

“You keep using that word; I do not think it means what you think it means”: Supreme Court’s *Warhol* Fair Use Decision Reforms “Transformativeness”

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In a 7-2 decision, the Supreme Court ruled that the late Andy Warhol infringed on photographer Lynn Goldsmith’s copyrighted portrait photograph of Prince, affirming the Second Circuit’s finding that Warhol’s “Prince Series” was not fair use.

Background

In 1981, Goldsmith took a series of portrait-style photographs of Prince for *Newsweek*. In 1984, *Vanity Fair* (owned by Condé Nast) obtained a one-time license to use one of Goldsmith’s photos as an “artist reference.” The artist was Andy Warhol, who unsurprisingly used the photograph to make a silkscreen image of Prince—and who also created fifteen more silkscreens (the “Prince Series”) in his well-known style. One of these was published alongside an article about the musician in *Vanity Fair*.

When Prince died in 2016, Condé Nast licensed “Orange Prince”—another image in the Prince Series—from the Andy Warhol Foundation for the Visual Arts (“AWF”) to use on the cover of a special commemorative magazine. Goldsmith was not consulted or credited and threatened to sue, but AWF struck first, seeking a declaratory judgment that the Prince Series was either (a) non-infringing, or (b) a fair use of Goldsmith’s photograph. Goldsmith countersued for infringement. The Southern District of New York granted summary judgment of fair use; the Second Circuit reversed, holding that “transformative” did not mean what the district court thought it meant and that the use was not fair. The Supreme Court then took up the question.

Holding and Analysis

The Court, framing the use as a commercial license to Condé Nast for magazine publication, held 7-2 that the first fair use factor—the “purpose and character” of the allegedly infringing use—did not favor AWF’s defense. Since the Second Circuit had also held that all the other fair use factors also favored Goldsmith, the use was thus not a fair one.

Writing for the majority, Justice Sotomayor stated that the first fair use factor – the character and purpose of the use – is a matter of degree. Although *Orange Prince* was transformative in the sense that it added new expression, meaning, or message to the underlying photograph, that alone is not dispositive of the first factor: it also matters whether the second work has a different purpose or character and whether the use is justified in its light. In this case, both works shared a common purpose, namely depicting Prince in connection with a magazine story about him. According to the Court, while it is not dispositive that a new work has a commercial purpose, it is an important factor—and the commercial nature of AWF’s use, in tandem with its substantially similar purpose, meant that this factor favored Goldsmith.

The Court harkened back to *Campbell v. Acuff-Ross Music, Inc.*, 510 U.S. 569 (1994), noting that the Court’s analysis of the first factor had continued after it established that the secondary work had added new expression to the underlying work. Key to *Campbell* was its recognition that the secondary work was a parody of the original and therefore was created with a wholly distinct – and socially justified – purpose.

The Court also cautioned that AWF’s focus on the “new expression, meaning, or message” aspect of transformativeness impinged on the Copyright Act’s derivative work right, which gives copyright owners the exclusive right to create works “based upon ... preexisting works,” including “any ... form in which a work may be recast, transformed, or adapted.” 17 U.S.C. §§ 101, 106(2). Thus, to preserve the derivative work right, the degree of transformation required to render a work “transformative” (for fair use) must go beyond the creation of a derivative work — and the commercial nature of the second work, as well as the degree of difference in the character and purpose underlying the use, are part of that inquiry.

Justices Gorsuch and Jackson concurred, stating that the issue before the Court was one of simple statutory interpretation and that nothing in the Copyright Act suggested that the Court could speculate about an artist’s intentions. Because they thought it was clear that the AWF silkscreen had the “character and purpose” of a commercial substitute for the original, it was not a fair use.

Justices Kagan and Roberts dissented, stating that the majority’s holding has upended the analysis under the first fair use factor by choosing to focus almost solely on the commercial nature of the work, entirely disregarding Warhol’s creativity and his intended message. The dissenters warned that the majority’s rule will have deleterious impacts on art and creation going forward by restricting artists from building off of the work of others — a consequence fundamentally at odds with the constitutional purpose of copyright law.

KEY TAKEAWAYS

- The Supreme Court reined in the first fair use factor, clarifying that merely adding “new expression, meaning, or message,” while relevant, is not enough to establish fair use.
- This first factor instead requires that courts additionally consider whether the challenged use has a distinct purpose or character from the original work, as well as whether the work is of a commercial nature.
- The dissent cautions that this decision will “make our world poorer” by impeding the creation of new art that builds off earlier works.

Winston & Strawn Law Clerk Jennifer Kopp also contributed to this alert.
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