[t]he law imposes no requirement that a work comment on the original or its author in order to be considered transformative," and that, "[i]nstead... to qualify as a fair use, a new work generally must alter the original with new expression, meaning, or message."<sup>21</sup> In *Firesabre Consulting LLC v Sheehy*,<sup>22</sup> the Southern District of New York cited *Cariou's* formulation of transformativeness – "add[ing] something new, with a further purpose or different character, altering the first with new expression, meaning, or message" – but denied defendants' summary judgment motion on fair use because the record was unclear on the nature and extent of any alterations to plaintiff's work.<sup>23</sup>

### The implications of *Cariou*

The Supreme Court's refusal to disturb the 2nd Circuit's *Cariou* decision is a positive development for appropriation artists and other users of copyrighted works. But has *Cariou* clarified or muddied the fair use doctrine, which one commentator has referred to as "the great white whale of American copyright law ... endlessly fascinat[ing] us even as it defeats our every attempt to subdue it?"<sup>24</sup>

And does *Cariou* properly balance the interests of owners and users of copyrighted material, or does it tip the balance too far in favour of users, and thus reduce the incentive to create?

One of the 2nd Circuit's key rulings – that an allegedly infringing work need not comment on the appropriated work to potentially be transformative – seems to follow the Supreme Court's holding in *Campbell*, while arguably making it clearer that *Campbell* was not limited to situations involving parody. The 2nd Circuit also emphasised that an allegedly infringing work may potentially be transformative – and thus fair use – as long as a "reasonable observer" would perceive it as altering the original with some "new expression, meaning, or message". It is questionable whether the 2nd Circuit's articulation provides any clarity here, as there is no indication how much new expression, meaning, or message will suffice to make an otherwise infringing work transformative. And if *any* new expression, meaning, or message is sufficient, then copyright owners may legitimately be concerned that infringing derivative works could be defended as transformative fair use works, eroding the scope of exclusive rights conferred in Section 106 of the Copyright Act.

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It is also unclear who the "reasonable observer" is, or what courts should do to decide how the reasonable observer would perceive the works at issue. The 2nd Circuit indicated that a court can make that determination itself by comparing the works at issue side-by-side. But it then determined that it could not make this call for five of Prince's paintings. On remand, the district court appears receptive to arguments that testimony by art scholars can assist in the inquiry. It remains to be seen what kinds of evidence – expert testimony, surveys or otherwise – will be proffered or accepted in future fair use cases involving appropriation

art, written materials, music, video games, and other kinds of copyrighted works.

### Footnotes

1. *Cariou v Prince*, 784 F. Supp. 2d 337 (SDNY 2011), rev'd, 714 F.3d 694 (2d Cir 2013), cert denied, US, 2013 WL 4522074 (12 Nov, 2013).
2. *Cariou*, 714 F.3d at 699.
3. id. at 699-700.
4. id. at 701, 700.
5. id. at 709.
6. *Cariou*, 784 F. Supp. 2d at 342.
7. id at 348.
8. id at 349.
9. id at 355-56.
10. *Cariou*, 714 F.3d at 706.
11. id (quoting *Campbell v Acuff-Rose Music, Inc*, 510 U.S. 569, 579 (1994)).
12. id.
13. id at 706.
14. id at 711.
15. Memorandum of Law Applying the Second Circuit's Fair Use Standard to the Analysis of the Five Artworks That Have Been Remanded to the District Court, *Cariou v Prince*, Case No 1:08-cv-11327 (SDNY 1 Aug, 2013).
16. Defendants' Memorandum of Law in Response to Plaintiff's Memorandum of Law Applying the Second Circuit's Fair Use Standard, *Cariou v Prince*, Case No. 1:08-cv-11327 (SDNY 15 Oct, 2013).
17. Brief *Amici Curiae* of the Andy Warhol Foundation for the Visual Arts, Inc and the Robert Rauschenberg Foundation in Support of Further Evidentiary Proceedings for Purposes of Determining Fair Use on Remand, *Cariou v Prince*, Case No 1:08-cv-11327 (SDNY 22 Oct, 2013).
18. *Seltzer v Green Day, Inc*, 725 F.3d 1170 (9th Cir 2013).
19. id at 1177 (citing *Cariou*, 714 F.3d at 708).
20. *Kienitz v Scornie Nation LLC*, F. Supp. 2d , 2013 WL 4197454 (WD Wis 15 Aug, 2013).
21. id at \*6 (quoting *Cariou*, 714 F.3d at 706).
22. *Firesabre Consulting LLC v Sheehy*, 2013 WL 5420977 (SDNY 26 Sept, 2013).
23. id at \*9-10.
24. P Goldstein, *Fair Use in Context*, 31 Colum JL & Arts 433 (2008).

### Authors



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