

Appropriate Appropriation: Second Circuit Holds That Commentary on Original Work Unnecessary for Fair Use Defense, Only Transformative Quality Required

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In *Cariou v. Prince*, No. 11-1197-cv (2d Cir. Apr. 25, 2013), an opinion with significant importance for the art world, the U.S. Court of Appeals for the Second Circuit clarified what is required for a defendant's entitlement to the "fair use" defense to a claim of copyright infringement, holding that the law does not require that a secondary use comment on the original artist or work, or popular culture, but only that the secondary work be "transformative."

In 2000, photographer Patrick Cariou published a book entitled *Yes Rasta*, featuring portraits of Rastafarians shot during his years in Jamaica, which enjoyed modest sales and distribution. Years later, well-known appropriation artist Richard Prince, in a series of paintings and collages, incorporated to varying extents several of Cariou's *Yes Rasta* portraits into his works. Prince's work for decades has involved taking others' photographs and other images and integrating them into his paintings and collages in different contexts. The works at issue were featured in number of exhibitions, including those by the Eden Rock Hotel in St. Barth's and defendant New York's Gagosian Gallery, owned by defendant Lawrence Gagosian.

Cariou brought claims of copyright infringement against Prince, the Gagosian Gallery, and Lawrence Gagosian, alleging that Prince's works infringed Cariou's rights in his *Yes Rasta* photographs. Prince (and the other defendants) raised a "fair use" defense. When satisfied, the "fair use" defense, codified in the federal Copyright Act, permits a defendant to make use of another's copyright work or portions thereof. Courts look to four main factors in determining whether a secondary use is "fair": the nature of the original copyrighted work, the extent of the original work used, whether the secondary use is commercial or non-commercial, and whether the secondary use replaces the market for the original.

The district court held that Prince's works were not eligible for the fair use defense and issued a permanent injunction compelling the defendants to deliver to Cariou all infringing works not yet sold for Cariou to destroy, sell, or otherwise dispose of. In doing so, the district court concluded that in order to qualify for a fair use defense, Prince's work must comment on Cariou, on Cariou's photographs, or on aspects of popular culture closely associated with Cariou or his photographs. The district court determined that Prince's works did not make any such comments, so the fair use defense was inapplicable and Prince's works were infringing.

On appeal, the Second Circuit evaluated whether the district court applied the incorrect standard to determine if Prince's artworks made fair use of Cariou's copyrighted photographs. As a primary matter, the Second Circuit looked to the aims of the Constitution's "intellectual property" clause, reasoning that copyright law was designed to stimulate activity and progress in the arts, and that excessively broad copyright protection would stifle, rather than advance, the law's objective; the fair use doctrine functions as a mediator between the property rights that copyright law establishes in creative works and the ability of artists or authors to express themselves by reference to others' works. Quoting its prior precedent, the Court stated that the "ultimate test of fair use is whether the copyright law's goal of promoting the Progress of Science and the useful Arts would be better served by allowing the use than by preventing it."

The Second Circuit made clear that the real test for the fair use defense is whether the secondary artwork is a "transformative" use of the original work, and stated that the law imposes no requirement that a work comment on the original or its author in order to be considered transformative. Indeed, the Court said that a secondary work "may constitute 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." What is critical is whether the new work alters the original with new expression, meaning, or message, and how the work in question appears to the reasonable observer. The Court was careful to clarify that cosmetic changes to an original work would not automatically qualify a secondary work to fair use protection; it is possible that a secondary work could modify the original without being transformative.

In evaluating the use of Cariou's photographs in Prince's paintings and collages, the Second Circuit concluded that twenty-five of the thirty works at issue were transformative, manifesting "an entirely different aesthetic from Cariou's photographs" – Cariou's photos depicted the natural beauty of Rastafarians in their environment whereas Prince's works were "crude and jarring," "hectic and provocative." Further, where Cariou's pictures were relatively small and in black and white, Prince's collages and paintings were massive, colorful, and made of varying media, all contributing to the distinct expressive nature of Prince's work. Even though Prince's works were commercial in nature, the Court did not give that factor significant weight because of the works' transformative quality. With regard to whether the Prince's works would harm the market for Cariou's photographs, the Court said that in a fair use analysis, the concern is not whether the secondary use suppresses or even destroys the market for the original work (or potential derivatives), but whether the secondary use *usurps* the market for the original work. The Court reasoned that the audiences for Prince's artwork and Cariou's photographs were quite different – Prince's works sold for millions of dollars and were displayed at exhibitions attended by major celebrities, whereas Cariou's works had modest sales that would not be impacted by Prince's works. The Court further reasoned that while Cariou's photographs were themselves creative works of art, which weighed against fair use, that factor was of limited use where the works of art were being used for a creative purpose. In analyzing the significance of how much of Cariou's photographs Prince took, the Court said the concern was not only whether Prince took more than what was necessary, but also the quality and importance of the taken materials to the original work. The Second Circuit determined that although Prince used key portions of certain of Cariou's photographs, Prince transformed those photographs into something new and different.

The Court concluded that twenty-five of the Prince works were entitled to fair use protection due to their transformative qualities. The Court was not able to reach that same conclusion as to five other Prince works, and sent the question back to the district court to look at whether those five works, which had relatively minimal alterations, impermissibly infringed Cariou's copyrights. The Gagosian Gallery and art dealer Lawrence Gagosian could not be held directly or secondarily liable with regard

to the twenty-five non-infringing works, but could be held liable were the other five works found to be infringing by the district court.

The *Cariou* case is an important clarification of copyright law with substantial and obvious impact on the art world, both for artists as well as for exhibitors and dealers of artwork. In not limiting the fair use defense to only those works which comment in some way on the original work, the original work's creator, or popular culture surrounding the original work or its creator, the Second Circuit's decision permits a much greater universe of secondary works to be eligible for the fair use defense. This reading of the fair use doctrine permits a more expansive potential for appropriation of original works, provided that the new works actually transform the underlying works by in adding new expression, meaning, or message.

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