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Copyright's Lost Art of Substantial Similarity

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Copyright's Lost Art of Substantial Similarity

*Sandra M. Aistars**

ABSTRACT

Three copyright doctrines focus more than any others on the contributions of authors to visual artworks: originality, substantial similarity, and fair use. Questions regarding the aesthetics of works of authorship filter into judicial determinations under each of these doctrines. This Article comments on a trend among courts hearing visual arts cases to de-emphasize substantial similarity analyses and shift infringement determinations almost entirely to the fair use defense.

The trend has troubling procedural fairness consequences. Without a full evidentiary record about the artworks they encounter in infringement cases, courts' ability to properly evaluate whether the use of appropriated material in a second work is justified, or whether expression has been taken from the first work for some other (infringing) purpose, is compromised. If courts fail to properly understand works because they do not fully analyze basic infringement claims, it can also affect later users and owners of artworks.

Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith illustrates the conflicts appellate courts face when they are forced to analyze cases solely through the lens of fair use. This Article embraces Warhol's majority opinion but suggests that the dissent's concerns about judicial reluctance to engage with and understand creative works

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aesthetically are not entirely misplaced. Such engagement should happen earlier in the infringement inquiry, however—not merely as part of a fair use analysis. This Article expands the 2022 Meyer Lecture delivered by this Author shortly after oral arguments concluded in the Warhol litigation. It urges that to ensure the best outcomes for all artists, courts should apply a procedurally conscious approach to analyzing copyright infringement cases involving visual artworks. Specifically, district courts should establish a solid record that the first work is original; then inquire whether the second work infringes, applying the test for substantial similarity. Only if they find infringement should courts consider the affirmative defense of fair use.

Following the proper procedural path is crucial to balancing all parties' interests—particularly when the works of two artists are involved. Allowing both the first and the second artists equal voice in representing the originality of their contributions is necessary to ensure an adequate factual record in copyright litigation. Courts require this record to anticipate the impact of their rulings on future litigants and the art world at large. These goals are consistent with copyright jurisprudence, which encourages creativity and original contributions to the creative lexicon.

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I. INTRODUCTION

In May of 2022, Andy Warhol's *Shot Sage Blue Marilyn* became the most expensive twentieth century artwork ever auctioned, sold based on a bid of \$195 million.¹ Much like the artist's *Prince Series*, which was the subject of the Supreme Court case *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith, Shot Sage Blue Marilyn* uses a photograph as a reference work.² In this instance, the photograph is a publicity still of Marilyn Monroe from the film *Niagara*.³ The contemporary art market—a market that copyright law regulates—is a meaningful segment of the creative sector.⁴ Yet courts, including the Supreme Court in *Warhol Foundation*,⁵ often shy away from analyzing artworks in copyright infringement cases, preferring to

1. Robin Pogrebin, *Warhol's 'Marilyn,' at \$195 Million, Shatters Auction Record for an American Artist*, N.Y. TIMES (May 9, 2022), <https://www.nytimes.com/2022/05/09/arts/design/warhol-auction-marilyn-monroe.html?smid=em-share> [https://perma.cc/546G-PAJ9].

2. *Id.*

3. *Id.*

4. John Zarobell, *The Contemporary Art Market*, ARTS, June 30, 2021, at 1, <https://doi.org/10.3390/arts10030043> [https://perma.cc/C35Y-CWWS].

5. *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 143 S. Ct. 1258 (2023). The majority in *Warhol Foundation* determined that the first fair use factor in § 107(1) did not favor the Foundation because the specific use the Foundation was engaged in was licensing. *Id.* at 1261. This type of use may supersede or supplant the original, unlike those listed in the preamble to the section (criticism, comment, news reporting, education, scholarship, research), which tend to serve different purposes than the original. *Id.* at 1282–83. Because the litigants and the courts focused on fair use (which the court ruled is determined use by use, and user by user) rather than infringement or substantial similarity, there was no reason to examine whether Warhol's use of Goldsmith's work was itself infringing aesthetically different as the dissent urged. *See id.* at 1296–97 (Kagan, J., dissenting).

decide cases on grounds that will limit their need for aesthetic engagement.⁶

Three copyright doctrines focus more than any others on the contributions of authors to visual art works: originality, substantial similarity, and fair use.⁷ Questions regarding the aesthetics of works of authorship filter into determinations made under each of these doctrines.⁸ The order in which courts prioritize the tests and the diligence they apply to pursue them has procedural as well as policy effects on individual decisions and on the operation of the courts. When the author of an earlier work accuses a subsequent artist of misappropriating their original, courts should follow a specific analysis. Canonical copyright doctrine require a three-step inquiry to assess: (1) whether the first work is original; (2) whether the second work is substantially similar to the first because the second has wrongfully copied protectable expression from the first; and (3) if so, whether the use of the copied expression in the second work is nevertheless acceptable under the affirmative defense of fair use.⁹ Courts are increasingly turning to the affirmative defense of fair use to resolve infringement cases.¹⁰ At the same time, judges are dismissing or resolving infringement claims on motions to dismiss or for summary judgment—often before discovery has been concluded.¹¹ These factors

6. See, e.g., *id.* at 1272 (holding that the *Prince Series* was not fair use based on the fair use doctrine factors rather than the aesthetic differences between the original and derivative work).

7. See MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13D.02 (Matthew Bender ed., 4th vol. 2022) [hereinafter NIMMER].

8. See *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 59–60 (1884); see also *In re Trade-Mark Cases*, 100 U.S. 82, 94 (1879); *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 340–41 (1991).

9. See NIMMER, *supra* note 7, § 13D.02; *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 561 (1985) (describing fair use as an affirmative defense).

10. See NIMMER, *supra* note 7, § 13F.02. It is used to determine the legality of home video taping for time shifting, *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984), educational and corporate photocopying, *Cambridge Univ. Press v. Patton*, 769 F.3d 1232 (11th Cir. 2014), *Am. Geophysical Union v. Texaco Inc.*, 60 F.3d 913 (2d Cir. 1994), news reporting, *Fox News Network, LLC v. TVEyes, Inc.*, 883 F.3d 169 (2d Cir. 2018), parody and satire, *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994), uses of letters and film clips in biographies and documentaries, *Norse v. Henry Holt & Co.*, 991 F.2d 563 (9th Cir. 1993), fan and collector guides, *Warner Bros. Ent. Inc. v. RDR Books*, 575 F. Supp. 2d 513 (S.D.N.Y. 2008), digital sampling, *A&M Records v. Napster, Inc.*, 239 F.3d 1004 (9th Cir. 2001), decompilation and reverse engineering, *Sony Comput. Ent., Inc. v. Connectix Corp.*, 203 F.3d 596 (9th Cir. 2000), comparative advertising, *Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144 (4th Cir. 2012), and internet search engines, *Authors Guild v. Google, Inc.*, 804 F.3d 202 (2d Cir. 2015), *Authors Guild, Inc. v. HathiTrust*, 755 F.3d 87 (2d Cir. 2014).

11. See Daryl Lim, *Saving Substantial Similarity*, 73 FLA. L. REV. 591, 649 (2021) (performing empirical analysis on copyright pretrial motions); Clark D. Asay, *An Empirical Study*

combined suggest a trend of courts de-emphasizing the substantial similarity analysis and shifting the work of infringement decisions almost entirely to the fair use defense.¹² This trend is especially prominent in cases involving the visual arts and appropriation artists.¹³

This Article suggests that the trend has numerous procedural drawbacks for all concerned. When litigants and courts omit or de-emphasize the only explicitly comparative step in a three-step analysis, it leads to an incomplete evidentiary record of limited value to other courts and future litigants. Procedurally, it would appear that if a court skips the substantial similarity analysis, it relieves the complaining artist of the burden of proof to establish infringement.¹⁴ However, when courts and litigants shift the copyright analysis to a fair use framework, it also reorients the inquiry in ways that can limit record evidence and the original artist's ability to present a compelling case.¹⁵ In other situations, proceeding to a fair use framework too quickly privileges established art or venerated artists over emerging artists or art forms that challenge existing norms.¹⁶

Courts do not seem to understand visual artworks as intuitively as they do other works of authorship like literature.¹⁷ Therefore, an

of *Copyright's Substantial Similarity Test*, 13 U.C. IRVINE L. REV. 35, 64 (2022) (performing empirical analysis on copyright pretrial motions).

12. See, e.g., *Maxtone-Graham v. Burtchaeff*, 803 F.2d 1253 (2d Cir. 1986); *Authors Guild, Inc.*, 755 F.3d at 206–12.

13. See *infra* Section IV(A).

14. See NIMMER, *supra* note 7, § 13.03(a)(5).

15. See discussion *infra* Part IV; *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 43 (2d Cir. 2021), *aff'd*, 143 S. Ct. 1258 (2023).

16. See *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1272 (11th Cir. 2001); *Warhol Found.*, 11 F.4th at 43. *But see Cariou v. Prince*, 784 F. Supp. 2d 337, 344, 354–55 (S.D.N.Y. 2011), *rev'd in part*, 714 F.3d 694 (2d Cir. 2013).

17. See Amy Adler, *Fair Use and the Future of Art*, 91 N.Y.U. L. REV. 559, 586 (2016); Rebecca Tushnet, *Worth a Thousand Words: The Images of Copyright*, 125 HARV. L. REV. 683, 702 (2012); see also Amy Adler, *Artificial Authenticity: Art, NFTs, and the Death of Copyright*, 98 N.Y.U. L. REV. 706, 713 (2023); Asay, *supra* note 11, at 96; Jiarui Liu, *An Empirical Study of Transformative Use in Copyright Law*, 22 STAN. TECH. L. REV. 163, 176 (2019); Clark D. Asay, Arielle Sloan & Dean Sobczak, *Is Transformative Use Eating the World?*, 61 B.C. L. REV. 905, 961–62 (2020); Amy Adler, *Why Art Does Not Need Copyright*, 86 GEO. WASH. L. REV. 313, 331–32 (2018); Barton Beebe, Bleistein, *The Problem of Aesthetic Progress, and the Making of American Copyright Law*, 117 COLUM. L. REV. 319, 333 (2017); Brian Soucek, *Aesthetic Judgment in Law*, 69 ALA. L. REV. 381, 448–49 (2017); Robert Kirk Walker & Ben Depoorter, *Unavoidable Aesthetic Judgments in Copyright Law: A Community of Practice Standard*, 109 NW. U. L. REV. 343, 343 (2015); Eva E. Subotnik, *Originality Proxies: Toward a Theory of Copyright and Creativity*, 76 BROOK. L. REV. 1487, 1502 (2011); John Tehranian, *Dangerous Undertakings: Sacred Texts and Copyright's Myth of Aesthetic Neutrality*, in THE SAGE HANDBOOK OF INTELL. PROP. 418, 418 (Matthew David & Debora Halbert eds., 2014); Christine Haight Farley, *Judging Art*, 79 TUL. L.

additional challenge plagues art infringement cases more than other infringement cases. Courts may expressly seek to avoid aesthetic analysis in visual arts cases, erroneously relying on Justice Holmes's opinion in *Bleistein v. Donaldson Lithographing Co.* that "[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits."¹⁸ Yet, a close reading of the case shows that Justice Holmes did not counsel against conducting aesthetic inquiries about art.¹⁹ He warned only that judges should not inject their personal biases into copyright decisions about art.²⁰ In fact, the precedent on which Holmes relied, as well as other later foundational copyright cases, demonstrates that courts benefit from understanding the creative process and intellectual contributions of the artist. This understanding is helpful in distinguishing facts and ideas from protectable expressions, and in probing fair use questions.²¹

This Article proceeds as follows. Part II analyzes the *Warhol* case. Part III introduces the most important copyright doctrines necessary to assess visual art works: originality, substantial similarity, and fair use. Part IV demonstrates that questions about the aesthetic nature of authorial works filter into each of the doctrines previously introduced, and that courts can evaluate these questions by applying procedural and legal rules in a clear fashion. Courts should therefore take a transparent approach to assessing the objective facts about works and preserving them for the record to the best of their ability. Doing so is in the interest of procedural justice. Part V briefly describes how the key copyright doctrines should work together when a copyright infringement case is tried. This Part highlights the importance of conducting a threshold substantial similarity analysis to adequately assess facts about visual artworks. Part VI explains, by examining key appropriation art cases, why this approach produces better results procedurally as a policy matter. Part VII comments on the dynamic between the majority, concurring, and dissenting opinions in *Warhol Foundation* to explain why the case's decision advances procedural justice. Part VIII concludes.

REV. 805, 807 (2005); Robert A. Gorman, *Copyright Courts and Aesthetic Judgments: Abuse or Necessity?*, 25 COLUM. J.L. & Arts 1, 1–2 (2001).

18. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251–52 (1903).

19. *See* discussion *infra* Section III.A.

20. *See Bleistein*, 188 U.S. at 250–52.

21. *See* *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58–60 (1884); *see also In re Trade-Mark Cases*, 100 U.S. 82, 94 (1879); *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 340–41 (1991).

II. *ANDY WARHOL FOUNDATION FOR THE VISUAL ARTS, INC. v. GOLDSMITH: THE ILLUSTRATIVE CASE*

In 1984, *Vanity Fair* magazine licensed a reference photograph of the musician Prince from professional photographer Lynn Goldsmith.²² The magazine provided Warhol with the photograph and he created a series of sixteen works now known as the *Prince Series*.²³ One of those works, *Purple Prince*, appeared in the magazine as planned, and the rest remained unpublished.²⁴



FIGURE 1: LYNN GOLDSMITH PHOTO (THE “GOLDSMITH PHOTOGRAPH”) LICENSED BY *VANITY FAIR* FOR USE AS AN ARTIST REFERENCE TO CREATE ARTWORK FOR A MAGAZINE ARTICLE ABOUT THE MUSICIAN²⁵

22. Brief in Opposition at 5, *Warhol Found.*, 143 S. Ct. 1258 (No. 21-869); *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 382 F. Supp. 3d 312, 318 (S.D.N.Y. 2019), *rev'd*, 992 F.3d 99 (2d Cir. 2021), *aff'd*, 143 S. Ct. 1258 (2023).

23. *Id.* at 319.

24. See *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 32–34 (2d Cir. 2021), *aff'd*, 143 S. Ct. 1258 (2023).

25. Brief in Opposition at 5, *Warhol Found.*, 143 S. Ct. 1258 (No. 21-869).



FIGURE 2: THE *PRINCE SERIES*²⁶

Following Warhol's death in 1987, The Andy Warhol Foundation for the Visual Arts, Inc. (the Foundation) assumed the deceased artist's

26. Memorandum of Law in Support Motion by Defendants and Counterclaim Plaintiff Lynn Goldsmith and Lynn Goldsmith, Ltd. for Summary Judgment Pursuant to Rule 56 at 25–27, *Warhol Found.*, 382 F. Supp. 3d 312 (No. 17-cv-02532-JGK).

interest in the *Prince Series* copyrights.²⁷ After Prince's death in 2016, Condé Nast, *Vanity Fair's* parent company, licensed another image from the *Prince Series*, *Orange Prince*, for the cover of a commemorative magazine honoring the musician.²⁸ Ms. Goldsmith then became aware of the existence of the additional works in the *Prince Series* and contacted the Foundation, asserting copyrights in the works and seeking damages.²⁹ Ms. Goldsmith also registered the photograph originally licensed to *Vanity Fair* as an unpublished work with the Copyright Office.³⁰ The Foundation sued Goldsmith, seeking a declaratory judgment of noninfringement or, in the alternative, claiming fair use.³¹ Goldsmith countersued, alleging infringement.³²

The Foundation's complaint put the originality of both artists' works at issue.³³ It argued that although Warhol often used other artists' photographs, his own works were original and merely relied upon rather impersonal, preexisting publicity photographs, such as his famous works referencing Marilyn Monroe and Mao Zedong.³⁴ To demonstrate its argument, the Foundation proffered artist and expert narratives to help the court understand Warhol's signature portraiture method as original unto itself. Goldsmith's counterclaim focused on licensing matters.³⁵

The US District Court for the Southern District of New York granted summary judgment for the Foundation on fair use, asserting that it need not address the merits of the infringement claim because the Foundation's fair use arguments proved exceptionally compelling.³⁶ Two points are notable. First, the court focused on the use of the Goldsmith photograph from Warhol's perspective; it did not examine the Foundation's activities in licensing the work. Second, even when examining Warhol's use, the district court did not engage in a careful

27. *Warhol Found.*, 11 F.4th at 32–33.

28. *See id.* at 35.

29. *See* Complaint at 24, *Warhol Found.*, 382 F. Supp. 3d 312 (No. 17-cv-02532-JGK).

30. Answer of Defendants, Counterclaim of Lynn Goldsmith for Copyright Infringement and Jury Demand at 18, *Warhol Found.*, 382 F. Supp. 3d 312 (No. 17-cv-02532-JGK) [hereinafter Answer & Counterclaim].

31. Complaint, *supra* note 29, at 2.

32. *See* Answer & Counterclaim, *supra* note 30, at 10.

33. *See* Complaint, *supra* note 29, at 7.

34. *See id.* at 4–8.

35. *See* Answer & Counterclaim, *supra* note 30, at 13.

36. *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 382 F. Supp. 3d 312, 322–24, 331 (“AWF seeks a declaratory judgment declaring that none of the sixteen works in the Prince Series infringe the copyright of the Goldsmith Prince Photograph.”), *rev'd*, 992 F.3d 99 (2d Cir. 2021), *aff'd*, 143 S. Ct. 1258 (2023).

balancing of the four fair use factors enumerated in 17 U.S.C. § 107.³⁷ Instead the court conducted a visual comparison of the works side by side, finding Warhol's works "transformative" because they have a "different character," give Goldsmith's work "new expression," and employ "new aesthetics with creative and communicative results that are distinct from Goldsmith's."³⁸

Rather than opining on the purpose and character of the Foundation's commercial licensing use of *Orange Prince*, the district court commented that the works "can reasonably be perceived to have transformed Prince from a vulnerable, uncomfortable person to an iconic, larger than life figure."³⁹ As such, "each *Prince Series* work is immediately recognizable as a Warhol rather than as a photograph of Prince."⁴⁰ The court's language is more analogous to the "spontaneous and immediate"⁴¹ reaction expected from juries when comparing works for substantial similarity and is expressly contrary to the careful weighing of the four statutory factors required for a judicial ruling on a fair use defense.⁴²

The US Court of Appeals for the Second Circuit reversed and remanded.⁴³ On the purpose and character of the use under factor one, the Court of Appeals rejected the district court's broad notion that the addition of *any* new aesthetic or message to source material would be sufficient to "transform" it.⁴⁴ However, while conducting its fair use inquiry, the appellate court also compared the works side by side to probe the artist's subjective intentions in a manner akin to a substantial similarity comparison.⁴⁵ The court undertook this comparison instead of seeking justification from the Foundation for its challenged commercial licensing use of the appropriated material.⁴⁶ The Court of Appeals ultimately required proof that the second artist had created a work with a "fundamentally different and new' artistic

37. *Id.* at 325–26.

38. *Id.*

39. *Id.* at 326.

40. *Id.*

41. *Peel & Co. v. Rug Mkt.*, 238 F.3d 391, 398 (5th Cir. 2001).

42. *See Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 143 S. Ct. 1258, 1287 (2023) (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578 (1994)) ("The Court has cautioned that the four statutory fair use factors may not 'be treated in isolation, from one another. All are to be explored, and the results weighed together, in light of the purposes of copyright.'").

43. *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 54 (2d Cir. 2021), *aff'd*, 143 S. Ct. 1258 (2023).

44. *Id.* at 38–39.

45. *See id.* at 41–43.

