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ABSTRACT

In Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*, the Supreme Court conflated "use as an artist reference" with preparing a "derivative work." It did so on the erroneous assumption that permission to use a copyrighted work as an artist reference is a license to prepare a derivative work. But copyright law does not necessarily deem all uses of references for making new art to be the preparation of a derivative work. In other words, not all adaptations of an original work are infringing. Some may be neither derivative works nor substantially similar copies, and some may be subject to the exceptions and limitations in the statute, such as fair use.*

Examining longstanding artistic practices, case law, and our recent study of professional photographers, this Article develops a more nuanced view of the relationship between the artist reference and the derivative work. Drawing on this evidence, we argue that courts should explicitly engage with the characteristics and context of the reference and the new work before arriving at a determination of infringement or noninfringement between the two works.

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** Eva E. Subotnik, Professor of Law and Associate Dean for Faculty Scholarship, St. John's University School of Law. I dedicate this Article to the memory of my father, Professor Daniel Subotnik (1942–2024), on whose shoulders I stood for forty-eight years. He will be greatly missed.

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This reasoning applies equally whether the use of an artist reference is initially licensed or unlicensed by a second artist. When expressly authorized, artist references are simply permissions to use—a ticket to entry, permission for access to the work in its tangible and intangible forms. And, importantly, they are just the beginning of an artistic process. What the new author produces based on the artist reference makes all the difference, and legal liability should depend on aesthetic evaluation of both the referenced work and the new work. Avoiding that aesthetic evaluation and misconstruing an agreement to "use as an artist reference" as a license to prepare a derivative work, which the Supreme Court did in its formalistic approach in Warhol*, is a shortcut that distorts copyright law and harms creative practice.*

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INTRODUCTION

In *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*, the Supreme Court conflated "use as an artist reference" with preparing a "derivative work," assuming the answer to the question it claimed to avoid.[1] It did so on the erroneous assumption that permission to "use as an artist reference" is a license to prepare a derivative work. But copyright law does not necessarily deem all resulting uses from an "artist reference" to be "derivative works." Derivative works are certain kinds of adaptations that are statutorily enumerated.[2] Courts must determine that the resulting work fits within the definition of "derivative work" to find infringement of that exclusive right (if permission was not granted), which may then trigger application of defenses. In other words, not all adaptations of the original work are infringing. Some may be neither derivative works nor—under the more general infringement standard—substantially similar copies, and some may be subject to the exceptions and limitations in the statute, such as in § 107 (fair use) and thereafter.[3]

In this Article, we examine longstanding artistic practices, case law, and our recent study of professional photographers to develop a more nuanced view of the relationship between the artist reference and the derivative work. Artist references are photographs or other visual art to which subsequent artists may refer when making new work.[4] As this paper explains, use of a "reference" by artists is an age-old practice whose purposes range from inspirational to informational. Famously, Andy Warhol

1. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 598 U.S. 508, 515, 533–35 (2023) (internal quotation marks omitted).

2. 17 U.S.C. § 101 ("A 'derivative work' is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a 'derivative work.'").

3. Whether a derivative work is also necessarily a substantially similar copy is subject to some debate. *Compare* Mirage Editions, Inc. v. Albuquerque A.R.T. Co., 856 F.2d 1341 (9th Cir. 1988) (finding violation of right to prepare derivative work but no separate copy made in violation of § 106(1)), *with* Litchfield v. Spielberg, 736 F.2d 1352 (9th Cir. 1984) (holding "a work is not derivative unless it has been substantially copied from the prior work"). This Article's argument is unaffected by this distinction, but we discuss some of the implications of their independence *infra* at notes 50–60. We focus on the right to prepare a derivative work because that is how the Supreme Court analyzed the issue, and because often the more challenging analytical line to draw is between a derivative work and a work that is transformative in purpose and character under fair use factor one (§ 107(1)). Furthermore, as explained *infra*, the relevance of the agreement to "use as an artist reference" does not change if Warhol's work was deemed a substantially similar copy rather than a derivative work because in either case the Court failed to engage with the resulting paintings so as to justify a conclusion of infringement. For an analysis of the Warhol prints according to the substantial similarity analysis, see Carys J. Craig, *Transforming "Total Concept and Feel": Dialogic Creativity and Copyright's Substantial Similarity Doctrine*, 38 CARDOZO ARTS & ENT. L. J. 603, 643–46 (2020).

4. As explained more fully in Part II, an "artist reference" is also sometimes called an "aide-mémoire" in art history and practice. The artist reference is an image or object that helps an artist render work as intended. AARON SCHARF, ART AND PHOTOGRAPHY 111 (1974).

used photographs as references for many of his portraits, such as *Marilyn* or *Red Jackie*.[5] Contemporary portrait artists rely on photographs as references to make paintings, obviating the burden on subjects to endure long sittings. In general, artists regularly rely on photographs or other visual art to create images of otherwise inaccessible people, objects, or places. Artistic "use of a reference" is ubiquitous and subject to diverse and evolving practices within artistic communities. In our study of photographers, we explored their practices of, among other things, referential uses.[6] And contrary to the factual assumptions underlying the *Warhol* decision, the photographers we studied do not deem "derivative" (that is, with legal consequences) all new art made from the use of or reference to older art, even when done expressly and under an agreement to "use as an artist reference." Photographers describe a narrower scope of uses for which they would demand licenses. In this framework, an "artist reference" is a creative tool, and its use to produce a new work is not considered copyright infringement without evaluating the new work's aesthetic form and purpose.

In contrast and without a factual basis, the Supreme Court defined an "artist reference" as something that inevitably creates "stylized derivatives" within the scope of the original author's copyright.[7] This erroneous elision of "use as an artist reference" with "stylized derivative" avoided addressing the case's central legal issue: whether Warhol's *Prince Series* works are infringing works or fair uses.[8] As described more fully below, Andy Warhol made the *Prince Series* in 1984 with permission from Lynn Goldsmith to use her photograph as an artist reference. Included in the *Prince Series* was the *Orange Prince*, which Condé Nast later published on its cover in 2016. The factual errors and legal ambiguities left in the wake of the Court's *Warhol* decision require clarification, such as when uses of artist references require authorial permission or, instead, may be non-infringing.

This Article aims to provide that clarity by drawing on case law, history, and artistic practice. We show that "use as an artist reference" does not necessarily produce an infringing work for at least three reasons: (1) Photography practice hews to a narrower scope of copyright protection; (2) use as an artist reference does not necessarily produce a substantially similar copy or a derivative work (e.g., use of a reference per se is not

5. Emily A. Francisco, *Andy Warhol: Polaroids & Portraits*, 11 SCHMUCKER ART CATALOGS 11 (2013), https://cupola.gettysburg.edu/artcatalogs/11 [https://perma.cc/L97U-SMPT] [https://web.archive.org/web/20240128165705/https://cupola.gettysburg.edu/artcatalogs/11/] (describing Warhol's use of Polaroids in his early portraiture). "At the same time, he treated photography as both a reference tool for painting and an artistic medium of its own." *Id.* at 3; *see also Warhol Women, Red Jackie*, LÉVY GORVY (May 10, 2019), https://www.levygorvy.com/happenings/warhol-women-red-jackie/ [https://perma.cc/YA2X-2YSU] [https://web.archive.org/web/20240317151749/https://www.levygorvy.com/happenings/warhol-women-red-jackie/].

6. Jessica Silbey, Eva Subotnik & Peter DiCola, *Existential Copyright and Professional Photography*, 95 NOTRE DAME L. REV. 263, 277–301 (2019); *see also* Jessica Silbey, *Justifying Copyright in the Age of Digital Reproduction: The Case of Photographers*, 9 U.C. IRVINE L. REV. 405, 437–40 (2019).

7. *See* Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 598 U.S. 508, 535 (2023).

8. *Id.* at 536, 536 n.9 (narrowing the issue before the Court to the use by Condé Nast in 2016).

infringing); and (3) permission to use an artist reference may be sought and granted even if unnecessary under law. All three reasons require evaluating the second work's aesthetic characteristics—what is the art made with the use?—an evaluation the Supreme Court erroneously thought it could avoid.

We will have more to say about the background dispute, but the brief facts of the case are as follows. In 1984, Andy Warhol made sixteen portraits of the musician Prince, under commission with *Vanity Fair* for an article about the musician. Warhol used, with permission, Goldsmith's unpublished 1981 photograph of Prince as a reference for his portraits. *Vanity Fair* paid Goldsmith and Warhol for their contributions and published one of the sixteen Warhol prints—the *Purple Prince*—in the magazine. It is unclear if *Vanity Fair* knew there were sixteen prints or if Warhol only offered one. Goldsmith was credited with the source photo and Warhol was credited as the portrait artist.[9]

In 2016, after Prince's death, Condé Nast (which owns *Vanity Fair*[10]) requested another portrait from the Andy Warhol Foundation ("AWF") for a special edition about the musician. AWF offered *Orange Prince*, also made in 1984 as part of the earlier commissioned project.[11] When Condé Nast published *Orange Prince*, this time on the cover of the magazine, Goldsmith recognized her photo as a reference for the cover art and contacted AWF.[12] In her correspondence, she alleged that all of the Warhol Prince portraits in the *Prince Series* that used her photograph as a reference, except the *Purple Prince* published in 1984, infringed her photograph and could not be copied, distributed, or displayed without her permission. AWF refused to concede this point and filed a declaratory judgment action of noninfringement against Goldsmith.[13]

The procedural and substantive legal proceedings are thoroughly described by Professor Pamela Samuelson's excellent contribution to the 2023 Kernochan Center for Law, Media and the Arts' Symposium.[14] As they pertain to our Article, they will be discussed in more detail below. But central to this Article's focus is that the courts below wrestled in opposite ways with the aesthetic features of Warhol's *Prince Series* (and *Orange Prince* in particular) to determine whether Warhol prepared derivative works or otherwise transformed Goldsmith's photo into something new. The district court found fair use, considering evidence and expert testimony about how Warhol's *Prince Series* works are significantly different from Goldsmith's photograph. And the Court of Appeals for the Second Circuit rejected that evidence as beyond the capacity of a court's competence and creating a "celebrity-plagiarist privilege."[15]

9. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 514–22.
10. *Id.* at 519.
11. *Id.* at 519–520.
12. *Id.* at 522.
13. *Id.* at 522, 534.
14. *See* Pamela Samuelson, *Did the Solicitor General Hijack the* Warhol v. Goldsmith *Case?*, 47 COLUM. J.L. & ARTS 513 (2024).
15. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 43 (2d Cir. 2021).

The Supreme Court largely ignored those discussions, leaving the determination of derivative works and fair use substantially less clear than before. This Article hopes to bring a measure of clarity to the Supreme Court's decision by relying on the history of "use of artist references" and evidence from contemporary photographic practice. The Article also explains that aesthetic determinations are integral to determining whether a derivative work or a fair use has been made and that the Supreme Court's allergy to judging art is an excuse for avoiding the hard issues the case initially presented and that have not yet been resolved.[16]

The Supreme Court's decision in *Warhol* creates more problems than it solves. Importantly, it does not clarify the confusing decision of the Court of Appeals for the Second Circuit and instead answers a question that was not expressly presented to the Supreme Court: whether AWF should have requested permission and paid Goldsmith for Condé Nast's use of *Orange Prince* on the special edition cover in 2016. Notably, this is distinct from the question of whether *Orange Prince*—as a work in and of itself and when it was created—is a fair use of Goldsmith's photograph. The latter question was not answered except in the context of *Orange Prince*'s publication on the Condé Nast cover. This Article develops an answer to that important question, cabining the Court's holding in *Warhol* to the specific and unusual factual situation presented.

Without limiting *Warhol* to its facts, the Supreme Court decision appears to narrow the "transformative use" test without overruling it, as well as establish a use-by-use fair use assessment of otherwise lawfully made works, which would be the first explicit articulation of such a rule. It thus leaves lower courts and future parties in an uncomfortable state of uncertainty as to the scope and application of fair use. The Court appears (without being explicit) to confine its decision to circumstances in which an agreement to prepare a derivative work exists between the parties. It does so by misconstruing the 1984 agreement between *Vanity Fair* and Lynn Goldsmith as a license that effectively bound Andy Warhol to prepare a derivative work from Goldsmith's photograph for a single purpose (publication in the 1984 magazine and nowhere else). But, as we show, that is not what an agreement for "use as an artist reference" necessarily means. Based on evidence from history, contemporary photographic practice, and relevant case law on photographic references for secondary works, this Article corrects the erroneous assumptions in *Warhol* in order to properly guide its future application.

The Article proceeds in three parts. Part I briefly describes the rulings below: the district court finding fair use and the Court of Appeals for the Second Circuit finding no fair use and therefore infringement. It further describes a handful of lower court cases in which use of a photograph to produce a secondary work was assessed under

16. Professor Amy Adler has discussed the irrelevance of aesthetic determinations in judging the value and significance of art. *See* Amy Adler, *Why Art Does Not Need Copyright*, 86 GEO. WASH. L. REV. 313, 359 (2018) ("Not only does [an 'aesthetics' test] embroil judges in an inquiry for which they are distinctly ill suited, but also it injects a troubling term—'aesthetics'—into the center of fair use." (footnote omitted)). While we appreciate her expertise on how the fine art markets have operated, we believe that some degree of aesthetic analysis is foundational to the courts' ability to offer sound legal analysis on copyright law questions.

infringement analysis and/or the fair use factors in ways that differ from what occurred here. In many cases, the photographers' concern was reproduction—use of the photograph as an exact or near-exact copy. That makes sense, we point out, because the copyright statute and its legislative history circumscribe the scope of derivative works to enumerated adaptations and versions, not copies. Courts decide many photography copyright cases on fair use grounds—largely, though not exclusively, on the basis of the first factor. What is notable is the degree of aesthetic evaluation they engage in as part of the process, including the attention they pay to the context of the secondary use. The judgments are careful and measured—they do not contain any reflexive notion that use of a photograph to create a subsequent work of art is always infringement. We argue in Part I that courts should continue with that careful practice, *Warhol* notwithstanding.

This case law aligns with the evidence in Parts II and III. Part II describes the history of photographic "use as an artist reference" and how artists and photographers embraced that practice, as old as photography, for the purposes of making more art that is usually (but not always) different from the photograph and for which the photograph was an essential input. The *Warhol* majority ignored this history, distorting the legal effect of Warhol's use of Goldsmith's photograph as a reference for his paintings. Part III describes data from interviews with contemporary photographers about their tolerance for and resistance to unauthorized uses of their photographs. Photographers explain that what matters to them is what the new use looks like and what it is for—resonating with the "purpose and character" language of § 107(1) of the Copyright Act and requiring aesthetic evaluation of the new work. Photographers' explanations of permitted versus unpermitted uses may not always align with copyright's fair use doctrine (especially because photographers tend to object to critical uses). But, photographers' attention to aesthetic evaluation—as essential to distinguishing between permitted and unpermitted uses—undermines *Warhol*'s interpretation of fair use factor one as focusing only on "purpose" and ignoring the new work's "character." Part III ends with what should have happened in *Warhol* given the fuller context of "use as an artist reference" in history and practice.

I. LEGAL AND FACTUAL PRECEDENT

A. THE FACTS

In 1984, Andy Warhol made sixteen portraits of the musician Prince, under commission with *Vanity Fair*, for an article about the musician (the "*Prince Series*"). *Vanity Fair* sourced a photograph for the Warhol commission from Lynn Goldsmith's agency.[17]

17. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 517.

Figure 1: Goldsmith's photograph (left); Warhol's portraits (right)

The original transaction between Lynn Goldsmith and *Vanity Fair* was for an "artist reference" and was memorialized in an invoice dated October 29, 1984 (the "VF Invoice"). The VF Invoice described granting *Vanity Fair* the right to

> USE . . . ONE PHOTOGRAPH OF PRINCE, COPYRIGHT 1981 LYNN GOLDSMITH FOR USE AS ARTIST REFERENCE FOR AN ILLUSTRATION TO BE PUBLISHED IN VANITY FAIR NOVEMBER 1984 ISSUE. IT CAN APPEAR ONE TIME FULL PAGE AND ONE TIME UNDER ONE QUARTER PAGE. NO OTHER USAGE RIGHTS GRANTED. ONE TIME ENGLISH LANGUAGE ONLY NORTH AMERICAN DISTRIBUTION ONLY. License is granted to use ~~or reproduce~~ above-described photograph(s) on condition that total amount shown hereon is paid. The credit line—LYNN GOLDSMITH—must not be omitted, abbreviated or altered under penalty of double charge. Released, on rental basis only, and in accordance with terms and conditions of submission. License, for one reproduction only, is granted to reproduce above-described photograph(s) in IN [sic] VANITY FAIR NOVEMBER 1984 ISSUE.[18]

Goldsmith was to receive $400 for this use and source credit.[19] This invoice was preceded by an approval form, dated September 25, 1984, sent on behalf of Goldsmith to *Vanity Fair* that stated "11" x 14" B&W studio portrait of Prince by © 1981 Lynn

18. Joint Appendix – Volume I at 85–86, *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. 508 (No. 21-869) (strikethrough in original). The significance of the strikethrough of "reproduce" was not elaborated in the litigation, but it is our contention that "use" is different than "reproduce" for the purposes of understanding the practice of "use as an artist reference."

19. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 517.

Goldsmith for possible use as an artist reference."[20] *Vanity Fair* paid Goldsmith and published one of the sixteen Warhol prints—*Purple Prince*—in the magazine.

Better the sexual depravities of Prince than the sexual deprivations of Michael Jackson, declares TRISTAN VOX. Plus a special portrait for *Vanity Fair* by ANDY WARHOL

A few days after Mary Lou Retton won a gold medal at the Los Angeles Olympics, she appeared on *The Tonight Show* before Joan Rivers, who was swaddled in taffeta. The terrorizer asked the cherub about her new prosperity. The cherub replied that she was the proud owner of a new car. "A little red Corvette," she exclaimed, with the most wholesome smile in the world. Suddenly one was filled with alarm. Had American popular culture played a dirty trick on Mary Lou? It had, if her reference was to Prince. "Little Red Corvette," you see, is a ballad of broken hearts and dirty condoms which Prince recorded a few years ago. "You're the kinda person / That believes in makin out once / Love 'em and leave 'em fast / I guess I must be dumb / Cuz U had a pocket full of horses / Trojan and some of them used / But it was Saturday night / I guess that makes it alright. . . ."

Who kindles to such sentiments, and who does not, is not the point. The point is that escape from Prince is no longer possible. Finally he has arrived. The evidence is everywhere. The masses are good. His music is some of the tightest and most turnid rock 'n' roll ever made. The movie *Purple Rain* is a crude minor classic, an American successor to *The Harder They Come*. The myths are all the mighty ones: young rebel, lonely artist, battered child, mysterious stranger. There is even a motorcycle. From Minneapolis, Minnesota, there comes another tough but tender, violent but vulnerable American hero.

