

A TRANSFORMATIVE USE TAXONOMY: MAKING SENSE OF THE TRANSFORMATIVE USE STANDARD

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- I. FAIR USE FUNDAMENTALS AND THE TRANSFORMATIVE USE STANDARD..... 270
 - A. *Campbell v. Acuff-Rose Music* 272
 - B. *Transformative Use Before and After Campbell*..... 276
- II. DEFINING TRANSFORMATIVE USES..... 279
 - A. *Parody*..... 284
 - B. *Other Forms of Commentary and Criticism* 288
 - C. *News Reporting*..... 292
 - D. *Documentaries, Compendiums, Reference Books, and Other Uses Out of Context*..... 296
 - E. *Appropriation Art* 304
 - F. *Transformative Uses and Technology*..... 310
 - 1. *Photocopying* 311
 - 2. *Copying and Reverse Engineering*..... 320
 - 3. *Thumbnails, Linking and the Internet*..... 323
 - 4. *The Google Books Project and Transformative Use* 325
- III. NOT TRANSFORMATIVE BUT STILL FAIR USE..... 328
- IV. TAKINGS THAT ARE NOT TRANSFORMATIVE AND NOT FAIR USE 331
- V. CONCLUSION 335

The transformative use standard, which is an important aspect of copyright law’s fair use doctrine, has been confusing and uncertain since 1994 when it was first introduced by the United States Supreme Court in *Campbell v. Acuff-Rose Music*.¹ To try to make some sense of this standard, this article extends the work of several scholars including Paul Goldstein, Pamela Samuelson, Neil Netanel, and Michael Madison,² who have argued that the massive amount of fair use case law generally divides itself into categories, patterns, or policy clusters which have their own internal coherence. I contend that these observations apply as well

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1. *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 579 (1994).

2. See, e.g., Paul Goldstein, *Fair Use in Context*, 31 COLUM. J.L. & ARTS 433 (2008); Pamela Samuelson, *Unbundling Fair Uses*, 77 FORDHAM L. REV. 2537 (2009); Michael J. Madison, *A Pattern-Oriented Approach to Fair Use*, 45 WM. & MARY L. REV. 1525 (2004); Neil Netanel, *Making Sense of Fair Use*, 15 LEWIS & CLARK L. REV. 715 (2011).

to transformative use decisions more particularly, which similarly fit into a number of recurring, distinct patterns.

The analytic difficulty presented by the transformative use standard is that it is an ambiguous judicial construct³ layered on top of a pre-existing ambiguous and often criticized legislative construct in the Copyright Act.⁴ Section 107 codified the fair use doctrine with an illustrative list of uses which might be fair followed by four general factors to be examined when the fair use defense is raised by an alleged infringer.⁵ The determination of whether a particular use is transformative has been added to this multi-factored analysis. The challenge thus becomes relating this judicial construct to the statutory factors in a meaningful way. Moreover, this standard's relationship to other copyright law doctrines, such as the right to prepare derivative works, needs to be explained.⁶ After all, a derivative work by definition recasts, **transforms**, or adapts a preexisting work of authorship.⁷ Examining the vast case law in this area suggests initially that judicial results are largely, if not entirely, ad hoc and arbitrary.⁸ But lying

3. Transformative use has been described as an invasive species, and whether or not a particular use is transformative is in the eye of the beholder. See CRAIG JOYCE, MARSHALL LEAFFER, PETER JASZI, TYLER OCHOA & MICHAEL CARROLL, COPYRIGHT LAW 857, 866 n.4 (10th ed. 2016) [hereinafter CRAIG JOYCE ET AL.]. One scholar said transformative use is "a triumph of mindless sound bite over principled analysis." Goldstein, *supra* note 2, at 442. Another writes that the only clear lesson from the many transformative use decisions is how bitterly disputed the test has proven to be in application. See 4 MELVILLE NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.05[B][6], at 13-224.14-224.15 (2017) [hereinafter NIMMER ON COPYRIGHT].

4. See, e.g., Matthew Sag, *Predicting Fair Use*, 73 OHIO STATE L.J. 47, 48 n.1 (2012) ("[T]he application of fair use is conventionally presumed to be uncertain. This assumed incoherence and unpredictability has led many to question the value of fair use."); David Nimmer, "*Fairest of Them All*" and *Other Fairy Tales of Fair Use*, 66 LAW & CONTEMP. PROBS. 263, 287 (2003) ("[T]he factors . . . are malleable" and "[I]n the end, reliance on the four statutory factors to reach a fair use decision often seems naught but a fairy tale."); Jessica Litman, *Billowing White Goo*, 31 COLUM. J.L. & ARTS 587, 596 (2008). Arguing that all of copyright, including fair use, is "a billowing white goo." *Id.*

5. 17 U.S.C. § 107 (2012). The fair use privilege is a creation of the courts, having been introduced in the United States in 1841 in *Folsom v. Marsh*, 9 F. Cas. 342 (C.C. D. Mass. 1841). Congress codified it in the Copyright Act of 1976 in order "to restate the present judicial doctrine of fair use, not to change, narrow, or enlarge it in any way." H.R. REP. NO. 94-1476, at 66 (1976). See also CRAIG JOYCE ET AL., *supra* note 3, at 820-21.

6. 17 U.S.C. § 106(2) (2012); 17 U.S.C. § 101 (2012) (defining 'derivative work'). It has been argued that to understand transformative use, it is necessary to appreciate how derivative works differ from transformative works. Sag, *supra* note 4, at 55-56.

7. 17 U.S.C. § 101 (2012) (emphasis added to the definition of 'derivative work').

8. See, e.g., CRAIG JOYCE ET AL., *supra* note 3, at 857, 866 n.4 (describing the evolution of transformative use jurisprudence as an invasive species that is taking over

beneath the chaos, as other scholars contend, is a taxonomy that brings some order.⁹

This effort to identify these underlying connections is not, however, simply an effort to produce structure for the sake of structure. The analytic struggle presented by copyright law is of fundamental importance to our jurisprudence more generally because it illustrates the continuing conflict between two competing constitutional doctrines—on one hand, protecting intellectual property and ownership rights as an incentive to create, and, on the other, protecting freedom of expression including a creator's ability to build upon the works of others. The purpose of copyright is "to encourage people to devote themselves to intellectual and artistic creation"¹⁰ and the philosophy undergirding copyright is the belief that "encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors."¹¹ At the same time, it has long been recognized that few things are "strictly new and original throughout" and that every work "in literature, science and art, borrows, and must necessarily borrow, and use much which was well known, and used before."¹² Hence, there is a delicate balance and an inherent tension in copyright law between protecting copyrighted materials and allowing others to build upon those protected works,¹³ and it is important to understand how the

the garden, and that concluding whether a particular use is fair is like concluding that something is pornographic—you know it when you see it); NIMMER ON COPYRIGHT, *supra* note 3, at § 15.05[B][6], 13-23, 12-224.13 (stating that the only clear lesson is that the transformative use test is bitterly disputed in its application); N. Boorstyn, THE COPYRIGHT L. J. 29 (May–June 2014) (discussing whether or not a use is transformative and fair is often in the eye of the beholder).

9. See, e.g., Samuelson, *supra* note 2, at 2537 (organizing fair use into patterns); Madison, *supra* note 2, at 1623 (fair use decisions can be explained by whether the challenged use falls within or outside accepted patterns); Goldstein, *supra* note 2, at 438 (stating that fair use cases tend to present themselves in recurring patterns).

10. Goldstein v. California, 412 U.S. 546, 555 (1973).

11. Mazer v. Stein, 347 U.S. 201, 219 (1954).

12. Emerson v. Davies, 8 F. Cas. 615, 619 (C.C.D. Mass. 1845) (No. 4,436).

13. See Campbell v. Acuff-Rose Music, 510 U.S. 569, 575–76 (1994) (citing Carey v. Kearsley, 4 Esp. 168, 170, 170 Eng. Rep. 679, 681 (K.B. 1803) (Lord Ellenborough) ("[W]hile I shall think myself bound to secure every man in the enjoyment of his copyright, one must not put manacles upon science.")). Cf. Antioch Co. v. Scrapbook Borders, Inc., 291 F. Supp. 2d 980, 987 (D. Minn. 2003).

[W]e must take care to guard against two extremes equally prejudicial; the one, that men of ability, who have employed their time for the service of the community, may not be deprived of their just merits, and the reward of their ingenuity and labour; the other, that the world may not be deprived of improvements, not the progress of the arts be rewarded.

Wall Data v. L.A. Cty. Sheriff's Dept., 447 F.3d 769, 777 (9th Cir. 2006) (citing Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 480 n.33 (1984)); see also

transformative use standard affects that balance. The question, in effect, becomes when is the first author's work transformed fairly by a subsequent author who makes a secondary use of that work?

This article first discusses fair use generally, including *Campbell v. Acuff-Rose Music* and the evolution of the transformative use standard. Next, it defines the transformative use standard and its relationship to the right to prepare derivative works, and then discusses a dozen categories and subcategories of well-established transformative and non-transformative uses. This article's primary takeaways are that transformative uses are presumptively fair in several of the established categories and subcategories where the standard has proven to be useful for purposes of careful analysis, but that copyright owners can sometimes overcome this presumption and show infringement when the defendant's taking of protected expression is substantial or when its adaptation of the protected work is relatively trivial. In addition, this article suggests that in situations where the defendant's unauthorized use of the plaintiff's work clearly falls within one of the well-established fair use activities listed in section 107's preamble—including news reporting, criticism, research, scholarship, and teaching¹⁴—the courts should not feel compelled to explain why a challenged use is or is not transformative. Instead of twisting and stretching the doctrine to fit, the courts should stick with a traditional analysis and application of that use in relation to the statute's four factors. The standard should not be allowed to eviscerate the copyright owner's right to prepare derivative works. Like the old productive/nonproductive use distinction discussed by the Supreme Court in the venerable *Sony/Betamax* decision,¹⁵ analyzing whether a particular use is transformative should be helpful but not the determinative consideration in assessing fair use.

I. FAIR USE FUNDAMENTALS AND THE TRANSFORMATIVE USE STANDARD

Fair use is a long established limitation on copyright.¹⁶ Codified in section 107 of the Copyright Act,¹⁷ it recognizes a number of

Roger Zissu, *Expanding Fair Use: The Trouble With Parody, the Case for Satire*, 64 J. COPYRIGHT SOC'Y 163, 165 (2017) (Brace Lecture).

14. 17 U.S.C. § 107 (2012).

15. *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984).

16. *Folsom v. Marsh*, 9 F. Cas. 342, 345, 347–49 (C.C.D. Mass. 1841) (No. 4,901) (discussing what is now called fair use for the first time in a United States decision); see also *Lawrence v. Dana*, 15 F. Cas. 26, 60 (C.C.D. Mass. 1869) (No. 8,136).

17. 17 U.S.C. § 107 (2012).

unauthorized uses of protected works that do not infringe.¹⁸ This affirmative defense¹⁹ enables courts to avoid literal application of the exclusive rights and harsh results while simultaneously promoting the creativity copyright is meant to encourage.²⁰ It is a privilege to use copyrighted material in a reasonable manner without the copyright owner's permission,²¹ and an equitable rule of reason²² endorsed by Congress in the 1976 Act. Fair use "allows the public to use not only facts and ideas contained in a copyrighted work, but also expression itself in certain circumstances."²³ There is no rigid, bright line approach to fair use. Each case has to be decided on its merits.²⁴

Section 107 lists several activities in its preamble that might be regarded as fair use.²⁵ These examples can be seen as productive uses of copyrighted works that "build on the works of others by adding their own socially valuable creative element."²⁶ The statute then identifies four factors which the courts "shall" consider in determining whether a particular use is fair: 1) the purpose and character of the use; 2) the nature of the copyrighted work; 3) the amount and substantiality of the portion used; and 4) the effect of the use on the potential market for or

18. H.R. REP. NO. 94-1476, at 65–66 (1976). A person who makes a fair use of a protected work is not an infringer. *See also Sony*, 464 U.S. at 433. The list of exclusive rights in section 106 is prefaced by the phrase "subject to sections 107 to 122." 17 U.S.C. § 106 (2012). Those sections set forth uses which are not infringements—which are limitations on the exclusive rights—and the most general is section 107, the codification of fair use. It allows certain uses notwithstanding the exclusive rights. *Sony*, 464 U.S. at 447.

19. *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 590 (1994) (noting that because fair use is an affirmative defense, the proponent of the defense has the burden of demonstrating fair use).

20. NIMMER ON COPYRIGHT, *supra* note 3, at § 13.05; CRAIG JOYCE ET AL., *supra* note 3, at 820–21; H. REP. NO. 94-1476, at 66; *Iowa State Research Found., Inc. v. Am. Broad. Cos.*, 621 F.2d 57, 60 (2d Cir. 1980). Fair use buttresses the goals of copyright by putting works to beneficial use so that the public good coincides with claims of individuals. *Wall Data v. L.A. Cty. Sheriff's Dep't*, 447 F.3d 769, 777 (9th Cir. 2006) (citing THE FEDERALIST NO. 43, at 267 (James Madison)).

21. *Harper & Row Publs., Inc. v. Nation Enters.*, 471 U.S. 539, 549 (1985).

22. H.R. REP. NO. 94-1476, at 65; *Sony*, 464 U.S. at 475–76 n.27 (Blackmun, J., dissenting).

23. *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003).

24. There are no bright-line rules because the statute, and the doctrine it recognizes, calls for a case-by-case analysis. *Campbell*, 510 U.S. at 577; H.R. REP. NO. 94-1476, at 65–66. Fair use analysis is a mixed question of law and fact, *Harper & Row*, 471 U.S. at 560, which may be resolved on summary judgment if a reasonable trier could reach only one decision. *See also Hustler Magazine Inc. v. Moral Majority Inc.*, 796 F.2d 1148, 1151 (9th Cir. 1986); *Wright v. Warner Books, Inc.*, 953 F.2d 731 (2d Cir. 1991).

25. 17 U.S.C. § 107 (2012).

26. MARSHALL LEAFFER, UNDERSTANDING COPYRIGHT LAW 498 (6th ed. 2014)

value of the copyrighted work.²⁷ It is settled that no single factor is determinative,²⁸ and that the section's listed activities and factors are not exhaustive. Congress did not assign weights to the factors nor did it prescribe an order in which they are to be evaluated. The factors are for balancing the equities, and the courts are free to adapt the doctrine to particular situations case by case.²⁹

A. *Campbell v. Acuff-Rose Music*

The Supreme Court has addressed the fair use privilege four times since the doctrine was codified in the 1976 Act—*Sony Corp. of America v. Universal City Studios, Inc.* in 1984,³⁰ *Harper & Row, Publishers, Inc. v. Nation Enterprises* in 1985,³¹ *Stewart v. Abend* in 1990,³² and *Campbell v. Acuff-Rose Music, Inc.* in 1994.³³ Each decision is important in its own right, but not until *Campbell* “did the Court finally confront the doctrine of fair use . . . in a reasonably typical setting; parody.”³⁴

Campbell concerned an unauthorized rap version of a 1964 song by Roy Orbison and William Dees titled *Oh, Pretty Woman*.³⁵ Luther Campbell, of the group 2 Live Crew, sought permission to do a parody of this classic song, and went ahead and recorded it after the copyright owner, Acuff-Rose Music, denied the request.³⁶ Campbell's version copied the original work's characteristic opening bass riff and “repeated it, but also produced otherwise distinctive sounds, interposing ‘scraper’ noise, overlaying the music with solos in different keys, and altering the drum beat.”³⁷ He also copied the opening line from Orbison's song but then added his own words which “quickly degenerate[d] into a play on words, substituting predictable lyrics with shocking ones.”³⁸

27. 17 U.S.C. §§ 107(1)-(4) (2012).

28. *Pac. & S. Co. v. Duncan*, 744 F.2d 1490, 1495 (11th Cir. 1984).

29. H.R. Rep. No. 94-1476, at 65-66. See generally David Shipley, *Conflicts Between Copyright and the First Amendment After Harper & Row, Publishers v. Nation Enterprises*, 1986 B.Y.U. L. REV. 983, 992-94 (1986); Zissu, *supra* note 13, at 166-67.

30. 464 U.S. 417 (1984) (home recording of television broadcasts using new technology).

31. 471 U.S. 539 (1985) (unauthorized publication of excerpts from an unpublished manuscript).

32. 495 U.S. 207 (1990) (concerned primarily with ownership rights in a movie based on a short story).

33. 510 U.S. 569 (1994).

34. CRAIG JOYCE ET AL., *supra* note 3, at 825.

35. *Campbell*, 510 U.S. at 569.

36. *Id.* at 572-73.

37. *Id.* at 589.

38. *Id.* at 573 (quoting *Acuff-Rose Music, Inc. v. Campbell*, 754 F. Supp. 1150, 1154-55 (M.D. Tenn. 1991)).

The district court granted summary judgment for 2 Live Crew concluding that the song was a fair use parody that borrowed no more than necessary to conjure up the original, and that it was unlikely to affect the market for the original.³⁹ The Sixth Circuit reversed. It assumed the 2 Live Crew version was a parody but explained that the lower court did not put enough emphasis on the fact that commercial uses are presumptively unfair and that harm to the market for the original could be presumed as well.⁴⁰ In addition, the court said that this parody took too much protected expression from the original hit.⁴¹

The Supreme Court reversed following a very thorough analysis and application of each of the factors codified in section 107.⁴² It held that the Sixth Circuit erred in presuming this commercial use was unfair and that market harm could be presumed as well.⁴³ It also said that the Court of Appeals erred in holding that 2 Live Crew had copied excessively “considering the parodic purpose of the use.”⁴⁴ In discussing the first fair use factor—“the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purpose”⁴⁵—the Court stated:

The central purpose of this investigation is to see, in Justice Story’s words, whether the new work merely ‘supersede[s] the objects’ of the original creation, . . . or instead adds something

39. *Id.* (citing and quoting 754 F. Supp. at 1154–55, 1157–58)).

40. *Id.* (discussing *Acuff-Rose Music, Inc. v. Campbell*, 972 F.2d 1429, 1435, 1437–39 (6th Cir. 1992)).

41. *Id.* at 573–74.

42. *Id.* at 572–94. The Court stated that a parody’s commercial character is only one of the elements to be assessed in a fair use analysis, and that the appellate court had given insufficient consideration to the nature of parody in weighing the amount of copying. *Id.* at 572, 584, 589–90.

43. *Id.* at 584–85. The Court stated that the

commercial or nonprofit educational purpose of a work is only one element of the first factor enquiry into its purpose and character. . . . Accordingly, the mere fact that a use is educational and not for profit does not insulate it from a finding of infringement, any more than the commercial character of a use bars a finding of fairness. If, indeed, commerciality carried presumptive force against a finding of fairness, the presumption would swallow nearly all of the illustrative uses listed in the preamble paragraph of § 107.

Id. at 584. The Court also explained that the lower court, in presuming a likelihood of future harm to the plaintiff in *Campbell* and resolving the fourth statutory fair use factor against the defendant, had erred just as it had with the first factor, by applying a presumption about the effect of a commercial use. *Id.* at 590–91. The fourth statutory factor is “the impact of the use upon the potential market for or value of the copyrighted work.” 17 U.S.C. § 107(4) (2012).

44. *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 574 (1994).

45. 17 U.S.C. § 107(1) (2012).

new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is 'transformative.' . . . Although such **transformative use** is not absolutely necessary for a finding of fair use, . . . the goal of copyright, to promote science and the arts, is generally furthered by the creation of **transformative works**. Such works thus lie at the heart of the fair use doctrine's guarantee of breathing space within the confines of copyright, and the more **transformative** the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use.⁴⁶

The Supreme Court emphasized that the task of determining whether a challenged use is fair:

[I]s not to be simplified with bright-line rules, for the statute, like the doctrine it recognizes, calls for case-by-case analysis. . . . Nor may the four statutory factors be treated in isolation, one from another. All are to be explored, and the results weighed together, in light of the purposes of copyright.⁴⁷

There is, of course, more to the Supreme Court's *Campbell* decision than its elevation of transformative use to special status in fair use analysis.⁴⁸ For example, the Court aligned itself with all the other "courts that have held that parody, like other comment or criticism, may claim fair use under § 107."⁴⁹ It also acknowledged that, for the purposes of copyright law, "the heart of any parodist's claim to quote from existing material, is the use of some elements of a prior author's composition to create a new one that, at least in part, comments on that author's work."⁵⁰ In contrast, the claim to unfairness diminishes considerably when the alleged infringer's taking from another work has "no critical bearing on

46. *Campbell*, 510 U.S. at 579 (emphasis added) (citations omitted).

47. *Id.* at 577-78 (citing Pierre Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1110-11 (1990)).

48. CRAIG JOYCE ET AL., *supra* note 3, at 857.

49. *Campbell*, 510 U.S. at 579. The Court acknowledged that it first considered whether parody could be a fair use in *Benny v. Loew's*, 239 F.2d 532 (9th Cir. 1956), *aff'd sub nom* *Columbia Broad. Sys., Inc. v. Loew's Inc.*, 356 U.S. 43 (1958), but did not issue an opinion.

50. *Campbell*, 510 U.S. at 580.

the substance or style” of that work.⁵¹ The Court agreed with those courts that said, “[p]arody needs to mimic an original to make its point, and so has some claim to use the creation of its victim’s . . . imagination, whereas satire can stand on its own two feet and so requires justification for the very act of borrowing.”⁵² These statements, however, should not be interpreted to mean that satire cannot be a fair use.⁵³

B. Transformative Use Before and After Campbell

The transformative use standard announced in *Campbell* can be traced to the writings of the Honorable Pierre Leval, in particular his 1990 article, *Toward a Fair Use Standard*.⁵⁴ He wrote that a use is transformative if it is productive and employs the quoted material in a different manner or for a different purpose from the original, thus adding value to the original—“if the quoted matter is used as raw material, transformed in the creation of new information, new aesthetics, new insights and understandings—this is the very type of activity that the fair use doctrine intends to protect for the enrichment of society.”⁵⁵

This standard is in debt to the ‘productive use’ concept that had been embraced by lower courts prior to the Supreme Court’s 1984 decision in *Sony Corp. of America v. Universal City Studios*.⁵⁶ In *Sony*, the Court noted that fair use analysis requires a sensitive balancing of interests and that:

[t]he distinction between ‘productive’ and ‘unproductive’ uses may be helpful in calibrating the balance, but it cannot be wholly determinative. Although copying to promote a scholarly endeavor certainly has a stronger claim to fair use than copying

51. *Id.* (“If, on the contrary, the commentary has no critical bearing on the . . . original composition, which the alleged infringer merely uses to get attention or to avoid the drudgery in working up something fresh, the claim to fairness in borrowing . . . another’s work diminishes accordingly . . .”).

52. *Id.* at 580–81.

53. David Shipley, *A Dangerous Undertaking Indeed: Juvenile Humor, Raunchy Jokes, Obscene Materials and Bad Taste in Copyright*, 98 KENTUCKY L.J. 517, 550 (2009–10). In a footnote, the Court recognized that there could be situations where “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.” *Campbell*, 510 U.S. at 580–81 n.14.

