THE JURISPRUDENCE OF TRANSFORMATION: INTELLECTUAL INCOHERENCE AND DOCTRINAL MURKINESS TWENTY YEARS AFTER *CAMPBELL V. ACUFF-ROSE MUSIC*

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ABSTRACT

Examining recent judicial opinions, this Article analyzes and critiques the transformative-use doctrine two decades after the U.S. Supreme Court introduced it into copyright law in Campbell v. Acuff-Rose Music. When the Court established the transformative-use concept, which plays a critical role in fair-use determinations today, its contours were relatively undefined. Drawing on an influential law-review article, the Court described a transformative use as one that adds "new expression, meaning or message." Unfortunately, the doctrine and its application are increasingly ambiguous, with lower courts developing competing conceptions of transformation. This doctrinal murkiness is particularly disturbing because fair use is a key proxy for First Amendment interests in copyright law. This Article traces the evolution of transformative use, analyzes three key paradigms of transformative use that have gained prominence in the post-Campbell environment, and offers suggestions for a jurisprudence in which transformative use is a less significant component of the fair-use analysis.

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INTRODUCTION

In its divided opinion in *Cariou v. Prince*,[1] the Second Circuit addressed the fair-use assertions of an appropriation artist named Richard Prince.[2] Photographer Patrick Cariou sued Prince for copyright infringement after Prince "altered and incorporated"[3] several of Cariou's photos into his own paintings and collages.[4] Specifically, Prince cut out pictures of Rastafarians from Cariou's book, *Yes Rasta*, and then "juxtaposed them with images of guitars and naked women for a series of collages he called 'Canal Zone.' Prince's gallery then sold some of the paintings in the series for $10 million."[5] While one critic dubs Prince "the most successful practitioner" of appropriation art, Cariou characterizes Prince's work in "Canal Zone" as "plain laziness."[6]

A key element in the Second Circuit's fair-use determination, as is now standard practice in the federal judiciary, was whether Prince had engaged in a "transformative use" of Cariou's photos.[7] The majority ultimately held that twenty-five of Prince's works were transformative and remanded the case to the district court to determine whether the other five works were similarly transformative.[8] The court noted that it was unclear whether certain alterations Prince made to the five photos "amount[ed] to a sufficient transformation of the original work of art such that the new work is transformative."[9]

Judge J. Clifford Wallace, dissenting in part, was skeptical of the majority's purported ability to identify transformative use in some of the

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[1] 714 F.3d 694 (2d Cir. 2013).

[2] *See generally* Sherri Irvin, *Appropriation and Authorship in Contemporary Art*, 45 BRITISH J. AESTHETICS 123 (2005) (providing an excellent overview of appropriation art). Prince has been described as one of "the instigators of early 1980s appropriation or pictures art" who "established his art-world bona fides by re-photographing existing photographs: of fashion models, Marlboro men, luxury watches, pornography and biker chicks." Roberta Smith, *Tracing a Radical's Progress, Without Any Help From Him*, N.Y. TIMES, Feb. 9, 2007, at E37.

[3] *Prince*, 714 F.3d at 698.

[4] *Id.*

[5] All Things Considered: 'Canal Zone' Collages Test the Meaning of 'Fair Use' (National Public Radio broadcast May 16, 2012).

[6] Adam Lindemann, *My Artwork Formerly Known as Prince*, N.Y. OBSERVER, Mar. 29, 2011, at Culture.

[7] *Prince*, 714 F.3d at 704 (noting that Prince "asserted a fair use defense, arguing that [his] artworks are transformative of Cariou's photographs and, accordingly, do not violate Cariou's copyrights").

[8] *Id.* at 711.

[9] *Id.*

works, but not others.[10] Judge Wallace found it relevant that Prince had, in testimony, seemed to disclaim any interest in the plaintiff's intent in creating the photographs or in creating a work with new meaning through his appropriation art. In reasoning reminiscent of Justice Potter Stewart's oft-quoted dictum about obscenity—"I know it when I see it"[11]—Judge Wallace expressed doubt that the majority could simply apply its own artistic judgment to identify transformative use in any principled way. Wallace asserted that:

> [W]hile I admit freely that I am not an art critic or expert, I fail to see how the majority in its appellate role can 'confidently' draw a distinction between the twenty-five works that it has identified as constituting fair use and the five works that do not readily lend themselves to a fair use determination."[12]

The division in *Prince* highlights the tremendous uncertainty created by the transformative-use doctrine, which over the last twenty years has become something close to the *sine qua non* in fair use cases.[13] When the U.S. Supreme Court first instantiated this doctrine in *Campbell v. Acuff-Rose Music, Inc.*[14] in 1994, its contours were relatively undefined. The Court, drawing on an influential article in the *Harvard Law Review*,[15] described a transformative use as one that adds "new expression, meaning or message."[16] Yet, it also declined to decide definitively whether the use in the case at bar (a rap parody of Roy Orbison's song "Oh, Pretty Woman" by rappers 2 Live Crew) was indeed transformative.[17] Instead, the Court remanded the case to the Sixth Circuit for further proceedings, noting that "we think it is fair to say that 2 Live Crew's song reasonably could be perceived as commenting on the original or criticizing it, to some degree."[18] With this cursory and equivocal analysis, the Court turned the transformative use doctrine loose onto copyright law, where it quickly became an enormously important, albeit undertheorized, component in

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[10] *Id.* at 712–14 (Wallace, J., concurring in part, dissenting in part).
[11] Jacobellis v. Ohio, 378 U.S. 184, 197 (1964) (Stewart, J., concurring).
[12] *Prince*, 714 F.3d at 713 (Wallace, J., concurring in part, dissenting in part).
[13] *See* HOWARD B. ABRAMS, 2 THE LAW OF COPYRIGHT § 15:42.30 (2d ed. 1991 & Supp. 2010) ("In contemporary fair use jurisprudence it is fair to say that in evaluating the first statutory factor—the purpose and character of the use—the question of whether the use is 'transformative' has emerged as the central and often determinative question.").
[14] 510 U.S. 569 (1994).
[15] Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105 (1990).
[16] *Campbell*, 510 U.S. at 579.
[17] *Campbell* involved the rap group 2 Live Crew's use of Roy Orbison's song "Oh, Pretty Woman" in a rap parody. *See infra* notes 50–52 and accompanying text.
[18] *Id.* at 583.

lower-court fair-use determinations.[19] In the immediate aftermath of *Campbell* and its reception in the lower courts, one perceptive scholar described the doctrine of transformative use as "a scrambled mess."[20] Unfortunately, in the ensuing two decades, the ambiguity surrounding the doctrine has, if anything, increased.

This doctrinal murkiness is particularly disturbing because fair use is a key proxy for free-expression interests in copyright law. The Supreme Court has repeatedly held that fair use, along with the separation of facts and ideas from expression, obviates the need for First Amendment scrutiny of copyright law by providing an internal statutory safeguard for free-speech interests.[21] For example, the Court in *Eldred v. Ashcroft* alluded to fair use, as well as the idea–expression and fact–expression dichotomies, in pointing out that "copyright's built-in free speech safeguards are generally adequate"[22] when copyright interests conflict with First Amendment values. Moreover, the rise of both the Internet and digital media makes users' ability to borrow and remix others' expression increasingly important.[23] As Professor Matthew Sag points out: "If fair use is truly arbitrary and uncertain, our copyright system is fundamentally broken."[24]

Part I of this Article initially examines the basics of fair-use analysis in copyright. Next, Part II traces the rise and evolution of the transformative-use doctrine, beginning with *Campbell*. Part III then explores three different paradigms of transformative use that have gained prominence in the post-*Campbell* environment. This trio of competing conceptualizations fosters a great deal of intellectual incoherence in fair-use doctrine. Finally, the Article concludes in Part IV by offering some possible

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[19] The transformative use test developed in *Campbell* has since migrated, as well, to right-of-publicity cases. *See, e.g.*, Comedy III Prods., Inc. v. Saderup, 21 P.3d 797, 808 (Cal. 2001) (citing *Campbell* as supporting the transformative-use test in a right-of-publicity case).

[20] Diane Leenheer Zimmerman, The More Things Change, the Less They Seem "Transformed": Some Reflections on Fair Use, 46 J. COPYRIGHT SOC'Y 251, 252 (1998).

[21] The First Amendment to the United States Constitution provides, in pertinent part, that "Congress shall make no law . . . abridging the freedom of speech, or of the press." U.S. CONST. amend. I. The Free Speech and Free Press Clauses were incorporated nearly ninety years ago through the Fourteenth Amendment Due Process Clause as fundamental liberties to apply to state and local government entities and officials. *See* Gitlow v. New York, 268 U.S. 652, 666 (1925).

[22] Eldred v. Ashcroft, 537 U.S. 186, 221 (2003). *See also, e.g.*, Harper & Row Publishers, Inc. v. Nation Enterprises, 471 U.S. 539, 560 (1985).

[23] Matthew Sag, *Predicting Fair Use*, 73 OHIO ST. L.J. 47, 49 (2012).

[24] *Id.*

solutions for addressing the problems wrought by the transformative-use doctrine.

I. THE BASICS OF FAIR USE: A PRIMER

Fair use provides a key limitation on the rights of copyright owners. It allows some degree of borrowing of copyrighted expression by third parties, without either permission from or payment to the copyright holder.[25] As one court explained it, fair-use doctrine "permits courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity that the law is designed to foster."[26]

Fair use evolved from the English doctrine of "fair abridgment" that arose after passage of the Statute of Anne in 1710.[27] The first U.S. synthesis of the doctrine is generally credited to Justice Joseph Story in *Folsom v. Marsh* in 1841.[28] Although fair use began as an equitable doctrine, and still retains an aura of equity because of its ad hoc nature, it has been firmly ensconced in federal statutory law since enactment of the 1976 Copyright Act.[29]

The fair-use section of the Act begins with a preamble that lists a variety of potential fair uses, including "criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research,"[30] although this list is not intended to be exhaustive. The statute then provides four nonexclusive factors, derived largely from Story's synthesis in *Folsom*, which courts typically evaluate *seriatim* to determine whether a particular use is fair:

1. the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
2. the nature of the copyrighted work;
3. the amount of substantiality of the portion used in relation to the copyrighted work as a whole; and
4. the effects of the use upon the potential market for or value of the copyrighted work.[31]

As with many multi-factor legal tests, this four-part standard by itself introduces considerable uncertainty into a typical fair-use defense.

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[25] 17 U.S.C. § 107 (2013).
[26] Iowa St. Univ. Research Found., Inc. v. Am. Broad. Cos., 621 F.2d 57, 60 (2d Cir. 1980).
[27] William F. Patry, Patry on Fair Use 8 (2010).
[28] 9 F. Cas. 342, No. 4901 (C.C.D. Mass. 1841).
[29] 17 U.S.C. § 107 (2013).
[30] Id.
[31] Id.

