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The author analyzes the “transformative use” standard of the fair use defense as it was invoked in recent copyright infringement cases.

Is This Legal Alchemy? When a Copy of Another’s Work May Become Transformative for Fair Use Purposes

By ANDREW BERGER

Predicting a fair use outcome in copyright litigation is not for the faint of heart. There are no bright-line rules; instead, the Copyright Act calls for case-by-case analysis, directing courts to weigh four illustrative and non-exclusive factors.¹

But there is one guidepost that parties often overlook when attempting to determine if the defense of fair use applies to a claim of copyright infringement. When a new work makes “transformative” use of the original work, a court will almost always find the use fair.² The

transformative standard asks “whether the new work merely supersedes 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. . . .”³

A New Purpose Is Enough

But what does “altering the first” work mean? Does the new work have to physically change the old or sim-

¹ 17 U.S.C. § 107 sets forth four factors that are “to be considered” in determining fair use.

² *Warner Bros. Entertainment Inc. v. RDR Books*, 575 F. Supp. 2d 513, 88 USPQ2d 1723 (S.D.N.Y. 2008) (76 PTCJ

652, 9/12/08), and *Castle Rock Entertainment v. Carol Publishing Group Inc.*, 955 F. Supp. 260, 268, 42 USPQ2d 1336 (S.D.N.Y. 1997), are the only two cases the author has been able to find that rejected fair use despite the transformative nature of defendant’s work. But in *Warner Bros.*, the court was careful to note that defendant’s work (a reference guide to the *Harry Potter* books) was not “consistently transformative” because it failed to “‘minimize the expressive value’ of the original expression.” *Id.* at 49, 62. Further, the Second Circuit on appeal in *Castle Rock* held that “[a]ny transformative purpose possessed by . . . [defendant’s work, a trivia book about the *Seinfeld* television comedy series] to be slight to non-existent.” 150 F.3d 132, 142, 47 USPQ2d 1321 (2d Cir. 1998).

³ *Campbell v. Acuff-Rose Music Inc.*, 510 U.S. 569, 579, 29 USPQ2d 1961 (1994).

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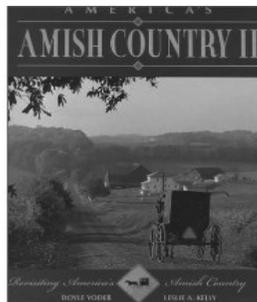
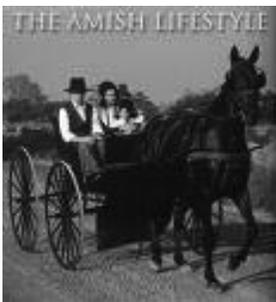
ply copy it for a new purpose? A number of recent cases, including *Kelly v. Arriba Soft Corp.*,⁴ *Bill Graham Archives v. Dorling Kindersley Ltd.*⁵ and *Blanch v. Koons*,⁶ indicate that copying the old work for a new purpose is enough if two other criteria are also present. Understanding the criteria necessary to create a transformative copy may be useful to parties facing a fair use issue.

Arriba: A New Technological Purpose

In *Kelly v. Arriba*, the defendant's search engine contained some two million thumbnail versions of photos, which defendant had copied, posted, and made available for viewing on its site.⁷ Thirty-five of those thumbnails were Kelly's photos that Arriba had copied and posted without permission. (Two of the plaintiff's thumbnails appear below.) The district court granted the defendant summary judgment, finding that Arriba's use of the plaintiff's images was fair.⁸

The district court held that Arriba's search engine was transformative because it served a new function and made a new use of the photographs. The plaintiff's photographs were intended to be "artistic" and "esthetic." In contrast, the defendant's search engine was "functional" and "comprehensive," designed "to catalogue and improve access to images on the Internet."⁹ The district court also noted with approval that the search engine did not exploit the plaintiff's photographs "in any special way" but instead reproduced them as part of the Arriba's "indiscriminate method of gathering images."¹⁰

The Ninth Circuit affirmed, adding that "Arriba was neither using Kelly's images to promote its site nor trying to profit by selling Kelly's images."¹¹



Kindersley: A New Creative Purpose

In *Bill Graham Archives v. Dorling Kindersley Ltd.* the defendant also made a new, non-exploitive use of an inconsequential amount of original authorship. There, the defendant copied without authorization a few

⁴ 77 F. Supp. 2d 1116 (C.D. Cal. 1999); *aff'd in part and rev'd in part*, 336 F.3d 811, 67 USPQ2d 1297 (9th Cir. 2003) (66 PTCJ 286, 7/11/03).

