Did the Solicitor General Hijack the *Warhol v. Goldsmith* Case?

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TABLE OF CONTENTS

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INTRODUCTION

Hijack may be an apt description of the effect that the Office of the Solicitor General ("OSG") had on the *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith* case when it filed an amicus curiae brief with the Supreme Court in support of Lynn Goldsmith's claim that the Andy Warhol Foundation for the Visual Arts ("AWF") had made an unfair use of her photograph of the rock star Prince.[1] From Goldsmith's first contact with AWF in 2016 informing it of her claim of infringement until she filed her merits brief with the Court in 2022, she had consistently claimed that Andy Warhol's 1984 creation of a series of sixteen prints and drawings of Prince (known as the *Prince Series*) infringed copyright in her 1981 photograph of the musician.[2] For six long years, AWF and Goldsmith disputed whether Warhol's creation of the works was fair use or infringement. OSG's amicus curiae brief did not engage with that dispute, but asserted that the only question before the Court was whether AWF's 2016 license of one of the *Prince Series* (known as the *Orange Prince*) to Condé Nast for the cover of a commemorative issue was a transformative fair use, which OSG opined it was not.[3]

While OSG was certainly correct in asserting that Goldsmith wanted compensation for AWF's 2016 grant of a license to make and distribute copies of the *Orange Prince* for the cover of Condé Nast's special issue, that was not Goldsmith's only claim. In fact, it was not even her main claim.[4] Yet, OSG's brief reframed and significantly narrowed the question presented to the Court, and interpreted the trial and appellate court rulings as though both courts had ruled only on the fairness of the 2016 license when both courts had, in fact, focused their analyses almost entirely on the 1984 creation of the Warhol works.[5]

OSG's narrowing of the case came as a surprise to AWF, which had consistently and squarely focused on the fairness of Warhol's 1984 creation of the *Prince Series*. Moreover, many other amicus curiae briefs filed with the Court in *Warhol* assumed, as had AWF, that the fair use issue before the Court was whether Warhol's 1984 creation

1. Brief for the United States as Amicus Curiae Supporting Respondents, Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 598 U.S. 508 (2023) (No. 21-869) [hereinafter OSG Brief]. I am not the first to criticize the Office of the Solicitor General ("OSG") for its sometimes undue influence with the Court. *See, e.g.*, Tejas N. Narechania, *Defective Patent Deference*, 95 WASH. L. REV 869, 870 (2020); Darcy Covert & Annie J. Wang, *The Loudest Voice at the Supreme Court: The Solicitor General's Dominance of Amicus Oral Argument*, 74 VAND. L. REV. 681, 684 (2021).

2. *See infra* Part I.

3. OSG Brief, *supra* note 1, at 11, 14. *But see* Peter J. Karol, *What's the Use? The Structural Flaw Undermining* Warhol v. Goldsmith, J. COPYRIGHT SOC'Y (forthcoming 2024) (manuscript at 1) (https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4663576 [https://perma.cc/26SG-MQ5S] [https://web.archive.org/web/20240309013543/https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4663576]) (writing that "commercial licensing is neither a copyright use, nor an act of infringement").

4. *See infra* Part III.D.

5. Both lower courts ruled on the fairness of Warhol's 1984 creation of the works at issue. *See* Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 382 F. Supp. 3d 312, 331 (S.D.N.Y. 2019), *rev'd*, 11 F.4th 26, 32 (2d Cir. 2021), *aff'd*, 598 U.S. 508 (2023). *But see* OSG Brief, *supra* note 1, at 10–11 (stating that the only issue before the Court is the 2016 license).

of the *Prince Series* was fair use or infringement. Neither the litigants nor their amici had adequate opportunities to fully brief responses to the novel theory of fair use put forward by OSG at the merits stage of the case—that even if Warhol's original creation of the *Prince Series* was lawful, each subsequent use of those works must be justified as a fair use. OSG's considerable influence in the case was especially troubling given that the U.S. government did not have a meaningful federal interest at stake in the litigation.[6]

Strangely enough, the Supreme Court acceded to OSG's reframing of the question presented in the *Warhol* case, even though it had granted certiorari to address AWF's question about the creation issue. The Court's decision did not question OSG's interpretation of the lower courts' rulings.[7] So why did OSG reframe the *Warhol* case in this way, and why did the Court acquiesce in it?

Another good question is why Justice Sotomayor's opinion for the Court buried the lede. It consigned to a footnote the most important statement in the entire decision: that Goldsmith had "abandoned all claims to relief other than her claim as to the 2016 Condé Nast license and her request for prospective relief as to similar commercial licensing."[8] Relying on this abandonment, the Court declared that it would express no opinion about Warhol's "creation, display, or sale of any of the original Prince Series works."[9] The Court thereby avoided addressing the many divergent views expressed in AWF's briefs and many amicus briefs (except OSG's) as to whether Warhol's 1984 creations were transformative fair uses or infringing derivative works.

But why would Goldsmith decide to abandon her larger claims, and why is that abandonment important to an accurate understanding of the *Warhol* ruling? This Article suggests some answers to these questions and explains why it matters that the case was resolved in this way.

The truest thing that can be said about the *Warhol* opinion is that the Court held that AWF's commercial licensing of the *Orange Prince* to Condé Nast in 2016 was not a transformative fair use of that image because it had the same purpose (or at least an overlapping purpose) as Goldsmith's photograph.[10] Both were images of the musician

6. OSG's brief stated the United States had a federal interest in the case but not of a sort that affected federal agency operations. OSG Brief, *supra* note 1, at 1–2. Historically, OSG construed federal interests quite narrowly. *See, e.g.*, Michael E. Solimine, *The Solicitor General Unbound: Amicus Curiae Activism and Deference in the Supreme Court*, 45 ARIZ. ST. L.J. 1183, 1199–1201 (2013) (critiquing OSG's relaxed conception of "federal interest" over time). In the past, OSG did not generally file amicus briefs in private litigant cases unless the outcome of the Court's decision would impact federal law enforcement or the administration of a federal agency. *See id.* at 1197–98.

7. *See infra* text accompanying notes 113–15, 176.

8. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 598 U.S. 508, 534 n.9 (2023) (citing Brief for Respondents 3, 17–18; Transcript of Oral Argument 80–82). *But see infra* note 168 (suggesting that the Court may have overinterpreted Goldsmith's "abandonment" of those claims).

9. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 534. As Professor Karol has pointed out, granting a license, whether commercial or not, does not trigger any of the exclusive rights of copyright. Karol, *supra* note 3, at 1–3.

10. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 537–38. For an excellent commentary on the *Warhol* decision, see Tyler Ochoa, *U.S. Supreme Court Vindicates Photographer, but Destabilizes Fair Use*,

that could be marketed to magazines to accompany stories about him. That is the holding of the case. Everything else the Court said in *Warhol* is dicta. Contrary to the hopes of AWF and many amici, whether they supported AWF's or Goldsmith's position, the Court said virtually nothing to clarify the distinction between transformative fair uses and infringing derivative works.[11]

Part I discusses the origins and evolution of the copyright dispute between AWF and Goldsmith and reviews the trial and appellate court decisions on AWF's summary judgment motion on the fair use issue. Part II suggests that OSG may have hijacked the *Warhol* case and suggests why it might have done so, as well as why Goldsmith might have acquiesced in this. Part III discusses a largely invisible issue in the *Warhol* case: § 103(a) of the Copyright Act of 1976 (1976 Act), which would have nullified AWF's copyrights in the *Prince Series* if courts ruled that those works infringed Goldsmith's derivative work rights. Part IV considers the implications of the Court's decision for fair use analyses going forward and for AWF's claim of copyright in the *Prince Series*. Part V considers how the Court could have resolved the *Warhol* case in alternative ways. Part VI concludes.

I. ORIGINS AND EVOLUTION OF THE DISPUTE BETWEEN AWF AND GOLDSMITH

The facts of *Warhol v. Goldsmith* are relatively straightforward. In 1984, *Vanity Fair* decided to publish an article about the rock musician Prince's rise to fame. It contacted Lynn Goldsmith's licensing agency in search of a photograph of Prince and obtained a license for one that Goldsmith took in 1981.[12] The license was for a one-time-use of the photograph as an artist reference for a $400 fee and required that *Vanity Fair* credit Goldsmith for the source material.[13] *Vanity Fair* then commissioned Andy Warhol to prepare visual art to accompany the article about Prince and supplied him with the Goldsmith photograph.[14] Warhol made two drawings based on the photograph and fourteen colorful images, probably so that *Vanity Fair* would have some options about

TECH. & MKTG. L. BLOG (June 20, 2023), https://blog.ericgoldman.org/archives/2023/06/u-s-supreme-court-vindicates-photographer-but-destabilizes-fair-use-andy-warhol-foundation-v-goldsmith-guest-blog-post.htm [https://perma.cc/T95P-U6WF] [https://web.archive.org/save/https://blog.ericgoldman.org/archives/2023/06/u-s-supreme-court-vindicates-photographer-but-destabilizes-fair-use-andy-warhol-foundation-v-goldsmith-guest-blog-post.htm].

11. The title of the Columbia Law School symposium on *Warhol* suggests that the Court's decision interpreted the derivative work right, but the Court rarely mentioned that right except to suggest that overbroad interpretations of fair use would undermine it. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 529, 541.

12. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 382 F. Supp. 3d 312, 318 (S.D.N.Y. 2019). For a discussion of the term "artist reference," see Jessica Silbey & Eva E. Subotnik, *What the* Warhol *Court Got Wrong: Use as an Artist Reference and the Derivative Work Doctrine*, 47 COLUM. J.L. & ARTS 353 (2024).

13. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 517.

14. *Andy Warhol Found. for the Visual Arts, Inc.*, 382 F. Supp. 3d at 318. There is no evidence in the record that Warhol knew of the terms of the license between *Vanity Fair* and Goldsmith's agent.

which image would be the best fit for its story.[15] *Vanity Fair* published one of the colorful Warhol images of Prince (known as the *Purple Prince*) adjacent to an article entitled "Purple Fame" in 1984.[16] It credited Goldsmith as a source, as the license between Goldsmith's agent and *Vanity Fair* required.[17]

Many years later, after the tragic death of Prince in 2016, Condé Nast (parent company of *Vanity Fair*) decided to publish a special issue about the rock star and contacted AWF about reusing the 1984 print for that issue.[18] When Condé Nast discovered that Warhol had made additional prints based on Goldsmith's photo, it decided to license a different one (known as the *Orange Prince*) for the front cover of the special issue and paid AWF $10,000.[19] Condé Nast apparently did not contact Goldsmith about getting her permission for using that Warhol work for the special issue, nor did it credit her as a source in the commemorative issue.[20]

When Goldsmith saw the Condé Nast special issue on Prince, she noticed that the *Orange Prince* on the front cover was very similar to one of her photographs from 1981.[21] She contacted AWF to assert her claim that this image infringed her copyright.[22] She further asserted that AWF had no copyright interest in any Warhol work that was based on her photograph and demanded a substantial sum from AWF as compensation for the infringement.[23] In anticipation of litigation against AWF, she registered her claim of copyright in the photograph with the Copyright Office.[24]

So far as we know, Goldsmith never made a claim against Condé Nast even though it, not AWF, had made, sold, and distributed thousands of copies of that special issue throughout the United States.[25] Goldsmith could also have charged Condé Nast with

15. *Id.* at 319. A one-time-use license would not necessarily mean that only one work of art could be created. As Goldsmith later suggested, Warhol may have created all sixteen works to give *Vanity Fair* a choice about which one to accompany the article. *See infra* text accompanying note 167; *see also* Ochoa, *supra* note 10 (surmising Warhol created the sixteen works to give *Vanity Fair* some choices).

16. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 518.

17. *Id.*

18. *Id.* at 519.

19. *Id.* at 519–20. The license gave Condé Nast a three-month exclusive license for use of that image. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 35 (2d Cir. 2021).

20. *Andy Warhol Found. for the Visual Arts, Inc.*, 11 F.4th at 35. This suggests that Condé Nast, which has considerable experience licensing in-copyright images for its magazines, thought that Warhol's images were not encumbered by Goldsmith's photograph.

21. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 382 F. Supp. 3d 312, 321 (S.D.N.Y. 2019). Goldsmith initially thought the *Orange Prince* was based on a different photograph than the one eventually in litigation. *Id.*

22. *Id.*

23. During oral argument to the Supreme Court, AWF's counsel said her monetary demand was in the seven figures and she "also demanded the copyright." *See* Transcript of Oral Argument at 7, *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. 508 (No. 21–869) [hereinafter Supreme Court Oral Argument].

24. *Andy Warhol Found. for the Visual Arts, Inc.*, 382 F. Supp. 3d at 321.

25. If Goldsmith had sued Condé Nast for the unauthorized reproductions and distributions of copies to the public of the *Orange Prince*, she might have recovered both actual damages and disgorgement of profits attributable to the infringement. 17 U.S.C. § 504. She was not eligible for awards of statutory damages or attorney fees because she did not register her claim of copyright until after the alleged infringement commenced. 17 U.S.C. § 412. Surprisingly, none of the *Warhol* opinions commented on the missing claim

breach of the agreement between her agent and *Vanity Fair* which had granted it only a one-time-use license and required it to identify Goldsmith as the source. But so far as we know, she did not complain to Condé Nast either about copyright infringement or breach of contract.

Confident that Warhol's use of the photograph was non-infringing, AWF sued Goldsmith asking the court to declare that the sixteen works in the *Prince Series* were not substantially similar to Goldsmith's photograph,[26] or alternatively, that Warhol had made fair use of the photograph.[27] Goldsmith counterclaimed, charging AWF with copyright infringement and asking the court to declare that AWF could not claim copyright in the *Prince Series* works.[28]

AWF's confidence in its fair use theory was due in no small part to the Supreme Court's landmark 1994 decision *Campbell v. Acuff-Rose Music, Inc.*[29] The Court ruled that Campbell's creation of a rap parody version of a popular Roy Orbison song could be fair use because of its transformative purpose, that is, because Campbell had "add[ed] something new, with a further purpose or different character, altering it with new expression, meaning or message."[30] The Court explained that the fair use doctrine leaves "breathing space" for future generations of creations that build on the expression in pre-existing works in keeping with the constitutional purposes of copyright.[31] *Campbell* recognized that with transformative uses of a first author's expression, the commercial nature of the use is less significant in the fair use analysis because it is less likely than non-transformative uses to harm the first author's markets.[32] The Court's *Google LLC v. Oracle America., Inc.* ruling in 2021 reaffirmed the significance of transformative fair uses and *Campbell*'s definition of that term.[33] For the most part, courts have construed the transformative purpose concept quite broadly.[34]

against Condé Nast. *See* Ochoa, *supra* note 10 (noting that Goldsmith did not sue Condé Nast); *see also infra* note 28 and accompanying text (describing Goldsmith's amended answer and counterclaim).

26. Complaint at 2, 29, *Andy Warhol Found. for the Visual Arts*, 382 F. Supp. 3d 312 (No. 1:17-cv-02532-JGK) [hereinafter AWF Complaint]. The complaint also asserted that Goldsmith's potential copyright claims were barred by the statute of limitations and laches. *Id.* ¶¶ 70–82.

27. *Id.* ¶¶ 67–69.

28. Amended Answer of Defendants, Amended Counterclaim of Lynn Goldsmith for Copyright Infringement and Jury Demand at 1, 26, *Andy Warhol Found. for the Visual Arts*, 382 F. Supp. 3d 312 (No. 1:17-cv-02532-JGK) [hereinafter Amended Answer and Counterclaim]. Goldsmith sought a finding from the court that AWF had no copyright in any of the *Prince Series* works. *Id.* at 27.

29. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994). The Court endorsed the concept of transformative purposes set forth in Judge Pierre Leval's law review article on fair use. *See* Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105 (1990). The *Campbell* decision cited to Leval's article more than a dozen times.

30. *Campbell*, 510 U.S. at 579. The Court assessed Campbell's fair use defense under all four fair use factors. What was novel about the Court's holding was the first factor's emphasis on the significance of transformative purposes.