One court referred to fair use as "exceptionally elusive, even for the law,"[32] while Professor Paul Goldstein called it "the great white whale of American copyright law. Enthralling, enigmatic, protean . . . ."[33] Noted commentator David Nimmer famously said of the doctrine's perceived indeterminacy that "had Congress legislated a dartboard rather than the particular four fair use factors embodied in the Copyright Act, it appears that the upshot would be the same."[34]

Courts have considerable discretion in the application of the factors. Although some authority exists for the fourth factor being the most important,[35] it has since been overshadowed by the transformative-use doctrine (notably absent from the four statutory factors) articulated in *Campbell*. It is to the rise of the transformative-use doctrine that the next Part turns.

II. TRANSFORMATIVE USE ASCENDANT: FROM SCHOLARLY ROOTS TO JUDICIAL INSTANTIATION

Transformative use, like most legal doctrines, did not arise *ex nihilo*. A precursor doctrine—"productive use"—had been part of fair use, at least in some cases, for some time.[36] At least one understanding of productive use had been that it involved the use of others' copyrighted expression to create a new work.[37] However, the Supreme Court in *Sony Corp of America v. Universal City Studios, Inc.*[38] in 1984 rejected the notion that the presence or absence of productive use was pivotal as to whether a particular use was fair.[39] The Court did note that "the distinction between 'productive' and 'unproductive' uses may be helpful in calibrating the balance, but it cannot be wholly determinative."[40]

Productive use morphed into transformative use in a thoughtful and widely cited *Harvard Law Review* article by Judge Pierre N. Leval of the

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[32] Marvin Worth Prods. v. Superior Film Corp., 319 F. Supp. 1269, 1273 (S.D.N.Y. 1970).
[33] Paul Goldstein, *Fair Use in Context*, 31 COLUM. J.L. & ARTS 433, 433 (2008).
[34] David Nimmer, *"Fairest of Them All" and Other Fairy Tales of Fair Use,* 66 LAW & CONTEMP. PROBS. 263, 280 (2003).
[35] *See, e.g.*, Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 566 (1985).
[36] Laura G. Lape, Transforming Fair Use: The Productive Use Factor in Fair Use Doctrine, 58 ALB. L. REV. 677 (1995).
[37] *Id*. at 708.
[38] 464 U.S. 417 (1984).
[39] *Id.* at 455.
[40] *Id*. at 456 n. 40.

U.S. Court of Appeals for the Second Circuit.[41] Judge Leval's thesis was that fair use needed a guiding principle then absent from the case law:

> Judges do not share a consensus on the meaning of fair use. Earlier decisions provide little basis for predicting later ones. Reversals and divided courts are commonplace. The opinions reflect widely differing notions of the meaning of fair use. Decisions are not governed by consistent principles, but seem rather to result from intuitive reactions to individual fact patterns.[42]

Judge Leval's solution was to find a new, guiding principle using the basic goal of copyright law: encouraging creativity and innovation in literary and artistic works for the public good. This prime directive of copyright law is contained in the Copyright and Patent Clause of the U.S. Constitution, which expresses the purpose of copyright and patent law as existing "To promote the Progress of Science and the useful Arts . . . ."[43] This goal of promoting progress in turn meant, Leval reasoned, that borrowings of copyrighted expression furthering such intellectual or artistic progress—transformative uses—should be considered fair, while other appropriations should not:

> The use must be productive and must employ the quoted matter in a different manner or for a different purpose from the original. A quotation of copyrighted material that merely repackages or republishes the original is unlikely to pass the test; in Justice Story's words, it would merely 'supersede the objects' of the original. If, on the other hand, the secondary use adds value to the original—if the quoted matter is used as raw material, transformed in the creation of new information, new aesthetics, new insights and understandings—this is the very type of activity that the fair use doctrine intends to protect for the enrichment of society.[44]

Leval's thesis of conceptual isomorphism between the purposes of copyright writ large and the purpose (and operation) of fair use, while neat, tidy and intuitively appealing, was clearly adventurous. Neither the history of fair-use law in the United States nor the text of the statute provided strong support for Judge Leval's sweeping synthesis.[45] Early copyright law in the U.S. was considerably narrower than the law as it stands now; many issues we might debate today as possible fair uses were simply not

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[41] Leval, *supra* note 15.
[42] *Id.* at 1106–1107.
[43] U.S. CONST. art. I, § 8, cl. 8.
[44] Leval, *supra* note 15, at 1111.
[45] *See, e.g.*, MARSHALL LEAFFER, UNDERSTANDING COPYRIGHT LAW 431 (1999) (writing that "despite its seductive charm and approbation in the case law, the productive use doctrine is neither supported by the language of the statute or the legislative history").

infringing. As Professor Lawrence Lessig has pointed out, the first copyright act covered only "maps, charts, and books," and only protected against verbatim copying.[46]

Even more significantly for Judge Leval's thesis, as Professor Laura Lape has noted, fair use in the nineteenth century "was in its barest infancy, and was hardly a coherent or clearly delineated doctrine, as may sometimes be implied. [Moreover,] *notwithstanding certain scholarly and judicial assertions to the contrary, nineteenth century case law does not support the existence of a productive use factor for fair use*."[47] Thus, the historical pedigree Judge Leval claimed for his proposed alignment of the purpose of copyright and that of fair use was, at best, contested. The unifying principle he advocates is an intellectually elegant one, but it is his invention, which has significant implications for its adoption as law, particularly in a statutory area (although the fair use statute is sufficiently open textured to encourage some level of judicial innovation). It was, of course, also apparent that the newly christened transformative-use doctrine was a repackaged formulation of productive use, as Judge Leval's quoted passage above explicitly states.[48]

Judge Leval's new creation was embraced enthusiastically in Justice Souter's majority opinion in *Campbell*. While the Court did not accept transformative use as *necessary* to a fair use, just as the *Sony* Court had treated productive use, it was nonetheless regarded as highly auspicious in the new analytical scheme *Campbell* created.[49]

Campbell arose when notorious rappers 2 Live Crew appropriated the first lyric line and a key opening musical phrase from "Oh, Pretty Woman," a widely recorded popular song most associated with Roy Orbison.[50] The 2 Live Crew version was arguably a rap parody of the original, particularly using crude references to sexuality to skewer the

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[46] Lawrence Lessig, *Copyright's First Amendment*, 48 UCLA L. REV. 1057, 1061 (2001).

[47] Laura G. Lape, *Transforming Fair Use: The Productive Use Factor in Fair Use Doctrine*, 58 ALB. L. REV. 677, 688 (1995) (emphasis added) (citing, among other things, Judge Leval's seminal article).

[48] Judge Leval has emphasized the connection between productive use and transformative use, stating in a later lecture that the Supreme Court's adoption of transformative use in *Campbell* "restores the lost emphasis on 'productive use,' but now in the context of a far more sophisticated discussion, related in every detail to the basic objectives of copyright doctrine." Pierre N. Leval, Campbell v. Acuff-Rose*: Justice Souter's Rescue of Fair Use*, 13 CARDOZO ARTS & ENT. L.J. 19, 22 (1994).

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

[50] *Id.* at 573.

perceived naiveté of the original.[51] The Supreme Court, in a unanimous opinion written by Justice Souter, found that the Sixth Circuit had misapplied the first fair-use factor, the purpose and character of the use, by ruling that that factor weighed against fair use due to the commercial nature of 2 Live Crew's appropriation.[52]

The Court, citing Judge Leval, rejected the notion that a commercial use necessarily leads to an unfavorable finding as to the first fair-use factor. Instead, the Court stated, the factor one inquiry should determine whether the new work "adds something new with a further purpose or different character, altering the first with *new expression, meaning or message . . .* ."[53] This sort of alteration is the essence of a transformative use. Although a transformative use was not required for the use to be fair, the Court reasoned that "the more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use."[54]

Justice Souter's opinion also noted that the transformative-use doctrine had implications for fair-use factors beyond the first, the purpose and character of the use. For example, the transformative nature of parody, the Court reasoned, could give a parodist more leeway on the third fair-use factor, the amount and substantiality of the portion used.[55] The parodist, to craft a successful parody recognizable to the audience, may need to borrow more of the original work—perhaps even the heart of it—in order to evoke the original in the minds of audience members.[56] The Court also noted as to the fourth fair-use factor, the effect on the market for the original, that transformative uses are often less likely to harm the market for the original work. As Justice Souter wrote, when "the second use is transformative, market substitution is at least less certain, and market harm may not be so readily inferred."[57]

Justice Souter's opinion also cautioned against evaluation of the aesthetic worth of the borrowing work, quoting Justice Oliver Wendell Holmes' famous line from *Bleistein v. Donaldson Lithographing Co*.[58] on the copyrightability of circus posters: "[I]t would be a dangerous

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[51] Id.
[52] Id.
[53] *Id.* at 579 (emphasis added).
[54] *Id.*
[55] *Id.* at 588.
[56] *Id.* at 588–89 ("Copyright does not become excessive in relation to parodic purpose merely because the portion taken was the original's heart. If 2 Live Crew had copied a significantly less memorable part of the original [Roy Orbison song], it is difficult to see how its parodic character would have come through.")
[57] *Id.* at 591.
[58] 188 U.S. 239 (1903).

undertaking for persons trained only to the law to constitute themselves final judges of the worth of [a work], outside of the narrowest and most obvious limits."[59] The fine line between aesthetic evaluation and the determination of transformative use continues to bedevil lower courts, as later Parts of this Article make clear.

A close reading of *Campbell* nonetheless reveals difficulties with its exposition of transformative use. Aside from the definition quoted above (adding new expression, meaning or message), there was little attention to the analytical nuances of the doctrine. It was not clear, for example, how transformative use differed from its earlier incarnation as productive use, if indeed it did. If there was no difference, one wondered why the dramatic announcement of new terminology was required. Moreover, some of Justice Souter's language blurred the sense of whether certain passages in the opinion were applicable only to parodists or to all transformative users. It was clear that parody was a subset of transformative use, but the precise contours of the distinctions between the two were hazy in *Campbell*. These ambiguities no doubt contributed to the current muddled state of the doctrine.

Despite its legal murkiness, the transformative use doctrine gradually became central to fair use determinations in many lower courts. As an empirical study by Professor Neil Weinstock Netanel of fair-use cases from 2006 to 2010 concluded, "fair use doctrine today is overwhelmingly dominated by the Leval–*Campbell* transformative use doctrine."[60] Netanel examined a total of sixty-eight judicial opinions, of which he noted that "[the] recent decisions that unequivocally characterize the defendant's use as transformative almost universally find fair use."[61] Similarly, "all but three cases that characterized the use in question as non-transformative, or only 'minimally,' 'partly,' or 'somewhat' transformative, found no fair use."[62]

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[59] *Id.* at 251.