54. Leval, *supra* note 47, at 1105 (1990).

55. *Id.* at 1111.

56. *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984) (holding that private, noncommercial taping of television shows for the purpose of time shifting was a fair use).

to avoid interrupting a poker game, the question is not simply two dimensional. For one thing, it is not true that all copyrights are fungible. Some copyrights govern material with broad potential secondary markets. Such material may well have a broader claim to protection because of the greater potential for commercial harm. Copying a news broadcast may have a stronger claim to fair use than copying a motion picture. And, of course, not all uses are fungible. Copying for commercial gain has a much weaker claim to fair use than copying for personal enrichment. But the notion of social 'productivity' cannot be a complete answer to this analysis. A teacher who copies to prepare lecture notes is clearly productive. But so is a teacher who copies for the sake of broadening his personal understanding of his specialty. Or a legislator who copies for the sake of broadening her understanding of what her constituents are watching; or a constituent who copies a news program to help make a decision on how to vote.⁵⁷

In making this statement about the usefulness of the productive/nonproductive use distinction, the Supreme Court reversed the Ninth Circuit which had rejected fair use; the Court of Appeals had concluded that private, noncommercial taping of television shows for time shifting purposes was not a productive use and therefore, was, not fair.⁵⁸ In short, the Supreme Court made clear that a nonproductive use could be fair use.

Notwithstanding this warning that the productive/nonproductive use distinction cannot be wholly determinative in any sensitive fair use balance,⁵⁹ as well as the Court's statements in *Campbell* about evaluating each of the four factors and rejecting presumptions, the transformative use standard is now at the core of the fair use doctrine.⁶⁰ It has taken on a life of its own.⁶¹ The determination of whether a particular use is

57. *Id.* at 455 n.40

58. *Universal City Studios, Inc. v. Sony Corp. of Am.*, 659 F.2d 963, 977 (9th Cir. 1981)

59. Professor Leaffer states that the productive use theory was specifically rejected in *Sony*. LEAFFER, *supra* note 26, at 500.

60. Sag, *supra* note 4, at 55. *But see*, Jennifer Rothman, *Best Intentions: Reconsidering Best Practices Statements in the Context of Fair Use and Copyright Law*, 57 J. COPYRIGHT SOC'Y U.S.A. 371, 377 (2010) (finding that transformativeness is important, but it is not determinative and should not be regarded as the most important fair use factor).

61. Laura Heymann, *Everything is Transformative: Fair Use and Reader Response*, 31 COLUM. J.L. & ARTS 445, 447 (2008) ("[T]he term has since become as fundamental a part of any fair use analysis as the statutory language itself.").

transformative—subsumed within the inquiry into the first factor,⁶² has turned into a presumption; if a use is deemed transformative, fair use follows almost automatically; but if the use is deemed not transformative, then it likely will not be considered fair.⁶³ Some courts have failed to remember that certain uses of protected works that are not transformative, like copying for classroom use or research purposes, have long been recognized as fair,⁶⁴ and that some transformative uses should be held to infringe after the required sensitive balancing of the fair use provision's four factors.⁶⁵ The Supreme Court might not have intended to give this standard presumption-like status, but it did state that “the more transformative the new work, the less will be the significance of other factors, like commercialism, that may weight against a finding of fair use.”⁶⁶ In any event, it reduces the importance of the other factors⁶⁷ and drives fair use analysis.⁶⁸

The problem for courts, practitioners, and commentators is that transformativeness cannot be defined with precision,⁶⁹ and that the lower

62. Jonathan Francis, *On Appropriation: Cariou v. Prince and Measuring Contextual Transformation in Fair Use*, 29 BERKELEY TECH. L.J. 681, 682 (2014).

63. The fair use defense has been discussed in over 140 reported decisions since *Campbell* was decided in 1994, and the issue of whether the defendant's challenged use was transformative is discussed in most of these decisions. In the overwhelming majority of cases in which the court concluded that the defendant's use was transformative, it found fair use. On the other hand, in the overwhelming majority of the decisions in which the court determined that the use was not transformative, it ruled against fair use. It is rare to find a decision in which a court said that the use was not transformative but still found fair use. *See also* Netanel, *supra* note 2, at 768–69.

64. The preamble to section 107 lists “teaching (including multiple copies for classroom use), scholarship, or research.” 17 U.S.C. § 107 (2012). Copying works for these purposes is not transformative. Fair use is not limited to transformative or productive uses. LEAFFER, *supra* note 26, at 499–500; *see also* *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 579 (1994) (stating that a transformative use is not necessary for a finding of fair use).

65. NIMMER ON COPYRIGHT, *supra* note 3, at §§ 13.05[A][1][b], 13-169-171 (2017).

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

67. *Sag*, *supra* note 4, at 55. Transformative has become a short hand for fair or not fair. *See also* NIMMER ON COPYRIGHT, *supra* note 3, at § 13.05[A][1][b], 13-169-171. *But see*, Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions*, 1978–2005, 156 U. PA. L. REV. 549 (2008) (concluding that the market factor is most important in predicting whether a use is fair based on the finding that 83.8% of the time the evaluation of market harm correlates with the outcome).

68. Netanel, *supra* note 2, at 734.

69. “The plethora of cases addressing this topic means there is no shortage of language from other courts elucidating (or obfuscating) the meaning of transformation.” *Seltzer v. Green Day, Inc.*, 725 F.3d 1170, 1176 (9th Cir. 2013); *see also* *Sag*, *supra* note 4, at 57. A leading casebook asks, “[h]ow would you advise a publisher that wanted to ride the commercial wave of a new hit TV show with an unauthorized ‘companion’ volume that draws heavily on that show?” CRAIG JOYCE ET AL., *supra* note 3, at 866 n.4.

courts have muddled the waters by taking the concept well beyond the commercial parody at issue in *Campbell*.⁷⁰ They have often applied transformativeness in a conclusory manner.⁷¹ This highly contentious topic⁷² has been the subject of many articles,⁷³ and has been described as an invasive species like kudzu that is taking over the garden.⁷⁴ One scholar said it is “a triumph of mindless sound bite over principled analysis.”⁷⁵ Another states that “the only clear lesson to emerge [from the many decisions] is how bitterly disputed the transformative use test has proven to be in application.”⁷⁶ Like the canons or rules of statutory interpretation, there are plenty of reported decisions to use on either side of most transformative use issues.⁷⁷ You know it when you see it!⁷⁸ In other words, whether or not a use is transformative often seems to be in the eye of the beholder.⁷⁹

Even though fair use decisions may appear ad hoc, even though difficult judgment calls must be made in assessing alterations to a work, and even though it is confusing and uncertain to determine whether the purpose and character of a particular unauthorized use is

This note references decisions about unauthorized lexicons and compendiums that seemed transformative but were held not to be fair uses. *Id.*

70. Sag, *supra* note 4, at 56.

71. NIMMER ON COPYRIGHT, *supra* note 3, at § 13.05[A][1][b] at 13-168-169.

72. Seltzer v. Green Day, Inc., 725 F.3d 1170, 1176 (9th Cir. 2013).

73. See, e.g., Heyman, *supra* note 61; Paul Goldstein, *Fair Use in Context*, 31 COLUM. J.L. & ARTS 433 (2008); Diane Leenheer Zimmerman, *The More Things Change the Less They Seem “Transformed”: Some Reflections on Fair Use*, 46 J. COPYRIGHT SOC’Y U.S.A. 251 (1998); John Tehranian, *Whither Copyright? Transformative Use, Free Speech and an Intermediate Liability Proposal*, 2005 B.Y.U. L. REV. 1201 (2005); Mary W.S. Wong, *Transformative User-Generated Content in Copyright Law: Infringing Derivative Works or Fair Use?* 11 VAND. J. ENT. & TECH. L. 1075 (2009); Matthew Sag, *Predicting Fair Use*, 73 OHIO ST. L.J. 47 (2012); R. Anthony Reese, *Transformativeness and the Derivative Work Right*, 31 COLUM. J.L. & ARTS 467 (2008);

74. CRAIG JOYCE ET AL., *supra* note 3, at 857.

75. Goldstein, *supra* note 2, at 442.

76. NIMMER ON COPYRIGHT, *supra* note 3, at § 15.05[B][6], 13-224.15. “[W]hether a work is transformative is a often highly contentious topic.” Seltzer v. Green Day, Inc., 725 F.3d 1170, 1176 (9th Cir. 2013); see also *Ty, Inc. v. Publications Int’l*, 292 F.3d 512, 517-19 (7th Cir. 2002) (discussing that Judge Posner critiqued the transformative use concept as well as the four factor test. He drew a distinction between complementary uses of a work, such as a book review or parody that are fair, and unfair substitutional uses that usurp the market for the work or derivatives and infringe).

77. In regard to the tools of statutory construction, the late Professor Karl Llewellyn wrote in 1950 that “there are two opposing canons on almost every point.” Karl Llewellyn, *Remarks on the Theory of Appellate Decision and the Rules or Canons about How Statutes Are to Be Construed*, 3 VAND. L. REV. 395, 401 (1950).

78. *Jacobellis v. Ohio*, 378 U.S. 184, 197 (1964) (Stewart, J., concurring) (“But I know it when I see it.”).

79. CRAIG JOYCE ET AL., *supra* note 3, at 866 n.4.

transformative,⁸⁰ advice has to be given, briefs have to be written, arguments have to be made, and judges have to make decisions. Stanford's Paul Goldstein made the following three observations about fair use: first, it is a "pragmatic, fact specific doctrine that proceeds from case to case" with experience as its guide; second, fair use cases tend to "present themselves in recurring categories"; and third, each of these categories has "its own equities and efficiencies that courts attend to" in trying to resolve particular cases.⁸¹ His second observation about fair use, that cases tend to present themselves in recurring categories, is reinforced by other scholars including Berkeley's Pamela Samuelson, who organized fair use cases into patterns or policy relevant clusters,⁸² and Pittsburgh's Michael Madison, who asserts that fair use decisions can be explained by whether the challenged use falls within or outside accepted patterns.⁸³ These observations about patterns, categories and policy clusters are the foundation for this article's attempt to categorize transformative use decisions. The transformative use case law fits into a number of recurring patterns. Still, the lines are not clear and this author would much prefer to write an appellate brief on whether or not a particular use is transformative, instead of writing an opinion letter to a client on whether his or her prospective use of another's copyrighted work would likely be transformative and, therefore, fair.

II. DEFINING TRANSFORMATIVE USES

Many courts have attempted to explain what makes a use transformative.⁸⁴ For example, "[t]here must be real, substantial condensation of the materials, and intellectual labor and judgment bestowed thereon; and not merely the facile use of scissors; or extracts of the essential parts, constituting the chief value of the original work."⁸⁵ Some quote Judge Leval's influential article which states that if

[t]he secondary use adds value to the original – if the quoted matter is used as raw material, transformed in the creation of

80. Boorstyn, *supra* note 8, at 29.

81. Goldstein, *supra* note 2, at 438.

82. Pamela Samuelson, *Unbundling Fair Use*, 77 FORDHAM L. REV. 2537 (2009).

83. Michael Madison, *A Pattern-Oriented Approach to Fair Use*, 45 WM. & MARY L. REV. 1525, 1623 (2004).

84. *Seltzer v. Green Day, Inc.* 725 F.3d 1170, 1176 (9th Cir. 2013) (saying that there are a plethora of cases elucidating and obfuscating the meaning of transformativeness).

85. *Worldwide Church of God v. Philadelphia Church of God, Inc.*, 227 F.3d 1110, 1117 (9th Cir. 2000) (quoting *Folsom v. Marsh*, 9 F. Cas. 342, 345 (C.C. D. Mass. 1841) (No. 4,901)).

new information, new aesthetics, new insights and understandings—this is the very type of activity that the fair use doctrine intends to protect for the enrichment of society.⁸⁶

Campbell is important too with courts repeating the Supreme Court's admonition that it is necessary to ask if the challenged use supersedes the objects of the original or "adds something new, with a further purpose or different character."⁸⁷

According to some courts, adding value does not necessarily require actual modification of the original work. "The use of a copyrighted work need not alter or augment the work to be transformative in nature. Rather, it can be transformative in function or purpose without altering or actually adding to the original work."⁸⁸ The flip side of this is the proposition that "where the use is for the same intrinsic purpose as [the copyright holder's] . . . such use seriously weakens a claimed fair use."⁸⁹ Thus, doing no more than finding a new way to exploit the creative virtues of the original work is not transformative.⁹⁰

Stating these several verbal formulations is relatively easy, but applying them and explaining why a particular use is, or is not, transformative is challenging. The explanations given in some decisions do a better job of obfuscating than elucidating.⁹¹ Moreover, it has been argued that to understand transformative use, one has to appreciate how derivative works differ from transformative works.⁹² This is a subtle distinction that is also easier to state than to apply and explain in actual disputes. This difficulty is caused by "the word 'transform' also play[ing] a role in defining 'derivative works,' over which the original rights holder retains exclusive control."⁹³

The Copyright Act defines a derivative work as one "based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, . . . or any other form in which a work may be recast, **transformed**, or adapted."⁹⁴ One of the exclusive rights held by the

86. *Seltzer* 725 F. 3d at 1176 (quoting Leval, *supra* note 54, at 1111); *Castle Rock Entm't, Inc. v. Carol Publ'g Group, Inc.*, 150 F.3d 132, 142 (2d Cir. 1998) (quoting Leval, *supra* note 54, at 1111).

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

88. *A.V. v. iParadigms, LLC.*, 562 F.3d 630, 639 (9th Cir. 2009) (citing *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1165 (9th Cir. 2007)).

89. *Worldwide Church of God*, 227 F.3d at 1117 (citations omitted) (internal quotation marks omitted).

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

91. *Seltzer*, 725 F.3d at 1176.

92. *Sag*, *supra* note 4, at 55–56.

93. *Authors Guild v. Google, Inc.*, 804 F.3d 202, 215 (2d Cir. 2015).

94. 17 U.S.C. § 101 (2012) (emphasis added).

copyright owner is the right “to prepare derivative works based upon the copyrighted work.”⁹⁵ The paradigmatic examples of derivative works include translating a novel into another language, adapting a novel as a play or a motion picture, and recasting a novel as an audiobook.⁹⁶

The contention is that derivative work transformations are not necessarily transformative as that term was intended by the Supreme Court in the fair use context. This is because the change, such as converting a novel into a play, does “not involve the kind of transformative purpose that favors a fair use finding.”⁹⁷ “Although derivative works that are subject to the author’s copyright transform an original work into a new mode of presentation, such works —unlike works of fair use—take expression for purposes that are not ‘transformative.’”⁹⁸

[The statute] suggests that derivative works generally involve transformations in the nature of changes of form. . . . By contrast, copying from an original for the purpose of criticism or commentary on the original, or provision of information about it, tends most clearly to satisfy *Campbell’s* notion of the ‘transformative’ purpose involved in the analysis of Factor One.⁹⁹

Another way to say this is

that virtually all works that qualify as transformative are derivative works; but not all derivative works are transformative. A new work that copies from another, and adds something new, fails to meet the further different purpose requirement for transformative when it is derivative but “supersede[s] the objects of the original creation.”¹⁰⁰

We know that a transformative work under fair use analysis “imbues the original with a further purpose or different character, altering the first with new expression, meaning or message.”¹⁰¹ However, it is said that

95. *Id.* at § 106(2).

96. *Authors Guild v. HathiTrust*, 755 F.3d 87, 95 (2d Cir. 2014).

97. *Google, Inc.*, 804 F.3d at 215; *Antioch Co. v. Scrapbook Boarders, Inc.*, 291 F. Supp. 2d 980, 990 n.5 (D. Minn. 2003); *see also* Zissu, *supra* note 13, at 175.

98. *Castle Rock Entm’t, Inc. v. Carol Publ’g Grp.*, 150 F.3d 132, 143 (2d Cir. 1998).

99. *Authors Guild v. Google*, 804 F.3d at 215–16.

100. Zissu, *supra* note 13, at 175 (quoting *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 569 (1994)).

101. *Sag*, *supra* note 4, at 55–56 (quoting *Campbell*, 510 U.S. at 579).

assessing transformativeness is not a question of degree but a "judgment of the motivation and meaning of those differences."¹⁰² Retelling *Gone With the Wind* from the perspective of the mixed race, slave half sister of Scarlett O'Hara would thus be seen as a transformative parody and fair use,¹⁰³ while a more traditional sequel based on Margaret Mitchell's classic novel and using some of the primary characters would be an infringing derivative work if done without permission.¹⁰⁴ The former is for the transformative purpose of parody, while the latter, the sequel, serves the same purpose as the original novel.¹⁰⁵

In my opinion, it is difficult to make a judgment about the motivation of authors, their purposes, and the meaning of differences between a secondary work (the adaptation) and the original work that it uses. The movie musical, *My Fair Lady* is adapted from the Broadway version of that musical comedy of the same name with music and lyrics by Lerner and Loewe. The Broadway musical is an adaptation of George Bernard Shaw's stage play 'Pygmalion.'¹⁰⁶ Do the movie and Broadway musical have the same purpose as the underlying play?

Luther Campbell of 2 Live Crew unsuccessfully sought permission to record his parody-rap adaptation of 'Oh, Pretty Woman' before releasing it.¹⁰⁷ He knew that his parody was an adaptation of that popular song. How can one say that a parody version of a hit song is any more or less transformative of the underlying work than a play subsequently recast as a musical and later as a movie? Is 2 Live Crew's parody version—their comment on the original song—more clearly a distinct or different purpose from the original Roy Orbison rendition than was the Lerner and Lowe recasting of Pygmalion as the musical *My Fair Lady*?

102. *Id.* at 56.

103. See *SunTrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1282 (11th Cir. 2001) (the Mitchell estate would not permit a sequel to *Gone With the Wind* to include anything on miscegenation or homosexuality, and the defendant's unauthorized book featured both).

104. In support of his hypothetical about *Pride and Prejudice and Zombies* being a parody of Jane Austen's original classic, Professor Sag cites the litigation over the *Wind Done Gone* in *SunTrust Bank v. Houghton Mifflin*, 268 F.3d 1257 (11th Cir. 2001). See Sag, *supra* note 4, at 56.

105. One court suggested that a book with a collection of unauthorized photographs of Beanie Babies would be treated as an infringing derivative work since it transforms, recasts or adapts the dolls, but the use of unauthorized photographs of the dolls in a collector's guide that provides tips to doll collectors would not be derivative since it does not recast the dolls. Instead, it is informational. It serves a different purpose, and would be treated as a fair use. *Antioch Co. v. Scrapbook Borders, Inc.*, 291 F. Supp. 2d 980, 990–91 (D. Minn. 2003) (discussing *Ty Inc. v. Publ'ns. Int'l*, 292 F.3d 512 (7th Cir. 2002)).

106. CRAIG JOYCE ET AL., *supra* note 3, at 220–21.

107. *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 572–73 (1994).

In the words of *Campbell*, both adaptations seem to “imbue the original with a further purpose or different character,” and alter it “with new expression.”¹⁰⁸

The risk with this subtle distinction between transformative uses and derivative works is that misapplication of the transformative use standard can undermine the copyright owner’s right to prepare derivative works.¹⁰⁹ Perhaps the safest conclusion is that a derivative work transforms a preexisting work, but this transformation is not necessarily transformative for fair use purposes.¹¹⁰ Adding to this subtle distinction is that courts have said, as noted above, that a secondary use can be transformative and fair even if the original work is not modified so long as the purpose of the secondary use is different from the intrinsic purpose of the original use; ie., it presents a different message such as commenting on the original or providing otherwise unavailable information about the original work. As Judge Leval explained recently,

[t]he word ‘transformative’ cannot be taken too literally as a sufficient key to understanding the elements of fair use. It is rather a suggestive symbol for a complex thought, and does not mean that any and all changes made to an author’s original text will necessarily support a finding of fair use.¹¹¹

So how does counsel proceed to offer guidance to his or her client about moving forward with a creative project or bringing an infringement action in view of these subtle distinctions and the nuances in language

108. *Id.* at 579. Another way to think about this transformative use/derivative work distinction is to consider *Romeo and Juliet* and *West Side Story*. If Shakespeare’s copyright was still in effect in the late 1950s when *West Side Story* became a hit on Broadway and then on film, would the Bard of Avon have had a viable infringement claim against Leonard Bernstein and his collaborators if they had done *West Side Story* without permission? Could Bernstein’s recasting of that tragic love story be defended as transformative and therefore a fair use? *West Side Story* is a musical transformation of *Romeo and Juliet* that fits comfortably within the Copyright Act’s definition of derivative work, and it also imbues the original with a different character and alters it with new expression that fits within the Court’s explanation of a transformative use. Is the purpose of the musical the same as the purpose of the play?

109. LEAFFER, *supra* note 26, at 499. *Cf.* *Antioch Co. v. Scrapbook Borders, Inc.*, 291 F. Supp. 2d 980, 991–92 (D. Minn. 2003) (discussing how defendant’s use of plaintiff’s copyright stickers could be considered an unauthorized derivative work in response to defendant’s argument that their use was transformative).

110. Boorstyn, *supra* note 8, at 28. This author notes that an unauthorized movie based on a novel is transformative in that it adds something new, gives the work new expression, and offers a new aesthetic, but that the movie would not be treated as a transformative, fair use, but as an infringing, derivative work. *Id.*

111. *Authors Guild v. Google, Inc.*, 804 F.3d 202, 214–15 (2d Cir. 2015).

used by the courts? For many lawyers, it is helpful to study prior decisions carefully and decide whether a client's project or problem is analogous or how it might be distinguished. The following sections organize many of the post-*Campbell* decisions as a transformative use taxonomy in order to help in assessing whether a proposed project or an unauthorized use might be a fair use.

*A. Parody*¹¹²

There have been many fair use decisions involving parody since the *Campbell* decision in 1994 in which the Court stated that "parody has an obvious claim to transformative value."¹¹³ In a substantial majority of these cases the uses were deemed transformative and fair, at least where the parodic character of the defendant's use could reasonably be perceived.¹¹⁴

For example, Mattel's iconic fashion doll Barbie has been the subject of many parodies; she has not been reluctant to litigate, and she has often lost due to a solid fair use defense.¹¹⁵ The comedian Carol Burnett had her "Charwoman" character parodied in an episode of the *Family Guy* and sued unsuccessfully for infringement.¹¹⁶ Another episode of the *Family Guy* resulted in litigation after the song "When You Wish Upon a Star" was evoked in a song parody titled "When You Wish upon a Weinstein." This was held to be transformative and fair.¹¹⁷ The highly-

112. This is one of the two categories mentioned by Professor Goldstein. Goldstein, *supra* note 2, at 440. Professor Samuelson places parody cases in a category where First Amendment interests of subsequent authors and the public are implicated. Samuelson, *supra* note 82, at 2549–51.

113. *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 579 (1994).

114. *Id.* at 582.

