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Locke Lord QuickStudy: A Fair Decision for Creativity? SCOTUS ?Finds No Fair Use in Warhol Prince Portrait

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On May 18, 2023, the United States Supreme Court held that the “purpose and character” of the Andy Warhol Foundation’s (“AWF”) use of Lynn Goldsmith’s portrait of Prince did not favor a determination of fair use.

The decision caps off a years-long copyright suit, which was initially filed in the Southern District of New York in 2017. Lynn Goldsmith, a professional photographer known for her portraits of rock musicians, licensed a photograph of Prince to Vanity Fair in 1984 to serve as reference for an Andy Warhol cover illustration. Unbeknownst to her, Warhol continued to use the image in the creation of fifteen other works, known collectively as the Prince Series.

After Prince’s death in 2016, Condé Nast contacted AWF to license Warhol’s original illustration for a special ‘In Memoriam’ publication, but AWF instead licensed a different work from the Prince Series entitled “Orange Prince.” When Goldsmith learned of the Prince Series, she contacted AWF about their alleged infringement and the Foundation sued for declaratory judgment of non-infringement based on fair use. The S.D.N.Y. granted AWF summary judgment, finding that three of the four fair use factors — including purpose and character of the use — favored AWF.

Goldsmith appealed to the Second Circuit, which reversed and remanded in 2021. The Appeals Court held that all four fair use factors favored Goldsmith. The Second Circuit was particularly concerned with the purpose and character of the use, and whether Warhol’s use of the photograph was sufficiently transformative. The Court ultimately held that, to qualify as transformative, the secondary use of an original work must serve a wholly “different and new artistic purpose,” which AWF failed to demonstrate. AWF filed a petition for certiorari and the Supreme Court heard arguments in October 2022.

The majority opinion, delivered by Justice Sotomayor, addressed the narrow issue of whether the purpose and character of AWF’s use of Goldsmith’s photograph favored AWF under the first fair use factor in connection with AWF’s commercial licensing of the Orange Prince. Ultimately, the Court agreed with the Second Circuit’s decision that it did not. Importantly, the Court expressly stated that it was not providing any opinion as to the creation, display, or sale of any of the original Prince Series works. Sotomayor’s majority opinion clashed with Justice Kagan, who wrote a contentious dissent arguing in defense of artistic expression.

The majority attempted to strike a balance between transformative use of existing artwork and original artists’ exclusive right to create derivative works. According to the Court, determination of the first factor (the purpose and character of the use) turns in part on the extent to which the use at issue has a fundamentally different artistic

purpose from the original, but transformation is not the end-all for the first factor. The Court held that the commercial (or non-commercial) character of the use must also be considered.

In the case at issue, the Court decided that Warhol's print and Goldsmith's black-and-white photograph shared the same purpose—both images were portraits of Prince licensed to magazines to illustrate articles about the artist. Furthermore, AWF's use of "Orange Prince" was commercial because it actively licensed the print for use in magazines. Having concluded that the print was not substantially transformative and that AWF used the image commercially for the same use as Goldsmith's original photograph, the Court ruled that the first factor did not favor fair use.

A key takeaway of the decision is that the artist's subjective, expressive intent — or the intent stated by others — is not singularly decisive in understanding the purpose of a use. Rather, the Court must look at the specific use to determine the purpose: Warhol was originally commissioned to create the Prince print as a magazine illustration for *Vanity Fair* using the original Goldsmith photograph, and AWF licensed "Orange Prince" to Condé Nast for the same purpose.

The decision is notable for its discussion of derivative works (defined in § 101 to include works that "recast, transform, or adapt" preexisting works) and transformative use, although the Court refused to draft a bright-line rule to distinguish between the two.

Justice Kagan expressed grave reservations about the majority's decision in her dissenting opinion. The majority, in her estimation, missed the mark on recognizing just how transformative Warhol's additions to Goldsmith's photograph were: Goldsmith had intended to portray Prince as a vulnerable person, but Warhol exploded that image to make a broader commentary on celebrity culture and commodification. Kagan went so far as to accuse the Court of subscribing to the "I could paint that" school of art criticism," treating the photograph as a fungible market substitute for the colorful silkscreen print and disregarding the artistry required to make transformative use. In a footnote response, Sotomayor called the dissent "a series of misstatements and exaggerations from [its] very first sentence."

Conclusion

Artists will have to carefully contemplate the purpose and character of the use of other works to remain on the right side of the line between a derivative work and a transformative one. Ultimately, the narrow nature of the ruling confirms that fair use determination will continue to be highly contextual and fact-specific inquiry.

The Supreme Court's opinion is captioned *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith et al.* No. 21-869 (May 18, 2023).

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