[60] Neil Weinstock Netanel, *Making Sense of Fair Use*, 15 LEWIS & CLARK L. REV. 715, 736 (2011). For another empirical study demonstrating the centrality of the transformative doctrine to fair use determinations, see Matthew Sag, *Predicting Fair Use*, 73 OHIO ST. L.J. 47 (2012). An earlier empirical study that left off in 2005 argued that the influence of the transformative factor was exaggerated at that point, although that study nonetheless pointed out that "in those opinions in which transformativeness did play a role, it exerted nearly dispositive force not simply on the outcome of factor one, but on the overall outcome of the fair use test." Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978–2005*, 156 U. PA. L. REV. 549, 565 (2008).

[61] Netanel, *supra* note 60, at 740.

[62] *Id.* at 741.

III. TRANSFORMATIVE USE ASCENDANT: FROM SCHOLARLY ROOTS TO JUDICIAL INSTANTIATION

This Part explores three different ways in which courts since *Campbell* have conceptualized the transformative-use doctrine.

A. Transformation as New Insights

One mode of conceptualizing transformative use is captured in Professor William F. Patry's emphasis on the new insights added by the borrower as the key to transformative use. Professor Patry argues that "the form that the productive or transformative use takes—e.g., a new work or commentary—is less important than the presence and quality of the new insight."[63] The "new insights" paradigm also gains support from the fair-use statute's preamble, with its enumeration of criticism, comment, scholarship and the like as potentially favored uses.

A classic new-insights case is the Second Circuit's *Leibovitz v. Paramount Pictures Corp.*,[64] decided in 1998. In *Leibovitz*, Paramount created an advertisement for its movie *Naked Gun 33 1/3: The Final Insult* that parodied Annie Leibovitz's iconic *Vanity Fair* cover photograph of a nude, enormously pregnant Demi Moore. Paramount's ad featured a similar looking nude, pregnant woman, but with the superimposed face of a smirking Leslie Nielsen, the lead actor in the film. The ad copy read: "Due This March."

In considering whether the Nielsen ad was transformative, the Second Circuit found that Paramount brought new meaning to the original photo by directing "deflating ridicule" toward it: "Because the smirking face of Nielsen contrasts so strikingly with the serious expression on the face of Moore, the ad may reasonably be perceived as commenting on the seriousness, even the pretentiousness, of the original."[65] The court noted that, while not every feature of a defendant's work that was merely different

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[63] William F. Patry, Patry on Fair Use 123 (2010).

[64] 137 F.3d 109 (2d Cir. 1998). In addition to the cases discussed in the text, see, e.g., Castle Rock Entertainment v. Carol Publ'g Grp., 150 F.3d 132, 142 (2d Cir. 1998) (concluding that the "Seinfeld Aptitude Test," a trivia quiz book about the television show, had no "transformative purpose," since it provided no commentary on the show, but instead simply posed questions about the episodes); Columbia Pictures, Inc. v. Miramax Films Corp., 11 F. Supp. 2d 1179, 1188 (C.D. Cal. 1998) (holding that a movie poster for a Michael Moore documentary that drew upon poster for hit film *Men in Black* was not transformative since it did not comment on or criticize original work); Mattel, Inc. v. Walking Mountain Prods., 353 F.3d 792, 802 (9th Cir. 2003) (finding that an artist whose works placed "Barbie" dolls in danger from household appliances engaged in transformative use by commenting on Barbie's cultural influence).

[65] *Id*. at 114.

from the plaintiff's original could necessarily provide transformative commentary on the original, Paramount's work sufficiently demonstrated such transformativeness. The Second Circuit further reasoned that "the ad might also be reasonably perceived as interpreting the Leibovitz photograph to extol the beauty of the female body, and rather unchivalrously, to express disagreement with this message."[66]

While this brand of deep reading is contestable, the Second Circuit clearly sought more than new meaning or expression standing alone, but new meaning or expression *linked to and directed toward* the borrowed work. Without new insights aimed at the plaintiff's original work, aesthetic changes in the borrowing work are not enough to warrant the label "transformative" under this approach.

A similar approach to identifying transformation is at work in the Eleventh Circuit's analysis in *Suntrust Bank v. Houghton Mifflin Co.*, a case in which an author borrowed significant portions of Margaret Mitchell's novel *Gone With the Wind*.[67] Alice Randall wrote *The Wind Done Gone* from the perspective of Scarlett's half-sister Cynara, who is a slave. Randall's work critiqued Mitchell's novel and its portrayal of slavery and the South. In creating *The Wind Done Gone*, "she appropriated the characters, plot and major scenes from GWTW into the first half of TWDG."[68]

In its analysis of the transformative factor, the circuit court seemed exclusively focused on new insights that Randall's book could bring to the original: "Randall's work flips GWTW's traditional race roles, portrays powerful whites as stupid or feckless, and generally sets out to demystify GWTW and the strip the romanticism from Mitchell's specific account . . . ."[69] Quoting *Campbell*, the Eleventh Circuit found that Randall's novel "reflects transformative value because it 'can provide social benefit by shedding light on an earlier work, and in the process, creating a new one.'"[70] To the Eleventh Circuit, "transformative value" is inherently tied to the new-insights model.

Of course, one might argue that *Leibovitz* and *Suntrust Bank* are parody cases and that it is this factual configuration that drives the judicial demand for new insights.[71] But there are non-parody cases that also require

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[66] *Id*. at 115.
[67] 268 F.3d 1257 (11th Cir. 2001).
[68] *Id*. at 1259.
[69] *Id*. at 1270.
[70] *Id.* at 1271 (quoting Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 579 (1994)).
[71] The paradigm transformative-use scenario, *Campbell*, was of course a parody case, and there the Court, although defining transformative use quite broadly,

new insights connected to the original to qualify as transformative use. Consider, for example, *Gaylord v. United States*, a Federal Circuit case dealing with a photograph of a war memorial.[72] In *Gaylord*, the Postal Service selected a work by photographer John Alli for a stamp commemorating the fiftieth anniversary of the Korean War armistice. Alli had taken a photo of the National Korean War Veteran's Memorial in Washington, D.C., a sculptural work created by Frank Gaylord. The memorial itself consisted of "'19 stainless steel statues representing a platoon of foot soldiers in formation,' referred to as The Column."[73] Alli's photograph, subsequently issued as a stamp, was taken after a winter storm had encased the statues in snow and dim lighting conditions created a surreal feel to the photo.

The Court of Federal Claims held that the stamp with Alli's photo was "a transformative work, having a new and different character and expression than Mr. Gaylord's 'The Column.'"[74] The Federal Circuit panel disagreed, citing cases in which the borrowing works commented on some aspect of the originals, such as *Blanch v. Koons*[75] and *Lennon v. Premise Media Corp*.[76] In *Blanch*, noted visual artist Jeff Koons borrowed a copyrighted photograph of a woman's feet in Gucci sandals, incorporating it into a painted collage. In *Lennon*, documentary filmmakers used a brief clip from the John Lennon song "Imagine," juxtaposed with images of Stalin. In both cases, the Federal Circuit reasoned, the borrowing work commented on the original work—in *Blanch* through a "commentary on the social and aesthetic consequences of mass media,"[77] and in *Lennon* through a critique of the singer's naïve view of what a world without religion might look like.

In *Gaylord*, the Federal Circuit ruled that the stamp did not "transform the character of [the original work] The Column," unlike the works in *Blanch* and *Lennon*.[78] The court stated that "[a]lthough the stamp altered the appearance of The Column by adding snow and muting the color, these alterations do not impart a different character to the work."[79] While the court noted other possible routes to a fair-use defense, including historical scholarship that incorporates original source material to add context, the primary route to transformative use nonetheless was, for this

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nonetheless focused some of its analysis on the ways in which 2 Live Crew's version skewered the innocence of Orbison's original.

[72] 595 F.3d 1364 (Fed. Cir. 2010).

[73] *Id.* at 1368 (quoting Gaylord v. United States, 85 Fed. Cl. 59, 63 (2008)).

[74] 85 Fed. Cl. at 69.

[75] 467 F.3d 244 (2d Cir. 2006).

[76] 556 F.Supp. 2d 310 (S.D.N.Y. 2008).

[77] *Koons*, 467 F.3d at 252–53.

[78] *Gaylord*, 595 F.3d at 1373.

[79] *Id.* at 1373–74.

court, the new-insights model. Yet it is not at all clear from *Campbell* that new insights, particularly vis-à-vis the borrowed work, are required in order to create a transformative use.

The new insights model was clearly operating in a 1997 Ninth Circuit case, *Dr. Seuss Enterprises v. Penguin Books USA, Inc*.[80] The defendant published *The Cat NOT in the Hat! A Parody by Dr. Juice*, which retold the O. J. Simpson murder trial in the style of Dr. Seuss. The Ninth Circuit ruled that the borrowing work, which used the Seussian poetic style and some elements of the original to recount an entirely different set of events, was not transformative. As the Ninth Circuit put it:

> While Simpson is depicted 13 times in the Cat's distinctively scrunched and somewhat shabby red and white stove-pipe hat, the substance and content of The Cat in the Hat is not conjured up by the focus on the Brown-Goldman murders or the O. J. Simpson trial. Because there is no effort to create a transformative work with 'new expression, meaning or message,' the infringing work's commercial use further cuts against the fair use defense.[81]

The Ninth Circuit failed to cite any support for the notion that the only way to create a transformative work in this context was by conjuring up the borrowed work.[82] The very different nature of the expression in the defendant's work certainly seemed, on its face, to meet the "new expression, meaning or message" rubric. As the Nimmer treatise put it, "[i]t is hard to imagine a message or meaning more disparate from Theodore Geisel's children's classic than making his Cat into a murderer who beats the system and gets off scot-free."[83]

While the new-insights paradigm has intuitive appeal, it nonetheless seems relatively far afield from the original meaning of transformative use. Recall that the Supreme Court defined a transformative use as one that "adds something new with a further purpose or different character, altering the first with new expression, meaning or message . . . ."[84] However, the new insights model seems to add an additional requirement—whatever

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[80] 109 F.3d 1394 (9th Cir. 1997).

[81] *Id.* at 1401.

[82] Of course, as some commentators have noted, at least part of the explanation for this more restrictive definition of transformative use may be the difficulties courts have encountered in separating out transformative uses, which are generally fair, from derivative works, which also transform the copyrighted expression, but which are one of the exclusive rights granted to the copyright holder. *See, e.g.*, R. Anthony Reese, *Transformativeness and the Derivative Work Right*, 31 COLUM. J.L. & ARTS 467, 471–72 (2008).