Well, not quite. Look again. "Rude Boy," he calls himself. The name suits. He dresses as a dandy or as a stud; in gloves and ruffles and a long lurid purple doublet, or in a sloping black codpiece and a cross. He poses against a backdrop of bedsprings, or shining ready on a bed. He sings, in a kind of filthy falsetto, about sexual climax ("... I wanna be your lover / I wanna be the only one that makes you come. . . running"), sexual confusion ("Bambi can't you understand? / Bambi it's better with a man"), sexual cross-dressing ("When you were mine / I used to let you wear all my clothes"), and sexual combinations ("I never was the kind to make a fuss / When he was there / Sleepin between the two of us"). There are odes to onanism, lots of them; and onstage he sometimes writhes, tossing and turning on the hard black amplifiers, until the convulsions conclude with what used to be called, when Nijinsky did it at the end of *L'Après-midi d'un Faune*, an autoerotic movement. Indeed, he looks rather like a faun—lithe body, satin skin, trembling lips—until you see the eyes, and the mustache that has not grown in, and the gait. They are cold and they are mean.

Is this course creature really the favorite of American popular culture? Wait until Jerry Falwell hears. There will be hell to pay; and the repulsive reverend might have a point. In fact, the protests have already begun—from liberals, who generally find out about the fun first. There are murmurings about misogyny. Prince, it is said, hates women. No doubt he does; the sexual style he exemplifies is primarily an expression of anger. In his music, women are had against their will. In his movie, they are beaten and tossed into the trash. (This is not the Minneapolis of Mary Tyler Moore.) There is no doubt, if it is the politics of culture that you want, that this inner-city satyr is a perfect star for the great era of American reaction that is upon us. The re-objectification of women that John Travolta began on the backseat of a car in *Saturday Night Fever* has, well, climaxed in the songs and the scenes of Prince.

But leave politics; too much politics and there is no mind for pleasure. Anyway, the path to pleasure is frequently not pretty. One woman's misogynist may be the image of another woman's desire. And men have been known to hunger for those who hate them, too. There is a measure of spiritual authenticity in sleaze. Better the low than the level. Better the sexual depravities of Prince than the sexual deprivations of Michael Jackson. (Prince will never find fans among parents.) His single-mindedness about sex means that he is serious about *(Continued on page 120)*

PURPLE FAME

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Figure 2: As published in *Vanity Fair*, November 1984

It is unclear if *Vanity Fair* knew there were sixteen prints or if Warhol only offered one. Goldsmith was credited with the source photo and Warhol was credited as the portrait artist.[21]

In 2016, after Prince's death, Condé Nast asked AWF for permission to run *Purple Prince* on the cover of a commemorative magazine issue, and learned AWF had other images from the 1984 *Prince Series*.[22] AWF offered Condé Nast *Orange Prince* and Condé Nast paid $10,000 for that use.[23]

20. Joint Appendix – Volume I, *supra* note 18, at 146.

21. Joint Appendix – Volume I, *supra* note 18, at 324-25 ("The article's attribution credits stated it featured 'a special portrait for *Vanity Fair* by ANDY WARHOL.'").

22. The Second Circuit describes the exchange like this: "On April 22, 2016, the day after Prince died, Condé Nast, Vanity Fair's parent company, contacted AWF. Its initial intent in doing so was to determine whether AWF still had the 1984 image, which Condé Nast hoped to use in connection with a planned magazine commemorating Prince's life. After learning that AWF had additional images from the Prince Series, Condé Nast ultimately obtained a commercial license, to be exclusive for three months, for a different Prince Series image for the cover of the planned tribute magazine." Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 35 (2d Cir. 2021).

23. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 520.

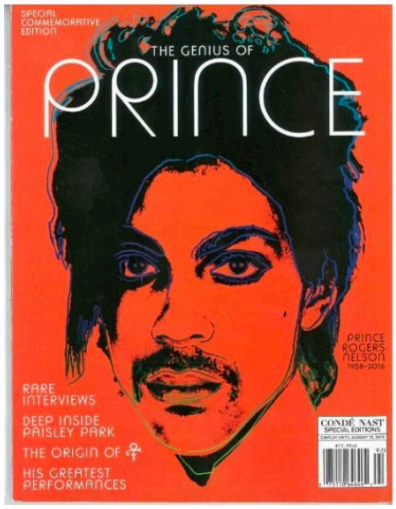

Figure 3: As published by Condé Nast, May 2016

No one checked with Goldsmith that time, neither AWF nor Condé Nast. Why? Presumably because once Warhol made the *Prince Series* as part of his work for *Vanity Fair* in 1984, Warhol's use of Goldsmith's photograph as an artist reference was complete. What remained were the sixteen Warhols, which subsequently were sold and distributed to private collectors and museums (and copies eventually licensed by AWF). Whether Condé Nast's failure to also ask Goldsmith's permission to use Warhol's *Orange Prince* in 2016 on the commemorative magazine cover violated the Copyright Act was not even a question presented to the Supreme Court in *Warhol*.

Goldsmith threatened to sue only Warhol, not Condé Nast, which muddied the Court's analysis of the issues, to say the least.[24] Untangling the issues requires focusing on an embedded question, initially part of Goldsmith's counterclaim against AWF: that all sixteen prints in the *Prince Series* infringe her photograph.[25] Goldsmith eventually

24. The case was initially filed as a declaratory judgment action by AWF with a countersuit by Goldsmith. Condé Nast was never brought into the lawsuit. The doctrinal muddle created by Goldsmith threatening only Warhol, and not bringing Condé Nast into the lawsuit, is well described in Peter Karol, *What's the Use? The Structural Flaw Undermining* Warhol v. Goldsmith, J. COPYRIGHT SOC'Y (forthcoming 2024).

25. Goldsmith abandoned her claims about the lawfulness of the *Prince Series* as created in 1984 by the time she got to the Supreme Court. *See Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 534 n.9 (citing to Goldsmith's brief and to her counsel's statements at oral argument). Indeed, Goldsmith's brief to the Supreme Court suggests that all sixteen works may have been created under a license. Brief for Respondents at 36–37, *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. 508 (No. 21-869) ("The Copyright Act also protects museum displays if displayed works were 'lawfully made.' 17 U.S.C. § 109(c). Here, the creation of the Prince Series is not at issue because the only alleged infringement involves the 2016 magazine licensing of Orange Prince. And the circumstances of the Prince Series' creation remain obscure. For instance, it is unclear whether Warhol created the Prince Series so *Vanity Fair* could pick the image it liked best—in which

dropped this broader claim but not until oral argument before the Supreme Court, narrowing the issue for the Court to the use of *Orange Prince* on the magazine cover. But the significance of use as an "artist reference" in 1984 remains central to both the broad and narrow claims of copyright infringement.

In its decision, the Supreme Court articulated two ways portrait photographers license their works. One way, "[a] typical use," is when a photographer licenses a photo "to accompany stories about the celebrity, often in magazines."[26] The other way is more attenuated and is at the heart of the case itself: "A photographer may also license her creative work to serve as a reference for an artist, like Goldsmith did in 1984 when Vanity Fair wanted an image of Prince created by Warhol to illustrate an article about Prince." [27] As to the latter way, the Court was persuaded by Goldsmith's "'uncontroverted' evidence 'that photographers generally license others to create stylized derivatives of their work in the vein of the Prince Series.'"[28] The Court stated that "[s]uch licenses, for photographs or derivatives of them, are how photographers like Goldsmith make a living."[29]

This is a factual mistake. And it turns a ubiquitous, varied, and century-old artistic practice of "use as an artist reference" into a reified legal concept of "derivative work" without basis or context.[30] Although the legal issue eventually decided by the Supreme Court was not about infringement and only about application of fair use (specifically, § 107(1) alone), the Court's statement of facts seemed to suggest that the right transgressed—and for which the possibility of fair use was now to be evaluated—was

case the Prince Series might have been 'lawfully made' under Vanity Fair's license."). This concession makes the final disposition at the Supreme Court all the more mysterious because it would seem that the *Prince Series* consists of lawfully made works. *See* Samuelson, *supra* note 14, at 540. That *Orange Prince* may have been licensed unlawfully to Condé Nast in 2016 suggests that some *uses* of works in which copyright lawfully persists (Warhol's original art, the *Prince Series*) are nonetheless unlawful. This is an innovation in copyright law heretofore unknown, unless there is an antecedent contract specifically limiting subsequent uses of the otherwise lawfully made works created pursuant to the contract. *Cf.* Schrock v. Learning Curve Int'l, Inc., 586 F.3d 513, 524 (7th Cir. 2009) ("[B]ecause the owner of a copyrighted work has the exclusive right to control the preparation of derivative works, the owner could limit the derivative-work author's intellectual-property rights in the contract, license, or agreement that authorized the production of the derivative work."). In *Warhol*, that returns us to the interpretation of the VF Invoice. Our research suggests "use as an artist reference" does not tether the use of the subsequent work by its author to the photograph in any hierarchical or subservient way if the new work was made with permission by the reference author. From AWF's perspective, the new work is unencumbered by the photograph to which it referenced.

26. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 534.

27. *Id.* at 535. Obviously, there are many other ways portrait photographers license their images or otherwise make a living through portrait photography. *See, e.g.*, Silbey et al., *supra* note 6, at 277–301 (describing diverse business methods for photographers to earn a living from their work).

28. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 535 (quoting Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 50 (2d Cir. 2021)). More on this below in Part II.

29. *Id.* at 535. Goldsmith self-identifies as a celebrity portrait photographer, Joint Appendix – Volume II at 310, *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. 508 (No. 21-869), not simply a portrait photographer who earns a living making portrait photographs for anyone. The licensing opportunities for the former are obviously more abundant than for the latter.

30. *See infra* Part II.

the derivative work right born from the "use as an artist reference."[31] Indeed, one might predict that, going forward, the Court's language will be used to establish that use of an "artist reference for an illustration"[32] produces a quintessential type of derivative work that falls squarely within a photographer's bundle of § 106 rights.[33] That would be a mistake of law, as we describe below in Part III.C.

B. PROCEEDINGS BELOW

As mentioned, Professor Samuelson's companion article in this Symposium Issue comprehensively reviews the proceedings at all three levels in *Warhol*, and so here we highlight only those aspects relevant to our argument.

With respect to the district court, it sidestepped an in-depth discussion of infringement (of the derivative work right or otherwise) because it held that it "is plain that the Prince Series works are protected by fair use."[34] Nevertheless, in the lead-up to that judicial determination, the district court laid a trail of bread crumbs through the relevant infringement precedents and frameworks firmly grounded in the reproduction right analysis and no other.[35] Indeed, it would have been odd for the district court—had it decided to determine the infringement question—to have focused on any exclusive right other than the reproduction right because it said nothing about the other exclusive rights, including about the right to prepare derivative works.

The Second Circuit followed suit. It approached the issue as a reproduction right violation with no reference to the right to prepare derivative works.[36] To be sure, the appellate court's infringement analysis appeared at the end of a very long opinion rejecting fair use.[37] The court appeared to offer this eleventh-hour analysis, as an alternate to its fair use decision, in response to AWF's alternative claim that "the Prince Series works are not substantially similar to the Goldsmith Photograph."[38] Nonetheless, the appellate court's conclusion stated that far from an adaptation, Warhol's *Prince Series*

31. The Court frames the issue as whether the right to prepare a derivative work was infringed presumably because it was relying on the permission to "use as [an] artist reference" as evidence that a derivative work (an "adaptation" or "art reproduction") was prepared, 17 U.S.C. § 101 (defining derivative work), but the Court's statement of proceedings below describe both substantial similarity and derivative work claims. *See Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 525 ("AWF does not challenge the Court of Appeals' holding that Goldsmith's photograph and the Prince Series works are substantially similar.").

32. *See Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 517.

33. *Id.* at 535 (stating that the bundle "provide[s] an economic incentive to create original works, which is the goal of copyright").

34. *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 382 F. Supp. 3d 312, 324 (S.D.N.Y. 2019). It is common for a trial court to assume for purposes of a fair use determination—and without waiving defendant's opportunity to argue otherwise—that infringement exists, but the exemption of fair use nonetheless applies.

35. *Id.* at 323–24.

36. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 52–54 (2d Cir. 2021).

37. *Id.*

38. *Id.* at 52.

contained an "exact reproduction" of the Goldsmith photo.[39] This framework is not surprising within the context of the Second Circuit's opinion because earlier in the course of its fair use analysis, the court specifically avoided deciding the question of whether Warhol's *Prince Series* works are derivative works:

> Nonetheless, although we do not conclude that the Prince Series works are necessarily *derivative* works as a matter of law, they are much closer to presenting the same work in a different form, that form being a high-contrast screenprint, than they are to being works that make a transformative use of the original.[40]

This refusal by the Second Circuit to commit to a position on the derivative work status *vel non* of the *Prince Series* works is curious because the opinion repeatedly juxtaposes the application of the fair use factors (especially factors one and four) against the right to prepare derivative works.[41] The court comes right up to the line, criticizing "the district court [for] entirely overlook[ing] the potential harm to Goldsmith's derivative market, which is likewise substantial,"[42] but abstains from a clear or firm conclusion regarding whether Warhol's *Prince Series* violates both § 106(1) and § 106(2). It reversed only the district court's application of the fair use factors and remanded (absent appeal) for reconsideration in light of its rearticulated standard.[43]

On the fair use question itself under § 107, the Second Circuit issued a controversial decision rejecting the district court's factual findings of aesthetic transformation in the context of fair use's first factor, and narrowing the "transformative use" test to questions of similar genres or markets rather than to the secondary work's meaning and

39. *Id.* at 54 (distinguishing cases in which "the secondary users in those cases did not merely *copy* the original photographs at issue; they instead replicated th[e] photographs using their own subjects in similar poses" (emphasis added)). The court noted further, "By contrast, Warhol did not create the Prince Series by taking his own photograph of Prince in a similar pose as in the Goldsmith Photograph. Nor did he attempt to copy merely the 'idea' conveyed in the Goldsmith Photograph. Rather, he produced the Prince Series works by *copying* the Goldsmith Photograph itself—*i.e.*, Goldsmith's particular expression of that idea." *Id.* (emphasis added). To hammer the point home, the court concluded, "This is not to say that every use of an *exact reproduction* constitutes a work that is substantially similar to the original. But here, given the degree to which Goldsmith's work remains recognizable within Warhol's, there can be no reasonable debate that the works are substantially similar." *Id.* (emphasis added).

40. *Id.* at 43 (emphasis in original); *see also id.* at 44 ("And our conclusion that those images are closer to what the law deems 'derivative' (and not 'transformative') does not imply that the Prince Series (or Warhol's art more broadly) is 'derivative,' in the pejorative artistic sense, of Goldsmith's work or of anyone else's.").

41. *See, e.g.*, *id.* at 39, 43.

42. *Id.* at 50.

43. *See* Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 598 U.S. 508, 535 (2023). The Supreme Court did not exercise such restraint. Instead, it repeated the Second Circuit's zero-sum analysis relating the existence of a derivative work with the absence of a transformative use. And then the Supreme Court went further: It stated that Warhol's art was, in fact, a "stylized derivative[]" of Goldsmith's photo. *Id.* In Part II below, we describe further the faulty basis of the Court's determination and the errors that flow from it.

message.[44] The transformative use test, announced first by the Supreme Court in *Campbell v. Acuff-Rose Music, Inc.*, holds that the more the second work transforms the first work—in purpose and character—the more likely the first fair use factor favors the second work.

> Under the first of the four § 107 factors, the purpose and character of the use, including whether such use is of a commercial nature . . . the enquiry focuses on whether the new work merely supersedes the objects of the original creation, or whether and to what extent it is 'transformative,' altering the original with new expression, meaning, or message. 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.[45]

The appellate court justified its decision finding insufficiently transformed meaning or message for purposes of the first fair use factor by critiquing the district court's reliance on Warhol's artistic style as the source of the aesthetic transformation. It concluded that "the Prince Series retains the essential elements of its source material, and . . . the Goldsmith Photograph remains the recognizable foundation upon which the Prince Series is built."[46]

In doing so, the appellate court seemed to talk out both sides of its mouth. It cited copyright's aesthetic non-discrimination principle as the basis for the district court's error interpreting Warhol's art as different in meaning and message from Goldsmith's photograph.[47] And then it also conducted its own aesthetic analysis comparing the two works and finding insufficient aesthetic differences. The court said that the two works are both works of visual art and portraits of the same person, and that despite "the distinct aesthetic sensibility that many would immediately associate with Warhol's signature style—the elements of which are absent from the Goldsmith photo," the *Prince Series* "is not 'transformative' within the meaning of the first factor."[48] The Second Circuit's application of the aesthetic non-discrimination principle, its fair use analysis, and its rejection of the district court's findings of new expression, meaning, and message work profound shifts in copyright law and are contrary to milestone Supreme Court decisions, including those as recent as 2021.

The Supreme Court granted certiorari to resolve the issue—or so it had seemed. Specifically, the question presented on which the Court granted cert was published as follows:

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44. *Andy Warhol Found. for Visual Arts, Inc.*, 11 F.4th at 40 (pointing, for example, to the fact that "at least at a high level of generality, [the two works] share the same overarching purpose (*i.e.*, to serve as works of visual art)").

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

46. *Andy Warhol Found. for the Visual Arts, Inc.*, 11 F.4th at 43.

47. *Id.* at 41–42 ("[T]he district judge should not assume the role of art critic and seek to ascertain the intent behind or meaning of the works at issue. That is so both because judges are typically unsuited to make aesthetic judgments and because such perceptions are inherently subjective.").

48. *Id.* at 42.

> This Court has repeatedly made clear that a work of art is "transformative" for purposes of fair use under the Copyright Act if it conveys a different "meaning or message" from its source material. Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 579 (1994); Google LLC v. Oracle Am., Inc., 141 8. Ct. 1183, 1202 (2021). In the decision below, the Second Circuit nonetheless held that a court is in fact forbidden from trying to "ascertain the intent behind or meaning of the works at issue." App. 22a-23a. Instead, the court concluded that even where a new work indisputably conveys a distinct meaning or message, the work is not transformative if it "recognizably deriv[es] from, and retain[s] the essential elements of, its source material." Id. at 24a.
>
> The question presented is:
>
> Whether a work of art is "transformative" when it conveys a different meaning or message from its source material (as this Court, the Ninth Circuit, and other courts of appeals have held), or whether a court is forbidden from considering the meaning of the accused work where it "recognizably deriv[es] from" its source material (as the Second Circuit has held).[49]

The Supreme Court failed to resolve this question and instead issued an opinion expanding the scope of derivative works on the basis of a misunderstanding about "use as an artist reference." We return to this flawed analysis in Part III.