46. *See id.*

purpose and character.”⁴⁷ Simply imposing another artist’s style on a work—as Warhol had done—did not satisfy the appellate court.⁴⁸

The court ruled against the Foundation because the Warhol works were created for the same overarching purpose and function as Goldsmith’s: they were visual artworks, and portraits of the same person.⁴⁹ The court did not find the works transformative simply because they were “immediately recognizable as Warhols” because to accept the lower court’s reasoning would have created a “celebrity plagiarist’s privilege.”⁵⁰ The Second Circuit found for Goldsmith on all four fair use factors and also belatedly ruled in her favor on substantial similarity.⁵¹ Notably, it neither remanded to the district court to document a proper record on infringement, nor corrected the district court’s incorrect perspective in reviewing the challenged use from Warhol’s perspective rather than the Foundation’s.⁵²

The Warhol Foundation appealed only on the court’s consideration of the first fair use factor.⁵³ Justice Sotomayor, writing for the majority, held that because the use shared substantially the same purpose as the “Goldsmith Photograph,” was of a commercial nature, and was not persuasively justified by the Foundation, the purpose and character of the use, including whether the use was of a commercial nature, weighed against the Foundation.⁵⁴ In a strongly worded dissent, Justice Kagan and Chief Justice Roberts questioned whether courts after *Warhol* would still be required to make a serious inquiry into the follow-on artist’s creative contributions, or whether any new expression a later artist adds would be dismissed as irrelevant simply because the second artist entered into a licensing transaction concerning the work.⁵⁵ Of note, both the district and the appellate courts as well as the dissenting Supreme Court Justices focused on Warhol’s use of the Goldsmith work, his intentions when creating the *Prince Series*, and the resulting character of the works.⁵⁶

47. *Id.* at 42.

48. *Id.*

49. *Id.*

50. *Id.* at 43.

51. *Id.* at 51; 54.

52. *Id.* at 54.

53. *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 143 S. Ct. 1258, 1272 (2023).

54. *Id.* at 1273.

55. *Id.* at 1301 (Kagan, J., dissenting).

56. *See Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 382 F. Supp. 3d 312, 326 (S.D.N.Y. 2019), *rev’d*, 992 F.3d 99 (2d Cir. 2021), *aff’d*, 143 S. Ct. 1258 (2023); *see also* Andy

By contrast, the Supreme Court majority opinion and concurrence direct courts to analyze the purpose and character of the *challenged* use—in this case, the Foundation’s licensing of *Orange Prince* for a magazine cover where it could potentially compete with Lynn Goldsmith’s own licensing opportunities for the unmodified image.⁵⁷ Although commentators have characterized this framing of the question as a limitation on the scope of the opinion,⁵⁸ as this Article explains, it is more properly understood as a procedural refocusing of the fair use inquiry. If courts accept this invitation to revive copyright’s lost art of substantial similarity analysis, this framing has the potential to unlock a more diverse account not only of fair use itself, but also of the doctrine’s interplay with the entire tapestry of copyright law.

III. DOCTRINES NECESSARY FOR COMPREHENDING COPYRIGHTED WORKS

A. *Originality*

The Constitution allows Congress to protect the “writings” of “authors.”⁵⁹ Congress has elected to do so by incorporating common law standards for originality into the Copyright Act without change.⁶⁰ According to the Supreme Court, copyright protection presupposes a requirement of originality that it has called the “*sine qua non*” of copyright.⁶¹

The locus of originality has always been the author’s imprint on the work. Two late nineteenth-century Supreme Court decisions explain the requirement for and framework of protections for visual artworks under the Constitution.⁶² In the *Trade-Mark Cases*, the Supreme Court distinguished copyrighted writings from trademarks.⁶³

Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 32 (2d Cir. 2021), *aff’d*, 143 S. Ct. 1258 (2023).

57. *Warhol Found.*, 143 S. Ct. at 1289 (Gorsuch, J., concurring).

58. *See, e.g.*, Corynne McSherry, Cara Gagliano & Katharine Trendacosta, *What the Supreme Court’s Decision in Warhol Means for Fair Use*, ELEC. FRONTIER FOUND. (May 23, 2023), <https://www.eff.org/deeplinks/2023/05/what-supreme-courts-decision-warhol-means-fair-use> [<https://perma.cc/SCM8-LXHM>].

59. U.S. CONST. art. I, § 8, cl. 8.

60. H.R. REP. NO. 94-1476, at 51 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5664 (“This standard does not include requirements of novelty, ingenuity, or aesthetic merit, and there is no intention to enlarge the standard of copyright protection to require them.”).

61. *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345–46 (1991).

62. *See In re Trade-Mark Cases*, 100 U.S. 82, 94 (1879); *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884).

63. *See* 100 U.S. at 93–94.

To be classified as a copyrightable writing of an author, a work must be “*original*, and . . . founded in the creative powers of the mind. The writings which are to be protected are *the fruits of intellectual labor*.”⁶⁴ In contrast, companies gain protection for their trademarks merely by adopting and using them in commerce.⁶⁵

A few years later, the Supreme Court further amplified the importance of the author’s imprint on a work when opining on the copyrightability of photographs. *Burrow-Giles v. Sarony* probed the tensions between authorship and technology use.⁶⁶ Sarony alleged that a lithographic company infringed his rights in a photograph of Oscar Wilde.⁶⁷ The case established that photographs with sufficient authorial expression can be protectable under copyright.⁶⁸ The defense argued that extending copyright protections to photographs was unconstitutional because photographs are neither “writings” nor the productions of “authors,” but are rather mere mechanical reproductions of the physical features of an object that involve no originality of thought.⁶⁹ The Supreme Court disagreed, finding that “the Constitution is broad enough to cover an act authorizing copyright of photographs, so far as they are representatives of original intellectual conceptions of the author.”⁷⁰ It noted, however, that “ordinary” photographs might not enjoy copyright protection.⁷¹

Photographer Sarony’s narrative of the process of creation convinced the Court that he was an author and that his photograph was an original intellectual conception worthy of protection.⁷² In the Court’s retelling, using words taken straight from Sarony’s brief, he “made” the photograph entirely from his own mental conception.⁷³ He gave this conception visible form by posing Oscar Wilde in front of the camera, selecting and arranging the costume, draperies, and other accessories in the photograph.⁷⁴ He also arranged the subject to present graceful outlines, modulated the light and shade to evoke the desired expression,

64. *Id.* at 94.

65. *Id.* at 94–95.

66. *See Burrow-Giles*, 111 U.S. at 57–58.

67. *Id.* at 54–55.

68. *See id.* at 54–55, 58.

69. *Id.* at 54, 59.

70. *Id.* at 58.

71. *Id.* at 59.

72. *See id.* at 55.

73. Terry Kogan, *The Enigma of Photography, Depiction, and Copyright Originality*, 25 *FORDHAM INTELL. PROP., MEDIA & ENT. L.J.* 869, 887–88 (2015).

74. *Burrow-Giles*, 111 U.S. at 60.

and “from such disposition, arrangement, or representation, made entirely by plaintiff, he produced the picture in suit.”⁷⁵

The court’s commentary on the “useful,” “harmonious,” and “graceful” nature of the picture,⁷⁶ and on the plaintiff’s work conducted “entirely from his own original mental conception,” contrasts markedly with the *Trade-Mark Cases*’s language explaining why trademarks are not original.⁷⁷ It was because the lower court took the time to understand how the artist made the artwork that the Supreme Court was equipped to elevate Sarony’s photograph of Wilde above “ordinary” photographs and deem it protectable under copyright.⁷⁸

Justice Oliver Wendell Holmes, Jr. built on *Sarony* when he ruled that circus posters are protectable as “pictorial illustrations or works connected with the fine arts” in *Bleistein v. Donaldson Lithographing Co.*⁷⁹ Courts use *Bleistein*, problematically, as an excuse to avoid apprehending artworks before them due to the famous “dangerous undertaking” quote:

It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme, some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge.⁸⁰

In truth, the case simply counsels judges not to inject their personal biases into copyright rulings.⁸¹ It thus establishes a minimalist approach to the originality requirement in US copyright law, recognizing commercial and other “low art” expression as copyrightable.⁸²

Justice Holmes ruled that a work is protectable if it manifests the author’s own perception of and reaction to the world.⁸³ At the same

75. *Id.*

76. *Id.* at 54.

77. *In re Trade-Mark Cases*, 100 U.S. 82, 94 (1879).

78. *See Burrow-Giles*, 111 U.S. at 60.

79. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251–52 (1903) (quoting Copyright Acts, ch. 301, § 3, 18 Stat. 78, 79 (1874) (current version at 54 Stat. 106)).

80. *Id.*

81. *See id.*

82. *See id.*

83. *See id.* at 250.

time, because the test is based on the author's personality, others are free to represent the same object or scene in their own authorial voice.⁸⁴

Under this personality-based test, whether the author depicted or "copied" objects from real life did not matter:

The copy is the personal reaction of an individual upon nature. Personality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible, which is one man's alone. That something he may copyright unless there is a restriction in the words of the act.⁸⁵

By basing originality decisions on an assessment of whether the artist has manifested personality in a work, Holmes gave judges a way to avoid the "dangerous undertaking" of injecting personal bias when evaluating originality.⁸⁶ Judges only need to decide whether a work is original, guided by their own aesthetic judgment in the "narrowest and most obvious" of cases.⁸⁷ It took almost a century for the Supreme Court to provide an example of such a case in *Feist Publications, Inc. v. Rural Telephone Service Co.*, where the Court focused on what constitutes creativity.⁸⁸ Citing the *Trade-Mark Cases*, the Court underscored that "originality requires independent creation plus a modicum of creativity"⁸⁹ and that copyright only protects writings that are "original, and are founded in the creative powers of the mind."⁹⁰ To prove infringement, one must show "copying of constituent elements of the work that are original."⁹¹

Accordingly, the Supreme Court did not afford protection to a factual compilation of telephone listings arranged in alphabetical order because it was "devoid of even the slightest trace of creativity."⁹² Rather than attempt to define creativity, the Supreme Court demonstrated what it meant by describing the rural phone directory at issue as "mechanical," "entirely typical," "garden-variety," "obvious," "basic

84. *See id.*

85. *Id.*

86. *See id.* at 251–52.

87. *Id.* at 251.

88. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 363 (1991). Ironically, where Holmes had taken the directory cases as a given, even using them as a foil for his assessment of originality in dicta in *Bleistein*, 188 U.S. at 249–50, *Feist* concerned rural telephone directories and found the particular arrangement of listings in alphabetical order not to be original. *Feist*, 499 U.S. at 363.

89. *Feist*, 499 U.S. at 346.

90. *Id.* (emphasis removed from "original").

91. *Id.* at 361 (citing *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 548 (1985)).

92. *Id.* at 362.

information,” and a “mere selection.”⁹³ Hence *Feist’s* additional gloss on *Bleistein* is that judges may make copyright decisions based on their qualitative evaluations of works in the “narrow category of [cases]” “in which the creative spark is utterly lacking.”⁹⁴

The *Feist* decision was arguably a response to the broad deference courts gave to *Bleistein’s* low originality standard.⁹⁵ The decision is frequently cited for its rejection of the “sweat of the brow” doctrine,⁹⁶ which allowed protection for directories and similar works as original works of authorship based on the labor authors invested in creating them.⁹⁷ *Feist* also provides a detailed analysis of the non-copyrightability of facts juxtaposed with the copyrightability of compilations.⁹⁸ It did not, however, overrule *Bleistein*.⁹⁹

Feist provides a bridge to the substantial similarity comparison of two works. To establish infringement, an author must prove that the accused infringer had access to his work and that the second artist’s work is substantially similar to the copyrightable expression in the author’s own copyrighted work.¹⁰⁰ The next Section examines the elements of and various tests for substantial similarity in greater detail. Here, it is sufficient to note that although the *Feist* Court was ostensibly comparing two works—one of which had extensively copied the other,

93. *Id.* Note that while here the Supreme Court lists a variety of descriptions of activity that it does not consider creative because it is “obvious,” in a different part of the decision the court explicitly describes the needed creative spark as sufficient no matter how “crude, humble or obvious.” *Id.* at 345 (quoting *NIMMER*, *supra* note 7, § 1.08(c)(1)). Scholars have also noted that because the court found it impractical or was not willing to objectively define creativity or to set a measurable standard for the level of creativity a work must achieve, the opinion “resorted to a form of name-calling” and used five different formulations of the “modicum of creativity” standard—all inherently ambiguous and imprecise. *See, e.g.*, Russ VerSteeg, *Rethinking Originality*, 34 WM. & MARY L. REV. 801, 823 (1993). While *Feist’s* holding that the white page listings were facts and compiling them in alphabetic order was not creative was relatively straightforward, line drawing in cases affording protections to original methods of selection, coordination and compilation of works or organization of information that is not purely factual is less so. *See id.* at 821, 857–58.

94. *Feist*, 499 U.S. at 359; accord Justin Hughes, *Restating Copyright Law’s Originality Requirement*, 44 COLUM. J.L. & ARTS 383, 391 (2021).

95. *See* Howard B. Abrams, *Originality and Creativity in Copyright Law*, 55 LAW & CONTEMP. PROBS., 2, 7 (1992).

96. *See, e.g.*, *CCC Info. Servs., Inc. v. MacLean Hunter Mkt. Reps., Inc.*, 44 F.3d 61, 65 (2d Cir. 1994); *Charter Sch. Cap., Inc. v. Charter Asset Mgmt. Fund, L.P.*, 768 F. App’x 776, 778 (9th Cir. 2019) (citing *Feist*, 499 U.S. at 352–56).

97. *CCC Info Servs. Inc.*, 44 F.3d at 65.

98. *See, e.g.*, *Keeling v. Hars*, 809 F.3d 43, 50–51 (2d Cir. 2015).

99. *Feist*, 499 U.S. at 359.

100. *E.g.*, *Arica Inst. v. Palmer*, 970 F.2d 1067, 1072 (2d Cir. 1992); *Wickham v. Knoxville Int’l Energy Exposition, Inc.*, 739 F.2d 1094, 1097 (6th Cir. 1984).

including by reproducing fictitious listings—the Court’s focus was on originality as a prerequisite to considering substantial similarity of the works.¹⁰¹ Consequently, courts should read the case as a sharpening of the focus in various elements of the substantial similarity test on whether copying by the second artist or work is of elements that manifest originality.¹⁰²

Feist’s reliance on and failure to overrule *Bleistein*¹⁰³ suggest that courts in visual arts cases should parse aspects of originality by paying greater attention to how (or whether) artists manifest their personalities in works.¹⁰⁴ This includes probing the myriad intellectual and creative contributions artists make, like understanding the difference between an unprotected idea or fact and its protected expression.¹⁰⁵ Such assessments may be required to assess initial copyrightability of a work as well as to make substantial similarity comparisons of works. The information may likewise be important when determining whether a use is justified as a transformative use. In such cases, a court must examine a second author’s challenged use and the second author must offer an appropriate justification for each use on its own terms under factor one.

B. Substantial Similarity

If a work’s originality rests on recognizing that the author imbues a work with her unique personality, then the task for a court ruling on infringement is to render a decision that correctly assesses whether the works are sufficiently similar to constitute actionable infringement. Substantial similarity is “one of the most difficult questions in copyright law” and “the least susceptible of helpful generalizations.”¹⁰⁶ Congress has never passed legislation on this issue, and the Supreme Court has never ruled on it. Thus, all case law

101. See *Feist*, 499 U.S. at 344, 361.

102. See NIMMER, *supra* note 7, § 13.03(B)(2)(b). In *Feist*, “Notwithstanding the validity of the copyright in plaintiff’s work as a whole, notwithstanding defendant’s exact copying from plaintiff’s work—even to the extent that defendant reproduced some fictitious listings composed by plaintiff to detect copying—and notwithstanding the decision by both lower courts in plaintiff’s favor, a unanimous Supreme Court held defendant’s conduct noninfringing as a matter of law, given that the constituent elements that defendant appropriated were not themselves original.” *Id.* § 13.03(E)(1)(b). The constituent elements copied were facts, which are not copyrightable. *Id.* § 13.03(E)(1)(b) n.202.6.

103. *Feist*, 499 U.S. at 359.

104. See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 249–50 (1903).

105. See discussion *infra* Part V.

106. NIMMER, *supra* note 7, § 13.03(A).

providing guidance on substantial similarity comes from a line of lower court decisions harkening back to the nineteenth century which established the substantial similarity test and fair use doctrine.¹⁰⁷

The tests reflect that copying alone is insufficient to establish infringement, but each test evaluates this principle differently.¹⁰⁸ As the tests emerged, courts focused on three discrete issues: (1) whether the alleged infringer used the first work, or created the accused work independently (“actual copying”); (2) if the alleged infringer used the first work, whether the copied elements justify liability (“wrongful appropriation”); and (3) whether copyright doctrine otherwise entitled the second work to protection as a fair abridgment or fair use.¹⁰⁹ To answer the first question, courts looked for evidence to establish that an alleged infringer had copied and that similarities had not resulted coincidentally.¹¹⁰ To prove misappropriation, courts asked whether what an alleged infringer had copied was of substantial value to the copyright owner’s work.¹¹¹ Magnitude of copying is not necessary proof of misappropriation. In the famous case *Daly v. Palmer*, Judge Blatchford observed that even if the copying was insignificant quantitatively, but was nonetheless of “substantial” value to the owner’s work aesthetically or economically, the copying would be actionable.¹¹² Thus, *Daly* established the precursors of the modern-day substantial similarity test.¹¹³

In the early twentieth century,¹¹⁴ an alleged infringer’s access to the original work became an element of the case, as did proof that the content the accused infringer had copied was copyrightable subject matter.¹¹⁵ The seminal case *Arnstein v. Porter* combined the first two inquiries into one prong of a test intended to establish actual copying.¹¹⁶ It also made “substantial similarity” between aesthetically or economically valuable portions of the works a second prong of the test

107. See *id.*; *Emerson v. Davies*, 8 F. Cas. 615, 622 (C.C.D. Mass. 1845); *Greene v. Bishop*, 10 F. Cas. 1128, 1134 (C.C.D. Mass. 1858); *Daly v. Palmer*, 6 F. Cas. 1132, 1137–38 (C.C.S.D.N.Y. 1868); *Folsom v. Marsh*, 9 F. Cas. 342, 345 (C.C.D. Mass. 1841).

108. See Amy B. Cohen, *Masking Copyright Decisionmaking: The Meaninglessness of Substantial Similarity*, 20 U.C. DAVIS L. REV. 719, 724–28 (1987).

109. *Id.* at 724.

110. See *Emerson*, 8 F. Cas. at 625; *Greene*, 10 F. Cas. at 1133–34.

111. See *Emerson*, 8 F. Cas. at 625.

112. See *Daly*, 6 F. Cas. at 1133–34, 1137–38.

113. See Cohen, *supra* note 108, at 727.

114. *Id.* at 728.

115. *Id.*

116. *Id.* at 731–32 (citing *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946), *abrogated on other grounds* by *Heyman v. Com. & Indus. Ins. Co.*, 524 F.2d 1317 (2d Cir. 1975)).

intended to prove that the copying rose to a level that is actionable as an appropriation of the first artist's protected expression.¹¹⁷

The intended audience in *Arnstein*, just like the public to whom Justice Holmes deferred in *Bleistein*, was the “lay listeners, who comprise the audience for whom such popular music is composed.”¹¹⁸ This fact is consistent with *Bleistein*'s concern that judges should not deny copyright to “pictures which appeal[] to a public less educated than the judge.”¹¹⁹ The Second Circuit has further refined this test and, at least in certain situations, it applies the proxy of a “[m]ore [d]iscerning [o]bserver.”¹²⁰ Courts do not presume that this more discerning observer has better taste; they merely presume the observer is able to account for the presence of both protectable and unprotectable elements in works when judging wrongful appropriation under the second prong of the test.¹²¹

The substantial similarity test is the court's main opportunity to compare the works at issue to determine if one infringes the other.¹²² The burden of proof in this initial test lies with the original author.¹²³ Fair use is an affirmative defense relevant only if a work is otherwise infringing.¹²⁴ As such, fair use affords the second artist a separate opportunity to present additional, context-specific information about the accused work, including the context in which the work was created or is being used.¹²⁵ This information aids in establishing—among other things—the work's transformative character and purpose, and whether the copied expression is used to advance that purpose or is taken for other (unprotected) reasons.¹²⁶

Because it is the core test for infringement, the substantial similarity test focuses on determining the overall “wrongfulness” of the

117. See *Arnstein*, 154 F.2d at 468–69.

118. *Id.* at 473. This articulation is consistent with Justice Holmes's interest in respecting the tastes of the lay public articulated in *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251–52 (1903).

119. *Bleistein*, 188 U.S. at 251–53.