[83] 4 Melville B. Nimmer & David Nimmer, Nimmer on Copyright § 13.05 n. 85.2 (2013).

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

"new" is added must relate back to the borrowed work and provide some degree of commentary on that work. This suggests, at the very least, a change in emphasis from the *locus classicus* of transformative use, Judge Leval's article, in which the transformative concept is not so backward-looking:

> If, on the other hand, the secondary use adds value to the original—if the quoted matter is used as raw material, transformed in the creation of new information, new aesthetics, new insights and understandings—this is the very type of activity that the fair use doctrine intends to protect for the enrichment of society.[85]

In this formulation, at least, as long as the borrowed work is materially altered and the new work adds some additional artistic or intellectual value beyond that of the original, the criteria of transformative use are met.

B. Transformation as Creative Metamorphosis

A number of important fair-use cases have applied a more straightforward definition of transformative use than the new-insights model provides. This alternative approach simply involves sufficient aesthetic alteration of the original work, without requiring new insights directed toward the borrowed work. These cases[86] simply ask that the new work perform some unspecified degree of "creative metamorphosis"[87] to the original work.

In *Prince*, for example, the Second Circuit analyzed the fair-use claims of appropriation artist Richard Prince in an infringement suit by photographer Patrick Cariou.[88] Cariou's work, *Yes Rasta*, was a book of landscape and portrait photos involving Rastafarians in Jamaica. Cariou testified the photos were "'extreme classical photography and portraiture,'

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[85] Leval, *supra* note 15, at 1111.

[86] In addition to the cases discussed in the text, see, e.g., Blanch v. Koons, 467 F.3d 244, 253 (2d Cir. 2006) (focusing, in a case involving appropriation artist Jeff Koons' use of a fashion photograph called "Silk Stockings," on both on creative metamorphosis and change in purpose: "[T]he use of a fashion photograph created for publication in a glossy American 'lifestyles' magazine—with changes of its colors, the background against which it is portrayed, the medium, the size of the objects pictured, the objects' details and, crucially, their entirely different purpose and meaning—as part of a massive painting commissioned for exhibition in a German art-gallery space . . . was transformative."); L.A. News Service v. CBS Broad. Inc., 2002 U.S. App. LEXIS 26206 at *33 (finding the use of video footage of L.A. riots in the opening montage of a television show transformative due to its creative aspects and a change in purpose).

[87] Princeton Univ. Press v. Michigan Document Servs., Inc., 99 F.3d 1381, 1389 (6th Cir. 1996).

[88] *Prince*, 714 F.3d at 705–712.

and that he did not 'want that book to look pop culture at all.'"[89] Prince's *Canal Zone* collage took thirty-five photographs from *Yes Rasta* and attached them to plywood. Prince then "altered the photographs significantly, by among other things painting 'lozenges' over their subjects' facial features and using only portions of the some of the images."[90] Prince later created thirty additional works that included Cariou's images in whole or in part.[91] In some of Prince's works, the photos are obscured, tinted, or otherwise altered.[92] Prince's works dwarfed the size of Cariou's photos—as the court put it, "the smallest of the Prince artworks measures 40" x 30", or approximately ten times as large as each page of *Yes Rasta*."[93]

The Second Circuit made short work of the new-insights model, rejecting the district court's requirement that the borrowing work comment on or critically refer to the borrowed work. As the Second Circuit stated:

> The law imposes no requirement that a work comment on the original or its author in order to be considered transformative, and a secondary work may constitute a fair use even if it serves some purpose other than those (criticism, comment, new reporting, teaching, scholarship, and research) identified in the preamble to the statute.[94]

All that *Campbell* required, the *Prince* court reasoned, was that a transformative user alter the original with "new expression, meaning, or message."[95]

In its analysis of Prince's works, the court determined, simply by examining each work, that all but five of the thirty pieces at issue were clearly transformative as a matter of law. The court held that those "twenty-five of Prince's artworks manifest an entirely different aesthetic from Cariou's photographs," because "[w]here Cariou's serene and deliberately composed portraits and landscape photographs depict the natural beauty of Rastafarians and their surrounding environs, Prince's crude and jarring works, on the other hand, are hectic and provocative."[96] The court also noted that the twenty-five works differed greatly from Cariou's photos in "composition, presentation, scale, color palette, and media . . . ."[97]

The Second Circuit majority furthermore downplayed the importance of Prince's testimony that he did not have a particular message

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[89] *Id.* at 699.
[90] *Id.*
[91] *Id.*
[92] *Id.*
[93] *Id.* at 700.
[94] *Id.* at 706.
[95] Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 579 (1994).
[96] *Prince*, 714 F.3d at 706.
[97] *Id.*

he wanted to convey with his work and that he had no interest in the intent behind the original photos. These considerations were not critical to transformative use. Instead, the court explained, transformative use was to be determined based on how a reasonable observer might respond to the works.[98] "Prince's work could be transformative without even commenting on Cariou's work or on culture," the court wrote, "and even without Prince's stated intention to do so."[99] In this case, the Second Circuit reasoned, twenty-five of the works were transformative because they clearly "have a different character, give Cariou's photographs a new expression, and employ new aesthetics with creative and communicative results distinct from Cariou's."[100]

The court held, however, that five of Prince's works involved a closer question on the issue of transformative use. Although these works had "minimal alterations" that "moved the work in a different direction from Cariou's classical portraiture and landscape photos,"[101] they nonetheless were sufficiently similar to the borrowed photos that the Second Circuit could not say with certainty that they offered enough new expression, meaning, or message to qualify as transformative.[102]

The court discussed several of the works in depth, noting artistic similarities and differences. For example, Prince's work *Charlie Company* "prominently displays four copies of Cariou's photograph of a Rastafarian riding a donkey, substantially unaltered, as well as two copies of a seated nude woman with lozenges covering all six faces."[103] It also featured a pastoral background that was not unlike Cariou's work. The court was unsure whether the differences between the works in this instance were sufficiently transformative.[104] As a result, the Second Circuit concluded that "the district court is best situated to determine, in the first instance, whether such relatively minimal alterations"[105] made the five borrowings transformative, and, ultimately, fair.

It is unclear precisely what metric of transformation was applied in *Prince*. The court could not seem to articulate a standard beyond a purely impressionistic sense of how much aesthetic change the court "felt" was sufficient to constitute transformation. Nor was it entirely clear why the district court might be "best situated" to make the ultimate determination. As noted earlier, Judge Wallace, in partial dissent, expressed skepticism

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[98] *Id.* at 707.
[99] *Id.* at 707.
[100] *Id.* at 707–08.
[101] *Id.* at 711.
[102] *Id.*
[103] *Id.*
[104] *Id.*
[105] *Id.*

about the majority's ability to draw principled distinctions between the twenty-five works it viewed as transformative and the five works it viewed as questionable.[106] Nor did Judge Wallace appear to believe a manageable standard had been articulated: "Certainly we are not merely to use our personal art views to make the new legal application to the facts of this case."[107] But Judge Wallace failed to propose a standard for determining whether a given use is transformative, and did not articulate what the district court should consider on remand.

The Second Circuit also disagreed with the district court's determination that Prince took too much of the original under the third fair-use factor (extent of the use). At this point in the opinion, the conflation of transformative use and parody that bedeviled Justice Souter's *Campbell* opinion added significant confusion. The Second Circuit stated that the district court's conclusion that Prince took more of the original photos than necessary was incorrect because "the law does not require that the secondary artist may take no more than is necessary,"[108] citing the portion of *Campbell* that dealt with factor three. However, that section of *Campbell* spoke specifically to the *parodist's* need to use enough of the original work to make clear to the audience what the target of the parody was.[109] It did not explicitly license larger takings for transformative works that were not critiquing or commenting on the original.

The Second Circuit quoted *Campbell* for the proposition that the borrower "'must be permitted to "conjure up" at least enough of the original' to fulfill its transformative purpose."[110] But the critical language from *Campbell* omitted by the Second Circuit's quotation from that case was that "*the parody* must be able to 'conjure up' at least enough of that original *to make the object of its critical wit recognizable*."[111] This language from *Campbell* was quite clearly aimed at parodists in particular, not transformative users in general. Moreover, under the creative-metamorphosis paradigm, how can one possibly determine how much of the original work is needed to "conjure [it] up" if the borrowing work has no necessary connection to the original and is not commenting on it? The question becomes nonsensical outside of the new-insights model. If the putative fair user is not somehow connecting his or her work to the original, there is no particular amount of the original work that would need to be used to conjure up anything.

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[106] *See supra* text accompanying notes 10–12.
[107] *Prince*, 714 F.3d at 714 (Wallace, J., concurring in part and dissenting in part).
[108] *Id.* at 710 (citing Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 588 (1994)).
[109] *Campbell*, 510 U.S. at 588.
[110] *Prince*, 714 F.3d at 710 (quoting *Campbell*, 510 U.S. at 588).
[111] *Campbell*, 510 U.S. at 588 (emphasis added).

Prince illustrates the serious difficulties with the creative-metamorphosis model, involving as it does complex judgments about literary and artistic works that may be beyond the aesthetic acumen of the average judge. Moreover, the paucity of guidance from *Campbell* requires that those judgments be made without any sort of rigorous framework to guide the decision.

Those same difficulties arise when the transformative-use doctrine is imported from copyright doctrine into right-of-publicity law. Right-of-publicity cases adapting *Campbell* largely follow the creative-metamorphosis model of transformativeness, beginning with the first case to apply transformative use to publicity law, the California Supreme Court's 2001 decision in *Comedy III Productions, Inc. v. Saderup*.[112] *Comedy III* involved a charcoal drawing reproduced on t-shirts of the legendary comedy team The Three Stooges. The licensing entity for the Stooges claimed that this use violated California's right-of-publicity statute. In order to balance the publicity right against the defendant's First Amendment rights, the California Supreme Court rejected the extant approaches to achieving that balance, instead ruling, for the first time, that the appropriate standard was the transformative-use test.[113]

The California Supreme Court held that, when a right-of-publicity defendant simply crafts some sort of accurate and unembroidered depiction

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[112] 21 P.3d 797 (Cal. 2001). Numerous arguments have been made that the transformative-use doctrine is a bad fit for publicity law because the publicity tort differs in important ways from copyright protection. While the focus of this work is on the application of the doctrine, rather than its ultimate justification, it seems clear that those arguments carry significant weight.