C. A SHORT HISTORY OF PHOTOGRAPHY COPYRIGHT CASE LAW

Photography cases from the past several decades—specifically, those that are natural ancestor precedents for *Warhol*—have not always invoked the derivative work right in the ways suggested by the Court's reasoning in *Warhol*. While a full account of such litigation is beyond the scope of this Article, we highlight here some notable cases to demonstrate *Warhol*'s unorthodox reasoning regarding the relevance of "use of an artist reference" to the derivative work right and how unnecessary that aspect is in the context of similar cases.

First, a preliminary note. As discussed above,[50] because the district court decided the case on fair use grounds without deciding infringement, the issue of infringement was not squarely presented or decided. Both the district court and the court of appeals mostly analyzed the application of fair use, although, as previously mentioned, in both decisions some discussion was devoted to infringement of the reproduction right (under the "substantial similarity" test). When the Supreme Court decided the case, it remained a fair use case, but the assumption in *Warhol* appeared to be that Warhol infringed Goldsmith's right to prepare derivative works largely because of the agreement for her photo to "serve as an artist reference."[51]

49. Petition for a Writ of Certiorari at i, *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 598 U.S. 508 (2023) (No. 21-869) (alterations in original).

50. *See supra* Part I.B.

51. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 520. As we mentioned *supra* note 3, our analysis of the relevance of "use of an artist reference" remains the same whether the new work produced is accused of being a "substantially similar copy" or a "derivative work."

For our purposes in this Article, the shift in analysis from an unlawful copy to an unlawful derivative work is significant because the Court appears ready to assume the latter (without analysis) thanks alone to Goldsmith's permission to "use [her photograph] as [an] artist reference." With the discussion of cases that follow and the history and uses of artist references in Parts II and III, we hope to complicate that assumption and reorient the infringement analysis as one that compares the aesthetics of the two works—either as a substantially similar copy or as a derivative work (or as neither)—informed by the statutory definition and case law. An assumption that the derivative work right has been infringed without factual and legal analysis ignores the independence of the derivative work as an exclusive right grounded in a statutory definition and informed by relevant case law and history.[52] And the same assumption has direct implications on the correct application of fair use factors one and four, whereby the nature of the transformation of the work (its "purpose and character") and the existence of a distinct market for the new work as altered become centrally relevant. In other words, the fair use analysis would arguably proceed differently on these two important factors with more clarity on the existence and scope of the derivative work at issue.

Of course, whether the reproduction right and right to prepare derivative works are meaningfully distinct has been the subject of sustained analysis.[53] Most commentators agree that while the rights overlap, their separate enumeration and evidence from the legislative history indicate their independence. A violation of one (e.g., the right to make copies) does not necessarily mean a violation of the other (e.g., the right to prepare derivative works), and vice versa.[54] Moreover, the legislative history to the 1976 Act does not mention "derivative works," only "versions" and "adaptations,"[55] indicating an intention to capture in the author's exclusive right to prepare derivative

52. To be sure, 17 U.S.C. § 106(1) and 106(2) may and often do overlap. *See supra* notes 3, 50–51; *infra* note 53. But the breadth of the derivative work right and its confusion with a fair use that is a "transformative work" make the need for disentanglement all the more vital. As *Warhol* explained: "As most copying has some further purpose and many secondary works add something new, the first [fair use] factor asks 'whether *and to what extent*' the use at issue has a purpose or character different from the original. . . . The larger the difference, the more likely the first factor weighs in favor of fair use. A use that has a further purpose or different character is said to be 'transformative,' but that too is a matter of degree. . . . To preserve the copyright owner's right to prepare derivative works, defined in § 101 of the Copyright Act to include 'any other form in which a work may be recast, transformed, or adapted,' the degree of transformation required to make 'transformative' use of an original work must go beyond that required to qualify as a derivative." *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 510 (emphasis in original) (citations omitted).

53. *See e.g.*, Pamela Samuelson, *The Quest for a Sound Conception of Copyright's Derivative Work Right*, 101 GEO. L.J. 1505 (2013); Daniel Gervais, *The Derivative Right, or Why Copyright Law Protects Foxes Better Than Hedgehogs*, 15 VAND. J. ENT. & TECH. L. 785, 805 (2013).

54. *But see* MELVILLE B. NIMMER & DAVID NIMMER, 2 NIMMER ON COPYRIGHT § 8.09[A][1] ("[I]f the right to make derivative works, *i.e.*, the adaptation right, has been infringed, then there is necessarily also an infringement of either the reproduction or performance right.").

55. *See, e.g.*, H. COMM. ON THE JUDICIARY, 87TH CONG., COPYRIGHT LAW REVISION, REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 22 (1961) (stating the "right to make new versions," including "translations, adaptations").

works certain targeted "reuses of protected works"[56] that were of concern to the copyright industries engaging in the legislative reform. Eventually, these targeted adaptations or versions were enumerated in the nine exemplary derivatives contained in the statutory definition of a derivative work and, as Professor Pamela Samuelson has argued, also include the exemplars' "close analogues."[57] This is to say that what is and infringes as a "derivative work" is not always the same as what is or infringes as a "copy" under the reproduction right. And keeping in mind these separate two categories and their analyses—and the purposes for their independence—can help clarify the relevance of the evidence in the infringement case and the ultimate determination of the scope of protection, liability, and strength of defenses.

For our purposes, the distinction between the reproduction right and the right to prepare derivative works is in the kind of analysis necessary to find (1) infringement and (2) existence of fair use, especially for factor one's assessment of "purpose and character" and factor four's assessment of market harm. Whether the second work is a "substantially similar copy" put to a different purpose or, alternatively, a new version of the first work with a different "character" demands aesthetic and contextual analysis that relies on distinct facts and expertise. Arguably, Goldsmith could have prevailed following either path, but the fair use analysis for a violation of the reproduction right would have relied on different facts and analyses: proving that *Orange Prince* was a substantially similar copy of Goldsmith's photograph, and that an ordinary observer not setting out to notice differences would mostly see their similarities.[58] The first fair use factor would then be easy for Goldsmith, because the two images would have been determined to be substantially the same and, at least for licensing to magazines to illustrate a story about Prince, the two works would therefore be substitutable.

But if Warhol's art is arguably a derivative work—an adaptation or new version of the Goldsmith photo—the nature and purposes of Warhol's changes would affect whether Warhol produced a derivative work as enumerated within the definitional nine categories or their close analogues. Similarly, if the changes Warhol made to the image's purpose and character are so far transformed ("with new expression, meaning, or message"[59]), fair use's first factor would lean in Warhol's favor and away from infringement liability. This predicate determination of a derivative work would also affect the fair use analysis under factor four, which asks not only about aesthetic and

56. Gervais, *supra* note 53, at 800.

57. Samuelson, *supra* note 53, at 1509.

58. *See, e.g.*, Peter F. Gaito Architecture, LLC v. Simone Dev. Corp., 602 F.3d 57, 66 (2d Cir. 2010) ("The standard test for substantial similarity between two items is whether an 'ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard [the] aesthetic appeal as the same.'" (alteration in original) (citations omitted)). Sometimes an analogous test is posed. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 53 (2d Cir. 2021) ("In general, and as applicable here, two works are substantially similar when 'an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.'" (citations omitted)).

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

purposive transformation but also about foreseeable derivative markets for the altered work, a potentially harder factual proffer than with substantially similar copies.[60]

What facts did *Warhol* rely upon to determine that *Orange Prince* was a derivative work other than Goldsmith's permission to provide her photograph as an "artist reference" for Warhol? What facts support such a finding absent the agreement between Goldsmith and *Vanity Fair*? What makes the *Orange Prince* a derivative work (and not a substantially similar copy) that demands a special kind of treatment when subject to the fair use factors? And what about all the other works in the *Prince Series* that may have different characters and purposes?

The *Warhol* Court provided no answer to these questions and only conclusory assessments about the role of derivative works in the photography business and the prominence of licensing photographs in news media.[61] And that thin reasoning does not help establish that Warhol's work is a derivative work as defined by statute and case law. If the Court's reason for so concluding is based only on Goldsmith's permission for Warhol to "use [her photograph] as [an] artist reference," we assert this is insufficient as a matter of fact and law. More broadly, we think that the simple formula that "use as an artist reference" always creates a "derivative work" is not consistent with the case law, the history of the right to prepare derivative works, or its implication for the fair use analysis.

60. Markets for substantially similar copies are often presumed, unless the uses reflect the statutory preamble, such as for criticism, commentary, news reporting, education, scholarship, or research. 17 U.S.C. § 107. *But see Campbell*, 510 U.S. at 591 ("No 'presumption' or inference of market harm that might find support in *Sony* is applicable to a case involving something beyond mere duplication for commercial purposes.").

61. *See* discussion of these facts, *infra* Parts II and III.

For example, in *Reece v. Island Treasures Art Gallery, Inc.*, a case from 2006, a photographer brought an action for copyright infringement of his "sepia tone image of a woman kneeling in the beach shorebreak, performing in the hula kahiko tradition with the shoreline in the distant background."[62] He sued an art gallery for publicly displaying a stained-glass version of his photograph. Here are the relevant works:

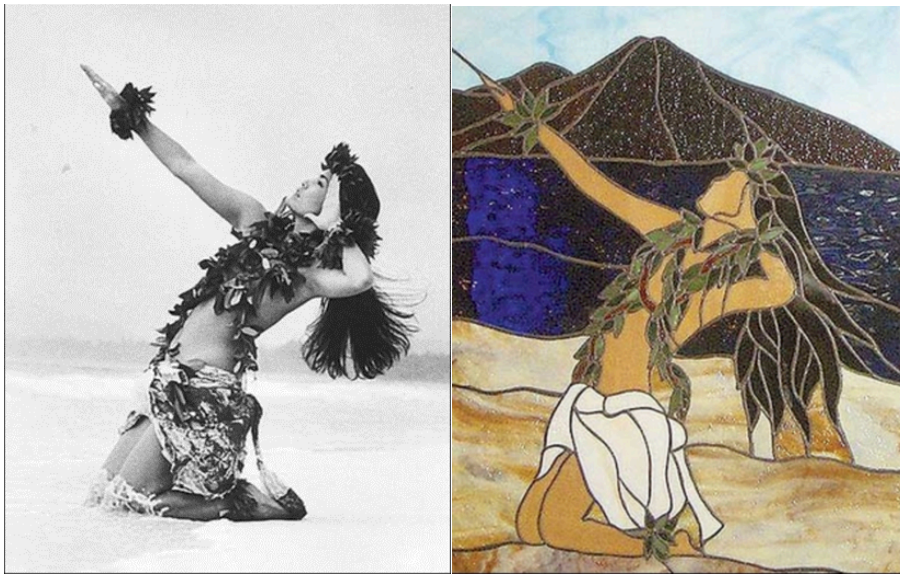

Figure 4: Kim Taylor Reece, *Makanani* (left); Marylee Leialoha Colucci, *Nohe* (right)[63]

The case was framed as a simple reproduction right violation: The plaintiff had argued that the stained-glass work was "a virtually identical copy of" plaintiff's photograph.[64] And the court decided the case purely on reproduction right violation principles, finding—after a substantial comparison of the two works[65]—that they were not substantially similar, let alone that any derivative work right had been violated.[66]

In a more recent case, *Laspata DeCaro Studio Co[r]poration v. Rimowa GmbH*, a creative marketing agency's photos "evoking Hollywood in the 1920s" were used without its permission as "reference photographs" for an "advertising campaign and lookbook" for

62. Reece v. Island Treasures Art Gallery, Inc., 468 F. Supp. 2d 1197, 1200 (D. Haw. 2006).

63. *Id.*

64. *Id.* at 1201. Indeed, this language is a direct quote from the plaintiff's complaint, which nowhere mentioned the derivative work (or adaptation) right. *See* First Amended Complaint at 2, *Reece*, 468 F. Supp 2d 1197 (No. 06-00489 JMS/BMK) ("The infringing image is at least substantially similar to the original photograph, and in fact is virtually identical to the original.").

65. *Reece*, 468 F. Supp 2d at 1204–09.

66. *Id.* at 1204.

a German luggage manufacturer.[67] In that case, the plaintiff did allege violations of various rights, including the derivative work right.[68] The court denied cross-motions for summary judgment "to both parties on the issue of substantial similarity because [it found] that reasonable jurors could differ as to whether each of the allegedly infringing . . . photographs is substantially similar to the corresponding . . . original."[69] Noteworthy for our purposes is the degree of care the court used in explaining the similarities and differences between the images, rather than automatically converting use of reference into infringement and granting summary judgment to the plaintiff. Here is one representative pairing of images:

Figure 5: Plaintiff's image (left); Defendants' image (right)

And here is what the court had to say:

> Scènes-à-faire in this . . . pair of images include the woman in a flapper dress, the Jack Russell terrier on a director's chair, and the background, which in both images evokes a classic studio lot. Similarities that may be protectable include the general positioning of objects in the images, with the dog on the director's chair to the left, facing the woman on the right with its forelimbs resting on the seat arm. The woman in both images extends an imaginary treat to the dog with her right hand, standing with her left arm back and her left leg bent (although the women are not identically posed). Both images frame the dog with a more distant background and have ladders against the wall in the top right quadrant of the image.
>
> But the two images differ in ways such that a reasonable jury could find that they are not substantially similar. For instance, the lighting and tones in the images are almost reversed. The models in the [plaintiff's] image are outside a warehouse in the daytime. On the top left quadrant of the image is the entrance to a dark warehouse. The woman is dressed in black or dark colors. The model in the [defendants'] image is inside a dark warehouse or hangar, backlit by the daylight coming through the entrance to the building on the top left and a studio light on the right which casts long shadows in the image. The

67. Laspata DeCaro Studio Co[r]poration v. Rimowa GmbH, No. 16 Civ. 934 (LGS), 2018 WL 3059650, at *1–2 (S.D.N.Y. June 20, 2018).

68. First Amended Complaint and Demand for Jury Trial at 8–12, *Rimowa GmbH*, No. 16 Civ. 934 (LGS), 2018 WL 3059650.

69. *Rimowa GmbH*, 2018 WL 3059650, at *3.

> woman is dressed in white or light colors. The overall effect is that the [defendants'] image is more dramatic.[70]

Many photography cases are decided on fair use grounds, meaning that the two works may appropriately enjoy two rounds of aesthetic scrutiny by the court. In *Rogers v. Koons*, Jeff Koons's sculpture *String of Puppies* was alleged to have infringed photographer Art Rogers's photo *Puppies*.[71]

Figure 6: Art Rogers, *Puppies* (top left); Jeff Koons, *String of Puppies* (all others)

The district court in this case did focus on the derivative work right as the relevant right at issue, identifying "art reproduction" as the form of derivative.[72] This made sense in view of one of Koons's arguments: that the change of medium precluded his liability.[73]

The district court admittedly did not go into much detail with respect to the similarities and differences between the works, other than invoking the "substantial

70. *Id.* at *5.

71. Rogers v. Koons, 960 F.2d 301, 305–06 (2d Cir. 1992). We have retrieved relevant images from the Intellectual Property Teaching Resources database, found at https://ipteaching.ll.georgetown.edu/.

72. Rogers v. Koons, 751 F. Supp. 474, 477 (S.D.N.Y. 1990), *amended on reargument*, 777 F. Supp. 1 (S.D.N.Y. 1991), *aff'd*, 960 F.2d 301 (2d Cir. 1992).

73. *Rogers*, 751 F. Supp. at 477 (noting that "Koons' reproduction of the Rogers photograph in sculpture form does not preclude a finding of copyright infringement" and proceeding to discuss the derivative work right).

similarity" test and perfunctorily applying it.[74] But the Second Circuit went further. With respect to the infringement analysis, it noted that "Koons used the identical expression of the idea that Rogers created; the composition, the poses, and the expressions were all incorporated into the sculpture to the extent that, under the ordinary observer test, we conclude that no reasonable jury could have differed on the issue of substantial similarity. For this reason, the district court properly held that Koons 'copied' the original."[75] It held, furthermore, that "Koons' additions, such as the flowers in the hair of the couple and the bulbous noses of the puppies, are insufficient to raise a genuine issue of material fact with regard to copying in light of the overwhelming similarity to the protected expression of the original work."[76] The fair use analysis, pre-*Campbell* as it was, did not engage in much aesthetic scrutiny, reducing the factor one analysis to the fact that "[t]he circumstances of this case indicate that Koons' copying of the photograph 'Puppies' was done in bad faith, primarily for profit-making motives, and did not constitute a parody of the original work."[77]

But modern fair uses (i.e., post-*Campbell*) are quite expansive in their aesthetic analysis, which asks the hard questions about whether the new work is truly "derivative" or whether it exudes a new "purpose and character"[78] to justify the fair use defense. In another case involving Koons as a defendant, *Blanch v. Koons*, Koons's painting *Niagara* was alleged to have infringed Andrea Blanch's photograph *Silk Sandals by Gucci* ("*Silk Sandals*"), which had appeared in *Allure* magazine.[79]

74. "There is no question in the case at bar that 'an average lay observer' would recognize the sculpture 'String of Puppies' as 'having been appropriated from' the photograph 'Puppies.' Questions of size and color aside, the sculpture is as exact a copy of the photograph as Koons' hired artisans could fashion, which is precisely what Koons told them to do." *Rogers*, 751 F. Supp. at 478.

75. *Rogers*, 960 F.2d at 308.

76. *Id.*

77. *Id.* at 310.

78. 17 U.S.C. § 107(1).

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

Figure 7: Andrea Blanch, *Silk Sandals by Gucci* (left); Jeff Koons, *Niagara* (right)[80]

The Second Circuit went out of its way to describe both works in detail and Koons's process in creating the follow-on work:

> 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."[81]

The case was resolved entirely on fair use grounds. Applying the transformative use test under factor one, the Second Circuit stated: "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."[82]

To be sure, the court bolstered its view with well-crafted and uncontradicted statements by the defendant, obviating the court's need to rely on its own "artistic

80. *Id.*
81. *Id.* at 248.
82. *Id.* at 253.

sensibilities"[83]—a path unavailable to Warhol in *Warhol*. But the court also gave the reader some comparative details about the two works to help contextualize its conclusion that the purpose and character of the defendant's new work were transformed from the original on which it relied. Note also that the mere usage of a portion of Blanch's work—"scanned" and "incorporated" though they were—did not automatically mean an infringement had occurred. Koons used Blanch's work without permission and as a reference—even as raw material, as Warhol did (although Warhol had permission). And yet the Second Circuit did not assume that use as a reference and as incorporated into the new work automatically produced a derivative work.