31. *Id.*

32. *Id.* at 579, 591.

33. Google LLC v. Oracle Am., Inc., 593 U.S. 1, 29 (2021).

34. *See, e.g.*, Clark D. Asay et al., *Is Transformative Use Eating the World?*, 61 B.C. L. REV. 905, 962 (2020). Some courts have adopted broader interpretations of *Campbell* than others. *Compare, e.g.*, Cariou v. Prince,

A. THE TRIAL COURT RULED IN FAVOR OF AWF'S FAIR USE DEFENSE

After a hearing on the litigants' cross-motions for summary judgment,[35] the trial court granted AWF's motion on the fair use issue and denied Goldsmith's motion.[36] The court addressed all four fair use factors: (1) the purpose and character of the challenged use; (2) the nature of the copyrighted work; (3) the amount and substantiality of the taking; and (4) the effect of the use on the potential market for or value of the copyrighted work.[37]

Concerning the purpose of the use factor, the court indicated that the most important consideration was whether Warhol's use of Goldsmith's photograph was transformative. [38] It concluded that all sixteen works in the *Prince Series* were transformative because, in keeping with *Campbell*, they had a different meaning and conveyed a different message than Goldsmith's photograph.[39] The court pointed to numerous differences between the depictions of Prince in the Warhol works and depictions in Goldsmith's photograph.[40] Goldsmith's photograph had emphasized crisp details of Prince's bone structure, but these aspects of his face were, the court thought, "softened in several of the Prince Series works and outlined or shaded in the others."[41] Warhol depicted Prince "as a flat, two-dimensional figure," in contrast to "the detailed, three-dimensional being in Goldsmith's photograph."[42] In addition, Warhol's *Prince Series* works "contain loud, unnatural colors, in stark contrast with the black-and-white

714 F.3d 694 (2d Cir. 2013) (concluding use of Cariou's photographs in twenty-five of thirty works by artist Richard Prince was transformative), *with* Kienitz v. Sconnie Nation LLC, 766 F.3d 756 (7th Cir. 2014) (affirming that use of photo on a t-shirt was fair because there was no market harm and little of the photo's expression was used, but criticizing *Cariou* for overbroad emphasis on transformativeness), *and* Dr. Seuss Enters., L.P. v. ComicMix LLC, 983 F.3d 443 (9th Cir. 2020) (holding illustrated book combining aspects of Dr. Seuss book and *Star Trek* TV series not transformative despite alterations in content, theme, and meaning).

35. *See* The Andy Warhol Foundation for the Visual Arts, Inc.'s Reply Memorandum of Law in Further Support of Its Motion for Summary Judgment, Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 382 F. Supp. 3d 312 (S.D.N.Y. 2019) (No. 1:17-cv-02532-JGK) [hereinafter AWF SJ Memo]; Memorandum of Law in Support of Motion by Defendants and Counterclaim Plaintiff Lynn Goldsmith and Lynn Goldsmith, Ltd. for Summary Judgment Pursuant to Rule 56, *Andy Warhol Found. for the Visual Arts, Inc.*, 382 F. Supp. 3d 312 (No. 1:17-cv-02532-JGK) [hereinafter Goldsmith SJ Memo].

36. *Andy Warhol Found. for the Visual Arts, Inc.*, 382 F. Supp. 3d at 324, 331. Although AWF also moved for summary judgment on the no-substantial-similarity issue, the trial court did not address it, saying this was unnecessary in view of its fair use ruling. *Id.* at 324. *But see* Sandra M. Aistars, *Copyright's Lost Art of Substantial Similarity*, 26 VAND. J. ENT. & TECH. L. 109 (2023) (criticizing courts for failing to consider whether two works are substantially similar before addressing fair use defenses). AWF's complaint identified numerous differences between expressiveness of the Warhol *Prince Series* works and Goldsmith's photograph. AWF Complaint, *supra* note 26, ¶¶ 25–27.

37. 17 U.S.C. § 107.

38. *Andy Warhol Found. for the Visual Arts, Inc.*, 382 F. Supp. 3d at 325.

39. *Id.* at 326.

40. *Id.* (identifying, e.g., Warhol's focus on Prince's face and some of his neckline and removal of his torso).

41. *Id.*

42. *Id.*

original photograph."[43] The court regarded Warhol's alterations as having "result[ed] in an aesthetic and character different from the original."[44] It concluded that Warhol had transformed Prince "from a vulnerable, uncomfortable person to an iconic, larger-than-life figure," such that "the humanity Prince embodies in Goldsmith's photograph is gone."[45] The court gave little weight to the commerciality of the Warhol works because they were transformative and because of the public benefit of such art.[46] The purpose factor thus favored AWF's fair use defense.

The court regarded the nature of the work factor as neutral. Although Goldsmith's photograph was creative and unpublished, which ordinarily would weigh against fair use, the court thought that a counterbalancing consideration was that Goldsmith's agent had licensed use of the photograph as an artist reference, under which Warhol created the series of Prince portraits.[47]

In assessing the amount and substantiality of the taking, the court disagreed with Goldsmith's argument that the Prince Series had appropriated the "essence" of her photograph. It found that "Warhol [had] removed nearly all of the photograph's protectible elements in creating the Prince Series."[48] It noted that neither the subject of the photograph, nor his pose, was protectable by copyright law.[49] The court regarded this factor as tipping in favor of AWF's claim.

As for market effects, the court concluded that the *Prince Series* had not supplanted market demand for Goldsmith's photograph because Warhol's works operated in a very different market than the market for her photograph.[50] It questioned whether potential licensees for Warhol's and Goldsmith's depictions of Prince, such as magazine illustrations or music album covers, would regard the *Prince Series*, "consisting of stylized works manifesting a uniquely Warhol aesthetic," as a substitute for Goldsmith's "intimate and realistic photograph of Prince."[51] Besides, Goldsmith had chosen not to license that photograph to anyone except *Vanity Fair*.[52] Consequently, the court regarded the market effects factor as weighing in favor of Warhol's fair use claim.

B. THE SECOND CIRCUIT REVERSED THE FAIR USE RULING

Goldsmith's appeal met with success in the Second Circuit. Judge Lynch's opinion ruled that Warhol's use of the Goldsmith photograph was not transformative because the *Prince Series* had the same purpose as Goldsmith's in being visual art depicting Prince

43. *Id.*
44. *Id.*
45. *Id.*
46. *Id.* at 325.
47. *Id.* at 327.
48. *Id.* at 330.
49. *Id.* at 329–30.
50. *Id.* at 330.
51. *Id.* at 330–31.
52. *Id.* at 330.

that was available for commercial licensing to magazines.[53] It rejected the new meaning or message rationale of the trial court's contrary finding, saying that judges are ill-suited to make judgments about the meaning or message of artistic works.[54] Nor should judges consider the artist's intent or the views of art critics in deciding whether a secondary work was transformative.[55] In its view, judges should instead look at the plaintiff's and defendant's works side-by-side and "examine 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."[56]

Judge Lynch regarded Warhol's *Prince Series* as "retain[ing] the essential element of its source material" and observed that Goldsmith's photograph "remains the recognizable foundation upon which the Prince Series is built."[57] The opinion failed to consider that the similarities were due to *Vanity Fair* having commissioned Warhol to make visual art based on her photograph under its artist reference arrangement with Goldsmith's agent. At a high level of generality, it found that the Goldsmith photograph and the *Prince Series* "share the same overarching purpose (*i.e.*, to serve as works of visual art)."[58] While not holding that Warhol's Prince works were infringing derivatives,[59] the court suggested that they were closer to that category than to other transformative uses that courts had found to be fair. [60]

The Second Circuit decision regarded the commerciality of Warhol's use of the photograph as weighing against fair use. Warhol was not entitled to make use of Goldsmith's work, the court noted, without paying her the customary price.[61] Yet, the court expressed its willingness to take account of public interests in access to Warhol's art and in AWF's mission to advance the visual arts when considering equitable remedies for AWF's unfair use of the photograph.[62]

After concluding Warhol's use of the photograph was non-transformative and commercial, the court found that the purpose factor weighed against fair use.

As for the nature of the work factor, the Second Circuit agreed with the trial court that Goldsmith's photograph was creative and unpublished, considerations that weighed against fair use.[63] Unlike the trial court, it gave no weight to the artist

53. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 40–42 (2d Cir. 2021). *But see* Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 579 (1994) (directing courts to consider whether a secondary work had a new meaning or message compared to the first work).

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

55. *Id.*

56. *Id.* at 42 (quoting Cariou v. Prince, 714 F.3d 694, 706 (2d Cir. 2013)).

57. *Id.* at 43.

58. *Id.* at 40, 42.

59. *Id.* at 43.

60. *Id.*

61. *Id.* at 44–45.

62. *Id.*

63. *Id.* at 45.

reference arrangement under which Warhol had permission to make visual art based on Goldsmith's photograph.[64]

The court stated that Warhol had "borrow[ed] significantly from the Goldsmith Photograph, both quantitatively and qualitatively."[65] His works were "instantly recognizable as depictions or images of the Goldsmith Photograph itself."[66] In this respect, the court once again ignored Warhol's entitlement to make visual art based on the Goldsmith photograph under the artist reference arrangement. The court seemed to view Warhol's use of the photograph as though Warhol had seen Goldsmith's photograph in a magazine and copied it expecting that his celebrity status as an artist would excuse the infringement.

The court went on at length about the similarities between the photograph and the *Prince Series* works:

> The Prince Series retains the essential elements of its source material, and Warhol's modifications serve chiefly to magnify some elements of that material and minimize others. While the cumulative effect of those alterations may change the Goldsmith Photograph in ways that give a different impression of its subject, the Goldsmith Photograph remains the recognizable foundation upon which the Prince Series is built.[67]

Thus, the court concluded, the amount factor also cut against fair use.

While the appellate court agreed with AWF that Goldsmith's photograph and Warhol's art works "occupy distinct markets,"[68] it concluded that "the Prince Series works pose cognizable harm to Goldsmith's market to license the Goldsmith Photograph to publications for editorial purposes and to other artists to create derivative works based on the Goldsmith Photograph and similar works."[69] The court noted the existence of a market "to license photographs of musicians, such as the Goldsmith Photograph, to serve as the basis of a stylized derivative image" and speculated that "permitting this use would effectively destroy that broader market, as, if artists 'could use such images for free, there would be little or no reason to pay for

64. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 382 F. Supp. 3d 312, 327 (S.D.N.Y. 2019). The Second Circuit mentioned the artist reference arrangement in its recitation of the facts, *Andy Warhol Found. for the Visual Arts, Inc.*, 11 F.4th at 34, but ignored it when analyzing the fair use defense.

65. *Andy Warhol Found. for the Visual Arts, Inc.*, 11 F.4th at 47.

66. *Id.* Although the trial court did not consider whether the *Prince Series* works were substantially similar to the Goldsmith photograph, *Andy Warhol Found. for the Visual Arts, Inc.*, 382 F. Supp. 3d at 324, the Second Circuit decided to address this issue anyway and concluded that Warhol's works were substantially similar to the photograph as a matter of law. *Andy Warhol Found. for the Visual Arts, Inc.*, 11 F.4th at 52–54. *But see* Brief of *Amici Curiae* Law Professors in Support of Appellees and Affirmance, *Andy Warhol Found. for the Visual Arts, Inc.*, 11 F.4th 26 (No. 19-2420-cv) (arguing that the *Prince Series* works are not substantially similar in expression to the Goldsmith photograph).

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

68. *Id.* at 48.

69. *Id.* at 51.

[them].'"[70] Hence, the court concluded that the Warhol works had made unfair use of Goldsmith's photograph.[71]

Judge Jacobs's concurrence suggested that the court's ruling against AWF's fair use defense should not be understood to encumber AWF's copyrights, saying (erroneously) that "Goldsmith does not claim that the original works infringe and expresses no intention to encumber them; the opinion of the Court necessarily does not decide that issue."[72] Nor did Judge Jacobs believe that the court had "consider[ed], let alone decide[d], whether the infringement here encumbers the original Prince Series works that are in the hands of collectors or museums, or, in general, whether original works of art that borrow from protected material are likely to infringe."[73] He regarded Goldsmith as only seeking compensation for AWF's commercial licensing of the *Orange Prince* and indicated that the Second Circuit would have to reconsider its ruling if Goldsmith was claiming the Warhol works were illegal.[74]

C. AWF PETITIONED FOR CERTIORARI

Because the Second Circuit's *Warhol* decision repudiated the "new meaning or message" criterion for assessing the transformativeness of a secondary work, which the Court had endorsed not only in *Campbell* but also in its very recent *Google v. Oracle* decision,[75] AWF petitioned for a writ of certiorari asserting that the Second Circuit's interpretation of transformativeness was contrary to the Court's rulings and also conflicted with other appellate court rulings.[76]

AWF's lawyers probably expected that a reversal on the transformation subfactor would require the Second Circuit to revisit its assessment of the other fair use factors. When a secondary work has been found transformative, courts in the post-*Campbell* cases have generally given less weight to commerciality, the nature of the work, the amount taken, and potential market harms, just as the trial court did in *Warhol*.[77] This

70. *Id.* at 50 (alteration in original) (citations omitted). *But see* Karol, *supra* note 3, at 19–25 (explaining why commercial licensing of a copyrighted work is not of itself an infringement of copyright). Karol notes that it is "incoherent to ask whether AWF made a fair use of Goldsmith's work. It made no use of the work at all, in the statutory meaning of that term." *Id.* at 3.

71. *Andy Warhol Found. for the Visual Arts, Inc.*, 11 F.4th at 51.

72. *Id.* at 55 (Jacobs, J., concurring). *But see* Amended Answer and Counterclaim, *supra* note 28, at 26 (asking for a declaration that AWF owned no copyrights in the *Prince Series*). It was as if Judge Jacobs had not read Judge Lynch's fair use analysis which heavily concentrated on Warhol's creation of the *Prince Series*.

73. *Id.* at 54.

74. *Id.* at 55. Judge Jacobs was mistaken about what Goldsmith was claiming.

75. Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 579 (1994); Google LLC v. Oracle Am., Inc., 593 U.S. 1, 29 (2021).

76. Petition for a Writ of Certiorari at 17, Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 598 U.S. 508 (2023) (No. 21-869) [hereinafter Cert Petition].

77. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 382 F. Supp. 3d 312, 325, 327, 330 (S.D.N.Y. 2019).

expectation was thwarted when the Court affirmed the Second Circuit's ruling after holding that AWF's 2016 grant of a license was non-transformative.[78]

II. HOW OSG REFRAMED THE *WARHOL* CASE

It is not uncommon for OSG or the Justices to adjust the question presented on which the Court granted cert as the case proceeds through the Court's review process.[79] Sometimes the Justices accept or even encourage litigants to adjust the question presented.[80] Yet, other times the Justices express annoyance when the parties or OSG reframe the issues before the Court.[81] In most cases, OSG's reframing of the question presented simply sharpens the key issue for the Justices without radically changing the nature of the case and eliding the litigants' true disputes.[82] In the *Warhol* case, however, OSG's reframing of the question presented dramatically changed the nature of the case. Moreover, OSG interpreted the lower courts' rulings to fit with its reshaping of the issue before the Court, omitting elements that did not fit its new narrative on the case.

78. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 551. The Court noted that AWF had not asked it to review the Second Circuit's ruling on other fair use factors, so it affirmed that court's unfair use ruling, *id.*, without indicating that its ruling on the transformativeness issue was much narrower than the Second Circuit's ruling on that same issue.

79. *See, e.g.*, Patricia A. Millett, *"We're Your Government and We're Here To Help": Obtaining Amicus Support from the Federal Government in Supreme Court Cases*, 10 J. APP. PRAC. & PROCESS 209, 226–27 (2009); Bert I. Huang, *A Court of Two Minds*, 122 COLUM. L. REV. 90, 92–93 (2022).

