19-2420-cv

United States Court of Appeals

for the

Second Circuit

THE ANDY WARHOL FOUNDATION FOR THE VISUAL ARTS, INC.,

Plaintiff-Counter-Defendant-Appellee,

v. –

LYNN GOLDSMITH, LYNN GOLDSMITH, LTD.,

Defendants-Counter-Plaintiffs-Appellants.

On Appeal from the United States District Court for the
Southern District of New York in No. 17-cv-02532,
Hon. John G. Koeltl

BRIEF OF *AMICUS CURIAE* PROFESSOR AMY ADLER IN SUPPORT OF PETITION FOR PANEL REHEARING AND REHEARING *EN BANC*

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INTEREST OF *AMICUS CURIAE*

Professor Amy Adler is the Emily Kempin Professor of Law at New York University School of Law.[1] As a professor who teaches and writes about art law and the First Amendment, Professor Amy Adler has an interest in the proper interpretation and application of the First Amendment and copyright law to art. Because the panel opinion threatens to chill the creation of new works of art, Professor Amy Adler supports the petition for panel rehearing and rehearing *en banc*, and has filed a motion for leave to file this brief.[2]

[1] This affiliation is provided for identification purposes; this brief does not purport to present the institutional views, if any, of New York University School of Law.

[2] This brief was authored solely by *Amicus Curiae* and her counsel. No part of this brief was authored by counsel to a party, and no person other than *Amicus Curiae* or her counsel made a monetary contribution to the preparation or submission of this brief.

ARGUMENT

By making its own views on the merits of Andy Warhol's artistic work determinative and ignoring the meaning and the message his art may have for the artistic community, the panel runs afoul of the First Amendment. Panel rehearing or *en banc* review is warranted to resolve the irreconcilable conflict between the panel opinion and the Supreme Court's First Amendment precedent. Fed. R. App. P. 35(a).

I. THE FAIR USE DOCTRINE IS A FIRST AMENDMENT SAFEGUARD FOR ALL WORKS THAT USE PREEXISTING EXPRESSION

Copyright law restricts speech and presents a clear tension with the First Amendment. Copyright law is compatible with the First Amendment only because of two "built-in First Amendment accommodations"—the idea/expression dichotomy (which is not at issue here) and fair use. *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003).

Fair use protects the First Amendment rights of both speakers and listeners by ensuring that those whose speech involves dialog with preexisting copyrighted works are not prevented from sharing that speech with the world. *See Golan v. Holder*, 565 U.S. 302, 329 (2012) (the "First Amendment protections" embodied in fair use require courts to afford "considerable latitude for scholarship and comment"). As Judge Leval explained, "fair use serves as the First Amendment's

agent within the framework of copyright." Pierre N. Leval, *Campbell As Fair Use Blueprint?*, 90 Wash. L. Rev. 597, 614 (2015). It is only because of fair use and the idea/expression dichotomy—the two "speech-protective purposes and safeguards embraced by copyright law"—that copyright law has avoided the "heightened review" often merited when Congress limits the freedom of speech. *Golan*, 565 U.S. at 329.

Notably, fair use "allows the public to use not only facts and ideas contained in a copyrighted work, but also expression itself[.]" *Eldred*, 537 U.S. at 219. Interpreting fair use to flatly exclude any work in which the preexisting work "remains . . . recognizable," as the panel did here (Op. 31), grants copyright owners the very monopoly on certain forms of expression that fair use was intended to prevent. This not only undermines copyright law, but conflicts with the First Amendment.

II. THE PANEL OPINION IS INCONSISTENT WITH THE FIRST AMENDMENT BECAUSE IT IGNORES THE MEANING AND MESSAGE OF WARHOL'S ART

The Supreme Court has cautioned that courts should not style themselves as art critics passing on the worth and meaning of artistic works. As Justice Holmes explained:

> It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme, some works

> of genius would be sure to miss appreciation. . . . It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time.

Bleistein v. Donaldson Lithographic Co., 188 U.S. 239, 251 (1903).

In its attempt to fashion a test that avoids that trap, the panel opinion instead fell directly into it. The panel focused solely on the aesthetic similarity between Warhol's series of paintings and the underlying photograph of Prince, and dismissed the possibility of any meaning or message that did not appear on the surface. Yet *Campbell* establishes that courts must view a work as transformative if it adds a new "meaning or message," even if they themselves don't "get" the message, so long as an audience may reasonably perceive it. *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579, 582 (1994) (the question is whether transformative meaning "may reasonably be perceived," not whether the new expression "is in good taste or bad").

But the panel established a rule that, when two works are facially similar enough, they are never transformative. *See* Op. 28 ("[T]he secondary work's transformative purpose and character must, at a bare minimum, comprise something more than the imposition of another artist's style on the primary work such that the secondary work remains both recognizably deriving from, and retaining the essential elements of, its source material."). That is, the panel assumed that works that are facially similar can *never* differ in their purpose and

can *never* convey a different expression, meaning, or message. To make matters worse, the panel disavowed any inquiry into the meaning of a work, stating that courts should not "seek to ascertain the . . . meaning of the works at issue." Op. 27. But if you ignore a work's meaning and message, then you ignore the essence of its expressive value.