One objection has been that publicity rights do not provide the same sort of incentive to the creation of a public persona that copyright does to the creation of artistic and literary works. *See, e.g.*, Cardtoons, L.C. V. Major League Baseball Players Ass'n, 95 F.3d 959, 974 (10th Cir. 1996); Diane Leenheer Zimmerman, *Fitting Publicity Rights into Intellectual Property and Free Speech Theory: Sam, You Made the Pants Too Long!*, 10 DEPAUL-LCA J. ART & ENT. 283, 306 (2000) ("[N]ot a shred of empirical data exists to show that anyone would change her behavior with regard to her primary activity—that is, that a person would invest less energy and talent in becoming a sports star or entertainer or great civic figure—if she knew in advance that, after achieving fame, she would be unable to capture licensing fees from putting her face on sweatshirts or coffee mugs.").

Another objection is that the law should not encourage the production of celebrity personae the way copyright doctrine encourages the creation of copyrighted works. *See* Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161, 1163 (2006) ("[S]ociety doesn't need to encourage more celebrities or more marketing of celebrity image.").

[113] *Comedy III*, 21 P.3d at 808.

of the plaintiff, whether in words, images, or some other form of expression, First Amendment interests are outweighed by the policy of protecting the plaintiff's persona.[114] But when the defendant adds transformative expressive elements, the free-expression interest becomes stronger.[115] Moreover, the transformed persona is "less likely to interfere with the economic interest protected by the right of publicity."[116] Thus, the First Amendment test based on transformative use asks whether the celebrity's persona is merely one of the "raw materials" in the ultimate depiction or is the "sum and substance of the work in question."[117] This is, of course, the creative-metamorphosis model in a nutshell. Ultimately, the California Supreme Court found an absence of transformation in Saderup's depiction of The Three Stooges, because it was a straightforward, literal visual portrayal of the comedy team.[118]

There are two important points from *Comedy III*. First, once the transformative-use test is transplanted into the alien soil of right-of-publicity law, the creative-metamorphosis model is almost obligatory since there is no original "work" with which to compare the borrowed expression, as in a copyright action.[119] Rather than a specific song, photograph, poem,

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[114] *Id*.
[115] *Id.*
[116] *Id.*
[117] *Id.* at 809.
[118] The California Supreme Court explicated the doctrine further in *Winter v. DC Comics*, 69 P.3d 473 (Cal. 2003). There, the court found a comic book reimagining of rock musicians Johnny and Edgar Winter as "Johnny and Edgar Autumn," two villainous half-human, half-worm characters, was indeed transformative. The state high court stated the transformative-use doctrine as follows: "An artist depicting a celebrity must contribute something more than a 'merely trivial' variation, [but must create] something recognizably 'his own,' in order to qualify for legal protection." *Id.* at 478. The court went on to conclude that not only were the Winters not depicted in a literal way, but that "plaintiffs are merely part of the raw materials from which the comic books were synthesized [and were contained in] a larger story, which is itself quite expressive." *Id.* at 479. The case thus adds the complicating factor, discussed later in the text, of how transformative the surrounding expressive materials are, separate from any transformation performed directly upon the celebrity persona itself.

Interestingly, even in *Winter*, a seemingly clear case of transformation, a lower appellate court had ruled that the issue was sufficiently uncertain to make it a jury question. As one commentator noted: "The mere fact that the court of appeals panel made this error illustrates the difficulties the indefiniteness of the transformative standard causes." Gloria Franke, Note, *The Right of Publicity vs. the First Amendment: Will One Test Ever Capture the Starring Role*?, 79 S. CAL. L. REV. 945, 973 (2006).
[119] *See, e.g.*, Brief of Amici Curiae The Organization for Transformative Works et al. at 15–16, Hart v. Elec. Arts, Inc., No. 11-3750 (3d Cir. 2012) ("[W]ith no

or other work, as in copyright, the "original" in publicity law is an amorphous entity known as the celebrity's persona, which can include references to the person's name, likeness, voice, or other identifying characteristics.[120] This distinction between copyright and publicity law makes the new-insights model a much more challenging fit, although certainly not impossible. Second, *Comedy III* did not import the whole of the fair-use analysis into right-of-publicity doctrine, but only the transformative-use test. The California Supreme Court provided scant conceptual justification for plucking a single element from the multi-part fair-use test and elevating it to such a critical role in the First Amendment status of speech that may infringe publicity rights. Nonetheless, in the *Comedy III* model, transformativeness is the sole and exclusive route to vindication of a defendant's First Amendment rights.

If transformative use is, rightly or wrongly, a dominant consideration in current copyright fair-use doctrine, it is the *only* consideration in publicity cases that follow the *Comedy III* approach. This makes the imprecision of the test particularly disturbing. *Comedy III*'s progeny show clear evidence of being infected by this legal imprecision.

Consider, for example, the 2013 split decision by the Third Circuit in *Hart v. Electronic Arts, Inc.*,[121] a right-of-publicity case brought by former Rutgers quarterback Ryan Hart. Hart sued Electronic Arts ("EA") for unauthorized use of his persona[122] in the company's successful *NCAA Football* video game. The game includes "digital avatars" of real college players "that resemble their real-life counterparts and share their vital and biographical information."[123] EA also promoted the game using actual film footage of the real Hart throwing a pass in a bowl game against Arizona State.[124]

After rejecting various techniques of balancing First Amendment interests against the right of publicity, the Third Circuit adopted the transformative-use test as its guiding framework. The court declined to

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original work to measure against the defendant's work, the only metric of 'transformation' comes from what the court thinks is artistic, or not, about the defendant's speech.").

[120] J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY 4.9–4.15 (2d ed. 2000).

[121] 717 F.3d 141 (3d Cir. 2013).

[122] Since the right of publicity is a matter of state law, the Third Circuit applied New Jersey law in this case, which had been removed from New Jersey state court by Electronic Arts. Although it exists in statutory form in some states such as California, the right of publicity is recognized as a common-law right of action in New Jersey. *Id.* at 150–52.

[123] *Id.* at 146.

[124] *Id.* at 147.

adopt the "Predominant Use Test" used by the Missouri Supreme Court in *Doe v. TCI Cablevision*.[125] This test asks whether the use of the plaintiff's persona primarily exploits the commercial value of that persona or primarily makes an expressive use of the individual's identity.[126] The Third Circuit opined that "the Predominant Use Test is subjective at best, arbitrary at worst, and in either case calls upon judges to act as both impartial jurists and discerning art critics. These two roles cannot co-exist."[127] The irony, of course, is that much the same could be said about the transformative-use doctrine the court chose to apply instead.

In applying the transformative-use test to the facts of *Hart*, the Third Circuit considered both the use of Hart's likeness and his biographical information in the video game. The court noted that Hart's digital avatar "closely resembles the genuine article. Not only does the digital avatar match Appellant in terms of hair color, hair style and skin tone, but the avatar's accessories mimic those worn by Appellant during his time as a Rutger's player."[128] The court found that Hart's biographical and statistical information in the game was likewise an accurate representation of reality.[129] Moreover, the digital avatar did exactly what the real Hart did in his heyday—played college football in a digitized stadium that recreated the atmosphere of a college football game. "This is not transformative," the court wrote. "[T]he various digitized sights and sounds in the video game do not alter or transform the Appellant's identity in a significant way."[130]

The Third Circuit also rejected the notion that a game feature that allowed users to alter the avatar's appearance created any legally significant transformation.[131] The court was convinced that a major part of the game's appeal was its realism, and thus that EA was capitalizing on the identities of the real players.[132] The avatar that closely resembled the player was the default setting, and the mere fact that a consumer could alter the image was insufficiently transformative.[133]

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[125] 110 S.W.3d 363 (Mo. 2003).
[126] *Hart*, 717 F.3d at 154.
[127] *Id*.
[128] *Id.* at 166.
[129] *Id.*
[130] *Id.*
[131] *Id.* at 167–68.
[132] *Id.* at 168.
[133] *Id.* ("That Appellant's likeness is the default position only serves to support our conclusion that realistic depictions of the players are the 'sum and substance' of these digital facsimiles . . . [W]e are disinclined to credit users' ability to alter the digital avatars in our application of the Transformative Use Test to this case . . . .") (citing Kirby v. Sega of Am., Inc., 50 Cal.Rptr.3d 607 , 617–18 (Cal. Ct. App. 2006)).

Nor was the court convinced by EA's argument that "*other* creative elements of NCAA Football, which do not affect Appellant's digital avatar, are so numerous that the videogames should be considered transformative."[134] The various sights and sounds that went into the game itself were thus not appropriate considerations. The focus, the court reasoned, should be on how the celebrity persona itself is used, not on additional creative elements that frame the persona but do not directly act upon or alter the celebrity identity.[135] The court held that creative elements of the work that do not directly affect the celebrity identity are without legal significance.[136]

Judge Thomas L. Ambro, in dissent, took strong exception to the position that other expressive elements in the game carried no weight in the transformativeness inquiry. He quoted *Comedy III* for the proposition that the celebrity likeness must be considered within the totality of the work in question, whether it "is one of the 'raw materials' from which *an original work* is synthesized, or whether the depiction or imitation of the celebrity is the very sum and substance of *the work in question*."[137]

Judge Ambro noted that the *Hart* majority analyzed only changes to the digital avatar itself, rather than how that likeness fit into the entirety of the highly creative work that was the video game: "To me, a narrow focus on an individual's likeness, rather than how the likeness is incorporated into and transformed by the work as a whole, is a flawed formulation of the transformative inquiry."[138] Ambro also noted that the insertion of real individuals into novels, films, and other media is generally protected under publicity law, and that his reading of the transformative-use test would better harmonize with broader First Amendment doctrine as applied to publicity cases.[139]

The conflict between the *Hart* majority and Judge Ambro is not a new phenomenon for courts attempting to apply the creative-metamorphosis model of the transformative test. One scholar has referred to this division as the "fused" versus "intact" problem.[140] Courts sometimes seem to have difficulty deciding whether to focus on the totality of the work into the

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[134] *Id.* at 169.
[135] *Id.*
[136] *Id.*
[137] 21 P.3d at 809 (emphasis added).
[138] *Hart*, 717 F.3d at 173 (Ambro, J., dissenting). An eerily similar 2–1 split on the transformativeness issue occurred in another EA faceoff with a college player in the Ninth Circuit, decided just two months after *Hart*. Keller v. Elec. Arts, Inc., 724 F.3d 1268 (9th Cir. 2013).
[139] *Id.*
[140] Matthew D. Bunker, *Transforming the News: Copyright and Fair Use in News-Related Contexts*, 52 J. COPYRIGHT SOC'Y 309, 325–26 (2005).

which the borrowed material (whether expression or persona) has been "fused," creating an entirely new, conceptually indivisible work, or on the individual borrowed material standing alone ("intact"), even if that borrowed material is surrounded by new expressive work. Courts seem to differ on the exact site of any necessary transformation—must the individual, borrowed portion be transformed, or is it enough that the borrowed material is fused into a larger expressive whole that is itself transformative?