Even the Seventh Circuit engaged in aesthetic analysis in its decision in *Kienitz v. Sconnie Nation LLC*,[84] despite distancing itself from the Second Circuit's high-watermark transformative use approach in *Cariou v. Prince*.[85] In *Kienitz*, the Mayor of Madison, Wisconsin, Paul Soglin sought to shut down the annual Mifflin Street Block Party, "whose theme (according to Soglin) was 'taking a sharp stick and poking it in the eye of authority.'"[86] In connection with the 2012 Block Party, "Sconnie Nation made some t-shirts and tank tops displaying an image of Soglin's face and the phrase 'Sorry for Partying.'"[87] Upon its sale of fifty-four such items, the photographer of the relevant image, Michael Kienitz, sued Sconnie Nation for copyright infringement.[88] Infringement was not at issue. "Sconnie Nation concedes starting with a photograph that Kienitz took at Soglin's inauguration in 2011. Soglin (with Kienitz's permission) had posted it on the City's website, from which Sconnie Nation downloaded a copy.

83. "Although it seems clear enough to us that Koons's use of a slick fashion photograph enables him to satirize life as it appears when seen through the prism of slick fashion photography, we need not depend on our own poorly honed artistic sensibilities. Koons explained, without contradiction, why he used Blanch's image:

> Although the legs in the Allure Magazine photograph ["Silk Sandals"] might seem prosaic, I considered them to be necessary for inclusion in my painting rather than legs I might have photographed myself. The ubiquity of the photograph is central to my message. The photograph is typical of a certain style of mass communication. Images almost identical to them can be found in almost any glossy magazine, as well as in other media. To me, the legs depicted in the Allure photograph are a fact in the world, something that everyone experiences constantly; they are not anyone's legs in particular. By using a fragment of the Allure photograph in my painting, I thus comment upon the culture and attitudes promoted and embodied in Allure Magazine. By using an existing image, I also ensure a certain authenticity or veracity that enhances my commentary—it is the difference between quoting and paraphrasing—and ensure that the viewer will understand what I am referring to.

We conclude that Koons thus established a 'justif[ication for] the very act of [his] borrowing.' Whether or not Koons could have created 'Niagara' without reference to 'Silk Sandals,' we have been given no reason to question his statement that the use of an existing image advanced his artistic purposes." *Blanch*, 467 F.3d at 255 (alterations in original) (citations omitted); *see* Eva E. Subotnik, *Intent in Fair Use*, 18 LEWIS & CLARK L. REV. 935, 949–52 (2014) (discussing and critiquing this aspect of the decision).

84. *See* Kienitz v. Sconnie Nation LLC, 766 F.3d 756 (7th Cir. 2014).

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

86. *Kienitz*, 766 F.3d at 757.

87. *Id.*

88. *Id.*

The photograph was posterized, the background was removed, and Soglin's face was turned lime green and surrounded by multi-colored writing."[89] The court was thus faced with a fair use dispute over these images:[90]

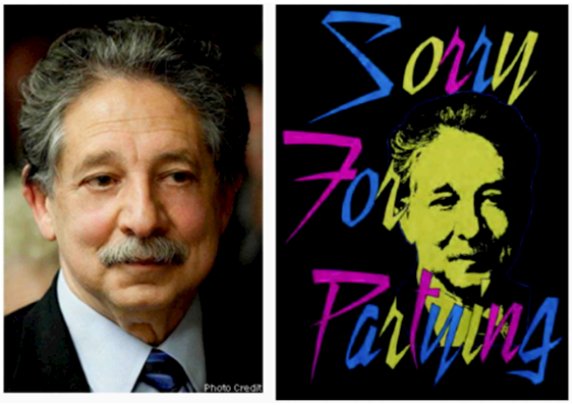

Figure 8: Photograph of Paul Soglin by Michael Kienitz (left); Sconnie Nation LLC t-shirt (right)[91]

The court focused its attention on fair use factor three because defendants removed so much of the original to make the poster. As the court explained:

> Other than factor (4), which we have discussed already, only [factor] (3)—the amount taken in relation to the copyrighted work as a whole—has much bite in this litigation. Defendants removed so much of the original that, as with the Cheshire Cat, only the smile remains. Defendants started with a low-resolution version posted on the City's website, so much of the original's detail never had a chance to reach the copy; the original's background is gone; its colors and shading are gone; the expression in Soglin's eyes can no longer be read; after the posterization (and reproduction by silk-screening), the effect of the lighting in the original is almost extinguished. What is left, besides a hint of Soglin's smile, is the outline of his face, which can't be copyrighted. Defendants could have achieved the same effect by starting with a snap-shot taken on the street.[92]

Here, the court analyzes the characteristics of the new work as distinct from the old work precisely to determine how factor three (as it relates to the other factors) influences the fair use determination. In particular, the court analyzes whether the defendant's new work put to a new use interferes with the copyright owner's reasonable expectation of exploitable value in the photograph. By contrast, the *Warhol* Court

89. *Id.*
90. *Id.* at 758.
91. *Id.*
92. *Id.* at 759.

conducted fair use factor one's aesthetic analysis in the most cursory way. It relied only on an invoice for use of Goldsmith's photograph "to serve as an artist reference"[93] to declare the Warhol prints "stylized derivatives"[94] and that both artists occasionally publish their portraits in magazines.[95] *Warhol*'s conclusory determination is inaccurate as a matter of photography practice and history. And as the above discussion shows, it is unusual in the context of the many lower court cases that considered the aesthetics of copyrighted works in order to conduct a thorough assessment of fair use in light of either infringing copies or derivative works.

II. THE "ARTIST REFERENCE"

A. THE SET-UP

As mentioned above, the original transaction between Lynn Goldsmith and *Vanity Fair* was for an "artist reference."[96] The facts as stated above in Part I.A and the use of the term "artist reference" were undisputed, but what "artist reference" means was nowhere explained. Instead, the Supreme Court's opinion in favor of Goldsmith kept repeating the vague understanding that artist references serve illustration purposes, as here: "Vanity Fair sought to license one of Goldsmith's Prince photographs for use as an 'artist reference.' The magazine wanted the photograph to help illustrate a story about the musician."[97] In one other place, the Court cites what it describes as "uncontroverted" evidence, saying:

> A photographer may also license her creative work to serve as a reference for an artist, like Goldsmith did in 1984 when Vanity Fair wanted an image of Prince created by Warhol to illustrate an article about Prince. As noted by the Court of Appeals, Goldsmith introduced "uncontroverted" evidence "that photographers generally license others to create stylized derivatives of their work in the vein of the Prince Series." In fact, Warhol himself paid to license photographs for some of his artistic renditions. Such licenses, for photographs or derivatives of them, are how photographers like Goldsmith make a living.

93. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 598 U.S. 508, 533–35 (2023).

94. *Id.* at 535. In recent remarks on the Supreme Court's opinion, Professor Amy Adler has argued that the Court's references to Warhol's "characteristic style" and to the fact that Warhol portrayed Prince "somewhat differently" from Goldsmith, *id.* at 546, indicate some level of aesthetic analysis. *See* Amy Adler, Keynote Address at the Cardozo Arts and Entertainment Law Journal's Annual Symposium: "Barking Up the Wrong Tree: An Exploration of Intellectual Property Law Protections Following Bad Spaniels and Andy Warhol" (Feb. 16, 2024). We submit that is insufficient aesthetic engagement by the Court.

95. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 520–21.

96. *See supra* note 18 and accompanying text.

97. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 515; *see also id.* at 517 ("In 1984, Goldsmith, through her agency, licensed that photograph to Vanity Fair to serve as an 'artist reference for an illustration' in the magazine."); *id.* at 533–34 ("After Goldsmith licensed the photograph to Vanity Fair to serve as an artist reference, Warhol used the photograph to create the Vanity Fair illustration and the other Prince Series works. Vanity Fair then used the photograph, pursuant to the license, when it published Warhol's illustration in 1984.").

> They provide an economic incentive to create original works, which is the goal of copyright.[98]

There are many problems with these statements. First, the evidence was not uncontroverted. Goldsmith testified she could recall no other instance in which her photographs of Prince were used as a possible artist reference.[99] Second, the other evidence on which the Court relies is a preliminary expert report explaining existing licensing markets for photographs, including use on book covers and product packages, but not including use as "artist references."[100] Indeed, the excerpt of the expert report before the Court nowhere mentions "artist reference." Third, the Supreme Court's conflation of "artist reference" with "stylized derivative" in the above sentences is the legal question to be decided but lacks any legal analysis.

By defining an "artist reference" as something that yields "stylized derivatives," which is necessarily within the scope of the original author's copyright, the Supreme Court avoided addressing the case's central legal issue: whether what was produced *in this case* with the artist reference is an infringing work or a fair use. This leaves lower courts and future parties in an uncomfortable state of uncertainty. It also disrupts the well-established practice of using "artist references" to make new art.

And herein lies our central claim: Not all uses of artist references produce infringing works that must be licensed;[101] visual artists regularly rely on existing works to create their own.[102] And when an artist receives permission to use or "reference" existing copyrighted works, doing so does not necessarily produce work that required permission in the first place. The Court's *deus ex machina*—conflating "artist reference"

98. *Id.* at 535 (citations omitted).

99. "Goldsmith testified that she did not know whether, aside from the license to Vanity Fair in 1984, she or her company ever (1) licensed any of the photographs from her December 3, 1981 studio shoot; (2) licensed any of those photographs for use as an artist reference; or (3) licensed any other photograph she has made of Prince for use as an artist reference." Joint Appendix – Volume II, *supra* note 29, at 568.

100. *Id.* at 291–99 (Preliminary Expert Report of Professor Jeffrey Sedlik). Sedlik's Amicus Brief, not cited by the Court, describes a "specialized . . . license that would allow a creative artist to use a photograph in a derivative work . . . [as] an 'artist reference license.'" Brief of Amicus Curiae Jeffrey Sedlik, Professional Photographer and Photography Licensing Expert, in Support of Respondents at 31, *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. 508 (No. 21-869). In support, Sedlik references the PLUS Coalition's definition, an organization Sedlik co-founded in 2004. *Id.* at 31–32.

101. The fact that the invoice for the transaction between VANITY FAIR and Goldsmith was sometimes called a license by the parties in litigation does not change the legal analysis of *whether what was produced from the transaction required a license under law*. To be sure, VANITY FAIR and Warhol had no way of accessing the Goldsmith photo without permission from Goldsmith, as it was an unpublished photograph in her archives. So, the VF Invoice was as much as bailment for the tangible copy of the photo as it was a license to use for a particular purpose and not others. Whether the license also included the right to reproduce copyrightable expression in the photo may be assumed by the language of the invoice: The photograph was to serve as a reference for an illustration in the magazine. Whether in fact the Warhol *Prince Series* reproduced copyrightable expression from the photograph, and enough of it to be a substantially similar copy and/or a derivative work (such as an "art reproduction"), was part of the focus of the contradictory court opinions below, which the Supreme Court failed to clarify. *See supra* Part I.

102. *See infra* Part II.B.

with "stylized derivative[]"—was both factual and legal error, which hopefully will not extend beyond the limited context of *Warhol*.

The long and diverse history of using "artist references" is worth describing in detail to avoid compounding *Warhol*'s error. Sometimes called an "aide-mémoire" in art history and practice, the artist reference is an image or object that helps an artist render work as intended.[103] Since shortly after the birth of photography in 1839, painters and other artists have relied on photographs as aide-mémoires to compose their art.[104] Famous painters, such as Edgar Degas, Eugène Delacroix, Vincent van Gogh, Paul Gauguin, and Paul Cézanne, all experimented with and used photographs when creating their paintings.[105]

In general, it seems both obvious and inevitable that visual artists would use photographs as a "reference" when making paintings or other art. Consider if an artist has never seen an octopus in person or up-close but wants to include one in a painting. A photograph—or many—would be helpful to consult. This would be true for any subject of visual art that is hard to access firsthand. Think of distant places or deceased people.[106] Or, consider the practice of portraiture and the exhausting experience of

103. *See* SCHARF, *supra* note 4, at 111.

104. *See id.* at 111–12; *see also* GABRIEL WEISBERG, BEYOND IMPRESSIONISM: THE NATURALIST IMPULSE (1992) (describing widespread practice among naturalist painters, in response to the Realism movement, of depicting contemporary life as modern and using photography as an important tool in doing so, in many cases copying directly from photographs); Elizabeth Childs, *"The Colonial Lens: Gauguin, Primitivism, and Photography in the Fin de siècle," in* ANTIMODERNISM AND ARTISTIC EXPERIENCE: POLICING THE BOUNDARIES OF MODERNITY 50 (Lynda Jessup ed., 2001) (describing Gauguin's use of photography for his Tahitian paintings). Art historians describe Gauguin as having carried photographs with him to Tahiti for his paintings and contributing to dozens of works of art. *See* Charles Stucky, *The First Tahitian Years*, *in* THE ART OF PAUL GAUGUIN 210, 214 (1988) (reporting in a collection of letters edited by Roseline Bacou and Ari Redon, "Lettres de Gaugin, Gide, Huysmans, Jammes, Mallarme, Verhaeren . . . à Olion Redon" (1960), in which Gauguin writes, "I am bringing a whole little world of friends with me in the form of photographs [and] drawings who will speak to me everyday" (alteration in original)); *see also* ELIZABETH C. CHILDS, VANISHING PARADISE: ART AND EXOTICISM IN COLONIAL TAHITI 95 (2013) (describing the number of Gauguin works based on photographs).

105. *See, e.g.*, *Photo Models of Alphonse Mucha – in the Photos and Paintings. Captivating Images and Their Prototypes*, ARTHIVE (Feb. 1, 2019) [hereinafter ARTHIVE], https://arthive.com/publications/1156~Photo_models_of_Alphonse_Mucha_in_the_photos_and_paintings_Captivating_images_and_their_prototypes/ [https://perma.cc/LR77-VNCF] [https://web.archive.org/save/https://arthive.com/publications/1156~Photo_models_of_Alphonse_Mucha_in_the_photos_and_paintings_Captivating_images_and_their_prototypes/] (collecting art and commentary devoted to networking among artists, galleries, and collectors).

106. Of course, photography as a medium has long been noted for its ability to bring the world closer, and the past present. *See, e.g.*, Walter Benjamin, The Work of Art in the Age of Its Technological Reproducibility, *in* 4 WALTER BENJAMIN: SELECTED WRITINGS: 1938–1940, at 19, 21–22 (Howard Eiland & Michael W. Jennings eds., 2006) ("[T]echnological reproduction can place the copy of the original in situations which the original itself cannot attain" and "enables the original to meet the recipient halfway" . . . "in the form of a photograph." . . . The "cathedral leaves its site to be received in the studio of an art lover."). Roland Barthes opens Camera Lucida with his experience of coming across an 1852 photograph of Napoleon's youngest brother and realizing, with "amazement," that "I am looking at eyes that looked at the Emperor." ROLAND BARTHES, CAMERA LUCIDA: REFLECTIONS ON PHOTOGRAPHY 3 (Richard Howard trans.,

sitting for a painter over hours and days. A photographic artist reference is now standard practice for portrait painters to free them and their subject from the confinement of portrait sitting. Photography is of course its own art form. But it is also—and has always been—an aid for painting and drawing, as well as an input into the art itself. Below we describe diverse kinds and uses of photographic "artist references." As should become clear, the term is much broader and varied than *Warhol* made it seem. And, erasing that variation undermines copyright's goals of facilitating the making and dissemination of works of authorship: If all photographic artist references become "stylized derivatives," the practice of making art by referring to photographs without permission and payment has been rendered illegal.[107]

B. A LONG PRACTICE OF PERMITTED USES AS ARTIST REFERENCE

Henri de Toulouse-Lautrec (1864–1901), an artist famous for his fin de siècle illustrations of life in the Paris neighborhood around Montmartre, relied on photographs as references for his work. Lautrec's artistry and career successes also relied on the rise of printmaking and "elevated the popular medium of the advertising lithograph to the realm of high art."[108] As one curator at the Metropolitan Museum of Art wrote, "It is fair to say that without Lautrec, there would be no Andy Warhol."[109] Lautrec was not a photographer himself, but he asked his many photographer friends to make photographs for him. Some photographs are described by art historians as "commissioned" photos and many others as made by "amateur" photographers.[110]

1981) (internal quotation marks omitted). In this latter example, the photograph serves as a portal to an earlier time as well as to an inaccessible visual subject.

107. Of course, Andy Warhol had permission to use, as we describe in more detail below. With permission to use the Goldsmith photo as an artist reference, the question of whether his *Prince Series* is infringing—that is, whether or not the paintings are derivative works or fair uses—should end there. Under the VF Invoice, VANITY FAIR may have only had the right to publish the work resulting from use of the artist reference one time, but that transaction and its restriction involved only VANITY FAIR's use of the photo and Goldsmith, not Andy Warhol's use of the photograph.

108. Cora Michael, *Henri de Toulouse-Lautrec (1864–1901)*, THE METRO. MUSEUM OF ART (May 2010), https://www.metmuseum.org/toah/hd/laut/hd_laut.htm [https://perma.cc/FDX4-RUS6] [https://web.archive.org/save/https://www.metmuseum.org/toah/hd/laut/hd_laut.htm].

109. *Id.*

110. Press Release, *Exhibition: Toulouse-Lautrec and Photography*, Sektionen der Ausstellung, Kunst Museum Bern (Aug. 28, 2015), https://www.kunstmuseumbern.ch/admin/data/hosts/kmb/files/page_editorial_paragraph_file/file_en/1107/150826_ausstellungsfuehrer_toulouse_lautrec_e.pdf?lm=1440581397 [https://perma.cc/SAK6-T9ZA] [https://web.archive.org/save/https://www.kunstmuseumbern.ch/admin/data/hosts/kmb/files/page_editorial_paragraph_file/file_en/1107/150826_ausstellungsfuehrer_toulouse_lautrec_e.pdf?lm=1440581397]. "Of the three photographers who often did this work for him, only one was a professional photographer, and his name was Paul Sescau. The second was François Gauzi. He was actually a painter and, together with Lautrec in the 1880s, a student of Fernand Cormond in Paris. The last of the trio was Maurice Guibert, a young bon viveur who earned his living as a sales representative for champagne makers . . . but was first and foremost an enthusiastic amateur photographer. Many of the best photographic portraits of Lautrec were taken by this long-standing friend; however, they were all first made after 1890. Prior to this date, the artist engaged especially Francois Gauzi to do photography commissions for him. . . . Of the three photographer

Whatever the business relationship between photographer and artist, Lautrec's art relied on the referential photographs. And, that same art is celebrated as Lautrec's own authored work, separate from the photographs on which he relied.[111] A recent exhibition at the Kunstmuseum Bern in Bern, Switzerland, focused on the interrelationship between Lautrec's art and the rise of photography. It exhibited side-by-side the photographs and the illustrations for which Lautrec became famous, explaining that "[w]hatever he depicted and how he did so would have been inconceivable without photography."[112]

Here are just two examples:

Figure 9: Photo reference (left); Henri de Toulouse-Lautrec, *At the Café La Mie* (right)[113]

friends, Paul Sescau also loved wearing costumes and taking pictures of himself in these getups, often posing with a musical instrument [in] his hands. Sescau must have been a very talented musician too. Lautrec designed a color poster for him when he opened up his new photographer's studio at Place Pigalle in 1896/1897." *Id.*

111. Contemporary analysis of these business relationships might conceive of the transactions as "implied licenses" to use the photograph where the photographer would expect the artist to have full range of uses of the work made by reference to the photograph. Terms of implied licenses are context specific and arise from the parties' conduct, relationship, and history of dealings. *See, e.g.*, Aaron Perzanowski, *Tattoos, Norms, and Implied Licenses*, 107 MINN. L. R. HEADNOTES 104 (2023); *see also* Christopher M. Newman, *"What Exactly Are You Implying?": The Elusive Nature of the Implied Copyright License*, 32 CARDOZO ARTS & ENT. L. J. 501 (2014).