80. *See, e.g.*, Jodi Kantor & Adam Liptak, *Behind the Scenes at the Dismantling of* Roe v. Wade, N.Y. TIMES (Dec. 15, 2023), https://www.nytimes.com/2023/12/15/us/supreme-court-dobbs-roe-abortion.html [https://web.archive.org/web/20240203005823/https://www.nytimes.com/2023/12/15/us/supreme-court-dobbs-roe-abortion.html]; Adam Liptak, *Does the Supreme Court's Cherry Picking Inject Politics into Judging?*, N.Y. TIMES (Oct. 9, 2023), https://www.nytimes.com/2023/10/09/us/supreme-court-cases.html [https://web.archive.org/web/20240203005318/https://www.nytimes.com/2023/10/09/us/supreme-court-cases.html].

81. *See, e.g.*, Unicolors, Inc. v. H&M Hennes & Mauritz, L.P., 595 U.S. 178, 189 (2022) (Thomas, J., dissenting) ("I would not reward Unicolors for its legerdemain [in changing the question presented], and because no other court had, before today, ever addressed whether § 411(b)(1)(A) requires 'actual knowledge,' I would dismiss the writ of certiorari as improvidently granted."); Star Athletica L.L.C. v. Varsity Brands, Inc., 580 U.S. 405, 413 (2017) (criticizing OSG's position for making legal arguments about separability of utility and artistry in useful article copyright cases that "were not raised below and that are not advanced in this Court by any party").

82. In *Star Athletica*, for instance, the petitioner and respondent agreed that the question presented concerned the appropriate test for deciding when the design of a useful article is protectable under § 101 of the Copyright Act. OSG reframed the question as whether two-dimensional decorations for the surface of a garment, if sufficiently original, qualify for copyright protection. Brief for the United States as Amicus Curiae Supporting Respondents at 1, *Star Athletica, L.L.C.*, 580 U.S. 405 (No. 15-866). OSG's question was narrower than the litigants' but not in a manner that changed the nature of the issue in litigation.

A. OSG DRAMATICALLY ALTERED THE QUESTION PRESENTED TO THE COURT

The specific question on which the Court granted AWF's petition was:

> Whether a work of art is "transformative" when it conveys a different meaning or message from its source material (as this Court, the Ninth Circuit, and other courts of appeals have held), or whether a court is forbidden from considering the meaning of the accused work where it "recognizably deriv[es] from" its source material (as the Second Circuit has held).[83]

Although this framing of the question did not directly indicate that more than one work was at issue or that Warhol's creation of a series of works was at issue, the petition left no doubt that AWF was urging the Court to hold that the fourteen prints and two drawings Warhol created under the commission from *Vanity Fair* were transformative. It stated unequivocally that "[a]t issue in this case is the legality of Andy Warhol's Prince Series—a set of portraits that transformed a preexisting photograph of the musician Prince into a series of iconic works commenting on celebrity and consumerism."[84] AWF challenged the Second Circuit's conclusions that the 1984 creation of the *Prince Series* works was non-transformative, and that courts could not consider what meaning or message secondary works might reasonably be perceived to have.[85] AWF's merits brief repeated the question presented in exactly the same words as the petition.[86]

Goldsmith's brief opposing certiorari likewise focused on the legality of the 1984 creation of the sixteen Warhol works. It identified the question as "whether the Second Circuit correctly held that Warhol's silkscreens of Prince did not constitute a transformative use, where Warhol's silkscreens shared the same purpose as Goldsmith's copyrighted photograph and retained essential artistic elements of Goldsmith's photograph."[87] The brief defended the Second Circuit's ruling that the *Prince Series* had a non-transformative purpose.[88] It focused heavily on Warhol's uses of Goldsmith's photograph when creating the sixteen images in the *Prince Series*, for example, stating:

> Goldsmith's photograph was the basis for the entire Prince Series. All of the Warhol works thus unsurprisingly carried forward essential features of her original composition. Warhol kept the same angle of Prince's gaze. He reproduced the shadows ringing Prince's eyes and darkening his chin. Warhol replicated the same dark bangs partially obscuring Prince's right eye. Warhol even copied the light and shadow on Prince's lips, which owe

83. Cert Petition, *supra* note 76, at I (alteration in original).

84. *Id.* at 2 (alteration in original).

85. *Id.* at 17.

86. Brief for Petitioner at i, Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 598 U.S. 508 (2023) (No. 21-869) [hereinafter Brief for Petitioner].

87. Brief in Opposition at I, *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. 508 (No. 21-869) [hereinafter Goldsmith Opposition Brief] (making a plural reference to Warhol's "silkscreens").

88. *Id.* at 17.

> their pattern to the gloss that Goldsmith asked Prince to apply. Even the reflections from Goldsmith's photographer's umbrellas in Prince's eyes remain visible in Warhol's series.[89]

By the time Goldsmith filed her merits brief, however, she decided to drop her initial statement of the question presented and instead adopted AWF's statement of that question.[90] Her merits brief concentrated on defending the Second Circuit's ruling, challenging AWF's assertions about the significance of new meanings and messages for the transformative subfactor, and arguing that Warhol's use of Goldsmith's photograph was non-transformative because it was not necessary for his creative purposes in depicting Prince.[91]

OSG's amicus brief statement of the question presented was, however, starkly different from both AWF's and Goldsmith's: "[w]hether petitioner established that its licensing of the silkscreen image was a 'transformative' use, and that Section 107(1) therefore weighs in petitioner's favor, simply by showing that the image can reasonably be perceived to convey a meaning or message different from that of respondent's original photograph."[92]

OSG's formulation of the question presented implied that the case involved only one work, namely, *Orange Prince*, and only one license of that work, namely, that which AWF granted in 2016 for Condé Nast's use of *Orange Prince* on the cover of its magazine. OSG's amicus brief repeatedly assured the Court that the 1984 creation of the Warhol works was not before it.[93] But this was, in fact, the first time that the 2016 license as the sole issue in the *Warhol* case had been so narrowly drawn.

B. OSG OMITTED REFERENCES TO SOME OF GOLDSMITH'S CLAIMS AND THE LOWER COURTS' RULINGS

OSG's amicus brief in support of Goldsmith failed to acknowledge that Goldsmith's counterclaim had sought a judgment that all sixteen Warhol works in the *Prince Series* infringed her rights. Her counterclaim allegations characterized the *Prince Series* as infringing derivative works, referred to the *Purple Prince* as "the Infringing Image," and, saying that it and the *Orange Prince* were the "same work," opined that none of the Warhol works had altered the fundamentals of her photograph; Goldsmith asserted in Paragraph 6 of her prayer for relief that she was entitled to "permanent injunctive relief, enjoining [AWF] from further reproducing, modifying, preparing derivative works from, selling, offering to sell, publishing or displaying the Infringing Image and any

89. *Id.* at 9 (citations omitted).

90. Brief for Respondents at I, *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. 508 (No. 21-869) [hereinafter Goldsmith Merits Brief]. Goldsmith's merits brief did not repudiate her claims that Warhol's creation of the *Prince Series* works was unfair or that AWF held no copyright in the *Prince Series* works; she concentrated instead on shoring up the Second Circuit's conclusion about the unfairness of the 2016 license and proposed a new standard for assessing fair uses.

91. *Id.* at 20–21. Goldsmith's merits brief raised this necessity argument for the first time.

92. OSG Brief, *supra* note 1, at I.

93. *Id.* at 10–11, 14, 32.

other Warhol-created works that are substantially similar to the Goldsmith Photo or Infringing Image."[94] Paragraph 8 sought a "Finding" that AWF "cannot assert copyright protection in the Infringing Image, and any other Warhol-created works that are substantially similar to the Goldsmith Photo or Infringing Image, because they are unauthorized derivative works."[95] She moved for summary judgment on her claims that all sixteen works infringed her copyright in that photograph,[96] a motion that the trial court denied.[97]

OSG's brief, by contrast, stated that the district court had "described the allegedly infringing behavior as petitioner's 'more recent licensing of the Prince Series works—namely, the 2016 license to Condé Nast.'"[98] However, the district court repeatedly stated that the litigation was about the legality of Warhol's 1984 creation of the sixteen works constituting the *Prince Series*.[99] That court relied heavily on the different meaning and message that the Warhol works conveyed as compared with Goldsmith's photograph in support of its conclusion that the *Prince Series* works were transformative creations.[100] The transformativeness of Warhol's use of the photograph to create the *Prince Series* was the single most important factor in the trial court's judgment, for it mitigated other considerations such as the commerciality of Warhol's creative purpose and the unpublished nature of the photograph.[101]

According to OSG's brief, the Second Circuit "identified the relevant use as petitioner's 'commercial licensing of the Prince Series, not Warhol's original creation' of that Series."[102] However, OSG did not acknowledge that the Second Circuit reversed the trial court's ruling that Warhol's 1984 creation of the *Prince Series* was fair use, and held that the 1984 creations were unfair uses of Goldsmith's photograph.[103] The Second

94. Amended Answer and Counterclaim, *supra* note 28, at 4–5, 8, 10–11, 23, 26–27. AWF's complaint stated that Goldsmith had told it that the *Prince Series* were infringing derivative works. It quoted from a Facebook posting wherein Goldsmith complained that artists too often made their works based on photographs without paying for rights to do so. AWF Complaint, *supra* note 26, at 2, 24–25. Goldsmith was seemingly more upset by Warhol's works based on her photograph, notwithstanding the license authorizing use of the photograph, than by Condé Nast's use of the *Orange Prince* on the cover of the special issue.

95. Amended Answer and Counterclaim, *supra* note 28, at 27.

96. Goldsmith SJ Memo, *supra* note 35, at 20–27.

97. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 382 F. Supp. 3d 312, 331 (S.D.N.Y. 2019).

98. OSG Brief, *supra* note 1, at 14 (quoting *Andy Warhol Found. for the Visual Arts, Inc.*, 382 F. Supp. 3d at 324).

99. *Andy Warhol Found. for the Visual Arts, Inc.*, 382 F. Supp. 3d at 316, 322, 324–31. The trial court suggested, but did not hold, that Goldsmith's claims about the 1984 creation may have been outside the Copyright Act's statute of limitations. *Id.* at 324, 324 n.4 ("Goldsmith does not contend that the 'discovery rule' set out in *Psihoyos* [*v. John Wiley & Sons, Inc.*, 748 F.3d 120 (2d Cir. 2014)], saves this claim [regarding Warhol's creation of the *Prince series*].."). By granting the Foundation's summary judgment motions, the trial court's actual holding was that "the Prince Series works are protected by fair use." *Id.* at 331.

100. *Id.* at 326.

101. *Id.* at 325–27.

102. OSG Brief, *supra* note 1, at 14 (quoting Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 51 (2d Cir. 2021)).

103. *Andy Warhol Found. for the Visual Arts, Inc.*, 11 F.4th at 54.

Circuit discussed Warhol's process of creating the *Prince Series*.[104] It accepted the trial court's conclusion that Goldsmith may have intended to portray Prince as a vulnerable person and Warhol to strip him of his humanity, but the Second Circuit opined that transformativeness cannot depend on the intent of the artist nor of impressions of critics.[105] The Second Circuit identified some respects in which Warhol removed elements of Goldsmith's photograph in the *Prince Series* and embellished others, concluding that the sixteen works retained the essential elements of the Goldsmith photograph which was why it regarded Warhol's use as non-transformative.[106] It regarded the purpose of the *Prince Series* as "identical" to the purpose of the Goldsmith photograph.[107]

While the Second Circuit gave considerable attention to the 2016 license when discussing the market effects factor,[108] its analysis of the transformativeness issue for purposes of the first factor focused on rejecting AWF's argument that Warhol's *Prince Series* was transformative when the works were created.[109] The conclusion that Warhol's 1984 creation of the *Prince Series* was unfair did, of course, have implications for the fairness of the 2016 license, but that was a byproduct of the Second Circuit's ruling that all sixteen works in the series were not fair uses. OSG's characterization of the Second Circuit's ruling as having focused only on the 2016 license was not quite accurate.[110]

OSG offered only a very brief explanation of its position that the "creation of the Prince Series is not at issue" when suggesting toward the end of its amicus brief that "Warhol may have created the other Prince Series images for his own edification or as part of his artistic process for creating the licensed 1984 Vanity Fair illustration," blaming the "undeveloped record" for some ambiguity about the status of Warhol's works at the time of creation.[111] Yet, nothing in the trial court or Second Circuit

104. *Id.* at 35.

105. *Id.* at 41.

106. *Id.* at 43.

107. *Id.* at 42, 42 n.5 ("[T]he Goldsmith Photograph and the Prince Series were both created for artistic purposes.").

108. *Id.* at 48–51.

109. *Id.* at 41.

110. To be fair, Judge Jacobs's muddled concurrence is closer to OSG's interpretation of what was at stake in *Warhol* than to Judge Lynch's. Only one line in the Lynch opinion is consistent with OSG's interpretation: "[W]hat encroaches on Goldsmith's market is AWF's commercial licensing of the Prince Series, not Warhol's original creation." *Id.* at 51; *cf. id.* at 54–55 (Jacobs, J., concurring). However, this statement by Judge Lynch pertained only to the market effects factor; Judge Lynch's discussion of the other three factors were focused on Warhol's creation of the *Prince Series*. The Second Circuit reversed the trial court's entire fair use ruling, not just as to the 2016 license.

111. OSG Brief, *supra* note 1, at 32. In my conversation with Suzanne Wilson, General Counsel of the Copyright Office, on January 4, 2024, Ms. Wilson stated that she believed that nothing but the 2016 license was before either the trial or appellate court. She construed the trial court as having decided that Goldsmith's pursuit of the 1984 creation claims was barred by the statute of limitations. However, the trial court stated that its holding was that "the Prince Series works are protected by fair use." Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 382 F. Supp. 3d 312, 331 (S.D.N.Y. 2019). The Second Circuit overturned that ruling, *Andy Warhol Found for the Visual Arts, Inc.*, 11 F.4th at 51, not just a ruling that the 2016 license was

opinions indicated that they found the record about Warhol's creation to be inadequate to make a judgment about whether those creations were fairly or unfairly made.[112]

The Supreme Court acquiesced in OSG's reframing of the question presented, agreeing that only AWF's "commercial licensing of Orange Prince to Condé Nast is alleged to be infringing."[113] Having concluded that Goldsmith had "abandoned all claims" of infringement except as to the 2016 license,[114] the Court decided it was unnecessary to consider the fairness (or not) of the 1984 creations.[115]

Yet, from the time Lynn Goldsmith first notified AWF about her claim that the *Orange Prince* infringed her copyright in 2016 up until August 8, 2022, when her merits brief was filed, Goldsmith's legal claim had consistently been that Warhol's creation of the sixteen works constituting the *Prince Series* infringed her copyright.[116] Goldsmith's abandonment of the creation claims, as the Court understood the case, happened sometime between February 4, 2022, when Goldsmith filed her brief opposing the grant of certiorari, and August 8, 2022, when she filed her merits brief. So why did she abandon those claims? Did OSG's decision to concentrate its brief on the 2016 license affect her decision to abandon them? Or did Goldsmith decide to abandon her larger claims and OSG just followed her lead on this?[117]

unfair. Moreover, neither AWF's nor Goldsmith's appeal briefs to the Second Circuit mentioned the statute of limitations; they focused only on the fair use issue. Nor did any of the Second Circuit *Warhol* opinions mention AWF's statute of limitations defense. Nor did OSG's amicus brief. The Court's decision makes no reference to the statute of limitations as an explanation for not addressing the 1984 creation issue.

112. The Second Circuit noted only that "the specific means that Warhol used to create the images is unknown," but both lower courts relied on expert testimony about Warhol's usual practice when assessing AWF's fair use claim. *See Andy Warhol Found for the Visual Arts, Inc.*, 11 F.4th at 35; *Andy Warhol Found. for the Visual Arts, Inc.*, 382 F. Supp. 3d at 319.

113. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith., 598 U.S. 508, 534 (2023). Professor Karol has identified a structural flaw in the *Warhol* decision, pointing out that the grant of a license, whether commercial or not, does not infringe any of copyright's exclusive rights, for which a fair use defense would be needed. A license merely gives the licensee permission to use protected works. Karol, *supra* note 3, at 1–3. Karol is correct that Justice Sotomayor cited that phrase eight times without identifying any exclusive right that AWF might have infringed. The Court picked up the "commercial licensing" focus of the case from OSG's amicus brief in which that phrase appeared thirteen times.

114. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 534 n.9.

115. *Id.* Justices Kagan and Sotomayor disagreed about whether the 1984 creation issue was before the Court. Their opinions were talking past each other.

116. *See, e.g.*, Amended Answer and Counterclaim, *supra* note 28, at 26–27; Goldsmith SJ Memo, *supra* note 35, at 20; Goldsmith Opposition Brief, *supra* note 87, at 11, 17.

117. Goldsmith's brief was filed one week before OSG's amicus brief, so some might wonder whether OSG was following her lead in focusing its amicus brief only on the 2016 license. This seems very unlikely for several reasons. First, OSG met with lawyers for the litigants in early May 2022 and had by then already begun considering its stance. Second, OSG had by early August spent months developing and refining its argument. It is very unlikely that OSG would be able within a week's window to change its analysis to align with arguments that only the 2016 license was at issue. Third, Goldsmith's merits brief was somewhat equivocal about whether she had given up her claims that Warhol's creation of the works was illegal. *See infra* text accompanying notes 160–64.

III. A MISSING ISSUE IN THE *WARHOL* DECISIONS: IMPLICATIONS OF § 103(A) FOR AWF'S COPYRIGHTS

OSG's decision to focus its amicus brief analysis on the 2016 license had one significant advantage for AWF. It avoided the need to discuss the implications of a ruling in favor of Goldsmith's derivative work claims that might have voided AWF's copyrights in the entire *Prince Series*. If Goldsmith could persuade courts that Warhol's uses of her photograph when making the 1984 *Prince Series* were not only unfair[118] but also infringements of her derivative work right[119]—an issue on which the Second Circuit did not rule[120]—she would likely also prevail on her most dramatic claim: that AWF could not claim a copyright interest in the sixteen Warhol works depicting Prince.[121] This Part explains why a derivative work ruling would nullify AWF's copyrights under 17 U.S.C. § 103(a). It also considers some strategic reasons why AWF and Goldsmith might have wanted to avoid the § 103(a) issue. Finally, it speculates about why Goldsmith may have decided to limit her claims to the 2016 license in her merits argument to the Court.

A. NULLIFICATION OF COPYRIGHTS UNDER § 103(A)

Under 17 U.S.C. § 103(a) and case law interpreting it, the copyrights that AWF claims in the *Prince Series* could be invalidated automatically by operation of law if a court found the Warhol works to be infringing derivative works.[122] These works have seemingly enjoyed copyright for roughly forty years, and AWF had licensed many uses

118. *See infra* Part IV.C discussing possible implications of Goldsmith's abandonment of her larger claims for her ability to argue the 1984 creations were unfair on remand to the lower courts.

119. Goldsmith's claim that AWF owns no copyright in the sixteen works in the *Prince Series* must posit that Warhol was entitled, by virtue of the artist reference license, only to make the *Purple Prince*—i.e., the art piece that *Vanity Fair* was entitled to publish, subject to crediting Goldsmith for the source photograph. Prior to filing her merits brief with the Court, Goldsmith apparently argued that Warhol had no entitlement, nor did AWF, to make any other use of that print, let alone to make use of any additional images based on her photograph.

120. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 43–44 (2d Cir. 2021). The Second Circuit suggested that the *Prince Series* was closer to being an infringement of this right than a fair use, but it did not so rule. *Id.* at 52. On remand, the trial court might have revisited AWF's statute of limitations defense to Goldsmith's claims that the 1984 creations were infringements. Hence, the Second Circuit's reversal of the fair use ruling would not automatically mean that the trial court would have to find the 1984 creations to be infringing derivative works.

121. *See supra* text accompanying note 28 (Goldsmith's request for a declaration that AWF cannot claim copyright in any of the *Prince Series* works).

122. Because Warhol created the *Prince Series* under a commission from *Vanity Fair* in keeping with the artist reference license from Goldsmith's agent, the Second Circuit should perhaps have concluded that at least one of those works (and maybe more than one if Warhol created the series to give *Vanity Fair* a choice about which image to use next to the Prince article) was an authorized derivative work. In this event, AWF's copyright in that image (or those images) would not be subject to § 103(a) nullification.

of the *Prince Series* works since acquiring the copyrights after Warhol's demise.[123] Before her change of position in her merits brief to the Court, Goldsmith's victory in the *Warhol* litigation would have meant that those very valuable copyrights would suddenly cease to exist.[124]

Copyright nullification would seem a logical consequence of applying the text of § 103(a) to cases such as *Warhol*. It provides, in pertinent part, that copyright protection "for a work employing pre-existing material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully."[125] The Patry copyright treatise observes that this provision "contemplate[s] the denial of protection to noninfringing material when it is included with infringing material as a penalty for the infringement."[126]

A case illustrating the nullifying character of § 103(a) is *Anderson v. Stallone*.[127] Anderson developed a screen treatment for a sequel to Stallone's *Rocky* movies featuring the fictional boxer in a match with a Russian contender. He pitched MGM officials to acquire rights in this treatment so they could make a movie based on it. After MGM released *Rocky IV*, which allegedly borrowed heavily from this treatment, Anderson sued Stallone and MGM for copyright infringement. Anderson argued that § 103(a) should be construed to give him derivative work copyrights in his original

123. *See* Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 382 F. Supp. 3d 312, 320 (S.D.N.Y. 2019).

124. In his concurrence, Judge Jacobs opined that the court was ruling not on the legality of the originals but only on the commercial licensing. *Andy Warhol Found. for the Visual Arts, Inc.*, 11 F.4th at 54–55 (Jacobs, J., concurring). By contrast, Judge Lynch's opinion for the panel was focused on the unfairness of the entire *Prince Series*. *See supra* Part I.B.

125. 17 U.S.C. § 103(a). The Second Circuit has somewhat limited the scope of § 103(a)'s nullification, saying that it applies only when infringing elements "tend[] to pervade the entire work" at issue. *See, e.g.*, Eden Toys, Inc. v. Florelee Undergarment Co., 697 F.2d 27, 34 n.6 (2d Cir. 1982) (citations omitted). This "pervade the entire work" standard has been influential in some subsequent cases and with some treatise authors. *See, e.g.*, Hiller, L.L.C. v. Success Grp. Int'l Learning All., LLC, 976 F.3d 620, 622 (6th Cir. 2020) (upholding jury instruction on the "pervade" standard for § 103(a) invalidation and recognizing that jury could have found derivative work was copyrightable despite some copying from the plaintiff's work); Wolf v. Travolta, 167 F. Supp. 3d 1077, 1091 (C.D. Cal. 2016) (reasonable jury could be persuaded that copied material did not pervade the defendant's work); *see also* 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 3.06 (2023). *But see* WILLIAM F. PATRY, PATRY ON COPYRIGHT § 3:59 (2023) (disagreeing with *Eden Toys* on this issue). Given the tone and substance of the Second Circuit's opinion holding that the Warhol works were substantially similar as a matter of law to the Goldsmith photograph, *Andy Warhol Found. for the Visual Arts, Inc.*, 11 F.4th at 52–54, it is unlikely that that court could be persuaded that Goldsmith's photograph did not "pervade" the Warhol works. *See, e.g.*, *id.* at 54 (Warhol "produced the Prince Series works by copying the Goldsmith Photograph itself—*i.e.*, Goldsmith's particular expression of that idea.").

126. PATRY, *supra* note 125, § 3:59; *see also* PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 2.16 (3d ed., 2024-2 Supplement). The result of § 103(a) nullifications when infringing and non-infringing parts are co-mingled "is particularly harsh for the motion picture producer whose use of the underlying story may have been unintentional, and whose independent contributions will typically represent the great proportion of the derivative work's value." GOLDSTEIN, *supra.*

127. No. 87-0592 WDKGX, 1989 WL 206431 (C.D. Cal. Apr. 25, 1989); *see* RESTATEMENT OF THE L., COPYRIGHT § 3, cmt.(g) (AM. L. INST., Tentative Draft No. 4, 2023) (discussing § 103(a) and giving examples of some uses of pre-existing works that would not enjoy copyright protection and some uses that would retain copyrights).

contributions that Stallone and MGM allegedly incorporated into the movie. The court rejected Anderson's interpretation of § 103(a). It held that he was an infringer because he had "bodily appropriated" the *Rocky* movie characters and "lifted lock, stock and barrel from the prior Rocky movies."[128] Because Anderson's treatment was an unauthorized derivative work, the court held that he was ineligible for a copyright under § 103(a).[129]

Given the stakes in the *Warhol* litigation for AWF's ability to claim rights in the *Prince Series*, it is curious—or perhaps even astonishing—that § 103(a) was not mentioned, even in passing, in any of the *Warhol* opinions. All six judicial opinions addressing AWF's fair use defense—one at the trial court level, two in the Second Circuit, and three at the Supreme Court—are utterly silent about § 103(a) and its implications for the Warhol copyrights.

The explanation for these omissions is simple. Neither AWF's nor Goldsmith's summary judgment briefs mentioned that provision. And none of Goldsmith's five appeal briefs (three to the Second Circuit and two to the Supreme Court) cited that section. AWF's initial brief to the Second Circuit also was silent about § 103(a).

The first brief to discuss the implications of § 103(a) for Warhol's copyrights was AWF's petition asking the Second Circuit panel to rehear its fair use ruling.[130] The rehearing petition focused largely on the inconsistency of that court's ruling with the Supreme Court's recently issued *Google v. Oracle* decision.[131] But the rehearing petition also asserted that the Second Circuit panel's narrow interpretation of transformative purposes "threatens to render *unlawful* large swaths of contemporary art that incorporates and reframes copyrighted material to convey a new and different message—effectively outlawing a genre widely viewed as 'one of the great artistic innovations of the modern era.'"[132] The *Warhol* decision had implications, in other words, not just for the sixteen Warhol works depicting Prince but for the entire field

128. *Anderson*, 1989 WL 206431, at *8.

129. *Id; see also* Pickett v. Prince, 207 F.3d 402, 406–07 (7th Cir. 2000) (rejecting an infringement claim for defendant's copying of plaintiff's guitar design in the shape of the copyrighted symbol representing Prince's name because plaintiff's infringing derivative was not entitled to copyright under § 103(a)); Polychron v. Bezos, No. 2:23-cv-02831-SVW-E, 2023 WL 6192743, at *8 (C.D. Cal. Aug. 14, 2023) (following *Anderson*, finding author of unauthorized sequel series of books not entitled to any copyright protection and dismissing claim against original creators); Sobhani v. @Radical.Media, Inc., 257 F. Supp. 2d 1234 (C.D. Cal. 2003) (rejecting an infringement claim based on the copying of numerous elements of plaintiff's commercial spoof of a motion picture because plaintiff had infringed rights in that movie and held no copyright under § 103(a)).

130. Petition for Panel Rehearing and Rehearing En Banc at 18, *Andy Warhol Found. for the Visual Arts, Inc.*, 11 F.4th 26 (No. 19-2420-cv) [hereinafter Rehearing Petition].

131. *Id.* at 2. This brief was filed by a different set of lawyers than those who represented AWF at the trial court and Second Circuit.

132. *Id.* at 17 (quoting Blake Gopnik, *Warhol a Lame Copier? The Judges Who Said So Are Sadly Mistaken.*, N.Y. TIMES (Sept. 24, 2021), https://www.nytimes.com/2021/04/05/arts/design/warhol-copyright-appeals-court.html [https://perma.cc/5FNJ-PY8K] [https://web.archive.org/save/https://www.nytimes.com/2021/04/05/arts/design/warhol-copyright-appeals-court.html].

of appropriation art as well as for centuries of visual art whose creators had long built upon images from previous works.[133]

AWF's rehearing petition observed that the panel's ruling would mean that "[a]rtists like Warhol [would] lose all copyright protection" and also that "licensing fees for their new works [could] be reaped only by the copyright owner of the source material (even when the second artist's contributions underpin all licensing demand)."[134] In other words, Goldsmith would be able, as Stallone had allegedly done with Anderson's screen treatment, to commercially exploit Warhol's *Prince Series* because AWF would no longer have any enforceable rights in those works. AWF regarded the value of the *Prince Series* works as overwhelmingly due to Warhol's contributions rather than to the artistry in Goldsmith's photograph. After all, Goldsmith had not exploited the copyright in that photograph (except for the 1984 license her agent granted to *Vanity Fair*) at all in the years thereafter.[135]

The rehearing petition added that nullification of AWF's copyrights would also have significant implications for the rights of museums and galleries who owned copies of the Warhol prints. Because § 109(a)'s grant of rights to resell, lend, or otherwise distribute owned copies applies only to "lawfully made" copies, museums, galleries, and collectors that owned copies of the Warhol works would no longer be entitled sell, lend, or otherwise distribute them.[136] Even worse, museums and galleries would no longer be able to lawfully display those copies publicly because § 109(c) limits the exclusive right to control public displays to "lawfully made" copies.[137]

Finally, the rehearing petition pointed out that if courts ruled that the Warhol *Prince Series* infringed Goldsmith's photograph, Goldsmith could, under 17 U.S.C. § 502, ask the court for an injunction forbidding AWF to make any further uses of the Warhol images and for an order to impound and destroy the infringing copies under § 503, as well as ask for an award of damages and disgorgement of past profits under § 504.[138] AWF obviously hoped to persuade the court that much more was at stake in the case than the panel had initially realized.

133. *See* Corrected Brief of the Robert Rauschenberg Foundation et al. as Amici Curiae in Support of Appellee's Petition for Panel Rehearing and Rehearing En Banc, *Andy Warhol Found. for the Visual Arts, Inc.*, 11 F.4th 26 (No. 19-2420-cv).

134. Rehearing Petition, *supra* note 130, at 18. It added: "Countless seminal works of contemporary art would be imperiled to suffer the same fate as the Prince Series." *Id.* AWF predicted that the Second Circuit's ruling would also have a chilling effect on future creation of artistic works. *Id.*

135. Andy Warhol Found for the Visual Arts, Inc. v. Goldsmith, 382 F. Supp. 3d 312, 322 (S.D.N.Y. 2019). As Goldsmith explained it, her intention is to "edition" her works at later dates in hopes of rising value. *See* Goldsmith SJ Memo, *supra* note 35, at 17.

136. 17 U.S.C. § 109(a); Rehearing Petition, *supra* note 130, at 18.

137. 17 U.S.C. § 109(c); Rehearing Petition, *supra* note 130, at 17.

138. Rehearing Petition, *supra* note 130, at 18. AWF's petition for certiorari and merits brief also mentioned the potential implications of § 103(a) for Warhol's copyrights, but did not emphasize the point in its cert petition as much as in the rehearing petition. *See* Cert Petition, *supra* note 76, at 35; Brief for Petitioner, *supra* note 86, at 54–56.