This is precisely the conflict at the heart of the transformative-use determination in Tiger Woods's right-of-publicity case, *ETW Corp. v. Jireh Publishing, Inc*., decided by the Sixth Circuit in 2003.[141] The work there was a sports painting by artist Rick Rush, "The Masters of Augusta," commemorating Woods's victory in the 1997 Masters golf tournament. Woods's triumph was notable both for the huge, twelve-stroke margin of victory and for Woods's win given the racially charged history of the event.[142] The painting portrayed three different images of Woods marching toward victory, as well as images of former champions, including Jack Nicklaus, Arnold Palmer and Bobby Jones.

A majority of the Sixth Circuit panel found the work was transformative, despite the fact that the images of Woods himself were simply accurate depictions of the golfer. The majority pointed out that the painting contained "a collage of images in addition to Woods's image which are combined to describe, in artistic form, a historic event in sports history and to convey a message about the significance of Woods's achievement . . . ."[143] These transformative elements, the court stated, entitled the work to First Amendment protection. This reasoning illustrates the classic "fused" view of the borrowed image (Woods's likeness) becoming a conceptually inseparable element within a larger, transformative work.

However, Judge Eric L. Clay, in dissent, focused much more on the "intact" image of Woods standing alone. Judge Clay found it "difficult to discern any appreciable transformative or creative contribution"[144] in the Rush painting. He further reasoned that:

> Indeed, the rendition done by Rush is nearly identical to that in the poster distributed by Nike. Although the face and partial body images of other famous golfers appear in blue sketch blending in the background of Rush's print, the clear focus of the work is Woods in

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[141] 332 F.3d 915 (6th Cir. 2003).
[142] *Id*. at 918.
[143] *Id*. at 938.
[144] *Id*. at 959 (Clay, J., dissenting).

> full body image, wearing his red shirt and holding his famous swing in the pose which is nearly identical to that depicted in the Nike poster.[145]

Judge Clay thus concluded that the depiction was simply a literal one, comparable to the image of The Three Stooges in *Comedy III*.[146] The majority and dissenting judges in this case, like those in *Hart*, clearly have very different conceptions of transformativeness. Even though the judges in both cases seem to be operating largely out of the creative-metamorphosis paradigm,[147] they perceive very different qualities when analyzing the exact same works.[148] This kind of impressionistic, rudderless inquiry poses grave dangers to free expression by chilling artists' creativity: If the law leaves speakers unclear about the limits of permissible expression, then speakers tend to self-censor.

C. Transformation as New Purpose

Can an unaltered image—one physically mirroring the original and devoid of any new elements or changes other than, perhaps, being reduced in size or cropped slightly—be used in a transformative way that constitutes a fair use? Put more provocatively, can an image be transformed if it is not transformed? The answer to both these queries is yes, at least sometimes, and particularly when the secondary image is deployed for a very different purpose or function.

The seminal case in this "faux transformation"[149] strand of the transformative-use doctrine is the 2000 ruling by the U.S. Court of Appeals for the First Circuit in *Núñez v. Caribbean International News Corp.*[150] The appellate court faced the issue of whether a newspaper's republication of photographs without the permission of the copyright-holding photographer

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[145] *Id.*

[146] *Id.* at 959 (citing *Comedy III*, 21 P.3d at 809).

[147] One might argue that a hint of "new insights" creeps into the majority opinion in the Woods' case when the majority alludes to the painting evoking the historic nature of Tiger's victory.

[148] Courts are clearly all over the map on this issue. It is worth noting that the district court in the *Hart* case found EA's game to be transformative: "Viewed as a whole, there are sufficient elements of EA's own expression found in the game that justify the conclusion that its use of Hart's image is transformative and, therefore, entitled to First Amendment protection." Hart v. Elec. Arts, Inc., 808 F.Supp.2d 757, 784 (D. N.J. 2011). *Cf.* Keller v. Elec. Arts, Inc., 2010 U.S. Dist. LEXIS 10719 at *16–18 (N.D. Calif. 2010) ("Here, EA's depiction of Plaintiff in 'NCAA Football' is not sufficiently transformative to bar his California right of publicity claims as a matter of law. . . . this Court's focus must be on the depiction of Plaintiff in 'NCAA Football,' not the game's other elements.").

[149] Matthew D. Bunker, *The Song Remains the Same: Transformative Purpose Analysis in Fair Use Law*, 87 JOURNALISM & MASS COMMC'N Q. 170, 180 (2010).

[150] 235 F.3d 18 (1st Cir. 2000).

constituted a fair use because the photos were "independently newsworthy."[151] In particular, the photos depicted a beauty pageant winner named Joyce Giraud in various stages of undress and were originally taken as part of her modeling portfolio.[152] The images, however, were considered pornographic by some people, thus sparking a newsworthy controversy "over whether they were appropriate for a Miss Puerto Rico Universe."[153] Put differently, the photos were originally taken for one purpose—to serve as part of Giraud's modeling portfolio—but were republished by *El Vocero* for what the First Circuit characterized as the "informative function"[154] of calling into question whether Giraud should keep her crown.

In ruling in favor of the newspaper's right to publish the photos without the permission of photographer Sixto Núñez, the First Circuit found it important that the photos

> were originally intended to appear in modeling portfolios, not in the newspaper; the former use, not the latter, motivated the creation of the work. Thus, by using the photographs in conjunction with editorial commentary, El Vocero did not merely 'supersede[] the objects of the original creations,' but instead used the works for 'a further purpose,' giving them a new 'meaning, or message.' *It is this transformation of the works into news*—and not the mere newsworthiness of the works themselves—that weighs in favor of fair use.[155]

In brief, the photos initially were captured for one purpose, but served another when used in combination with surrounding textual material in the newspaper. The First Circuit added that "it would have been difficult to report the news without reproducing the photograph[s]."[156] *Núñez*, as the First Circuit reiterated in 2012, stands for the proposition that combining photos with editorial commentary may create a new use for the works.[157]

Professor Kathleen Olson bluntly calls this an "absurd conception of transformative use."[158] She asserts that the First Circuit "seemed to be saying the modeling photograph was actually transformed into a new thing—news—by its subsequent use."[159] According to Olson, *Kelly v.*

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[151] *Id.* at 20.
[152] *Id.* at 21.
[153] *Id.*
[154] *Id.* at 22.
[155] *Id.* at 23 (emphasis added) (citations omitted).
[156] *Id.*
[157] Soc'y Holy Transfiguration Monastery, Inc. v. Archbishop Gregory, 689 F.3d 29, 60 (1st Cir. 2012).
[158] Kathleen K. Olson, *Transforming Fair Use Online: The Ninth Circuit's Productive-Use Analysis of Visual Search Engines*, 14 COMM. L. & POL'Y 153, 167 (2009).
[159] *Id.*

Arriba Soft Corp.[160] (described below) and *Núñez* collectively stand for the rather simple proposition that "if the work is used for a different purpose from the original, it is transformative."[161] While Olsen believes the outcomes in these cases are desirable, she criticizes how far these courts have strayed from the basic concept of transformativeness introduced in *Campbell*.[162] In its application, of course, the end result is far more than a semantic quagmire over how something can be transformed if it is not literally transformed.

Kelly emphasized not only the different function served by the borrowing work, but the fact that the work was altered in a way that made it unsuitable for its original purpose. In *Kelly*, the Ninth Circuit held in 2002 that an Internet search engine called Arriba that displayed its results in the form of thumbnails (small images) rather than text did not violate the copyright of photographer Leslie Kelly, whose images were among those that appeared as thumbnails.[163] Kelly asserted that "because Arriba reproduced his exact images and added nothing to them, Arriba's use cannot be transformative,"[164] but the Ninth Circuit ruled "that Arriba's use of Kelly's images for its thumbnails was transformative."[165] In reaching this conclusion, the appellate court cited favorably the First Circuit's decision in *Núñez*[166] and reasoned that:

> Arriba's use of the images serves a different function than Kelly's use—improving access to information on the Internet versus artistic expression. Furthermore, it would be unlikely that anyone would use Arriba's thumbnails for illustrative or esthetic purposes because enlarging them sacrifices their clarity. Because Arriba's use is not superseding Kelly's use but, rather, has created a different purpose for the images, Arriba's use is transformative.[167]

A similar reasoning was followed in 2007, when the Ninth Circuit held in *Perfect 10, Inc. v. Amazon.com, Inc.*[168] that the Google search engine's use of thumbnail versions of copyrighted images owned by Perfect 10 was "highly transformative."[169] The appellate court reasoned that "[a]lthough an image may have been created originally to serve an entertainment, aesthetic, or informative function, a search engine transforms

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[160] 336 F.3d 811 (9th Cir. 2003).
[161] Olson, *supra* note 158, at 167.
[162] *Id.* at 174.
[163] *Kelly*, 336 F.3d at 815
[164] *Id.* at 818.
[165] *Id.*
[166] *Id.* at 819.
[167] *Id.* at 811.
[168] 508 F.3d 1146 (9th Cir. 2007).
[169] *Id.* at 1165.

the image into a pointer directing a user to a source of information."[170] For the Ninth Circuit, Google's use of these images in reduced form as thumbnails constituted "a new work, namely, an electronic reference tool. Indeed, a search engine may be more transformative than a parody because a search engine provides an entirely new use for the original work, while a parody typically has the same entertainment purpose as the original work."[171] The Ninth Circuit ultimately reiterated its earlier holding from *Kelly* that "even making an exact copy of a work may be transformative so long as the copy serves a different function than the original work."[172]

At this point, the precedential scope of the search-engine cases is less than clear. U.S. District Judge Denise Cote observed in 2013 in *Associated Press v. Meltwater U.S. Holdings, Inc.*[173] that both *Perfect 10* and *Kelly* involved the fair-use defense as it applies "to a search engine engaged in a transformative purpose"[174] and, specifically, to the use of small-size, low-resolution thumbnails that are not market substitutes for the original images.[175] The cases, however, may carry implications for other areas. As one legal commentator recently asserted:

> Although [*Kelly* and *Perfect 10*] extend only to the use of thumbnail images in an Internet-based search engine, it can be argued that the use of images in the classroom environment differs substantially from the original use of the images as a form of artistic expression. Such a use is therefore transformative and, like the Internet search engine, provides an important societal benefit, namely that of education.[176]

While the logic in *Kelly* and *Perfect 10* thus might be expanded to other areas where unaltered images are used, Professor Thomas Cotter contends that the problem with the courts' reasoning in those cases "is that it provides no basis for determining the level of abstraction at which the parties' purposes should be compared."[177] Cotter asserts that a thumbnail "may not serve the same immediate purpose as the original, but it may assist in serving the same ultimate purpose."[178] This distinction, Cotter argues,

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[170] *Id.*
[171] *Id.*
[172] *Id.*
[173] 931 F. Supp. 2d 537, 555 (S.D.N.Y. 2013).
[174] *Id.*
[175] *Id.* at 556.
[176] Caitlain Devereaux Lewis, *Copyright Concerns in Visual Resources Collections: Clarifying the Issues Surrounding the Use of Images in Education*, 23 DEPAUL J. ART TECH. & INTELL. PROP. L. 69, 89 (2012).
[177] Thomas F. Cotter, *Transformative Use and Cognizable Harm*, 12 VAND. J. ENT. & TECH. L. 701, 721 (2010).
[178] *Id.* at 721–22.

may affect "whether the 'harm' asserted by the copyright owner should be cognizable."[179]

Moreover, even identifying the purpose behind the creation of the original work as a baseline against which to measure the borrower's claimed change of purpose generates difficult questions. As Professor R. Anthony Reese once pointed out, there is no judicial consensus whether to consider the purpose the original author "actually had in mind when creating the work, or . . . the purpose that a reasonable author creating this type of work would have had in mind."[180] If the former, should courts allow potentially self-serving testimony from the plaintiff on this point? Professor Reese also noted that some authors may have multiple purposes in mind when creating certain works, or may even decide to use a work for an entirely different purpose after its creation.[181] These kinds of questions introduce tremendous complexity into what some courts have attempted to portray as a straightforward and undemanding inquiry.