112. *Toulouse-Lautrec and Photography*, KUNSTMUSEUM BERN, https://www.kunstmuseumbern.ch/en/see/today/493-toulouse-lautrec-120.html [https://perma.cc/D4L3-KM6Z]
[https://web.archive.org/web/20240214191156/https://www.kunstmuseumbern.ch/en/see/today/493-toulouse-lautrec-120.html] (last visited Feb. 14, 2024).

113. *See, e.g.*, Erika Lancaster, *When and How To Use Other People's Photographs To Create Art*, ERIKA LANCASTER (Dec. 12, 2017), https://www.erikalancaster.com/art-blog/an-artists-guide-to-using-

Figure 10: Photo reference (left); Henri de Toulouse-Lautrec, *Jardin de Paris* (right)[114]

Lautrec's example shows how photography influences art and how art shapes photographic practices. One form of creative practice does not predominate over the other, "come first" (as in have creative priority), or become "derivative" of the other. Indeed, the critical reception and celebration of artists such as Lautrec demonstrate the mutual integration of photography with art.

Another fin de siècle artist, Alphonse Mucha (1860-1939), also relied on photographs as part of his celebrated paintings.[115] But Mucha made his own photographs as part of his artistic practice. Like other artists of his time, Mucha experimented with photography as a new technology and tool. But not until he was in Paris and sharing a studio with Paul Gauguin did he own a reliable camera to use for his commissioned art work.[116] At this time, between 1893–1896, he became well-known for his series on Sarah Bernhardt advertising theatrical performances in which she appeared. Many of them began as photographs for the purpose of eventually becoming theater posters.[117]

references-pt1-when-and-how-to-use-other-peoples-photographs-to-create-art [https://perma.cc/6T34-8L9Z] [https://web.archive.org/web/20240124022928/https:/www.erikalancaster.com/art-blog/an-artists-guide-to-using-references-pt1-when-and-how-to-use-other-peoples-photographs-to-create-art].

114. ARTHIVE, *supra* note 105; *see also* JIRI MUCHA ET AL., ALPHONSE MUCHA: POSTERS AND PHOTOGRAPHS (1971).

115. ARTHIVE, *supra* note 105.

116. *Id.*

117. *Id.*

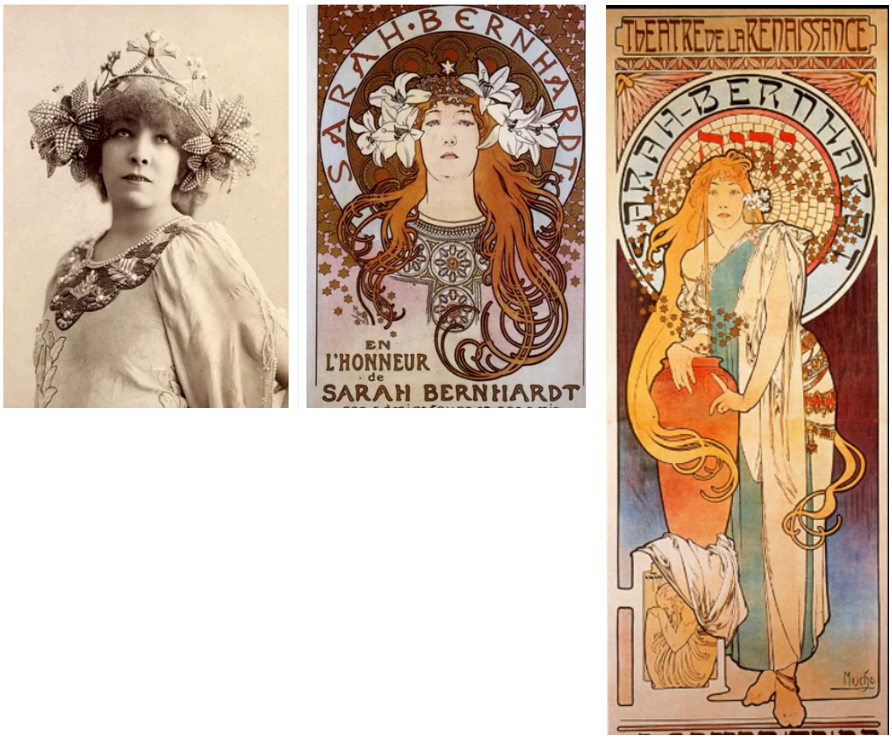

Figure 11: Photo reference (left); Alphonse Mucha, *En L'Honneur de Sarah Bernhardt* and *Sarah Bernhardt: Théâtre de la Renaissance* (right)[118]

118. *Id.*

Unlike Lautrec, Mucha more thoroughly experimented with photography, dressing up his models with his studio as a stage, "using draperies and jewels. . . . [He] preferred to improvise while shooting, and was driven by inspiration, creating works for the future rather than for a specific project."[119] In addition to using photographs as aide-mémoires for artwork on-demand, Mucha also made photographs to collect images and ideas for later artwork, using pieces of photographs as well as entire photographs in a bricolage process, as evidenced by the relationship between the below photographs and paintings.

Figure 12: Photo reference (left); Alphonse Mucha, *Le Soir* (right)[120]

119. *Id.*
120. *Id.*

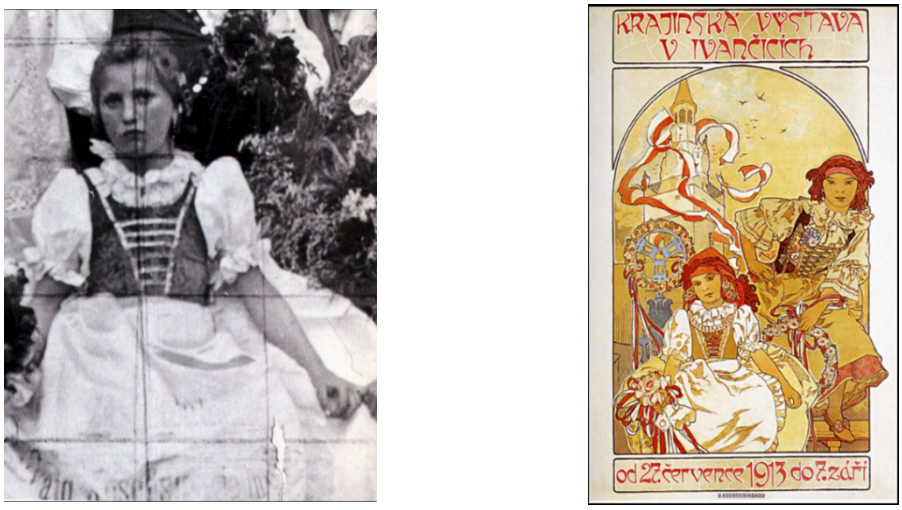

Figure 13: Photo reference (left); Alphonse Mucha, *Poster for Regional Exhibition at Ivančice 1913*[121]

Mucha was a prolific photographer as well as painter.[122] The two art forms appeared inseparable for him and part of a cohesive art practice. In the above photograph of the young girl sitting in a white dress (Figure 13, left), Mucha's gridlines are visible. He then used them to adapt the photographic image into the colorful poster advertising an exhibition in Ivančice, Czechoslovakia (then part of the Hapsburg Monarchy) (Figure 13, right).[123] Like Lautrec, Mucha used photography as both an exercise of and a step in his creative process; the photographs both stand on their own as authored images and are tools for subsequent creativity. They are a kind of "artist reference" essential to Mucha's practice without imposing a hierarchy or constraint over later work.

Whereas Mucha created his own photographic references, and Lautrec asked photographer colleagues to create references for him, Norman Rockwell engaged in yet a third kind of creative practice employing photographic references for his famous illustrations. His practice resembled a cinematic director, staging photographs in his studio with regular photographers whom he hired as part of his studio work.[124] As one curator described Rockwell's unique photographic practice,

> Unlike most illustrators, for whom camera studies are merely visual notes—convenient shortcuts to accuracy and efficient aids for meeting deadlines—Rockwell went to

121. *Id.*
122. *See* JIRI MUCHA ET AL., *supra* note 114.
123. ARTHIVE, *supra* note 105.
124. *See* RON SCHICK, NORMAN ROCKWELL: BEHIND THE CAMERA 9–12 (2009).

> elaborate lengths to stage images that portrayed his concepts exactly, sometimes producing as many as a hundred photographs for a single work. This method was key to the hyperrealism that lay at the heart of his appeal. . . . Working with photographers much as a director does with a cinematographer, he composed the scene, positioned the camera, and decided when to shoot, although he rarely looked through the viewfinder or tripped the shutter himself.[125]

125. *Norman Rockwell: Behind the Camera*, BROOKLYN MUSEUM, https://www.brooklynmuseum.org/opencollection/exhibitions/3227 [https://perma.cc/N9TP-GQ8B] [https://web.archive.org/web/20240124023635/https:/www.brooklynmuseum.org/opencollection/exhibitions/3227] (last visited Feb. 14, 2024).

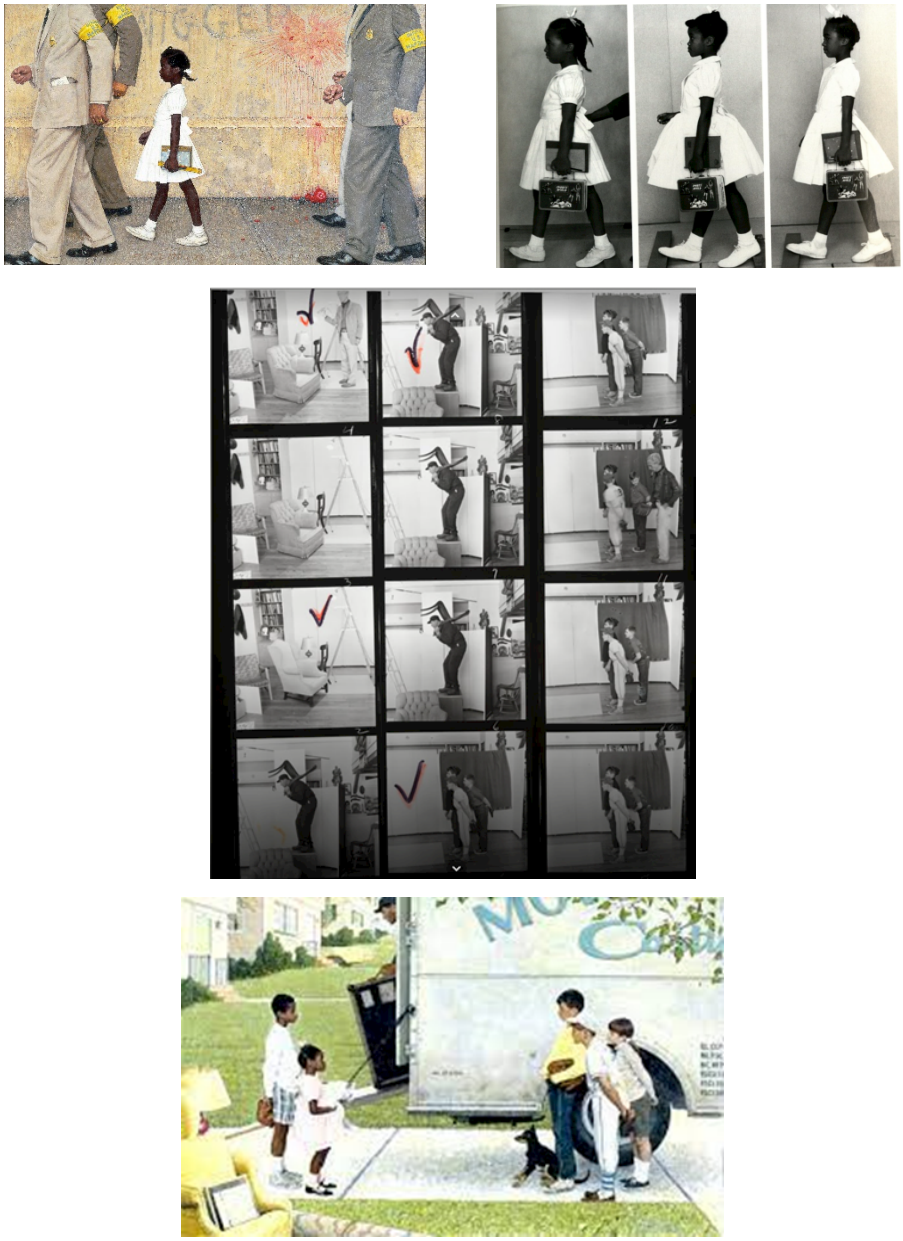

Figure 14: Norman Rockwell, *The Problem We All Live With* (top left); Photo reference for *The Problem We All Live With* (top right); Photo reference for *New Kids in the Neighborhood* (center); Norman Rockwell, *New Kids in the Neighborhood* (bottom)[126]

Rockwell was a realist painter and his illustrations are examples of narrative art, telling stories with pictures.[127] He was interested in ways to visually tell a particular story, as the above contact sheet for *New Kids in the Neighborhood* demonstrates with its approved and rejected images (Figure 14). A regular group of photographers assisted Rockwell with making the reference photographs. Rockwell then traced the photographs; he did not draw freehand.[128] The subject and style of Rockwell's paintings were sometimes controversial, not only because of the socio-political commentary they contained, but also because they were commissioned illustrations, some even for advertisements, and were described by some as "kitschy and cliched."[129] Rockwell considered himself a commercial illustrator, in fact, and celebration of his artistry and groundbreaking creative style only occurred decades after the height of his commercial practice.[130]

These are only three examples of cutting-edge and celebrated illustrators who relied on photographic references to produce their art. Research the practice of photographic references, and the fact of its ubiquity becomes immediately clear. The variation among the above examples demonstrates that there is not one way—be it lawful or normative—to engage in the creative practice. Mucha largely made his own photographs; Lautrec used photographs made by others; and Rockwell had studio photographers, whom he employed like assistants. Each artist used photographs deliberately, both as aide-mémoires to more efficiently render realistic illustrations and as aesthetic inputs for a final image. The final image often contained parts that resembled the photograph (or part of it) and also stood alone as original artwork. None of the artists appeared to assume that the existence of the preexisting photographs limited the making or use of their subsequent art; to the contrary, they enthusiastically embraced use of artist references for their illustrations as liberating and creativity-enhancing.

126. *See* SCHICK, *supra* note 124, at 202–03, 208.

127. *See id.* at 9; *see also* Rebecca Fulleylove, *Discover Norman Rockwell's Reference Photos for His Most Famous Paintings*, GOOGLE ARTS & CULTURE, https://artsandculture.google.com/story/discover-norman-rockwell-s-reference-photos-for-his-most-famous-paintings/iALCpe8lCP9QJg [https://perma.cc/VK75-2T9F] [https://web.archive.org/web/20240124024156/https:/artsandculture.google.com/story/discover-norman-rockwell-s-reference-photos-for-his-most-famous-paintings/iALCpe8lCP9QJg] (last visited Feb. 14, 2024).

128. Michael Zhang, *The Photographs Norman Rockwell Used To Create His Famous Paintings*, PETAPIXEL (Dec. 27, 2012), https://petapixel.com/2012/12/27/the-photographs-norman-rockwell-used-to-create-his-famous-paintings/ [https://perma.cc/6Q6W-6K92] [https://web.archive.org/web/20240124024529/https:/petapixel.com/2012/12/27/the-photographs-norman-rockwell-used-to-create-his-famous-paintings/]; *see also* SCHICK, *supra* note 124, at 10–12.

129. Claire O'Neill, *Norman Rockwell's Cast of Characters Revealed*, NPR (Nov. 29, 2009), https://www.npr.org/sections/pictureshow/2009/11/rockwell.html [https://perma.cc/9KHQ-GTDV] [https://web.archive.org/web/20240124024722/https:/www.npr.org/sections/pictureshow/2009/11/rockwell.html]. It is not clear why the commercialization of art should be controversial. We have found no evidence that Rockwell told stories with his commercial images that he would not be interested in telling otherwise.

130. *Id.*

What do these practices have to do with Warhol and the *Prince Series*? A couple of points are pertinent. First, there is variation among artists—some make their own photos, some use photos made by others—and the art made from "use as an artist reference" can vary widely. Based on that diversity of practice and outcome, it is wrong to assume one and only one legal result (an infringing "stylized derivative") from "use as an artist reference," whether used with permission or otherwise. Second, the practice of using photographs as an "artist reference" predated any formal copyright or contract rules between photographers and other artists, which rules presuppose licensing terms that likely did not arise until after the 1976 Act when the derivative work right was first broadly construed. Warhol was participating in that practice, established by his commercial illustrator predecessors. Whether he knew of the VF Invoice is largely beside the point if we take seriously this history of "use as an artist reference" as fundamental to twentieth-century art. Warhol was making his own work using a photograph as an "artist reference" and his art was meant to stand alone.

The practice of using photographic artist references is deeply embedded in the visual arts from the early days of photography. The Supreme Court's overreliance on the agreement between Goldsmith and *Vanity Fair* (and not with Andy Warhol, notably) to create a legal hierarchy between the works undermines the important, historic practice between artists that understands the works as independent. By insisting that our twenty-first century copyright regime deem the new artwork "derivative" when published on a magazine cover, it subordinates the new artwork to the preexisting one when that is not what history tells us was the practice. This result is nonsensical, especially in light of the commercial examples of Mucha, Lautrec, and Rockwell, all of whom made images for advertisements and journalistic illustration. Further, it is not what the 1984 agreement says.[131] And, in context of art history and practice, it cannot

131. The VF Invoice could be read in several ways. As we explain *infra* Part III.C, we think the best interpretation is that Warhol was given access to and permitted to use the Goldsmith photograph to make any number of illustrations—that is consistent with the above-described history—and VANITY FAIR was permitted to publish one of those illustrations in its 1984 November issue. The practice of "use as an artist reference" (and the data from contemporary photographers in Part III) strongly suggest that Warhol's art made by reference to the photograph was wholly his own, as long as it was aesthetically distinguishable and not a mere copy of Goldsmith's work.

