Chicago-Kent Journal of Intellectual Property

Volume 23 | Issue 1 Article 10

12-20-2023

Some Thoughts on Warhol and the Future of Transformative Works

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A version of the following remarks was delivered during a panel discussion on Andy Warhol Foundation v. Goldsmith *at Chicago-Kent's 2023 Supreme Court Intellectual Property Review*

SOME THOUGHTS ON *WARHOL* AND THE FUTURE OF TRANSFORMATIVE WORKS

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Transformative use being fair use survives the Court's decision in *Warhol v. Goldsmith*. It also doesn't – it depends what we mean when we say transformative use. The Supreme Court opted for a narrow reading of *Campbell v. Acuff-Rose Music, Inc*., one which treats it as a decision bounded by its facts and context, and while not limited to parody, certainly focused on criticism or comment as found in Section 107 of the Copyright Law. Following *Warhol*, transformative use remains, but in the narrower definition where Campbell's query into whether something "adds something new . . . altering the first with new expression, meaning, or message" is cabined by reference to commercial impact of the new work on the existing work.[1]

This does indicate something of a shift from the court's decision in 2021 in *Google v. Oracle*, where the Court found that "reimplementing an interface can further the development of computer programs," made Google's copying elements of the Java SE programming language for Android mobile

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

phones transformative.[2] A blistering dissent by Justice Thomas argued this this "eviscerates copyright," and it certainly did seem to expand the meaning of transformative use.[3] The court acknowledged that *Campbell* was focused on parody, but equally noted that "[a]n 'artistic painting' might, for example, fall within the scope of fair use even though it precisely replicates a copyrighted" work.[4] The Court there likewise held that it "was not necessarily true" that commercial purpose "tips the scales" against a finding of fair use so long as the use was commercial.

In some ways, the Supreme Court's holding in *Warhol v. Goldsmith* is thus a response to its holding in *Google v. Oracle*, making clear that decision should not be read as expansively as some (including perhaps Justice Kagan) might think. This is not entirely different from how the Second Circuit's decision below in *Warhol v. Goldsmith* was a response pushing back against their earlier decision in *Cariou v. Prince*, which held that modification of photos of Rastafarians in Jamaica by appropriation artist Richard Prince was transformative and a fair use in some cases.[5] Following the Warhol decision, *Google v. Oracle* seems much more of a computer copyright decision than a general statement on fair use.

Accordingly, the *Warhol* decision is perhaps best read as an attempt by the Court to restore fair use to its statutory boundaries. This is necessarily related to a similar attempt to center the statute vis a vis the exclusive right to creative derivative works, which is defined as any "form in which a work may be recast, transformed, or adapted."[6] Any attempt to define fair use in relation to transformation but reckon with the inclusion of transformation as being an exclusive right of the copyright holder, and the court's opinion is simply the latest statement in a line of cases going back centuries. To understand that this statutory scheme is a result of deliberate choices resulting from a lengthy doctrinal evolution, it's worth tracing that evolution.

TRANSFORMING FAIR ABRIDGMENT

The debate over how to define transformative use – and more generally the place of a multifactor test versus a general inquiry into purpose – is of long vintage. Starting in the 1700s, English courts found that an abridgement was not infringing if it was a "fair abridgement." This doctrine descended from an English case where the court had drawn a distinction between "true abridgements" which were "fairly made" and "coloured shortenings."[7] The

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

3. *Id.* at 1219 (Thomas, J., dissenting).

4. *Id.* at 1203

5. Cariou v. Prince, 17 F.3d 694 (2013). However, the Second Circuit was quick to note in its opinion below in this case that not all of Richard Prince's works were fair uses in that case.

6. 17 U.S.C. §§ 101, 106.

7. Gyles v Wilcox (1740) 26 ER 489; GEORGE TICKNOR CURTIS, A TREATISE ON THE LAW OF COPYRIGHT 265 (1847).

rule from that case was that a fair abridgement was one that showed unique work and genius, while an infringing work would be a shortening of a work without substantial labor, presumably to take advantage of the original author's work.

