

TYPES NOT MAPPED YET May 23, 2023 | TTR not mapped yet | Michael L. Nepple

Sign o' the Times? Supreme Court decides Andy Warhol's Prince silkscreen is not a fair use

In a 7-2 decision, the Supreme Court found that an Andy Warhol silkscreen of the singer Prince, sourced from an original Lynn Goldsmith photograph, did not qualify for the Copyright Act's "fair use" defense because both the photograph and the silkscreen had the same use, which was to illustrate commercial magazine articles about the singer. "Fair use" is a defense to a claim of copyright infringement, allowing the public to use copyrighted materials in certain circumstances.

In 1981, Goldsmith took the original black and white Prince photo. She granted a limited license for the photo to be used as an artist's reference for a *Vanity Fair* article. In addition to the silkscreen Warhol created for the article, but unknown to Goldsmith at the time, Warhol also created a series of silkscreens and pencil drawings, all based on her photo. When, years later, Goldstein discovered Warhol's multiple works based on her photo, she sued because of one particular use of it - what the Court referred to as the "Orange Prince" work.

Goldsmith sought a licensing payment from Warhol's estate for the use of her photo. The estate sought a declaration that it did not infringe Goldsmith's copyright because its use was a fair use, and Goldsmith counterclaimed for copyright infringement.

At the Supreme Court, the Warhol estate argued that the Orange Prince work was "transformative" because it conveys "a different meaning or message" than the original photograph, including "a comment on celebrity," and thus qualified as a fair use. A subsequent artist's transformation of an original work is a key factor in the fair use analysis. We have previously written about the fair use defense [here](#) and [here](#).

In a 7-2 decision written by Justice Sotomayor, the Court limited its analysis to the first of the four statutory fair use factors: "the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes." This is the factor that often rests on consideration of whether the new work was sufficiently transformative of the original. "On that narrow issue," and "limited to the challenged use" - the Orange Prince silkscreen only - the Court determined the first fair use factor favored Goldsmith, not the Warhol estate.

The Warhol estate relied on the Court's 1994 *Campbell* decision, which determined that the band 2 Live Crew's version of Roy Orbison's *Pretty Woman* was a fair use because the Crew's song "easily conveyed a new meaning or message." The Court rejected that argument, stating that its prior ruling "cannot be read to mean" that the first fair use factor "weighs in favor of any use that adds some new expression, meaning, or message." Rather, *Campbell* requires a court look at transformativeness to decide whether the new use serves "a purpose distinct from the original."

The Court explained that the first factor relates to the problem of substitution - substitution being "copyright's bete noire" (that's French for "something that one particularly dislikes." I had to look it up). The Court cautioned that a new work used for the same or a highly similar purpose as the original is likely a substitution and thus not a fair use. The Court found that the first fair use factor favored Goldsmith because although the "Orange Prince" work was a new expression of the original photo, it was used for the same purpose - as a portrait of Prince, used to illustrate an article in a commercial magazine about the singer.

Moving forward, the Court's decision will require a close analysis of any claimed transformation, and whether that transformation serves a purpose different from that of the original work, or if it acts merely as a substitute.



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