Illustrating the difficulty in fathoming different purposes and disputing the notion that serving a different purpose can make the same content transformative, the U.S. Court of Appeals for the Second Circuit in *Infinity Broadcasting Corp. v. Kirkwood*[182] rejected claims by defendant Kirkwood that the unaltered retransmission of Infinity's copyrighted radio content on a different medium ("Dial-Up" phone lines) served transformative purposes. Kirkwood argued that subscribers used its service factual purposes, such as "auditioning on-air talent" or "verifying the broadcast of commercials," rather than the entertainment purposes of Infinity's over-the-air audience.[183] The Second Circuit emphasized that "difference in purpose is not quite the same thing as transformation"[184] and that "a change of format, though useful, is not technically a transformation."[185]

The appellate court in *Infinity Broadcasting* also suggested that an audience's different use of the same retransmitted content does not make it transformative. The defendant Kirkwood argued that his "users transform the broadcasts by using them for their factual, not entertainment, content."[186] The court rejected Kirkwood's reasoning, stating that "it is Kirkwood's own retransmission of the broadcasts, not the acts of his end-

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[179] *Id.*
[180] Reese, *supra* note 82, at 494.
[181] *Id.* at 494–95.
[182] 150 F.3d 104 (2d Cir. 1998).
[183] *Id.* at 106 (citation omitted).
[184] *Id.* at 108.
[185] *Id.* at 108 n.2.
[186] *Id.* at 108.

users, that is at issue here and all Kirkwood does is sell access to unaltered radio broadcasts."[187]

Is the *Núñez* different-purpose line of news cases limited narrowly to only instances where "the underlying photos are newsworthy in themselves"[188] or does it apply more broadly? The divided August 2012 opinion by the U.S. Court of Appeals for the Ninth Circuit in *Monge v. Maya Magazines, Inc*.[189] illustrates the ambiguity that today plagues this different-purpose news facet of the transformative-use doctrine.

In *Monge*, a three-judge panel considered whether a gossip magazine's unauthorized publication of stolen photos depicting a pop singer's previously private and secret wedding to her manager was a transformative use.[190] As used in the magazine, each of the photos "was reproduced essentially in its entirety; neither minor cropping nor the inclusion of headlines or captions transformed the copyrighted works."[191] Maya, the publisher of *TVNotas* magazine, nonetheless argued that even if the original wedding photos of Noelia Lorenzo Monge and Jorge Reynoso were not physically or creatively transformed, their publication in a magazine "as an exposé amounted to transformation" because it "transformed the photos from their original purpose—images of a wedding night—into newsworthy evidence of a clandestine marriage."[192]

Speaking broadly on the subject of transformative use, the majority initially noted that "transformation is a judicially-created consideration" in fair-use determinations.[193] Citing *Perfect 10* for the notion that using images in a new context for a different purpose "may be transformative,"[194] the two-judge Ninth Circuit majority conceded that the magazine's purpose in publishing the photos in order to expose the couple's clandestine wedding "was at odds with the couple's purpose of documenting their private nuptials." But the majority asserted that "an infringer's separate purpose, by itself, does not necessarily create new aesthetics or a new work"[195] amounting to a transformative use, and it distinguished *Perfect 10*.

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[187] *Id.*
[188] Daxton R. "Chip" Stewart, *Can I Use This Photo I Found on Facebook? Applying Copyright Law and Fair Use Analysis to Photographs on Social Networking Sites Republished for News Reporting Purposes*, 10 J. TELECOMM. & HIGH TECH. L. 93, 106 (2012).
[189] 688 F.3d 1164 (9th Cir. 2012).
[190] *Id.* at 1173–76.
[191] *Id.* at 1174.
[192] *Id.* at 1175.
[193] *Id.* at 1173.
[194] *Id.* at 1176.
[195] *Id.*

Specifically, it reasoned that "unlike the thumbnail images at issue in *Perfect 10*, Maya left the inherent character of the images unchanged."[196]

The *Monge* majority also distinguished the facts before it from those in *Núñez*:

> The controversy [in *Núñez*] was whether the salacious photos themselves were befitting a "Miss Universe Puerto Rico," and whether she should retain her title. In contrast, the controversy here has little to do with photos; instead, the photos here depict the couple's clandestine wedding. The photos were not even necessary to prove that controverted fact—the marriage certificate, which is a matter of public record, may have sufficed to inform the public that the couple kept their marriage a secret for two years.[197]

Put differently, the *Monge* majority found that the unaltered images in *Núñez* were themselves the story,[198] while in *Monge* the unaltered images were not at all necessary to tell the story, as a marriage certificate would have been a suitable substitute to prove the existence of the couple's wedding. This analysis comports with the opinion of Professors Mark Bartholomew and John Tehranian that "*necessity* also plays a powerful role in limiting the types of news-related uses that qualify as transformative for the purposes of the fair use analysis."[199] Ultimately, the majority in *Monge* concluded that the magazine's use of the wedding photos constituted "wholesale copying sprinkled with written commentary" that "was at best minimally transformative."[200]

In stark contrast, Judge Milan D. Smith, Jr., concluded in his dissent "that the fundamentally different purpose underlying Maya's publication of the photos constituted a transformative use."[201] Smith reasoned that "Maya's commentary, editing, and arrangement of the photos added to, and ultimately changed, the original character of the images by advancing them as the basis of an exposé. The extent of Maya's editing, commentary, and arrangement thus weighs in favor of a finding of transformativeness."[202]

Even more fundamentally, Judge Smith parted company with the majority on the weight that transformativeness itself should be given in fair use analyses. While the *Monge* majority had dubbed the question of transformativeness "far from being determinative" of fair use and "simply

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[196] *Id.*
[197] *Id.* at 1175.
[198] *Id.*
[199] Mark Bartholomew & John Tehranian, *An Intersystemic View of Intellectual Property and Free Speech*, 81 GEO. WASH. L. REV. 1, 18 (2013) (emphasis added).
[200] *Monge*, 688 F.3d at 1176.
[201] *Id.* at 1188 (Smith, J., dissenting).
[202] *Id.* at 1186.

one of the factors"[203] courts consider, Judge Smith ramped up its significance. "The transformative use analysis is *an integral question* under the first factor, and in fair use generally," Smith argued.[204] He added that "the more transformative the use, the less other factors, such as commerciality, weigh against a finding of fair use."[205] Smith's view comports with Professor Michael Murray's recent assertion that the transformative test "has become *the defining standard* for fair use"[206] and Professor R. Anthony Reese's observation that the "rise of transformativeness as an explicit, and *important*, aspect of fair use analysis."[207]

In *Monge*, Judge Smith emphasized that the magazine's "exposé served an entirely different purpose—indeed, a purpose contrary to the Couple's original intent to record and conceal their Las Vegas wedding."[208] This was particularly significant for Judge Smith because he noted that Judge Pierre Leval had asserted in his influential law journal article[209] that "[t]ransformative uses may include criticizing the quoted work, *exposing the character of the original author, proving a fact*, or summarizing an idea argued in order to defend or *rebut it*."[210] In this case, the publication of the photos: 1) exposed the character of the pop singer as conniving by wanting to keep her wedding a secret in order to protect her image of being a single singer with appeal to young people; 2) proved the fact she was married; and 3) and rebutted the notion that she was single.[211] As Judge Smith wrote, the magazine's "article constituted much more than a haphazard republication

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[203] *Id.* at 1175 n.8.
[204] *Monge*, 688 F.3d at 1185 (Smith, J., dissenting) (emphasis added).
[205] *Id.* at 1185.
[206] Michael D. Murray, *What is Transformative? An Explanatory Synthesis of the Convergence of Transformation and Predominant Purpose in Copyright Fair Use Law*, 11 CHI.-KENT J. INTELL. PROP. 260, 261 (2012) (emphasis added).
[207] R. Anthony Reese, *Transformativeness and the Derivative Work Right*, 31 COLUM. J.L. & ARTS 467, 468 (2008) (emphasis added).
[208] *Monge*, 688 F.3d at 1187. Some of the differences between the majority and the dissent highlight the lack of precision in "purpose" analysis in general. The majority perceives the purpose of the both the plaintiffs and the defendant as similar—the photos were used to commemorate the wedding. The dissent attributes a more specific purpose to the plaintiffs: maintaining a *private* record of the event. The borrower, on the other hand, used the photos to prove the deception of the plaintiffs. There appears to be no discernible metric for the level of specificity at which such purposes are framed, which has the effect of adding great uncertainty to the analysis.
[209] *See* Randall P. Bezanson & Joseph M. Miller, *Scholarship and Fair Use*, 33 COLUM. J.L. & ARTS 409, 439 (2010) (noting that "[t]he term 'transformative use' was first coined by Judge Pierre Leval in 1990").
[210] *Monge*, 688 F.3d at 1187 (quoting Leval, *supra* note 15, at 1111).
[211] *Id.*

of the Couple's photos. Framed around the Couple's refusals to confirm their marriage and to continue to represent Noelia as an 'unwed sex symbol,' Maya used the images as documentary evidence."[212]

The split decision in *Monge* is troubling not only because it illustrates the slipperiness and subjectivity of the transformative-use inquiry in cases where there has been no physical transformation of the images in question, but also because it demonstrates the vast power that judges wield over determining what is or is not newsworthy. Professor Amy Gajda asserts that *Monge* "has the potential to seriously impact future news decisions by journalists."[213] To the extent journalists face tremendous ambiguity in the determination of transformative use in news contexts, news organizations may be much less likely to risk infringement liability by publishing newsworthy material that may be subject to copyright claims.