One of the first American cases to consider the issue of abridgments and adaptations was *Folsom v. Marsh*, where Justice Story, riding Circuit in Massachusetts in 1841, was faced with a case regarding the copyright in President Washington's papers.[8] Following President Washington's death, his nephew Justice Bushrod Washington worked with Chief Justice John Marshall to identify the historian Jared Sparks as the proper editor for the papers, leading to publication of the twelve-volume *The Writings of George Washington* in 1837-1838.[9] In 1840, the Rev. Charles W. Upham adapted Sparks's work into a two-volume work aimed at students wherein President Washington told the story of his life in his own words called *The Life of Washington*, accompanied by text by Upham.[10] In all, over a third of Upham's work was taken from Sparks's 12 volumes, all of it originally by Washington.[11]

Sparks's publisher Charles Folsom sued Upham, his publisher Bela Marsh, and others, arguing that *The Life of Washington* infringed the copyright in the 12-volume work. Finding that over 300 pages of Upham's works, consisting entirely of letters by Washington, were copied from Sparks's work, the question before the court was thus whether the work was infringing. The Court considered but rejected claims that the letters were public domain, leaving only the core question of infringement.[12] The difficulty for Justice Story was that the "defendants' work cannot properly be treated as an abridgment of that of the plaintiffs," and thus a new doctrinal approach was needed beyond fair abridgment.[13] Justice Story thus brought forth a new doctrine, albeit one with a substantial doctrinal continuity with its predecessor doctrine – fair use.[14]

The factors provided by Justice Story are familiar to anyone who has read Section 107 of the current copyright law.[15] The fair use inquiry Story provided looks to the

> [1] nature and objects of the selections made,
> [2] the quantity and value of the materials used, and

8. Folsom v. Marsh, 9. F.Cas. 342 (C.C.D. Mass. 1841).
9. *Id.* at 344.
10. *Id.*
11. *Id.* at 348.
12. *Id.* at 345.
13. *Folsom*, 9 F. Cas. At 347.
14. Matthew Sag, *The Pre-History of Fair Use*, 76 BROOK. L. REV. 1371 (2011).
15. *Folsom*, 9 F. Cas. At 348.

> [3] the degree in which the use may prejudice the sale, or diminish the profits, or supersede the objects, of the original work.[16]

Applying these factors, Justice Story found that the taking of 300 pages of letters was too much of an appropriation to constitute fair use, focused specifically on the market effects of Upham's work.[17] Interestingly, Justice Story indicated that if it had been an abridgement, the doctrine of fair abridgment might apply.

The law at the time allowed essentially any transformation or other derivative work, including abridgments, contrary to the law today.[18] The doctrine from the fair abridgment rule was really one that straight copying of a work was not permitted but independent abridgment was permitted.[19] This idea that authors did not possess an exclusive right to create derivative works was subject to criticism in the first American treatise on copyright, by George Ticknor Curtis in 1847, who found it "apparent that no writer can make and publish an abridgment, without taking to himself profits of literary matter which belong to another."[20] In his treatise Curtis also commented that the fair use of a previous publication was a recognized doctrine, implicitly something different from the fair abridgement doctrine he criticized, but that there were not (yet) good examples of the doctrine being positively applied. [21]Curtis likewise argued for an exclusive right of translation, asserting that

> [t]he property of the original author embraces something more than the words in which his sentiments are conveyed. It includes the ideas and sentiments themselves, the plan of the work, and the mode of treating and exhibiting the subject. In such cases, his right may be invaded, in whatever form his own property may be reproduced. The new language in which his composition is clothed by translation affords only a different medium of communicating that in which he has an exclusive property; and to attribute to such a new medium the effect of entire originality, is to declare that a change of dress alone annihilates the most important subject of his right of property.[22]

This describes modern copyright law, which protects derivative works.