During oral argument before the Second Circuit, Goldsmith's lawyer disclaimed any intention to seek these extreme remedies and asserted that all she wanted was some compensation from AWF.[139] The Second Circuit was reassured by these statements.[140] The panel opinion dismissed as "not particularly relevant" AWF's concerns about the implications of its rulings for museums' and galleries' ability to display the Warhol images they owned.[141] It defensively denied that it was outlawing a particular field of art.[142]

The concurring opinion recognized that it was "very easy for opinions in this area (however expertly crafted) to have undirected [sic] ramifications."[143] Judge Jacobs asserted that the court was not "consider[ing], let alone decid[ing], whether the infringement here encumbers the original Prince Series works that are in the hands of collectors or museums."[144] He declared that "Goldsmith does not claim that the original works infringe and expresses no intention to encumber them,"[145] a claim which was not even close to being true.[146] As he understood the case, all Goldsmith wanted was some compensation for AWF's licensing.[147]

Goldsmith's reassurances notwithstanding, the Second Circuit panel simply did not understand how § 103(a) was likely to play out in a case such as *Warhol*. If Warhol's uses of Goldsmith's photograph went beyond what fair use allows, and if those uses infringed Goldsmith's right to prepare derivative works, that would almost certainly result in AWF's copyrights in the *Prince Series* being rendered null and void.[148]

B. STRATEGIC REASONS FOR AVOIDING DISCUSSION OF § 103(A)

Goldsmith likely had some strategic reasons for not mentioning the prospect of automatic nullification of copyrights under § 103(a) if a court found that Warhol and AWF infringed her derivative work right. For one thing, Goldsmith wanted her

139. Oral Argument at 7:54, Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26 (2d Cir. 2021) (No. 19-2420-cv), https://www.courtlistener.com/audio/71561/the-andy-warhol-foundation-v-goldsmith/ [https://perma.cc/JY74-X23J] [https://web.archive.org/save/https://www.courtlistener.com/audio/71561/the-andy-warhol-foundation-v-goldsmith/]. Goldsmith's counsel made similar statements during Supreme Court Oral Argument, *supra* note 23, at 80–82.

140. *Andy Warhol Found. for the Visual Arts, Inc.*, 11 F.4th at 45 & n.8, 50–51 (noting that Goldsmith was not seeking an injunction or destruction).

141. *Id.* at 49.

142. *Id.* at 52.

143. *Id.* at 54 (Jacobs, J., concurring).

144. *Id.*

145. *Id.* at 55.

146. *See* Corrected Brief of Appellants Lynn Goldsmith and Lynn Goldsmith, Ltd. at 21–25, *Andy Warhol Found. for Visual Arts, Inc.*, 11 F.4th 26 (No. 19-2420-cv) (arguing that creation of the *Prince Series* was unfair and infringed her derivative work rights).

147. *Andy Warhol Found. for the Visual Arts, Inc.*, 11 F.4th at 54 (Jacobs, J., concurring).

148. The Court in *Campbell* observed that it may sometimes be in the public interest not to issue an injunction if a second comer's use is beyond what fair use allows. Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 578 n.10 (1994).

request for relief to seem relatively modest (i.e., just her fair share of licensing revenues from magazines such as those owned by Condé Nast). Second, she may implicitly have counted on the court to perceive as inequitable that she was paid only $400 in 1984 for the artist reference use of the photograph when AWF got $10,000 for licensing Condé Nast's use of the *Orange Princ*e which was based on her photograph. If the court perceived her counterclaim to be in pursuit of control over AWF's copyrights, this might have changed the court's perception of the equities as between AWF and Goldsmith. Third, she may have recognized that § 103(a) would automatically kick in if she could defeat AWF's fair use defense and prevail on her counterclaim.

Goldsmith would not need to ask the court for an injunction to commercially exploit copies of the Warhol *Prince Series,* including making derivative works of them, if § 103(a) applied. This was because AWF could not sue her for infringement as it would no longer have any exclusive rights in those works. Stealth mode might get Goldsmith everything she demanded in her counterclaim's prayer for relief.

AWF likely had a different set of strategic reasons for not mentioning § 103(a) prior to the Second Circuit rehearing petition. Because the trial court's ruling was consistent with the liberal interpretations given to fair use in cases such as *Cariou v. Prince*,[149] AWF was confident—in retrospect, overconfident—that the Second Circuit would affirm. AWF had also attracted amicus briefs in support of affirmance from some appropriation artists, the Rauschenberg Foundation, and some law professors.[150] Given that Goldsmith was downplaying the remedy she was seeking, AWF may have thought it was risky to point out that a ruling against its fair use defense might have much more dire consequences than an award of some compensation to Goldsmith.

OSG may have had yet another set of reasons for not mentioning § 103(a) in its brief. Because Warhol was long dead, it was not possible to resolve the ambiguity about the circumstances under which Warhol created those sixteen works. Hence, it made sense for OSG to surmise in its amicus brief that the works may have been created under the artist reference license or as fair uses. Perhaps it was just a coincidence that OSG's focus on the 2016 license opened up the possibility of achieving a compromise about

149. Cariou v. Prince, 714 F.3d 694, 712 (2d Cir. 2013) (holding Prince's use of Cariou's photographs to achieve a different aesthetic effect to be fair use as to twenty-five of the thirty images). An important distinction between the *Warhol* and *Cariou* cases is that Warhol obtained Goldsmith's photograph as an artist reference after having been commissioned to create visual art based on it, whereas the artist Richard Prince obtained copies of Patrick Cariou's photographs from a compilation in a book. AWF seemingly made a strategic decision not to emphasize *Vanity Fair*'s commission to Warhol to create visual art based on Goldsmith's photograph or that *Vanity Fair* gave Warhol the photograph as an artist reference. In retrospect, this may have been a mistake.

150. Brief of the Robert Rauschenberg Foundation as *Amicus Curiae* in Support of Appellee, Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26 (2d Cir. 2021) (No. 19-2420-cv); Brief for *Amici Curiae* Latipa (née Michelle Dizon) and Việt Lê, in Support of Appellee The Andy Warhol Foundation for the Visual Arts, Inc., *Andy Warhol Found. for the Visual Arts, Inc.*, 11 F.4th 26 (No. 19-2420-cv); Brief of *Amici Curiae* Law Professors in Support of Appellees and Affirmance, *Andy Warhol Found. for the Visual Arts, Inc.*, 11 F.4th 26 (No. 19-2420-cv).

Goldsmith's infringement claim.[151] A ruling in her favor only on that license would potentially appease both opposing camps—not just the petitioner and the respondent, but also the many amici who supported AWF, Goldsmith, or neither party, many of whom held conflicting views about the boundaries separating transformative fair uses and infringing derivative works.[152] A focus on the 2016 license would also provide the government with an opportunity to offer its view on how the Court should interpret transformativeness in fair use cases.

By suggesting that Warhol's creation of these works may have been fair use or covered by the license,[153] OSG avoided the need to address the implications of § 103(a). AWF's copyrights in the *Prince Series* could then remain intact, and the Court would not have to brand Warhol as an infringer. Appropriation art would likely live to see another day, and a potential deluge of litigation against appropriation artists could be averted.

A decision that focused only on the 2016 license would also mean that Goldsmith would not enjoy a windfall by, in effect, appropriating the remaining commercial value of the Warhol *Prince Series* copyrights. Moreover, it precluded Goldsmith from seeking an award of damages and profits disgorgement going back to 1984.[154] In addition, it avoided subsequent threats or litigation against galleries and museums for displaying works in the *Prince Series*.[155]

151. *See, e.g.*, Paul R. Gugliuzza & Pyry P. Koivula, *Stepping Out of the Solicitor General's Shadow: The Federal Circuit and the Supreme Court in a New Era of Patent Law*, 64 B.C. L. REV. 459, 495–552 (2023) (discussing OSG's flexibility in shaping key issues for the Court in its amicus briefs).

152. Many of the *Warhol* Supreme Court amici briefs (except OSG's) focused on the 1984 creation issue in keeping with the trial and appellate court decisions in the case.

153. OSG Brief, supra note 1, at 32.

154. Goldsmith argued at the trial court level that she did not discover Warhol's infringement until 2016 when she saw the *Orange Prince* on the cover of the Condé Nast special issue and was therefore entitled to sue AWF based on Warhol's 1984 infringement. *See* Goldsmith SJ Memo, *supra* note 35, at 20, 46. Whether on remand Goldsmith could potentially recover damages and profits back to 1984 may depend on how the Supreme Court resolves a circuit split about whether copyright owners can claim monetary relief going back to the first acts of infringement or if they are limited to recovery for only three years of infringement prior to filing. *Compare* Nealy v. Warner Chappell Music, Inc., 60 F.4th 1325 (11th Cir. 2023) (no time limit on damage recovery), *cert. granted*, 2023 WL 6319656 (Sept. 29, 2023) (No. 22-1078), *with* Sohm v. Scholastic, Inc., 959 F.3d 39, 52 (2d Cir. 2020) (recovery limited to three years prior to filing). For a discussion of the potential implications of this circuit split for Goldsmith, see Ochoa, *supra* note 10. The Court limited the *Nealy* case to the question of whether, under the discovery accrual rule, a copyright plaintiff can recover damages that allegedly occurred more than three years before the filing of a lawsuit.

155. Before the Second Circuit and Supreme Court, Goldsmith may have said that she did not intend to sue these institutions or individuals or assert entitlement to extreme remedies, but she or her heirs might later change their minds. *See* Eva E. Subotnik, *Artistic Control After Death*, 92 WASH. L. REV. 253, 309–10 (2017) (describing how heirs affect subsequent uses of copyright assets). Goldsmith could also have sold her copyright in that photograph to a third party who then might sue these institutions or individuals or whoever tried to sell one of the *Prince Series* prints at auction. Oddly enough, the value of those prints has risen significantly since the Supreme Court's decision in Goldsmith's favor. *See* Tori Latham, *The Supreme Court's Ruling on Andy Warhol's 'Prince' Prints May Have Increased Their Value by 40 Times*, ROBB REP. (June 12, 2023), https://robbreport.com/lifestyle/news/andy-warhol-prince-supreme-court-1234854770/ [https://perma.cc/8FPS-BAUT]

Yet, this would also mean that Goldsmith would not leave the litigation with AWF empty-handed. OSG and the Second Circuit perceived Goldsmith to be entitled to some compensation from AWF because of the commercial nature of the transaction with Condé Nast. Even if the initial creation of the *Orange Prince* might have been fair, however, this did not necessarily mean that AWF's license to Condé Nast was also fair. If the Court upheld Goldsmith's claim as to the 2016 license, Goldsmith and her amici would be satisfied, even if neither OSG nor the Court endorsed their views that Warhol's 1984 creations were infringing derivative works.

C. OSG MEETS WITH COUNSEL

OSG makes a regular practice of meeting with counsel for the petitioners and respondents in Supreme Court cases to give them the opportunity to make their best arguments for their clients and against their opponents' arguments.[156] During those meetings, OSG may indicate the position that OSG intends to take on the merits.[157] In the *Warhol* case, OSG may have made it clear to AWF's and Goldsmith's counsel that it regarded the only issue before the Court was whether the 2016 license was transformative.[158]

Goldsmith's lawyers may have hoped to persuade OSG that Warhol's creation of the *Prince Series* infringed her derivative work right, for this had been her core argument in the brief opposing certiorari and in her earlier briefs in the *Warhol* case.[159] However, if OSG signaled that only the 2016 license was at issue, Goldsmith may have been

[https://web.archive.org/web/20240127054649/https://robbreport.com/lifestyle/news/andy-warhol-prince-supreme-court-1234854770/].

156. *See, e.g.*, Millet, *supra* note 79, at 217, 227. Such meetings are likely to also include representatives of interested offices and agencies, "especially those charged with administering and implementing the law or regulation in question." *Id.* at 218; *see also* STEPHEN M. SHAPIRO ET AL., SUPREME COURT PRACTICE § 6.41 (11th ed. 2019) (referencing former Solicitor General Paul Clement describing meetings with parties' counsel along with government departments and agencies).

157. *See* Millett, *supra* note 79, at 227 ("A meeting [with OSG] will also allow counsel to develop her own briefing strategy based on insights gained from those discussions and, in particular, will allow formulation of her brief in a way that either takes advantage of any support provided by the Solicitor General's position or mitigates the harm inflicted by it.").

158. Email from Andrew Gass, counsel for the Andy Warhol Foundation for the Visual Arts, Inc., to Pamela Samuelson (Nov. 25, 2023) (on file with author). The meeting was held via Zoom on May 4, 2022. Email from Andrew Gass to Pamela Samuelson (Jan. 7, 2024) (on file with author). AWF's counsel sent a follow-up letter to OSG to explain why it continued to regard the 1984 creation of the *Prince Series* works as a live issue before the Court. Email from Andrew Gass to Pamela Samuelson (Dec. 26, 2023) (on file with author). Goldsmith's counsel declined a request to confirm that OSG told them that only the 2016 license was at issue in their meeting with OSG.

159. Goldsmith Opposition Brief, *supra* note 87, at 8–9, 11 (statement of facts); *id.* at 17 (asserting that the Second Circuit ruled correctly). If Goldsmith had succeeded in getting a ruling that the 1984 *Prince Series* works were infringing derivatives, that would potentially have been worth hundreds of thousands of dollars (or possibly more). Monetary compensation limited to a share of the 2016 license revenues would have been much more modest.

persuaded to give up her larger claim of infringement based on Warhol's creation of the *Prince Series*.

That said, Goldsmith risked losing the whole case if OSG was prepared to suggest to the Court that Andy Warhol's uses of the photograph in 1984 might have been fair use or covered by the license. A smaller win would still be a win, even if she lost the opportunity to get substantial damages for past infringements and effective control over the commercial value of the Warhol *Prince Series*.

D. MERITS ARGUMENTS TO THE COURT

Goldsmith's merits brief and oral argument did not clearly signal to the Court that she was no longer contending that the 1984 creation of the *Prince Series* had infringed her rights. The brief principally argued for a recalibration of fair use under which a second comer's use would be deemed transformative "only if that use must necessarily copy from the original without 'supersed[ing] the use of the original work, and substitut[ing] . . . for it.'"[160] Under this standard, fair use would be available only for new uses that copy from original works "out of necessity" to achieve "some distinct creative end."[161] Limiting fair use to necessity-copying cases would, Goldsmith argued, further the purposes of copyright to protect creators from second comers that usurp their markets.[162] Because Warhol did not need to copy Goldsmith's photograph to make new visual art, his creation of the *Prince Series* was not transformative under this necessity standard.[163] Goldsmith's brief also criticized AWF's emphasis on the "new meaning or message" standard because it implicitly posited that imposing Warhol's unique style on any work would make it transformative.[164] These aspects of Goldsmith's arguments intimated that the 1984 creation issue was still live in her conception of the case.

Most of AWF's reply brief sought to refute Goldsmith's argument for a fair use necessity standard. It pointed to inconsistencies of this novel theory with the Court's precedents and argued that she had waived this theory by not raising it in the lower courts.[165] Because Goldsmith principally focused on its necessity standard for judging fair uses, AWF did not perceive Goldsmith's merits brief to be solely focused on the 2016 license and aligned with OSG's alternative use-by-use standard.

As for OSG's amicus brief, AWF criticized it for not addressing the question presented and disagreed with its use-by-use approach to assessing transformativeness,

160. Goldsmith Merits Brief, *supra* note 90, at 24 (alterations and omissions in original) (internal citations omitted); *see also id.* at 20–21, 23–35 (discussing a standard that would limit fair use to necessity-copying cases).

161. *Id.* at 21.

162. *Id.*

163. *Id.*

164. *Id.* at 23.

165. Reply Brief for Petitioner at 10–17, Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 598 U.S. 508 (2023) (No. 21-869).

saying it "cannot be reconciled with this Court's cases or the underlying purposes of copyright law" because it ignored the contents of secondary works.[166]

AWF's reply brief did not respond to that part of Goldsmith's merits brief that characterized the origins of the *Prince Series* creation as "obscure" and speculated that Warhol might have created those works "so *Vanity Fair* could pick the image it liked best—in which case the Prince Series might have been 'lawfully made' under *Vanity Fair*'s license."[167] In this respect, she conformed her argument to OSG's likely position, which improved her chances of winning before the Court.[168]

During oral argument, AWF sought to draw the Court's attention to the implications of the Second Circuit's ruling in Goldsmith's favor, asserting that it "would strip protection not just from the Prince Series but from countless works of modern and contemporary art" and would make it illegal "for artists, museums, and galleries and collectors to display, sell, profit from, and maybe even possess" such works.[169] Goldsmith's oral argument, by contrast, focused on the unfairness of the 2016 license and why AWF's theory about transformativeness would "drive a giant hole through a derivative work [right]."[170]

Unlike its amicus brief, OSG's oral argument did not mention the possibility that the 1984 creations might have been fair use or covered by the license. It asserted instead that the 2016 licensed use was not transformative and was unfair because the *Orange Prince* had the same commercial purpose as Goldsmith's photograph and competed in the same market for licensing images of Prince to magazines for stories about the rock musician.[171]

OSG agreed with a key point from the Second Circuit's decision that AWF's commercial licensing of Warhol's *Orange Prince* to magazines was non-transformative because it had the same purpose and competed in the same market as Goldsmith's photograph.[172] And the Supreme Court agreed with this analysis.