115. *See, e.g., Mattel, Inc. v. Pitt*, 229 F. Supp. 2d 315 (S.D.N.Y. 2002) (holding that defendant's adaptation of SuperStar Barbie to become Dungeon Doll—a dominatrix Barbie—was transformative and fair use); *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003) (holding that a series of 78 photos of Barbie in various positions, nude, and juxtaposed with kitchen appliances were parody and fair use); *cf. Mattel, Inc. v. MCA Records*, 296 F.3d 894 (9th Cir. 2002) (holding that the song titled Barbie Girl which poked fun at Barbie and the values she represents was to be a permitted trademark parody).

116. *Burnett v. Twentieth Century Fox Film Corp.*, 491 F. Supp. 2d 962 (C.D. Cal. 2007) (holding that the animated figure resembling plaintiff's Charwoman character with a role in a skit titled 'Peterotica' was a parody and fair use).

117. *Bourne Co. v. Twentieth Century Fox Film Corp.*, 602 F. Supp. 2d 499 (S.D.N.Y. 2002) (holding that the parody of this song from Disney's Pinocchio, aimed at Disney's antisemitism, was fair use); *see also Abilene Music, Inc. v. Sony Music Entm't, Inc.*, 320 F. Supp. 2d 84 (S.D.N.Y. 2003) (holding that the altered use of the first three lines from the song *Wonderful Life* in hip hop artist Ghostface Killah's song *The Forest* was a parody, transformative and fair use).

regarded photographer Annie Leibovitz sued unsuccessfully for infringement against a poster for the movie 'Naked Gun 33-1/3' that superimposed the head of the late Leslie Nielsen on a photo of a pregnant model posed to look like Leibovitz's portrait of a nude, pregnant Demi Moore that had appeared on the cover of *Vanity Fair*. This was held to be transformative and fair.¹¹⁸

In these cases the defendants were successful in convincing the courts that their uses of the works were parodies and fair use—that the allegedly infringing work used some element of the plaintiff's "composition to create a new one that, at least in part, comment[ed] on" the plaintiff's work.¹¹⁹ On the other hand, if the defendant's use of another's protected work is not seen as commenting on or criticizing that work, then the defendant's fair use defense becomes much weaker because it does not qualify as a parody.¹²⁰ It will not have obvious transformative value. As Justice Kennedy cautioned in his concurring opinion in *Campbell*, courts applying "our fair use analysis . . . must take

118. *Leibovitz v. Paramount Pictures Corp.*, 137 F.3d 109, 110 (2d Cir. 1998); *see also* *Louis Vuitton Malletier, SA v. My Other Bag, Inc.*, 156 F. Supp. 3d 425 (2d Cir. 2016) (holding that defendant's use of Vuitton's designs produced a new expression and message that was transformative).

119. *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 580 (1994); *see also* *Brownmark Films, LLC v. Comedy Partners*, 682 F.3d 687 (7th Cir. 2012) (imitating South Park series of a video that had gone viral held to be fair use and parody); *Lyons Partnership v. Ginnoulas*, 14 F. Supp. 2d 947 (S.D. Tex. 1998) (using a purple dinosaur, ridiculing Barney, in a comedy routine at sports events held to be transformative and fair use); *Master Card Int'l v. Nader 2000 Primary*, 70 U.S.P.Q. 2d 1046 (S.D.N.Y. 2004) (using a campaign ad for Nader's campaign, mimicking MasterCard's Priceless ads, held to be transformative and fair use); *Louis Vuitton Malletier SA v. Haute Diggity Dog*, 464 F. Supp. 2d 495 (E.D. Va. 2006) (stating that defendant's Chewy Vuitton dog toy held to be transformative and fair use in their parody of the high end status of plaintiff's products); *Lennon v. Premise Media Corp.*, 556 F. Supp. 2d 310 (S.D.N.Y. 2008) (using fifteen seconds from Beatles' song *Imagine* in documentary film *EXPELLED, No Intelligence Allowed* to criticize the naivete of John Lennon's views held to be transformative and fair use); *Lucasfilm v. Media Market Group*, 182 F. Supp. 2d 897 (N.D. Cal. 2002) (stating that plaintiff was unlikely to succeed on an infringement claim against animated pornographic film *Starballz* that draws on *Star Wars* because of its parodic character); *CCA & B, LLC v. F + W Media Inc.*, 819 F. Supp. 2d 1310, 1321–22 (N.D. Ga. 2011) (holding defendant's *Elf Off* book makes transformative use of plaintiff's elf doll and is a parody); *Admji v. DLT Entm't Ltd.*, 97 F. Supp. 3d 512 (S.D.N.Y. 2015) (holding defendant's play *3C* is a highly transformative parody of the 1970s comedy series *Three's Company*). *Cf.* *AFLAC v. Hagan*, 266 F. Supp. 2d 682 (N.D. Ohio 2002) (holding an unsuccessful trademark claim against gubernatorial candidate's use of the AFLAC duck in campaign ads with his opponent's head superimposed on the duck and repeatedly quacking "TaftQuack").

120. *ShIPLEY*, *supra* note 53, at 558–59.

care to ensure that not just any commercial takeoff is rationalized *post hoc* as a parody.”¹²¹

For example, in *Dr. Seuss Enterprises, L.P. v. Penguin Books U.S.A., Inc.*, the defendants’ retelling of the O.J. Simpson double-murder trial in a book written and illustrated to evoke a Dr. Seuss book, with both illustrations and writing done in those distinctive styles, was not treated as a parody but as an infringing satire.¹²² The book “simply retell[s] the Simpson tale,” with “no effort to create a transformative work.”¹²³ Similarly, the defendants in *Columbia Pictures Industries v. Miramax Films Corp.* asserted that their trailer and movie posters for Michael Moore’s satiric documentary, *The Big One*, were fair use parodies of the hit film *Men in Black* and posters for that movie.¹²⁴ The court disagreed:

The TBO Poster and Trailer do not create a “transformative work.” The TBO advertisements cannot reasonably be perceived as commenting on or criticizing the ads for “Men In Black.” The TBO Poster merely incorporates several elements of the MIB Poster: figures with a particular stance carrying large weapons, standing in front of the New York skyline at night, with a similar layout. Similarly, the TBO Trailer appears to be little more than an effort to “get attention” for “The Big One” and “avoid the drudgery in working up something fresh.”

...

Rather than commenting on or criticizing Plaintiffs’ ads, Defendants’ ads seek to use Plaintiffs’ ads as a vehicle to entice viewers to see “The Big One” in the same manner as Plaintiffs used their own ads to entice viewers to see “Men In Black.” In

121. *Campbell*, 510 U.S. at 600 (Kennedy, J. concurring).

122. *Dr. Seuss Enters., L.P. v. Penguin Books U.S.A., Inc.*, 924 F. Supp. 1559 (S.D. Cal. 1996), *aff’d*, 109 F.3d 1394 (9th Cir. 1997).

123. *Dr. Seuss Enters., L.P. v. Penguin Books U.S.A., Inc.*, 109 F.3d 1394, 1401 (9th Cir. 1997). Similarly, the lower court stated that the defendants made no “attempt to comment upon the text or themes of *The Cat in the Hat*.” 924 F. Supp. at 1569. *But see* Lombardo v. Dr. Seuss Enters., 16 Civ. 9974 (AKH), 2017 WL 1378413 (S.D.N.Y. Sep. 19, 2017) (holding that *Who’s Holiday!*, a one-woman play about a grown-up Cindy Lou is a parody that does not infringe *How the Grinch Stole Christmas*); Mindy Pava, Kelley Drye & Warren, *Joy in Who-Ville? Playwright Wins Fair Use Copyright Dispute in Parody “Grinch,”* AIPLA NEWSSTAND, Sept. 19, 2017; James Burger, Thompson Coburn, *The Grinch Loses and Protection of Parody Wins*, AIPLA NEWSSTAND, Sept. 21, 2017.

124. *Columbia Pictures Indus. v. Miramax Film, Corp.*, 11 F. Supp. 2d 1179, 1187–88 (C.D. Cal. 1998).

such circumstances, Defendants have not created a transformative work which alters the original with new expression, meaning or message.¹²⁵

The major problem with the post-*Campbell* parody case law is the lack of guidance on how to determine whether a challenged spoof or take-off criticizes or comments on the original work in order to qualify as a parody.¹²⁶ The line between a transformative parody and a satire is not clear. Judge Posner writes that fair use defense should apply only if the parody targets the parodied work instead of using it as a resource to create a comic effect, but he acknowledges problems “both in distinguishing these uses and of overlaps between them.”¹²⁷ A pastiche that transforms two or more popular works can be very entertaining, but is it really a parody that comments on one or more of the protected works that it utilizes in the mash-up?¹²⁸ Still, unauthorized uses which are clearly parodies will likely be held to be transformative and fair.

125. *Id.* at 1188 (citations omitted).

126. Shipley, *supra* note 53, at 559. *See, e.g.,* SunTrust Bank v. Houghton Mifflin Co., 268 F.3d 1257 (11th Cir. 2001) (holding novel retelling the story of *Gone With the Wind* from the perspective of a mixed race, half-sister of Scarlett O’Hara to be a parody); Northland Family Planning Clinic v. Center for Bio-Ethical Reform, 868 F. Supp. 2d 962 (C.D. Cal. 2012) (holding use of portions of plaintiff’s video aimed at de-stigmatizing abortion in a video attacking abortion and plaintiff’s clinics to be a parody). *But see, Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992) (holding defendant’s reproduction of plaintiff’s photograph as a sculptural work was held not to be a parody, but an infringing work); *Salinger v. Colting*, 641 F. Supp. 2d 250 (S.D.N.Y. 2009) (concluding that defendant’s novel, *60 Years Later: Coming Through the Rye*, marketed as sequel to *Catcher in the Rye*, was not parody or satire and unlikely defendant could show it transformed Salinger’s novel) *vacated on other grounds*, 607 F.3d 68 (2d Cir. 2010) (improper to presume irreparable harm after finding likelihood of success on the merits); *Henley v. Devore*, 733 F. Supp. 2d 1144 (C.D. Cal. 2010) (holding online campaign videos with songs similar to plaintiff’s songs were not transformative fair use parodies of those songs); *TCA TV Corp. v. McCollum*, 839 F.3d 168 (2d Cir. 2016) (holding use without alteration of the Who’s on First comedy routine in a play with a dark critique of small town norms was not transformative and fair).

127. Richard A. Posner, *When is Parody Fair Use?*, 21 J. LEGAL STUD. 67, 71 (1992); *see also* Samuelson, *supra* note 2, at 2553–53 (classifying the *Wind Done Gone* use of *Gone With the Wind* as a transformative critique). Some cases are, however, easy. *See, e.g., Broadcast Music v. McDade & Sons*, 928 F. Supp. 2d 1120 (D. Ariz. 2013) (stating performance of *Sweet Home Alabama* with Arizona substituted for Alabama was not a parody).

128. Anandashankar Mazumdar, *Dispute Over Dr. Seuss-Star Trek Mashup Heading for Trial*, BNA: NEWS (June 13, 2017), <https://www.bna.com/dispute-dr-seussstar-n73014453206> (stating that Dr. Seuss argued unsuccessfully that mashups should not be protected with the court saying that it needed more evidence before deciding how fair use factors balanced out).

B. Other Forms of Commentary and Criticism

Section 107's preamble does not mention parody, but it does state that "the fair use of a copyrighted work . . . for purposes such as criticism, comment, . . . is not an infringement of copyright."¹²⁹ Courts have had little difficulty concluding that many different uses of protected works for criticism and comment are fair,¹³⁰ but sometimes require an alleged infringer to show that the challenged use was transformative.¹³¹ In my opinion, this is at odds with the Court's statement in *Campbell* that a use need not be transformative in order to be a fair;¹³² it ignores the well-established principle that when a challenged use falls within one of the purposes listed in section 107's preamble then the first fair use factor ordinarily favors the defendant,¹³³ and it overworks the word transformative.¹³⁴

The use of a video to criticize the plaintiff was transformative and a fair use in *Caner v. Autry*.¹³⁵ Plaintiff Ergun Caner was an author and evangelical speaker who had been dismissed as dean of Liberty University's seminary following an investigation into his claims of being raised in Turkey and indoctrinated with extreme Islamic philosophy.¹³⁶ The defendant posted two videos on YouTube with recordings of Caner speaking about Islam interspersed with criticism and commentary in an effort to refute the plaintiff's claims about his past.¹³⁷ Caner's infringement suit was dismissed on summary judgment with the court holding that the defendant's edited videos were transformative.¹³⁸ The court stated that "it has long been established that fair use protects the transformative use of a work to criticize, even when the parody or

129. 17 U.S.C. § 107 (West 2012).

130. A use more likely qualifies as fair if a work is used for the purpose of criticism or comment, two of the enumerated fair use exceptions in section 107. *Bouchat v. Baltimore Ravens Ltd. P'ship*, 619 F.3d 301, 307–08 (4th Cir. 2010).

131. *Id.* at 308–09.

132. *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 579 (1994).

133. *NXIVM Corp. v. Ross Inst.*, 364 F.3d 471, 477 (2d Cir. 2004) (stating that if the work falls within one of the favored purposes there is a strong presumption that the first factor favors the defendant).

134. Samuelson, *supra* note 2, at 2556 (discussing a category of cases she classifies as critical commentary).

135. *Caner v. Autry*, 16 F. Supp. 3d 689 (W.D. Va. 2014).

136. *Id.* at 692–93.

137. *Id.* at 692.

138. *Id.* at 715.

criticism is so forceful that it may eliminate the market for the object of the criticism.”¹³⁹

It would have been sufficient to say that the defendant’s use of plaintiff’s protected expression was to criticize the substance of his claims. After all, the defendant’s criticism of the plaintiff was “at the heart of what fair use seeks to protect, in that it targets the allegedly inconsistent statements of a person who has placed himself in the public spotlight through the very narratives now under fire.”¹⁴⁰ There are several other decisions with similar results.¹⁴¹

Even though criticism and comment are in the preamble to section 107, other post-*Campbell* decisions have analyzed unauthorized uses that were obvious forms of criticism or comment to determine whether they were parodies. The plaintiff in *Northland Family Planning Clinic, Inc. v. Center for Bio-Ethical Reform*¹⁴² created a video to be used for outreach, counseling, and education in an effort to de-stigmatize abortion, to point out that abortion is not uncommon, and to emphasize that women are good regardless of how they exercise their reproductive rights.¹⁴³ The video was titled “Every Day, Good Women Choose Abortion.”¹⁴⁴ The defendant used portions of this video verbatim in its own anti-abortion

139. *Id.* at 714. The dispute started with Caner submitting a take-down notice. Youtube then informed Caner that defendant Autry had disputed the take down so YouTube would repost the videos unless Caner sued within 10 days. *Id.* at 693.

140. *Id.* at 710–11.

141. See *Belmore v. City Pages, Inc.*, 880 F. Supp. 673 (D. Minn. 1995) (stating republication of entire news article as a critique of a police officer and police department was transformative and fair use); see also *Ascend Health Corp. v. Wells*, No. 4:12-CV-00083-BR, 2013 WL 1010589 (E.D.N.C. Mar. 14, 2013) (holding defendant’s use of images from the plaintiff’s website on his blogs and social media to criticize the plaintiff’s business practices was transformative and a fair use); *Katz v. Chevaldina*, No. 12-22211-CV, 2014 WL 4385690 (S.D. Fla. Sept. 5, 2014), *aff’d* *Katz v. Google, Inc.*, 802 F.3d 1178 (11th Cir. 2015) (holding defendant blogger’s use of plaintiff’s unflattering copyrighted picture of himself on blog postings criticizing plaintiff’s business and litigation practices was transformative because in some posts the defendant had cropped the photo, pasted images into cartoons with derogatory captions, and it was used for a purpose different from its original purpose); *Hoge v. Schmalfeldt*, No. ELH-14-1683, 2014 WL 3052489 (D. Md. July 1 2014) (finding defendant’s use of plaintiff’s blog posts in order to respond to material found in those blogs transformative and for the purpose of criticism or comment); *City of Inglewood v. Teixeira*, No. CV-15-01815-MWF, 2015 WL 5025839 (C.D. Cal. Aug. 20 2015) (stating defendant’s use of portions of city’s copyrighted video recordings of council meetings to make videos critical of the council and elected officials was transformative and fair use).

142. *Northland Family Planning Clinic, Inc. v. Center for Bio-Ethical Reform*, 868 F. Supp. 2d 962 (C.D. Cal. 2012).

143. *Id.* at 966.

144. *Id.* at 966. The plaintiff operates family planning clinics in the Detroit area. *Id.*

videos.¹⁴⁵ The narrative from the plaintiff's video continued to be heard while one of defendant's videos showed graphic images of abortion procedures and ended "with [the plaintiff's] name, telephone number, and the words 'Your Dead baby at 10 to 12 weeks,' superimposed over [an aborted] fetus."¹⁴⁶ The court discussed at length the parties' arguments about whether the defendant's videos were parodies,¹⁴⁷ and ultimately concluded that they were.¹⁴⁸ Although parodies need not be humorous,¹⁴⁹ the characterization of the defendant's videos as parodies was not necessary because it was obvious that they were aimed at criticizing the message in plaintiff's video and were transformative. The court stated that "[t]he new background soundtrack, the visuals, and the juxtaposition of the new video clips with the original creates an entirely different impact on the viewer. Thus, the accused Videos are transformative."¹⁵⁰ The court granted summary judgment for the defendants holding that their use of the plaintiff's video was insulated as a fair use.¹⁵¹

Instead of stretching the transformative use concept to cover the reproduction of a protected work in connection with what is clearly comment or criticism it would be preferable for the court to play it straight, as in *Savage v. Council on American-Islamic Relations*.¹⁵² Savage, a conservative talk show host, sued the defendant for posting copies of his anti-Islamic statements on its website along with a four

145. *Id.* at 967.

146. *Id.*

147. *Id.* at 970–78 ("In this case, the TAG and CBR Videos are parodies of the Northland Video because they use segments of the Northland Video in alternation with macabre images of abortion procedures to deride the original work's message that abortion is 'normal' and that good women choose to terminate their pregnancy." *Id.* at 972).

148. *Id.* at 976.

149. *See, e.g.,* SunTrust Bank v. Houghton Mifflin Co., 268 F.3d 1257 (11th Cir. 2001) (holding that a novel retelling the story of *Gone With the Wind* from the perspective of a mixed race half-sister of Scarlett O'Hara was a parody).

150. Northland Family Planning Clinic, Inc. v. Center for Bio-Ethical Reform, 868 F. Supp. 2d 962, 978 (C.D. Cal. 2012).

151. *Id.* at 966. *Cf.* BWP Media USA v. Gossip Cop Media, LLC, 87 F. Supp. 2d 499 (S.D.N.Y. 2015) (suit against celebrity gossip website for reproducing several photos and a video dismissed as to some images and not others due in part to difficulty of determining the purpose of the copying and whether it was transformative). Susan Decker, *White Supremacists' Use of Pepe the Frog Fought by Its Creator*, BNA IP L. RES. CENTER (Sept. 19, 2017), <https://www.bloomberg.com/news/articles/2017-09-18/white-supremacists-use-of-pepe-the-frog-fought-by-its-creator> (discussing whether use of copyrighted character on 'alt-right' sites is fair use).

152. *Savage v. Council on Am.-Islamic Relations, Inc.*, No. C 07-6076 SI, 2008 WL 2951281 (N.D. Cal. July 25, 2008).

minute recording from one of his shows.¹⁵³ The defendant posted these materials to criticize Savage's views, organize a boycott, and raise money.¹⁵⁴ The court said that there was "no dispute that the purpose and character of defendant's use . . . was a form of public criticism."¹⁵⁵ In concluding that the first fair use factor favored the defendant the court stated:

To comment on plaintiff's statements without reference or citation to them would not only render defendants' criticism less reliable, but be unfair to plaintiff. Further, it was not unreasonable for defendants to provide the actual audio excerpts, since they reaffirmed the authenticity of the criticized statements and provided the audience with the tone and manner in which plaintiff made the statements.¹⁵⁶

An analogous pre-*Campbell* decision which found fair use in the context of criticism and comment without turning to transformativeness is *Hustler Magazine v. Moral Majority*.¹⁵⁷ The late Rev. Jerry Falwell, in response to a parody advertisement for Campari liquor featuring him that was published in *Hustler Magazine*, sent out mailings to hundreds of thousands of supporters and donors that included a copy of the parody ad with some of the words redacted.¹⁵⁸ This was done to raise money to support Falwell's suit against *Hustler*, publisher Larry Flynt, and others, alleging libel, invasion of privacy, and intentional infliction of emotional

153. *Id.* at *1.

154. *Id.*

155. *Id.* at *4.

156. *Id.* at *6. Professor Samuelson categorizes this decision as an example of iterative copying for orthogonal speech related purposes. Samuelson, *supra* note 2, at 2557. *Cf.* *Dhillon v. Doe*, 2014 WL 722592 (N.D. Cal. Feb. 25 2014) (holding that the use of a photo as part of an article critical of plaintiff's politics was transformative and fair because it was used for the purpose of criticism and not identification); *Katz v. Google, Inc.*, 802 F.3d 1178 (11th Cir. 2015) (stating that the defendant's use of plaintiff's photo in scathing blog posts critical of plaintiff was transformative, while also noting that the use was educational and that there was no evidence of market harm). John Hannebery & Lachlan Sadler, Davies Collison Cave, *Victory for You Tubers as New York District Court Rule "Reaction Video" is Fair Use*, AIPLA NEWSSTAND (Sept. 26, 2017) (discussing reaction videos as criticism and comment—a classic form of fair use); Andrew Levad and Jason Gordon, Reed Smith L.L.P., *Judge Agrees—YouTube Mockery Protected by Fair Use*, AIPLA NEWSSTAND (Oct. 17, 2017). *But see*, *Henley v. Devore*, 733 F. Supp. 2d 1144 (C.D. Cal. 2010) (holding that the unauthorized use of plaintiff's songs for political ad critical of plaintiff's opponent was not fair use due to market harm).

157. *Hustler Magazine v. Moral Majority*, 796 F.2d 1148 (9th Cir. 1986).

158. *Id.* at 1150.

distress.¹⁵⁹ Falwell also displayed the advertisement on his television show.¹⁶⁰ *Hustler* sued, alleging that Falwell's reproduction and public display of the ad constituted copyright infringement.¹⁶¹ The Ninth Circuit eventually affirmed the grant of summary judgment for Rev. Falwell on fair use grounds, determining that although the defendants conceded that their use of the copies of the ad was to raise money, it was also a form of criticism and comment—an individual's effort to rebut a copyrighted work that contained derogatory comments.¹⁶² The court explained that “the public interest in allowing an individual to defend himself against such derogatory personal attacks serves to rebut the presumption of unfairness.”¹⁶³

*C. News Reporting*¹⁶⁴

News reporting is also included in the preamble to section 107 as one of several examples to “give some idea of the sort of activities the courts might regard as fair use under the circumstances.”¹⁶⁵ Although reproducing a portion of a protected work in connection with reporting the news is traditionally regarded productive and fair,¹⁶⁶ courts often

159. *Id.* at 1150 n.1.

160. *Id.* at 1149.

161. *Id.* at 1150 n.1.

162. *Id.* at 1153.