However, the courts were not yet ready to accept this, as was dramatically shown a few years later, when the Circuit Court in Philadelphia was called upon to adjudicate whether an unauthorized translation of the literary blockbuster *Uncle Tom's Cabin* infringed the author's copyright.[23] Harriet Beecher Stowe had secured a German translator for her novel and

16. *Id*.
17. *Id.* at 349.
18. *Id.* at 344.
19. *Id.* at 345.
20. CURTIS, *supra* note 7, at 276.
21. *Id.* at 241.
22. *Id.* at 292-293.
23. Stowe v. Thomas, 23 F. Cas. 201 (C.C.E.D. PA. 1853).

collaborated with him to produce a superior authorized translation.[24] However, the Philadelphia German newspaper *Die Freie Presse* prepared its own translation and published it serially, leading Stowe to sue for infringement.[25] The Court took a view of copyright which deliberately denied any derivative rights in Stowe's work, holding that she held only the "exclusive right to print, reprint and vend it."[26] The Court concluded that "[a] translation may, in loose phraseology, be called a transcript or copy of her thoughts or conceptions, but in no correct sense can it be called a copy of her book."[27]

TRANSFORMING DERIVATIVE WORKS

As such, in the mid-19th century, copyright law had not yet developed an exclusive right to derivative works, although it was beginning to be considered. The academic view was that derivative rights existed in works, but Courts were not willing to accept this absent a statute which made such rights clear. Fair use was beginning to be discussed, but what it meant was as yet unclear. It would be another few decades until the next major fair use case of *Lawrence v. Dana*, which would clarify and give some new scope to the doctrine, and a major revision of copyright law shortly thereafter would begin to establish derivative rights in creative works.[28]

In that case in 1869, involving an annotated edition of Henry Wheaton's treatise on international law (the same Wheaton from *Wheaton v. Peters*), the court recognized "fair use" as a defense, but held it was inapplicable, because the alleged infringing work "occupies the same field and was designed for the same class of readers, and was 'made and composed' for the same general purpose" as the original work.[29] The case was partly argued by George Ticknor Curtis's brother (and Supreme Court Justice) B.R. Curtis, and the court noted G.T. Curtis's critique of the fair abridgment doctrine, but held it was still good law before holding that the infringing annotated edition was not a fair abridgement but instead "precisely what it purports to be, a reprint of the text of the author, with notes by a new editor."[30] Put another way, "fair use" and "fair abridgment" were clearly understood as two separate doctrines.[31]

The next year Congress finally provided for a form of protection for authors against unauthorized derivative works. An earlier law from 1856 had established exclusive public performance rights for authors of plays, and the 1870 Copyright Act extended that to provide that "authors may reserve

24. *Id.*
25. *Id.*
26. *Id.* at 208.
27. *Id.*
28. 15 F. Cas. 26 (C.C.D. Mass. 1869).
29. *Id.* at 58.
30. *Id.* at 59.
31. *Id.*

the right to dramatize or to translate their own works."[32] The Librarian of Congress would in turn promulgate regulations clarifying that authors could reserve these rights by "printing the words 'Right of translation reserved.' or 'All rights reserved.' below the notice of copyright entry, and notifying the Librarian of Congress of such reservation, to be entered upon the record."[33] The requirement to reserve these rights was formally eliminated in 1891.[34]

The 1870 Act did not mention abridgements, but in the next major treatise on copyright in 1879, Eaton S. Drone asserted that "in the United States, an author . . . has the exclusive right, without special reservation, to abridge it."[35] Drone's argument at some length against a right of fair abridgment seems to have been convincing – or at least captured the development of feelings about the doctrine as copyright law evolved towards a more modern form. No further reported cases of the fair abridgement defense being argued in the United States are found in reported cases from then on.

TRANSFORMING FAIR USE

It had long been understood that the 1870 Copyright Act, a modestly updated version of the 1790 and 1831 Acts, was insufficient as America entered into a new era. In 1909 Congress passed a new copyright law which modernized copyright administration, but it left a great deal undefined.[36] There was no longer an attempt to define which works were protected by copyright; copyright now extended to "all the writings of an author."[37] The term fair use does not appear at all, an intentional choice to leave the doctrine to the courts.[38] Meanwhile, language at once technical and broad defined the scope of what we now call derivative works by stating that a copyright owner held the

> exclusive right . . . [t]o translate the copyrighted work into other languages or dialects, or make any other version thereof, if it be a literary work; to dramatize it if it be a nondramatic work; to convert it into a novel or other nondramatic work if it be a drama; to arrange or adapt it if it be a musical work; to complete, execute, and finish it if it be a model or design for a work of art.[39]

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32. U.S. Copyright Act 1870, 16 Stat. 198, 212 (1870).