120. *E.g.*, *Boisson v. Banian, Ltd.*, 273 F.3d 262, 271–72 (2d Cir. 2001) (quoting *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1003 (2d Cir. 1995)) (“the test is guided by comparing the ‘total concept and feel’ of the contested works” without comparing only the copyrightable elements).

121. See *id.* at 272.

122. See Cohen, *supra* note 108, at 722.

123. NIMMER, *supra* note 7, § 12.11(D)(1).

124. *Id.* § 13F.04(B).

125. See, *e.g.*, *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1203 (2021).

126. *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 143 S. Ct. 1258, 1276 (2023); see also *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1269 (11th Cir. 2001).

copying.¹²⁷ Consistent with *Bleistein*,¹²⁸ a substantial similarity inquiry looks to the original work and its author, asking whether the portions of the work that the second artist has copied are actionable as a matter of copyright infringement.¹²⁹ To be successful, the first artist must convince the court that the second work appropriates parts of the original work where the author has significantly invested her personality.¹³⁰ This means that manifestation of the author's personality must act both as a vehicle to extend copyright to works and as a means to modulate the protections extended.¹³¹ Courts can only do this by examining both works before them, understanding what makes each work original, and only assigning liability where the second work takes “too much” of that original expression.¹³²

Courts generally apply one of three tests when judging substantial similarity.¹³³ The Second Circuit uses variants of *Arnstein's* “ordinary observer” test.¹³⁴ The Ninth Circuit applies the “extrinsic/intrinsic” test, which it announced in *Sid & Marty Krofft Television Productions Inc. v. McDonald's Corp.*,¹³⁵ but which originally derives from the *Arnstein* test.¹³⁶ Finally, a variety of other circuits apply the “abstraction/filtration/comparison” test.¹³⁷ The Second Circuit crafted this test to analyze the more complex issues in computer

127. See Shyamkrishna Balganes, *The Normativity of Copying in Copyright Law*, 62 DUKE L.J. 203, 221 (2012).

128. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903). This is a view that Americans might not like to admit sounds like it is tinged with European concepts of moral rights. See Susanna Frederick Fischer, *Who's the Vandal? The Recent Controversy over the Destruction of 5Pointz and How Much Protection Does Moral Rights Law Give to Authorized Aerosol Art?*, 14 J. MARSHALL REV. INTELL. PROP. L. 326, 338 (2015).

129. See *Arnstein v. Porter*, 154 F.2d 464, 468–69 (2d Cir. 1946), *abrogated on other grounds* by *Heyman v. Com. & Indus. Ins. Co.*, 524 F.2d 1317 (2d Cir. 1975).

130. See Balganes, *supra* note 127, at 211–12.

131. See *id.*

132. See Lim, *supra* note 11, at 602.

133. *Id.* at 602–03. Various subtests and permutations of these three dominant tests exist but they are largely variants that may be grouped within the larger headings adopted here or are not relevant for this discussion. See Kevin J. Hickey, *Reframing Similarity Analysis in Copyright*, 93 WASH. U. L. REV. 681, 699 (2016). Moreover, several leading treatises on copyright have adopted these categorizations. See Asay, *supra* note 11, at 38.

134. *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946), *abrogated on other grounds* by *Heyman v. Com. & Indus. Ins. Co.*, 524 F.2d 1317 (2d Cir. 1975); accord Hickey, *supra* note 133, at 690–91.

135. *Sid & Marty Krofft Television Prods. Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977), *overruled on inverse ratio rule* by *Skidmore v. Led Zeppelin*, 952 F.3d 1051 (9th Cir. 2020) (en banc); accord Hickey, *supra* note 133, at 692.

136. See *Sid & Marty Krofft Television Prods. Inc.*, 562 F.2d at 1164–65.

137. Hickey, *supra* note 133, at 694.

software.¹³⁸ In that context, an ordinary observer may not be able to judge whether substantial similarities exist between the designs of code unless experts assist in filtering out unprotectable elements from consideration.¹³⁹

Of the three tests, *Arnstein* is the longest-standing.¹⁴⁰ *Arnstein* is notable for two reasons: creating a two-pronged sequential test, and directing the court's attention to the response of the lay listeners "who comprise the audience for whom such popular music is composed."¹⁴¹

If courts apply the test correctly and fully, numerous benefits follow.¹⁴² The test effectively sequences decision-making, identifies areas where expert testimony is helpful, and tempers the broad recognition of copyrightability for original works manifesting the personality of the author with some concept of market impact to help measure wrongful appropriation.¹⁴³ The test acknowledges that "[t]he plaintiff's legally protected interest is not, as such, his reputation as [an artist] but his interest in the potential financial returns from his compositions which derive from the lay public's approbation of his efforts."¹⁴⁴

As Part IV demonstrates, regardless of the test, substantial similarity comparisons allow courts to grasp aesthetic facts about works they are considering and about the creative process that produced them. This is the phase of analysis where the court should consider whether an accused work includes infringing protected expression from the first work.

C. Fair Use

The well-known case *Folsom v. Marsh*¹⁴⁵ is credited with introducing the cotemporary fair use test.¹⁴⁶ Fair use is an affirmative

138. Lim, *supra* note 11, at 611–12.

139. See *Comput. Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 713–14 (2d Cir. 1992).

140. Lim, *supra* note 11, at 603.

141. *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946). This is consistent with Justice Holmes's interest in respecting the tastes of the lay public articulated in *Bleistein*. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251–52 (1903).

142. See *Arnstein*, 154 F.2d at 468 (discussing sequencing decision-making and expert testimony).

143. *Id.*; see discussion *supra* Part III, at 17–18, 23–24.

144. *Arnstein*, 154 F.2d at 473.

145. *Folsom v. Marsh*, 9 F. Cas. 342 (C.C.D. Mass. 1841).

146. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 576 (1994) ("In *Folsom v. Marsh*, 9 F. Cas. 342 (No. 4,901) (C.C.D. Mass. 1841), Justice Story distilled the essence of law and methodology from the earlier cases: 'look to the nature and objects of the selections

defense to copyright infringement.¹⁴⁷ As explained more fully below, defendants who prevail on the defense establish that their specific use of copyrighted material does not infringe the plaintiff's copyright.¹⁴⁸ Nevertheless, fair use is the most general exception in US copyright law.¹⁴⁹ Based on common law but given express statutory recognition for the first time in § 107 of the 1976 revision of the Copyright Act, the doctrine is an equitable rule of reason, and each case raising the question must be decided on its own facts.¹⁵⁰ The four factors adopted in § 107 are:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for non-profit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.¹⁵¹

Each of these factors in turn typically raises important subsidiary considerations.

Under factor one, courts often consider issues like the equitable doctrine of unclean hands and the propriety of the defendant's conduct generally, as well as whether the conduct fits within one of the enumerated categories in the preamble of § 107.¹⁵² In *Warhol*, the Supreme Court also clarified that because the Foundation was engaged in commercial licensing of Warhol's work to outlets where it competed with Lynn Goldsmith's, the commercial nature of the activity would require additional justification under factor one because it risked supplanting the original photograph.¹⁵³ This evaluation occurs

made, the quantity and value of the materials used, and the degree in which the use may prejudice the sale, or diminish the profits, or supersede the objects, of the original work.' Thus expressed, fair use remained exclusively judge-made doctrine until the passage of the 1976 Copyright Act, in which Justice Story's summary is discernible.") (citation omitted).

147. *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 143 S. Ct. 1258, 1285 n.21 (2023).

148. *Id.* at 1273.

149. Jane C. Ginsburg, *Fair Use in the United States: Transformed, Deformed, Reformed?*, 2020 SING. J. LEGAL STUD. 265, 265 (2020).

150. H.R. REP. NO. 94-1476, at 65 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5679; *see also Warhol Found.*, 143 S. Ct. at 1273, 1277 ("The same copying may be fair when used for one purpose but not another.").

151. 17 U.S.C. § 107.

152. Asay et al., *supra* note 17, at 915–16.

153. *Warhol Found.*, 143 S. Ct. at 1279–80.

separately from and in addition to the consideration of overall effect on the potential market for the work in factor four.¹⁵⁴

Under factor two, courts consider whether the nature of a work is more factual or creative, and its publication status.¹⁵⁵ Creative works and unpublished works are each less likely to be deemed fair uses than either factual or published works.¹⁵⁶ While this seems a straightforward evaluation on its face, and courts therefore generally make short work of the factor, the Supreme Court's fair use decision in *Google v. Oracle* turned on its determination that software code—protected as a literary work—was “functional” rather than creative.¹⁵⁷

In a twist on the usual course of events—where transformative use decisions under factor one drive decisions on the remaining factors—the Court in *Google* stressed that “the fact that computer programs are primarily functional makes it difficult to apply traditional copyright concepts in that technological world.”¹⁵⁸ Nevertheless, the *Google* Court—like the *Warhol* majority—also evaluated whether the purpose and character of Google's use of Sun Microsystem's code was significantly different from that of the original.¹⁵⁹ It then considered the merits of the other justifications for the use.¹⁶⁰

Factor three is no simpler. There are no bright-line tests of what is a permissible taking quantitatively, and the “heart of the work” concept comes into play when the most important part of a copyrighted work is appropriated, even if the taking is quantitatively small.¹⁶¹ Conversely, courts have allowed entire works to be copied if other factors favor the defendant.¹⁶²

Finally, under factor four, courts often use the discussion of market value as an opportunity to synthesize their analysis of the other factors and their subfactors in assessing market harm.¹⁶³ On the one

154. See *id.* at 1276.

155. Asay et al., *supra* note 17, at 916.

156. *Id.*

157. See *Google LLC v. Oracle Am. Inc.*, 141 S. Ct. 1183, 1203 (2021).

158. See *id.*

159. See *id.*

160. *Id.* at 1203–04; see also *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 143 S. Ct. 1258, 1277 n.8 (2023).

161. See, e.g., *Google*, 141 S. Ct. at 1204–05; *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 565 (1985).

162. See, e.g., *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 587 (1994); *Authors Guild v. Google, Inc.*, 804 F.3d 202, 221–23 (2d Cir. 2015); *Authors Guild, Inc. v. HathiTrust*, 755 F.3d 87, 98–99 (2d Cir. 2014).

163. See, e.g., Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978–2005*, 156 U. PA. L. REV. 549, 617 (2008).

hand, the “broad,” “supple,” “manipulable” criteria used to conduct a fair use analysis afford courts a great deal of flexibility and adaptability to new circumstances and technologies; on the other, it is this inherent adaptability of the fair use analysis that can make it unpredictable.¹⁶⁴

Following the Supreme Court’s decision in *Campbell v. Acuff-Rose Music, Inc.*, the assessment of the first fair use factor—the purpose and character of the use—gained importance.¹⁶⁵ *Campbell* articulated a new test under factor one focused on whether the use is transformative.¹⁶⁶ Roy Orbison’s publishers filed suit against rap music group 2 Live Crew and their record company, claiming that 2 Live Crew’s song “Pretty Woman” infringed their copyright in Orbison’s rock ballad “Oh, Pretty Woman.”¹⁶⁷ The district court ruled for 2 Live Crew, finding the song to be a parody that made fair use of Orbison’s work, but the court of appeals reversed and remanded, holding that the commercial nature of the song and the taking of the heart of the work rendered it an unfair infringement.¹⁶⁸ The Supreme Court held that 2 Live Crew’s commercial parody may be a fair use within the meaning of § 107.¹⁶⁹ Under the first of the four factors, courts must inquire “whether the new work merely ‘supersede[s] the objects’ of the original creation, or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning or message.”¹⁷⁰ The more transformative the work, the less significant will be the other factors, like commercialism.¹⁷¹

The *Warhol* decision clarified that “*Campbell* cannot be read to mean that § 107(1) weighs in favor of any use that adds some new expression, meaning, or message. Otherwise, transformative use would swallow the copyright owner’s exclusive right to prepare derivative works.”¹⁷² The decision strikes a balance between original works and secondary uses based on an evaluation of “objective indicia” of the character and purpose of each challenged use, including whether the use is commercial and the justifications for copying.¹⁷³ This is a positive

164. Ginsburg, *supra* note 149, at 267.

165. *Campbell*, 510 U.S. 569.

166. See *id.* at 579; Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 37 (2d Cir. 2021), *aff’d*, 143 S. Ct. 1258 (2023).

167. *Campbell*, 510 U.S. at 571–73.

168. *Id.* at 573–74.

169. *Id.* at 594.

170. *Id.* at 579 (quoting *Folsom v. Marsh*, 9 F. Cas. 342, 348 (C.C.D. Mass. 1841)).

171. *Id.*

172. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 143 S. Ct. 1258, 1282 (2023).

173. *Id.* at 1287.

outcome in terms of procedural fairness because it suggests courts and litigants should return their focus to a more rigorous analysis of all four statutory fair use factors. If courts precede that analysis with a basic infringement assessment applying the more discerning observer test for substantial similarity as a threshold matter, as this Article suggests, they will have a richer factual record in which to ground their decisions.

IV. QUESTIONS OF AESTHETICS

A. Judges Resist Aesthetic Matters—Especially Involving Visual Artworks & Copyright

“[J]udges can make fools of themselves pronouncing on aesthetic matters,” wrote Judge Richard Posner.¹⁷⁴ Yet, aesthetic inquiries inevitably—and properly—filter into all three of the doctrines introduced in Part III when judging works of visual art and other authorial works. Judges routinely use the “dangerous undertaking” quote from *Bleistein* to excuse supposed judicial ignorance of aesthetic matters in copyright cases.¹⁷⁵ However, generalist judges and lay juries make determinations in a variety of other areas of the law that are not only imbued with aesthetic import, but also require additional specialized technical knowledge. Such areas include: taxes, tariffs, zoning, historic preservation, land use, public funding, technology, and constitutional law.¹⁷⁶ Such decisions include: whether to grant funds to government projects;¹⁷⁷ how to appraise, tax, and depreciate art objects (and what qualifies);¹⁷⁸ what kinds of activities count as arts education;¹⁷⁹ whether certain architectural works are considered

174. *Gracen v. Bradford Exch.*, 698 F.2d 300, 304 (7th Cir. 1983); *see also* *Bucklew v. Hawkins, Ash, Baptie & Co.*, 329 F.3d 923, 929 (7th Cir. 2003) (claiming that a stringent originality requirement in copyright law “would involve judges in making aesthetic judgments, which few judges are competent to make”).

175. *See, e.g.*, *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 580 U.S. 405, 423 (2017); *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 42 n.4 (2d Cir. 2021), *aff'd*, 143 S. Ct. 1258 (2023); *Castillo v. G&M Realty L.P.*, 950 F.3d 155, 166 (2d Cir. 2020).

176. *Soucek*, *supra* note 17, at 382 (2017).

177. *See Nat’l Endowment for the Arts v. Finley*, 524 U.S. 569, 583 (1998) (denying funding for performance artists using its “decency and respect” criteria over a dissenting opinion by Justice Souter concerned with the “significant power to chill artistic” expression (citing *id.* at 622 (Souter, J., dissenting))).

178. *Soucek*, *supra* note 17, at 402 n.112 (citing *Judge v. Comm’r*, 35 T.C.M. (CCH) 1264 (1976)) (determining that the art at issue were wall decorations more than art, thus the owner which may be depreciable whereas true art is not).

179. *Id.* at 399–400 (citing *Goldsboro Art League, Inc. v. Comm’r*, 75 T.C. 337 (1980)) (holding that a gallery was entitled to tax exemptions because of its art education goal).

worthy of historic preservation;¹⁸⁰ whether to condemn billboards or graffiti as blight;¹⁸¹ and how to distinguish obscenity from serious literary, artistic, or scientific material.¹⁸²

Judge Posner's concern about the tendencies of judges presiding in art law cases is not entirely misplaced. Judges can and do make poor decisions in such cases. They are not immune from delving into discussions of their personal appreciation of the artwork at hand or succumbing to a fascination with the celebrity status of artists or their patrons.¹⁸³ But these shortcomings may occur, just as Justice Holmes warned, not because a court has thoroughly examined and understood the evidence about the art itself, but rather because the judges are resistant or hostile to the "language in which their author [speaks]."¹⁸⁴

Nevertheless, aesthetic inquiries are inescapable regardless of the mode of analysis a court chooses. Such considerations weave throughout each of the core doctrines courts need to resolve infringement disputes. While each of the doctrines requires consideration of aesthetic matters, courts most often overlook the substantial similarity inquiry—either avoiding it entirely or giving it cursory treatment in appropriation art cases.¹⁸⁵ This may be because the originality doctrine, even after *Feist*, sets the creativity bar so low that most artworks easily make the grade when considered on their own.¹⁸⁶ Thus, complaining artists readily clear the first hurdle of establishing ownership of a valid copyright.¹⁸⁷ Courts should next proceed to evaluate how the second artist copied individual elements of

180. *Id.* at 413 (citing Penn Cent. Transp. Co. v. City of New York, 438 U.S. 104, 110 (1978)) ("The Commission first performs the function, critical to any landmark preservation effort, of identifying properties and areas that have a special character or special historical or aesthetic interest or value as part of the development, heritage or cultural characteristics of the city, state or nation.").

181. *Id.* at 414 (citing *Metromedia, Inc. v. City of San Diego*, 453 U.S. 490, 510 (1981)) ("It is not speculative to recognize that billboards by their very nature, wherever located and however constructed, can be perceived as an esthetic harm.").

182. *See id.* at 381 ("This Article details the breadth and surprising philosophical depth of the law's engagement with aesthetic questions. And bucking conventional wisdom, it argues that in many areas of law, government *should* define artistic categories and promote aesthetic values.").

183. *See Salinger v. Colting*, 607 F.3d 68, 79–83 (2d Cir. 2010); *Cariou v. Prince*, 714 F.3d 694, 713–14 (2d Cir. 2013).

184. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

185. *See* Laura G. Lape, *The Metaphysics of the Law: Bringing Substantial Similarity Down to Earth*, 98 DICK. L. REV. 181, 188 (1994).

186. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

187. *See, e.g., Cariou v. Prince*, 784 F. Supp. 2d 337, 345 (S.D.N.Y. 2011), *rev'd in part*, 714 F.3d 694 (2d Cir. 2013); *Rogers v. Koons*, 751 F. Supp. 474, 477–78 (S.D.N.Y. 1990), *aff'd*, 960 F.2d 301 (2d Cir. 1992).

the original work and used them in the second work to determine whether the copying rises to a level to be actionable.¹⁸⁸ Yet courts tend to skip this step, opting instead to conduct their analysis solely in the context of the fair use defense, which they may perceive will allow them to avoid more taxing aesthetic inquiries.¹⁸⁹

Perversely, although judges assert that they do not judge art, often their failure to conduct a substantial similarity analysis forces them to do precisely that. In recent cases in the visual arts—most notably the *Warhol* litigation¹⁹⁰ and several cases involving Richard Prince¹⁹¹ and Jeff Koons¹⁹²—judges prematurely relied on the transformative use test without the proper evidentiary foundations on originality and substantial similarity. Consistent with copyright's goals of incentivizing creation, infringement claims should be tied to what is protectable in the first place.¹⁹³ Nonetheless, courts sometimes jump straight to an evaluation of fair use and ignore opportunities to make

188. See discussion of elements of substantial similarity comparison *supra* Section III.B.

189. See, e.g., A. Michael Warnecke, *The Art of Applying the Fair Use Doctrine: The Postmodern-Art Challenge to the Copyright Law*, 13 REV. LITIG. 685 (1994); *Weissman v. Freeman*, 684 F. Supp. 1248, 1261–62 (S.D.N.Y. 1988) (dismissing complaint based in the alternative on finding of fair use and omitting infringement analysis); *D.C. Comics, Inc. v. Reel Fantasy, Inc.*, 539 F. Supp. 141, 146–47 (S.D.N.Y. 1982) (granting summary judgment to defendants on copyright infringement based on finding of fair use and omitting infringement analysis); *Triangle Publ'ns, Inc. v. Knight-Ridder Newspapers, Inc.* 445 F. Supp. 875 (S.D. Fla. 1978) (court stated that plaintiff's § 106 display right was implicated by defendant's display of the cover of T.V. Guide, but performed no infringement analysis before finding against fair use), *aff'd on other grounds*, 626 F.2d 1171 (5th Cir. 1980); *Wright v. Warner Books, Inc.*, 953 F.2d 731, 743 (2d Cir. 1991) (Van Graafeiland, J., concurring) (The Southern District of New York merely recited the copyright owner's exclusive rights under § 106 as its analysis of the infringement issue then moved on to find fair use. “The defense of fair use assumes the existence of infringement.” On appeal at least one judge on the Second Circuit suggested that the district court should have conducted a substantial similarity analysis noting that the protectible material taken by defendant “was so minimal that the subject of fair use need not be reached.”).