To be sure, this case could have been litigated as a contract dispute instead of as a copyright infringement case. But Goldsmith did not threaten Condé Nast with a lawsuit (be it contract or otherwise). *See* Karol, *supra* note 24. Goldsmith threatened AWF instead with a copyright infringement claim that the *Prince Series* was an infringing derivative work. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 598 U.S. 508, 513 (2023). In that posture, the resulting declaratory judgment action brought by AWF understandably defended the Warhol art from being rendered unlawful (and thus uncopyrightable without Goldsmith's permission). This presumably would have been pursuant to § 103(a) of the Copyright Act. *See* Anderson v. Stallone, 11 U.S.P.Q.2d 1161 (C.D. Cal. 1989) (holding that an unauthorized screenplay about Sylvester Stallone's Rocky character is an infringing derivative work of the character Rocky and thus not entitled to copyright protection by screenplay author under § 103(a)); Pickett v. Prince, 207 F.3d. 402 (7th Cir. 2000) (holding that an unauthorized derivative of Prince's symbol—made into a guitar—cannot be copyrighted by guitar designer under § 103(a)). There is some debate about the reach of § 103(a) when the secondary work is not pervaded by or intermingled with the unlawfully used work. *See Anderson*, 11 U.S.P.Q.2d at 1168 (discussing dispute in legislative history). But that situation does not easily apply to the

be what the agreement meant—not for Andy Warhol, the artist whose use of artist references was as legendary as they were varied and persistent.[132]

None of this is to suggest that copyright law should yield to artistic practice and history. But, of course, when copyright is supposed to further creativity and support artistry, one wonders: Why not yield? To be sure, practices change and norms evolve. Between 1984, when Warhol made his *Prince Series*, and 2016, when Condé Nast ran a second article about Prince with a Warhol on its cover, the use of artist references

Prince Series, given it is not a work (unlike a compilation or collective work) easily separable into Goldsmith's photograph and Andy Warhol's art. The upshot is that Goldsmith initially sought through her counterclaim to invalidate AWF's copyright in the *Prince Series*, preventing AWF from licensing the works without permission from Goldsmith. Amended Answer of Defendants, Amended Counterclaim of Lynn Goldsmith for Copyright Infringement and Jury Demand at 105, Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 382 F. Supp. 3d 312 (S.D.N.Y. 2019) (No. 17-cv-02532-JGK); *accord* Samuelson, *supra* note 14, at 531–42 (discussing this point at length).

132. Francisco, *supra* note 5 (describing Warhol's use of Polaroids in his early portraiture). "At the same time, he treated photography as both a reference tool for painting and an artistic medium of its own." *Id.* at 3; *see also* Thomas Crow, *From the Archives: Saturday Disasters: Trace and Reference in Early Warhol*, ART IN AM. (Jan. 1, 1987), https://www.artnews.com/art-in-america/features/archives-saturday-disasters-trace-reference-early-warhol-63578/ [https://perma.cc/FWH4-RQ5Z] [https://web.archive.org/web/20240215175454/https://www.artnews.com/art-in-america/features/archives-saturday-disasters-trace-reference-early-warhol-63578/] (describing Warhol's use of photos he made, photos made for him, and photos he selected from other media to incorporate into his artwork, some silkscreens, some collages, and others tracings); George Porcari, *Who Shot Marilyn? Photography, Film and Andy Warhol's Silkscreens of Marilyn Monroe*, LIGHTMONKEY (2015), https://www.lightmonkey.net/who-shot-marilyn [https://perma.cc/9AZ3-DAHU] [https://web.archive.org/web/20240128174723/https://www.lightmonkey.net/who-shot-marilyn] (describing the use of Gene Kornman's publicity photograph of Marilyn Monroe for her performance in Niagara as part of Warhol's death series). For the digital image of the original Kornman photograph with Warhol's crop marks, resembling the way he cropped the Goldsmith photograph of Prince, see *Fig. 3. This 1953 Publicity Photograph of Marilyn Moroe by Photographer Gene Korman, Bearing Andy Warhol's Crop Marks, Was the Source Image for Warhol's Marilyn Series. / Beyond Pop's Image: The Immateriality of Everyday Life*, UNIV. OF MICH. LIBR., https://quod.lib.umich.edu/b/bulletinic/x-03101-und-03/03101_03 [https://perma.cc/87JK-XBKV] [https://web.archive.org/save/https://quod.lib.umich.edu/b/bulletinic/x-03101-und-03/03101_03] (last visited Feb. 15, 2024). For further discussion of Andy Warhol's persistent use of photographs as potentially infringing, see Kate Donahue, *Andy the Appropriator: The Copyright Battles You Won't Hear About at the Whitney's Warhol Exhibit*, COLUM. J.L. & ARTS: JLA BEAT (Aug. 2, 2019), https://journals.library.columbia.edu/index.php/lawandarts/announcement/view/112 [https://perma.cc/K9CQ-YX2K] [https://web.archive.org/save/https://journals.library.columbia.edu/index.php/lawandarts/announcement/view/112]. Art historians describe Warhol's use of the photograph as a "memory" or "memorial" and thus a comment on photography and its subject. *See* Thomas Crow, *From the Archives: Saturday Disasters: Trace and Reference in Early Warhol*, ART IN AM. (Jan. 1, 1987), https://www.artnews.com/art-in-america/features/archives-saturday-disasters-trace-reference-early-warhol-63578/ [https://perma.cc/FWH4-RQ5Z] [https://web.archive.org/web/20240215175454/https://www.artnews.com/art-in-america/features/archives-saturday-disasters-trace-reference-early-warhol-63578/] (describing Warhol's process of making his Marilyn series which "coincide[d] with [his] commitment to the photo-silkscreen technique . . . [in which] [t]he screened image, reproduced whole, has the character of an involuntary trace: it is a memorial in the sense of resembling memory, which is sometimes vividly present, sometime elusive, and always open to embellishment as well as loss").

might have changed.[133] Our point here is that ignoring all of this history and the specific contexts in which these artistic practices arise partakes in a kind of vacuous copyright formalism that does not serve copyright's purposes.[134] And in this case, it also results in more confusion than clarity.

Part III below describes the practices of contemporary working photographers, which we think sheds light on what the VF Invoice intended to accomplish and what Warhol reasonably thought he could do with the Goldsmith photograph. Those practices reaffirm the freedom to use artist references in many circumstances and not always to produce licensed "derivative works" in the legal sense. The varied practices also inject more nuance into the above-described examples, especially concerning the reasons why permission and payment may be sought.[135] As Part III explains, most photographers work within a reproduction right paradigm—one that limits making a "substantially similar" copy that is a market substitute for their photograph. They do not describe a derivative work scheme that broadly construes the adaptation right and brands as illegal new art made from the use of (or reference to) older art. In this framework, an "artist reference" is a creative tool and its use is rarely considered copyright infringement without an independent evaluation of the new work's aesthetic form and purpose. Photographers care about the subsequent art's message and what it looks like when assessing prohibited or permitted uses of their photographs. And this is different from whether use as an artist reference—a tool of creativity providing access to materials and services—should be paid for or credited in the manner one might compensate a collaborator or employee. As Part III describes, the use of an "artist reference," even in the face of an agreement for the use, is not the same as preparing a derivative work.

133. For a discussion about the changing nature of photography as an art form within the framework of copyright law in the digital age, see Silbey et al., *supra* note 6.

134. Formalism (and textualism) may simply be the way of the current Supreme Court, in many domains, not just intellectual property law. But that does not make it well-reasoned law or good policy. *See, e.g.*, Star Athletica, L.L.C. v. Varsity Brands, Inc., 580 U.S. 405, 415, 417 (2017) (interpreting and applying copyright law's "useful articles" doctrine based on the statutory definition that largely repeats the words in the statute, calling the application "straightforward" and citing the OED in support); *see also* Daniel Hemel, *The Problem with that Big Gay Rights Decision? It's Not Really About Gay Rights*, WASH. POST. (June 17, 2020), https://www.washingtonpost.com/outlook/2020/06/17/problem-with-that-big-gay-rights-decision-its-not-really-about-gay-rights/ [https://perma.cc/GW3V-P5MS] [https://web.archive.org/web/20240317215042/https://www.washingtonpost.com/outlook/2020/06/17/problem-with-that-big-gay-rights-decision-its-not-really-about-gay-rights/].

135. The data in Part III does not purport to speak to practices before the 1980s, when many of the photographers interviewed began their careers.

III. CONTEMPORARY PHOTOGRAPHER PRACTICE

A. THE CASE AND OUR CASE STUDY

The industries at the heart of the *Warhol* decision are commercial photography (Lynn Goldsmith), print media (*Vanity Fair* and Condé Nast), and contemporary art (Andy Warhol). Each industry deals with copyright law in its own specific manner. Copyright law may apply equally to each, but separate creative communities and the industries supporting them often develop separate norms and practices concerning permissive and prohibited copying—despite copyright law's formal rules.[136] In a study we conducted several years ago, we learned from professional photographers how they adapted their aesthetic and business practices, including reliance on copyright, given new digital age affordances. In particular, we learned from a variety of photographers how the internet was challenging established business expectations.[137] We published several articles describing that research, which focused on different aspects of contemporary photography practice, including: how photographers understand the benefits of copyright law; when copyright law works and does not work for them; how photographers manage the sometimes conflicting rights between the subjects of their photographs and the photographers' own copyright in the photographs; and photographers' views on what makes excellent photography, as opposed to what is simply "original" and protectible under copyright law.[138]

The dispute between Lynn Goldsmith and the Andy Warhol Foundation ("AWF") is an opportunity to return to our data to better understand the real questions the *Warhol* Court granted cert to decide: whether Condé Nast's 2016 use of Warhol's

136. JESSICA SILBEY, THE EUREKA MYTH: CREATORS, INNOVATORS, AND EVERYDAY INTELLECTUAL PROPERTY (2014) (analyzing data from over fifty interviews with a range of artists and scientists about diverse copyright, patent, and trademark practices). The composition of Panel I of the 2023 Kernochan Center for Law, Media and the Arts' Symposium, to investigate the approaches to the derivative work right in the motion picture, music, publishing, and photography industries, itself reflects this reality.

137. We do not claim that the photographers we interviewed are representative of all working photographers, or that we agree with their views, or that their views necessarily represent the state of the law leading up to the *Warhol* decision. What we can do is present the variations we noticed across the range of in-depth interviews we conducted. Our research methodology is explained in our publications cited *supra*; the interviews were stratified among photographic genres and business models to produce as much variation as possible so that when themes emerged, we could feel confident the themes were not idiosyncratic of individuals but representative of shared practices, behaviors, and beliefs. For a list of all the photographers interviewed, see JESSICA SILBEY, AGAINST PROGRESS: INTELLECTUAL PROPERTY AND FUNDAMENTAL VALUES IN THE INTERNET AGE 325–33 (2022).

138. Silbey et al., *supra* note 6; *see also* Jessica Silbey, *Control over Contemporary Photography: A Tangle of Copyright, Right of Publicity, and the First Amendment*, 42 COLUM. J.L. & ARTS 351 (2019) (describing how contemporary photographers prioritize their own First Amendment rights over their subjects' right of publicity and privacy as part of a stewardship of identity and image); Silbey, *supra* note 6 (describing how contemporary photographers' claims for originality, protection against infringement, and demands on the public domain do not align with canonical copyright doctrine). For more on the history of copyright interests of photographic subjects (or lack thereof), see Eva E. Subotnik, *The Author Was Not an Author: The Copyright Interests of Photographic Subjects from Wilde To Garcia*, 39 COLUM. J.L. & ARTS 449 (2016).

Orange Prince on its cover—without permission from or payment to Goldsmith—is fair use or otherwise infringes Goldsmith's right to prepare derivative works of her photograph.[139] (This is already an awkward question because *Vanity Fair* did not prepare the so-called "derivative work" in 1984, Warhol did. But it was *Vanity Fair* who paid Goldsmith $400 in 1984 for (presumably) Warhol's use as "artist reference." Whether Warhol knew of the fee or agreement between Goldsmith and *Vanity Fair* remains unknown.) What did permission to use as an "artist reference" guarantee Warhol in 1984 and thereafter? The Supreme Court decided that the use of the "artist reference" extended only to the preparation of the contribution to the 1984 magazine because it interpreted the invoice as a limited license to prepare a derivative work for a single purpose. This conclusion conflicts with existing copyright law and artistic practices.

Copyright law does not necessarily deem all resulting uses from an "artist reference" to be "derivative works." Derivative works are *certain kinds* of adaptations that are statutorily enumerated;[140] courts must determine that the resulting work fits within the definition of a "derivative work."[141] In other words, *not all adaptations of the original work infringe the derivative work right*; some may be non-infringing works or "fair uses." An infringement determination requires identifying a derivative work, which requires the predicate evaluation (or "interpretation") of the images made by reference to the original work. The *Warhol* Court avoided that predicate aesthetic evaluation (e.g., a comparison of *Orange Prince* with the Goldsmith photograph),[142] eschewing what it considered inappropriate art criticism as part of its legal determination, which compounded the error at the court of appeals.[143] But by conflating "use as an artist reference" with preparing a "derivative work," the Court assumed the answer to the

139. For a procedural history of the *Warhol* case, see Samuelson, *supra* note 14.

140. 17 U.S.C. § 101 (defining "derivative work").

141. To be sure, the existence of a license that describes works prepared under it to be derivative works may be good evidence that the parties intended that result. But if a license describes the right to prepare derivative works, and the resulting work is a fair use, that does not make the resulting work a derivative work that is permitted solely pursuant to the license. As the Supreme Court has said, "[W]e reject [the] argument that . . . request for permission to use the original should be weighed against a finding of fair use. . . . [T]he offer may simply have been made in a good-faith effort to avoid . . . litigation. If the use is otherwise fair, then no permission need be sought or granted. Thus, being denied permission to use a work does not weigh against a finding of fair use." Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 585 n.18 (1994).

142. Justice Kagan in dissent chastises the majority on just this point. "The majority does not see it. And I mean that literally. There is precious little evidence in today's opinion that the majority has actually looked at these images, much less that it has engaged with expert views of their aesthetics and meaning." Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 598 U.S. 508, 574 (2023) (Kagan, J., dissenting); *see also supra* notes 93–94 and accompanying text (describing, in our view, the flimsy nature of the aesthetic analysis that does exist in the Court's majority opinion).

143. *See supra* Part I (critiquing Second Circuit opinion).

aesthetic question it claimed to avoid. And it did so on the erroneous factual assumption that "use as an artist reference" is a license to prepare a derivative work.[144]

Explanations of contemporary photography practices described below contradict that assumption. Hopefully, future courts will not repeat the Supreme Court's mistake. Evidence from past practice relying on artist references[145] and from contemporary practice described below confirm that both the resulting images' form and function—not just the fact that an artist reference was used—can usefully determine whether a copyright license is necessary from working photographers. An overly formalistic reliance on an existing agreement to use an artist reference does not answer the question at the heart of *Warhol*—neither for photographers nor for artists who, like Warhol, rely on artist references.

B. VARIATIONS OF USES AS ARTIST REFERENCES

Despite the diverse forms of work and experience, the photographers we interviewed drew some consistent distinctions between adaptive reuses that, in their views, required permission and those that did not. As described more fully below, reuses that did *not* require permission—even when employing the photograph as an "artist reference"—were those that resulted in art that was sufficiently distinct from the old work and was truly the new artist's "own." What this means will be elaborated below, but in general it means the old work may be recognizable in the new work[146] but does not predominate. The old work may be a component of the new work, but the new work has a new character evidenced by the new artist's individual efforts and craft. While this might sound impossibly subjective, it also reflects existing aspects of the legal line between infringing derivatives and non-infringing fair uses.[147]

144. Whether the VF Invoice in this case was such a license—and if so, the scope of its terms—could have been the subject of factual and legal analysis below. Instead, the Court accepts haphazard waivers of scope by Goldsmith's counsel in her Supreme Court brief and at oral argument, changing the focus of the litigation at the last possible moment. *See* Samuelson, *supra* note 14. Until that point, AWF's lawyers were rational to believe they were litigating a case about whether the *Prince Series* works were fair uses or infringing derivative works, not whether the single use of the *Orange Prince* on the 2016 magazine cover, which AWF authorized Condé Nast to publish, was otherwise lawful under the 1984 agreement between VANITY FAIR and Goldsmith.

145. *See supra* Part II.

146. This undermines the thrust of the Second Circuit's recognizability principle. *See* Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 42 (2d Cir. 2021).

147. *See, e.g.*, Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 579 (1994) ("The central purpose of this investigation is to see . . . whether the new work merely 'supersede[s] 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; it asks, in other words, whether and to what extent the new work is 'transformative.' . . . Such works lie at the heart of the fair use doctrine's guarantee of breathing space within the confines of copyright." (alteration in original)); *see also* Authors Guild v. Google, Inc., 804 F.3d 202, 214 (2d Cir. 2015) ("In other words, transformative uses tend to favor a fair use finding because a transformative use is one that communicates something new and different from the original or expands its utility, thus serving copyright's overall objective of contributing to public knowledge."); Blanch v. Koons, 467 F.3d 244, 252 (2d Cir. 2006) (accepting evaluation of Koons art not simply "repackag[ing] Blanch's 'Silk

Moreover, we think the data from contemporary photographers is both more objective and more complex than current law. That is, explainable rules as norms exist according to photographers for when permission is required and when it is not, but they are more nuanced than the statutory definition and common law elaboration of "derivative work." Whether these internal community norms *should be* the legal rules is a different question—good reasons exist not to adhere to all the norms of the professional photographer community (or any particular community, for that matter). But they are nonetheless instructive to explain the error in *Warhol* and to guide future disputes by providing context for the ubiquitous practice on which art and creativity rely.

The photographers' practices are both overinclusive and underinclusive as to what would count as an infringing adaptation under law. The overinclusiveness presents significant First Amendment problems that copyright fair use is designed to avoid. And the underinclusiveness should give future courts pause as to whether "use as an artist reference" means anything but mere "use," which is not, by itself, infringement.

According to the photographers, several conditions required permission and payment. These include when a reuse is (1) a pure commercialization of the exact or near-exact image (e.g., reuse beyond the scope of a previous license); (2) by someone who is—or whose use will be—morally repugnant to the photographer; or (3) by a big for-profit company which regularly licenses images, should know better, and can pay. In the second and third conditions, distaste for the identity of the secondary user is a factor, which is not part of copyright infringement analysis for good reason: Enabling critical reuses and facilitating diversity of expression about and with the prior work is a core function of fair use to prevent copyright law from becoming a mechanism of censorship. The first condition describes infringement of the reproduction right and does not usually describe an adaptive use (i.e., the preparation of a derivative work) that adds additional original copyrighted expression. We provide examples of each condition; the examples also include acceptable reuses that resemble historic use as an "artist reference" described above in Part II.