166. *Id.* at 18.

167. Goldsmith Merits Brief, *supra* note 90, at 37.

168. Goldsmith's merits brief also stated that the sole use of her work identified in the counterclaim was the 2016 license. It also asserted she was not seeking to enjoin displays of the *Prince Series*, and that there was a three-year statute of limitations in copyright cases. *Id.* at 17–18. The Court cited these statements as the basis of its conclusion that she had abandoned the larger claims. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 534 n.9. AWF's reply brief might have made much more of these seeming concessions than it actually did.

169. Supreme Court Oral Argument, *supra* note 23, at 4–5. However, merely possessing an infringing derivative work does not infringe. *See, e.g.*, Societe Civile Succession Richard Guino v. Int'l Found. for Anticancer Drug Discovery, 460 F. Supp. 2d 1105, 1106 (D. Ariz. 2006). AWF also expressed concern about a chilling effect on the creation of new art, which would harm up-and-coming as well as established artists. Supreme Court Oral Argument, *supra* note 23, at 5. AWF did not mention § 103(a) explicitly.

170. Supreme Court Oral Argument, *supra* note 23, at 70, 80–81.

171. *Id.* at 86–115.

172. In particular, OSG agreed with the Second Circuit about the significance of the *Orange Prince* having the same purpose as Goldsmith's work in the commercial licensing market. OSG Brief, *supra* note 1, at 17–18.

E. THE JUSTICES DISAGREED ABOUT OSG'S REFRAMING OF THE *WARHOL* CASE

Did the Justices and their exceptionally well-qualified law clerks agree with OSG's assertion that the lower courts' *Warhol* decisions had only addressed the fairness of the 2016 license to Condé Nast? Did they believe those courts had said nothing whatever about the fairness—or not—of the 1984 creation of the *Prince Series*, as OSG's amicus brief intimated?

They must have realized that AWF's petition and merits briefs, as well as its briefs to the lower courts, were entirely focused on the fairness of Warhol's creation of the *Prince Series*.[173] Moreover, the necessity standard argument in Goldsmith's merits brief suggested she had not entirely given up that claim.[174] During oral argument, AWF reiterated points made earlier in its Second Circuit rehearing petition about the significant implications of § 103(a) if Goldsmith prevailed not only for Warhol's copyrights but also for museums, galleries, and collectors who owned copies of those works, as well as for the field of contemporary art writ large.[175] Did the Justices realize the potential nullifying effect of § 103(a), or did they just choose to ignore it when ruling on the merits?

Justice Sotomayor's opinion for the Court avoided dealing with the § 103(a) issue by acceding to OSG's narrowing of the question presented and characterizing Goldsmith as having abandoned her larger claims. The majority could then declare that the Court took no position about the lawfulness of the 1984 creation of the *Prince Series*.[176]

Some part of the battle between the majority and dissenting opinions was over the transformative purpose of the 1984 creation and the non-transformativeness of the 2016 license issue. This is apparent from Justice Sotomayor's criticism of Justice Kagan for "focus[ing] on a case that is not before the Court" because Justice Kagan had insisted that the issue before the Court was whether Warhol had transformative purposes and made transformative uses of Goldsmith's photograph when creating the *Prince Series*. Justice Kagan regarded AWF's fair use claim as sound because of the transformations.[177] The dissent recognized that the 1984 creation issue was what had been hotly disputed in the lower courts and about which AWF had sought Supreme Court review. Yet, Justice Sotomayor accused Justice Kagan of engaging in a "sleight of hand" by assuming that the purpose factor analysis should be the same for all uses of secondary works.[178]

173. *See supra* text accompanying notes 27, 84–86. In a footnote, Justice Sotomayor acknowledged that AWF had sought a declaration of non-infringement as to the *Prince Series*. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 534 n.9

174. *See supra* notes 90–91 and accompanying text.

175. *See* Brief for Petitioner, *supra* note 86, at 54–56; Supreme Court Oral Argument, *supra* note 23, at 4–5; *supra* text accompanying notes 131–37.

176. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 534. Perhaps tellingly, during oral argument Justice Sotomayor continually steered AWF's counsel away from discussing Warhol's creation of the *Prince Series* works to focus on AWF's 2016 licensing. *See* Supreme Court Oral Argument, *supra* note 23, at 6–11.

177. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 534 n.10; *id.* at 568–74 (Kagan, J., dissenting).

178. *Id.* at 534 n.10 (majority opinion).

She did not acknowledge that OSG's argument about judging fair uses on a use-by-use basis was novel and had not been fully briefed by the parties or their amici, or that OSG's case law support for the proposition was remarkably thin. She also charged Justice Kagan with having asserted a "false equivalence between AWF's commercial licensing and Warhol's original creation."[179] Justice Sotomayor thought this caused Justice Kagan to make a "series of misstatements and exaggerations" about the implications of the Court's ruling, among them apparently the assertion that upholding Goldsmith's claim would likely have harmful consequences for contemporary art.[180]

Justice Kagan criticized the majority for having philistine conceptions of contemporary art.[181] Perhaps she should instead have criticized the majority about its failure to address the issue actually before the Court, the lower court rulings, and Goldsmith's longstanding claims. That would have done more to limit the potential precedential potency of Justice Sotomayor's *Warhol* opinion than criticizing her fellow Justices for not appreciating Warhol's art.

Perhaps Justice Sotomayor—and the Justices who voted with her—decided that the *Warhol* case provided an opportunity to respond to numerous criticisms of fair use in the post-*Campbell* transformativeness case law if the Court focused only on the 2016 license issue.[182]

IV. IMPLICATIONS OF THE *WARHOL* DECISION FOR THE FUTURE OF FAIR USE

The *Warhol* decision delivered at least five messages about how courts should assess fair use defenses in future fair use cases. One is that a secondary work's new meaning or message may be relevant to whether that work was transformative but will not be dispositive. A second is that it matters whether a secondary work has the same or a

179. *Id.* The bitter and highly personalized criticisms in Justice Sotomayor's and Justice Kagan's opinions were unseemly. Both Justices should have put these first drafts in a drawer and written new ones after they cooled down.

180. *Id.* at 593 (Kagan, J., dissenting). *But see* Amy Adler, *The Supreme Court's* Warhol *Decision Just Changed the Future of Art*, ART IN AM. (May 26, 2023), https://www.artnews.com/art-in-america/columns/supreme-court-andy-warhol-decision-appropriation-artists-impact-1234669718/ [https://perma.cc/EC99-QHXN] [https://web.archive.org/web/20240222212009/https://www.artnews.com/art-in-america/columns/supreme-court-andy-warhol-decision-appropriation-artists-impact-1234669718/] (expressing similar concerns as Justice Kagan's dissent); Richard Meyer, *The Supreme Court Is Wrong About Andy Warhol*, N.Y. TIMES (June 5, 2023), https://www.nytimes.com/2023/06/05/opinion/supreme-court-andy-warhol.html [https://perma.cc/EDN4-YVRA] [https://web.archive.org/web/20240222212621/https://www.nytimes.com/2023/06/05/opinion/supreme-court-andy-warhol.html] (same).

181. *See Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 583–92.

182. Some have perceived a trend of broader interpretations of transformativeness in recent fair use cases, perhaps typified by the trial court's ruling in *Warhol*. *See* Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 382 F. Supp. 3d 312, 324–31 (S.D.N.Y. 2019); *see also* Asay et al., *supra* note 34, at 962 (highlighting broad interpretations of transformative purposes in the post-*Campbell* case law).

different purpose as the underlying work whose expression it borrows. Fair use may be less likely if the two works have the same purpose and more likely if they have different purposes. A third is that courts should weigh the commerciality of secondary works in fair use assessments, for the risk of competitive substitution is higher when secondary works have commercial purposes. A fourth is that authors of secondary works should offer justifications for their uses of expression from another author's works. A fifth is that fair uses should be judged on a use-by-use basis. That is, the fact that a second author's first use of another author's work was fair does not mean that their second or third use of that first work's expression will necessarily be fair use.[183]

Drawing upon these criteria, the Court decided that AWF's grant of a license in 2016 was not transformative. This resolved one important issue in the *Warhol* case. But the Court did not address another important issue: whether AWF has valid copyrights in the *Prince Series* works. If Goldsmith has abandoned her larger claims against AWF, does that mean she now accepts that AWF does own valid copyrights, even if those copyrights are to some degree encumbered by Goldsmith's copyright?

A. FIVE MESSAGES ABOUT FAIR USE IN *WARHOL*

One unmistakable message conveyed in *Warhol* concerns the criteria for judging "transformative" purposes in fair use cases. The Court had first articulated a definition of this term in *Campbell* and reiterated it in *Google* as "add[ing] something new, with a further purpose or different character, *altering the first with new expression, meaning, or message*."[184] *Warhol* dropped that last clause in the Court's restatement of that term's definition.[185] From now on, new expressions, meanings, or messages may, the Court said, be relevant to whether a secondary use has a different purpose than the original and hence is transformative, but will not be dispositive.[186]

Second, *Warhol* gave much more attention than *Campbell* to whether the secondary work had the same or a different purpose than the first work.[187] *Warhol* suggests that having the same purpose as a first work makes the second author's work less likely to

183. But for OSG's narrowing of the issue in *Warhol*, the Court would have had to decide whether Warhol's 1984 creation of the *Prince Series* was or was not transformative. This would surely have presented a closer question for the Court.

184. Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 579 (1994) (emphasis added); Google LLC v. Oracle Am., Inc., 593 U.S. 1, 29 (2021).

185. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 525–26. Justice Kagan's dissent discussed the significance of the omitted phrase. *Id.* at 558, 570–72 (Kagan, J., dissenting).

186. *Id.* at 525–26 (majority opinion). Under the Second Circuit's decision, by contrast, judges were expressly forbidden to give any consideration to the newness of the secondary work's expression, meaning, or message. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 41–42 (2d Cir. 2021). It is worth noting that the majority opinion includes multiple copies of Goldsmith's photograph, various works in Warhol's *Prince Series*, and other depictions of Prince, *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 516–23, without articulating its justification for making these multiple copies.

187. *Id.* at 527–29. In this respect, it was consistent with the Second Circuit decision, although the Court did not say that the second work must have a "distinct artistic purpose" as the Second Circuit did. *Andy Warhol Found. for the Visual Arts, Inc.*, 11 F.4th at 41.

be transformative because the risk of market substitution is greater when the second work has the same purpose.[188] Having the same purpose is also of concern if that use was commercial.[189] Yet, if a secondary work has a different purpose than the first work, as in many post-*Campbell* cases, it is more likely to be deemed transformative.[190] The Court also reiterated that transformativeness is a matter of degree and must be weighed carefully in relation to other factors.[191]

Third, *Warhol* suggests that the commerciality (or lack thereof) of the second work should have greater significance when courts assess the purpose and character of the challenged use.[192] However, there is no reason to think that *Warhol* has reinstated the presumption of unfairness that the Court first endorsed in *Sony* and then repudiated in *Campbell*, at least as applied to transformative works.[193] Rather, *Warhol* seems to have raised the significance of commercial purposes but only in light of the Court's concerns about secondary works supplanting demand for the original.[194]

Fourth, *Warhol* made explicit that an important consideration in fair use cases is the second comer's articulation of a justification for their use of expression from the first work.[195] The Court drew the justification concept from Judge Leval's discussion of fair use in *Authors Guild v. Google Inc.*[196] The Court explained that 2 Live Crew's use of parts

188. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 527–28, 532–33.

189. *Id.* at 532–33.

190. *See, e.g.*, Am. Soc'y for Testing & Materials v. Public.Resource.Org, 82 F.4th 1262, 1267–68 (D.C. Cir. 2023) (following *Warhol* and determining that defendant's distinct purpose in republishing industry standards developed by plaintiff organizations was transformative); Cramer v. Netflix, No. 3:22-cv-131, 2023 WL 6130030, at *7 (W.D. Pa. Sept. 18, 2023) (following *Warhol* and focusing on the actual use rather than on an artist's stated or perceived intent to find defendant's use of tattoo image different from plaintiff's original purpose).

191. *Am. Soc'y for Testing & Materials*, 82 F.4th at 1276–77. The Second Circuit *Warhol* decision, by contrast, treated transformativeness as an all-or-nothing consideration. *See* Brief of Authors Alliance as *Amicus Curiae* in Support of Petitioner at 13–15, *Andy Warhol Found. for Visual Arts, Inc.*, 598 U.S. 508 (No. 21-869) [hereinafter Authors Alliance Brief].

192. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 530–32, 536–38; *see, e.g.*, Campbell v. Gannett Co., No. 4:21-00557-CV-RK, 2023 WL 5250959, at *5 (W.D. Mo. Aug. 15, 2023) (relying on *Warhol* and emphasizing commercial nature of defendants' use of photo); Oracle Int'l Corp. v. Rimini St., Inc., No. 2:14-cv-01699, 2023 WL 4706127, at *75 (D. Nev. July 24, 2023) (applying *Warhol* to find defendant's copying of software was for the same, and commercial, purpose as plaintiff), *appeal filed* (9th Cir. July 27, 2023). But in a recent fair use case involving artificial intelligence and machine learning, the district court declined to "overread" *Warhol* and instead looked to the Court's decision in *Google*, which it said placed "much more weight on transformation than commercialism." Thomson Reuters Enter. Ctr. GmbH v. Ross Intel. Inc., No. 1:20-cv-613-SB, 2023 WL 6210901, at *7 (D. Del. Sept. 25, 2023); *see also* Apple Inc. v. Corellium, Inc., No. 21-12835, 2023 U.S. App. LEXIS 22252 (11th Cir. Aug. 23, 2023) (per curiam) (denying Apple's petition for rehearing and en banc review based on *Warhol*: "*Warhol* does not change our conclusion as to the first fair use factor that Corellium's product . . . was moderately transformative, and the opinion does not alter our balance of the four factors that they weigh in favor of fair use").

193. Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 583–85 (1994) (discussing Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417 (1984)).

194. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 534 n.9 (anticipating issuance of an injunction that would cover "similar commercial licensing" to the Condé Nast license).

195. *Id.* at 531–33.

196. *Id.* (citing Authors Guild v. Google Inc., 804 F.3d 202, 214 (2d Cir. 2015)).

of the Orbison song in *Campbell* had been justified because that song was a parody of Orbison's song (in which Acuff-Rose owned copyright),[197] which meant it was a critical comment on the original.[198] The Court was not persuaded that AWF had offered an adequate justification for its 2016 commercial license of the *Orange Prince* to Condé Nast.[199]

Fifth, *Warhol* agreed with OSG that fair use must be assessed on a use-by-use basis.[200] Under this conception, each commercial license AWF grants of a *Prince Series* work to a magazine, whether to illustrate a story about the musical artist or as a cover image, must be separately justified as a fair use, even if the 1984 Warhol works had been lawfully made. OSG's support for this proposition and analysis was remarkably thin.[201] The Court cryptically endorsed this proposition without citation to OSG's brief or discussion of the cases on which OSG relied.[202]

In OSG's view, AWF's copyrights in the *Prince Series* works, even assuming those works were lawfully made, were encumbered by the copyright in Goldsmith's photograph, at least for types of uses for which her photograph was a possible market substitute.[203] OSG's brief speculated that AWF might be entitled to grant other commercial licenses for uses of the *Orange Prince*, as long as those uses would not accompany stories about Prince. AWF might, for example, grant a magazine the right to use that image to illustrate Warhol's silkscreen techniques, as Goldsmith's photograph would be "ill-suited" for such a use.[204] Justice Gorsuch's concurring opinion

197. *Id.* (citing *Campbell*, 510 U.S. at 580–81); *id.* at 533 n.8 (discussing Google's justification for reimplementing interfaces to allow "different programs to speak to each other" and for programmers "to use their acquired skills" (quoting Google LLC v. Oracle Am., Inc., 593 U.S. 1, 31)); *see also* Facility Guidelines Inst., Inc. v. UpCodes, Inc., No. 4:22-cv-01308-AGF, 2023 WL 4026185, at *9 (E.D. Mo. June 15, 2023) (finding significant defendant's justification "to provide the public with free access to enacted law").

198. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 541–43 (discussing *Campbell*). Criticism and comment are two statutorily favored purposes in § 107. In process is a separate article to be entitled *Justifications for Fair Uses.*

199. *Id.*

200. OSG Brief, *supra* note 1, at 13–14. The *Warhol* opinion did not cite to the OSG brief on this point.

201. The only case law support OSG offered for the use-by-use approach were dicta from two prior Supreme Court decisions. It cited dicta from *Sony* to the effect that even if time-shift copying of television programs was fair use, selling copies of the time-shift copies to someone might not be. OSG Brief, *supra* note 1, at 19 (citing Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 446, 451 (1994)). It also cited dicta in *Campbell* in which the Court suggested that parodying a popular song for advertising purposes might present a different fair use question than 2 Live Crew's recording. *Id.* at 19 (citing *Campbell*, 510 U.S. at 585). The Court should have asked the parties to fully brief this issue.

202. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 533 (citing *Campbell*, 510 U.S. at 585, and *Sony Corp. of Am.*, 464 U.S. at 449–51). In a recent post-*Warhol* case involving a tattoo design based on plaintiff's photograph, the court granted cross-motions for reconsideration and, following *Warhol*, altered its first factor fair use analysis to focus on the purpose of the tattoo's use rather than its aesthetic character. In addition, the court looked at the tattoo creation and each social media post depicting the tattoo as separate uses. Sedlik v. Drachenberg, No. CV 21-1102, 2023 WL 6787447, at *3–4 (C.D. Cal. Oct. 10, 2023).

203. OSG Brief, *supra* note 1, at 16.

204. *Id.* at 33–34.

expressed a similar view.[205] The majority opinion suggested in a footnote that the purpose factor might be analyzed differently if AWF was using the images "solely for teaching purposes."[206]

B. SOME QUESTIONS ABOUT JUDGING FAIRNESS ON A USE-BY-USE BASIS

Before *Warhol*, many copyright professionals might have assumed that once a secondary use was declared fair use, that work could enjoy the full benefits of copyright, including the right to commercially license it. There is Second Circuit precedent supporting that conclusion.

In *Keeling v. Hars*, the plaintiff was a dramatist who created a parody play based on a movie, *Point Break*, and contracted with a theater company for two months of performances.[207] After consulting with a lawyer, Hars, the theater's owner, decided that she did not need Keeling's permission to perform the parodic play because the unauthorized use of the movie's expression meant that under 17 U.S.C. § 103(a), Keeling did not have a valid copyright in it.[208] Hars then proceeded to publicly perform this play for four years.[209] A jury found that Keeling had made fair use of material from the movie and that Hars had infringed Keeling's copyright.[210]

Hars appealed to the Second Circuit arguing that because fair use is an affirmative defense, not a positive right, Keeling did not own a valid copyright in her play.[211] The Second Circuit rejected Hars's argument and ruled in favor of Keeling. Because Keeling's creation of this parody was fair use and the play had sufficient originality to qualify for copyright, the court affirmed the ruling in Keeling's favor.[212] The Second Circuit did not say anything about Keeling's copyright being encumbered by the movie copyright; yet, the purpose of the movie and the play was arguably the same as popular entertainments, and both uses were commercial. The *Keeling* decision suggests that fair use works may not be as encumbered as OSG's amicus brief asserted.

OSG's innovative compromise, which requires a use-by-use assessment of fair uses, may have prevented one set of unfortunate consequences (that is, the nullification of AWF's copyrights). However, it opened up a new can of worms with which courts will have to grapple in coming years.

Consider how OSG's theory would affect secondary uses in other well-known fair use cases. Suppose 2 Live Crew wanted to perform the *Big Hairy Woman*, its rap parody

205. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 557–58 (Gorsuch, J., concurring) (suggesting that displaying the Warhol works in nonprofit museums and licensing them for use in a book about twentieth century art might be lawful because these uses would not compete with Goldsmith's photograph).

206. *Id.* at 534 n.10.

207. Keeling v. Hars, 809 F.3d 43, 45 (2d Cir. 2015).

208. *Id.*

209. *Id.*

210. *Id.* at 47.

211. *Id.* at 49.

212. *Id.* at 50–51, 54.

song, at a concert or to release a new version of it on a subsequent album. Would Acuff-Rose be able to sue Campbell for infringement and this time maybe win? The initial rap parody might have been fair use, but would every subsequent commercial use of the 2 Live Crew song be lawful?

Consider also the aftermath of the *SunTrust Bank v. Houghton Mifflin Co.* decision.[213] Alice Randall might want to authorize a motion picture version of *The Wind Done Gone* or a translation of her novel in German. Would she have to ask the Mitchell estate for permission?[214] What if the estate declined to give such permission? After the *Cariou v. Prince* ruling,[215] Richard Prince might want to sell posters of his reworkings of Cariou's photographs. Would Cariou now have a claim against Prince as to the works the Second Circuit found to be fair uses? Most copyright professionals might have assumed, until *Warhol*, that these tertiary uses would be lawful, but now we cannot be so sure.[216]

Although the Court characterized its ruling as a "narrow" one,[217] plaintiffs' lawyers will try to wring as much breadth out of the Court's dicta as they can,[218] and defense lawyers will look to limiting language wherever they can find it.[219] It will be years before we know definitively how broadly or narrowly lower courts will interpret *Warhol*.[220]

213. SunTrust Bank v. Houghton Mifflin Co., 268 F.3d 1257 (11th Cir. 2001) (vacating injunction to stay publication of Randall's book, a critical comment on GONE WITH THE WIND).

214. Randall reached a settlement with the Mitchell estate under which she retained the right to authorize a motion picture version of her novel. Barnini Chakraborty, *The Suit Done Settled*, CBS NEWS (May 10, 2002), https://www.cbsnews.com/news/the-suit-done-settled/ [https://perma.cc/3PSL-P2YY] [https://web.archive.org/web/20240126181023/https://www.cbsnews.com/news/the-suit-done-settled/].

215. Cariou v. Prince, 714 F.3d 694, 698–99 (2d Cir. 2013) (ruling that twenty-five of thirty artworks created by Prince were fair uses of Cariou's photographs).

216. *See, e.g.*, Mark A. Lemley & Rebecca Tushnet, *First Amendment Neglect in Supreme Court Intellectual Property Cases* (Jan. 11, 2024) (unpublished manuscript), https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4691950 [https://perma.cc/7LHK-UHJF] [https://web.archive.org/web/20240317002908/https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4691950] (criticizing the use-by-use fair use theory adopted in *Warhol*).

217. *See* Andy Warhol Found. for the Visual Arts, Inc., 598 U.S. 508, 534 n.9.

218. Some scholars will do so as well. *See, e.g.*, Shyamkrishna Balganesh & Peter S. Menell, *Going "Beyond" Mere Transformation:* Warhol *and Reconciliation of the Derivative Work Right and Fair Use*, 47 COLUM. J. L. & ARTS 411 (2024).

219. A number of scholars consider the *Warhol* ruling to be quite narrow. *See, e.g.*, Michael W. Carroll & Peter Jaszi, *The Triumph of Three Big Ideas in Fair Use Jurisprudence*, 99 TUL. L. REV. (forthcoming 2024); Ochoa, *supra* note 10; *see also* Karen Shatzkin & Dale Cohen, *PICTURE THIS: Applying the Fair Use Doctrine To Documentary Films After* Google/Oracle *and* Warhol, 30 UCLA ENT. L. REV. 1 (2023) (predicting documentary filmmakers' reliance on fair use should typically satisfy fair use); Michael D. Murray, *Copyright Transformative Fair Use After* Andy Warhol Foundation v. Goldsmith, 24 WAKE FOREST J. BUS. & INTELL. PROP. L. 21 (2024) (characterizing *Warhol* as a narrow clarification of transformative fair uses).

220. The *Warhol* decision has been criticized by numerous commentators. *See, e.g.*, Lemley & Tushnet, *supra* note 216 (describing growing tension between recent IP cases like *Warhol* and the First Amendment); Ochoa, *supra* note 10 (critiquing *Warhol*'s legal reasoning while not necessarily disagreeing with the outcome); Caroline Osborne & Stephen Wolfson, Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith, *A Narrow Ruling or a Transformational Decision? An Essay*, 84 OHIO ST. L.J. ONLINE 1 (2023) (criticizing *Warhol*'s fair use analysis for conflating factors one and four and favoring copyright owners). As for artistic community responses, see, e.g., Adler, *supra* note 180 (stating that *Warhol* destabilizes accepted art

C. WHAT IS THE STATUS OF AWF'S COPYRIGHTS ON REMAND?

The Supreme Court majority understood Goldsmith to have abandoned her claim that Warhol's creation of the *Prince Series* infringed her photograph copyright.[221] Insofar as this is an accurate representation of Goldsmith's refined position, the Second Circuit should recognize that its analysis of the 1984 creation issue was erroneous and should be rescinded. It should also recognize that the Court did not find much of that analysis persuasive.[222] The Second Circuit should ask AWF and Goldsmith to file a new round of briefs to advise it about how to refine its analysis to conform it to the Court's opinion on the considerably narrower issue concerning the 2016 license.[223] Otherwise, the Second Circuit should remand the case to the trial court so that it can hold a hearing and receive briefing about how the Court's ruling affects AWF's copyrights and what issues remain for the trial court to resolve.

If Goldsmith has truly abandoned her claim that the 1984 creation of the *Prince Series* was unlawful, the court should rule that AWF's copyrights are valid. Goldsmith's abandonment of her larger claims would seem to mean that she no longer opposes AWF's motion for summary judgment on the fairness of the initial creation of the *Prince Series*.[224]

Perhaps Goldsmith will make a new motion for summary judgment focused only on the 2016 license. This would give the parties an opportunity to brief whether that license was an infringement or whether AWF has other defenses as to that license.[225]

and legal norms and also degrades Andy Warhol as an artist); Meyer, *supra* note 180 (explaining how the Court misapprehends Warhol's art). *But see* Xiyin Tang, *Art After* Warhol, 71 UCLA L. REV. (forthcoming 2024) (presenting empirical study based on interviews describing extralegal artist community norms and practices using others' art).

221. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 534 n.9.

222. Notably, the Court did not endorse the multitude of the Second Circuit's similarity metrics. *See* Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 42–43, 47 (2d Cir. 2021) (stating, for example, that the *Prince Series* was "recognizably" similar to the photograph, the *Prince Series* retains "the essence" of the photograph, and the photograph is the "foundation" upon which the series was based). It also did not endorse the "overarching purpose and function" language in the Second Circuit's opinion. *Id.* at 42; *see* Authors Alliance Brief, *supra* note 191, at 22–31 (No. 21-869) (critical of Second Circuit's analysis of the fair use issue in *Warhol*).

223. As this Article was going to press, the *Warhol* litigants agreed on a settlement, with AWF paying Goldsmith $10,250 with respect to its 2016 Condé Nast license plus approximately $11,000 in taxable costs, and Goldsmith acknowledging that the statute of limitations barred any claims as to the creation of the *Prince Series*. Final Judgment, Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, No. 17-cv-02532-JGK (S.D.N.Y. Mar. 18, 2024).

224. AWF SJ Memo, *supra* note 35.

225. Professor Karol has persuasively argued that AWF's grant of the 2016 license did not constitute a direct infringement of any of Goldsmith's exclusive rights. Karol, *supra* note 3, at 19–25. The record does not indicate that AWF made or distributed a copy of the *Orange Prince* for the cover of the special issue. *Id.* at 4, 39. None of the court decisions in the *Warhol* case speak of AWF's infringement except as to the commercial license. As Karol explains, § 106 does make authorizing infringement as a basis for liability, but courts have understood that as supporting imposition of indirect liability not direct liability for infringement. *Id.* at 25–26. If AWF did not make or distribute copies of the *Orange Prince* but only licensed Condé Nast to use that print for the cover of the magazine, it was not a direct infringer of Goldsmith's copyright. Goldsmith would

In due time, assuming the trial court decides infringement did occur, it could issue a narrow injunction giving Goldsmith an entitlement to credit and to share in any further commercial exploitations of the *Prince Series* that might compete with her photograph, as the Court suggested.[226]

It remains to be seen whether on remand, Goldsmith will try to walk back from her statements in her merits brief to the Court and during oral argument that persuaded the Court that she had abandoned her larger claims.[227] Her merits brief suggested that all sixteen works may have been created under the license,[228] but she did not actually admit that they were. Her merits brief also mentioned the three-year statute of limitations, but she did not directly say that her claims based on the 1984 creation were time-barred.[229] She may want to claim that the only thing she had waived was her entitlement to request certain remedies. Yet because of § 103(a), she would not need an injunction if it ruled that the Warhol works were infringing derivative works because AWF's loss of copyright would happen automatically. Moreover, Goldsmith's merits brief challenged AWF's interpretation of the derivative work right at some length, which suggests that this claim was still live in her judgment, notwithstanding some statements suggesting otherwise.[230] On remand, courts should regard with skepticism any effort to walk back on the statements Goldsmith made to the Court that led the Justices to believe she had given up her larger claims.

V. WHAT SHOULD THE COURT HAVE DONE IN *WARHOL*?

The Supreme Court took the *Warhol* case to review two lower courts' rulings on the transformativeness (or not) of the 1984 creations of the *Prince Series*. That was the main issue about which AWF and Goldsmith had been in heated disagreement since 2017.[231] After reflecting on OSG's amicus brief and Goldsmith's apparently revised position, a majority of the Court changed their minds about what issue was pending before them.

At that point, they had three options: One was to dismiss the writ of certiorari for having been improvidently granted because Goldsmith had abandoned her argument about the issue on which they granted certiorari.[232] Second, the Justices could have

need to reframe its claim against AWF charging it with contributory infringement. This claim would require proof that Condé Nast was a direct infringer and that AWF knowingly made a material contribution to that infringement. AWF's state of ignorance about the risk of infringement when issuing the 2016 license might provide it with a defense to a contributory infringement claim.

226. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 534 n.9.

227. Estoppel and waiver principles may be available to preclude Goldsmith from walking back her earlier statements. *See* NIMMER & NIMMER, *supra* note 125, §§ 12.07, 13.07 (discussing the applicability of various types of estoppel doctrine in copyright litigation).

228. Goldsmith Merits Brief, *supra* note 90, at 37.

229. *Id.* at 18.

230. *Id.* at 37, 47–50 (extensively discussing derivative work rights).

231. *See* AWF Complaint, *supra* note 26; Amended Answer and Counterclaim, *supra* note 28; Cert Petition, *supra* note 76; Brief for Petitioner, *supra* note 86; Goldsmith Opposition Brief, *supra* note 87.

232. *See* SHAPIRO ET AL., *supra* note 156, at § 6.25; *see also* Unicolors, Inc. v. H&M Hennes & Mauritz, L.P., 595 U.S. 178, 189 (2022) (Thomas, J., dissenting) (advocating dismissing the writ of certiorari as

decided to rehear the case after receiving a new round of briefs focused on the much narrower fair use issue about the 2016 license.[233] This would have been a sensible option, given that none of the parties, nor the amici, had fully briefed that issue. Third, the Justices could go ahead and decide the narrower issue based on the record before them.