190. *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 43 (2d Cir. 2021), *aff'd*, 143 S. Ct. 1258 (2023).

191. See *Cariou v. Prince*, 714 F.3d 694 (2d Cir. 2013), in which appropriation artist Richard Prince incorporated photographs from Patrick Cariou's sensitive work on Rastafarians into his own series of paintings entitled *Canal Zone*—sometimes altering them significantly, sometimes merely superimposing “lozenges” of paint on the otherwise unaltered photographs. In contrast with Cariou's work, Prince exhibited his work in the Gagosian gallery and sold it for lofty prices to celebrity collectors. Although significant testimony was available to the district court judge, she did not preserve or rely on any of it in a substantial similarity analysis.

192. See *Blanch v. Koons*, 467 F.3d 244, 252 (2d Cir. 2006).

193. See *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 143 S. Ct. 1258, 1276 (2023).

evidentiary assessments about the originality of the art and contributions by the artists they encounter.¹⁹⁴

The US Court of Appeals for the Second Circuit made such a leap in the *Warhol* litigation.¹⁹⁵ It held that Andy Warhol's use of Lynn Goldsmith's reference photograph of the musician Prince was not fair use because it was insufficiently transformative.¹⁹⁶ The court ruled in favor of Goldsmith based on an evaluation of Warhol's subjective creative intent, and did so without the benefit of a substantial similarity analysis of the works in the district court.¹⁹⁷ Neither the US District Court for the Southern District of New York nor the Second Circuit ever fully¹⁹⁸ explained what made Lynn Goldsmith's work original, or why they believed Andy Warhol had wrongfully appropriated enough of that originality to be actionable as an infringement.¹⁹⁹ Many in the art world deemed the decision far removed from the normative values of the art market that copyright law, in part, regulates.²⁰⁰

Some contrasted the *Warhol* case with Richard Prince's victory in *Cariou v. Prince*.²⁰¹ There, the court deemed transformative an artist's application of blue lozenges of paper, disco balls, and collage images to images of Rastafarians a less famous artist had taken.²⁰² Attempting to reconcile the two decisions, some observers questioned

194. See, e.g., sources cited *supra* note 189.

195. *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26 (2d Cir. 2021), *aff'd*, 143 S. Ct. 1258 (2023).

196. See *id.* at 52. This ruling is error when considering the fair use defense because it views the matter from the perspective of Warhol, not the Foundation, thus considers the wrong use and the wrong user. *Id.* It analyzes Warhol's creative contributions not the Foundation's licensing activities. See also *id.* at 47 ("While Warhol did indeed crop and flatten the Goldsmith Photograph, the end product is not merely a screenprint identifiably based on a photograph of Prince. Rather it is a screenprint readily identifiable as deriving from a *specific* photograph of Prince, the Goldsmith Photograph.").

197. *Id.* at 35–36.

198. See *id.* at 54 (The Second Circuit included a very brief description of protectable elements of the Goldsmith Photograph copied by Warhol but did not engage in meaningful analysis. "[G]iven the degree to which Goldsmith's work remains recognizable within Warhol's, there can be no reasonable debate that the works are substantially similar.>").

199. See *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 382 F. Supp. 3d 312, 324 (S.D.N.Y. 2019) ("But the [c]ourt need not address this argument because it is plain that the Prince Series works are protected by fair use."), *rev'd*, 992 F.3d 99 (2d Cir. 2021), *aff'd*, 143 S. Ct. 1258 (2023).

200. See, e.g., Brief for the Robert Rauschenberg Found., et al. as Amici Curiae Supporting Petitioner at 2–3, *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 143 S. Ct. 1258 (2023) (No 21-869).

201. See *Cariou v. Prince*, 784 F. Supp. 2d 337 (S.D.N.Y. 2011), *rev'd in part*, 714 F.3d 694 (2d Cir. 2013).

202. See *id.* at 713–14.

whether courts will deem certain genres of art, such as collage, “permissible”²⁰³ and others—like Warhol’s work—not. While seeking not to judge art, the court left the impression it was engaging in such judgment—some speculated discriminating based on medium—because the court did not articulate any test or other objective rationale to justify the different outcomes.²⁰⁴

The ultimate effect of courts sidestepping evidentiary inquiries is far worse than scorn from art aficionados. This avoidance damages the judicial process. The Second Circuit’s gloss on the transformative use test in the *Warhol* litigation—that “the secondary work itself must reasonably be perceived as embodying a distinct artistic purpose, one that conveys a new meaning or message separate from its source material”²⁰⁵—is not in itself a radical departure from the standard established in *Campbell*.²⁰⁶ However, ostensibly relying on *Bleistein*, the Second Circuit intentionally avoided engaging with the artworks at issue, leaving it unclear how one is to divine whether a work conveys new meaning or message separate from its source material.²⁰⁷

When lower courts sidestep evidentiary inquiries and neglect the substantial similarity analysis, higher courts must engage in the evidentiary work copyright doctrine relegates to lower courts. This litigation passed a factual dispute to the Supreme Court under the guise of a debate over the proper standard for transformative fair use.²⁰⁸ A

203. Blake Gopnik, *Warhol a Lame Copier? The Judges Who Said So Are Sadly Mistaken*, N.Y. TIMES (Sept. 24, 2021), <https://www.nytimes.com/2021/04/05/arts/design/warhol-copy-right-appeals-court.html> [<https://perma.cc/8SP3-Y86E>].

204. See generally *Cariou*, 784 F. Supp. 2d 337 (outlining factors to be used in determining a work’s fair use).

205. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 29 (2d Cir. 2021), *aff’d*, 143 S. Ct. 1258 (2023).

206. See *id.* at 42. From the context of the decision, it is clear that the court does not mean to abandon the requirement to have a transformative character and purpose under factor one. The court nevertheless elsewhere provides further guidance, which reads more like a substantial similarity assessment, and is frankly unhelpful in the context of a transformative use analysis because it could be interpreted as announcing a new or additional test: “[T]he secondary work’s transformative purpose and character must, at a bare minimum, comprise something more than the imposition of another artist’s style on the primary work such that the secondary work remains both recognizably deriving from, and retaining the essential elements of, its source material.” See *id.*

207. See *id.* at 41.

208. See Brief of Professors Peter S. Menell, et al. as Amici Curiae in Support of Respondents at 2, Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 143 S. Ct. 1258 (2023) (No 21-869). As Professors Ginsburg, Menell and Balganesch noted in their amicus brief to the Supreme Court, the narrow focus on meaning and message in the fair use analysis also “elevate[s] ‘transformativeness’ to talismanic significance.” *Id.* This has led lower courts to substitute a vague notion for the original fair use factors outlined in the Copyright Act. See *id.* One

difference exists between making aesthetic value judgments about art, as Holmes warned against, and the Second Circuit's unwillingness to conduct a substantial similarity analysis to help it and the appellate courts assess fair use.²⁰⁹

The Supreme Court majority opinion declines to view the works from the perspective of their creator and instead examines the effect of the user's challenged use.²¹⁰ This is not a departure from *Campbell* because there, the challenged use was an unlicensed parody which the Court examined on its own terms.²¹¹ Still, the tension between the majority and dissenting opinions in *Warhol* demonstrates the convoluted nature of appellate decisions when lower courts do not fully develop the factual record.²¹²

The majority rule allows for consideration of works' meaning and message, but requires an objective inquiry into how a specific use of a work affects its character or purpose.²¹³ Thus, the majority required the Andy Warhol Foundation to justify its licensing of *Orange Prince* for the cover of a commemorative magazine where Goldsmith's photo might also have appeared separately from Warhol's original creation of the *Prince Series*.²¹⁴ The Court did not accept the use as transformative based merely on Warhol's earlier arguably creative use of Lynn Goldsmith's work and did not venture an opinion whether Warhol's use of the image in the *Prince Series* was justified.²¹⁵ Instead, the majority explained that whatever transformative intentions Warhol may have had were insufficient to sustain the Foundation's later commercial licensing use in competition with Goldsmith.²¹⁶

This approach ensures that *Campbell* does not swallow the copyright owner's derivative work right.²¹⁷ *Campbell* is "the

harm this exacts is the routine blessing by courts of appropriation by more notable artists of the work of less commercially successful artists in highly commercial ways. *See also id.* at 14–30. Courts do not adequately consider what effect that will have on the markets for the appropriated works. Clearly, this overlooks the interplay of the idea of transformative use and the derivative work right captured in the Copyright Act. *Id.*

209. *See Warhol Found.*, 11 F.4th at 41–42. The Second Circuit only made a cursory holding on substantial similarity after it had ruled on fair use and relied on its fair use holding to conclude the works were similar. This turns procedural order on its head.

210. *See id.* at 48.

211. *See id.* at 42.

212. *See discussion infra* Part VII.

213. *Warhol Found.*, 143 S. Ct. at 1287 (2023).

214. *Id.* at 1285 n.21.

215. *See id.* at 1283.

216. *Id.* at 1284–85.

217. *Id.* at 1282.

culmination of a long line of cases and scholarship about parody's claim to fairness in borrowing."²¹⁸ The case drew nuanced distinctions between concepts like parody and satire—both art forms that bring new meaning and message to works.²¹⁹

However, simply having any new message or meaning is insufficient; if the message an artist wishes to make can stand on its own two feet, further justification is necessary before copying will be adjudicated a fair use.²²⁰ Since the challenged use was licensing *Orange Prince* for the cover of a commemorative magazine upon the artist's death, any artistic message about the nature of celebrity Warhol may have originally intended was irrelevant to the majority.²²¹ The purpose of the challenged use years later was to “illustrate a magazine about Prince with a portrait of Prince,”²²² and the majority examined the use's effect independently.²²³

The dissenting justices vehemently disagreed with the majority.²²⁴ They accused the majority of being uninterested in the distinctiveness and newness of Warhol's portrait when considering factor one and charged that the majority's opinion reduced the factor one analysis to a “marketing decision: In the majority's view, Warhol's licensing of the silkscreen to a magazine precludes fair use.”²²⁵ The dissent viewed the dispute from the perspective of the artist's subjective creative intent, rather than the Foundation's²²⁶ licensing use; it continued its lament about the majority's “doctrinal shift,” claiming:

218. *Id.* at 1283.

219. *Id.*

220. *Id.* at 1276.

221. *See id.* at 1268.

222. *Id.* at 1284.

223. *See id.* at 1285–86.

224. *See id.* at 1293 (Kagan, J., dissenting).

225. *Id.* at 1291–92.

226. *See id.* Since Warhol had died by the time of the dispute, and the Foundation had taken over licensing, the dissent refers to both the artist and the Foundation as Warhol. Pursuant to the majority's analysis such a blurring of the lines would be folly because Warhol may have been fully justified in creating multiple unpublished silkscreens—including *Orange Prince*—without seeking a license from Goldsmith (e.g., for his own private study, or as proposals for Vanity Fair to choose from) even if the Warhol Foundation is not permitted to license those works for every possible use without clearing rights with Ms. Goldsmith. The Foundation's licensing activity should also be analyzed separately for whatever additional context the party involved in the licensing transaction brings to the fair use analysis. Warhol's commentary on celebrity might have stood on its own two feet when the canvases were created, and their use on the cover of a magazine about Prince in potential competition with Ms. Goldsmith's own work might be prohibited, but perhaps a post Supreme Court decision license of *Orange Prince* by the Warhol Foundation for a magazine article about art and the law would fare differently even under the majority's test (should the Foundation be so bold as to test those waters). *See id.* at 1268 n.1 (majority opinion).

It does not matter that the silkscreen and the photo do not have the same aesthetic characteristics and do not convey the same meaning. It does not matter that because of those dissimilarities, the magazine publisher did not view the one as a substitute for the other. All that matters is that Warhol and the publisher entered into a licensing transaction, similar to the one Goldsmith might have done. Because the artist had such a commercial purpose, all the creativity in the world could not save him.²²⁷

But all of these factors *do* matter because, as the majority noted in response, the Copyright Act has many “escape valves.”²²⁸ The majority opinion cites the idea-expression dichotomy, the general rule that facts may not be protected, the requirement of originality, and the general legal standard for infringement as examples.²²⁹ None of these questions were certified to the court on appeal, however.

B. The Originality Doctrine Is Suffused with Aesthetic Inquiries

The current Supreme Court is not alone in its struggles with aesthetic judgments. Professor Robert Gorman has shown that judges make aesthetic judgments in some situations and sidestep aesthetic analysis when it does not suit them.²³⁰ As the majority opinion in *Warhol* makes evident, the earlier and more thoroughly courts assess facts as an evidentiary matter, the more clearly they can articulate their legal reasoning.²³¹ In *Warhol*, the majority explains that while courts “should not attempt to evaluate the artistic significance of a particular work,” the “meaning of a secondary work, as reasonably can be perceived, should be considered to the extent necessary to determine whether the purpose of the use is distinct from the original.”²³²

To underscore that Holmes does not shy away from aesthetic contemplation, it is worth remembering that he could easily have resolved *Bleistein* on pure statutory construction grounds.²³³ Alternatively, he could have ruled the posters protectable by applying the reasoning in *Burrow-Giles Lithographing Co. v. Sarony*,²³⁴ because the works at issue were artistic conceptions of their authors, with

227. See *id.* at 1292 (Kagan, J., dissenting).

228. *Id.* at 1287 (majority opinion).

229. *Id.*

230. See Gorman, *supra* note 17, at 1.

231. See *id.* at 1283–84, 1284 nn.19–32 (criticizing the district court for its misreading of *Bleistein* and noting that the dissent demonstrates the danger of doing so: “on its view the first fair use factor favors AWF’s use of Goldsmith’s photograph simply because Warhol created worthy art”).

232. *Id.* at 1283–84.

233. *Id.* at 250–51.

234. See *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 60–61 (1884).

purposefully designed imagery.²³⁵ Instead, he chose to explain further that the Constitution required an author to manifest personality in a work to establish originality, thus ensuring that his opinion not be interpreted as putting into question the artwork of representational artists whose work is based on depicting nature as it exists, rather than staging compositions employing their “intellectual labors.”²³⁶ This interpretation supports that *Bleistein* does not require judges to avoid subjective contemplation of and engagement with artworks or artists whose disputes come before them. Rather, *Bleistein* shows such judicial engagement can occur, and that a judge’s assessments of copyright protection or infringement still need not turn on a judge’s personal aesthetic tastes. Holmes’s opinion is well known for citing the works of artists from Degas to Velazquez and quoting notable authors.²³⁷ It can be read as an invitation for judges to consider not only the artwork before the court, but the impact the court’s decision will have on the art world beyond. Holmes’s admonition should be interpreted to apply equally to all genres of art and to encourage judges to be receptive to the art of both well-known artists and emerging ones, privileging neither.

1. Originality in Art Reproduction Cases

Some scholars lament that the low bar for originality, both before and after *Feist*, affords protection to even insignificant works of authorship.²³⁸ They may group art reproductions in this category, but

235. See *id.* at 61; see also Diane Leenheer Zimmerman, *The Story of Bleistein v. Donaldson Lithographing Company: Originality as a Vehicle for Copyright Inclusivity*, in INTELL. PROP. STORIES 77, 98 (Jane C. Ginsburg & Rochelle Cooper Dreyfuss eds., 2006). The plaintiffs chose not to base their arguments on whether or not advertising should be entitled to protection but instead argued that the court could rule in their favor simply by applying the test from *Burrow-Giles*, 111 U.S. 53. A couple of early federal circuit court decisions suggested this was the right approach. In *Shumacher v. Schwencke*, 25 F. 466, 467–68 (C.C.S.D.N.Y. 1885) a New York court explained that copyrightability of a painting must be judged independently of the uses it is put to by others, otherwise a masterpiece such as a Rafael might be denied protection because it was used in advertising. See also *Yuengling v. Schile*, 12 F. 97, 100 (C.C.S.D.N.Y. 1882) (upholding copyright of chromolithograph of King Gambrinus holding a mug of beer because it was not just a representation of the product the company was selling, but a “work of the imagination” with “obvious artistic qualities”).

236. See Zimmerman, *supra* note 235, at 98.

237. See, e.g., Beebe, *supra* note 17, at 328; Trevor G. Reed, *Fair Use As Cultural Appropriation*, 109 CALIF. L. REV. 1373, 1392–93 (2021); Brian L. Frye, *Aesthetic Nondiscrimination & Fair Use*, 3 BELMONT L. REV. 29, 34 (2016); Subotnik, *supra* note 17, at 1502 n.61.

238. See Beebe, *supra* note 17, at 350; Christopher Buccafusco, *There’s No Such Thing as Independent Creation, and It’s a Good Thing, Too*, 64 WM. & MARY L. REV. 1617, 1673 (2023);

understanding how courts determine whether a copyist can claim copyright in a reproduction is instructive for a variety of reasons.²³⁹ Bearing in mind that the purpose of an art reproduction is usually to be as faithful to the original as possible, it may strike some as curious (albeit consistent with Holmes's personality-based test for originality) that copyrightability would turn on adding an author's imprint to the work.²⁴⁰ However, when a court grants protection to a reproduction of a public domain work that adds meaningful variations to the work that society values, copyright's incentive structure and utilitarian purposes are arguably served—even if the variations are slight.

Consistent with the themes in originality case law generally, cases celebrate the interpretive skills certain types of reproduction demand of the artist when the artist sensitively transposes an artwork to a new medium.²⁴¹ Courts set a low bar for originality, but do examine variations introduced by copyists during the transposition of a work to ensure they are the result of the author's own purposeful intellectual decisions rather than errors.²⁴²

For instance, in *Alfred Bell & Co. v. Catalda Fine Arts*, the Court held that an artist who made mezzotints of public domain old master paintings could claim copyright in the mezzotints provided the author contributed a distinguishable variation that was “recognizably his own.”²⁴³ Despite the low standard of originality the Court established, the opinion provides a detailed account of the process the engraver used to bring his conception of the old masterpiece to life in a new medium.²⁴⁴ Echoing *Sarony's* descriptions of the photographer's manipulation of light, shade, and costume to create an original composition and *Bleistein's* characterization of the uniqueness of handwriting, the Southern District of New York reasoned:

Zimmerman, *supra* note 235, at 102–03; Oren Bracha & Talha Syed, *Beyond the Incentive-Access Paradigm? Product Differentiation & Copyright Revisited*, 92 TEX. L. REV. 1841, 1896 (2014).

239. See, e.g., *Mazer v. Stein*, 347 U.S. 201, 202–03 (1954); *Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992). At least with respect to copyrightability of works an important, but often overlooked point under the current Copyright Act is that an author of a derivative work obtains copyright only in the new, “original” material she adds to the existing work. See *Rogers*, 960 F.2d at 307. Her addition has no effect on the copyright status of the preexisting work. See *id.*

240. See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 252 (1903).

241. See *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 74 F. Supp. 973, 976 (S.D.N.Y. 1947), *aff'd*, 191 F.2d 99 (2d Cir. 1951).

242. See *id.*; see also *Bleistein*, 188 U.S. at 250 (1903); NIMMER, *supra* note 7, § 2.01(A)(2).

243. See *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102–04 (2d Cir. 1951) (quoting *Bleistein*, 188 U.S. at 250).

244. *Alfred Bell & Co.*, 74 F. Supp. at 976.