163. *Id.* At this time, commercial uses still were presumptively unfair. *See Sony Corp. of Am. v. Universal City Studios*, 464 U.S. 417, 449–51 (1984). This decision was 2-1 with the dissent asserting that Falwell's efforts here sought to exploit the outrage in an effort to raise money, and that this weighed heavily against fair use. *Hustler Magazine*, 796 F.2d at 1158–59. The *Hustler* decision was cited in *Dhillon v. Doe*, No. C 13-01465 SI, 2014 WL 722592 (N.D. Cal. Feb. 25, 2014) (holding that defendant's use of plaintiff's head shot photo in connection with an article critical of and commenting on plaintiff's political view was transformative because it served the purpose of criticism and not identification); *see also Galvin v. Ill. Republican Party*, 130 F. Supp. 3d 1187 (N.D. Ill. 2015) (holding altered copy of photograph used for a political ad to be transformative and fair use—not a substitute for the original). *But see, Hill v. Public Advocate of the U.S.*, 35 F. Supp. 3d 1347 (D. Col. 2014) (finding unauthorized reproduction of plaintiff's photo of a gay couple's engagement in political advertisement critical of a candidate's views on family values not transformative and not a fair use).

163. Use for news reporting purposes also is one of Professor Samuelson's policy clusters. Samuelson, *supra* note 2, at 2558–66.

164. *Id.*

165. H.R. REP. NO. 94-1476 at 63 (1976). The listing is not exhaustive, and it is not intended to single out a particular use as being presumptively fair. *Id.*; *see also Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 539 (1985).

166. *Harper & Row*, 471 U.S. at 561.

unnecessarily discuss the transformative use standard in cases involving news just as they do in cases involving comment or criticism.¹⁶⁷

In *Fuentes v. Mega Media Holdings, Inc.*, the plaintiff was a well-known Cuban author and journalist who, after seeking asylum in the United States, reacquired ten to twelve hours of video footage he had created in the late 1980s concerning activities in Angola by high ranking members of Cuba's military.¹⁶⁸ The defendants obtained some of this video footage from a third party in 2008, and aired portions of it on a television show. Plaintiff sued for infringement.¹⁶⁹ The court granted summary judgment for the defendants on the strength of their fair use defense.¹⁷⁰ It noted, among other things, that news reporting was in section 107's preamble, that the subject matter was of historical importance, and that defendant's use was transformative because they had edited plaintiff's work and added commentary.¹⁷¹ It probably would have been sufficient to stick to the four statutory factors.

For example, an unauthorized use for news reporting can be a fair use without being very transformative as illustrated by *The Swatch Group Management Services v. Bloomberg, L.P.*¹⁷² The court stated that Bloomberg's unauthorized verbatim reproduction of a written transcript of Swatch's conference call about its 2010 earnings report was "at least arguably transformative."¹⁷³ In finding fair use, the court explained that

167. Courts do this even though these uses are listed in the preamble. Moreover, it is well established that a determination that a use is not transformative is not necessarily fatal to a fair use defense. *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 579 (1994).

168. *Fuentes v. Mega Media Holdings, Inc.*, No. 09-22979-CIV 2011 WL 2601356 (S.D. Fla. June 9, 2011).

169. *Id.* at *10.

170. *Id.* at *51–52.

171. *Id.*; see also *Nunez v. Caribbean International News Corp.*, 235 F.3d 18 (1st Cir. 2000) (holding that a newspaper's publication of professional photos of beauty pageant winner taken for her portfolio was transformative, newsworthy and fair use because the model was nude in one of the photos); *Video-Cinema Films, Inc. v. Cable News Network, Inc.*, No. 598 Civ. 7128-30, 2001 WL 1518264 (S.D.N.Y. Nov. 29, 2001) (holding that the use of a 20 second clip from the 1945 movie *G.I. Joe* in a two minute, fifty second news report about the death of the actor who portrayed GI Joe, Robert Mitchum, was transformative and fair use).

172. *The Swatch Group Mgmt. Servs. Ltd. v. Bloomberg L.P.*, 756 F.3d 73 (2d Cir. 2014), *amending and superseding* *The Swatch Group Mgmt. Servs. Ltd. v. Bloomberg L.P.*, 742 F.3d 17 (2d Cir. 2014).

173. *Id.* at 85. The court had initially said that this verbatim reproduction of the transcript was not transformative. *The Swatch Group Mgmt. Servs. Ltd.*, 742 F.3d at 28–29.

in the context of news reporting the need to convey information to the public may require a defendant to copy an entire work.¹⁷⁴

Of course, the use of a work for news reporting does not guarantee a finding of fair use as shown by *Fitzgerald v. CBS Broadcasting*.¹⁷⁵ This case concerned a dispute over a television station's unauthorized publication of a free lance photographer's photos that had been first published six years earlier.¹⁷⁶ The court said "[t]o determine exactly how much transformation occurred in the [defendant's] broadcast of the photo requires an analysis of the original, intended meaning and use of the photo and its ultimate meaning and use on June 24–25, 2004."¹⁷⁷ Here, the plaintiff's photo of the arrest of a gangster in 1998 was used, slightly cropped, in a news story about the sentencing in 2004 of a different gangster.¹⁷⁸ The court concluded that the only transformation in this case was that the photo of the earlier arrest "was downgraded from breaking news to a supplementary part of a larger story."¹⁷⁹ The court, after concluding that this commercial use was not transformative, weighed the other fair use factors and found infringement.¹⁸⁰ It would have been better for the court to say that the defendant's use of the plaintiff's old photo of one gangster to illustrate the sentencing of another gangster was not newsworthy and then proceed to an analysis of the four statutory fair use factors.

There are other decisions in which news reporting was raised in connection with a fair use defense, and the courts found infringement after concluding that the defendant's use was neither transformative nor fair. In *Harper Collins v. Gawker*, a blog's publication of twenty-one pages from Sarah Palin's soon- to be published book was not a fair use for several reasons including the fact that the blog copied the material to attract readers and not for purposes of criticism, comment, or news reporting.¹⁸¹ In *Monge v. Maya Magazines*, the defendant's publication of six of one hundred unpublished photographs of a celebrity wedding to corroborate a story in a gossip magazine was "at best minimally

174. *The Swatch Group Mgmt. Servs. Ltd.*, 756 F.3d at 85 (stating that faithful reproduction of the transcript of the conference call served the interest of accuracy, not piracy). The court had initially said that the secretly recorded telephone conference call disclosed by Bloomberg included material "of critical importance to American securities markets." *Id.* at 26–27.

175. *Fitzgerald v. CBS Broadcasting, Inc.*, 491 F. Supp. 2d 177 (D. Mass. 2007).

176. *Id.* at 180.

177. *Id.* at 185–86.

178. *Id.* at 181, 186.

179. *Id.*

180. *Id.* at 190.

181. *Harper Collins v. Gawker*, 721 F. Supp. 2d 303, 305 (S.D.N.Y. 2010).

transformative.”¹⁸² According to the court, the defendant published more photos than necessary.¹⁸³ In *Balsey v. LFP*, the Sixth Circuit affirmed the denial of defendant Hustler’s motion for a judgment as a matter of law regarding its publication of plaintiff’s photos of her participation in a wet T-shirt contest several years earlier.¹⁸⁴ The magazine’s use of the photos was not transformative; they were not altered but for minor cropping, there was no added creative message, and the defendant’s purpose in publishing the photos was the same as the original purpose; to shock, arouse, and amuse.¹⁸⁵ Likewise, reuse of news videos of the 1992 Los Angeles riots and the beating of Reginald Denny was not transformative where the videos were simply re-transmitted in their entirety without comment, editing, or context.¹⁸⁶ Posting copyrighted news stories from mainstream media like the Los Angeles Times and the Washington Post on defendant’s bulletin board website and asking the site’s visitors to comment on the stories was neither a transformative use of the articles nor a fair use.¹⁸⁷ In each of these cases the courts, instead of discussing transformativeness, might have said that the particular uses of plaintiffs’ works were not news reporting and then proceed to apply the statute’s four factors.

182. *Monge v. Maya Magazines*, 688 F.3d 1164, 1176 (9th Cir. 2012).

183. *Id.* at 1164. The defendant did not meet its burden on fair use. Even though only six of 100 photos were published, those six were published in their entirety. *Id.* at 1180; see also *BWP Media U.S.A., Inc. v. Gossip Cop Media, Inc.*, 196 F. Supp. 3d 395 (S.D.N.Y. 2016) (holding that defendant’s use of photos and video from another gossip site, allegedly for the purpose of comment, was not transformative).

184. *Balsey v. LFP*, 691 F.3d 747, 754 (6th Cir. 2012). The plaintiff, who had lost her job as a broadcaster as a result of the earlier disclosure of some of these photographs, had acquired the copyright on them. *Id.* at 755.

185. *Id.* at 759; see also *Barcroft Media, Ltd. v. Coed Media Grp.*, No. 16-CV-7634 (JMF), 2017 WL 5032993, at *6 (S.D.N.Y. Nov. 2, 2017) (stating that defendant’s infringing use of plaintiffs’ copyrighted celebrity and human interest photographs on defendant’s pop culture websites had no transformative effect because it displayed them in the same manner and for the same purpose as they were originally intended and used).

186. *Los Angeles News Serv. v. Reuters TV Int’l*, 149 F.3d 978 (9th Cir. 1998). *But see*, *Los Angeles News Service v. CBS Broad., Inc.*, 305 F.3d 924 (9th Cir. 2002) (holding that Court TV’s rebroadcast of a short segment of the Denny beating in connection with its coverage of the trial of his assailant was transformative and fair use), *amended and superseded on other grounds*, 313 F.3d 1093 (9th Cir. 2002); see also *Nihon Kezai Shimbun, Inc. v. Comline Bus. Data, Inc.*, 166 F.3d 65 (2d Cir. 1999) (holding that defendant’s infringing abstracts of financial news reports were not in the least transformative but simply direct translations of plaintiff’s Japanese language reports).

187. *Los Angeles Times v. Free Republic*, No. CV 98-7840 MMM, 2000 WL 565200 (C.D. Cal. April 4, 2000) (plaintiffs also claimed that this use of their articles could impact the traffic on their own sites).

News reporting, like criticism and comment, is listed in the preamble to section 107 and was well established as a fair use before the transformative use doctrine became so important.¹⁸⁸ Here again, when an unauthorized use is defended as being for news reporting purposes the courts should do a straight forward fair use analysis instead of twisting and turning to decide whether the use is transformative. The courts should focus on whether the use was legitimate news reporting as well as the extent of the taking and the impact of the unauthorized copying on the market for the protected work.

D. Documentaries, Compendiums, Reference Books, and Other Uses Out of Context

There are many fair use decisions involving unauthorized uses of protected works out of context. By this I mean that a portion of a protected work is used without significant modification in a setting that is substantially different from the original author's setting—his or her actual and intended use of the work. The use out of context thus often “adds something new, *with a further purpose or different character*, altering the first with new expression, meaning, or message”¹⁸⁹ even though the existing work is not altered or altered only slightly.¹⁹⁰ In many of these use-out-of-context cases, courts have held that the uses were transformative and fair. However, it is important to note that in some of these cases only a relatively small amount of the protected work was used, and it was relatively clear that the character or purpose of the challenged use was significantly different from the work's original character or purpose.¹⁹¹ In my opinion, the transformative use standard plays a useful role for courts and counsel in litigating and ultimately deciding use out of context cases.

Bill Graham Archives v. Dorling Kindersley, Ltd. is a good example.¹⁹² The defendant published a 480-page coffee table book in 2003 that told the story of the Grateful Dead.¹⁹³ The story was told chronologically, along a timeline, with over 2,000 images and

188. 17 U.S.C. § 107 (2012).

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

190. *See generally* Zimmerman, *supra* note 73.

191. ‘Purpose’ in a fair use analysis is not an all-or-nothing matter. It is critical to evaluate the extent of the comment or criticism, whether it is substantial or insignificant. *Twin Peaks Prods., Inc. v. Publications Int’l, Ltd.*, 996 F.2d 1366, 1374 (2d Cir. 1993). However, the cases in this category show that a transformative use need not be a critical use. *CRAIG JOYCE ET AL*, *supra* note 3, at 866 n.5.

192. *Bill Graham Archives v. Dorling Kindersley, Ltd.*, 448 F.3d 605 (2d Cir. 2006).

193. *Id.* at 607.

explanatory text.¹⁹⁴ Plaintiff Bill Graham Archives held the copyright on Grateful Dead concert tour posters, and sued after substantially reduced images of seven of these posters were included in the book without permission.¹⁹⁵ The court of appeals affirmed a summary judgment in the defendant's favor, agreeing with the trial court's finding that the reproduction of the images on the book's timeline was transformative.¹⁹⁶ The appellate court emphasized that the use of the images in the biography as historical artifacts was very different from their original purpose which was generating public interest in upcoming concerts.¹⁹⁷ In addition, the reproductions were in reduced size, they were displayed at angles as part of a collage of images, and they took up no more than one-eighth of a page on the seven pages that included the images.¹⁹⁸ Accordingly, the first fair use factor weighed in the defendant's favor.¹⁹⁹

SOFA Entertainment, Inc. v. Dodger Productions is similar.²⁰⁰ At issue was a seven second excerpt from the January 2, 1966 broadcast of the Ed Sullivan Show during which this famous host introduced the Four Seasons.²⁰¹ The defendants used this clip in the popular musical, *Jersey Boys*—a historical dramatization of the Four Seasons and the lives of its members.²⁰² The court stated that the film clip, shown at the end of the play's first act,

references the Four Seasons' performance on the January 2, 1966 episode of *The Ed Sullivan Show* to mark an important moment in the band's career. At that point in rock & roll history, many American bands were pushed into obscurity by the weight of the "British Invasion," which was kicked off by the Beatles' performance on *The Ed Sullivan Show*. The Four Seasons, however, thrived. Being selected by Ed Sullivan to perform on his show was evidence of the band's enduring prominence in American music. By using it as a biographical anchor, Dodger put the clip to its own transformative ends.²⁰³

194. *Id.*

195. *Id.*

196. *Id.* at 608–12.

197. *Id.* at 610.

198. *Id.* at 611–15.

199. *Id.* at 609–10.

200. *SOFA Entm't, Inc. v. Dodger Prods.*, 709 F.3d 1273 (9th Cir. 2013).

201. *Id.* at 1276.

202. *Id.* at 1276–77.

203. *Id.* at 1278. The court cited the *Bill Graham Archives* decision, 448 F.3d 605 (2d Cir. 2006) (discussing the Grateful Dead concert poster decision discussed *infra*) and *Elvis Presley Enters., Inc. v. Passport Video*, 349 F.3d 622 (9th Cir. 2003) (holding that

To generalize from these and other ‘use out of context’ decisions,²⁰⁴ it seems to be safe to use a small amount of a copyrighted work without permission when the intended purpose, such as a biographical anchor, a historical artifact, or as a jumping off point, is considerably different from the original purpose of the work, such as entertainment or promotion. This will likely be treated as transformative.²⁰⁵ However, if

the use of television clips of Elvis in performance and on various television shows in connection with a documentary was transformative, but affirming the trial court’s ruling that the defendant biographer likely did not use the protected material fairly given the substantial amount of the taking); *see also* Corbello v. Devito, No. 2:08-cv-00867-RJC-PAL, 2017 WL 2587924 (D. Nev. June 14, 2017) (members of the Four Seasons and the producers of the musical Jersey Boys entitled to judgment as a matter of law against author who assisted one of the members in writing his autobiography because all but one of the factors favored fair use, in large part due to the transformative nature of the musical).

204. *See, e.g.,* Hofheinz v. A&E Television Networks, 146 F. Supp. 442 (S.D.N.Y. 2001) (using twenty-second clip from the movie *It Conquered the World* in a television biography of the actor Peter Graves held to be transformative and fair use); Warren Publ’g Co. v. Spurlock d/b/a Vanguard Prods., 645 F. Supp. 2d 402 (E.D. Pa. 2009) (holding that the use of 24 monster and horror magazine covers created by the artist Basil Gogos in a book that was a retrospective of the artist’s career was transformative and fair use); *Monster Commc’ns v. Turner Broad. Sys.*, 935 F. Supp. 490 (S.D.N.Y. 1996) (holding that the use of two minutes of video footage in movie biography of Muhammad Ali was fair use); *Seltzer v. Green Day, Inc.*, 725 F.3d 1170 (9th Cir. 2013) (holding that defendant’s photo of a graffiti covered wall with a poster of plaintiff’s work—a screaming face—as part of a video backdrop for live performances of a song was transformative and fair use given the new content and message even though plaintiff’s protected image itself was not significantly altered); *Calkins v. Playboy Enters. Int., Inc.*, 561 F. Supp. 2d 1136 (E.D. Cal. 2008) (holding that defendant’s use of plaintiff’s high school photo of Playboy Centerfold on a biography page was transformative and fair use because it was in reduced size and served a different function from the original image—to provide insight into her life).

205. *See also* Higgins v. Detroit Educ. Television Found., 4 F. Supp. 2d 701 (E.D. Mich. 1998) (holding that the use of thirty-five seconds of plaintiff’s song, without lyrics, as background music in a twenty-seven minute educational program counseling children to avoid drugs was transformative and fair use); *Nat’l Football Scouting, Inc. v. Rang*, 912 F. Supp. 2d 985 (W.D. Wash. 2012) (holding that defendant sports writer’s use of the plaintiff’s grades for eighteen players out of hundreds of players in plaintiff’s scouting reports as a starting point for his own comments about the draft prospects for particular players was transformative and fair use); *Arrow Prods. v. Weinstein Co. LLC*, 44 F. Supp. 3d 359, 368–70 (S.D.N.Y. 2014) (holding the recreation of three scenes from famous pornographic movie *Deep Throat* in biographical account of the movie’s star was transformative and fair use); *Bouchat v. Balt. Ravens*, 619 F.3d 301 (4th Cir. 2010) (holding the football team’s use of infringing Flying B logo in the lobby of the team’s corporate headquarters in connection with a display of tickets from the inaugural season and photos of the team’s first high draft picks was transformative since the logo was being used for factual content but sale of highlight films containing game footage from prior seasons when the logo was used was not fair use); *Bouchat v. Balt. Ravens*, 737 F.3d 932 (4th Cir. 2013) (holding the fleeting uses of the infringing ‘Flying B’ logo as

the defendant takes a large amount from the protected work—a substantial taking as opposed to that seven second clip of the Ed Sullivan Show in *SOFA Entertainment* or those seven images of concert posters in reduced size in *Bill Graham Archives*—then the defendant's use, though transformative, might not be fair.

This proposition is illustrated by *Warner Bros. Entertainment v. RDR Books* which concerned the potential publication of a print version of *The Harry Potter Lexicon*, a free online guide to the Harry Potter series.²⁰⁶ This book, *The Lexicon*, was to be encyclopedia of information from all the Harry Potter novels and also J.K. Rowling's companion books on Quidditch and Fantastic Beasts.²⁰⁷ The court said that *The Lexicon*'s use of the Potter series had transformative elements because instead of telling an entertaining story about the character Harry Potter and his magical world, it “uses material from the series for the practical purpose of making information about the intricate world of *Harry Potter* readily accessible to readers in a reference guide.”²⁰⁸ However, the use of Rowling's companion books in the *The Lexicon* was less transformative.²⁰⁹ The defendant's fair use defense was ultimately undermined by the extensive borrowing from the novels and the companion books,²¹⁰ and by the likelihood that publication of *The Lexicon* would impair the market for derivative works that Rowling could license.²¹¹ The court stated:

factual content in connection with displays at the Ravens' stadium and in videos about the history of the Ravens and the NFL are transformative and fair use, but use of the logo in connection with a video game was not transformative); *Faulkner Literary Rights, LLC v. Sony Pictures Classics, Inc.*, 953 F. Supp. 2d 701, 707–09 (N.D. Miss. 2013) (holding the paraphrase of one line from Faulkner's novel *Requiem for a Nun* in a movie comedy set in Paris is transformative and fair use in that the speaker, time, and place were diametrically dissimilar plus the quote was of miniscule importance); *Campinha-Bacote v. Evansville Vanderburgh Sch. Corp.*, No. 3:14-cv-00056-SEB-WGH, 2015 WL 12559889 (S.D. Ind. Nov. 5, 2015). Holding the use of plaintiff's ASKED Model, “clearly designed to be used exclusively by psychiatric nurses and similarly situated healthcare professionals,” in a the public education context was transformative and fair. *Id.*

206. *Warner Bros. Entm't v. RDR Books*, 575 F. Supp. 2d 513, 519–21 (S.D.N.Y. 2008).

207. *Id.* at 520–22. The book was to be an A to Z guide to creatures, characters, objects and events with over 2400 entries. *Id.* at 524.

208. *Id.* at 541. Since the book was to serve reference purposes, rather than the entertainment or aesthetic purposes of the novels, it did not supplant those works. *Id.*

209. It was slightly transformative by synthesizing the material from her companion works with the complete reference guide. *Id.* at 542.

210. *Id.* at 548.

211. *Id.* at 551.

In striking the balance between the property rights of original authors and the freedom of expression of secondary authors, reference guides to works of literature should generally be encouraged by copyright law as they provide benefit to readers and students; but to borrow from Rowling's overstated views, they should not be permitted to 'plunder' the works of original authors.²¹²

Elvis Presley Enterprises, Inc. v. Passport Video,²¹³ also ruled against fair use after saying that defendant's use of television clips of Elvis in live performances and on various television shows in a sixteen hour documentary was occasionally transformative.²¹⁴ The clips were of varying lengths, some were filler, and others were subject to commentary.²¹⁵ As in the *The Lexicon* litigation involving the Harry Potter series, the defendant's borrowings were too extensive. The Ninth Circuit stated:

In the aggregate, the excerpts comprise a substantial portion of Elvis' total appearance on many of these shows. For example, almost all of Elvis' appearance on *The Steve Allen Show* is contained in *The Definitive Elvis*. Thirty-five percent of his appearances on *The Ed Sullivan Show* is replayed as is three minutes from *The 1968 Comeback Special*.²¹⁶

The fair use issue was close because many of the clips were cited as historical reference points.²¹⁷ The entire work was biographical in nature, going beyond entertainment to tell the story of Elvis' life.²¹⁸ However, many of the clips were used "in excess of this benign purpose, and . . . are simply rebroadcast for entertainment purposes that Plaintiffs rightfully own."²¹⁹ The Second Circuit concluded that the district court had not abused its discretion in weighing the fair use factors and determining that plaintiffs would likely succeed on the merits.²²⁰

212. *Id.* at 551. The defendant ultimately published a revised version of *The Lexicon*. CRAIG JOYCE ET AL., *supra* note 3, at 858 n.7.

213. *Elvis Presley Enters. Inc. v. Passport Video*, 349 F.3d 622 (9th Cir. 2003).

214. *Id.* at 628-29.

215. *Id.* at 625.

216. *Id.*

217. *Id.* at 629.

218. *Id.* at 625.

219. *Id.* at 629.

220. *Id.* at 631.