Also in 2012, the U.S. Court of Appeals for the Sixth Circuit held that *Hustler* magazine's unauthorized publication of a copyrighted photo of a television news anchor in its "Hot News Babes" feature was not transformative.[214] The photo was taken at a wet t-shirt contest, and it previously appeared on a website called lenshead.com before it was taken down after the woman depicted in it, Catherine Bosley, purchased its copyright from photographer Gontran Durocher. Although citing *Perfect 10* for the proposition that "reprinting a photograph may not result in an automatic copyright violation,"[215] the Sixth Circuit reasoned that *Hustler* "did not add any creative message or meaning"[216] to Durocher's photograph and, instead, had "merely reprinted [the photo] in a different medium—a magazine rather than a website."[217] Inventively, counsel for *Hustler* argued that the magazine's "use was transformative because the original work was published on lenshead.com to depict the fact that Bosley participated in the wet t-shirt contest, whereas Defendant used the picture to 'illustrate its entertainment news story.'"[218] The Sixth Circuit rejected this argument, finding that *Hustler's* "use of the photograph was the same as Durocher's original use—to shock, arouse, and amuse"[219] and that it was reasonable to conclude that *Hustler* was "selling a picture, not a [news] story."[220] This last

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[212] *Id.* at 1186.
[213] Amy Gajda, *The Justices and News Judgment: The Supreme Court as News Editor*, 2012 BYU L. REV. 1759, 1789 (2012).
[214] Balsley v. LFP, Inc., 691 F.3d 747 (6th Cir. 2012), *cert. denied*, 133 S. Ct. 944 (2013).
[215] *Id.* at 759.
[216] *Id.*
[217] *Id.*
[218] *Id.*
[219] *Id.*
[220] *Id.*

salvo fired at *Hustler*, although perhaps amusing given the subject magazine's reputation as pornographic, nonetheless illustrates the danger for First Amendment press freedom when judges use the language of faux transformation to determine what is and is not a newsworthy purpose and, in turn, what speech is or is not protected.

One critical, factual difference between *Monge* and *Balsley* may be that the text directly relating to the unaltered photo in the latter case consisted of only a single paragraph.[221] Thus, whether an unaltered image is significantly transformed by surrounding textual material may be part quantitative (the amount of text used) and part qualitative (the overall story and the nexus between the photo and the story). It is unclear how much text accompanying a photo is either a sufficient or a necessary condition for holding that it serves a transformative use.

Ultimately, both the news story and thumbnail cases suggest that a secondary user's "exact replication of a copyrighted image"[222] may nonetheless be transformative when republished in a different context that serves a different purpose from the primary use.[223] Determining precisely how much surrounding context must exist, how different that context must be, and precisely how a different purpose is measured in order to be transformative remains troubling two decades after *Campbell*.[224]

CONCLUSION

Given the bewildering variety of models for transformation, it seems beyond argument that the doctrine is in a muddled state. Not only are

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[221] The text stated:

> This month's eye candy is Catherine Bosley from Cleveland's WOIO Channel 19. The anchorwoman not only looks good, but apparently also likes to party. Previously, while at WKBN in Youngstown, Ohio, she tendered her resignation after topless shots of the fetching blonde at a Florida wet T-shirt contest surfaced all over the Internet. Thanks to K.B. for an excellent submission.

Balsley, 691 F.3d at 759.

[222] Sarl Louis Feraud Int'l v. Viewfinder, Inc., 627 F. Supp. 2d 123, 28 (S.D.N.Y. 2008).

[223] *See* Sedgwick Claims Mgmt Servs., Inc. v. Delsman, 2009 U.S. Dist. LEXIS 61825, *15 (N.D. Cal. July 17, 2009), *aff'd*, 2011 U.S. App. LEXIS 5830 (9th Cir. Mar. 21, 2011) ("The question of fair use does not turn simply on whether the photographs themselves were unaltered. Rather, as the relevant jurisprudence makes clear, the salient inquiry is whether the use of the photos, *in the specific context used*, was transformative.").

[224] *Cf.* Bunker, *supra* note 149, at 177 (asserting that "precisely what the criteria of transformative purpose are and how they should be applied to future cases seem murky").

the multiple models of transformativeness incompatible, but judges applying the same paradigm are frequently examining very different elements in borrowed works to make the determination. Professor Paul Goldstein called the transformative-use doctrine, at least in certain applications, "a triumph of mindless sound bite over principled analysis."[225] Another noted IP scholar put it this way: "At the end of the day, characterizing a use as transformative may be nothing more than a conclusion based on some unconscious, inarticulable balancing of social costs and benefits."[226]

As noted earlier, this incoherence tends to create a disturbing First Amendment chilling effect. As the Supreme Court remarked recently: "Vague laws force potential speakers to 'steer far wider of the unlawful zone' . . . than if the boundaries of the forbidden areas were clearly marked."[227] Given the transformative-use doctrine's primacy in copyright fair use, not to mention its stranglehold on First Amendment determinations in publicity cases following *Comedy III*, the confused state of the doctrine seems chilling indeed.

Obviously, the Supreme Court bears some responsibility for the current confusion, given the ambiguity of the *Campbell* formulation and the lack of guidance since. The *Campbell* Court seemed entranced with the notion of transformative use, but its explication of the concept left considerable room for interpretation, particularly as to how transformativeness applied outside of the parody context. However, to be fair to the Court, transformativeness was merely one ingredient in the mix in *Campbell*. It is only in the ensuing twenty years that transformative use has become nearly determinative in the overall fair-use calculus in copyright, and supremely important in publicity cases that hew to the *Comedy III* approach.

This Article has analyzed some of the ambiguity created by the transformative-use doctrine. Clearly, as a start, putative fair users need (and deserve) a clearer conceptual map of the terrain than courts have thus far provided. Normatively, it seems doubtful that the transformative-use doctrine, even if substantially clarified at the level of concept and application, should be called upon to do the majority of the work in these cases.

One suggestion is returning the doctrine to a more modest role in fair-use cases. Transformative use, which almost certainly should include

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[225] Paul Goldstein, *Fair Use in Context*, 31 COLUM. J.L. & ARTS 433, 442 (2008).
[226] Thomas Cotter, *Transformative Use and Cognizable Harm*, 12 VAND. J. ENT. & TECH. L. 701, 725 (2010).
[227] Brown v. Entm't Merchs. Ass'n, 131 S. Ct. 2729 (2011) (Alito, J. concurring) (quoting Baggett v. Bullitt, 377 U.S. 360, 372 (1964)).

uses that add new meaning or message even without referring to the borrowed work, could operate once again as the *Campbell* Court seemed to intend it, as an ameliorating device in cases of commercial borrowing, rather than as a meta-factor that seems to trump all other considerations. This sort of "transformative minimalism" seems more in keeping with the spirit of the statute rather than the bloated doctrine now dominating the scene post-*Campbell*.

Another alternative to jettisoning transformative use to the ash can of failed fair-use considerations is to limit its application to particular forms of copyrightable expression. In other words, should transformative use be applied equally to news, photographs, paintings, novels and songs, or might it be that it is more relevant to only some of these forms of expression? For instance, transformative use might constitute an appropriate form of inquiry—even be the driving factor—when the context is one of a written parody, as it was in *Campbell* with song lyrics, but not be applicable to visual imagery such as photographs (as in *Prince* in 2013). While most judges are presumably familiar with the written-narrative convention of parody and the social convention of jokes, due to their generally high level of education, they may not have a similar understanding of certain conventions of photography and visual artworks like those at issue in *Prince*. The less-recognized and more obtuse the convention of expression employed by the secondary user—the convention of visual appropriation art, for instance, in *Prince*—the less weight, if any, might be given to transformative use. This approach would seem to comport with the principle from *Campbell* that a parodic character must "reasonably be perceived."[228] Put differently, the perception of whether something constitutes a written parody may be more reasonably gleaned and more readily explained in a judicial opinion than the perception of whether image-based appropriation art is transformative. While the reasonable-perception criterion purports to add some objectivity to the transformative-use inquiry, much like the concept of reasonableness provides objectiveness in negligence cases,[229] reasonable judgments may be too difficult to make when the convention deployed by the secondary user that allegedly transforms the original is poorly understood.

The quest for an objective metric of transformative use thus might more readily lend itself to a conventional movie genre, like romantic comedies, with which judges would be reasonably familiar. This proved to

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[228] Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 582 (1994).

[229] *See* JULIE A. DAVIES ET AL., A TORTS ANTHOLOGY 43 (2d ed. 1999) (noting that "[t]he negligence concept provides for the imposition of liability for unreasonable risk criterion. Thus, the fundamental focus is on the concept of '*unreasonableness*,' determined usually by an objective standard of what a mythical reasonably prudent person would do . . . .").

be the case in July 2013 when U.S. District Judge Michael P. Mills held that the paraphrased use in Woody Allen's movie *Midnight in Paris* of a line from William Faulkner's *Requiem for a Nun* was transformative.[230] In rendering his decision, Judge Mills pointed to four specific and seemingly objective factors militating in favor of transformativeness – "[t]he speaker, time, place, and purpose of the quote in these two works."[231] Even the switching of the quote from one medium to another—from the printed word to the celluloid image—was an objective factor Judge Mills considered, calling it "relevant that the copyrighted work is a serious piece of literature lifted for use in a speaking part in a movie comedy, as opposed to a printed portion of a novel printed in a newspaper, or a song's melody sampled in another song. This transmogrification in medium tips this factor in favor of transformative, and thus, fair use."[232] It seems highly unlikely on remand in *Prince* that U.S. District Judge Deborah A. Batts will be able to point to such objective criteria in determining whether the remaining five images by Richard Prince are transformative enough to constitute a fair use of Patrick Cariou's photographs of Rastafarians.

Yet even in the well-recognized and understood convention of parody from which the transformative-use inquiry began two decades ago in *Campbell*, it runs the risk of boiling down to a highly subjective formula: If it's funny, it's transformative. Ultimately, as this Article has attempted to demonstrate, the transformative-use inquiry is far from a laughing matter for the law of copyright.

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[230] *See* Faulkner Literary Rights, LLC v. Sony Pictures Classics Inc., 2013 U.S. Dist. LEXIS 100625, *14–15 (N.D. Miss. July 18, 2013) (concluding that "[t]hese factors coupled with the miniscule amount borrowed tip the scales *in such heavy favor of transformative use* that it diminishes the significance of considerations such as commercial use that would tip to the detriment of fair use" (emphasis added)).

[231] *Id.* at *14.

[232] *Id.* at *45.