The work of the engraver upon the plate requires the individual conception, judgment and execution by the engraver on the depth and shape of the depressions in the plate to be made by the scraping process in order to produce in this other medium the engraver's concept of the effect of the oil painting. No two engravers can produce identical interpretations of the same oil painting. This would appear to be sufficient to meet the requirement of some originality to entitle a work to the protection of the copyright law.²⁴⁵

The Second Circuit, affirming, explained:

The engraver produces his effects by the management of light and shade, or, as the term of his art expresses it, the chiaroscuro. The due degrees of light and shade are produced by different lines and dots; he who is the engraver must decide on the choice of the different lines or dots for himself, and on his choice depends the success of his print.²⁴⁶

Alfred Bell has come to be known for a more striking proposition: “A copyist’s bad eyesight or defective musculature, or a shock caused by a clap of thunder, may yield sufficiently distinguishable variations. Having hit upon such a variation unintentionally, the “author” may adopt it as his and copyright it.”²⁴⁷ The reasoning is sound. An author’s adoption of the variation is an affirmative and intentional decision no different than any other artistic decision made by an artist creating an original work of authorship. Whether one agrees with the court, this too is a decision with undeniable aesthetic import.

There is a lively academic debate on the topic of intentionality in authorship—a closely related area that also entails aesthetic line drawing. Professor David Nimmer, for example, asserts that courts should deny copyright protection to those who intend to reconstruct historical facts because they intend to undertake a historic reconstruction faithfully.²⁴⁸ If the scholar seeking copyright protection reassembles the text perfectly, the scholar has contributed no original authorship—only resurrected the previously lost text.²⁴⁹ On the other hand, if the scholar fails to properly reconstruct the text and introduces deviations, they are errors of poor scholarship rather than original authorship and do not merit copyright protection.²⁵⁰

245. See *id.* at 975; *Burrow-Giles Lithographic Co. v. Saroni*, 111 U.S. 53, 54–55 (1884); *Bleistein*, 188 U.S. at 250.

246. *Alfred Bell & Co.*, 191 F.2d at 104 n.22 (quoting WALTER ARTHUR COPINGER, *THE LAW OF COPYRIGHTS* 46 (7th ed. 1936)).

247. *Id.* at 105.

248. David Nimmer, *Copyright in the Dead Sea Scrolls: Authorship and Originality*, 38 HOUS. L. REV. 1, 85 (2001).

249. *Id.* at 95.

250. *Id.* at 112.

In the visual arts context, this concept applies mostly to art preservation. In contrast with a manufacturer of art reproductions, an art conservator does not obtain a copyright in a public domain work that the conservator preserved or restored.²⁵¹ Still, limits in the visual arts have tended to modulate protections. These limits include refusing to recognize copyrights in visual art works that seem too ordinary (to harken back to *Sarony*) or that rely too much on sweat of the brow effort, whether they are reproductions or original.²⁵² These decisions help illustrate how aesthetic decisions are inevitable in the core copyright doctrines. They are permissible under *Bleistein* and *Feist* because they draw the line between works where a creative spark is and is not evident to the court.²⁵³

For instance, in *Oriental Art Printing, Inc. v Goldstar Printing Corp.*, the Southern District of New York found that the photographs of Chinese food items for a menu lacked any artistic quality.²⁵⁴ It stated that “neither the nature and content of such photographs, nor plaintiffs’ description of their preparation, give the Court any reason to believe that any ‘creative spark’ was required to produce them.”²⁵⁵ The court complained that “[w]hile [Plaintiff] states that he worked with a photographer on the ‘lighting’ and ‘angles,’ he provides no description of either the lighting or angles employed, or any desired expression.”²⁵⁶ The court ultimately held that the images served a purely utilitarian function: identifying dishes on a take-out menu so that customers can understand what they are ordering.²⁵⁷ The court was concerned that recognizing copyright in the images would give the photographer the means to threaten other producers of Chinese menus, even if they created menus independently, because the court erroneously believed that all photographs of Chinese food items must look alike.²⁵⁸ Some scholars have noted that the photographer’s failure to provide an adequate narrative evincing his authorial decisions led to the court’s resistance to find the works copyrightable.²⁵⁹

251. See *id.* at 33–35 (discussing the restoration of the Sistine Chapel as involving more scientific precision than artistry and thus is not protected by copyright. However, the restoration was funded in part by promise of the film rights to make a movie about the restoration).

252. Cf. *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 60 (1884).

253. *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 358–59 (1991).

254. *Oriental Art Printing, Inc. v. Goldstar Printing Corp.*, 175 F. Supp. 2d 542, 546 (S.D.N.Y. 2001).

255. *Id.* at 546.

256. *Id.* at 547.

257. *Id.*

258. See *id.* at 546–47.

259. Subotnik, *supra* note 17, at 1521–22.

Feist's holding that “sweat of the brow” alone is not enough to confer protectability imposes another limit on the originality of photographs.²⁶⁰ *Bridgeman Art Library v. Corel Corp.*²⁶¹ held that photographs of public domain works of art which the photographer “labored to reproduce with absolute fidelity” were “slavish copies” and did not harbor the requisite spark of originality to make them copyrightable.²⁶² Judge Kaplan’s opinion demonstrated that he understood the technical skill and effort inherent in producing a photograph, but declined to find a change in medium alone—absent any distinguishable variation supplied by the second artist—sufficient to justify copyright protection.²⁶³

C. Substantial Similarity Comparisons of Works Allow Courts to Understand Basic Facts About Works and Their Uses

Judge Learned Hand, celebrated as one of the most illustrious copyright judges, is also popular for his copyright aphorisms.²⁶⁴ He described the test for substantial similarity as necessarily vague.²⁶⁵ When “aesthetic sensibilities of an observer” must be addressed, “the test is, if possible, even more intangible.”²⁶⁶ Judge Hand offered this assessment not to deter courts from undertaking the substantial similarity inquiry, but rather to underscore its serious nature.²⁶⁷ In this opinion and others, he routinely made such announcements only to carefully weigh any necessary aesthetic questions.²⁶⁸

260. See *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 352–53 (1991).

261. *Bridgeman Art Libr., Ltd. v. Corel Corp.*, 36 F. Supp. 2d 191 (S.D.N.Y. 1999).

262. *Id.* at 197.

263. *Id.* at 196.

264. Bruce E. Boyden, *Learned Hand: You're Reading Him Wrong*, MARQ. UNIV. L. SCH. FAC. BLOG (Apr. 13, 2018), <https://law.marquette.edu/facultyblog/2018/04/learned-hand-youre-reading-him-wrong/> [<https://perma.cc/Q2V7-FQRQ>].

265. *Peter Pan Fabrics v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960).

266. *Id.*

267. See *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1266 (11th Cir. 2001) (where the court explains another of Judge Hand’s aphorisms before itself carefully reviewing and deciding a case: “Judge Learned Hand’s famous statement in *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930), is actually nothing more than a concise restatement of the problem facing the courts.”).

268. See, e.g., *id.* at 489; *Nichols*, 45 F.2d at 121 (stating with regard to the distinction between idea and expression: “Nobody has ever been able to fix that boundary, and nobody ever can”); *Shipman v. R.K.O. Radio Pictures, Inc.*, 100 F.2d 533, 538 (2d Cir. 1938) (stating in Judge Hand’s concurrence that “[t]he test is necessarily vague and nothing more definite can be said about it”).

Peter Pan Fabrics v. Martin Weiner Corp. concerned designs on cloth that would ultimately be made into garments.²⁶⁹ Assessing infringement required the court to consider the scrutiny that observers would give the fabric designs once manufactured into clothing.²⁷⁰ Judge Hand did not simply compare the two fabric designs. He estimated how each design's "overall appearance will determine its aesthetic appeal when the cloth is made into a garment" by comparing such characteristics as the general color, arches, scrolls, and rows of symbols on both fabrics and concluding that while they resembled each other they were not identical.²⁷¹ He further considered that the ornamentation patterns were also not identical, but that "the ordinary observer unless he set out to detect the disparities, would be disposed to overlook them, and regard their appeal as the same."²⁷² Aesthetic determinations drive each determination, but the assessment is factual and evidentiary in nature.²⁷³ Judge Hand makes no value judgment or assessment of worth (e.g., that the first fabric is more beautiful or worthy of protection than the second) that would run counter to Justice Holmes's counsel in *Bleistein*.²⁷⁴ In this respect, the inquiry courts make when analyzing substantial similarity need not be any more challenging than the "comparatively modest" inquiry the *Warhol* majority requires of courts.²⁷⁵ It is focused on "how and for what reason a person is using a copyrighted work in the world, not on the moods of any artist or to aesthetic quality of any creation."²⁷⁶

Another famous case demonstrates how Judge Hand evaluated substantial similarity cases when distinguishing the idea from its expression was necessary. *Nichols v. Universal Pictures Corp.*,²⁷⁷ concerning the alleged infringement of a play by a motion picture, is the case in which Judge Hand articulated his famous "abstractions" test:

Upon any work, and especially upon a play, a great number of patterns of increasing generality will fit equally well, as more and more of the incident is left out. The last may perhaps be no more than the most general statement of what the play is about, and at times might only consist of its title; but there is a point in this series of

269. 274 F.2d at 488.

270. *Id.* at 489.

271. *Id.*

272. *Id.*

273. *See id.*

274. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 293, 251 (1903); *see Peter Pan Fabrics*, 274 F.2d at 489.

275. *See Andy Warhol Found. for the Visual Arts, Inc., v. Goldsmith*, 143 S. Ct. 1258, 1289 (2023) (Gorsuch, J., concurring).

276. *See id.*

277. *See Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 120 (2d Cir. 1930).

abstraction where they are no longer protected, since otherwise the playwright could prevent the use of his “ideas” to which, apart from their expression, his property is never extended. Nobody has ever been able to fix that boundary and nobody ever can.²⁷⁸

After a lengthy comparison of plot points, characters, themes, and subjects in the two works at bar, Judge Hand found the first work insufficiently original.²⁷⁹ With respect to characters, Judge Hand stated “the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly.”²⁸⁰ Similarly on plot—“though the plaintiff discovered the vein, she could not keep it to herself; so defined, the theme was too generalized an abstraction from what she wrote.”²⁸¹ Although the plaintiff had prepared an elaborate analysis of the two plays showing a parallelism between them, Judge Hand rejects them as “so general as to be quite useless.”²⁸² Judge Hand also criticized the use of expert testimony to describe “the intricacies of dramatic craftsmanship” instead preferring to stand upon the firmer ground of his own impressions after review.²⁸³ He urged that “the case [be] confined to the actual issues; that is, whether the copyrighted work was original, and whether the defendant copied it, so far as the supposed infringement is identical.”²⁸⁴

Setting aside Judge Hand’s views on the use of expert witnesses, his quote illuminates his approach to deciding cases—he was a careful and considerate judge who directly engaged with the copyrightable works to thoroughly understand them. He focused on two considerations. First, he prioritized gaining an understanding of what was original and protectable about the first work—including whether the first work was distinct enough in its expression to justify recognizing copyright.²⁸⁵ Second, he queried whether the second work copied protected expression from the first work, or was sufficiently original in its own right to escape infringement liability.²⁸⁶ Judge Hand’s approach illustrates the utility to courts of understanding

278. *Id.* at 121.

279. *See id.* at 122.

280. *Id.* at 121.

281. *Id.* at 122.

282. *Id.*

283. *Id.* at 123.

284. *Id.*

285. *See id.* at 121.

286. *See Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 56 (2d Cir. 1936). Originality assessments are always tempered with Judge Hand’s warning in yet another case that “no plagiarist can excuse the wrong by showing how much of his work he did not pirate.” *Id.*

originality as a threshold inquiry to determining infringement. His description of what he found protectable is also in accord with Supreme Court originality ruling in *Bleistein* and later ruling in *Feist*.²⁸⁷ Although the bar for protection is low, according to *Bleistein*, a work is original if it represents the artists' perception of and reaction to the world,²⁸⁸ and *Feist* requires that a party show at least a modicum of creativity, "no matter how crude, humble or obvious."²⁸⁹ The plaintiff in *Nichols* was not able to demonstrate sufficient similarity in the characters and plot points because they were too indistinct to reflect her perceptions of the world in a way that could be distinguished from that of others.²⁹⁰

D. The Fair Use Inquiry Requires Factual Analysis of Aesthetic Works to Determine if a New Use Is Justified

Originality and substantial similarity analyses provide courts the opportunity to make crucial factual assessments about visual artworks at issue in infringement proceedings. Courts have every reason to proceed to examine works in a deliberate manner. Lower courts should carefully explain their findings in opinions not only to provide a fact record for appellate courts but also to aid future litigants in understanding their rights and responsibilities under the law.

Courts risk reaching poor conclusions and distorting fair use jurisprudence if they fail to conduct the proper preparatory evidentiary analysis before considering fair use. This is because fair use is heavily inflected by evidentiary considerations about artwork. For instance, for a court to judge that a work is a transformative parody or determine whether a work of fan fiction requires a license as a derivative work takes significant engagement with and analysis of both works at bar. It also requires assessments of each author's or user's baseline intent and the ultimate response of the intended public for each work.²⁹¹

287. See *id.*; *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903); *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991).

288. See *Bleistein*, 188 U.S. at 250 (1903).

289. *Feist Publ'ns, Inc.*, 499 U.S. at 345 (1991). This is one of multiple phrasings of the creativity standard in *Feist* and may be perceived as being in tension with the ultimate ruling in the case finding the arrangement of the directory to be banal and garden variety. *Id.*

290. *Nichols*, 45 F.2d at 121.

291. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 582 (1994). As Justice Souter, writing for the majority in *Campbell* observed, "[t]he threshold question when fair use is raised in defense of parody is whether a parodic character may reasonably be perceived. Whether, going beyond that, parody is in good taste or bad does not and should not matter to fair use." See *id.*

The Supreme Court's clarification in the *Warhol* litigation that each challenged use must be assessed on its own terms to determine whether the use is justified as having a purpose and character sufficiently distinct from the original elucidates this precept.²⁹² Courts must be careful not to allow subjective, qualitative judgments to slip into the courts' assessments of the works. That risk is real, especially if a use is creative and the judgment is not well grounded in a factual evaluation of the works themselves. As Professor John Tehranian argues in an essay comparing the reasoning in three widely debated infringement cases—Alice Randall's rendition of *Gone with the Wind*, J.D. California's unauthorized sequel to *Catcher in the Rye*, and appropriation artist Richard Prince's *Canal Zone* series—aesthetic judgments are imbued with cultural norms. Moreover, in their application of the fair use doctrine, courts have “violated ostensible norms of aesthetic neutrality in deciding which works will remain consecrated and hallowed and which works will not.”²⁹³

The majority opinion in the *Warhol* litigation and the Second Circuit's concern about creating a “celebrity plagiarist's privilege”²⁹⁴ demonstrate an awareness of the unequal power dynamics between established and emerging artists. Here, the courts acknowledged the risk that judges might base transformative use decisions on whether an artist has attained blue-chip status in the art world.²⁹⁵ In other cases, courts have concluded that venerated artists are more likely to be making meaningful commentary when using the works of others.²⁹⁶ Courts may also excuse appropriation of works or elements of works as not substituting for the original work nor impacting the first artist's market.²⁹⁷

Compare, for example, the Second Circuit's attitude towards the comparatively unknown photographer Patrick Cariou versus its attitude towards beloved author J.D. Salinger when evaluating various

292. See *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 143 S. Ct. 1258, 1273 (2023).

293. Tehranian, *supra* note 17, at 419–20.

294. See *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 43 (2d Cir. 2021) (“Entertaining that logic would inevitably create a celebrity-plagiarist privilege; the more established the artist and the more distinct that artist's style, the greater leeway that artist would have to pilfer the creative labors of others.”), *aff'd*, 143 S. Ct. 1258 (2023); *Warhol Found.*, 143 S. Ct. at 1272 (“The Court of Appeals also rejected the District Court's logic that each Prince Series work is transformative because it 'is immediately recognizable as a Warhol, which the Court of Appeals believed would create a celebrity-plagiarist privilege.”) (internal quotations omitted).

295. See *Warhol Found.*, 11 F.4th at 43; *Warhol Found.*, 143 S. Ct. at 1272.

296. See, e.g., *Cariou v. Prince*, 714 F.3d 694, 699 (2d Cir. 2013).

297. See *Warhol Found.*, 143 S. Ct. at 1274.

factors in the fair use defense presented in each trial. The court depicted Cariou as an unknown photographer hoping to license images from an out-of-print coffee table book, and marveled at Richard Prince's ability to garner the admiration of celebrities and to sell them multimillion-dollar works at lavish openings in one of the many Gagosian galleries.²⁹⁸ The court dismissed Cariou's evidence that Richard Prince negatively affected the market for his works even though testimony showcased Cariou's plans to pursue gallery exhibitions for *Yes, Rasta!*²⁹⁹ The plans fell through because the intended collaborator—having seen the publicity surrounding Richard Prince's show—mistakenly believed that Cariou was working with Richard Prince.³⁰⁰

Salinger, on the other hand, was entitled to protect his work from sequels in his case even though he had claimed no interest in ever publishing again and lived as a recluse, making market harm claims dubious.³⁰¹ These examples suggest why scholars describe fair use as among the most significant, yet increasingly confounding, limitations on copyright protection.³⁰² Such aberrant evaluations might be remedied, however, if the court in either instance memorialized a meaningful substantial similarity comparison of the works themselves.³⁰³

Outcomes differ when courts compare works alleged to be infringing with the originals they use. Results are best when courts take care not to afford canonical or celebrity status to either work or artist. *Suntrust Bank v. Houghton Mifflin Co.*³⁰⁴ considered Alice Randall's parodic sequel *The Wind Done Gone*. The district court compared the work to its target—the iconic *Gone with the Wind*—in a thorough opinion.³⁰⁵ The circuit court denied a preliminary injunction because it

298. See *Cariou*, 714 F.3d at 709.

299. *Id.*

300. *Id.* at 344 (“However, when Celle became aware of the Canal Zone exhibition at the Gagosian Gallery, she cancelled the show she and Cariou had discussed.”), *rev'd in part*, 714 F.3d 694 (2d Cir. 2013).

301. See *Salinger v. Colting*, 607 F.3d 68, 74 (2d Cir. 2010).

302. See *id.*; *Cariou*, 714 F.3d at 709.

303. See *Cariou*, 784 F. Supp. at 346–47 (neglecting to discuss substantial similarity but noting the significant evidentiary record before jumping from discussion about copyrightability of photographs to fair use); *Salinger*, 641 F. Supp. 2d at 254 (stating summarily only that “the [c]ourt found that [p]laintiff has shown that there is substantial similarity between *Catcher* and *60 Years*, as well as between the character Holden Caulfield from *Catcher*, and the character Mr. C from *60 Years*, such that it was an unauthorized infringement of [p]laintiff's copyright” before moving to fair use analysis).

304. 268 F.3d 1257, 1259 (11th Cir. 2001).

305. See *id.* at 1265–67.

disagreed with the district court's fair use analysis.³⁰⁶ Regardless, both courts relied on the thorough evidentiary record available.³⁰⁷ Understanding whether copyright protected the scenes, characters, and short phrases taken from *Gone with the Wind* was important to properly scope the analysis of both the first and the third factors under fair use.³⁰⁸ Under factor one, the circuit court focused its attention on how Randall used protected elements from *Gone with the Wind* in her work to determine whether Randall's purpose was transformative.³⁰⁹ The court determined the work was a transformative parody specifically criticizing the depiction of slavery and the relationships between Black and white characters in *Gone with the Wind*.³¹⁰ Because both works were works of fiction, to determine whether the amount taken was reasonable in light of the purpose of the use under factor three, the court relied on the substantial similarity determination of protectable elements again.³¹¹ If the court did not first determine whether a character, scene, or phrase was protectable and the context in which it was used by both works, it could not parse whether a use was truly offered as a social critique or for unprotected purposes.³¹²

The transformative use test has grown to dominate fair use decisions and is involved in 90 percent of decisions in recent years.³¹³ Where parties successfully assert transformative use, courts tend to treat it as "a shortcut to fair use."³¹⁴ Courts will consistently override findings of commercial purpose or bad faith under factor one,³¹⁵ diminish the weight they grant to the nature of the work under factor two,³¹⁶ and dismiss the sliding-scale analysis under factor three.³¹⁷ Courts' evaluation of market harm is also "deeply influenc[ed]" by a finding of transformative use in factor one.³¹⁸ This leads courts to dismiss evidence of market substitution, and is the source of suspect claims that the defendant asserting transformative fair use is serving

306. *Id.* at 1276–77.

307. *Id.* at 1270.

308. *See id.* at 1269–74.