Sandals,' but . . . employ[ing] it 'in the creation of new information, new aesthetics, new insights and understandings.'" (alteration in original)); Castle Rock En't., Inc. v. Carol Publ'g Grp., Inc., 150 F.3d 132, 142 (2d Cir. 1988) ("If 'the secondary use adds value to the original—if [copyrightable expression in the original work] 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.'" (alteration in original)) (quoting Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1111 (1990)). Even the *Warhol* Court distinguished transformation for the purpose of fair use from adaptation for the purpose of preparing derivative works. "To preserve the copyright owner's right to prepare derivative works, defined in § 101 of the Copyright Act to include 'any other form in which a work may be recast, transformed, or adapted,' the degree of transformation required to make 'transformative' use of an original work must go beyond that required to qualify as a derivative." Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 598 U.S. 508 (2023); *cf.* Dr. Seuss Enters., L.P. v. ComicMix LLC, 983 F.3d 443, 454 (9th Cir. 2020) (noting new work failed to "possess[] a further purpose or different character, [and instead] paralleled [the original work's] purpose. . . . Absent new purpose or character, merely recontextualizing the original expression by 'plucking the most visually arresting excerpt[s]' of the copyrighted work is not transformative").

1. Exact or Near-Exact Copies

Most relevant to *Warhol* itself, photographers describe being paid when their photos are used explicitly as the basis of an illustration or magazine cover that would be a realistic rendering of the photo, albeit in a new form. For example, Rick Friedman, a commercial photographer and photojournalist, mentioned that he "used to get these wonderful assignments from the old *Wall Street Journal*. Remember they used to have all the dot . . . drawings? . . . They would hire us for a magazine day rate to go do that."[148] He remarked more generally that "people buy photographs to use to be the basis of a drawing."[149] This practice frequently extended to uses for magazine covers: A well-known magazine publication had "covers that would be drawings. And the drawing would be based on a photograph, and the photographer would get paid the same thing as if the cover ran as a photograph."[150]

This practice provides some evidentiary support for what the Supreme Court says in *Warhol*: "A photographer may . . . license her creative work to serve as a reference for an artist, like Goldsmith did in 1984 when Vanity Fair wanted an image of Prince created by Warhol to illustrate an article about Prince."[151] But Rick expressly described illustrations that are near-exact copies of the original photograph in a different medium. The photograph is used as an aide-mémoire (i.e., photograph to dot-drawing, or photograph to painted portrait).

More particularly, Rick's example is of both conditions one and three above. He described a near-exact copy of the photograph in a commercial context *and* a newspaper or magazine that regularly pays photographers for use of their photographs. Many photographers confirmed Rick's perspective, complaining when the second work was a near-exact copy of their photograph. For example, Noreen, a photojournalist, described a time she actually sued a painter for creating a "painted version of a photo that [she] had taken."[152] It was done in "photorealistic" style that "[l]ooked like my photo," and the painter was actually selling it. Eventually the case settled for a monetary

148. Interview with Rick Friedman, in Bos., Mass. (Sept. 12, 2016). These illustrations are called "hedcuts." For a description of the practice, see *Hedcut*, WIKIPEDIA, en.wikipedia.org/wiki/Hedcut [https://perma.cc/D5BK-GVJ4] [https://web.archive.org/web/20240128190144/https://en.wikipedia.org/wiki/Hedcut] (last visited Feb. 15, 2024); *see also* Francesco Marconi et al., *What's in a Hedcut? Depends How It's Made.*,WALL ST. J. (Dec. 16, 2019), https://www.wsj.com/articles/whats-in-a-hedcut-depends-how-its-made-11576537243 [https://perma.cc/N2C6-TNGL] [https://web.archive.org/web/20240128191522/https://www.wsj.com/articles/whats-in-a-hedcut-depends-how-its-made-11576537243]. Some of the photographers we quote and refer to herein permitted us to use their names; others requested pseudonyms. *See* Silbey et al., supra note 6, at 276. In order to adopt a consistent convention in referring to them, we often use first names in the following discussion.

149. Interview with Rick Friedman, *supra* note 148.

150. *Id.*

151. *Andy Warhol Found. for the Visual Arts, Inc.*, 598 U.S. at 535.

152. Interview with Noreen (pseudonym), in N.Y.C., N.Y. (July 21, 2017).

sum and an agreement that "if he ever exhibited it again, he had to put that . . . mine was the reference image."[153] We return to the importance of attribution below.

The situation in *Warhol* concerned a large for-profit company (Condé Nast) that regularly licenses images, should know better than to use a photograph without asking permission (according to the photographers we interviewed), and thus should pay (condition three above). But it does not clearly capture the first condition: a pure commercialization of the exact or near-exact image, because that issue was disputed by the lower courts until the Supreme Court avoided the question. The next section expands upon how photographers engage in aesthetic evaluation to determine whether exact or near-exact copies were made, which would (to them) determine whether permission to use their photographs was necessary. On this issue (of exact or near-exact copying), professional photographers express a range of attitudes and practices, and their demand for control or their acquiescence depends on the context, including the identity of the licensee and the nature of the use.[154]

2. From Shepard Fairey To Warhol: Commercial Use or Art?

To test professional photographers' tolerance for reuse of their photographs beyond exact or near-exact reproductions, we asked whether they thought Shepard Fairey should have asked permission to use the AP photograph of Barack Obama for Fairey's "Hope" poster.[155]

Figure 15: Shepard Fairey poster (left); AP photo/photo credit: Mannie Garcia, (right)

153. *Id.*

154. For more examples of the kind of tolerated uses by photographers of substantially similar copies of their photographs, see Silbey, *supra* note 6, at 437–40.

155. For more about this dispute, see David Kravets, *Associated Press Settles Copyright Lawsuit Against Obama 'Hope' Artist*, WIRED (Jan. 12, 2011), https://www.wired.com/2011/01/hope-image-flap/ [https://web.archive.org/web/20240128192935/https://www.wired.com/2011/01/hope-image-flap/].

This question drew a range of responses anchored in the context and nature of the use as well as the identity of the user.

Many photographers explained that the context of the use mattered to them, whether the copy was exact or altered. For example, Kim Lorraine said: "If someone took a picture that inspired them to create a poster to help an institution, like, or to help bring awareness, like say cancer, or anything . . . I would probably be fine with it, and I'd probably feel proud that that created that much emotion that people would want to use my image for the purpose of inspiring others to help."[156] But, Kim noted, "If it was used and transformed to something for someone just to make money, I would probably be ticked off . . . I would probably still reach out to the person who used it, for whatever inspiration . . . but I'd probably say, 'Hey, that's not cool, but I'm cool with it, because you're doing a really good thing, and I'm gonna back you, and I'm happy to back you, just give me attribution, that this is my picture.'"[157] Here we see acquiescence in uses that advance causes that the photographer supports and a critique of "pure commercial" uses without a further admirable purpose (in the photographer's view), which she will not constrain but for which she still wants credit.

Absent straightforward market substitution, photographers drew both purposive and aesthetic distinctions, and they were conscious of the challenges of doing so. Recognizing that the line between permitted and prohibited uses is fuzzy and often personal, some photographers defaulted to permissiveness for the sake of art—itself a laudable purpose. For example, Ali Campbell noted specifically that "I don't have a particularly hard-line stance" and underscored that her "general attitude is I'm like everyone should be making art."[158] But then she offered a contrast that resonated with other photographers:

> [I]f someone were to lift my photos and use 'em in like a Breitbart news article, I'd be livid, like, right? Because I'd be like, 'I don't want to have any association with that.' Or if someone were to do something that was like really, you know, disparaging, or really bigoted, I'd be really, really upset, whereas if someone's like, 'I included this in a painting,' or like 'I drew somebody from one of your photos,' and like it doesn't really bother me, 'cause I'm like . . . Thumbs up. Yeah. Exactly . . . because I think, it just, if it's encouraging other people to do creative work, that's good, that's, you know, that's fine with me.[159]

Another photographer, Andy Levine, explained his view in terms of inspiration and the freedom to be inspired. "I would never rip off the same idea, but . . . as an artist, I think you gotta, you know, every artist is inspired by a bunch of other artists, and some, you know maybe someone'll be inspired by something I would do, like, it's fine."[160] If the purpose is to make new art, that purpose receives deference from photographers.

156. Interview with Kim Lorraine, in N.Y.C., N.Y. (June 22, 2016).
157. *Id.*
158. Interview with Alison Campbell, in Bos., Mass. (Feb. 4, 2017).
159. *Id.*
160. Interview with Andy Levine, in Norwood, Mass. (June 20, 2017).

Some photographers went further. When we asked "have you had experience of people manipulating your work . . . doing some kinda transformation to it," Alejandro said he was "a little flattered" by "good artists" who are "inspired by [his] image" and make it into a new and valuable work.[161] The difference for him and Andy (as compared to other photographers we spoke with), however, is that none of these inspired uses were, in their eyes, commercially exploiting their work "per se."[162] With respect to one such incident, Alejandro said "they were good artists . . . and they took one image of mine and they made it, they said, you know they were inspired by this image, and they took some other image, and . . . I'm like, 'All right, you know, they're not selling it per se.'"[163]

What does "selling it per se" mean? Alejandro gave examples: "If they're trying to sell a sweater with my image on it, that'd be a problem. If it's an educational institution, I don't care."[164] Direct exploitation of the photograph as such is objectionable, but in service to a good cause or using it to make new or "good" art is okay (even "flattering").[165] To our copyright scholar ears, the aesthetic distinction Alejandro and Andy make here resembles early articulations of the originality standard in which original works of expression contain the artist's "personality"[166] and include efforts or aspects that are "recognizably [their] own."[167] These photographers are not concerned that the second work is merely based on or adapted from the first one.[168] They probe further about the nature of the new art and the context of its use.

Some photographers, like Alejandro, still described Shepard Fairey's "Hope" poster as borderline misappropriation, however. The analogy they drew was to controversies concerning music sampling—that is, clearly taking from another and layering your own work on top.[169] This kind of borrowing elicited a range of responses, some very permissive and others more critical. Linda, an editorial and fine art photographer, explained that inspired adaptations by fellow travelers in the professional photographic

161. Interview with Alejandro (pseudonym), in N.Y.C, N.Y. (July 10, 2017).

162. *Id.*

163. *Id.*

164. *Id.*

165. Neither was true in the above examples from Rick and Noreen. Both were art reproductions (described as "photorealistic"), not new art.

166. Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 250 (1903).

167. "All that is needed to satisfy both the Constitution and the statute is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.'" Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 102–03 (2d Cir. 1951) (citing Chamberlin v. Uris Sales Corp., 150 F.2d 512 (2d Cir. 1945)). For an exploration of the originality requirement and photography, see Eva E. Subotnik, *Originality Proxies: Toward a Theory of Copyright and Creativity*, 76 BROOK. L. REV. 1487 (2011).

168. *Bleistein* and its progeny concern originality as a threshold for copyright protection, and not whether an original derivative work infringes upon the work on which it was based. But it is interesting to us that the originality standard is invoked by professional photographers as one way to distinguish between permitted and prohibited copying. In our interviews with photographers, they suggest that if the second work appears to have sufficient authorship, the use of the first work is fine.

169. We find the music sampling analogy intriguing and think the range of debates in music copyright potentially fruitful in this context.

community are not problematic. For example, restaging a similar scene in a new location, if performed by a working photographer, does not trouble Linda "cause they're doing their own thing. They're actually working. . . . They're not taking someone else's work. . . . I guess, it's continuing a conversation, like borrowing your beats, like sampling. . . . [I]t's like a new song."[170] For Linda, what is important is that new art is being made, a laudatory practice. This was a persistent theme in the interviews.

Linda is bothered, however, if *non-photographers* take her work instead of paying her. She acknowledged that one can get caught up in

> questions of how many notes they actually [laughs] sampled, and like it's a technicality, but I think the use of images without permission is confusing to me because, . . . photography's many things to many people, and for me, my website, . . . it's like my portfolio online, but . . . all these other people that used the work are basically not paying me to go take those photos. They're not paying another photographer to go take those photos . . . they're not generating more work for photographers.[171]

Like Rick, Noreen, and Alejandro above, Linda described market substitution as a problem but embraces (or begrudgingly accepts as "confusing") the possibility of being lenient with art made from other art.

Some photographers went as far as to insist that unauthorized use was necessary for art itself, but that making art has to be the purpose of the use. Lee Crosson explained:

> I think it's a question of intent. . . . What is the person trying to do . . . ? In [the] case [of a student using a photograph in a PowerPoint presentation], I would have no problem at all. That would flatter me and nothing else . . . . [T]his is a conversation that needed to happen, and I think this is really the only way that it would've happened.

When asked about a situation in which the copier had asked permission and the photographer had said no, but the copier went ahead and did it anyway, Crosson replied,

> I think it would make it more powerful art. You know. I wouldn't wanna be that person. But it would make it more powerful art . . . . I don't know what I would say [if asked]. But that would destroy it. . . . [T]he conversation goes away. . . . F. Scott Fitzgerald has this great quote that I return to time and time again . . . "The test of a first-rate intelligence is the ability to hold two opposed ideas in the mind at the same time, and still retain the ability to function." And I think that's got applications everywhere. So . . . OK, I think it's almost necessary to be pissed about this [unauthorized copying], but . . . at the same time . . . I want to be able to say what I want to say, and when I want to say it, and this is a consequence of it, you know. And the law . . . it's impossible for that to be made around one single person, and that is essentially the expectation you're saying, like, "I don't want

170. Interview with Linda (pseudonym), in N.Y.C., N.Y. (Nov. 30, 2016).
171. *Id.*

> this to happen to me," but the implications of that not being able to happen I think are far more damaging, and far more wide-reaching.[172]

These are hard, uncomfortable distinctions, and photographers struggle with them. But for many the default is to let the art happen.

3. Attribution

Photographers sometimes distinguished between requiring permission and simply providing attribution. Alejandro joined the chorus that drawing lines is hard and raised the common concern of attribution. Talking about Shepard Fairey again, he said:

> Like he's [Shepard Fairey] creating something new, right? . . . But it's not entirely new . . . there's gotta be a nod at, there's gotta be something to the artist, or the original work that was, I would call it appropriated from. You know, because it did not exist before. And, OK, you have put another layer on top of it. It's like sampling tracks, right? But you still have to acknowledge that there is a creator—I mean, it's like, you know, do you do "copyright so-and-so with permission from artists, blah blah blah," I mean that's a way to do it.[173]

What does Alejandro mean here? He appears to tie his ethical compass to the "recognizability" principle that dominated the Second Circuit's *Warhol* decision, but less so the Supreme Court's. [174] For him, when the underlying (first) work is recognizable and/or predominates, the second work may infringe absent an exemption or excuse. Alejandro is unfamiliar with the details of copyright law; but, as he suggests in the quoted portion of his interview above, when "appropriat[ing]" from the "original work" and without creating something "entirely new," an artist should at least "acknowledge that there is a creator" underlying the new work. The second artist, like Fairey, should seek permission from the first, or at least credit the first with contributing so much to the new work.[175]

172. Interview with Lee Crosson, in Arrowsic, Me. (Dec. 24, 2016).

173. Interview with Alejandro, *supra* note 161.

174. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 54 (2d Cir. 2021) ("[G]iven the degree to which Goldsmith's work remains recognizable within Warhol's, there can be no reasonable debate that the works are substantially similar." (citation omitted)).

175. It is worth noting that the VF Invoice and agreement between Goldsmith and VANITY FAIR included a double-penalty provision in the case of failure to attribute. "The credit line—LYNN GOLDSMITH—must not be omitted, abbreviated or altered under penalty of double charge." Joint Appendix – Volume I, *supra* note 18, at 86. Goldsmith and her agency LGI were credited in the 1984 magazine vertically alongside the gutter between pages sixty-six and sixty-seven. *Id.* at 113. The extent of the credit on page sixty-six was "Lynn Goldsmith/LGI." *Id.* On page 121 of VANITY FAIR, an additional credit stated: "Page 67: source photograph © 1984 by Lynn Goldsmith/LGI." *Id.* at 113. "Condé Nast's vice president of business affairs and rights management, Chris Donnellan, testified that the reference to 'source photograph' meant '[t]he underlying image that was used to create the artwork.'" Joint Appendix – Volume II, *supra* note 29, at 326. "Source credit" in this case is the same as "use as an artist reference." The Warhol *Purple Prince* took up the entire page sixty-seven. *See* Joint Appendix – Volume I, *supra* note 18, at 112. Warhol was credited in the

Photographers emphasized attribution and the importance of credit and influence in making and innovating art forms, what in related fields we might call "citation," "precedent," or "reference."[176] Alejandro insisted that reference and citation are the proper way for artists to build on the works of others. For some, this requires permission; for others, attribution is enough. Martha, a photojournalist, said of the Shepard Fairey example:

> I guess if it was me, I would have said 'I'm flattered,' but AP wouldn't have. [laughs] . . . If it was me, I'd be flattered. I would love a little credit, you know, like that would be enough for me. I feel like, you know, I'm paid a weekly salary, or whatever. And to me like having that out there is inspiration, if somehow people knew that it was my photograph, I think for me that would be enough. But I'm like, I don't monetize everything. [laughs][177]

Related to the desire for attribution is the perception that the second artist, by not crediting the first, falsely presents their work as new—as an original artwork. For some, this was Shepard Fairey's failure. Failing to credit breaches ethical norms, which for them is synonymous with infringement. Craig Dale, a portrait and commercial photographer who also teaches photography, commented on the Fairey example, saying: "I think to present something as an original artwork, particularly as a portrait photographer, like if you're gonna present my portrait of somebody as your own original artwork, I'm gonna have a problem with that."[178] By contrast, presenting work in a way that uses the underlying work but only as a reference—drawing a Hitler moustache on a Trump photograph (an example Craig used in his interview)—does not create independent art or hold itself out as doing so. That kind of alteration is a more acceptable appropriation because, unlike the Shepard Fairey example, there is no

byline of the article as "a special portrait for *Vanity Fair* by ANDY WARHOL." Joint Appendix – Volume II, *supra* note 29, at 324.

As Alejandro's example demonstrates, attributive credit is a normative practice distinct from copyright law. Attribution is highly desirable among artists and providing it can squelch brewing lawsuits even when meritorious. SILBEY, *supra* note 136, at 153, 165–67, 283–84 (describing the importance of attribution). Students of copyright are often surprised to learn that giving or omitting credit does not coincide with avoiding or committing copyright infringement. Omitting credit is not a copyright violation, and providing credit does not avoid copyright liability or mean anything more, absent normative evidence in the specific industry. People want credit not necessarily because they are authors in the copyright sense, but to be recognized as part of a creative collaboration. For articles on the misalignment between IP—especially copyright—and attribution, see, e.g., Catherine L. Fisk, *Credit Where It's Due: The Law and Norms of Attribution*, 95 GEO. L.J. 49 (2006); Greg Lastowka, *Digital Attribution: Copyright and the Right To Credit*, 87 B.U. L. REV. 41 (2007); Rebecca Tushnet, *Naming Rights: Attribution and Law*, 2007 UTAH L. REV. 781.