While I am unpersuaded by the Court's analysis of the fair use issues in *Warhol*, Section A explains how the Court might have ruled in Goldsmith's favor on the 2016 license, while agreeing with AWF about the transformativeness of the 1984 creations. Section B explains why I think the Court should have ruled in AWF's favor because Warhol created the *Prince Series* under an artist reference arrangement. Both sections are written as though they are opinions of the Court.

A. AN ALTERNATIVE RATIONALE FOR RULING IN FAVOR OF GOLDSMITH

Insofar as the Second Circuit ruled that Andy Warhol made non-transformative uses of Lynn Goldsmith's photograph of Prince when creating the *Prince Series* in 1984, we vacate its ruling and remand for further proceedings consistent with our ruling today. We agree with AWF that Warhol's *Prince Series* conveys a different meaning and message than Goldsmith's photograph. Hence, we conclude that Warhol's purpose and use of that photograph was, consistent with our prior fair use rulings, transformative. Transformativeness is, however, always a matter of degree and must be considered in relation to the other fair use factors. We agree with the Second Circuit that the trial court gave too much weight to the transformative character of the *Prince Series*. Furthermore, we disagree with AWF's contention that the transformative nature of Warhol's use of the photograph in 1984 is dispositive of the fair use issue as to the 2016 license.

Warhol's initial creation of the *Prince Series* may have been lawful because, as Goldsmith's merits brief conjectured, Warhol created the *Prince Series* under an agreement with *Vanity Fair* that had obtained an artist reference license from Goldsmith's agent or alternatively, because they were fair uses, as OSG's brief suggested. We surmise that Warhol likely created the sixteen works so that *Vanity Fair* would have some choices about which image would best illustrate the story it was planning to publish about Prince's rise to fame. In our view, this means that AWF owns valid copyrights in the *Prince Series*.[234] It also means that the originals of those works

improvidently granted because Unicolors relied on a different argument in its merits briefing). Professor Karol suggests the Court should have dismissed the *Warhol* cert as improvidently granted since commercial licensing, as such, does not infringe any exclusive right of copyright law. Karol, *supra* note 3, at 29.

233. The Court has sometimes asked the litigants to undertake a new round of briefing and rescheduled oral argument, as it did in *Sony*. Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 421 (1984).

234. Upon closely reading Goldsmith's merits brief, we are unconvinced that she has fully abandoned her claims as to the 1984 creation of the *Prince Series*. Hence, we address the transformativeness of Warhol's creation of the works, as AWF requested, and conclude that Warhol had a transformative purpose when creating the *Prince Series*.

now in the hands of museums, galleries, and collectors were "lawfully made" under U.S. copyright law. Hence, those originals are entitled to the benefits of the first sale limitations on copyright's exclusive distribution and display rights as embodied in § 109 (a) and (c).

Yet, the lawfulness of the original creation of the *Prince Series* does not mean that there is no merit in Goldsmith's copyright claim based on the 2016 license. The owner of copyright in a lawfully created derivative work may be constrained in its exploitation of a derivative when the work on which it was based is still in copyright.[235] In most cases, the scope of authorization to exploit a derivative work will depend on the contract between the copyright owner of the first work and the creator of the authorized derivative. In *Warhol*, no contract existed between Goldsmith or her agent and Warhol so we cannot use that mechanism to decide to what extent Warhol or AWF was authorized to exploit the *Prince Series*. We must decide the case instead based on default rules of copyright law.

The copyright in a lawfully created derivative work gives its author exclusive rights only in the original expression it contributed to the derivative work.[236] That author acquires no rights in expression from the underlying work(s) on which the derivatives were based unless a contract confers such rights. Insofar as the Second Circuit ruled that expressive elements in Goldsmith's photograph are embodied in the *Orange Prince*, AWF's exploitation of that image is subject to (and therefore partly encumbered by) the copyright in Goldsmith's photograph.[237]

We believe that encumbrance is quite limited. AWF should be free to license the *Prince Series* works for uses that do not compete in the marketplace with Goldsmith's photograph. For example, AWF would be free to grant a license to the author of a book about Warhol's print-making techniques. However, if it wants to license one of Warhol's images of Prince to a magazine such as those owned by Condé Nast to illustrate stories about the musician, it should have to share licensing revenues with Goldsmith. In 2016 AWF may not have known of Goldsmith's existence, but its ownership of copyright in the *Prince Series* was nonetheless encumbered by her copyright in the photograph on which the *Orange Prince* was based. Hence, Goldsmith is entitled to some compensation for AWF's 2016 license to Condé Nast and to an injunction requiring AWF to share revenues with Goldsmith for any future licensing

235. *See, e.g.*, Schrock v. Learning Curve Int'l, Inc., 586 F.3d 513, 524 (7th Cir. 2009) (explaining that "because the owner of a copyrighted work has the exclusive right to control the preparation of derivative works, the owner could limit the derivative-work author's intellectual-property rights in the contract, license, or agreement that authorized the production of the derivative work").

236. 17 U.S.C. § 103(b).

237. *See* Ochoa, *supra* note 10 (agreeing that the Court reached a "just and defensible" outcome, but criticizing it for going further than was necessary, "leaving the fair use doctrine unmoored in stormy seas and even more susceptible to the whims and caprice of individual judges").

of the Warhol *Prince Series* works that compete in the same market as Goldsmith's photograph.[238]

B. HOW THE COURT COULD HAVE RULED IN AWF'S FAVOR

Insofar as the Second Circuit ruled that Andy Warhol made non-transformative uses of Lynn Goldsmith's photograph of Prince when creating the *Prince Series* in 1984, we vacate its ruling and remand for further proceedings consistent with our ruling today. We agree with AWF that Warhol's *Prince Series* conveys a different meaning and message than Goldsmith's photograph. Hence, we conclude that Warhol's purpose and use of that photograph was, consistent with our prior fair use rulings, transformative. Transformativeness is always a matter of degree and must be considered in relation to the other fair use factors. We agree with the Second Circuit that the trial court gave too much weight to the transformative nature of the *Prince Series*.

The most plausible basis for ruling that Warhol's initial creation of the *Prince Series* was lawful was, as Goldsmith's merits brief conjectured, that Warhol created the *Prince Series* under an agreement with *Vanity Fair* who had obtained an artist reference license from Goldsmith's agent. We surmise Warhol likely made the sixteen works so that the magazine would have some choices about which image would best illustrate the story it was planning to publish about Prince's rise to fame. In our view, this means that AWF owns valid copyrights in the Warhol works in that series and that originals of those works now in the hands of museums, galleries, and collectors were "lawfully made" under U.S. copyright and hence entitled to the benefits of the first sale limitations on copyright's exclusive distribution and display rights as embodied in § 109 (a) and (c).

Because no contractual relationship existed between Goldsmith or her agent and Warhol or AWF, we cannot look to contractual language to decide the scope of authorization Warhol or AWF had to exploit the *Prince Series*. We think that both the trial court and the Second Circuit gave insufficient attention to Warhol's receipt of the Goldsmith photograph from *Vanity Fair*, a photograph that Goldsmith's agent had licensed the magazine to use as an artist reference. *Vanity Fair* commissioned Warhol to make one or more transformative works of art so the magazine could use it to illustrate the story about Prince's rise to fame. It was reasonable for Warhol to believe that the works he created were fully his to own and to exploit, as works created pursuant to artist reference arrangements generally are.[239] *Vanity Fair* might have been bound by the license restrictions to which it agreed, but Warhol was not a party to that license and could therefore not be bound by it.

238. Professor Ochoa would have wanted the court to also consider whether Goldsmith is entitled to an injunction requiring AWF to give credit to Goldsmith whenever AWF licenses use of a work in the *Prince Series*. *Id.*

239. *See* Silbey & Subotnik, *supra* note 12 (discussing artist references).

It is a fundamental principle of contract law that contracts bind only the parties who enter into them.[240] As Professor Mark Gergen has observed, privity rules "that prevent a contract from protruding negatively upon a nonparty serve a partitioning function. Because of these rules, when an actor engages in a transaction that is part of a chain or web of contracts, she need not worry about a contract to which she is not a party subjecting her to a contractual obligation."[241] Gergen goes on to explain:

> A pair of rules in contract law limit the legal effect of a contract to the parties to the contract. The first rule is that a contract cannot bind a nonparty or "destroy rights of a nonparty." There is no exception to this rule in contract law: other bodies of law must be used to get around it. Property law makes it possible to use a covenant to bind a nonparty. A nonparty may also be liable for tortious interference with contract. And a nonparty may be required to respect a contractual restriction on the use of property by the doctrine of equitable notice.
>
> The second rule is that a nonparty acquires no rights under a contract. Modern contract law does make exceptions to this rule though the common law took some time to come around to this position. Modern contract law allows parties to a contract to bestow a contract right on a nonparty by assignment or as a third-party beneficiary.[242]

Under the privity doctrine, Warhol cannot be bound by any contract restriction to which *Vanity Fair* agreed insofar as he was not a party to the contract with Goldsmith's agent.

Under some circumstances, courts have held that a third party can be bound by restrictions agreed to by contracting parties when that outsider knew about restrictions that limited uses of a resource and the outsider obtained the resource with knowledge of the restrictions.[243] But there is no evidence that Warhol, let alone AWF, knew of any restriction upon his use of the photograph that would implicate his rights in the works he created for *Vanity Fair*.

What Warhol knew was that he was given the Goldsmith photo as an artist reference and that he was commissioned to create art for *Vanity Fair*. (That AWF now knows of the restriction is irrelevant. For the restriction to bind based on notice, Warhol must have had notice of the restriction at the time he created the prints.[244])

240. The rest of this subsection incorporates excerpts from a blog post discussing OSG's reframing of the question presented in *Warhol*. *See* Pamela Samuelson & Mark P. Gergen, *What's Wrong and What's Missing in the SG's Amicus Brief in* Andy Warhol Foundation v. Goldsmith*?*, VOLOKH CONSPIRACY (Sept. 6, 2022), https://reason.com/volokh/2022/09/06/whats-wrong-and-whats-missing-in-the-sgs-amicus-brief-in-andy-warhol-foundation-v-goldsmith/ [https://perma.cc/7YP9-VKZY] [https://web.archive.org/web/20240126234511/https://reason.com/volokh/2022/09/06/whats-wrong-and-whats-missing-in-the-sgs-amicus-brief-in-andy-warhol-foundation-v-goldsmith/].

241. Mark P. Gergen, *Privity*, *in* THE OXFORD HANDBOOK OF THE NEW PRIVATE LAW 481 (Gold et al. eds., 2021).

242. *Id.* at 482 (citations omitted).

243. *See id.* at 485; *see also* Mark P. Gergen, *Privity's Shadow: Exculpatory Terms in Extended Forms of Private Ordering*, 43 FLA. ST. U. L. REV. 1, 48–55 (2015) (discussing doctrine of equitable notice).

244. *See* Gergen, *supra* note 241, at 490 & n.28.

Had Warhol agreed with *Vanity Fair* not to commercialize the *Prince Series* works without getting permission from Goldsmith's agent, that would have bound him. The issue would then be whether Goldsmith was a third-party beneficiary to this agreement. But there is no evidence of such an agreement.

OSG's brief did not delve into the significance of the license as it affects the Warhol copyrights. Like the Second Circuit, OSG seemed to think that AWF could make some uses of the *Prince Series*, maybe even commercial ones, as long as they do not interfere with Goldsmith's markets. But it will be very difficult for courts to decide which kinds of commercialization of the Warhol works are off limits and which are not.

This is the first case of which we are aware in which copyrights are thought to exist but are encumbered as to some uses, despite the absence of an agreement to restrict an artist's uses of his copyrighted work. OSG and Goldsmith proposed a narrow encumbrance, but we think that this theory of the *Warhol* case is legally unsound.

In any case, Warhol did not lose his right to make fair uses of the Goldsmith photograph by virtue of a license restriction to which he had not agreed and of which, so far as we know, he was unaware. Moreover, nothing in the lower court decisions suggests that when the AWF licensed the Warhol print to Condé Nast, it knew that Goldsmith or her photograph existed.[245] It was reasonable, therefore, for AWF to license Condé Nast to use the *Orange Prince* without the encumbrance of Goldsmith's copyright.

VI. CONCLUDING THOUGHTS

No one can know how the Court would have resolved the *Warhol* dispute if OSG had decided not to file an amicus brief that reframed the case from one about the legality of Warhol's initial creation of the *Prince Series* works to one about the grant of a single commercial license in 2016. Perhaps OSG should not have filed an amicus curiae brief in *Warhol* given that there was no meaningful federal interest at stake in that case.[246] It seems unfair to the litigant OSG disfavors for the government to put its weighty thumb

245. Tyler Ochoa has disagreed with this contractual-based interpretation of the *Warhol* case, arguing that *Vanity Fair* could not give Warhol a broader license than it had gotten from Goldsmith's agent. Written comments from Professor Tyler Ochoa to Pamela Samuelson (Dec. 12, 2023) (on file with author). But perhaps the lack of notice and the expectation that an artist reference did clear rights may be relevant to AWF's fair use defense.

246. *See, e.g.*, Solimine, *supra* note 6, at 1205–07. Had the U.S. government had a direct and meaningful interest in the resolution of private litigant disputes about the interpretation of copyright's fair use doctrine, OSG would likely have filed amicus curiae briefs in *Sony v. Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984); *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539 (1985); and *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994). Yet it filed amicus briefs in none of them. In the 1980s and 1990s, OSG filed amicus briefs in only two of the Court's twelve copyright cases. Both directly implicated federal agency operations or U.S. foreign policy. *See* Quality King Distribs., Inc. v. L'Anza Rsch. Int'l, Inc., 523 U.S. 135 (1998) (involving United States foreign policy and border control interests); Cmty. for Creative Non-Violence v. Reid, 490 U.S. 730 (1989) (interpreting copyright's work for hire rule which implicated the Copyright Office's registration practices). The Court rejected OSG's arguments in both cases. *See Quality King Distribs., Inc.*, 523 U.S. at 151–52, 153–54; *Cmty. for Creative Non-Violence*, 490 U.S. at 742 n.8.

on the scale in the absence of a meaningful federal interest in the outcome.[247] OSG's reframing of the question presented caught the petitioner and its amici off-guard because they had focused their briefs on the question on which the Court granted certiorari: whether Warhol's 1984 creation of the *Prince Series* was transformative. OSG did not articulate a persuasive rationale for its conclusion that creation of the original Warhol series was not at issue when that was precisely the issue about which the parties had been litigating for six years. OSG interpreted the trial and appellate courts holdings to comport with its reframing of the issue in litigation. It also introduced a major new doctrine to the law of fair use—that each use of a secondary work based in part on a first author's work must be justified—an issue and doctrine that had not been raised below and about which neither AWF nor its amici, let alone Goldsmith's amici, had a meaningful opportunity to respond. This seems unfair.

Yet, the compromise achieved by the Court's adoption of OSG's narrowing of the question presented had some benefits. AWF's copyrights in the *Prince Series* works now seem secure; Goldsmith has the satisfaction of winning some compensation from AWF for licensing the *Orange Prince* to Condé Nast, although not the windfall she initially sought; and a majority of the Court has somewhat clarified its interpretation of transformative purposes in fair use cases, even if the boundary line between transformative fair uses and infringing derivative works is no clearer than before the Court took the *Warhol* case.

It remains to be seen how much influence the *Warhol* decision will have in subsequent fair use cases. The Court characterized its holding in *Warhol* as "narrow."[248] In light of OSG's last-minute reframing of the question presented and the lack of full briefing of the reframed question, perhaps we should take the Court at its word and not read too much into the dicta that hints at a broad curtailment of the fair use doctrine.

247. *See e.g.*, Solimine, *supra* note 6, at 1188; Covert & Wang, *supra* note 1, at 684; Lincoln Caplan, Response, *The SG's Indefensible Advantage: A Comment on* The Loudest Voice at the Supreme Court, 74 VAND. L. REV. EN BANC 97 (2021) (raising fairness issues posed by OSG's dominance in the Supreme Court).

248. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 598 U.S. 508, 514–16 (2023); *see also id.* at 552–53 (Gorsuch, J., concurring).