309. *See id.* at 1269–71.

310. *Id.* at 1270–71.

311. *See id.* at 1272.

312. *See id.* at 1271–72.

313. Liu, *supra* note 17, at 163; *see also* Asay et al., *supra* note 17, at 912.

314. Liu, *supra* note 17, at 167.

315. *Id.* at 163.

316. *Id.* at 168.

317. *Id.*

318. *Id.*

“an audience of a different caliber.”³¹⁹ Courts have extended the doctrine beyond its original contours.³²⁰ All of these data points underscore the importance of grounding fair use—and in particular the assessment of the transformative character and purpose of a work—in substantial similarity. Failure to do so leads to decisions that are unmoored from basic doctrines of copyright law as described in this Article.

A 2020 empirical study by Professor Clark Asay suggests that courts have increasingly suffused their analyses of each of the factors with a transformative use analysis.³²¹ Over time, courts have divorced the *Campbell* Court’s decisions from their facts, retaining only the statements regarding the Court’s treatment of the factors. For instance, the Supreme Court noted in considering factor two that parodies “almost invariably copy publicly known, expressive works.”³²² This makes the second factor largely irrelevant to resolving parody cases, but this analysis is not uniformly applicable to other use scenarios. Nevertheless, factor two became less significant to all fair use outcomes post-*Campbell*.³²³ Similarly, regarding factor three, the *Campbell*

319. *Id.*

320. *See, e.g.,* Authors Guild, Inc. v. Google Inc., 954 F. Supp. 2d 282, 292–93 (2013). *But see* Matthew Sag, *Predicting Fair Use*, 73 OHIO ST. L.J. 47, 74–77, 79–80, 84 (2012) (studying several factors that appear to predict whether a use is likely to be considered a fair use and including an emphasis on factors likely to lead to a finding of transformative use and, therefore, fair use); Pamela Samuelson, *Unbundling Fair Uses*, 77 FORDHAM L. REV. 2537, 2548–63, 2619–20 (2009) (pushing back against the common critique that fair use is unpredictable by creating a taxonomy of typical fair uses that courts have recognized, including a category of uses that are likely to be considered transformative uses); Asay et al., *supra* note 17 (referencing Sag’s and Samuelson’s articles and generally collecting and commenting on other scholarly articles empirically analyzing application of transformative fair use).

321. *See* Asay et al., *supra* note 17, at 918. Other important findings include: Both district and appellate courts apply the transformative use doctrine in at least equal numbers; this is significant given that many cases are never appealed. *Id.* at 932. District and appellate courts in the Second and Ninth Circuits dominate fair use case law, Second Circuit courts apply transformative use in 87 percent of their opinions, Ninth Circuit courts in 84 percent. *Id.* at 934. The Seventh Circuit hears far fewer fair-use cases than the Second Circuit but applies the transformative use test in “near equal measure;” however, it increasingly raises the test to criticize overreliance on the concept, and the Second Circuit as its originator. *Id.* at 935–36. Other circuits frequently cite Second and Ninth Circuit case law when defining and applying the transformative use test. This includes the Seventh Circuit (critic of the Second Circuit) which cites the Second Circuit more often than it cites itself. And the Second and Ninth Circuits cite each other on fair use. *Id.* at 937. Overall win rates in all circuits combined are 50.34 percent. The Second Circuit is above average with a 58.18 percent win rate when asserting fair use, and the Ninth is below average at 45.26 percent. *Id.* at 940 tbl.7.

322. *Campbell*, 510 U.S. at 586–88.

323. *See, e.g.,* Dr. Seuss Enters., L.P. v. ComicMix LLC, 983 F.3d 443, 456 (9th Cir. 2020) (“[T]he second factor ‘typically has not been terribly significant in the overall fair use balancing.’”).

Court recognized that parodies may need to take aim at the original's heart to make their parodic points evident and that the copying of the lyrics in *Campbell* was not excessive in light of the song's parodic purpose.³²⁴ This analysis too was taken out of its original context with the result that transformative users were granted greater and greater leeway by courts to take more liberties with significant portions of works, assuming they can justify the appropriation.³²⁵ This highlights ambiguity underlying whether such an expansion beyond *Campbell*'s facts would have occurred had courts methodically performed thorough substantial similarity analyses as the *Suntrust* courts did before turning to fair use,³²⁶ giving the appellate courts the benefit of a well-developed factual record to consider all four fair-use factors.

The Supreme Court reminded lower courts in *Warhol* that *Campbell* is a nuanced decision.³²⁷ The majority directs that fair use balances the interests between original works and secondary uses by examining “objective indicia of the [challenged] uses’ purpose and character, including whether the use is commercial,” and the “reasons for copying.”³²⁸ Refocusing factor one on understanding both parts of this equation helps return attention to the value the statute places on original works and ensures that the copyright owner’s derivative use right remains viable.³²⁹ Because courts will benefit from understanding

324. *Campbell*, 510 U.S. at 586–89. The Court remanded for further consideration on the musical composition. It is no doubt heresy to ask what might have been had the *Campbell* Court itself enjoyed the benefit of a full substantial similarity analysis from the district court, but it is notable that the Court remanded for further evaluation of the amount of the musical composition taken, in light of the song’s parodic purpose and character of its transformative elements and considerations of the potential for market substitution. Clearly the Supreme Court did not feel equipped to determine these issues without an adequate evidentiary record, developed through further evaluation of the similarity of the works. *Id.* at 571.

325. *See Asay, supra* note 11, at 919. Note that Professor Asay critiques an influential analysis by Professor Baron Beebe as well as studies by other scholars for not adequately accounting for the court’s teachings in *Campbell* and for failing to track inter- and intra-factor influence. *Id.* at 923. Other studies also exist and are respectfully critiqued by Professor Asay for lacking the empirical depth of the Liu and Asay studies. *See id.* at 921–26. Asay also explicitly disagrees with Beebe’s interpretation of Beebe’s dataset: “In our view, the fact that over eighty-one percent of post-*Campbell* appellate opinions and nearly sixty percent of district court opinions in his dataset explicitly considered transformative use is actually strong evidence that transformative use is one of the most dominant considerations in fair use case law.” *Id.* at 930.

326. *See Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1265–67 (11th Cir. 2001).

327. *See Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 143 S. Ct. 1258, 1283 (2023).

328. *Id.* at 1287.

329. *Id.* at 1261 (“To preserve the copyright owner’s right to prepare derivative works, defined in § 101 of the Copyright Act to include ‘any other form in which a work may be recast, transformed, or adapted,’ the degree of transformation required to make ‘transformative’ use of an original work must go beyond that required to qualify as a derivative.”).

the context and considerations affecting the creation and use of works in making these judgments, the decision provides further reason for parties to adequately brief and litigate threshold infringement issues.³³⁰

Nowhere can the ascendance of the transformative use test be seen as vividly as in the evolution of the Second Circuit's jurisprudence vis-à-vis appropriation art.³³¹ Professor Jane Ginsburg traced this evolution up to what the *Warhol* court deemed "the high-water mark" of its fair use jurisprudence—the *Cariou* case.³³² She concludes that the Second Circuit's endorsement of using another artist's work as raw material invites misuse and impinges on the right to authorize derivative works, thus problematically expanding fair use.³³³ However, she likewise notes that if a second author relies too heavily on a first author's work, the argument that the second author's use has a negative market impact on the first author's derivative works' licensing market is circular.³³⁴ A secondary user's reliance on fair use instead of licensing decreases the original author's revenues and therefore has a negative market impact on the copyright holder.³³⁵ Courts address this circularity problem by examining the degree to which a second author "reworks" a work.³³⁶ "[I]f the defendant has insufficiently reworked the plaintiff's creation, the court can comfortably find an invasion of the plaintiff's markets."³³⁷ Such an analysis may put courts "in the position of second-guessing artistic judgments."³³⁸ Professor Ginsburg asserts that courts must not "genuflect before assertions of artistic prerogative." She contends that courts should instead examine whether the use actually "transforms" the copied content, and whether the extent of the copying necessarily advances the transformative objective, or instead "simply adds embellishment."³³⁹

Professor Ginsburg's analysis of how courts attempt to harmonize derivative markets and transformative uses shows the extent to which fair use inquiries are fact-dependent and fraught with

330. See *id.* at 1287 (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578 (1994)) ("The Court has cautioned that the four statutory fair use factors may not 'be treated in isolation, from one another. All are to be explored, and the results weighed together, in light of the purposes of copyright.'").

331. See Ginsburg, *supra* note 149, at 277 n.55.

332. *Id.*

333. *Id.* at 273–74.

334. *Id.* at 274 n.34.

335. See *id.* at 274.

336. *Id.*

337. *Id.*

338. *Id.*

339. *Id.*

aesthetic considerations. To avoid circularity, courts should prioritize understanding the two works at issue and how they achieve their expressive aims. If courts first determine whether the second author's use is infringing because it takes too much of the protectable expression audiences value from the first author and only apply the affirmative defense of fair use should it prove necessary, they will also render rulings that are directly useful to more people. As the *Warhol* majority reminded courts, fair use is analyzed on a use-by-use and a user-by-user basis.³⁴⁰ Therefore, courts must be careful not to allow an artist to stand in for a later user such as the Warhol Foundation in analyzing fair use scenarios far-removed from the creation of the work.³⁴¹ However, the same logic does not apply to analyzing basic infringement. If a court applies a substantial similarity analysis and finds that a second artist's work does not infringe the first work because it is not substantially similar, that determination applies to the work itself.³⁴²

Since the definition of a derivative work includes the right to "transform" the original work, one of the challenges the transformative use test introduced is how to define a copyright owner's exclusive right to make and license derivative works separately from the fair use defense.³⁴³ A transformative use must go beyond the realm of derivative uses.³⁴⁴ However, if courts apply fair use as an affirmative defense to copyright infringement and not prematurely before performing an infringement analysis, the trier of fact will be less likely to misunderstand this distinction.

The crux of the infringement analysis pursuant to a substantial similarity test is whether the defendant *took from* the plaintiff so much of what is rightfully plaintiff's copyrighted work that it harms the plaintiff.³⁴⁵ If it is established that the defendant has done so, the defendant may nevertheless prevail under the transformative use test by showing that the defendant's use of the new work "*adds something new, with a further purpose or different character, altering the first with new expression, meaning or message.*"³⁴⁶ According to the *Warhol* majority, the use must also be objectively justifiable under the

340. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 143 S. Ct. 1258, 1277 (2023).

341. *See id.*

342. NIMMER, *supra* note 7, § 13.03(A).

343. *See Warhol Found.*, 143 S. Ct. at 1275.

344. *Id.*

345. *Arnstein v. Porter*, 154 F.2d 464, 473 (2d Cir. 1946), *abrogated on other grounds by Heyman v. Com. & Indus. Ins. Co.*, 524 F.2d 1317 (2d Cir. 1975).

346. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994) (emphasis added).

circumstances, including, importantly, commercial use.³⁴⁷ Therefore, courts should comprehend both works through a substantial similarity infringement analysis first, before proceeding to analyze fair use. In doing so, they will reach a better result overall, including when they apply the transformative use test: one that respects both artists and their respective works. Justice Kagan and Chief Justice Roberts's dissent in *Warhol* queried when the creative contributions of a second artist would be evaluated.³⁴⁸ If, as the dissenting justices posit, two works are completely different—if they do not share the same aesthetic and do not convey the same meaning—then such facts should be established in a threshold substantial similarity analysis and no fair use defense for any challenged use should be necessary.³⁴⁹ Logically, the second work simply does not infringe the first—no matter how it is used or by whom. The next Part demonstrates how a case involving the work of two artists might be analyzed.

V. THE ORIGINALITY, SUBSTANTIAL SIMILARITY, AND FAIR USE
DOCTRINES SHOULD BE CONSIDERED SEQUENTIALLY TO ACHIEVE THE
BEST RESULTS

Imagine a photographer has photographed a beloved musician and registered copyright in the photograph. Another artist creates a drawing from the photograph by using a lightbox to project and trace the image onto paper without the authorization of the photographer. The artist colorizes the drawing by washing it with a transparent purple tint. The second artist reproduces and sells signed, limited editions of the purple-hued drawing to collectors. The first artist sues the second artist for copyright infringement. The second artist denies infringing the copyright in the photograph and asserts various defenses, including fair use.

To establish infringement, a plaintiff must prove two things: ownership of a valid copyright and that the defendant has copied original elements from the copyrighted work.³⁵⁰ To qualify for copyright

347. *Warhol Found.*, 143 S. Ct. at 1273.

348. *Id.* at 1292 (Kagan, J., dissenting) (quoting *Campbell*, 510 U. S. at 579) (“Before today, we assessed ‘the purpose and character’ of a copier’s use by asking the following question: Does the work ‘add[] something new, with a further purpose or different character, altering the [original] with new expression, meaning, or message?’”).

349. See *id.* (“When it did [differ] so to a significant degree, we called the work ‘transformative’ and held that the fair-use test’s first factor favored the copier (though other factors could outweigh that one).”).

350. *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991).

protection, the photograph must exhibit originality.³⁵¹ Originality requires that the author independently created the work, and that the work possesses at least some degree of creativity.³⁵² Given this low bar for originality, courts generally have little trouble deeming photographs and other artworks to be copyrightable.³⁵³ Further, to maintain an infringement suit, plaintiffs must register a copyright with the US Copyright Office, and a valid registration certificate confers on the artist a rebuttable presumption of copyright validity if the registration was made in a timely manner.³⁵⁴ This would confer a valid copyright in the photograph.

However, to establish infringement, the first artist must also prove that the second artist has copied original elements (protectable expression) from their work.³⁵⁵ In general, regardless of the specific test a jurisdiction applies,³⁵⁶ the first artist demonstrates infringement by establishing the alleged infringer had access to the original work and that substantial similarity exists between the works.³⁵⁷ Proving access can be challenging with respect to some genres of copyrighted works because defendants tend to claim independent creation. However, the example in this hypothetical is patterned after appropriation art cases, where “appropriation” of existing images and objects into new works is the point, the second artist does not usually deny access or copying.³⁵⁸

351. *Id.* at 340.

352. *Id.* at 345.

353. *Cariou v. Prince*, 784 F. Supp. 2d 337, 346 (S.D.N.Y. 2011) (“[I]t has been a matter of settled law for well over one hundred years that creative photographs are worthy of copyright protection even when they depict real people and natural environments.”), *rev’d in part*, 714 F.3d 694 (2d Cir. 2013).

354. 17 U.S.C. § 410 (“In any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate.”).

355. *Feist Publ’ns, Inc.*, 499 U.S. at 345.

356. See discussion *infra* Section III.B (discussing the similarity in outcomes of decisions despite differences in how tests are articulated in each of the Circuits).

357. See, e.g., JUD. COUNCIL OF U.S. ELEVENTH CIR., CIVIL PATTERN JURY INSTRUCTIONS § 9.17 (2022).

358. See *Art Term: Appropriation*, TATE, <https://www.tate.org.uk/art/art-terms/a/appropriation> [<https://perma.cc/ZEW6-XKNX>] (last visited Sept. 10, 2023). In cases where direct evidence of access is an issue for an artist, it may be proved by showing that the second artist had a reasonable opportunity to see the work before creating her own work if the evidence reasonably establishes that the defendant could have seen it and could have copied it, but this cannot be based on mere conjecture or speculation. Access can also be established by proof of “striking similarity” if an artist can prove that the similarities between the works are so striking that a reasonable person would assume that the second artist copied the first work, rather than creating the work independently, or that similarities occurred by coincidence or prior common source. See, e.g., JUD. COUNCIL OF U.S. ELEVENTH CIR., *supra* note 357, § 9.18.

Accordingly, an infringement analysis will turn on the substantial similarity comparison of the two works to determine if *wrongful* copying occurred.³⁵⁹ The first artist will prevail if the court determines that the second artist copied sufficient protectable expression from the photograph.³⁶⁰ The court will find for the second artist if the purple-toned drawing copied only unprotectable facts, used them in a fragmentary manner where the second author's own contributions overshadow the original, or used only the first artist's idea.³⁶¹ Note that the focus in this stage of the inquiry is on similarity between the works, which is consistent with the complaining artist having the burden of proof.

If the question is presented in the abstract, few will dispute that the complaining artist should prove the elements of the infringement case, as opposed to a court shifting the burden to the defending artist to establish an affirmative defense. However, such burden shifting happens regularly in copyright litigation. Not infrequently, the accused artist even initiates this burden shifting by filing a summary judgment motion early in the proceedings arguing fair use.³⁶²

This should not surprise experienced litigators or judges. If the complaining artist requires discovery to build a case, cutting off discovery and framing the argument in fair use terms before the first artist has laid the groundwork on wrongful appropriation may be a litigation tactic. In a substantial similarity analysis, the burden of proof rests with the copyright holder to establish similarities between the works and that the second work wrongfully appropriates the original author's expression.³⁶³

Moreover, inviting a court to explore the similarities between the works leads it to view the works from the first artist's perspective. Here, sequencing and framing can matter. Omitting the original artist's opportunity to frame their case can, at least theoretically, have a powerful effect on outcomes. Literature in the cognitive sciences teaches that an object that is suggested as the baseline for comparison

359. See NIMMER, *supra* note 7, § 13.03(F)(1)(a).

360. See *id.* § 13.03(B)(2)(a).

361. See *id.* § 13.03(F)(1)(b); see also *Blanch v. Koons*, 467 F.3d 244, 257 (2d Cir. 2006).

362. See, e.g., *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 382 F. Supp. 3d 312, 316 (S.D.N.Y. 2019), *rev'd*, 992 F.3d 99 (2d Cir. 2021), *aff'd*, 143 S. Ct. 1258 (2023); *Ranieri v. Adirondack Dev. Group, LLC*, 164 F. Supp. 3d 305, 318 (N.D.N.Y. 2016); *Kennedy v. Gish, Sherwood & Friends, Inc.*, 143 F. Supp. 3d 898, 902–03 (E.D. Mo. 2015); *Cariou v. Prince*, 784 F. Supp. 2d 337, 342 (S.D.N.Y. 2011), *rev'd in part*, 714 F.3d 694 (2d Cir. 2013); *Rogers v. Koons*, 751 F. Supp. 474, 475 (S.D.N.Y. 1990), *aff'd*, 960 F.2d 301 (2d Cir. 1992).

363. See NIMMER, *supra* note 7, § 13.03(A)(2)(b).

influences individuals' perception of the second object.³⁶⁴ If a court does not take the time to consider the original copyright owner's case in substantial similarity terms, the first artist is limited in how powerfully they can frame their case.³⁶⁵

In contrast to the substantial similarity inquiry, the fair use defense—and transformative use in particular—focuses the court's attention on whether the second artist has established sufficient differences between the works.³⁶⁶ Since fair use is an affirmative defense,³⁶⁷ the phrasing of the transformative use question invites the court to view the works from the perspective of the second author, including what the author has added to a work. Transformative use analyses in visual arts cases are unsatisfying in the absence of developed substantial similarity comparisons. Specifically, such analyses lack: an evidentiary record supporting the first work's originality; an inquiry into what (if anything) is original about the second work; and a determination of whether the second work's use of the first work's protectable elements is actionable as infringement.³⁶⁸

Absent the evidence a threshold analysis generates, a discussion of transformative use inadequately answers the transformativeness inquiry, including whether the second artist has copied only as much as is reasonable. Instead, after determining a work is transformative, courts tend to address factor three, which asks whether the second author is using only so much of a first work as is reasonable to advance

364. Hickey, *supra* note 133, at 685 (citing, Kate Klonick, *Comparing Apples to Applejacks: Cognitive Science Concepts of Similarity Judgment and Derivative Works*, 60 J. COPYRIGHT SOC'Y U.S.A. 365, 383 (2013)) ("Framing can result in asymmetrical similarity judgments depending on what is being considered as the referent and what is being considered as the subject."); Amos Tversky, *Features of Similarity*, 84 PSYCH. REV. 327, 340 (1977) ("Like other judgments, similarity depends on context and frame of reference.").