33. Librarian of Congress, Directions for Securing Copyrights, DIRECTIONS FOR REGISTERING COPYRIGHTS – COLLECTED – 1866-1956 (1874), *available at* https://archive.org/details/1905DirectionsForRegisteringCopyrights6thEd/.

34. International Copyright Act of March 3, 1891, Pub. L. 51-565, 26 Stat. 1106 (1891).

35. EATON S. DRONE, A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS IN GREAT BRITAIN AND THE UNITED STATES 334 (1879).

36. Copyright Act of 1909, Pub. L. 60-349, 35 Stat. 1075 (1909).

37. *Id.* at 1078 .

38. ALAN LATMAN, FAIR USE OF COPYRIGHTED WORKS (1958), reprinted in STUDIES PREPARED FOR THE SUBCOMM. ON PATS., TRADEMARKS, & COPYRIGHTS, S. COMM. ON THE JUDICIARY, 86th Cong., 2d Sess., Copyright Law Revision 18 (Comm. Print 1960) (hereinafter Latman Study).

39. Copyright Act of 190, 35 Stat. at 1075.

This language made the same choice as the earlier laws did in itemizing rather than providing a simple derivative works right, but the new law did embrace how derivative works were construed at the time. Literary works in particular received broad protection, with a prohibition against unlawfully "making any other version thereof."[40] Some other types of works received essentially no protection against derivative uses.[41] In this case, the initially ambitious 1909 Act ended up being a dramatic move forward but still something of a half measure.

In 1917, Arthur Weil published the next major treatise on copyright in the United States. In it he noted that fair use had "been gradually enlarged" over the years.[42] To Weil, fair use meant "a use which is legally permissive, either because of the scope of a copyright, the nature of a work, or by reason of the application of known commercial, social or professional usage."[43] Instead of giving his own test of fair use, Weil simply quoted the standard given in *Folsom.*[44] Weil also recognized that it was it was "entirely within the limits of fair use to make parodies or literary perversions of copyrighted work."[45] Perhaps ironically, because fair use remained undefined by statute and instead served only as a general doctrine, it was not necessary to determine how a parody fit into the general framework from *Folsom*. Weil also noted that the broad language of section 1(b) for derivative works "appears to reserve the exclusive right of abridgment to the copyright proprietor, thus terminating difficult controversies of fact, under the prior law."[46]

In his 1936 treatise, Leon H. Amdur took a more modern approach to the collection of rights now known as derivative rights and termed them the "right of transformation." *Copyright Law and Practice* 285 (1936). This conceptual shift was important – recognizing the derivative works right as a general right, rather than the somewhat polyglot formation used in the 1909 Act and in previous treatises. For fair use, Amdur added a question of attribution, a suggestion not followed up by the caselaw but perhaps consonant with treaty obligations under the moral rights provisions of the Berne Convention.[47] The factors he advocated were thus (1) the nature of the original work, (2) the nature of the use, (3) the purpose of the use, (4) the intent of the use, and (5) whether credit was given.[48]

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40. *Id.*
41. *Id.* at 1078-79.
42. ARTHUR WEIL, AMERICAN COPYRIGHT LAW 429 (1917).
43. *Id.*
44. *Id.* at 431.
45. *Id*. at 432.
46. *Id.* at 74.
47. Berne Convention for the Protection of Literary and Artistic Works art. 6bis, Sept. 9, 1886, 102 Stat. 2853, 828 U.N.T.S. I-11850.
48. LEON H. AMDUR, COPYRIGHT LAW AND PRACTICE 778 (1936).