There were similar outcomes favoring the copyright owner in litigation over a Godzilla compendium book that contained commentary, critique, trivia, plot summaries and still pictures of each Godzilla film,²²¹ a 'Seinfeld Aptitude Test' trivia quiz book that used 643 fragments about the hit show's characters and their quirks from eighty four of the episodes,²²² and a book summarizing in great detail the plots of episodes of the Twin Peaks television series.²²³ In all of these cases, the defendants arguably transformed copyrighted material from the plaintiffs' works but took too much protected expression.²²⁴

However, even relatively small takings of protected work might not be regarded as transformative if the purpose or character of the new use is hard to differentiate clearly from the original use or purpose of the work. A case on point is *Ringgold v. Black Entertainment Television* which involved the unauthorized public display for roughly thirty seconds of a poster version of Faith Ringgold's 'Church Picnic Story

221. *Toho Co. Ltd. v. William Morrow & Co.*, 33 F. Supp. 2d 1206 (C.D. Cal. 1998).

222. *Castle Rock Entm't, Inc. v. Carol Publ'g Group, Inc.* 150 F.3d 132 (2d Cir. 1998); see also *Twin Peaks Prods. Inc. v. Public Int'l Ltd.*, 996 F. 2d 1366 (2d Cir. 1993) (retelling the stories of the *Twin Peaks* series in abridged versions infringed because the plot details of the shows were in the same sequence as the original series); *Paramount Pictures Corp. v. Carol Publ'g Group*, 11 F. Supp. 2d 329, 335 (S.D.N.Y. 1998) (finding the use of characters, plots and dramatic episodes that make up the *Star Trek* series in unauthorized 'Joy of Trek' book is not transformative and not fair use).

223. *Twin Peaks Prods. Inc. v. Publ'ns Int'l Ltd.* 996 F.2d 1366 (2d Cir. 1993). Cf. *Paramount Pictures Corp. v. Carol Publ'g Group*, 11 F. Supp. 2d 329, 335 (S.D.N.Y. 1998) (stating the use of characters, plots and dramatic episodes from the *Star Trek* series in unauthorized 'Joy of Trek' book is not transformative and not fair use); *Dr. Seuss Enters., L.P. v. ComicMix LLC*, 256 F. Supp. 3d 1099 (S.D. Cal. 2017) (denying motion to dismiss infringement claim against a transformative mash-up of tropes and elements from both Dr. Seuss works and the *Star Trek* franchise because the fair use elements were in near-perfect balance); *Ranieri v. Adirondack Dev. Group*, 164 F. Supp. 3d 305 (N.D.N.Y. 2016) (denying summary judgment for defendant who had reproduced plaintiff's copyright floor plans in slightly modified form for its own advertising materials notwithstanding its argument that these plans could not be used to erect a condo and that they educated the public).

224. *Compare Greenberg v. Nat'l Geographic Soc'*, 244 F.3d 1267 (11th Cir. 2001) with *Faulkner v. Nat'l Geographic Enters., Inc.* 409 F.3d 26 (2d Cir. 2005). In the former the modification of plaintiff's copyrighted photo so that it morphed as users navigated a CD Rom was seen as transformative but infringing because the defendant exceeded its license under section 201(c) while in the latter case the court concluded that defendant's electronic replica of the original works fell within that section and the Supreme Court's decision in *Tasini v. New York Times*, 533 U.S. 483 (2001); see also *CRAIG JOYCE ET AL.*, *supra* note 3, at 299. Cf. *Bouchat v. Balt. Ravens*, 619 F.3d 301 (4th Cir. 2010) (infringing using the 'Flying B' logo in season highlight films is not transformative in that the use of the logo serves the same purpose of identifying the team as it served with the defendant first infringing the logo).

Quilt.²²⁵ This occurred in a five minute scene during the television show ROC.²²⁶ The court said that this unauthorized public display of Ringgold's art was not for any of the purposes listed in the preamble to section 107, and that it was not transformative because the poster was used for the same purpose for which it was created—to be decorative.²²⁷ The defendant added nothing new.²²⁸ It used the poster to decorate the set.²²⁹ Similarly, the unauthorized use of a photograph on an advertising company's website for the purpose of providing examples of its work to prospective clients was held to be outside the scope of fair use in *Straus v. DVC Worldwide, Inc.*²³⁰ The defendant argued that it had transformed the photo from a portrait of a famous golfer to advertise a product to show its ability to advertise a healthcare product; this was a portfolio use to show it could create advertising.²³¹ After saying there was scant authority on whether self-promotional materials can be fair use, the court concluded that the transformative purpose here was slight to non-existent. This was not fair use.²³² The same result was reached in a case involving the unauthorized and slightly altered use of a New Jersey gay couple's engagement photograph in a mailer sent to Colorado voters that attacked a candidate's views on gay marriage and family values. The court held that this infringing use was not transformative.²³³

225. Ringgold v. Black Entm't Television, 126 F.3d 70, 72–73 (2d Cir. 1997).

226. *Id.* The original quilt is in Atlanta's High Museum of Art.

227. *Id.* at 78–79.

228. *Id.* at 79.

229. *Id.* at 78–79; see also *Teter v. Glass Onion, Inc.* 723 F. Supp. 2d 1138 (W.D. Mo. 2010) (holding defendant gallery's unauthorized display on its website of both high resolution and thumbnail images of plaintiff's artwork was not fair use because the images did not alter the art with new expression and the postings were for an informational or promotional purpose); *Hirsch v. CBS Broad. Inc.*, 17 Civ. 1860, 2017 WL 3393845, at *2 (S.D.N.Y. Aug. 4, 2017) (holding that showing a cropped version of the plaintiff's copyrighted photograph for about two seconds on 48 Hours was not de minimis as a matter of law, and denying defendant's motion to dismiss because the factual record needed to be developed to determine if defendant was entitled to a fair use defense for news reporting); *Antioch Co. v. Scrapbook Borders, Inc.* 291 F. Supp. 2d 980 (D. Minn. 2003) (finding defendant's infringing use of plaintiff's copyrighted stickers in a book to show how the stickers could be displayed was more derivative than transformative and used the stickers for their intended purpose—to create a pictorial representation in which the stickers would not lose their individual identities); see also Mike Nepple, Thompson Coburn, *Fair Use Blocks Out Copyright Claim Over LeBron's Tattoo*, APLA NEWSSTAND (June 1, 2017) (discussing the *Solid Oaks v. Take Two* litigation over whether showing James' copyrighted Lion's Head tattoo in a video game is fair use or de minimis).

230. *Straus v. DVC Worldwide, Inc.*, 484 F. Supp. 2d 620, 642–43 (S.D. Tex. 2007)

231. *Id.* at 642.

232. *Id.* at 643.

233. *Hill v. Pub. Advocate of the U.S.*, 35 F. Supp. 3d 1347 (D. Col. 2014).

In contrast, in a case involving an unauthorized but obscured display of plaintiff's photographs for about ninety seconds of a movie, the court said that the defendant used the images "in furtherance of the creation of a distinct visual aesthetic and overall mood for the moviegoer watching the scene in the killer's apartment."²³⁴ This use was transformative and neutralized the film's commercialism.²³⁵ Similarly, in *Neri v. Monroe*, an architectural design firm posted on its website photographs depicting the entrance hallway of a condominium it had remodeled for a client. The plaintiff artist's copyrighted blown glass sculptural work, commissioned by the same client of the firm, was visible in these photographs.²³⁶ The artist sued the firm and the court found fair use, saying that the two-dimensional realistic photos of the interior space, in which the plaintiff's sculptural work could be seen, were highly transformative of the plaintiff's three-dimensional, impressionistic, composition of pieces of translucent glass.²³⁷ The posting informed the public about the defendant company's remodeling work. It was not for aesthetic purposes, and it did not supersede the plaintiff's composition.²³⁸

There are many 'use out of context' cases in which the courts found that the defendant's use of the plaintiff's work, sometimes without alteration, to serve a different purpose is transformative and fair. The most critical factors seem to be the extent of the repurposing and the amount of the taking. The more substantial the repurposing—i.e., using a photo from a modeling portfolio for a news report—then the less likely that the use supersedes the original and is accordingly fair. Similarly, the more extensive the taking, even for a new purpose, then the fair use argument becomes harder to make.

234. *Sandoval v. New Line Cinema Corp.*, 973 F. Supp. 409, 413 (S.D.N.Y. 1997).

235. *Id.* See also *Straus v. DVC Worldwide, Inc.*, 484 F. Supp. 2d 620, 641 (S.D. Tex. 2007) (holding 'snippet' use of plaintiff's photograph of Arnold Palmer in TV ad for Nicorette gum for two to three seconds in the background is *de minimis*).

236. *Neri v. Monroe*, No. 11-cv-429-slc, 2012 WL 12888415 (W.D. Wis. Sept. 21, 2012), *vacated and remanded*, 726 F.3d 989 (7th Cir. 2013). The website credited the photographer but not the artist.

237. *Id.*

238. *Id.* See also *Sarl Louis Feraud Int'l v. Viewfinder Inc.*, 627 F. Supp. 2d 123, 128 (S.D.N.Y. 2008) (holding defendant's posting on its website of its photographs of French plaintiff's fashion designs said to be highly transformative since the photos were images of the designs which were posted not to market fashion but for the purpose of providing the public with news about the fashion world); *Amsinck v. Columbia Pictures Indus.*, 862 F. Supp. 1044 (S.D.N.Y. 1994) (holding use of plaintiff's copyrighted mobile in a film held to be fair use without a discussion of transformativeness); *Kennedy v. Gish, Sherwood & Friends, Inc.*, 143 F. Supp. 3d 898 (E.D. Mo. 2015) (holding defendant's use of low resolution screenshots of plaintiff's photos from plaintiff's website in an online ad campaign held to be transformative and fair because this use, in a different context, served a different purpose and did not supersede plaintiff's purpose).

E. Appropriation Art

“‘Appropriation’ art attempts to recontextualize famous (or not-so-famous) images by juxtaposing them with new material.”²³⁹ As in the ‘use out of context’ cases discussed in the previous section, the owners of copyright in appropriated images often sue for infringement, but appropriation artists seem to win most of the time in the post-*Campbell* world. However, the defendant artist needs to be able to make a plausible argument that he or she transformed the plaintiff artist’s work in a meaningful way.²⁴⁰

Pre-*Campbell* the artist Jeff Koons was unsuccessful in asserting fair use to justify turning photographer, Art Rogers’ commissioned work “Puppies” into a three-dimensional sculptural piece.²⁴¹ He tried to argue that his unauthorized derivative work was a parody of the plaintiff’s photograph but the court said that

The problem in the instant case is that even given that “String of Puppies” is a satirical critique of our materialistic society, it is difficult to discern any parody of the photograph “Puppies” itself. We conclude therefore that this first factor of the fair use doctrine cuts against a finding of fair use.²⁴²

Moreover, the behavior of the defendant artist and his gallery suggested they believed that since “they were significant players in the art business, and the copies they produced bettered the price of the copied work by a thousand to one, their piracy of a less well-known artist’s work would escape being sullied by an accusation of plagiarism.”²⁴³

Over a decade after losing to Rogers, and after the Supreme Court decided *Campbell*, Koons was sued by another photographer. Without seeking permission, he scanned an advertisement for Gucci sandals from *Allure* magazine. The photo in the ad, titled “Silk Sandals,” had been taken by Andrea Blanch, a well-regarded fashion photographer. Koons altered this photo slightly as he incorporated it, along with other scanned

239. CRAIG JOYCE ET AL., *supra* note 3, at 867.

240. See generally Peter Jaszi, *Is There Such a Thing as Postmodern Copyright?*, 12 TUL. J. TECH. & INTELL. PROP. 105 (2009); Heyman, *supra* note 61; William M. Landes, *Copyright, Borrow Images and Appropriation Art: An Economic Approach*, 9 GEO. MASON L. REV. 1 (2000).

241. *Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992).

242. *Id.* at 310.

243. *Id.* at 304.

images, against a pastoral background as part of a collage.²⁴⁴ Koons said he used the image as part of his commentary on the social and aesthetic consequences of mass media—purposes very different from the plaintiff's advertising photo for *Allure*. The photo was raw material for his distinct creative objectives.²⁴⁵ The court stated that the test for determining whether Koons' use of Blanch's photograph was transformative

is to see 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.” . . . The test almost perfectly describes Koons's adaptation of “Silk Sandals”: the use of a fashion photograph created for publication in a glossy American “lifestyles” magazine—with changes of its colors, the background against which it is portrayed, the medium, the size of the objects pictured, the objects' details and, crucially, their entirely different purpose and meaning—as part of a massive painting commissioned for exhibition in a German art-gallery space. We therefore conclude that the use in question was transformative.²⁴⁶

Koons' victory in his use of the fashion photograph is reconcilable with his earlier defeat for making an unauthorized sculpture based upon the commissioned photograph of the couple holding a litter of puppies. It is easy to say that *Campbell* was decided in between the two decisions with the Supreme Court announcing the transformative use standard but the cases are distinguishable as explained by a concurring opinion in *Blanch v. Koons*:

244. *Blanch v. Koons*, 467 F.3d 244, 247–48 (2d Cir. 2006)

Koons scanned the image of ‘Silk Sandals’ into his computer and incorporated a version of the scanned image into ‘Niagara.’ He included in the painting only the legs and feet from the photograph, discarding the background of the airplane cabin and the man’s lap on which the legs rest. Koons inverted the orientation of the legs so that they dangle vertically downward above the other elements of ‘Niagara’ rather than slant upward at a 45-degree angle as they appear in the photograph. He added a heel to one of the feet and modified the photograph’s coloring. The legs from ‘Silk Sandals’ are second from the left among the four pairs of legs that form the focal images of ‘Niagara.’

Id.

245. *Id.* at 252.

246. *Id.* (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994)).

I agree that Koons' work is highly transformative of Blanch's, using it as raw material for an entirely different type of art, and that his use of Blanch's work furthered a purpose (art that comments on existing images by juxtaposing them against others) that can make a finding of fair use appropriate. In both respects, the facts of this case are quite distinguishable from those of *Rogers v. Koons*, . . . in which Koons slavishly recreated a copyrighted work in a different medium without any objective indicia of transforming it or commenting on the copyrighted work.²⁴⁷

*Mattel v. Walking Mountain Products*²⁴⁸ and *Cariou v. Prince*²⁴⁹ are also fair use decisions which can be categorized as appropriation art cases. Both are consistent with *Blanch v. Koons* with their respective courts finding fair use. The *Mattel* decision, involving photographs of the toy manufacturer's iconic doll 'Barbie,' is often treated as a parody case.²⁵⁰ The defendant photographer, Thomas Forsythe

developed a series of 78 photographs entitled 'Food Chain Barbie,' in which he depicted Barbie in various absurd and often sexualized positions. . . . While his works vary, Forsythe generally depicts one or more nude Barbie dolls juxtaposed with vintage kitchen appliances. For example, "MalTED Barbie" features a nude Barbie placed on a vintage Hamilton Beach malt machine. "Fondue a la Barbie" depicts Barbie heads in a fondue pot. "Barbie Enchiladas" depicts four Barbie dolls wrapped in tortillas and covered with salsa in a casserole dish in a lit oven.²⁵¹

The Ninth Circuit had no difficulty determining that Forsythe's photos had turned the image of Barbie on her head, displaying her nude, sometimes frazzled, and posed in ridiculous and often dangerous situations. He had transformed the doll's meaning, and his commentary

247. *Blanch*, 467 F.3d at 262 (R. Katzmann, concurring). The concurring opinion also states, "that Blanch failed to show that Koons' use of her work actually harmed her in any way. She thus stands in stark contrast to the plaintiff in *Rogers*, for whom licensing of his work in general, and the appropriated work in particular, yielded considerable revenue." *Id.*

248. *Mattel Inc. v. Walking Mt. Prods.*, 353 F.3d 792 (9th Cir. 2003).

249. *Cariou v. Prince*, 714 F.3d 694 (2nd Cir. 2013).

250. See CRAIG JOYCE ET AL., *supra* note 3, at 841; *Mattel*, 353 F.3d at 800-03.

251. See CRAIG JOYCE ET AL., *supra* note 3, at 796.

about gender roles and the position of women in society was readily apparent.²⁵²

The appropriation artist Richard Prince, the defendant in *Cariou v. Prince*,²⁵³ used over sixty photographs from Patrick Cariou's book *Yes Rasta*. This book contains portrait and landscape photos of Jamaica and the Rastafarians who live there. Prince altered these photographs and incorporated them into a series of thirty paintings and collages. Cariou sued Prince and a gallery for copyright infringement, and the lower court ruled in the plaintiff's favor but the Court of Appeals reversed as to twenty-five of the works, concluding that Prince's uses were transformative and fair.²⁵⁴ The appellate court said that the trial court was mistaken in concluding that a work could not be considered transformative unless it commented on the original as with parody.

The law imposes no requirement that a work comment on the original or its author in order to be considered transformative, and a secondary work may constitute a fair use even if it serves some purpose other than those (criticism, comment, news reporting, teaching, scholarship, and research) identified in the preamble to the statute.²⁵⁵

Regarding twenty-five of the thirty allegedly infringing works, the court said that they

manifest an entirely different aesthetic from Cariou's photographs. Where Cariou's serene and deliberately composed portraits and landscape photographs depict the natural beauty of Rastafarians and their surrounding environs, Prince's crude and jarring works, on the other hand, are hectic and provocative. Cariou's black-and-white photographs were printed in a 9 1/2" x 12" book. Prince has created collages on canvas that incorporate color, feature distorted human and other forms and settings, and measure between ten and nearly a hundred times the size of the photographs. Prince's composition, presentation, scale, color palette, and media are fundamentally different and new

252. *Id.* at 802.

253. *Cariou*, 714 F.3d at 694.

254. *Id.* at 698. In respect to the remaining five works, the case was remanded to the trial court to determine fair use in accordance with the correct test.

255. *Id.* at 706.

compared to the photographs, as is the expressive nature of Prince's work.²⁵⁶

As with the decisions summarized in the 'use out of context' category, one of the lessons from the appropriation artist cases is that an artist's unauthorized use of another's protected work is less likely to be regarded as transformative if the alterations of the work are relatively minor and the extent of the appropriation is substantial. This might cause the court to say that the defendant's use lacks any expression, meaning or message that is different from the copied work's original expression.²⁵⁷ Jeff Koons' three-dimensional reproduction of Art Rogers' photo of a couple holding a litter of puppies can be seen as nothing more than an unauthorized derivative work—taking a two-dimensional photograph and making it into a three-dimensional sculptural work,²⁵⁸ while his alteration of Blanch's fashion photograph and Prince's alterations of Cariou's photographs were dramatic and substantial.²⁵⁹ Another illustration of taking too much protected expression and not making sufficient alterations to the protected work is *Morris v. Young* in which an artist made some changes to plaintiff's photographs of the Sex Pistols, including Johnny Rotten and Sid Vicious, through cropping, adding tint and changing the medium.²⁶⁰ The court said these were minor alterations that added only marginal artistic innovation, and were not transformative.²⁶¹

256. *Id.* But see *Graham v. Prince*, 15-Cv-10160(SHS), 2017 WL 3037535 (S.D.N.Y. July 18, 2017) (holding Richard Prince's alterations to plaintiff's Instagram photograph were insignificant and not transformative thus weighing against finding of fair use); Jesse Brody, Manatt Phelps & Phillips, LLP, *Copyright Suit Requires Fair Use Analysis*, AIPLA NEWSSTAND (Aug. 3, 2017) (discussing the court's refusal to dismiss suit against Richard Prince in part because his use did not demonstrate a sufficient transformation of Graham's photograph).

257. See, e.g., *Morris v. Young*, 925 F. Supp. 2d 1078, 1085–86 (C.D. Cal. 2013); *Graham v. Prince*, 15-Cv-10160(SHS), 2017 WL 3037535 (S.D.N.Y. July 18, 2017).

258. *Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992).

259. See also *Kienitz v. Sconnie Nation LLC*, 766 F.3d 756 (7th Cir. 2014) (holding Defendant's substantial altered version of the photograph of the Mayor of Madison, Wisconsin that was placed on t-shirts and tank tops along with a political message protesting a decision by the Mayor was transformative and fair).

260. *Morris*, 925 F. Supp. 2d at 1081–82.

261. *Id.* at 1084–86. One photo was cropped to frame the subjects and then tinted in a deep red. The second photo was printed using black enamel on an acrylic background. See also *Morris v. Guetta*, No. LA CV12-00684 JAK (RZx), 2013 U.S. Dist. LEXIS 15556 (C.D. Cal. Feb. 4, 2013). Defendant's works still were pictures of Sid Vicious making the same distinct facial expressions depicted in plaintiff's photo plus there was no commentary on plaintiff's work. See also *N. Jersey Media Grp., Inc. v. Jeanine Pirro & Fox News Network, LLC*, 74 F. Supp. 3d 605 (S.D.N.Y. 2015) (holding defendant's use

The Court of Appeals for the Federal Circuit reached an analogous result in *Gaylord v. United States*.²⁶² The plaintiff sculptor owns the copyright on “The Column,” the Korean War Veterans Memorial in Washington D.C. that depicts a platoon of nineteen soldiers walking in formation.²⁶³ A photograph of fourteen of the life-size soldiers, dusted with snow, was adapted by the Postal Service as a stamp without the sculptor’s permission.²⁶⁴ The court, in ruling against fair use, concluded that the stamp was not transformative because it reflected no purpose or commentary beyond that of the memorial itself.²⁶⁵ Both comment on the Korean War.²⁶⁶ The stamp added snow and muted colors, but it did not alter the character of the protected work.²⁶⁷ Minimal alterations coupled with a use or purpose similar to the plaintiff’s original use or purpose might not be regarded as transformative.²⁶⁸

Digital sampling cases also fit into this category. With sampling several seconds of a popular recording are reproduced and used without permission in another artist’s recording.²⁶⁹ In one major case the defendants argued that their use of George Clinton’s classic ‘Atomic

on its website of plaintiff’s iconic photograph of firefighters raising the American flag at the ruins of the World Trade Center juxtaposed with the iconic WWII photo of the flag being raised on Iwo Jima was not transformative); *Graham v. Prince*, 15-Cv-10160(SHS), 2017 WL 3037535 (S.D.N.Y. July 18, 2017) (holding Richard Prince’s appropriation by screenshot of plaintiff’s Instagram post of a photograph would not be seen as transformative because the changes he made to the work were insignificant with minor cropping and a comment).

262. *Gaylord v. United States*, 595 F.3d 1364 (Fed. Cir. 2010).

263. *Id.*

264. *Id.* at 1371.

265. *Id.* at 1376.

266. *Id.* at 1381.

267. *Id.* at 1373–74. *Cf. Reyes v. Wyeth Pharms., Inc.*, 603 F. Supp. 2d 289 (D.P.R. 2009) (holding photograph of plaintiff’s glass sculpture included in advertisement intended to raise public awareness about rheumatoid arthritis and treatment options was minimally transformative and not a fair use since there were no comments about the sculpture in the ad and the sculpture was still presented to the viewer as a work of art); *Davis v. The Gap, Inc.*, 246 F.3d 152 (2nd Cir. 2001) (holding presentation of plaintiff’s copyrighted eye-wear in clothing ad not transformative nor fair use because it was worn in the ad as intended—as eye jewelry); *Ringgold v. Black Entm’t Television, Inc.* 126 F.3d 70 (2d Cir. 1997) (holding unauthorized use of poster of plaintiff’s copyrighted story quilt as decoration that is displayed as part of the set for a television show was not transformative because it was used for the same decorative purpose as the original).