365. See *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 143 S. Ct. 1258, 1292 (2023) (Kagan, J., dissenting). Moreover, one can imagine that properly targeted discovery might even unearth evidence that copying was conducted purely for the artist's convenience, to advance the second artist's own narrative, or because the second artist believed they could produce a better version of the first artist's work. Such evidence would not only suggest wrongful copying, but could undercut a fair use defense as well. Prior to the recent Supreme Court ruling in the *Warhol Foundation* litigation, which makes clear that every assertion of transformative use must be defended on a use-by-use basis and justified according to the specific circumstances of the user, some litigants may have believed that strategic admissions concerning copying and skipping a substantial similarity inquiry could hinder the original artist from obtaining information that would be useful in mounting their case. See *generally id.* at 1277 (majority opinion).

366. See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994) (quoting *Folsom v. Marsh*, 9 F. Cas. 342, 348 (C.C.D. Mass. 1841)).

367. See NIMMER, *supra* note 7, § 13.03(A)(2)(b).

368. See discussion *infra* Part VI.

the transformative purpose.³⁶⁹ Without some understanding of whether the elements taken from an earlier work have been wrongfully copied, courts cannot adequately answer the question factor three poses. As a result, the trend is to overlook the factor.

Returning to the hypothetical, the court should require the first artist to prove that the second artist wrongfully appropriated sufficient protectable expression to be actionable. The photographer should not assume that just because the court has determined the first author holds a valid copyright and the second artist has admitted to using the work, the substantial similarity comparison is complete. The prevailing approach is to evaluate artworks for substantial similarity as a whole rather than dissect them into incoherent elements.³⁷⁰ However, unprotectable elements exist in photographs and other works of visual art as they do in all copyrightable works, and copyright law takes account of that fact through its core doctrines.³⁷¹ Artists should therefore not be reticent in helping courts to understand their works.

Portraits present a particular challenge. Case law dictates copyright only protects the artistic choices the photographer makes and not the underlying facts about the subject.³⁷² But this distinction can be difficult to draw. In a lawsuit in the Central District of California, professional photographer Jeff Sedlik filed a response describing the myriad creative choices he made to achieve the desired creative expression in his iconic portrait of Miles Davis.³⁷³

Sedlik's sensitive elaboration of his creative process explains the meticulous planning of every element of the photograph.³⁷⁴ It also provides behind-the-scenes insights to how images like the Miles Davis portrait are designed and crafted to manifest the artist's vision in many other ways.³⁷⁵ Sedlik cites significant time spent researching and listening to Miles Davis's work and distilling what he learned into

369. See *Campbell*, 510 U.S. at 586.

370. See discussion *infra* Section III.B (discussing the substantial similarity doctrines).

371. NIMMER, *supra* note 7, § 13.03(F)(5).

372. *Leibovitz v. Paramount Pictures Corp.*, 137 F.3d 109, 115–16 (2d Cir. 1998).

373. See Plaintiff Jeffrey B. Sedlik's Second Supplemental Response to Defendants' First Set of Special Interrogatories at 2–15, *Sedlik v. Von Drachenberg*, No. CV 21-1102 DSF (MRWx), 2022 U.S. Dist. LEXIS 231517* (C.D. Cal. June 27, 2022) (No. 2:21-cv-01102-DSF-MRWx).

374. *Id.* at 3. Sedlik meticulously planned every element necessary for the photograph—natural and artificial lighting and lighting modifiers, choosing cameras, lenses, and mocking up positioning, depth of field, backgrounds, foregrounds, props, wardrobe, styling, makeup, pose, expression, making plans for subject direction, film type, etc.—all required to achieve his envisioned expression. *Id.*

375. See *id.*

concepts representing his desired creative expression.³⁷⁶ He first fixed those concepts in hand-drawn sketches which he iteratively refined.³⁷⁷ Sedlik explains he executed the shoot in surprising circumstances.³⁷⁸ The mood of the image suggests a dark jazz club, but in reality the portrait was made outdoors in bright sunlight on the patio of Miles Davis's beach house.³⁷⁹ This required specialized lighting and environmental controls, which Sedlik constructed and repeatedly tested and revised, then struck, loaded, transported, and reassembled at Davis's house the day of the shoot.³⁸⁰ These might sound like descriptions of labor, but Sedlik set forth the narrative instead to demonstrate that his vision was manifested in every single element of the image he produced.³⁸¹ Sedlik's authorial expression culminates in the way he portrays Miles Davis's beautifully expressive face.³⁸²



FIGURE 3: © JEFFREY SEDLIK, INCLUDED WITH PERMISSION OF THE ARTIST

376. *Id.* at 3.

377. *Id.*

378. *See id.* at 3–4.

379. *Id.* at 3.

380. *Id.*

381. *Id.* at 2–3.

382. *Id.* at 4–5. Sedlik orchestrates countless creative and technical details to achieve the portrait. He instructs the makeup artist on the makeup to use with the lighting he designed to achieve the right reflective qualities and get the desired highlights. He readjusts lighting in the last minute, cutting a hole in sailcloth to ensure a shaft of sunlight is positioned right above Davis. He angles reflectors to get the desired highlights and shadows, to diffuse light around the outdoor studio he has constructed, and creates white catchlights in Miles' eyes for the result he has planned when first sketching the images. *Id.*

Sedlik describes fine tuning Miles Davis's pose—physically adjusting the angle of his shoulders and arms, directing him to position his hand and face, and telling Davis to tense all his facial muscles simultaneously to intensify the veins on his face.³⁸³ The ultimate design of the pose—Miles's finger to his lips—symbolizes his masterful use of silence in his music, placing equal emphasis on the notes and the pauses between them.³⁸⁴ It is also, Sedlik notes, a visual homage to Miles Davis's great masterpiece *In a Silent Way*.³⁸⁵ As a final coda, Sedlik “rotated Miles Davis's hand and positioned his fingers in a cascade visually representing aurally perceived musical notes.”³⁸⁶

Sedlik's testimony demonstrates the artist manifesting his personality and creativity throughout the image. He testified “[t]he range of creative choices available to [me] in producing the Iconic Miles Davis Portrait was not merely broad—it was infinite.”³⁸⁷ Should it choose to use Sedlik's testimony, the Central District of California will have the benefit of understanding how Sedlik “made” the photograph “entirely from his own conception.”³⁸⁸

The statement suggests one could properly attribute virtually everything about the photograph to Sedlik's deliberate and elaborate planning to achieve a specific creative result.³⁸⁹ The first artist in the hypothetical would be wise to do the same. Even if the court does not require a description of protectable elements, the photographer should include a similar artist's narrative as part of their summary judgment motion on fair use. If the second artist were to claim that, for instance, the added purple wash eliminated or altered creative elements of the first artist's photograph, a detailed description of all the creative inputs by the first artist to the work is likely to be helpful to the court.³⁹⁰ Recalling Judge Hand's process of evaluating substantial similarity in *Nichols* and transposing it to a hypothetical involving images, the artist will be well served to be specific in delineating their artistic contributions.³⁹¹ Of course, contemporaneous narratives or affidavits

383. *Id.* at 8.

384. *Id.*

385. *Id.*

386. *Id.*

387. *Id.* at 9.

388. *See* *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 54–55 (1884).

389. *See id.* at 59–60.

390. Note that according to the Supreme Court such edits would have to be purposeful commentary on the underlying photograph in order to justify a fair use finding on factor one. *See* *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 143 S. Ct. 1258, 1276 (2023).

391. *See Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 122 (2d Cir. 1930).

from the artist are not always available. In such cases, the estate representing the artist is in the best position to choose historic and critical reviews of the artist's work that might be helpful to provide similar contextual information.³⁹²

The parties in the *Warhol* litigation offered no such elaborate testimony about originality.³⁹³ Lynn Goldsmith also did not press for a thorough substantial similarity analysis, so while some record evidence exists with respect to Lynn Goldsmith's creative choices, it is relatively limited.³⁹⁴ For procedural reasons, her complaint focused primarily on matters concerning the Foundation's licensing practices.³⁹⁵

Regrettably, as the record of *Cariou* demonstrates, even when an artist does present thorough testimony concerning original creation and infringement, the lower court may not preserve an adequate record on substantial similarity in particular for the appellate courts.³⁹⁶ Appellate courts may accordingly take a diverging path.³⁹⁷ As a result, artists and their lawyers may question the value of offering foundational information on their process.

Although Lynn Goldsmith ultimately prevailed, under the Court's opinion, secondary users must offer compelling objective evidence beyond solely offering evidence of *any* new meaning or message to justify the copying of an original work.³⁹⁸ Accordingly, the *Warhol* test magnifies the need for an evidentiary analysis of the

392. See, e.g., *id.* at 123 (discussing how expert testimony “greatly extends the trial and contributes nothing” but rather testimony like that of a spectator should be included). Not all artists will wish to offer their own or other's responses to their work—preferring instead that the work stand on its own.

393. See Brief of Amicus Curiae Jeffrey Sedlik, Pro. Photographer and Photography Licensing Expert, in Support of Respondents at 2, *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 143 S. Ct. 1258 (2023) (No. 21-869). This appears to have been a strategic decision on Goldsmith's part since Jeff Sedlik was one of her expert witnesses and advised her on other elements of her approach. His testimony was offered to support her arguments on licensing. See *id.*; see also *Nichols*, 45 F.2d at 123.

394. See Amended Answer of Defendants, Amended Counterclaim of Lynn Goldsmith for Copyright Infringement and Jury Demand at 18, *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 382 F. Supp. 3d 312 (S.D.N.Y. 2019) (No. 17-cv-02532-JGK) [hereinafter Amended Answer of Defendants]. The Foundation, supported by academic amici, urged consideration of substantial similarity as a quicker path to resolution, arguing that any protectable elements had been stripped by Warhol's silkscreen process. Brief of Amici Curiae Copyright L. Professors in Support of Petitioner for Certiorari at 13–18, *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 143 S. Ct. 1258 (2023) (No. 21-869).

395. See Amended Answer of Defendants, *supra* note 394, at 13.

396. See discussion *supra* Part IV (discussing *Cariou v. Prince*, 714 F.3d 694 (2d Cir. 2013)).

397. See discussion *supra* Part IV.

398. *Warhol Found.*, 143 S. Ct. at 1285–86.

circumstances surrounding the creation and use of both works for courts to make a transformative use determination.

Returning to the hypothetical, assuming the first artist establishes that (1) most or all of the visible image in the photograph constitutes creative expression, and (2) by tracing directly from the photograph through the lightbox projection the second artist has reproduced the photograph more or less exactly, thus infringing one of the exclusive rights under § 106, the second artist may still assert the defense of fair use. Presumably, the second artist will argue the hand tracing and treatment with purple tint transformed the photograph.

Like the first artist, the second artist should submit evidence to help the court understand the artist's creative process, including how much protectable expression the second artist might have been copied and the artist's justification. Notably, only when one reaches the second artist's fair use defense does that inquiry actually require the court to consider whether the work has been "alter[ed] . . . with new expression, meaning, or message."³⁹⁹ This is also when the court considers the second artist's copying in the context of the asserted fair use purpose. The second artist should be prepared to explain the degree of difference between the use of material in the first work and second.

After the *Warhol* litigation, courts cannot merely accept assertions that any addition of material or alteration of message is automatically transformative under factor one.⁴⁰⁰ Instead, the justification for the use must be judged in context and is a question of degree.⁴⁰¹ In the hypothetical, as in the *Warhol* litigation, the court should consider the commercial purpose of the second work. However, the Supreme Court did not opine on gallery sales and museum exhibitions of the *Prince Series*, so there is not a definitive ruling on such uses.⁴⁰²

Nevertheless, the Court commented on Warhol's well-known *Soup Cans* series to illustrate a distinction between secondary works that are transformative and those merely adding the second artist's new meaning.⁴⁰³ The court distinguished *Soup Cans* from the *Prince Series* in a variety of ways. Both series make use of copyrighted works to

399. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994). In contrast, infringement decisions turn on aesthetic similarities—how many of the protectable elements of a work have been copied? What is the overall look and feel of the work? *See also* *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 539–40 (1985); *Mazer v. Stein*, 347 U.S. 201, 217 (1954).

400. *Warhol Found.*, 143 S. Ct. at 1282.

401. *Campbell*, 510 U.S. at 579.

402. *See Warhol Found.*, 143 S. Ct. at 1277–78.

403. *Id.* at 1282.

comment on consumerism, but the *Soup Cans* do not subsume the market for Campbell's logos because Warhol's purpose in using them is "orthogonal to advertising soup."⁴⁰⁴

The Foundation's use of *Orange Prince* differs in that it potentially competes with Goldsmith in her licensing market. Warhol also has a justification for targeting the logo in creating *Soup Cans*. Because the cans symbolize mass consumption, the logo itself enables the commentary. The logo is not merely the subject of the secondary work.⁴⁰⁵

By contrast, the *Prince Series* makes no particular commentary on the Goldsmith Photo itself. This combination of factors strengthens Warhol's claim regarding the *Soup Cans* and weakens the Foundation's claim concerning the commercial licensing of *Orange Prince* for the cover of a magazine. The comparison illustrates the court's direction that the first factor justification must be evaluated as a matter of degree. If the second artist's commercial use is likely to displace or subsume the market for the first work, then the second artist will need a stronger justification for the use of the first work.

Although the majority opinion gives room to doubt how intentional reproductions as a form of social commentary would be analyzed post-*Warhol*, there are still plausible arguments.⁴⁰⁶ Sherrie Levine is recognized for challenging notions of originality, identity, and authenticity in her work.⁴⁰⁷ She engages in social commentary by reproducing well-known art works by male artists, bringing to them a feminist perspective.⁴⁰⁸ Her series "After Walker Evans," comments on different societal themes like the loss of uniqueness as a result of mechanical and digital reproduction.⁴⁰⁹ In the series, she uses reproductions of works via the medium of photography to make her artistic point.⁴¹⁰ Applying the rule from *Warhol*, Levine might argue

404. *Id.*

405. *Id.*

406. See, e.g., Corrina Peipon, *Take It Or Leave It: Institution, Image, and Ideology*, HAMMER MUSEUM AT UCLA (2014), <https://hammer.ucla.edu/take-it-or-leave-it/artists/sherrie-levine> [https://perma.cc/9ZCQ-ZMPX].

407. *Id.*

408. See *id.*

409. See *id.*

410. *Id.*

that her art is nevertheless a fair use⁴¹¹ because it depends on using the first artist's work to make her point.⁴¹²

Moreover, even though the works may at first glance appear largely unaltered, the unconscious contributions of the artist behind the lens proves paramount. This is a theme that was important to Evans' work too.⁴¹³ Evans ascribed to the documentary philosophy of photography, which strove to represent the world as it exists.⁴¹⁴ His images, many shot on assignment for the Farm Security Administration, are frank and unadorned in style yet capture intricate and minute details about the lives, cultures, and communities he documented.⁴¹⁵ However, because Evans himself was from a wealthy family, his images of farm workers have an outsider's perspective and thus reveal something about himself as well.⁴¹⁶

The Levine series described above works by reproducing the original images ostensibly to make significantly different statements about the subject matter and Evans himself.⁴¹⁷ Levine's arguments regarding her creative contributions as transformative copier, and thus those available to other secondary artists are largely unchanged by *Warhol's* majority's holding.⁴¹⁸ It is true, however, that the further afield from Levine's personal creative uses, the more justifications a court will require. Thus, Levine would have to provide additional justifications should she seek to license her works for commercial uses, unless a court had found her works indeed not substantially similar or otherwise not infringing on the merits.

The next Part further explains why courts should ensure their approach to infringement cases in the visual arts conforms with

411. Since much of Evan's work was created under contract for the Federal Government and some of it in the 1920s, it may not be subject to copyright protection. Dep't of Photographs, *Walker Evans (1903–1975)*, METRO. MUSEUM OF ART (Oct. 2024), https://www.met-museum.org/toah/hd/evan/hd_evan.htm [<https://perma.cc/GG9U-WYYT>].

412. *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 143 S. Ct. 1258, 1283 (2023) (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580–81 (1994)) (“Distinguishing between parody (which targets an author or work for humor or ridicule) and satire (which ridicules society but does not necessarily target an author or work), the Court further explained that “[p]arody needs to mimic an original to make its point, and so has some claim to use the creation of its victim’s (or collective victims’) imagination, whereas satire can stand on its own two feet and so requires justification for the very act of borrowing.”).

413. See Dep't of Photographs, *supra* note 411.

414. See *id.*

415. See *Summary of Walker Evans*, ART STORY, <https://www.theartstory.org/artist/evans-walker/> [<https://perma.cc/8XPU-ADMA>] (last visited Sept. 15, 2023).

416. *Id.*

417. See *id.*

418. See *id.* at 1301 (Kagan, J., dissenting).

procedural justice and therefore should more thoroughly engage with substantial similarity analyses. It notes the manner in which the failure of courts and litigants to examine substantial similarity wreaks additional distortions on the fair use factors.

VI. COURTS DISTORT THE FAIR USE FACTORS BY DECIDING ORIGINALITY AND SUBSTANTIAL SIMILARITY ISSUES *SUB ROSA*

The earlier sections have introduced and described the core doctrines of copyright law necessary to resolve infringement cases, explained that these doctrines are all infused with aesthetic considerations, and explored a hypothetical to illustrate how an inquiry should proceed. This discussion foreshadowed several policy concerns that arise from omitting substantial similarity, the only explicitly comparative step in a three-step analysis for infringement. The resulting incomplete evidentiary record will likely stymie courts in their efforts to determine a permissible amount and type of copying. Empirical studies already show that courts have a tendency to ignore some traditional fair use factors.⁴¹⁹

The following cases illustrate how, particularly in appropriation art cases, courts are issuing decisions of limited value to other courts and future litigants.⁴²⁰ If courts avoid aesthetic inquiries and limit the record evidence they receive and pass on to appellate courts as a result, this harms both artists. Courts should seek instead to promote procedural justice that promotes confidence in and respect for judicial institution.

Cases involving Jeff Koons and Richard Prince perhaps best illustrate these concerns. These artists are notable both for their prolific creation of appropriation art and the associated infringement lawsuits.⁴²¹ The discussion of the lawsuits below surfaces another concern: that appellate courts are deciding substantial similarity cases *sub rosa* without applying the appropriate tests. When substantial similarity is not a question on appeal, appellate courts appear to apply the transformative use doctrine impressionistically as a means of deciding substantial similarity. This allows courts to use the fair use defense as a shortcut to rule in favor of artists without performing a full substantial similarity analysis.

419. See Asay, *supra* note 11, at 38–39; Liu, *supra* note 17 at 180.

420. See *Cariou v. Prince*, 714 F.3d 694 (2d Cir. 2013); *Blanch v. Koons*, 467 F.3d 244 (2d Cir. 2006).

421. See *Blanch*, 467 F.3d.; *Cariou*, 714 F.3d. at 698.

Given the utter dominance of transformative use in fair use considerations in recent years, such lack of transparency is particularly troubling. Undisciplined transformativeness analysis limits judicial accountability and is thus procedurally unfair to litigants. Unsurprisingly, however, when parties fail to present courts with a strong factual assessment of protectable elements in a work, courts rely on their independent assessments of whether an artist had transformative intent, meaning, or message. These are areas that are particularly difficult even for art historians and critics to evaluate and firmly pinpoint. If, instead, courts make adequate assessments based on comprehending the physical properties of works, copyright adjudication can be grounded in largely objective, factual determinations.

Furthermore, courts should apply a more discriminating observer test when confronted with works where the trier of fact needs to mentally account for protectable and unprotectable elements. This test would allow courts to discount unprotectable elements when assessing works but avoids the risk of dissecting a creative work into unrecognizable parts. The following discussion illustrates the merits of such an approach.

The Second Circuit's fair use analysis in *Cariou* is under-interrogated with respect to its treatment of the photographer Patrick Cariou and his sensitive portraiture of Jamaican Rastafarians.⁴²² Scholars outside the modern art world have in recent years found Richard Prince's exploitation of Cariou's work and the opinion excusing it troubling.⁴²³ Specifically, Richard Prince claimed to have no message about the Cariou works themselves, and perhaps no message at all.⁴²⁴ *Cariou* is also problematic in part because the court does not adequately ground its reasoning with a thorough substantial similarity analysis.