⁵ 448 F.3d 605, 78 USPQ2d 1764 (2d Cir. 2006) (72 PTCJ 61, 5/19/06).

⁶ 467 F.3d 244, 80 USPQ2d 1545 (2d Cir. 2006) (73 PTCJ 5, 11/3/06).

⁷ 77 F. Supp.2d at 1118

⁸ *Id.* at 1121

⁹ *Id.* at 1119

¹⁰ *Id.*

¹¹ 336 F.3d at 818

Grateful Dead concert posters, reduced them in size, combined them into a collage of text and images and used them on seven pages of its 480-page biography of the band.¹²

The Second Circuit affirmed the district court's fair use finding. The circuit court noted that, although the band used the posters for artistic expression and promotion, the defendant employed them for a new purpose. The court stated that the defendant used the posters as "historical artifacts" to enhance "the book's biographic information about the Grateful Dead and provide a "visual context" for the book's text.¹³ Further, the defendant ensured that the posters were not exploited "for commercial gain" in "advertising" or "to promote the sale of the book."¹⁴ In addition, the posters constituted a tiny portion of the book.¹⁵ (A copy of the first page of the book and an inside page containing a poster are below.)



Koons: A New Satirical Purpose

Blanch v. Koons also involves a creative reproduction of the plaintiff's copyrighted work. The plaintiff's photograph depicts a woman's lower legs and feet wearing sandals resting on a man's lap. The legs and feet appear at close range and dominate the photo.¹⁶ The plaintiff testified that she wanted her photograph to "show some sort of erotic sense."¹⁷ Jeff Koons, a self-styled appropriation artist, borrowed the plaintiff's image to further his purpose of commenting on "commercial images . . . in our consumer culture."¹⁸ He copied the legs and feet from the photograph, changed their color and inverted their orientation so they point vertically downward. He then incorporated them into a collage with three other pairs of women's feet and legs all dangling over images of food and landscapes.¹⁹

The Second Circuit, finding fair use, affirmed the dismissal of the plaintiff's infringement action.²⁰ The appellate court stated that Koons did much more than find a new way to exploit the creative virtues of the plaintiff's image.²¹ Instead, Koons made transformative use of that image by employing it for a new purpose "as fodder for his commentary on the social and aesthetic consequences of mass media" and "to satirize life as it appears when seen through the prism of slick fashion

¹² 448 F.3d at 607

¹³ *Id.* at 609

¹⁴ *Id.* at 612

¹⁵ *Id.* at 611

¹⁶ 467 F.3d at 248

¹⁷ *Id.* at 252

¹⁸ *Id.* at 248

¹⁹ *Id.*

²⁰ *Id.* at 259

²¹ *Id.* at 252

photography.”²² The court concluded “[w]hen, as here, the copyrighted work is used as ‘raw material’ in the furtherance of distinct creative or communicative objectives, the use is transformative.”²³ (Blanch’s photo and Koons’ collage are below; the legs and feet Koons borrowed from the photo are the second pair to the left in the collage.)

Some Conclusions

These cases indicate that old wine in new bottles is not fair use. Instead, the reproduction must do more than repackage the original. It must instead serve a new technological purpose as in *Arriba* or a new creative function as in *Kindersley* or *Koons*. Further, the reproduction must minimize the expressive elements in the original work rather than exploit or seek to profit from



the elements. Thus, *Arriba* never offered Kelly’s images for sale or sought to use them to advertise its site. Similarly, *Kindersley* never attempted to use the posters for commercial gain; and *Koons* employed plaintiff’s photograph simply as raw material. Finally, these three cases demonstrate that the amount of original authorship that is copied in the reproduction must be insignificant.

In sum, these cases may help predict a fair use outcome when a party seeks to reproduce original authorship in a new work.

²² *Id.* at 253, 255

²³ *Id.* at 253