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LITIGATION

## The copyright fair use doctrine: courts poised to seek limiting principles amid the labels

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Litigation over copyright law's fair use doctrine frequently boils down to a battle of labels, with the outcome often depending on whether a use is categorized as parody or satire, transformative or derivative, art or appropriation. Cases now pending in the U.S. 2nd and 9th U.S. Circuit Courts of Appeals will test the issue again in 2012.

The Copyright Act codifies the common law fair use doctrine in a four-factor test set forth in 17 U.S.C. Section 107. In weighing a fair use defense to an infringement claim, courts consider: the purpose and character of the use, the nature of the copyrighted work, the amount and substantiality of the portion taken from the copyrighted work, and the effect of the use on the potential market for the copyrighted work.

Over time, courts have tended to elevate one factor or another to dominance, as a way to simplify the analysis. Traditionally, courts described the fourth factor — market impact — as the most important. Courts also have embraced and abandoned presumptions against commercial uses and against the copying of unpublished materials. In 1994, the U.S. Supreme Court shifted the emphasis to the first factor in *Campbell v. Acuff-Rose Music*.

The Court held that fair use protected rap group 2 Live Crew because its raunchy cover of the Roy Orbison ballad "Oh, Pretty Woman" parodied the sentiments of the earlier song. In doing so, the Court adopted a new test for the first factor — whether the defendant's use is "transformative" of

the original work. According to the Court, a transformative use copies from the original work but "adds something new, with a further purpose or different character." The Court found parody to be a classic fair use, because a parodist must copy aspects of the original work in order to poke fun at it.

Since 1994, courts have treated "transformativeness" as the linchpin of the four-factor test. As the new talisman, however, transformativeness can be an elusive concept.

On one hand, it broadly protects works that parody or comment in some way on the original. Indeed, *Campbell* inaugurated an era of pseudo-academic, post-hoc rationalization, in which lawyers dissected pop culture artifacts like graduate students padding a thesis, laboring to fit anything clever or cool into the "parody" category. The Supreme Court set the tone for this in *Campbell* itself, opining that the rap cover "can be taken as a comment on the naiveté of the original of an earlier day, as a rejection of its sentiment that ignores the ugliness of street life and the debasement that it signifies."

The Court in *Campbell* also attempted to limit the transformative use concept by distinguishing parody from satire, which borrows material in order to ridicule targets other than the original work. If the alleged infringer uses the original work merely "to get attention or to avoid the drudgery in working up something fresh," the work is not transformative and the claim to fair use diminishes.

The Supreme Court adopted the transformative use theory from Judge Pierre Leval's 1990 *Harvard Law Review* article, "Toward a Fair Use Standard." Judge Leval described a transformative use as one in which the original work "is used as raw



Associated Press.

Luther Campbell of the rap group 2 Live Crew speaks at a news conference in 1994 after the U.S. Supreme Court ruled for the group in its lawsuit over Roy Orbison's "Oh Pretty Woman." Graphic.

material, transformed in the creation of new information, new aesthetics, new insights and understandings...."

That idea itself is in tension with copyright law's adaptation right. Section 106(2) of the Copyright Act reflects a legislative judgment to give copyright owners control over the creation of derivative works. The Act defines a derivative work as "a work based on one or more preexisting works" in any form in which the preexisting work "may be recast, transformed, or adapted."

A motion picture or Broadway musical based on a novel surely uses the original as "raw material" in the creation of "new aesthetics." It thus "transforms" the novel,

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but it also has always been understood to be a derivative work that requires a license from the

copyright owner. As this example illustrates, it simply cannot be true that everything labeled as art, as a mash-up, or as an example of "re-mix culture" qualifies as a fair use immune from liability for copyright infringement merely because it "transforms" the original work in some fashion.

Fair use law requires a limiting principle that is not supplied by the "raw materials"

notion alone. This year the 2nd and 9th Circuits will have opportunities to define some of those limits. Both cases raise the question whether the defendant's use must comment on the original work in order to be transformative.

In *Cariou v. Prince*, the 2nd Circuit will consider an appeal from a decision that rejected a fair use defense raised by well-known "appropriation artist" Richard Prince and art dealer Gagosian Gallery. Photographer Patrick Cariou sued based on Prince's use of photographs that Cariou took over a six-year period of Jamaican Rastafarians, which he subsequently published in a book titled "*Yes, Rasta*." Prince lifted 41 images out of "*Yes, Rasta*" as elements for his collage art series called "Canal Zone." Prince enlarged, cropped, tinted, and painted over portions of Cariou's photos, but still copied substantial portions of each work.

Recognizing the tension between fair use and adaptation rights, Judge Deborah Batts of the Southern District of New York held that Prince's paintings could be "transformative" only to the extent that they commented on Cariou's photographs. If they "merely recast, transform[ed], or adapt[ed]" the photos, Prince's works instead would be "infringing derivative works." The court relied in large part on Prince's own testimony that he did not "really have a message" and "did not intend to comment on any aspects of the original works or on the broader culture."

On the other coast, the 9th Circuit will soon consider how the fair use doctrine applies when the defendant substantially alters a work, adds a new meaning and message, but does not comment on the original work. In *Selzer v. Green Day*, Judge Philip Guti-

errez of the Central District of California, found in August 2011 that fair use applied where the band Green Day used an artist's work as part of the background images projected at its concerts.

In 2003, artist Derek Selzer created *Scream Icon* — "a dramatic image of a human face contorted in the expression of a cry or a scream" — and reproduced the image on posters and stickers, which were displayed on buildings, walls, and street signs around Los Angeles. Five years later, defendant Richard Staub, a photographer and set designer, photographed a wall in Los Angeles "covered with street art and graffiti" which also depicted a "torn and weathered" *Scream Icon* poster. After Green Day hired Staub to create video backdrops for its concert tour, he used a portion of his photo for the background displayed during the band's performance of *East Jesus Nowhere*. The song's underlying theme was the hypocrisy of religions. Staub altered his photograph of the *Scream Icon* poster by changing the color and contrast, adding a brick background, and superimposing a red spray-painted cross over the image.

The court agreed with the defendants that the video backdrop constituted a transformative use of Selzer's image. The court focused on how Staub's alteration of the image meshed with the music and lyrics of the Green Day song. While Selzer said that he created *Scream Icon* to represent youth culture and skateboarding, the court found that Staub added imagery to the poster to represent "the relationship between organized religion and pain and suffering." This use was "transformative," the court held, because it "added new meaning" to the original.

Both cases present close questions, and both call upon the appellate courts to address whether the transformative use test requires that the defendant intend to convey a message that comments directly on the original work. If not, then the courts must find another limiting principle that prevents "transformativeness" from overwhelming a copyright owner's right to control the creation of derivative works. Guided by the Supreme Court's distinction between parody and satire in *Campbell*, at a minimum it would seem the second work must comment on some aspect of society or popular culture closely associated with or exemplified by the original work. Such a ruling would not be a judgment that appropriation art is not art. It would mean only that there is no "art" exception to the fair use doctrine, and that appropriation art with no discernible message is infringing art.



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