This is not because information about Cariou's creative process and works was lacking. Judge Deborah Batts, the author of the controversial district court opinion that originally found in favor of Cariou,⁴²⁵ notes in the opinion that "Cariou spent time with

422. See discussion *supra* Section IV.D ("In the dispute between Patrick Cariou and Richard Prince, Cariou was depicted by the circuit court as a lowly photographer hoping to license images from an out-of-print coffee table book, whereas the court marveled at Richard Prince and his ability to garner the admiration of celebrities and to sell them multi-million-dollar works at lavish openings in one of the many Gagosian galleries."); *Cariou*, 714 F.3d at 709.

423. See Andrew Gilden, *Raw Materials and the Creative Process*, 104 GEO. L.J. 355, 377 (2016).

424. *Cariou v. Prince*, 784 F. Supp. 2d 337, 349 (S.D.N.Y. 2011), *rev'd in part*, 714 F.3d 694 (2d Cir. 2013).

425. *Id.* at 355–56.

Rastafarians in Jamaica over the course of some six years, gaining their trust and taking their portraits.”⁴²⁶ She says that Cariou testified “at length” about the creative choices he made in composing and taking individual photos as well as the film processing and studio techniques he used to achieve his desired expression.⁴²⁷ Yet, rather than explain what she found original about both artists’ works, Judge Batts merely announced that “creative photographs are worthy of copyright protection even when they depict real people and natural environments.”⁴²⁸ This analysis addresses only the question of whether Cariou had a valid copyright and neglects substantial similarity.

The Second Circuit overturned Judge Batts on appeal.⁴²⁹ The Second Circuit’s hollow reasoning on fair use in *Cariou* has garnered significant criticism, with the court itself claiming it is its most extreme jurisprudence on the topic.⁴³⁰ The appellate court might have reached a different result, or at least its reasoning could have been more developed, had Judge Batts provided the Second Circuit with a record of a thorough substantial similarity analysis.

For instance, although the district court opinion notes in passing that Cariou provided voluminous testimony about his creative process and art practice, the opinion does not capture it.⁴³¹ In turn, the circuit court’s statement of facts concerning Patrick Cariou’s work mainly recounted the “limited commercial success” of his work⁴³² as compared to Richard Prince’s better-received alterations.⁴³³ The court evaluated the work de novo and did not conduct a substantial similarity comparison.⁴³⁴

Since the district court’s opinion reflected no such comparison either, the circuit court did not consider the originality of each artist’s work.⁴³⁵ Nor did it consider the interplay of ideas and expression in the

426. *Id.* at 343.

427. *Id.*

428. *Id.* at 346.

429. *See* *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 38 (2d Cir. 2021), *aff’d*, 143 S. Ct. 1258 (2023).

430. *Id.*

431. *Cariou*, 784 F. Supp. 2d at 343.

432. *Cariou v. Prince*, 714 F.3d 694, 699 (2d Cir. 2013). The court notes that Cariou’s book is out of print; that over 60 percent of the copies sold below the original retail price; that the publisher paid Cariou just over \$8,000 from sales of the book; and that Cariou has never sold or licensed individual photographs except through a handful of private sales to personal acquaintances. *Id.*

433. *Id.*

434. *Id.* at 704.

435. *See id.*

artists' works.⁴³⁶ The circuit court consequently had no record to support its holding that Prince's images are aesthetically different from Cariou's in character, expression, and creative and communicative results.⁴³⁷

The Second Circuit did not seek an objective justification for Richard Prince's use of the Cariou photographs that would have supported a transformation in character or purpose.⁴³⁸ Instead, the circuit court asserted that its observation of Prince's artworks themselves convinced it of transformative nature of all but five of the works because they manifested "an entirely different aesthetic" from Cariou's photographs.⁴³⁹ If that was so, then perhaps the court should have found a lack of substantial similarity before ever reaching fair use. Instead, this reasoning resulted in a fair use ruling that consisted of a graph of twenty-five separate findings attesting that the court "observed" each of Prince's artworks to be "different" than Cariou's.⁴⁴⁰

The case also demonstrates that a court's premature fair use analysis can improperly put greater focus on the meaning and message of artworks. This pressures artists to articulate a coherent narrative that contextualizes their work more broadly regardless of whether the artist created that work with such expressive intentions in mind. The district court in *Cariou* originally ruled against Prince based on his testimony that he was uninterested in Cariou's expressive intent and had no particular message of his own to convey either.⁴⁴¹

If, instead of probing transformative use, the court had merely looked to whether the works were substantially similar, such a method would obviate the need to establish one artist's intent to comment on the other's. Since the court found the works to be completely different aesthetically, ruling under substantial similarity grounds would have allowed the court more precision to articulate its reasoning. If the facts supported such a conclusion, the court could have explained that copyright did not protect the expression Prince appropriated, or that

436. *See id.*

437. *Id.* at 708.

438. *Id.* at 707.

439. *Id.* at 706.

440. *See id.* The lack of analysis in the decision is in sharp contrast to the thoughtful contemplation set forth in Judge Learned Hand's substantial similarity cases. One can't help but think that the Second Circuit was also reacting to the remedy of destruction ordered by Judge Batts especially since there was no factual analysis on wrongful appropriation in the district court opinion to persuade the appellate court of the correctness of this remedy. *See id.* at 712 n.5.

441. *Id.* at 707.

Prince took insufficient expression, or that the expression Prince took was fragmentary and submerged in the additional contributions.

Such explanations would have been helpful to other visual artists and later litigants. Instead, by ruling on fair use alone, the circuit court in *Cariou* said only that the works were aesthetically “different.”⁴⁴² The circuit court failed to explain the differences it saw and instead stated bluntly that it “examine[d] how the artworks may ‘reasonably be perceived’ . . . and [it saw] twenty-five of them as transformative as a matter of law.”⁴⁴³

Skipping the substantial similarity analysis can prolong litigation and distort the fair use analysis because courts are forced to account for the failure of lower courts to analyze cases under this framework. As the discussion of the district court opinion in *Cariou* demonstrates, courts can do equal harm short-circuiting the analysis, regardless of whether they find infringement. On the other hand, when district courts perform a thorough substantial similarity analysis, it can be useful to the appellate courts and artists alike.⁴⁴⁴

Cariou's underdeveloped substantial similarity analysis contrasts greatly with the thorough analysis performed by the district and the circuit courts in *Koons v. Rogers*.⁴⁴⁵ There, appropriation artist Jeff Koons contended that he relied on only non-copyrightable elements of the professional photographer Art Rogers's photograph as “source material” to create the sculpture *String of Puppies*.⁴⁴⁶ The courts carefully considered how each artist created his work and rejected Koons' argument. Both courts were persuaded that photographer Art Rogers had exercised substantial creative effort in the composition and production of the photograph.⁴⁴⁷ Rogers drew on his years of artistic experience to select the lighting, location, seating, and arrangement of the subjects.⁴⁴⁸ He also made creative and technical judgments throughout the shoot, including subsequent developing, printing and

442. *See id.* at 711.

443. *Id.* at 707.

444. *But see* Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 52 (2d Cir. 2021), *aff'd*, 143 S. Ct. 1258 (2023).

445. *Rogers v. Koons*, 751 F. Supp. 474, 478 (S.D.N.Y. 1990); *Rogers v. Koons*, 960 F.2d 301, 308 (2d Cir. 1992).

446. *See Rogers*, 751 F. Supp. at 476–77.

447. *Id.* at 480; *Rogers*, 960 F.2d at 304.

448. *Rogers*, 960 F.2d at 304.

selection of the images.⁴⁴⁹ By contrast, Jeff Koons directed that a factory in Italy fabricate the sculpture *String of Puppies* “as per photo.”⁴⁵⁰

Koons objected to the district court’s substantial similarity analysis, claiming a trial judge uneducated in art would not be an appropriate decision maker,⁴⁵¹ but the court rebuffed this assertion.⁴⁵² It probed what made the photograph original and unique, considering how the photograph and the sculpture each used the idea and its expression:

It is not [the ideas of a couple with eight small puppies seated on a bench that is protected, but rather Roger’s *expression* of this idea . . . had appellant simply used the idea presented by the photo, there would not have been an infringing copying. But here Koons used the identical expression of the idea that Rogers created; the composition, the poses, and the expressions were all incorporated into the sculpture.⁴⁵³

The Second Circuit Court of Appeals emphasized that it would not find substantial similarity merely by pointing to the elements that the copier did not copy.⁴⁵⁴ Thus, the court found Koons’s additions unavailing in light of the overwhelming similarity of the sculpture to the photograph.⁴⁵⁵ Nor did the change in medium alter the court’s finding of substantial similarity.⁴⁵⁶ The court’s finding was consistent with its ruling on fair use, which in this case was unfavorable to Koons. Presaging the Supreme Court’s approach in *Warhol*,⁴⁵⁷ the court determined that to be a parody, *String of Puppies* must have at least in part commented on *Puppies*, even if the goal of the work was to also make a larger statement about society in general.⁴⁵⁸ If *Puppies* played no role in the parody, there would be no need to conjure up the original work, and hence no need to use it pursuant to fair use.⁴⁵⁹ The case

449. *Id.*

450. *Id.* at 305.

451. *Id.* at 308.

452. *Id.*

453. *Id.* (emphasis in original) (citations omitted).

454. *Id.*

455. *Id.*

456. *Id.* at 312.

457. See *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 143 S. Ct. 1258, 1276–77 (2023).

458. *Rogers*, 960 F.2d. at 309. Koons displayed *String of Puppies* as part of an exhibit titled “The Banality Show.” *Id.* at 305.

459. *Id.* at 309–10. This evaluation is consistent with the majority opinion in *Campbell* as well. There, the court mused that “a parody that more loosely targets an original than” did 2 Live Crew’s parody could still come within its analysis of parody, but where a parody whose wide dissemination in the market runs the risk of serving as a substitute for the original, or where licensed derivatives exist, it is incumbent on the party claiming fair use to establish the extent of

illustrates how the court's analysis of wrongful copying in the substantial similarity setting informs decisions regarding transformativeness and whether copying is reasonable in light of the artist's transformative purpose.

Some scholars compare Koons's early loss with the subsequent *Blanch v. Koons*, where the artist prevailed on a fair use defense, arguing that examining meaning or message will merely lead to self-serving artist testimony.⁴⁶⁰ This is a legitimate concern, but the procedural history of both cases reveals that courts can avoid this outcome by fully analyzing and deciding cases on substantial similarity grounds where appropriate. The district court in *Blanch* should have considered and ruled on substantial similarity in favor of Koons rather than deciding the case on fair use grounds. Had the court done so, it would have avoided the need to rule on the transformative nature of the work or to consider Koons' testimony at all.

Although the district court purportedly analyzed the case as a fair use case,⁴⁶¹ much like the district court in *Warhol*, the court arguably decided it on substantial similarity grounds *sub rosa*. The *Blanch* court cited Koons's deposition testimony, in which he claims his work comments on "culture and attitudes promoted and embodied in Allure Magazine."⁴⁶² However, the court's ultimate decision was based on purely factual assessments about the works, much like those the trier of fact typically makes in a substantial similarity inquiry.⁴⁶³ The district court noted that "the quality of copyright protection for the [first work] is very weak."⁴⁶⁴ It found that no protectable elements from *Blanch*'s work were included in Koons's painting,⁴⁶⁵ the use in Koons's

the transformation and the parody's critical relationship to the original. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 580 n.14 (1994). "By contrast when there is little or no risk of market substitution, whether because of the large extent of transformation of the earlier work, the new work's minimal distribution in the market, the small extent to which it borrows from an original, or other factors, taking parodic aim at an original is a less critical factor in the analysis, and looser forms of parody may be found to be fair use, as may satire with lesser justification for the borrowing than would otherwise be required." *Id.*

460. See Brief of Professors Peter S. Menell, et al., *supra* note 208, at 26.

461. *Rogers*, 960 F.2d at 306.

462. *Blanch v. Koons*, 396 F. Supp. 2d 476, 481 (S.D.N.Y. 2005).

463. See *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 53 (2d Cir. 2021) (quoting *Malden Mills, Inc. v. Regency Mills, Inc.*, 626 F.2d 1112, 1113 (2d Cir. 1980)) ("In general, and as applicable here, two works are substantially similar when 'an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.'"), *aff'd*, 143 S. Ct. 1258 (2023).

464. *Blanch*, 396 F. Supp. 2d at 482.

465. *Id.* at 481.

work was different than the use in Blanch's,⁴⁶⁶ and the use of the work was fragmentary as part of a collage.⁴⁶⁷ These are not evaluations of fair use factors; these are findings supporting a ruling of no substantial similarity.

VII. *ANDY WARHOL FOUNDATION FOR THE VISUAL ARTS, INC. V. GOLDSMITH* FROM A PROCEDURAL JUSTICE PERSPECTIVE

Researchers in the social sciences have found that to evaluate whether a judicial decision-making process is just, the public considers: (1) whether all parties have an opportunity to present evidence and state their case from their own perspective; (2) whether decision-makers receive the information they need to make good decisions; (3) whether decision-makers consider the information impartially; and (4) whether decision-makers decide based on unbiased rules that are applied consistently across parties and cases.⁴⁶⁸ Even if one disagrees with the substantive outcome of a ruling, if one deems the procedure just, procedural justice will likely matter more in evaluating the legitimacy of the decision.⁴⁶⁹

Justice Sotomayor's majority opinion in *Warhol* elegantly corrects decades of troubled visual arts fair use law in a manner that advances procedural justice. With a light touch, the opinion affirms the lower court but reframes the analysis to consider factor one solely from the perspective of the Warhol Foundation's challenged commercial licensing use. This provides a different account of the relevant facts to consider under the first fair use factor. It also allows the majority to subtly redirect analysis of other copyright matters—like the second artist's subjective intent when creating a work—to the remainder of the Copyright Act.⁴⁷⁰

The majority's approach was necessary because the judges and litigants in both the district and circuit courts failed to analyze the case

466. *Id.*

467. *See id.*

468. Tracey L. Meares & Tom R. Tyler, *Justice Sotomayor and the Jurisprudence of Procedural Justice*, 123 YALE L.J. F. 525 (2014) <https://www.yalelawjournal.org/forum/justice-sotomayor-and-the-jurisprudence-of-procedural-justice> [<https://perma.cc/GNB4-76WK>].

469. *Id.*

470. *See* Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 143 S. Ct. 1258, 1287 (2023) (“[C]opyright law is replete with escape valves These doctrines (and others) provide ample space for artists and other creators to use existing materials to make valuable new works If the last century of American art, literature, music, and film is any indication, the existing copyright law, of which today's opinion is a continuation, is a powerful engine of creativity.”).

with the appropriate procedural rigor.⁴⁷¹ The district court concluded that it need not consider the merits of Lynn Goldsmith's infringement claim because the Foundation could prevail on its affirmative defense of fair use.⁴⁷² The court of appeals primarily considered the district court's fair use analysis and conducted a belated substantial similarity analysis only as an afterthought.⁴⁷³ Nevertheless, both courts opined on subtle aesthetic questions in the context of a fair use analysis despite the underdeveloped evidentiary record—each coming to different conclusions.⁴⁷⁴ The Warhol Foundation sought review on only the first fair use factor.

Because the lower courts did not address infringement in the correct procedural order and did not do so on a full evidentiary record, their rulings on fair use were inartfully documented. The majority opinion turns largely on the proper perspective to apply when evaluating the justification for challenged uses under factor one. The resulting ruling requires a “comparatively modest” inquiry into the circumstances and reasons a person is using a copyrighted work, not one focused on the “moods of any artist or the aesthetic quality of any creation.”⁴⁷⁵ The majority opinion and the concurring opinion both point out that the decision to leave issues of artistic interpretation to the side do not make those issues irrelevant. They merely underscore that the objective evaluation of the purpose and character of the Foundation's use under the particular circumstances at issue are not directly implicated in their reasoning.⁴⁷⁶

When viewed from a procedural justice perspective, *Warhol* has a broad impact. The decision clarifies the rules for examining a challenged use under factor one and directs courts' attention to the statutory language, re-contextualizing the *Campbell* decision.⁴⁷⁷ *Warhol* preserves the author's derivative use right by requiring transformative uses to “go beyond that required to qualify as a

471. See *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 53–54 (2d Cir. 2021) (discussing substantial similarity only after completing fair use analysis), *aff'd*, 143 S. Ct. 1258 (2023); see also *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 382 F. Supp. 3d 312, 324 (S.D.N.Y. 2019) (dismissing the substantial similarity analysis because “it relates to conduct that occurred nearly forty years ago and is well outside the Copyright Act's statute of limitations”), *rev'd*, 992 F.3d 99 (2d Cir. 2021), *aff'd*, 143 S. Ct. 1258 (2023).

472. See *id.*

473. See *Warhol Found.*, 11 F.4th at 37.

474. See *id.* at 38–42; *Warhol Found.*, 382 F. Supp. 3d at 325–26.

475. *Id.*

476. See *id.* at 1287 (majority opinion); *id.* at 1289 (Gorsuch, J., concurring).

477. *Id.* at 1287 (majority opinion).

derivative.”⁴⁷⁸ The skein that connects the main themes in the opinion is ensuring follow-on uses of works are objectively *justified* if they are unlicensed and that the justification is tied to the statutory factors.

Both Justices Sotomayor and Kagan have publicly stated that they seek to ensure that the law and legal institutions express society’s shared ideals so that the public has respect for the law.⁴⁷⁹ Justice Sotomayor describes her efforts to ensure fairness in the law as being “process driven.”⁴⁸⁰ Through paying close attention to the facts of a case and projecting ahead how a given procedure will affect different parties with varying fact patterns, she aims to adopt objectively fair procedures when handing cases.⁴⁸¹ This shared aspiration toward procedural justice may yet unite the Justices should future cases probing the boundaries of substantial similarity or fair use come before the court.

Justice Kagan’s dissent noted that the majority acknowledges the fair use provision as contemplating evaluating the copier’s addition of new expression.⁴⁸² She further suggests that future courts may, under appropriate circumstances, make a “serious inquiry into the follow-on artist’s creative contributions” despite the fact that the majority opinion does not.⁴⁸³ This concession is followed by a lengthy celebration of creativity based on what the dissent terms “transformative copying” but what really amounts to applications of originality, idea-expression dichotomy, and basic infringement and substantial similarity analysis.⁴⁸⁴ For rhetorical reasons, Justice Kagan paints a dire picture of a world robbed of the creativity of visual artists and others who build on existing works.⁴⁸⁵ However, one need not fear this loss of beauty if courts heed the majority’s cues to resurrect copyright’s lost art of substantial similarity.

478. *Id.* at 1275.

479. See Emily Aronson, *Sotomayor and Kagan Talk Supreme Court, Service and Success at ‘She Roars’*, PRINCETON UNIV. (Oct. 5, 2018, 9:12 PM), <https://www.princeton.edu/news/2018/10/05/kagan-and-sotomayor-talk-supreme-court-service-and-success-she-roars> [<https://perma.cc/FM64-M9XT>]. See generally Yale L. Sch., *A Conversation with Justice Sonia Sotomayor ‘79 and Linda Greenhouse ‘78 M.S.L.*, VIMEO (Feb. 3 2014), <https://vimeo.com/85872053> [<https://perma.cc/D862-ACSS>] (The goal of the law is to express our shared ideals as a society and through doing that to enable everyone to identify with the law and with our democracy and its political and legal institutions).

480. See Yale L. Sch., *supra* note 479.

481. See *id.*

482. *Warhol Found.*, 143 S. Ct. at 1303 (Kagan, J., dissenting).

483. *Id.* at 1304.

484. See *id.* at 1305.

485. See *id.*

VIII. CONCLUSION

The *Warhol* decision provides a reason for courts to reassess how they judge visual arts cases. Courts should analyze copyright infringement cases involving visual art in the same order as they consider other infringement cases. First, district courts should establish a solid record that the first work is original; then inquire whether the second work is substantially similar to the first. Only if they find infringement should courts consider the affirmative defense of fair use, evaluating the justification of challenged uses (focusing on the proper use) as *Warhol* teaches. When ruling on appeals, circuit courts, armed with an adequate record, should likewise rule on substantial similarity first. Decisions regarding the original authorship of a work and whether a second artist has wrongfully appropriated protectable expression are necessary to fully evaluate the four fair use factors and to render decisions the public will accept as procedurally just.