In the mid-20th century there were several attempts to formulate factors for determining whether a use of a copyrighted work was fair. However, all rely heavily on the criteria given by Justice Story in *Folsom,* with occasional attempts to add additional factors. In his 1944 treatise Horace G. Ball asserted that there were three key elements of fair use and his treatise analyzes the developing law of fair use around them – "(1) The nature, scope and purpose of the work in question . . . (2) The extent, relative value, purpose and effect of the material appropriated…[and] (3) intent."[49] A decade later, in an influential article, Chief Judge Leon Yankwich of the Southern District of California stated that a determination of fair use "require[s] consideration of (1) the quantity and importance of the portions taken; (2) their relation to the work of which they are a part; (3) the result of their use upon the demand for the copyrighted publication."[50] Once in the 1950s and again in the 1970s the Supreme Court had the opportunity to address the fair use doctrine, but each time a recusal led the Court to split evenly 4-4.[51]

This was the state of the law in 1955, when the U.S. Copyright Office, at the request of Congress, began a series of "Revision Studies" of Copyright Law, laying the groundwork for what would become the current copyright law over two decades later in 1976. Study number 14 (out of over thirty) by Alan Latman focused on the question of fair use, and provides a detailed survey of fair use up to that point.[52] The study did not make a specific recommendation, instead giving a number of different options, ranging from keeping the law's current silence on fair use or mentioning it but going no further, to suggestions of a statute which laid out general factors for fair use or specifying specific situations where fair use would apply.[53] In the study the question is raised whether parody is given greater protection than other forms of fair use, but not answered.[54] Among the comments received and appended to the study is one from Prof. Melville Nimmer, still a few years away from first publication of his treatise. In his comment letter Nimmer suggests that parody is indeed entitled to greater but not unlimited protection, and further urged that the statute not attempt to define fair use.[55]

By 1963 a draft of the copyright bill included a forerunner of the modern language of Section 107, combining the fourth approach (a list of situations) followed by the third approach (general factors for determining fair use, with neither one being exclusive.[56] Factors which had been urged in the

49. HORACE G. BALL, LAW OF COPYRIGHT AND LITERARY PROPERTY 262-63 (1944).

50. Leon R. Yankwich, *What Is Fair Use?*, 22 U. CHI. L. REV. 203, 213 (1954).

51. Robert Brauneis, *Parodies, Photocopies, Recusals, and Alternate Copyright Histories: The Two Deadlocked Supreme Court Fair Use Cases*, 68 SYRACUSE L. REV. 7 (2018).

52. Latman Study, *supra* note 38.

53. *Id.* at 32-33.

54. *Id.* at 9-10.

55. *Id.* at 42-43.

56. Richard Dannay, *Factorless Fair Use: Was Melville Nimmer Right,* 60 J. COPYRIGHT SOC'Y U.S.A. 127, 129 (2012-2013).

past, such as credit and intent, were not included, in favor of a restatement of the test used in *Folsom* in more modern language.[57] In 1964 Melville Nimmer once again urged that fair use only be mentioned in general terms in the law, and in response the bills introduced in the House and Senate in 1965 simply stated that "[n]otwithstanding the provisions of Section 106, the fair use of a copyrighted work is not an infringement of copyright."[58] Congress thought the better of this though, and in 1966 copyright revision bills restored the earlier language providing situations and factors for when fair use would be found.[59] The current language of section 107 closely tracks the language from the 1966 bill, and these situations and factors were explicitly made non-exclusive.

Writing in 1964, Melville Nimmer declared that the "scope and limits" of fair use "are most obscure."[60] However, as one might expect given the above, he quotes an example of the multifactor *Folsom*-inspired test and is skeptical of it, asserting it "suggests no firm guide as to when … the defense of fair use *should* be invoked."[61] To his mind, the relevant question was the effect on the market of the plaintiff's work by defendant's work – "by comparing . . . the function of each work regardless of media."[62] Accordingly, parodies would be a fair use, while competing works would not be.

