



## PEOPLE/BIZ

## Viewpoint: Andy Warhol, Prince and fair use — what doc-makers need to know

By Guest Author

June 19, 2023



Below, Nicole Page (pictured, below left) and Daniel Ain (pictured, below right) — partner and senior associate at New York's RPI Law, respectively — explore the impact a recent U.S. Supreme Court decision could have on the fair use doctrine going forward.

The U.S. Supreme Court recently decided a case that could impact non-fiction producers if copyright holders attempt to use it as basis to bring new copyright infringement claims.

In *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*, the Court re-examined one of the factors considered under the fair use doctrine, which producers rely on to use unlicensed copyrighted material for “purposes such as criticism, comment, news reporting, teaching ... scholarship, or research.” The Court determined that the first factor in the analysis, the “purpose and character of the use,” points in favor of fair use when the secondary use of intellectual property is sufficiently distinct from the original use.

A quick summary of the facts of the case: in 1981, acclaimed celebrity portrait photographer Lynn Goldsmith was commissioned by *Newsweek* to photograph then-rising star Prince. Goldsmith retained ownership of the photographs. In 1984, Goldsmith licensed one of the images to *Vanity Fair*, on a “one-time” basis, for iconic pop artist Andy Warhol to use as an “artist reference” for a silkscreen illustration (“Purple Prince”) published in the November 1984 issue of the magazine, for which Goldsmith received \$400 and a source credit.

Warhol, however, ultimately created a series of 16 works (14 silkscreens and two drawings) entitled *The Prince Series*, all derived from the Goldsmith photograph. In 2016, the Andy Warhol Foundation (Warhol's successor) licensed one of the 16 works (“Orange Prince”) to Condé Nast for \$10,000. It was the publication of “Orange Prince” that led to litigation.

In considering whether the use of Goldsmith's photograph constituted copyright infringement, lower courts evaluated the below four factors codified in the Copyright Act to determine whether the Foundation's use of Goldsmith's photo was “fair”:

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

It has been long established that the most important of the four factors is the first. In analyzing that factor, courts consider whether the new work is “transformative” — meaning, does the new work “add something new, with a further purpose or different character, altering the first with new expression, meaning, or message.” (See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579.) In *Warhol*, the Court determined that it was equally as important to consider how the new work was used and whether the new use had a commercial purpose.

In holding that the licensing of “Orange Prince” to Condé Nast did not favor fair use under the first factor, Associate Justice Sonia Sotomayor, writing for the majority, noted that “[w]hether the purpose and character of a use weighs in favor of fair use is ... an objective inquiry into what use was made, i.e., what the user does with the original work.” The Court held that because the use of Goldsmith’s original photograph and Warhol’s “Orange Prince,” in Justice Sotomayor’s words, “share substantially the same purpose” — that is, commercial licensing to a publication — the Foundation’s use did not pass muster under the first factor.

The Court, however, emphasized the limits of its holding. Both Justice Sotomayor’s majority opinion and Associate Justice Neil McGill Gorsuch’s concurrence made clear that the first-factor analysis might have come out the other way if a different secondary “use” was at issue. As Justice Gorsuch stated: “If, for example, the Foundation had sought to display Mr. Warhol’s image of Prince in a non-profit museum or a for-profit book commenting on 20th-century art, the purpose and character of that use might well point to fair use. But those cases are not this case.”

In considering whether or not a fair use claim may be viable, documentary filmmakers should now ask themselves: does the use of copyrighted material in my film differ from the original use(s) of the material?

In *Warhol*, Justice Sotomayor stated “[i]f an original work and a secondary use share the same or highly similar purposes, and the secondary use is of a commercial nature, the first factor is likely to weigh against fair use, absent some other justification for copying.” So how could this play out in the documentary film world?

Let’s say Filmmaker 1 shoots a short film which includes original footage depicting the effects of climate change on residents of California, and then licenses the film to a distributor. Now, let’s say that Filmmaker 2 uses an unlicensed clip of Filmmaker 1’s original footage in her film about climate-change deniers, relying on the “transformative” manner in which the footage is used in her film. Filmmaker 2 then similarly licenses her film to a distributor.

In a post-*Warhol* world, Filmmaker 1 might assert an infringement claim and argue that, while Filmmaker 2 used the footage to convey a distinct message (e.g., those denying scientific evidence of climate change), because the footage in both projects was used for the same purpose — namely, licensing a film to a distributor — and is commercial in nature, Filmmaker 2’s use does not hold up as fair use.

At the moment it’s still early days, and *Warhol* may not ultimately have much impact on documentarians. We may, however, see increased scrutiny and caution in the short term from buyers who have concerns about whether this decision could spark a wave of copyright infringement suits. Hopefully, the decision will not prevent projects from getting off the ground — a result that Associate Justice Elena Kagan, who cast one of two dissenting votes in the decision, most fears: “It will stifle creativity of every sort. It will impede new art and music and literature. It will thwart the expression of new ideas and the attainment of new knowledge. It will make our world poorer.”

In the meantime, it will be important for documentarians, and creators of all types, to stay aware of the latest developments.

*Nicole Page is a partner at Reavis Page Jump LLP in New York where she leads the Entertainment Law group. Page regularly serves as production and clearance counsel for unscripted series and documentaries. In addition, Nicole acts as outside general counsel for numerous production companies assisting with employment, corporate and litigation matters. Nicole proudly serves as President of the Board of Women Make Movies. Daniel J. Ain is a senior associate at Reavis Page Jump LLP, practicing in the firm’s Entertainment Law group. He counsels production companies and independent producers on a broad range of television, film and digital media projects across all stages of development and production. He additionally represents screenwriters, directors, actors, authors, athletes and other creatives in all aspects of their entertainment and media-related matters.*