268. *See, e.g., Erickson Prods. v. Kast*, No. 5:13-cv-05472 HRL, 2014 WL 5474741 (N.D. Cal. Apr. 23, 2014) (holding defendant’s copying and using on its own website photos from a Wells Fargo site that plaintiff had licensed to Wells Fargo was not transformative).

269. *See, e.g., Bridgeport Music, Inc. v. UMG Recordings, Inc.*, 585 F.3d 267, 272–73 (6th Cir. 2009) (discussing how George Clinton’s classic Atomic Dog was sampled by hip hop and rap artists).

Dog' in the recording 'D.O.G. in Me' was fair use.²⁷⁰ The Sixth Circuit acknowledged that this use was transformative given its different theme, mood and tone. However, after weighing the other fair use factors, it determined that a jury's finding that this was not fair use was not against the great weight of the evidence.²⁷¹ In contrast, the Southern District of New York held that Drake's use of thirty-five seconds of sampled lyrics from a one minute record was transformative and fair because Drake had fundamentally altered the message of the plaintiff's composition.²⁷² Courts are still divided whether and when sampling constitutes infringement.²⁷³

The transformative use standard is useful in analyzing and deciding appropriation art cases as in the many 'use out of context' cases discussed in the previous section. Here also the courts often hold that a defendant artist's use of another's artist's work, sometimes without significant alteration, to serve a different purpose is transformative and fair. The most critical factors also seem to be the clarity or obviousness of the defendant's new message he or she is making with the first artist's work and the amount of the taking. The more substantial the repurposing—i.e., photographs of Barbie posed in kitchen appliances or reduced scale images of advertising posters on timelines in a book—the less likely that the use supersedes the original and is accordingly fair. Similarly, the more extensive the amount of taking, even for a new purpose, then the fair use argument becomes harder to make.

F. Transformative Uses and Technology

The Supreme Court and the lower courts grappled with whether certain uses of copyrighted works made possible by advancements in technology were fair use long before the transformative use doctrine was announced in *Campbell*. Of course, what was a major technological change in the 1970s often seems archaic in 21st Century. In my opinion,

270. *Id.*

271. *Id.* at 278. The plaintiffs' work was creative, the taking was recognizable although small, and the plaintiff could lose substantial licensing revenues from such unauthorized uses.

272. *Estate of Smith v. Cash Money Records*, 253 F. Supp. 3d 737 (S.D.N.Y. 2017). Drake had a license to use the sound recording but not the composition—it had not been registered with the Copyright Office.

273. *Compare* *Newton v. Diamond*, 349 F.3d 591 (9th Cir. 2003) (*de mimis* applied to sampling of a three-note sequence from a musical work where the sound recording had been licensed) *with* *Bridgeport Music, Inc. v. Dimension Films*, 410 F.3d 792 (6th Cir. 2005) (any sampling is *per se* an infringement).

the transformative use standard is not especially useful in most of these cases.

1. Photocopying

Photocopying was a major concern in the 1960s and 1970s. The leading decision before the passage of the 1976 Act was *Williams & Wilkins Co. v. United States* in which publishers of scientific journals challenged the photocopying practices at the National Institutes of Health and the National Library of Medicine.²⁷⁴ In a 4-3 decision, the Court of Claims held that the photocopying should be considered a fair use because: these federal nonprofit institutions were devoted solely to the advancement and dissemination of medical knowledge, both institutions normally restricted copying on an individual scientist's request to a single copy of an article and to articles of less than fifty pages, there has been copying of protected works by libraries ever since the 1909 Act was adopted, medical science would be seriously hurt if such photocopying were stopped, and there was no showing of economic injury to plaintiff.²⁷⁵

Congress passed the 1976 Act not long after the *Williams & Wilkins* decision, and the preamble to section 107 includes the following critical language: "reproduction in copies . . . for purposes such as . . . teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright."²⁷⁶ Publishers had little success challenging institutional copying practices at schools, colleges and universities due to this language in section 107 and the fact that most educational institutions generally adhered to copying practices that fell within a safe harbor provided by the so-called Classroom Guidelines for Educational Photocopying.²⁷⁷ The notable exception was a case that was

274. *Williams & Wilkins Co. v. United States*, 487 F.2d 1345 (Ct. Cl. 1973), *aff'd by an equally divided court*, 420 U.S. 376 (1975). These defendants had subscriptions to the journals published by the plaintiffs. The practice was to photocopy and distribute articles to scientists and researchers who requested them, but usually no more than one article per journal, no more than fifty pages, and only a single article per request. CRAIG JOYCE ET AL., *supra* note 3, at 875.

275. *Williams*, 487 F.2d at 1357-63. In addition, the court said that there was doubt about the coverage of 'copy' in the Act, and it also noted that the Copyright Act was being revised. In addition, it discussed practices overseas.

276. 17 U.S.C. § 107 (2012).

277. The fair use guidelines are found in the legislative history for the 1976 Act. They were endorsed by some proprietor and user groups as a reasonable interpretation of the minimum standards of fair use. H.R. REP. NO. 94-658, at 72 (1976).

settled with New York University in 1983.²⁷⁸ In addition, the Supreme Court acknowledged in *Campbell* that an “obvious statutory exception to this focus on transformative uses is the straight reproduction of multiple copies for classroom distribution.”²⁷⁹

However, the publishing industry enjoyed some success challenging the reproduction of course packs and anthologies at off-campus, for profit, copy shops. These materials were reproduced for purchase by students. The fair use defense did not succeed in large part because of the commercial nature of copy shops’ activities.²⁸⁰ In addition, several courts determined that the alleged infringers’ uses of the protected materials for the same intrinsic purposes as intended by the copyright owners were strong indicia against fair use.²⁸¹ Today a court might state, unnecessarily, that these copying practices are not transformative.

Reproduction and distribution for educational purposes utilizing digital technology instead of the photocopier took center stage in the infringement claims asserted by several publishers against the electronic course reserve practices at the Georgia State University libraries making excerpts from academic books available online to students enrolled in particular courses.²⁸² In holding that many of defendant Georgia State’s practices were fair use, the trial court said that the language of section 107 and the *Campbell* decision compelled a finding that factor one favored fair use.²⁸³ It stated that:

278. CRAIG JOYCE ET AL., *supra* note 3, at 875–76, (citing and discussing *Addison-Wesley Publ. v. N.Y. Univ.*, 82 civ-8333(ADS), 1983 WL 1134 (S.D.N.Y. May 31, 1983).

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

280. *See, e.g., Princeton Univ. Press v. Mich. Document Servs.*, 99 F.3d 1381 (6th Cir. 1996) (en banc); *Blackwell Publ., Inc. v. Excel Research Grp., LLC*, 661 F. Supp. 2d 786 (E.D. Mich. 2009); *Basic Books, Inc. v. Kinko’s Graphics Corp.*, 758 F. Supp. 1522 (S.D.N.Y. 1991).

281. *Marcus v. Rowley*, 695 F.2d 1171, 1175 (9th Cir. 1993); *Jartech v. Clancy*, 666 F.2d 403 (5th Cir. 1982); *Universal City Studios, Inc. v. Sony Corp.*, 659 F.2d 963, 969 (9th Cir. 1981); *see also Iowa State Univ. Res. Found. v. ABC*, 621 F.2d 57 (2nd Cir. 1980). The scope of fair use is constricted when the original and the copy serve the same function. This same function test is addressed in the House of Representatives’ 1967 Report, specifically in relation to classroom materials. The Report states that, with respect to the fair use doctrine, “[t]extbooks and other material prepared primarily for the school market would be less susceptible to reproduction for classroom use than material prepared for general public distribution.” H.R. REP. NO. 83, 10th Cong. 1st Sess. 33, 34 (1967).

282. *Cambridge Univ. Press v. Becker*, 863 F. Supp. 2d 1190 (N.D. Ga. 2012), *rev’d*, *Cambridge Univ. Press v. Patton*, 769 F.3d 1232 (11th Cir. 2014), *on remand*, *Cambridge Univ. Press v. Becker*, No. 1:08-CV-1425-ODE, 2016 WL 3098397 (N.D. Ga. Mar. 31, 2016). Even though the suit was filed in 2008, there was no published opinion until 2012.

283. *Becker*, 863 F. Supp. 2d at 1224.

[t]his case involves making copies of excerpts of copyrighted works for teaching students and for scholarship, as specified in the preamble of § 107. The use is for strictly nonprofit educational purposes as specified in § 107(1). The fact that the copying is done by a nonprofit educational institution leaves no doubt on this point.²⁸⁴

In response to the contention that factor one favored the publishers because the uses were not transformative, the court repeated the statement from *Campbell* that “[t]he obvious statutory exception to this focus on transformative uses is the straight reproduction of multiple copies for classroom distribution.”²⁸⁵ The lower court also concluded that the second factor favored the defendants because the works were nonfiction; it went with a ten percent presumption on factor three; and, it found that factor four favored the plaintiffs when there was a reasonably priced, readily available license for the excerpts. Since three of the four factors weighed in defendant GSU’s favor, the court found fair use.²⁸⁶

This decision was reversed and remanded by the Eleventh Circuit which found fault with the lower court’s methodology of using bright line rules and a formula. The court agreed that the first factor favored fair use, and it emphasized that fair use must be conducted on a flexible, case by case basis.²⁸⁷ On remand, the lower court found that the vast majority of Georgia State’s practices were fair (forty-four of forty-eight) after going through a more flexible evaluation as mandated by the Court of Appeals. It is important to note that before analyzing each of the forty-eight alleged instances of infringement, the court made the following statement:

In the fair use analyses for the various claims which follow, factor one (“the purpose and character of the use”) will

284. *Id.*

285. *Id.* at 1224–25 (quoting in full *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994)). In essence, there was no need for the court to discuss the transformative use standard, let alone stretch it out of shape to accommodate this kind of unauthorized reproduction of protected works for learning and educational purposes. The post-*Campbell* emphasis on transformative uses seems to ignore the *Betamax* decision and the Court’s recognition that verbatim copying of a work for personal use is fair. Twisting and pushing a particular use to say it is transformative is one thing, but courts must not ignore or forget that there is often social value to copying a work verbatim for personal use. See generally Rebecca Tushnet, Essay, *Copy This Essay: How Fair Use Doctrine Harms Free Speech and How Copying Serves It*, 114 YALE L.J. 535 (2004).

286. *Becker*, 863 F. Supp. 2d at 1242–43; *Cambridge Univ. Press v. Becker*, No. 1:08-CV-1425-ODE, 2016 WL 3098397 (N.D. Ga. Mar. 31, 2016).

287. *Cambridge Univ. Press v. Patton*, 769 F.3d 1232 (11th Cir. 2014).

uniformly favor fair use because all uses were strictly of a nonprofit educational character for the sole purpose of teaching students in classes at a nonprofit educational institution, notwithstanding the nontransformative nature of the use. This outcome will be stated summarily in each fair use analysis to avoid repetition.²⁸⁸

In summary, even though the defendants' digital reserve practices were not transformative, the first factor tipped in their favor, and most of the practices were held to be fair.

It is difficult to find anything transformative about photocopying, scanning, or otherwise digitally reproducing a copyrighted work, and this was acknowledged in a post-*Campbell* copy shop case. A court said that transformation was indiscernible in materials reproduced for a course pack; verbatim copying of ninety-five pages from a 316-page book does not transform the ninety-five pages "even if you juxtapose them to excerpts from other works and package everything conveniently. This kind of mechanical 'transformation' bears little resemblance to the creative metamorphosis accomplished by the parodists in the *Campbell* case."²⁸⁹ Nevertheless, some courts continue to discuss the transformative use standard in photocopying cases, and occasionally conclude that the secondary use is transformative when it is for a substantially different purpose than that of the original work.²⁹⁰

Transformativeness in connection with photocopying was discussed in *American Geophysical Union v. Texaco Inc.*²⁹¹ in which eighty-three publishers of scientific and technical journals claimed that the unauthorized reproduction of their articles at Texaco's research library was copyright infringement. The library subscribed to these journals, and copies were made for the oil company's applied researchers. Texaco

288. *Cambridge Univ. Press v. Becker*, No. 1:08-CV-1425-ODE, 2016 WL 3098397 at *9 (N.D. Ga. Mar. 31, 2016).

289. *Princeton Univ. Press v. Mich. Document Servs.*, 99 F.3d 1381, 1389 (6th Cir. 1996) (en banc).

290. See, e.g., *American Inst. of Physics v. Winstead PC*, No. 3:12-CV-1230-M., 2013 WL 6242843 (N.D. Tex. Dec. 3, 2013) (holding that an intellectual property law firm's practice of making copies of academic and scientific articles relevant to the technology implicated by patent application it submits to the Patent Office, and for use by attorneys in preparing applications and advising clients, was regarded as transformative); *Lucent Info. Mgmt., Inc. v. Lucent Techs., Inc.*, 5 F. Supp. 2d 238, 242 (D. Del. 1998) (holding that reproduction of plaintiff's letter as part of a survey done in connection with trademark litigation is fair use—transformative use not discussed but the court emphasized that the defendant used the letter for a different purpose than the original).

291. *Am. Geophysical Union v. Texaco Inc.*, 60 F.3d 913 (2d Cir. 1994).

claimed that this copying was fair use.²⁹² The parties stipulated to have the court analyze the photocopying of one scientist, chosen at random, for purposes of an initial trial limited to the issue of whether Texaco's photocopying was fair use. The District Court, after considering all the factors in section 107, held that the defendant's copying, as represented by eight articles the scientist had photocopied, was not fair.²⁹³ The court of appeals affirmed.

The appellate court's discussion of transformative use was thoughtful and thorough.²⁹⁴ It stated:

To the extent that the secondary use involves merely an untransformed duplication, the value generated by the secondary use is little or nothing more than the value that inheres in the original. Rather than making some contribution of new intellectual value and thereby foster the advancement of the arts and sciences, an untransformed copy is likely to be used simply for the same intrinsic purpose as the original, thereby providing limited justification for a finding of fair use.²⁹⁵

Texaco had argued that reproducing a journal article in a form more easily used in a scientist's lab was transformative, but the court disagreed. The copy "merely transforms *the material object* embodying the intangible article that is the copyrighted original work."²⁹⁶ The court acknowledged that the photocopied articles were in a useful format and had some independent value, but that the primary archival purpose of the reproduction tipped the first factor against Texaco.²⁹⁷ However, the court also emphasized that it was not dealing with the

292. *Id.* at 915.

293. *Id.* at 914–16.

294. *Id.* at 922–24 (agreeing with the lower court that Texaco's copying was not transformative).

295. *Id.* at 923.

296. *Id.* (emphasis added). There is a dissenting opinion in which it is asserted that research by a Texaco scientist should be treated the same as theoretical research by a chemistry professor at a university—a fair use. *Id.* at 933–34 (Jacobs, J., dissenting); see also *Basic Books, Inc. v. Kinko's Graphics Corp.*, 758 F. Supp. 1522, 1530–31 (S.D.N.Y. 1991) (holding repackaging of excerpts from copyrighted works in anthology form is not transformative); *Lowry's Reports, Inc. v. Legg Mason*, 271 F. Supp. 737, 748–49 (D. Md. 2003) (holding defendant's reproduction of plaintiff's market report for distribution within its marketing department served to exploit the report for defendant's commercial benefit for the price of one subscription, supplanting the normal market for the report was not a fair use). Transformative use was not discussed.

297. *Am. Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 923–24 (2d Cir. 1994) (discussing that the photocopy was easier to use than as part of a bulky journal, it was more amenable to marking, and it was easy to replace if damaged). *Id.* at 920. The

question of copying by an individual, for personal use in research or otherwise (not for resale), recognizing that under the fair use doctrine or the *de minimis* doctrine, such a practice by an individual might well not constitute infringement. In other words, our opinion does not decide the case that would arise if [the Texaco scientist] were a professor or an independent scientist engaged in copying and creating files for independent research, as opposed to being employed by an institution in the pursuit of his research on the institution's behalf.²⁹⁸

This statement acknowledges that photocopying scientific articles was a fair use in *Williams & Wilkins v. United States* as well as the proposition that many personal uses of copyrighted materials, like making a copy of a recorded performance and copying a television show for later viewing, are regarded as fair.²⁹⁹ There is nothing transformative about re-recording a recorded musical performance or recording a television show. However, the reach of this personal use exemption beyond the facts of *Sony* is now uncertain, perhaps due to the post-*Campbell* emphasis on the transformative use standard.³⁰⁰

The perceived need to find a transformative use to justify finding fair use has caused some courts to focus on the nature or purpose of defendant's use of exact copies instead of sticking with the proposition that there is nothing transformative about a verbatim reproduction of a work and evaluating the four statutory factors. For example, in *American*

existence of an established system for licensing the rights to make photocopies worked against Texaco on the fourth fair use factor. See CRAIG JOYCE ET AL., *supra* note 3, at 871. In essence, Texaco should have paid for more subscriptions or for a license to make copies. Its library is not the same as a university's research library.

298. *Am. Geophysical Union*, 60 F.3d at 916. See, e.g., *Am. Inst. of Physics v. Winstead PC*, No. 3:12-CV-1230-M., 2013 WL 6242843 (N.D. Tex. Dec. 3, 2013). An intellectual property law firm's practice of making copies of academic and scientific articles before submitting them to the Patent Office was transformative.

299. CRAIG JOYCE ET AL., *supra* note 3, at 878 (discussing home audio recording as well as the impact of the decision in *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984)).

300. CRAIG JOYCE ET AL., *supra* note 3, at 879–80 (discussing peer to peer file sharing and the *Grokster* decision in which the Supreme Court assumed that downloading sound recordings for personal use was not a fair use, *MGM Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913 (2005), and *Cartoon Network LP, LLLP v. CSC Holding, Inc.*, 536 F.3d 121 (2d Cir. 2008) in which the court treated a viewer's decision to record a program using the defendant's remote storage technology as indistinguishable from a viewer's decision to record a program using a VCR—a permissible personal use under *Sony Corp. of Am.*, 464 U.S. 417).

Institute of Physics v. Winstead PC,³⁰¹ publishers of scientific journals challenged an intellectual property law firm's practice of copying academic and scientific articles relevant to technology implicated by patent applications and submitting those copies to the Patent Office along with the applications.³⁰² The court concluded that this use of exact copies of the articles was transformative because the firm was not using the articles as a subscriber or reader, but to provide "a background context for patent examiners in their analysis of patent applications."³⁰³ It also said that the articles were analyzed by the defendants "to determine if they are relevant to the invention they seek to patent for their client. In this sense, defendants read the articles not to learn the scientific material contained therein, but to identify whether the article discusses scientific information related to the client's potential patent."³⁰⁴

Similarly, the selection of briefs, memoranda and other court documents by Lexis and West for inclusion in a database was seen as transformative in *White v. West Publishing Corp.*³⁰⁵ An attorney who had been removed as counsel registered the copyrights on his previously filed motions and memoranda, fearing that new counsel might use his work product.³⁰⁶ These court documents had been filed electronically using PACER and this made them publicly available online as well as in the clerk's office. They were then selected by defendants West and Lexis for inclusion in their online subscription databases so White sued for copyright infringement.³⁰⁷ The court ruled that including these documents in the databases was fair. Regarding transformativeness, the court explained that White created the documents to provide legal services and to secure a specific legal outcome, while the defendants used the documents for the purpose of creating an interactive legal

301. *Ame. Inst. of Physics v. Winstead PC*, No. 3:12-CV-1230-M., 2013 WL 6242843 (N.D. Tex. Dec. 3, 2013).

302. *Id.*

303. *Id.*

304. *Id.* The court also said that it is not merely the content of the article that matters, but its existence in the literature. They "establish the state of the industry at a particular point in time" and are used as "evidence supporting a quasi-judicial decision." *Id.*

305. *White v. West Publ'g Corp.*, 29 F. Supp. 3d 396 (S.D.N.Y. 2014).

306. Edward White, an attorney serving as class counsel in a suit in the U.S. District Court for the Western District of Oklahoma, filed a motion for summary judgment and a brief in support of that motion, but midway through this litigation he was removed as class counsel and the class was decertified. New counsel was appointed so Mr. White, fearing that this new counsel might use his work product, registered copyrights on his previously filed motion and memorandum. *Id.* at 397.

307. *Id.* at 398.

research tool.³⁰⁸ Moreover, the court said that Lexis and West added something new through the process of reviewing, coding, converting, linking, and identifying documents, and this gave their unauthorized uses a further purpose or different character.³⁰⁹

Notwithstanding the emphasis in some cases on the defendants' transformative purposes for using exact copies, the making of a complete, verbatim copy of a work for a use or purpose which is not listed in section 107 often will be considered infringing regardless of the technology used to reproduce the work. In *Associated Press v. Meltwater United States Holdings, Inc.* the AP went after an Internet news clipping service that used web crawlers to create daily email reports for its customers containing excerpts from AP's online articles.³¹⁰ The defendant argued that its use of the AP's articles was fair because it functioned as a search engine for its subscribers in response to their inquiries.³¹¹ The court disagreed, finding nothing transformative about Meltwater's undiluted use of AP's protected news stories.³¹² It took the 'lede' or opening text, to convey the heart of the stories without adding any commentary or insight.³¹³

In *Capital Records LLC v. ReDigi* the defendant's online marketplace for the resale of digital music files was held to violate plaintiffs' reproduction rights and fall well outside the bounds of fair use.³¹⁴ Uploading to and downloading from ReDigi's server was not transformative because those acts coupled with the sale of digital music files added nothing new, with a further purpose or a different character, to the protected works.³¹⁵

308. *Id.* at 399 (citing *Blanch v. Koons*, 467 F.3d 224, 251 (2d Cir. 2006)) for the proposition that the sharply different objectives of the parties in creating and using the work confirms the transformative nature of the use.

309. *Id.* (citing *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994)). The second fair use factor also favored fair use, the third factor was neutral, and the fourth factor also favored fair use since there was no secondary market and the plaintiff admitted he had lost no clients as a result of defendants' usage.

310. *AP v. Meltwater U.S. Holdings, Inc.*, 931 F. Supp. 2d 537 (S.D.N.Y. 2013).

311. *Id.* at 541.

312. *Id.* at 556-57.

313. *Id.* The defendant copied between 4.5% and 61% of the articles. *See also* *Infinity Broad. Corp. v. Kirkwood*, 150 F.3d 104 (2d Cir. 1998) (holding defendant Dial Up's retransmission of plaintiff's radio broadcasts to paying subscribers over the telephone was not transformative because it left the character of the original broadcast unchanged and it was not a fair use).

314. *Capital Records, LLC v. ReDigi, Inc.*, 934 F. Supp. 2d 640 (S.D.N.Y. 2013).