The story for derivative works in what would become the 1976 Act is far simpler. In July of 1964, S. 3008 and H.R. 11947 were introduced, providing that a right to prepare derivative works was exclusive to the copyright owner, and that would endure into Section 106 of the current copyright law.[63] There was more discussion of what exactly a derivative work is, but a definition was settled on and written into Section 101 of the copyright law, that it is "a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted."[64]

TRANSFORMING THE 1976 COPYRIGHT ACT

In 1990 Judge Pierre Leval of the Second Circuit Court of Appeals (then of the U.S. District Court for the Southern District of New York) published

57. *Id.*
58. *Id.* at 130.
59. *Id*.
60. MELVILLE B. NIMMER AND DAVID NIMMER, *The Defense of Fair Use*, *in* NIMMER ON COPYRIGHT § 145 (1964)
61. *Id*. (emphasis in original).
62. *Id.*
63. S. 3008, 88th Cong. (1964); H.R. 11947, 88th Cong. (1964) (codified in 17 U.S.C. § 106.)
64. 17 U.S.C. § 101; Copyright Act of 1976, Pub. L. 94-553, 90 Stat. 2541 (1976).

his influential article *Toward a Fair Use Standard*.[65] Judge Leval argued that for the first fair use factor (if not overall) the

> the heart of the fair user's case . . . turns primarily on whether, and to what extent, the challenged use is transformative. The use must be productive and must employ the quoted matter in a different manner or for a different purpose from the original.[66]

The obvious dissonance between the exclusive grant of a right to create transformative works to the copyright holder and a standard for fair use that turns on whether the use is transformative is not addressed. Having covered the history of fair use from *Folsom*, one can also hear that this statement of transformativeness owes far more to the deprecated fair abridgement doctrine than to fair use since *Folsom*. Judge Leval's opinion, stated later, is that the four factor test adopted by Congress was a mistake, and

> the inclusion of superfluous words in the [copyright] statute was likely to cause trouble. While the fair use statute was under .consideration, [Melville Nimmer] recommended that it be pared down to the bare bones: 'fair use . . . is not an infringement.' Had his wisdom been followed, many of these quixotic misadventures might have been avoided.[67]

Obviously, this preference does not square with what Congress provided for in the 1976 Act, which explicitly requires courts to consider (at least) four factors.[68] However, the Supreme Court has used Judge Leval's analysis to handle two situations Congress did not cleanly address. As discussed, parody has always been understood to be protected by the fair use doctrine, but although it was discussed, it was not included explicitly in Section 107.[69] Thus, when faced with a parody of Roy Orbison's "Pretty Woman," the Court held that the use was possibly transformative as parody and thus the other factors of the statutory fair use analysis would be given less weight.[70] The question of whether this opinion meant to deprecate the statutory factors and replace them with a transformativeness inquiry for all works, or only for parodies which commented on the original, would play out over subsequent decades.

Computers were on the distant horizon for of the drafters of the 1976 Act – a committee to study computers and copyright was underway at the

65. 103 HARV. L. REV. 1105 (1990).

66. *Id.* at 1111 (emphasis in original).

67. Pierre Leval, *Nimmer Lecture: Fair Use Rescued*, 44 UCLA L. REV. 1449, 1466 (1997). *See also,* Benjamin Moskowitz, Note, *Toward a Fair Use Standard Turns 25: How Salinger and Scientology Affected Transformative Use Today,* 25 FORDHAM UNIV. INTELL. PROP. MEDIA & ENT. J.L. 1057 (2015).

68. 17 U.S.C. § 107.

69. *Id.*

70. Campbell v. Acuff-Rose Music, 510 U.S. 569 (1994).

time of the passage of the 1976 Act but modern computer fair use problems were mostly theoretical at that point.[71] Over times these problems would grow substantially, and Judge Boudin's concurrence in the Lotus v. Borland case suggested that fair use was a better vehicle for solving problems of software copyright than the infringement analysis.[72] When a long-running dispute over the re-creation of computer code between technology giants Oracle and Google reached the Court, transformativeness was once again invoked to find fair use.[73]

Part of the key question for the Warhol court was how significant the context of the Google case was. There's a long distance aesthetically between an artistic photograph and the application programming interface of a computer language like Java. After all, the court noted that

> fair use can play an important role in determining the lawful scope of a computer program copyright, such as the copyright at issue here. It can help to distinguish among technologies. It can distinguish between expressive and functional features of computer code where those features are mixed. It can focus on the legitimate need to provide incentives to produce copyrighted material while examining the extent to which yet further protection creates unrelated or illegitimate harms in other markets or to the development of other products. In a word, it can carry out its basic purpose of providing a context-based check that can help to keep a copyright monopoly within its lawful bounds.[74]

