



Transformative or Not Transformative - That is the Question: Fair Use and Appropriation Art

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"Fair use" is a defense to a claim of copyright infringement. What constitutes fair use is ever evolving. Recently, the federal appeals court in New York heard arguments in a copyright case involving the French photographer Patrick Cariou and the American painter and photographer Richard Prince, *Cariou v. Prince*. Cariou claimed that Prince improperly used Cariou's photographs of Rastafarian life in Jamaica from his book *Yes Rasta* in creating a series of large format images entitled the *Canal Zone* works. Prince claims to be part of a tradition dubbed "appropriation artists" into which some would place works by Warhol, de Kooning, Rauschenberg and Picasso. In short, appropriation art takes an existing work and alters it in some fashion.

In his *Canal Zone* works, Prince used Cariou's photographs as a base upon which to impose other objects or designs. In one example, Cariou photographed a lightly clad Rastafarian with a jungle background. Prince enlarged this image and imposed upon it blue ovals over the eyes, nose and mouth. Additionally, Prince included a photographic cut-out of an electric guitar with hands, making it appear that the subject was playing guitar. Other examples include various Cariou photographs in which Prince placed photographs of nude women.

Cariou claimed that Prince's works infringed upon Cariou's copyright to the photographs. In response, Prince claimed that the defense of "fair use" defeated any claim of infringement. The copyright fair use defense is a judicially created doctrine which has been codified in the Copyright Act of 1976.¹ Congress outlined a number of uses "likely" to be considered fair uses (thereby non-infringing uses). The specified uses in the statute are: criticism, comment, news reporting, teaching (including multiple copies for classroom), scholarship, and research. (17 U.S.C. § 107 [Preamble].) Congress also provided a test of four (4) factors to consider for a fair use evaluation:

1. The purpose and the character of Prince's use. (17 U.S.C. § 107(1).)
2. The nature of the original work that includes the Cariou photographs. (17 U.S.C. §107(2).)
3. The amount and substantiality of the portion of the original work that is used. (17 U.S.C. §107(3).)
4. The effect of Prince's use upon the potential market for or value of the original (Cariou's) work. (17 U.S.C. § 107(4).)

Unfortunately, Prince's use is not specifically listed in preamble to the statute. However, the "likely" fair use statutory list is illustrative only.² Even more, the four fair use test factors are not exclusive, are interrelated and require a balancing.³

The federal district court in New York ruled in favor of Cariou, and Prince appealed. Two of the principal issues on appeal are (a) whether Prince's works are "transformative," and thus subject to the defense of fair use, and (b) whether the potential market for Cariou's work was harmed.

*Transformative.*⁴ Under the Copyright Act, a court is obligated to consider, among other things, "the purpose and character of the [allegedly infringing] use." This includes examining whether the new work "transformed" the original. The trial court here held that the subsequent work must comment on or criticize the original work in order to constitute fair use. In prior case law, the Supreme Court has ruled that what makes a work transformative is that it "adds something new, with a different purpose or different character, altering the first with new expression, meaning or message."⁵ Whether this means that the subsequent work must comment on or criticize the original work is one of the contested legal issues which the appellate court will be required to address.

Another contested legal issue before the court, and relevant to the issue of transformation, is whether the court must look objectively at the subsequent work of art to determine whether the work constitutes comment or criticism of the prior work; or, alternatively, should the court examine subjectively the intent of the appropriation artist. It is entirely possible that, on the one hand, an appropriation artist does not intend to comment or criticize the prior work, while, on the other hand, an observing audience might reasonably perceive such comment or criticism. This latter point is significant in that Prince testified in deposition that he was not commenting on Cariou's photographs or technique.

Potential Market For Cariou's Work. Prince argued before the appellate court that his works, by their nature, do not supersede or supplant Cariou's intended market. He argued that Cariou's photographs are easily reproducible and have been sold almost exclusively in book form (now out of print). Prince's works are massive and one-of-a-kind works designed for sale to a very limited audience and command market prices that range in the hundreds of thousands to millions of dollars. Prince asserted that the trial court was in error in focusing on the mere commerciality of his use of Cariou's photographs rather than on whether Prince usurped Cariou's market.

Cariou agreed that the "end users" for each artist's work were different. However, he argued that his access to an "intermediate" market, namely art galleries, was harmed. Cariou produced evidence from one "soon-to-open" gallery proprietor who had some interest in showing Cariou's work but felt uncomfortable doing so when she learned about Prince's showing of Cariou's works at another gallery. In response, Prince pointed out that the gallery proprietor and Cariou had never agreed to have a show, devoted no significant effort to develop a show and that Cariou did not return her communications until after he filed his suit.

COMMENT: The appellate decision here will provide some further definition to the concept of "transformation" for purposes of a fair use defense. It will also establish additional guidance on how the courts will look at the potential market for the original work. It is likely that whatever the outcome, the losing party will petition the Supreme Court to review the issues in the case. Should that occur, *Cariou v. Prince* could be the next "big" decision from the Supreme Court on the fair use defense.

¹ *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 549 (1985) and 17 U.S.C. § 107, et seq.

² See *Pacific and Southern Co., Inc. v. Duncan*, 744 F.2d 1490, 1495 (11th Cir. 1984).

³ *Campbell v. Acuff-Rose Music, Inc.* 510 U.S. 569, 577 (1994); *Mattel inc. v. Walking Mountain Productions*, 353 F.3d 792, 899 (9th Cir. 2003).

⁴ Whether a subsequent work is "transformative" and thus susceptible to a fair use defense should not be confused with whether a subsequent work is "derivative." (See *Castle Rock Entertainment, Inc. v Carol Publishing Group, Inc.*, 150 F.3d 132, 143 (2d Cir. 1998); 17 U.S.C. §§ 101, 106(2).) A derivative work is an adaptation of an earlier copyrighted work, for example, a film or play based upon a book. The creator of the derivative work must have ownership of or a license to use the underlying work; otherwise there is an infringement. The line of distinction may not always be clear but it does exist.

⁵ *Campbell*, 510 U.S. at 579; see also *Blanch v. Koons*, 467 F.3d 244, 253 (2d Cir. 2006).