315. *Id.* at 653-54. The court did not agree that ReDigi's facilitation of resale of digital files was for personal use because ReDigi and the uploading user profit from the resale of a digital music file, and the downloader saves on the price of the song in the real market. All the fair use factors worked against ReDigi. *See also* *Fox Broad. Co. v. Dish Network*,

Similarly, in *Clean Flicks of Colorado, LLC v. Soderbergh* the sale and rental of copyrighted movies that had been edited to remove sex, profanity and violence was held to infringe.³¹⁶ The entities that edited the movies to make them more appropriate for family home viewing raised fair use, asserting a public policy test that they were “criticizing the objectionable content commonly found in current movies and that the were providing more socially acceptable viewing alternatives.”³¹⁷ The court rejected this argument. It said it was not free to assess the social value of the movies, but that it was appropriate to protect the creators’ rights.³¹⁸ A more recent decision involving a similar service to remove objectionable material concluded that the defendant’s use of plaintiffs’ works was not fair because the edited works served the “same intrinsic entertainment value that is protected by Plaintiffs’ copyrights” and is not transformative.³¹⁹

L.L.C., 905 F. Supp. 2d 1088 (C.D. Cal. 2012). Defendant Dish Network’s AutoHop quality assurance technology infringes plaintiff’s reproduction right and is neither transformative nor a fair use. But, a preliminary injunction was denied because the harm to the plaintiff was not irreparable in nature, but economic, given Dish Network’s efforts to compete with Hulu, Netflix, and iTunes. The Ninth Circuit affirmed the denial of the preliminary injunction because Fox did not show irreparable harm. The court assumed that the lower court ruling was correct. *Fox Broad. Co. v. Dish Network, L.L.C.*, 723 F.3d 1067 (9th Cir. 2013). On remand the trial court ruled that AutoHop did not infringe by merely skipping ads, but that the quality assurance copies were not transformative and infringed—the copies did not alter the original works with new expression, meaning or message. *Fox Broad. Co. v. Dish Network LLC*, 160 F. Supp. 3d 1139 (C.D. Cal. 2015).

316. *Clean Flicks of Colo., LLC v. Soderbergh*, 433 F. Supp. 2d 1236 (D. Colo. 2006). *Clean Flicks* bought DVDs, made digital copies of them on the hard drive of a computer after overcoming content scrambling protection, made edits, and then downloaded the edited master copy for sale to the public. *Id.* at 1238; *see also* *Disney Enters. v. VidAngel, Inc.*, 224 F. Supp. 3d 957 (C.D. Cal. 2016) (holding defendant’s service in which customers can choose objectionable material to remove from films, notwithstanding the edits made by users, is not transformative because the defendant’s use of plaintiff’s films still serves the same intrinsic entertainment value).

317. *Clean Flicks of Colo. LLC*, 433 F. Supp. 2d at 1240.

318. *Id.* During the pendency of this case Congress passed the Family Movie Act of 2005 that amended section 110 of the Copyright Act to provide an exemption for editing movies by a member of a private household if no fixed copy of the altered version is created. *Id.*

319. *Disney Enters., Inc. v. VidAngel, Inc.*, 224 F. Supp. 3d 957, 973 (C.D. Cal. 2016), *aff’d*, 869 F.3d 848 (9th Cir. 2017); *see also* Jodi Benassi, McDermot Will & Emery, *No Fairytale Ending for Unauthorized Movie Streaming*, AIPLA NEWSSTAND (Sept. 28, 2017) (discussing the Ninth Circuit’s decision); Mark Sableman, Thompson Coburn, *9th Circuit’s VidAngel Decision Vindicates Lawful Filtering Service*, AIPLA NEWSSTAND (Sept. 12, 2017) (discussing how the ruling against VidAngel vindicated the efforts of ClearPlay to push for the passage of the Family Movie Act of 2005). VidAngel has subsequently modified its service in an effort to comply with that statute. *See VidAngel’s Copyright Fight with Disney*, Time Warner Grow, 94 BNA PTCTJ 1300 (Sept. 15, 2017).

The *Meltwater*, *ReDigi*, and *Clean Flicks* disputes involve online technology, the web, and sophisticated reproduction devices but they are still relatively straightforward examples of unauthorized copying which are difficult to defend as fair use. The courts discuss whether defendants' uses of the plaintiffs' works were transformative but it would have been relatively easy in each case for the court to stick with a straightforward analysis of the four factors in section 107. The transformative use standard is not needed to help courts and counsel argue and resolve these relatively clear instances of verbatim reproduction of copyrighted works for a variety of purposes—some for education, research, or other productive purposes, and others primarily for commercial gain.

2. Copying and Reverse Engineering

To write a computer program, such as one for a video game, that will run on another company's game platform, it is necessary to reverse engineer or decompile the computer program(s) for the platform. The reverse engineering or decompiling process requires, as its first step, copying the entire game platform program(s).³²⁰ This kind of intermediate copying violates the reproduction right,³²¹ but several courts have held that this is a fair use.

The leading reverse engineering case, decided before *Campbell v. Acuff-Rose*, is *Sega Enterprises v. Accolade, Inc.*³²² Accolade wanted to create video games which would be compatible with Sega's Genesis video game console so it decompiled several of Sega's copyrighted video games to figure out how they interacted with the game console. It then made several compatible games and was sued for infringement.³²³ The court recognized that the copying required to decompile the programs violated the Sega's reproduction right, but found fair use after a close examination of the four factors in section 107. Regarding the first factor, the court acknowledged that Accolade's use was commercial but there was no evidence that it was attempting to avoid its own creative work because the games it released for play on Sega's Genesis console had already been developed for other hardware.³²⁴ Although Accolade's ultimate purpose was making compatible games,

320. CRAIG JOYCE ET AL., *supra* note 3, at 881–82.

321. *See, e.g.,* Walker v. Univ. Books, Inc., 602 F.2d 859, 864 (9th Cir. 1979); Walt Disney Prods. v. Filmation Assocs., 628 F. Supp. 871, 875–76 (C.D. Cal. 1986).

322. *Sega Enters. v. Accolade, Inc.*, 977 F.2d 1510 (9th Cir. 1992).

323. *Id.* at 1514–15.

324. *Id.* at 1522.

its direct purpose in copying Sega's code, and thus its direct use of the copyrighted material, was simply to study the functional requirements for Genesis compatibility so that it could modify existing games and make them usable with the Genesis console. . . . no other method of studying those requirements were available to Accolade. On these facts, we conclude Accolade copied . . . for a legitimate, essentially non-exploitative purpose, and that the commercial aspect of its use can best be described as of minimal significance.³²⁵

Had *Sega* been decided today instead of in 1992, it is likely that the court would say that this reproduction of the program in connection with decompiling or reverse engineering is transformative. It might emphasize that "[t]he use of a copyrighted work need not alter or augment the work to be transformative in nature. Rather, it can be transformative in function or purpose without altering or actually adding to the original work."³²⁶

This statement was made in a Fourth Circuit decision concerning an online system that downloads and archives student papers to perform a digital comparison for detecting plagiarism.³²⁷ Student authors of the downloaded papers and essays alleged that this plagiarism detection system infringed. The trial court granted summary judgment for the defendant on the infringement claim, finding fair use.³²⁸ The court of appeals affirmed, saying that the defendant's use of the papers and essays "had an entirely different function and purpose than the original works; the fact that there was no substantive alteration to the work does not preclude the use from being transformative in nature."³²⁹

325. *Id.* at 1533–23; *Cf. Atari Games Corp. v. Nintendo of Am., Inc.*, 975 F.2d 832 (Fed. Cir. 1992) (holding deprocessing of lawfully purchased computer chips to understand the functioning of a game manufacturer's security program is a fair use, but the program that Atari eventually made to fit Nintendo's lock was substantially similar to Nintendo's program); *DSC Comms. Corp. v. Pulse Comms., Inc.*, 170 F.3d 1354 (Fed. Cir. 1999) (rejecting a *Sega*-based fair use defense).

326. *A.V. v. iParadigms, LLC*, 562 F.3d 630, 639 (4th Cir. 2009).

327. *Id.* at 634. Schools and colleges subscribe to the defendant's service and then require their students to submit their written assignments through an integration between the defendant's system and the school's course management system. *Id.*

328. The lower court said that the system's use (digital archiving) of the papers to prevent plagiarism and to protect students' works from being plagiarized was highly transformative. *Id.* at 638.

329. *Id.* at 639; *See also Oracle Am., Inc. v. Terix Comput. Co.*, No. 5:13-cv-03385-PSG, 2015 WL 1886968 (N.D. Cal. April 24, 2015). Defendants contended that their copying of Oracle software was to analyze and extract information to perform maintenance on their client's computer systems and was thus transformative. The court

In *Sony Computer Entertainment, Inc. v. Connectix Corporation* the Ninth Circuit discussed transformativeness in connection with the reverse engineering of a copyrighted computer program.³³⁰ Connectix, a video game system manufacturer, wanted to create its Virtual Game Station that would enable the compact discs used in Sony's PlayStation console to be played on a regular home computer.³³¹ To do this, it had to repeatedly copy Sony's basic input-output system that operates the PlayStation.³³² The court, applying *Sega*, held that this was fair use, and said that the defendant's Virtual Game Station was 'modestly transformative.'

The product creates a new platform, the personal computer, on which consumers can play games designed for the Sony PlayStation. This innovation affords opportunities for game play in new environments, specifically anywhere a Sony PlayStation console and television are not available, but a computer with a CD-ROM drive is. More important, the Virtual Game Station itself is a wholly new product, notwithstanding the similarity of uses and functions . . . Sony does not claim that the Virtual Game Station itself contains object code that infringes Sony's copyright. We are therefore at a loss to see how Connectix's drafting of an entirely new object code for its VGS program could not be transformative, despite the similarities in function and screen output.³³³

However, there may be limits on how far some courts are willing to push the transformative use standard to accommodate reverse engineering and decompiling. In the *Oracle v. Google* litigation saga over Google's use of Oracle's Java Application Programming Interfaces (APIs) to implement its Android operating system, the Court of Appeals for the Federal Circuit criticized the lower court for relying on the *Sega* and *Sony v. Connectix* decisions in holding that the APIs were not

acknowledged that a secondary work could be transformative in function or purpose without actually altering or adding to the original work. *Id.*

330. *Sony Comput. Entm't, Inc. v. Connectix Corp.*, 203 F.3d 596 (9th Cir. 2000).

331. *Id.*

332. *Id.* at 598-99.

333. *Id.* at 606-07; *see also* *Ticketmaster Corp. v. Tickets.com*, No. CV99-7654-HLH (VBK), 2003 WL 21406289 (C.D. Cal. Mar. 6, 2003) (*Sega* applied to permit automated temporary copying of interior webpages to extract factual information contained on those pages). *But see* *Fox Broad. Co. v. Dish Network, LLC*, 905 F. Supp. 2d 1088 (C.D. Cal. 2012) (*Sega* not applied to reproductions enabling AutoHop to automatically skip advertisements and commercials).

subject to copyright. However, after concluding that the APIs were copyrightable, it left open the possibility that Google might have a fair use defense.³³⁴ It noted disputed issues of fact as to whether Google's use was transformative and the impact of the use on the market for a licensed Java-based phone, and it suggested that the desire for interoperability might be relevant to the second and third fair use factors.³³⁵ The case thus returned to the district court for a trial on Google's fair use defense, with Google telling the jury that its use of the Oracle's Java APIs for a mobile operating system was a new and original purpose; hence, transformative.³³⁶ It also argued that the second and third factors favored fair use, and that the market harm factor favored it as well because no one was using the APIs for mobile devices.³³⁷ The jury found fair use and the decision is being appealed.³³⁸

3. Thumbnails, Linking, and the Internet

There have been several suits attempting to prevent Internet search engines like Amazon and Google from providing or utilizing images of plaintiffs' protected works associated with relevant text in response to a user's search query.³³⁹ These images are thumbnails; reduced, low resolution versions of full-sized images stored on third-party computers.³⁴⁰ The challenged thumbnails were, however, stored on the search engine provider's servers.³⁴¹ When a user clicked the thumbnail, he or she was then linked to a third-party computer holding the full-size version of the image.³⁴² Entities that owned the copyright on the images asserted that Amazon's and Google's utilization of these thumbnail versions infringed their reproduction and public display rights.³⁴³ Courts

334. *Oracle Am., Inc. v. Google, Inc.*, 750 F.3d 1339, 1371–72 (Fed. Cir. 2014), *rev'g* 872 F. Supp. 2d 974 (N.D. Cal. 2012); ELECTRONIC FREEDOM FOUNDATION, www EFF.ORG/cases/oracle-v-google (last visited Oct. 3, 2017); CRAIG JOYCE ET AL., *supra* note 3, at 885.

335. *Oracle Am., Inc.*, 750 F.3d at 1376–77.

336. *Id.*

337. Jeff John Roberts, *Google and Oracle's \$9.3 Billion Fair Use Fight Starts Today, Here's a Guide*, FORTUNE (May 9, 2016), <http://fortune.com/2016/05/09/google-oracle-fair-use/>.

338. ELECTRONIC FREEDOM FOUNDATION, www EFF.ORG/cases/oracle-v-google (last visited Oct. 3, 2017) (Oracle is appealing this decision).

339. *See, e.g.*, *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146 (9th Cir. 2007); *Kelly v. Arriba Soft Corp.*, 336 F. 3d 811 (9th Cir. 2003); *Perfect 10 v. Google, Inc.*, 416 F. Supp. 2d 828 (C.D. Cal. 2006).

340. *Amazon.com, Inc.*, 508 F.3d at 1156.

341. *Id.* at 1157.

342. *Id.*

343. *Id.*

held that the thumbnails directly infringed these exclusive rights,³⁴⁴ but concluded that the use of the thumbnails in search engines was a fair use in part because using protected images as thumbnails was said to be transformative.³⁴⁵

For example, in *Kelly v. Arriba Soft* the Ninth Circuit stated that although the defendant made ‘exact replications’ of the plaintiff’s images

the thumbnails were much smaller, lower-resolution images that served an entirely different function than Kelly’s original images. Kelly’s images are artistic works intended to inform and to engage the viewer in an aesthetic experience. His images are used to portray scenes of the American West in an aesthetic manner. Arriba’s use of Kelly’s images in the thumbnails is unrelated to any aesthetic purpose. Arriba’s search engine functions as a tool to help index and improve access to images on the internet and their related web sites.³⁴⁶

This use was not simply a retransmission of the images in a different medium and thus arguably a superseding use by the defendant. Instead, defendant’s use of the images was for an entirely different purpose.³⁴⁷ This was held to be highly transformative even though the images were not substantially altered but for the reduction in size and lower resolution.³⁴⁸ In this context, the transformative use standard complemented the traditional four-factor fair use analysis.

344. *Id.* at 1161–62; *Kelly*, 336 F.3d at 816–17. The search engine providers are not, however, directly infringing when the user clicks the thumbnail to link to a full-sized image stored on a third-party computer because those images, unlike the thumbnails, are not stored on Google’s or Amazon’s servers. *Amazon.com, Inc.*, 508 F.3d at 1160–61.

345. *Kelly*, 336 F.3d at 818–19; *Amazon.com, Inc.*, 508 F.3d at 1164–65.

346. *Kelly*, 336 F.3d at 818.

347. *Id.*; *See Amazon.com, Inc.*, 508 F.3d at 1165; *Field v. Google, Inc.*, 412 F. Supp. 2d 1106 (D. Nev. 2006) (holding search engine caching of websites is a fair use). *But see* *Video Pipeline, Inc. v. Buena Vista Home Entm’t, Inc.*, 342 F.3d 191 (3rd Cir. 2003). Video Pipeline’s internet sites, which rented or sold videos and DVDs, provided short clips of movies from its large database so that customers of those sites could preview the movies. Disney challenged, but Video Pipeline asserted that its use of these video clips from its database was transformative because the use was informational instead of for entertainment. However, the practice was enjoined because of its impact on Disney’s market for similar clips.

348. *Amazon.com, Inc.*, 508 F.3d at 1165. *Cf. A.V. v. iParadigms, LLC*, 562 F.3d 630, 639 (4th Cir. 2009) (holding reproduction of copyrighted term papers and essays in connection with plagiarism detection software has an entirely different function and purpose than the original works); *Rosen v. eBay, Inc.*, No. CV 13-6801 MWF (Ex), 2015 WL 1600081 (C.D. Cal. Jan. 16, 2015) (holding posting of magazine photos, as used to

4. The Google Books Project and Transformative Use

Google's announcement in 2004 that it had reached agreements with several major libraries to digitize their collections and make them available for full-text searching on the Internet resulted in objections from copyright owners and litigation. Works were reproduced in their entirety to create this massive database. Works in the public domain (i.e., those published before 1923) were displayed to users in their entirety while users looking at post-1923 works; presumed to be protected, would see only basic bibliographic information and brief excerpts surrounding the user's search terms.³⁴⁹ Google was not authorized by copyright owners to copy or display their works, and it did not compensate them for these uses.³⁵⁰ Courts have now held that reproducing the copyrighted books in digital format and making the 'snippets' available to users is a fair use.³⁵¹

In *Authors Guild v. Hathitrust*³⁵² the plaintiffs challenged the digitization by Google of over ten million books held in the collections of eighty member institutions, including the University of Michigan and the University of California, for contribution to the Hathitrust Digital Library. This database enables the general public to search for particular terms though all its materials. However, absent authorization, the search results only shows page numbers where the search terms are found and the number of times the term appears. This digital library also allows patrons with certified print disabilities to have full text access to works. Finally, it permits member libraries to replace their copies of works which are lost, destroyed or stolen when a replacement copy is not obtainable at a fair price elsewhere.³⁵³

represent magazines available for resale, is a fair use because the images are used for the fundamentally different purpose of promoting a secondary market).

349. *Authors Guild v. Google, Inc.*, 804 F.3d 202, 208–11 (2d Cir. 2015).

350. Neil Boorstyn, *Authors Guild v. Google, Inc.*, 28 COPYRIGHT L.J. 4 (Jan.–Feb. 2014).

351. *Authors Guild, Inc. v. Hathitrust*, 902 F. Supp. 2d 445 (S.D.N.Y. 2012), *aff'd*, 755 F.3d 87 (2d Cir. 2014); *Authors Guild, Inc. v. Google, Inc.*, 954 F. Supp. 2d 282 (S.D.N.Y. 2013) *aff'd*, 804 F.3d 202 (2d Cir. 2015). This litigation lasted well over a decade. The Authors Guild and Google reached a settlement in 2008 but it was amended after objections from third parties, and ultimately rejected by the district court in 2011 as not being "fair, adequate, and reasonable." A class was certified in 2012 but then vacated by the Second Circuit in 2013. On remand, both parties moved for summary judgment on the issue of fair use. Bloomberg BNA P.T.C. Journal, 87 PTCJ 101 (Nov. 15, 2013).

352. *Hathitrust*, 902 F. Supp. 2d at 445.

353. *Id.* at 448–49.

The lower court found defendants' use to be fair and granted their motion for summary judgment.³⁵⁴ The first factor heavily favored the defendants. The purpose of the use was for scholarship and research so the character of the use was said to be transformative.³⁵⁵ The court of appeals affirmed, ruling that the creation of a full-text searchable database is a "quintessentially" transformative use, explaining that the result of a word search is different in purpose, character, expression, meaning, and message from the page and the book from which it is drawn by providing superior search capabilities and facilitating access.³⁵⁶

*Authors Guild, Inc. v. Google, Inc.*³⁵⁷ is similar. The lower court opinion lists the benefits of Google Books including being an important reference tool; facilitating research; promoting data mining and text mining; expanding access to works; providing print disabled persons with the ability to read works by using text enlargement software, text to speech software, and Braille devices; and, generating new audiences and new sources of income for many copyright owners, book sellers, and authors.³⁵⁸ It also found that Google's use of copyrighted works was highly transformative because digitization transforms text into a comprehensive word index that helps readers, scholars, researchers and others find books. The use of text to facilitate search through display of snippets was seen as being analogous to the transformative use of thumbnails in the *Kelly v. Arriba Soft* and *Perfect 10* cases.³⁵⁹ The court explained that the display of snippets for text search or research is a different purpose than that of the copyright owners' in that the snippets direct users to a broad selection of books, and opens up new fields of research. Moreover, Google's use does not supplant books because it cannot be used to read books. Accordingly, it provides for the creation of new information, aesthetics, insights, and understandings.³⁶⁰

The Second Circuit affirmed in a comprehensive opinion by the judge whose 1990 law review article gave birth to the transformative use standard, the Honorable Pierre Leval. The court carefully analyzed the

354. *Id.* at 464.

355. *Id.* at 460–61.

356. *Hathitrust*, 755 F.3d at 97. The court determined that providing access to the print was not transformative because the underlying purpose of the digital version was the same as the original author's purpose. Nevertheless, this use also was held to be fair. *Id.* at 101–02. The court did not rule on the Hathitrust's preservation use of the plaintiffs' works. *Id.* at 103–04.

357. *Authors Guild, Inc. v. Google, Inc.*, 954 F. Supp. 2d 282 (S.D.N.Y. 2013), *aff'd*, 804 F.3d 202 (2d Cir. 2015).

358. *Id.* at 287–88.

359. *Id.* at 291; see also *supra* notes 339–48 and accompanying text.

360. *Google, Inc.*, 954 F. Supp. 2d at 291 (discussing how Judge Chin analyzed and discussed all the fair use factors).

purpose of the search and snippet functions and ultimately affirmed that they were transformative and fair use.³⁶¹ Judge Leval wrote that “[w]e have no difficulty concluding that Google’s making of a digital copy of Plaintiffs’ books for the purpose of enabling a search for identification of books containing a term of interest to the searcher involves a highly transformative purpose,” in the sense intended by *Campbell*.³⁶² He also said that “[s]nippet view . . . adds importantly to the highly transformative purpose of identifying books of interest to the searcher. With respect to the first factor test, it favors a finding of fair use.”³⁶³

Judge Leval, on behalf of a unanimous Second Circuit Court of Appeals, ultimately deployed a traditional fair use analysis in concluding that the scanning of millions of books in the Google Books project was lawful.³⁶⁴ The transformative use standard played an important role in the court’s analysis because notwithstanding Google’s profit motive, the defendants’ transformative purposes were numerous and clear. Moreover, there was no evidence of substitutive competition.³⁶⁵ The fundamental purposes of copyright were well served by holding that the scanning of protected materials critical to making the search engine function effectively is fair use.

361. *Authors Guild v. Google, Inc.*, 804 F.3d 202, 214–25 (2d Cir. 2015); *But see* *Code Revision Comm’n v. Public.Resource.Org, Inc.*, 244 F. Supp. 3d 1350 (N.D. Ga. 2017) (stating that reproduction of the entire Georgia Code, including copyrightable annotations and other copyrightable materials, on the Internet as a searchable free database is neither transformative nor a fair use); *Am. Soc’y for Testing & Materials v. Public.Resource.Org, Inc.*, 121 U.S.P.Q. 2d (BNA) 1513 (D. D.C. 2017) (holding reproduction and display of public domain and copyrightable materials—codes and standards for testing, buildings, electrical systems, and the like developed by private organizations and adopted by public entities—on free database is not transformative and not fair use).

362. *Authors Guild v. Google, Inc.*, 804 F.3d 202, 216–17 (2d Cir. 2015).