176. For an example of this terminology in architecture, see Amanda Reeser Lawrence, *Standing on Precedent: An Argument for Instrumentalizing Architectural History*, *in* 2012 ASCA INTERNATIONAL CONFERENCE: CHANGE, ARCHITECTURE, EDUCATION, PRACTICES - BARCELONA 205 (2012), https://www.acsa-arch.org/proceedings/International%20Proceedings/ACSA.Intl.2012/ACSA.Intl.2012.31.pdf [https://perma.cc/RDS9-AXZ9] [https://web.archive.org/save/https://www.acsa-arch.org/proceedings/International%20Proceedings/ACSA.Intl.2012/ACSA.Intl.2012.31.pdf].

177. Interview with Martha (pseudonym), in Bos., Mass. (July 10, 2017).

178. Interview with Craig Dale, in Hoboken, N.J. (Sept. 17, 2018).

"disguising" that the underlying photograph is anything but the work of the first artist. To our ears, the demand for attribution resonates with prohibition against plagiarism, not copyright infringement.[179]

Michael Grecco, a commercial and editorial photographer who also runs a business pursuing online infringements on behalf of other photographers, combined these approaches. In terms of Fairey, Michael said:

> Shepard is a friend. If Shepard called me, and asked me to use it, I would'a told him yes. If you're a student, and you call me, and tell me you're doing a project, I say yes. I'm not gonna charge you if you have the courtesy to ask, and are conscious enough about copyright law, dependent on the circumstances.[180]

But then in terms of credit and attribution, he said "I get magazines and real websites call me, financial websites call me up, 'Oh you'll get credit.' I said 'Go fuck yourself. So do you take credit home to feed your family?'"[181] In this example, we see clearly the distinction between the benefit of asking permission and being granted it for certain uses, even if for near-exact copies, and the expectation that commercial entities that regularly license photographs to illustrate literary content should pay for them.

4. Defining Harms, Not Derivative Works

The harms photographers seek to avoid range from market substitution to protecting what they perceive as their moral rights (such as attribution and integrity). Both arise in the context of the preparation of derivative works, *but the harm is not the existence of a derivative work per se*. Some works "based on" or "adapted from" photographs will be welcome—even "flattering" if the resulting images qualify as good art. Others will be unwelcome if the second work somehow "disguises" the photograph when obviously being based upon it, thereby misattributing the artistry to the second author when the first should be credited. Some uses will be tolerated as new art, non-commercial, or charitable. Other uses (mostly exact or near-exact copies for illustration purposes) are objectionable because they are by those who usually hire photographers to make pictures or pay for licensed copies, whether it is in *Breitbart* or on the cover of a magazine. In these cases, photographers think they should be able to control those uses and exploit existing markets for their work. Contrary to the *Warhol* decision, use as an "artist reference" is not at all dispositive.

We conclude with a final example from James, a commercial and editorial photographer, who combined many of these perspectives in a single exchange. Like others, James insisted that permission be sought when one of his photographs was transposed into a painting.

179. *See* RICHARD POSNER, THE LITTLE BOOK OF PLAGIARISM (2007) (describing the difference between plagiarism and copyright infringement as the former being based in fraud and misrepresentation).

180. Interview with Michael Grecco, in Brooklyn, N.Y. (Dec. 1, 2017).

181. *Id.*

> Q: What if somebody made a painting of your photo?
>
> A: There we have a problem.[182]

By contrast, he does not mind if someone copies or is "inspired by" his photograph when that involves restaging his photograph and making one's own, even if the new photographer mimics the style of James's photograph. Doing the work of making new art, even if it resembles the old art, is part of being an artist.

> Q: But I can imagine trying to reproduce that [photo], for example. Not copying your picture, not right-click and copy, but saying, "I wanna make a picture that looks like [your] picture." Is that the same kind of problem? . . . I'm making a photo, trying to make it just look like [yours].
>
> A: Knock yourself out.
>
> Q: Why, that doesn't bother you at all?
>
> A: Does not bother me at all.
>
> Q: Why not? I could sell it instead of someone buying yours.
>
> A: Knock yourself out . . . .
>
> Q: Is that because I can't?
>
> A: No. It's just like I, I don't know that, I've been inspired by photographers, right? And it's . . . and it's, [sighs] I say this with all humility. I think it's easier to make the great picture than it is to make the picture that feels like a snapshot. . . . So taking some inspiration to have the desire to do that, I think that's a good thing.[183]

The "inspired" new work would be "based upon" James's photo (it would have been made *in reference* to James's photo) and might look a lot like his photo. But that "does not bother" him at all. James *does* object, however, to a painter making his photo into a painting, which we assume is a near-exact copy. Why? Both scenarios likely produce both derivative works and substantially similar copies. But the photographers we studied cared less about the mere existence of a "derivative work," or a "copy," or a use of their photographs as an "artist reference" and much more about:

- market substitution of the original photograph (they did not care as much about remakes or new art "inspired by" their photos);
- how their photos as photos (and not as a new art form) were being recontextualized and reused, if their meanings changed based on who was

182. Interview with James (pseudonym), in Bos., Mass. (May 21, 2018).
183. *Id.*

using the photo, or if the use served a cause or message with which they disagree;

- being *seen* as original artists and being referred to and recognized as authors, because taking without citation (either artistic credit or formal permission) offends both artistic practice and professional norms. This means that when other artists are making art, be it Shepard Fairey or perhaps Warhol, it is problematic to re-render the photograph into a photorealistic painting or dot-illustration, without more, and to fail to acknowledge the original artist.

C. ANSWERING *WARHOL*

Does any of the above history, facts, or analysis answer the real question at the center of *Warhol v. Goldsmith*: whether Warhol's *Prince Series*, made in 1984 with permission to "use [Goldsmith's photo] as [an] artist reference," infringes Goldsmith's copyright in her photographic portrait of Prince?[184] If we were to analyze that original question in light of the above explanations from working photographers, the invoice for "use as artist reference" in combination with the aesthetic features of the *Prince Series* does not prove infringement by Warhol but is likely dispositive of the opposite. The *Prince Series* are non-infringing works.

Warhol made his prints with permission from Goldsmith, the same way past artists made their work as described in Part II. Whether the situation is best described as an implied license,[185] or, given what was made, a non-infringing work, should not matter. What does matter is the following. Goldsmith received credit and payment for the original use on the cover of *Vanity Fair*, as requested by her agent and per the VF Invoice. The rest of the *Prince Series*, its copies and distribution, did not require payment to Goldsmith because Warhol was given the photo for "use as [an] artist reference" as part of his work for *Vanity Fair*, from which he produced the *Prince Series* as a whole. Warhol likely and fairly presumed he had permission to make the series because *Vanity Fair* handed him the Goldsmith photo in 1984.

This is a reasonable belief based on our understanding of professional photography and what permission to "use as an artist reference" means, especially when the resulting work is so distinctive of the new artist's effort and style. Warhol's *Prince Series* is not a mere "photorealistic" copy of Goldsmith's photo for which every use would be a market substitute for a Goldsmith and for which photographers agree permission would be

184. As described above, this question changed throughout the course of the litigation such that when the Supreme Court eventually decided the case, the Court narrowed it to only the use of *Orange Prince* on the cover of VANITY FAIR in 2016. *See supra* notes 25, 144.

185. *See supra* note 111 (discussing implied licenses). The implied license cases are relevant here, as is the fact of a copyright holder's "handing over" their work for various purposes which are, in turn, taken up. *See, e.g.*, Asset Mktg. Sys., Inc. v. Gagnon, 542 F.3d 748, 754–55 (9th Cir. 2008); Effects Assocs., Inc. v. Cohen, 908 F.2d 555, 558–59 (9th Cir. 1990).

required. Considering the historic examples in Part II and the accounts of photography practice and norms in Part III.B, reference photographs and the new work made with them are not market substitutes for each other because the new work is not a near or exact-copy and it usually stands on its own as an independently authored work. The authored second works—by Lautrec, Rockwell, or the artists who "flatter" the photographers with their new art based on the reference photographs—are separate works unencumbered by the reference photograph and are not considered unlawful. Likewise, the *Prince Series* is something new and stands on its own.

That the Goldsmith photo and one of the Warhol's Prince portraits could in principle (or in fact) each be on the cover of a magazine is irrelevant to AWF's liability. Almost anything can be on the cover of a magazine, and there are many options to illustrate an article about Prince, including other photographs of Prince or other contemporary art images of the rockstar.[186]

In 1984, permission might have been necessary from Goldsmith because access to the photograph was otherwise unavailable. But that does not mean that what Warhol made with the photograph required permission had he gotten hold of the photograph in another way. Relatedly, when in 2016, Condé Nast sought to use a new Warhol on its cover, Warhol (had he still been alive) and AWF should not have had to seek permission from Goldsmith because Warhol did not commit copyright infringement when he made the *Prince Series* in 1984. The independence of the *Prince Series* means that Warhol and AWF should not have had to pay for subsequent uses and copies of the *Prince Series* by other people—even on the cover of a magazine. Pursuant to tried-and-true practices between artists and especially after putting in his own effort and time making the series, Warhol's work became his own.[187]

Would credit be good, like liner notes on a musical album? Yes, it would, but of course, attribution is not part of copyright law.[188] To be sure, photographers appreciate attribution or citation to their reference photographs when the line is blurry between a near copy and something new. And in this way, Andy Warhol's primary mistake (or

186. Consider these examples of other artworks depicting Prince that could have also been on the cover of a magazine about him. *See, e.g.*, Dane Shue, *Prince Pop Art Portrait* (2023), Private Collection; Kathleen Carrillo, *Prince* (2023), Private Collection. For other photographs of Prince, see, e.g., Jeff Katz. Brianne Tracy, *Prince Like You've Never Seen Him Before: The Star's Longtime Photographer Shares Rare Photos and Private Memories*, PEOPLE (July 15, 2019), https://people.com/music/prince-rare-photos-jeff-katz-exclusive/ [https://perma.cc/LTK8-HF9J]
[https://web.archive.org/web/20240317231625/https://people.com/music/prince-rare-photos-jeff-katz-exclusive/].

187. If Warhol was a sub-licensee of VANITY FAIR under the VF Invoice, subject to its terms and limitations, Warhol was presumably unaware. The effect of such an arrangement, whereby Warhol's work produced by reference to Goldsmith's photograph is forever and wholly encumbered by Goldsmith's copyright in the underlying photograph, is contrary to established artistic practice and not clearly what the VF Invoice says or means. Apparently, Goldsmith finally conceded this point about the legality of the *Prince Series*. *See supra* notes 25, 144 (discussing Goldsmith's abandonment of her claims that the *Prince Series* is unlawful in its entirety).

188. For reasons discussed in the copyright literature, mandatory attribution is problematic as a legal rule and factual imperative. See *supra* note 175 (on attribution).

AWF's ongoing mistake) may have been failure to credit Lynn Goldsmith. But as mentioned *supra*, that is a question of ethical norms among artists in the way plagiarism norms are a matter of community standards in education and research.[189] Mandating that authors credit all references and sources of inspiration as a matter of copyright law is unworkable and, to many authors (perhaps especially to Warhol) is likely considered an intrusion into their artistic practice.[190]

Likewise, should Condé Nast have sought permission from and paid Goldsmith to re-run a Warhol Prince on its cover? Probably yes, given the explanations in our interviews that regular licensees and companies who hire photographers and distribute copies of their photographs (or reproduce versions of their photographs in other forms) should continue to pay for and support photographers. This seems especially true given that *Vanity Fair*'s agreement with Goldsmith was for "one time" use, "no other usage rights granted."[191] That invoice is best interpreted as "one time" use for Warhol (which it was—he made the whole *Prince Series* with the one time use in 1984) and "one time" use for *Vanity Fair* (which it was not—the magazine and its parent company Condé Nast ran a Warhol based on the photo twice). What does that mean for Condé Nast? It breached an agreement with Goldsmith, for which it might owe Goldsmith the reasonable value of a license negotiated ex ante the breach. But it did not commit copyright infringement.

* * * * *

The variation in our data and in professional photographic practice leads to the conclusion that not all uses of artist references must be licensed to avoid infringement liability. Instead, it is necessary that courts explicitly engage with aesthetics and context before they arrive at a conclusion of infringement or noninfringement between two works. And this applies equally to use of an artist reference by a second artist who was a contractual stranger to the first.

But when expressly authorized, artist references are simply permissions to use—a ticket to entry, permission for access to the work in its tangible and intangible forms.[192]

189. *See supra* Part III.B.3.

190. See, e.g., discussions of Andy Warhol's innovation as a contemporary artist as questioning the possibility of originality and the place of "the copy" in modern art, in ARTHUR C. DANTO, ANDY WARHOL (1997); ARTHUR C. DANTO, WHAT ART IS (2013). *See also* ROSALIND E. KRAUSS, THE ORIGINALITY OF THE AVANT-GARDE AND OTHER MODERNIST MYTHS (1986); Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23, 34–35 (2003) (highlighting the challenges of using trademark law for the purposes of authorial attribution, especially when copyright law only provides for attribution for limited works under the Visual Artists Rights Act).

191. *See supra* note 18 and accompanying text.

192. *See supra* note 101 describing an artist reference as a kind of bailment when works are inaccessible as a physical matter. When use is not expressly authorized, the question is even more straightforward, at least for the photographers we studied: Is the new work a near or exact-copy of the reference photograph, or does it stand alone as a new work and with independent authorship that distinguishes it from the photograph?

And, as importantly, they are the *beginning* of an artistic process. Artist references are just that—references. What the new author produces based on the artist reference makes all the difference, and legal liability depends on (or should depend on) aesthetic evaluation of both the referenced work and the new work. Avoiding that aesthetic evaluation and deferring to an express or implied agreement "to use as an artist reference" is a shortcut that deforms copyright law and creative practice.

For future courts, resolution of the question whether the use of an artist reference produces an infringing work or is a fair use must be informed by aesthetic judgment. How could it not be?[193] Courts and lawyers must ask: What do the first and second works look like? What is the purpose or context for the second work? What are the customary practices and relationships between the parties?[194] Certainly, infringement should not depend on the mere existence of an agreement to use the photograph as an artist reference, which could produce almost anything—even subsequent works with no resemblance to the photograph.[195]

The evidence in *Warhol* about the Goldsmith-*Vanity Fair* transaction to use her photo as an "artist reference" reflects an age-old practice between photographers and artists of making all kinds of art free from further permission, infringement liability, and other encumbrances. The Supreme Court decision and its formalistic interpretation of the *Vanity Fair* invoice distorted the relevance of this historical practice and should not constrain future artists.

IV. CONCLUSION

Although the Court in *Warhol* might have made it seem otherwise, photographers do not view every adaptive use of their photographs to constitute infringement. Photographers' aesthetic and professional practices are both overinclusive and underinclusive of the legal rules defining an infringing derivative work. The overinclusiveness concerns, which constitute claims of distortion and attribution, are largely irrelevant to the legal analysis in the *Warhol* case. These practices may be helpful to avoid lawsuits, but play little role in the infringement or fair use analyses.[196]

193. *See supra* note 142 (quoting the dissent's critique on this point).

194. Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 562 (1985) ("The crux of the profit/nonprofit distinction is not whether the sole motive of the use is monetary gain but whether the user stands to profit from exploitation of the copyrighted material without paying the customary price."). This often-quoted sentence from *Harper & Row* begs the question: The "customary price" for which use?

195. Otherwise put, the fact that permission to use was obtained does not mean it was needed; the fact that many artists do not obtain permission to use is not a lapse on their part. It all depends on what is made with the use.

196. The copying norms literature can be helpful to explain misalignment between different artistic communities who may sometimes face each other in court. For example, in *Sedlik v. von Drachenberg*, No. CV 21-1102 DSF (MRWx), 2023 WL 6787447 (C.D. Cal. Oct. 10, 2023), a photographer sued a tattoo artist for her rendition of his photo of Miles Davis as a tattoo on her friend's arm, and the court denied summary judgment and sent infringement claims and most elements of fair use to the jury, which returned a verdict of no infringement. *Compare* Aaron Perzanowski, *Tattoos & IP Norms*, 98 U. MINN. L. REV. 511 (2013) (explaining tattoo artists' practice of copying reference art by other artists but not further copying custom

The practices most instructive for the legal question in *Warhol* concern photographers' tolerance for use by other artists who make "inspired by" versions and artistic adaptations that foreground the new artists' style and efforts. This evidence conforms with historic practice of "artist references" and copyright case law since 1976. Both explain that an infringing use of a photograph more frequently resembles a substantially similar copy of the photograph or a "photorealistic" adaptation in another form, used in the same context as the original photograph and without permission from the original author.

None of this was true in *Warhol*. Andy Warhol's *Prince Series* was made with permission from Goldsmith, is an example of contemporary pop art, and does not share the aesthetic character and qualities of Goldsmith's photorealistic portrait of Prince. The Court could have paid more attention to these practices between artists of "use as an artist reference," all of which is relevant to construing the VF Invoice and the intent between the parties. The everyday practice of artists should matter when the everyday practice of art is at stake.[197]

tattoos on other people), *with* Silbey et al., *supra* note 6, *and* Silbey, *supra* note 6, at 437–40 (explaining photographer expectations that exact and near-exact copies of their photographs will be licensed). It is also possible that outlier community members are more prone to file or be part of lawsuits. Also, there is some evidence that in recent years, photographers are more frequently filing lawsuits than other individual artists (or authors generally). *See* Melissa Eckhause, *Fighting Image Piracy or Copyright Trolling? An Empirical Study of Photography Copyright Infringement Lawsuits*, 86 ALBANY L. REV. 111 (2023); *cf.* SILBEY, *supra* note 137, at 314–15 (explaining how the photographer case study was derived from an initial, but erroneous assumption that photographers were outliers among artists as to the reasons for and mechanisms by which they protect their work and earn a living). In the context of *Warhol*, Lynn Goldsmith threatened but did not file suit. AWF filed the declaratory judgment action. If what Goldsmith really wanted was a $10,000 license from Condé Nast (and her initial counterclaim seeking invalidation of Warhol's art was just litigation bluster), her preference would have been consistent with our interview data of photographers. As we understand, neither Goldsmith nor AWF involved Condé Nast in the lawsuit, possibly because Condé Nast is a major licensee of both photographers and artists, and suing an entity who is a major source of licensing revenue is bad business.

197. Of course, when overriding fundamental or constitutional principles are at stake, everyday practices may have to give way.