Following the Court's ruling on the side of *Google*, the Andy Warhol Foundation for the Visual Arts filed a motion for reconsideration with the Second Circuit, in response to which the Second Circuit produced an amended opinion effectively calling the *Google* case a decision limited to the computer context, noting that "the court in *Google* took pains to emphasize that the unusual context of the case," and declining to find this case to be similar.[75]

And while the Supreme Court did not expressly go quite as far as the Second Circuit did in limiting Google v. Oracle to the computer context, it seems likely *Warhol* will be the precedent most likely used outside the context of computers for the consideration of "the purpose and character of the

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71. FINAL REPORT OF THE NATIONAL COMMISSION ON NEW TECHNOLOGY USES OF COPYRIGHTED WORKS (Jul. 31, 1978).

72. Lotus Dev. Corp. v. Borland Int'l, 49 F.3d 807, 821 (1st Cir. 1995); *aff'd by an equally divided Court*, 516 U.S. 233 (1996). As files held by the Clinton Library show, now-Justice Kagan was closely involved with drafting the government's brief while Associate White House Counsel. Office of White House Counsel, KAGAN LOTUS FILES (1995) https://archive.org/details/KaganLotusFiles. Whether this case – which was expected to be a major precedent – influenced her views of copyright and fair use, and when considered in the context of *the Google v. Oracle* opinion whether this helps explain the energy of her dissent in *Warhol v. Goldsmith* can only be speculated at.

73. Google LLC v. Oracle Am., Inc., 141 S. Ct. 1183 (2021).

74. *Id.* at 1198.

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

use" under the fair use test. While transformation is important in the parody context, and will be used as part of the analysis otherwise, it is only one of several factors to consider – part of the "purpose and character" inquiry, but no more. In the Court's words, "*Campbell* cannot be read to mean that §107(1) weighs in favor of any use that adds some new expression, meaning, or message. Otherwise, 'transformative use' would swallow the copyright owner's exclusive right to prepare derivative works."

CONCLUSION

In all of this there was some hope the Supreme Court would give more clarity on what the derivative works right – the exclusive right to recast, transform, or adapted a work – is, and how it differs from the reproduction right practically given that nonliteral copying is nonetheless infringement of the reproduction right. Both the majority and concurrence focus on the fact that "transform" is found in the definition of derivative work, but not in Section 107, and that is part of the rationale for transformation alone not being a fair use, since it is an exclusive right. The majority explains that "the degree of transformation required to make 'transformative' use of an original must go beyond that required to qualify as a derivative." This line is going to be quoted but what exactly it means is unclear – infringement cases are often fuzzy on whether the reproduction or derivative works right is being infringed, and/or simply mention the derivative works right as an afterthought. This case is frankly no different – the declaratory complaint filed by Goldsmiths claims infringement of both the reproduction and derivative works rights, but there is no real attempt to separate them out.

And maybe this is acceptable. At the Chicago-Kent Supreme Court IP Review, when the issue was discussed it was suggested that it didn't matter all that much – infringement of either right is an infringement resulting in the same damages, and focusing on which exact right is bring infringed may not be necessary. After all, in his treatise Nimmer warns that trying to determine if something is derivative or not in the IP space is an example of the perils of taxonomy.[76] As Justice Story noted in another copyright case, "there are, and can be, few, if any, things which, in an abstract sense, are strictly new and original throughout," and all works are in some ways derivatives.[77] Yet this feels unsatisfactory from a doctrinal perspective, and given that a circuit split exists as to the nature of the derivative works right, presents practical problems as well.[78] Perhaps in another few decades.

76. 1 MELVILLE B. NIMMER & DAVID NIMMER, *The Perils of Taxonomy*, *in* NIMMER ON COPYRIGHT § 3.08 (2023).

77. Emerson v. Davies, 8 F. Cas. 615, 619 No. 4436 (C.C.D. Mass. 1845).

78. *Cf.* Mirage Editions, Inc. v. Albuquerque A.R.T. Co., 856 F.2d 1341 (9th Cir. 1988); Lee v. A.R.T. Co., 125 F.3d 580, 581 (7th Cir. 1997).