363. *Id.* at 218. *But see* *Fox News Network v. TVEyes, Inc.*, 124 F. Supp. 3d 325 (S.D.N.Y. 2015) (holding that the defendant’s archiving function was fair use but that its downloading and date-time search functions were not fair use, where defendant media-monitoring service recorded content on more than 1,400 television and radio stations and then transforms the content into a searchable database that enables subscribers to track when, where and how words of interest are used in the media).

364. *Authors Guild v. Google, Inc.*, 954 F. Supp. 2d 282, 294 (S.D.N.Y. 2013), *aff’d*, 804 F.3d 202 (2d Cir. 2015).

365. Jeff John Roberts, *Google Book is ‘Highly Transformative,’ Appeals Court Confirms in Fair Use Ruling*, *FORTUNE* (Oct. 16, 2015), <http://fortune.com/2015/10/16/google-books-appeals-court/>.

III. NOT TRANSFORMATIVE BUT STILL FAIR USE

There are a few post-*Campbell v. Acuff-Rose* decisions in which courts have stated that a challenged use of a copyrighted work was not transformative but still found fair use. After all, the Supreme Court stated in *Campbell* that concluding that a use is transformative is not required for finding fair use.³⁶⁶

In *Gulfstream Aerospace Corp. v. Camp Systems*³⁶⁷ defendant Camp Systems reproduced extensive portions of Gulfstream's maintenance manuals which Camp borrowed from owners of Gulfstream aircraft. Camp used the reproduced manuals to provide routine scheduled maintenance services on these owners' planes. In discussing Camp's fair use defense, the court said this copying was not transformative since the reproduced portions of the manuals were being used the very way they were intended to be used.³⁶⁸ However, the fourth fair use factor—impact on the market—weighed heavily in Camp's favor. Gulfstream's copyright claim had nothing to do with incentives to create the maintenance manuals. "Rather, what Gulfstream seeks here is to use its claimed copyright in its manuals to gain a judicially-enforced monopoly in maintenance-tracking services for Gulfstream aircraft."³⁶⁹

Similarly, in *S&L Vitamins v. Australian Gold*³⁷⁰ a company's use of thumbnail images of its competitor's tanning products on its own website in marketing its own tanning products was not transformative, but the court concluded that it had no impact on the market for or value of the competitor's copyrighted work. Instead, this legitimate comparative advertising could have an impact on the sale of the parties' tanning products.³⁷¹ The lesson of these two decisions is that a nontransformative use can be a fair use against a plaintiff who is seeking to use its copyright not to protect a creative work but to prevent fair competition.

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

367. *Gulfstream Aerospace Corp. v. Camp Sys. Int'l*, 428 F. Supp. 2d 1369 (S.D. Ga. 2006).

368. *Id.* at 1377.

369. *Id.* at 1380.

370. *S&L Vitamins, Inc. v. Australian Gold, Inc.*, 521 F. Supp. 2d 188 (E.D.N.Y. 2007).

371. *Id.* at 214–15; *see also* *Super Future Equities, Inc. v. Wells Fargo Bank Minn., N.A.*, 553 F. Supp. 2d 680 (N.D. Tex. 2008). *Super Future Equities* posted the claimant's copyrighted image on an informational website in which it was critical of the claimant's business practices. The court found there was nothing transformative about the posted image since the criticism was not aimed at the protected work, but it concluded that this posting had no impact on the value of the copyrighted image and was deemed a fair use. *Id.*

There has been other decisions in which courts found that a particular use of protected material was not transformative but still found that fair use fit comfortably within one of the uses listed in section 107's preamble, like cases involving news reporting. *Los Angeles News Service v. CBS Broadcasting*³⁷² concerned the showing of excerpts of the plaintiff's nine-minute clip of the beating of Reginald Denny in connection with Court TV's coverage of the trial of the man who had assaulted Mr. Denny. In earlier rulings the Ninth Circuit had said merely rebroadcasting videos of the Los Angeles riots without a license was neither transformative nor a fair use.³⁷³ In this case Court TV plucked the most interesting nine minutes of coverage and did not add anything new,³⁷⁴ yet the trial and appellate courts said that Court TV's use of the clip was fair.³⁷⁵ More recently, the Second Circuit repeated a statement from *Campbell* that a transformative use is not absolutely necessary for a fair use finding³⁷⁶ and then added that "[i]n the context of news reporting and analogous activities . . . the need to convey information to the public accurately may in some instances make it desirable and consonant with copyright law for a defendant to faithfully reproduce an original work rather than transform it."³⁷⁷

There are other post-*Campbell* decisions which do not discuss whether the defendant's use is transformative but still conclude that the first factor favors the defendant. For example, in *Jackson v. Warner Brothers* the plaintiff's paintings could be seen in the movie, "Made in America," for less than sixty seconds and the court said that the first factor favored defendant in finding fair use.³⁷⁸ Without discussing transformativeness, the court pointed out that the plaintiff's works were not the focus of the movie, could not be seen clearly, and were not superseded by the defendant's use of them.³⁷⁹ In *Bond v. Blum* an

372. *L.A. News Serv. v. CBS Broad., Inc.*, 305 F.3d 924 (9th Cir. 2002).

373. *L.A. News Serv. v. KCAL-TV Channel 9*, 108 F.3d 1119 (9th Cir. 1997); *L.A. News Serv. v. Reuters TV Int'l, Ltd.*, 149 F.2d 987, 993 (9th Cir. 1998).

374. *CBS Broad., Inc.*, 305 F.3d at 939. The court added that the inclusion of the clip in a video montage to introduce the Prime-Time Justice program had a better claim of transformativeness. *Id.*

375. *Id.* at 938–40 (9th Cir. 2002) Finding that it was not transformative "for the most part." *Id.*

376. *Swatch Grp. Mgmt. Servs. v. Bloomberg L.P.*, 742 F.3d 17 (2nd Cir. 2014) (citing *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579) *amended and superseded by* 756 F.3d 73 (2d Cir. 2014). Bloomberg published verbatim the transcript of plaintiff's conference call discussion of the company's 2010 earnings report.

377. *Id.* at 28–29.

378. *Jackson v. Warner Bros.*, 993 F. Supp. 585, 589–90 (E.D. Mich. 1997).

379. *Id.* at 589. The court also said that the defendant's use of the paintings was *de minimis* and could not be regarded as a substitute for the works. *Id.* at 590–91. *See*

author's autobiographical manuscript about the murder of his own father was introduced as evidence in a child custody dispute by his wife's ex-husband to show that this author's household would not be suitable for children.³⁸⁰ The author alleged copyright infringement but the court concluded that the first factor weighed in favor of fair use because the narrow purpose of the defendant ex-husband's use of the manuscript was as evidence; it contained admissions against the plaintiff author's interests.³⁸¹

The relatively few post-*Campbell* decisions in which the courts conclude that a use was not transformative or do not even discuss the doctrine can be explained by several factors: the challenged use was not a substitute for the protected work; the challenged use had no impact on the market for or value of the copyrighted work; the amount taken—qualitatively or quantitatively—was insubstantial; or, the defendant's use of plaintiff's work served copyright's fundamental purposes. This latter point is well illustrated by the fair use determinations in the litigation saga over digital reserve room practices in the Georgia State University libraries.³⁸²

Before analyzing each of forty-eight alleged instances of infringement, forty-four of which were held to be fair use, the lower court made the following statement:

In the fair use analyses for the various claims which follow, factor one ("the purpose and character of the use") will uniformly favor fair use because all uses were strictly of a nonprofit educational character for the sole purpose of teaching

Compaq Comput. Corp. v. Ergonome Inc., 387 F.3d 403, 409–10 (5th Cir. 2004) (holding defendant's commercial use of four illustrations and seven phrases from plaintiff's over 100-page book with over eighty photographs weighed against fair use but given all the evidence at trial the jury's finding of fair use was well supported—there was no discussion of transformativeness and whether the defendant's use was de minimis); see also Mastercard Int'l Inc. v. Nader 2000 Primary Comm., Inc., No. 00civ.6068 (GBD), 2004 WL 434404 (S.D.N.Y. Mar. 8, 2004) (holding candidate's television ad, which played off MasterCard's successful Priceless ads, to be a parody and fair use but transformativeness was not discussed).

380. Bond v. Blum, 317 F.3d 385, 391 (4th Cir. 2003).

381. *Id.* at 395; see also Healthcare Advocates, Inc. v. Harding, Earley, Follmer & Frailey, 497 F. Supp. 2d 627 (E.D. Pa. 2007) (holding defendant law firm's use of a search tool on a public website to access archived screen shots in connection with a trademark infringement suit to be a fair use with the court, without discussing transformativeness, saying that factor one favored the defendant firm).

382. See generally Cambridge Univ. Press v. Becker, 863 F. Supp. 2d 1190 (N.D. Ga. 2012), *rev'd*, Cambridge Univ. Press v. Patton, 769 F.3d 1232 (11th Cir. 2014), *on remand*, Cambridge Univ. Press v. Becker, No. 1:08-CV-1425-ODE, 2016 WL 3098397 (N.D. Ga. Mar. 31, 2016).

students in classes at a nonprofit educational institution, notwithstanding the nontransformative nature of the use. This outcome will be stated summarily in each fair use analysis to avoid repetition.³⁸³

In its initial 2012 ruling the trial court said that the language of section 107 and the *Campbell* decision compelled a finding that factor one favored fair use.³⁸⁴ It stated that

[t]his case involves making copies of excerpts of copyrighted works for teaching students and for scholarship, as specified in the preamble of § 107. The use is for strictly nonprofit educational purposes as specified in § 107(1). The fact that the copying is done by a nonprofit educational institution leaves no doubt on this point.³⁸⁵

In response the publisher's contention that factor one favored the plaintiffs because the uses were not transformative, the court quoted a footnote from *Campbell* saying that "[t]he obvious statutory exception to this focus on transformative uses is the straight reproduction of multiple copies for classroom distribution."³⁸⁶ In essence, there was no need for the court to stretch the transformative use standard out of shape to accommodate this kind of unauthorized reproduction of protected works for learning and educational purposes.³⁸⁷

IV. TAKINGS THAT ARE NOT TRANSFORMATIVE AND NOT FAIR USE

The presumption-like status of the transformative use concept cuts both ways. In the majority of reported decisions in which the court

383. *Becker*, 2016 WL 3098397 at *9.

384. *Cambridge Univ. Press v. Becker*, 863 F. Supp. 2d 1190, 1224 (N.D. Ga. 2012).

385. *Id.* at 1224.

386. *Id.* at 1224–25 (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994)); see also *Reiner v. Nishimori*, No. 3:15-cv-00241, 2017 WL 1545589 (M.D. Tn. Apr. 28, 2017) (holding summary judgment dismissing plaintiff photographer's claims against an art school and a student who used plaintiff's photo for educational purposes as a mock ad in connection with a class assignment).

387. The post-*Campbell* emphasis on transformative uses seems to ignore the *Betamax* decision and the Court's recognition that verbatim copying of a work for personal use is fair. Twisting and pushing a particular use to say it is transformative is one thing, but courts must not ignore or forget that there is often social value to copying a work verbatim for personal use. See generally Rebecca Tushnet, Essay, *Copy This Essay: How Fair Use Doctrine Harms Free Speech and How Copying Serves It*, 114 YALE L.J. 535 (2004).

determined that the defendant's use of plaintiff's work was transformative, it found fair use. Conversely, in the overwhelming majority of the reported decisions in which a court concluded that the defendant's use was not transformative, it ruled against fair use and found infringement. These decisions ordinarily involve taking too much without a different purpose; the appropriations of protected expression that are substantial, the original work is altered only slightly if not at all, and the defendant appropriator's intent or purpose in using the secondary work is very similar to that of the protected work. Most substantial takings with little, if any, transformation, are hard to justify as fair use.

For example, a movie intended to be a prequel to the original *Star Trek* series with use or reference to elements and details in the original series, done to stay true to the canon, was held not transformative and not fair use. The court said that the defendants wanted their *Axanar* works to supplant the *Star Trek* works.³⁸⁸ Similarly, the author of a book about the rise and fall of Pan American Airlines who admittedly used at least twenty-five percent of the words and phrases from a published book about one of Pan American Airlines' founders in his unpublished manuscript sought a declaratory judgment that he did not infringe.³⁸⁹ He lost on summary judgment, with the court finding infringement to an extraordinary degree,³⁹⁰ and saying it was clear that no reasonable jury could find fair use.³⁹¹ It also said that no jury could find that this use of material was transformative to a substantial degree. The declaratory judgment plaintiff took a substantial portion of the protected work verbatim, added a couple of chapters, and worked in some transitions.³⁹² "In essence, Robinson did nothing more than update a shortened version of Daley's book and pass it off as his own. When the secondary use involves such an untransformed duplication of the original, it has little or no value that does not exist in the original work."³⁹³

388. *Paramount Pictures Corp. v. Axanar Prods.*, No. 2:15-CV-09938-RGK-E, 2017 WL 83506 (C.D. Cal. Jan. 3, 2017).

389. *Robinson v. Random House, Inc.* 877 F. Supp. 830, 834 (S.D.N.Y. 1995).

390. *Id.*

391. *Id.* at 843.

392. *Id.* at 834.

393. *Id.* at 840-41; *see also Religious Tech. Ctr. v. Netcom On-Line Commun. Servs.*, 923 F. Supp. 1231 (N.D. Cal. 1995) (defendant's posting of a substantial amount of plaintiff's writings with very little in the way of criticism or commentary was not fair use in part because the posting was only minimally transformative because so little was added to the plaintiff's works); *Richards v. Merriam Webster, Inc.*, 55 F. Supp. 3d 205 (D. Mass. 2014) (defendant's copying and modification of roughly seventy percent of plaintiff's dictionary as a public service to facilitate reading comprehensive might be transformative but the other three factors strongly disfavored fair use so infringement was found); *Penguin Random House LLC v. Colting*, No. 17-CV-386 (JSR), 2017 WL

The manufacturer of a karaoke device asserted in a declaratory judgment action that its reproduction and display of song lyrics on the video screen was a fair use.³⁹⁴ It asserted that karaoke teaches singing by allowing people to sing along with recorded music, but the court said it was not reasonable to infer that teaching was the purpose of the manufacturer's use of the lyrics. It was, however, reasonable to infer that the manufacturer did not alter or add to the lyrics. The court acknowledged that posting the lyrics facilitated parent control over objectionable songs, but said that the ultimate purpose of the use was commercial and not fair.³⁹⁵

In another case a cleric posted substantial portions of a Greek Orthodox monastery's copyrighted English language translations of ancient Greek religious texts without permission.³⁹⁶ The court ruled against fair use, saying that the cleric's postings were not transformative because they were essentially verbatim copies with miniscule alterations that served the same underlying purpose as the original translations; to further religious practices and education.³⁹⁷

Similarly, a bank copied and used copyrighted reverse mortgage forms which had been created by a mortgage counseling service after the

3977000 (S.D.N.Y. Sept. 7, 2017) (holding on summary judgment that unauthorized children's guides to *Breakfast at Tiffany's*, *The Old Man and the Sea*, *On the Road*, and other novels were not transformative, but infringing derivative works).

394. *Leadsinger, Inc. v. BMG Publ'g*, 512 F.3d 522 (9th Cir. 2008).

395. *Id.* at 530.

396. *Soc'y of the Holy Transfiguration Monastery v. Gregory*, 689 F.3d 29 (1st Cir. 2012).

397. *Id.* at 60; *see also* *Worldwide Church of God v. Phil. Church of God, Inc.*, 227 F.3d 1110 (9th Cir. 2000) (holding defendant religious organization's copying of plaintiff's book in its entirety supersedes the object of the original book—to serve religious practice and education—and is not transformative nor a fair use); *Peter Letterese & Assocs. v. World Inst. of Scientology Enters.*, 533 F.3d 1287, 1309–12 (11th Cir. 2008) (holding an organization's unauthorized use of plaintiff's course materials to teach sales techniques to members as part of their training was not transformative, but after evaluating all the factors it found fair use as to one set of materials but not as to another set). *Cf. C. Entrance Examination Bd. v. Pataki*, 889 F. Supp. 554, 567–68 (N.D.N.Y. 1995) (holding the xerographic reproduction and disclosure of copyrighted test materials pursuant to state law would not be transformative use of those materials so the state failed to establish that disclosure of the materials would be a fair use); *Veeck v. S. Bldg. Code Cong. Int'l*, 293 F.3d 791, 823–24 (5th Cir. 2002) (en banc) (Wiener, J., dissenting). Opinion with disagreement about several issues and a dissenting opinion stating that website operator's posting of copyrighted but enacted model building codes was not a fair use since nothing about the posting was transformative and the posting could have a negative impact on the market for the copyrighted model codes. *Id.*

bank had terminated its participation in the service's program.³⁹⁸ The bank raised a fair use defense that was rejected. The court said that the factor one inquiry was whether the new work is transformative rather than a mere successor to the original, and then explained that the bank's form was a copy of the plaintiff's form that served the same purpose and thus supplanted it.³⁹⁹

The reproduction of plaintiff's aerial photographs of a construction site for presentation to arbitrators and witnesses in a dispute over that site was held to infringe the photographer's copyright in *Images Audio Visual Productions, Inc. v. Perini Building Co., Inc.*⁴⁰⁰ The defendant's fair use defense failed in part because there was nothing transformative about the defendant's reproduction of the pictures and they were used for the same purpose they were intended to serve; to provide a record of defendant's progress on the contested construction site.⁴⁰¹ In *Dahlen v. Michigan Licensed Beverage Association*⁴⁰² the defendants negotiated with plaintiff about making a poster that would inform bar patrons about their rights regarding drinking and driving, and then, after negotiations broke down, they went ahead and used plaintiff's 'We Care About You' poster to create their own poster titled 'Do You Know Your Rights?'.⁴⁰³ The two posters were not identical but there was considerable overlap including similar layouts and content.⁴⁰⁴ In holding that the defendant's use of the plaintiff's poster was not fair use the court discussed transformative use and said that the first factor heavily favored the plaintiff because the defendant's poster did not imbue the work with a "further purpose or different character," or add anything new to the poster's mission.⁴⁰⁵ "[T]he two works are intended for precisely the same audience, and provide their intended readers with almost entirely the same information."⁴⁰⁶

398. *Homeowner Options for Mass. Elders, Inc. v. Brookline Bancorp, Inc.*, 754 F. Supp. 2d 201, 204-05 (D. Mass. 2010). The forms the defendant used contained the H.O.M.E. acronym. *Id.* at 205.

399. *Id.* at 209-10.

400. *Images Audio Visual Prods. v. Perini Bldg. Co.*, 91 F. Supp. 2d 1075 (E.D. Mich. 2000).

401. *Id.* at 1081.

402. *Dahlen v. Mich. Licensed Bev. Ass'n*, 132 F. Supp. 2d 574 (E.D. Mich. 2001).

403. *Id.* at 576-77. Plaintiff's poster also advised bar patrons of facts relating to drinking and driving, including what to do in the event you stopped by police for suspicion of driving under the influence. *Id.*

404. *Id.* at 577.

405. *Id.* at 586.

406. *Id.* There were, however, fact issues that precluded the grant of summary judgment for either side. See also *Davis v. GAP, Inc.*, 244 F.3d 152, 174 (2d Cir. 2001) (holding a defendant's use in an advertisement of a photograph in which one of the

Transformative use arguments also fail when the secondary user breaches a license and continues to use the plaintiff's copyrighted work. For example, Twentieth Century Fox Films, in connection with a breach of contract suit, asserted that Marvel Enterprises' use of clips from its X-Men films and trailers in promoting its new Mutant X television series was copyright infringement as well as a breach of the licensing agreement, Marvel raised fair use, and the court concluded fair use was inapplicable.⁴⁰⁷ It said that Marvel's use of the films and trailers was like Fox's use of them; promotional. They had not created a transformative work altering the original with a new expression, meaning or message.⁴⁰⁸ Similarly, a computer software developer sued the Los Angeles County Sheriff's Department for copyright infringement after the department loaded the plaintiff's software on over 6,000 computers when the department had purchased licenses for 3,663 computers.⁴⁰⁹ The department claimed fair use but the court concluded otherwise, saying that there was nothing transformative about the department's use since it made exact copies of the software and put them to use for the same purpose as the original software.⁴¹⁰

V. CONCLUSION

Most reported decisions discussing and applying the transformative use standard, like fair use decisions generally, fit within recurring patterns or clusters, as shown by the dozen categories and subcategories analyzed in this article. In some of these categories, such as parody, uses out of context and appropriation art, the court's analysis and discussion of whether an unauthorized reproduction of a copyrighted work is transformative performs an important role in explaining why that particular use is or is not fair. However, in the fair use categories listed in

models wore the plaintiff's copyrighted eye jewelry was not transformative and fair use because it showed the jewelry as it was made to be worn, like an ad the plaintiff might have sponsored for his design).

407. *Twentieth Century Fox Film Corp. v. Marvel Enters.*, 155 F. Supp. 2d 1, 45–46 (S.D.N.Y. 2001).

408. *Id.* at 46–47; *see also* *Lamb v. Starks*, 949 F. Supp. 2d 753, 756–57 (N.D. Cal. 1996) (alleged infringer claimed fair use in posting a movie trailer without permission but was unable to rebut that this was infringement since the use was clearly commercial).

409. *Wall Data Inc. v. L.A. County Sheriff's Dep't*, 447 F.3d 769, 773–74 (9th Cir. 2006).

410. *Id.* at 778; *SCQuARE Int'l, Ltd. v. BBDO Atl., Inc.*, 455 F. Supp. 1347 (N.D. Ga. 2006) (holding defendant's creation and use of a condensed version of plaintiff's training program was not remotely transformative since the defendant's version did not comment on or build upon plaintiff's manuals, and as an abridgement the manuals presented the possibility of supplanting the plaintiff's works).

section 107's preamble, which were well-established before *Campbell v. Acuff-Rose* was decided in 1994, such as criticism, comment, news reporting, and copying for educational and research purposes, it is unnecessary for courts to turn to the transformative use standard. When it is relatively clear that the challenged use fits within one of those well-established categories, it would be better for the courts to stick with a straight-forward analysis using section 107's four factors. This is preferable to trying to twist and turn the transformative use standard to accommodate and explain a challenged use. Otherwise, the transformative use standard becomes more presumption-like, implicitly amending section 107. This outcome is counter to the Supreme Court's explicit rejection in *Campbell v. Acuff-Rose*⁴¹¹ of using presumptions in fair use analysis. Moreover, in view of the subtle distinction between some allegedly transformative uses and derivative works,⁴¹² the standard's evolution into a presumption risks undermining the right to prepare derivative works.⁴¹³ The standard should not be allowed to eviscerate this important right. Like the old productive or nonproductive use distinction discussed by the Supreme Court in the venerable *Sony/Betamax* decision,⁴¹⁴ analyzing whether a particular use is transformative should be helpful but not the determinative consideration in assessing fair use.

411. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 584–91 (1994).

412. *Supra* notes 91–110 and accompanying text.

413. 17 U.S.C. § 106(2) (West 2012).

414. *Supra* notes 54–58 and accompanying text.