That rule is inconsistent with the First Amendment. The First Amendment recognizes that communication can take many different forms and requires courts to consider the variety of meanings that can reasonably be attached to a particular work by different observers. What is to one person an "unseemly expletive" is to another a powerful message; "one man's vulgarity is another's lyric." *Cohen v. California*, 403 U.S. 15, 23, 25 (1971) (jacket reading "Fuck the Draft" was protected speech because the Court looked beyond the "cognitive content" of speech to protect the "emotive function" beneath the surface "which, practically speaking, may often be the more important element of the overall message sought to be communicated"); *see also Hannegan v. Esquire, Inc.*, 327 U.S. 146, 157–58 (1946) ("What is good literature, what has educational value, what is refined public information, what is good art, varies with individuals as it does from one generation to another. . . . But a requirement that literature or art conform to some norm prescribed by an official smacks of an ideology foreign to our system."). Indeed, the very same word can convey radically different meanings based on who

uses it and in what context. *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017) (trademark office violated the First Amendment when it denied registration of the name of a rock band chosen by a member of a minority group to "recapture" a racial slur directed at that group); *see also Iancu v. Brunetti*, 139 S. Ct. 2294, 2299 (2019) (the Lanham Act's bar on registration of "immoral[] or scandalous" trademarks violates the First Amendment).

A speaker's message need not be facially obvious for her speech to be constitutionally protected: The Supreme Court has expressly recognized that the First Amendment does not require "a narrow, succinctly articulable message." *Hurley v. Irish-American Gay, Lesbian and Bisexual Group of Boston*, 515 U.S. 557, 569 (1995) (parade was constitutionally protected speech even absent a "particularized" message). Otherwise, the First Amendment would "never reach the unquestionably shielded painting of Jackson Pollock, music of Arnold Schöenberg, or Jabberwocky verse of Lewis Carroll." *Id.*; *see also Cohen*, 403 U.S. at 26 (linguistic speech "conveys not only ideas capable of relatively precise, detached explication, but otherwise inexpressible emotions as well"). As the Supreme Court warned in *Pope v. Illinois*, the First Amendment protects a work even if its meaning is appreciated by only a "minority of a population." 481 U.S. 497, 501 n.3 (1987). When confronted with a work of art, courts must therefore consider all of the work's potential audiences and the messages those audiences

may reasonably perceive, or risk running afoul of the First Amendment. *See Cohen*, 403 U.S. at 25 ("[W]e think it is largely because governmental officials cannot make principled distinctions in this area that the Constitution leaves matters of taste and style so largely to the individual."). In other words, the First Amendment's answer to the difficulty of discerning the meaning or message of speech is to err on the side of permitting speech where it would be permissible if considered from the perspective of *some* relevant observer.

The Supreme Court made this clear in *Pleasant Grove City, Utah v. Summum*, 555 U.S. 460 (2009). In *Summum*, the Court analyzed whether the First Amendment required a city to allow a private group to place a donated monument in a park in which other donated monuments were already present. The Court held that the city was not required to accept the monument, reasoning that the placement of a monument is a form of government speech. *Id.* at 470–71. In arguing otherwise, the would-be monument donor warned that the government speech doctrine could be used as a "subterfuge for favoring certain private speakers over others based on viewpoint," and suggested that a government entity accepting a privately donated monument should be required to adopt a formal resolution publicly embracing the monument's "message." *Id.* at 473.

The Court disagreed. The Court explained that the donor's argument assumed "that a monument can convey only one 'message'—which is,

presumably, the message intended by the donor—and that, if a government entity that accepts a monument for placement on its property does not formally embrace that message, then the government has not engaged in expressive conduct." *Id.* at 474. But that argument "fundamentally misunderstands the way monuments convey meaning." *Id.* Rather than conveying a simple message, "the monument may be intended to be interpreted, and may in fact be interpreted by different observers, in a variety of ways." *Id.* Accordingly, "it frequently is not possible to identify a single 'message' that is conveyed by an object or structure, and consequently, the thoughts or sentiments expressed by a government entity that accepts and displays such an object may be quite different from those of either its creator or its donor." *Id.* at 476. Thus, the Court recognized, "text-based monuments are almost certain to evoke different thoughts and sentiments in the minds of different observers, and the effect of monuments that do not contain text is likely to be even more variable." *Id.* at 475.

So too with art. Consider Marcel Duchamp's *Fountain*. Is *Fountain* one of the most important works of twentieth century art, or is it just a urinal? Different people would likely answer that question differently. But courts can neither decide who is right nor ignore the question: The First Amendment requires courts to consider the wide variety of possible meanings conveyed by a work of art. And it accordingly protects Duchamp's message.

The panel opinion does the opposite. Rather than take into account the meaning or message of Warhol's art, the panel erases its potential meaning from the fair use analysis entirely. The panel held that a work of art that "recognizably derive[s] from, and retain[s] the essential elements of," a pre-existing work can *never* be transformative. Op. 28. The panel did not care whether Warhol's work has a different potential meaning or message than the photograph on which it was based: Under the panel's test, that question is irrelevant if the new work is too similar in appearance to the original work. That violates the First Amendment.

The panel's error in disregarding the Supreme Court's guidance with respect to both fair use and the First Amendment is particularly egregious in this case because of Warhol's recognized influence on modern art and on a whole generation of artists working today who will be chilled by this ruling. Indeed, the panel ignored the very expression that makes Warhol a pivotal figure in twentieth century art. You cannot protect the First Amendment value of a Warhol work, or many works of art, by looking only at their surfaces and disregarding underlying meaning. Scholars can and do differ over whether we should view art from the artist's perspective or the plaintiff's perspective or the perspective of a reasonable audience member or the perspective of a viewer with some familiarity with art. *See* Rebecca Tushnet, *Judges as Bad Reviewers: Fair Use and Epistemological Humility*, 25 Law & Lit. 20 (2013); Amy Adler, *Fair Use and the Future of Art*, 91

N.Y.U. L. Rev. 559 (2016); Jeanne C. Fromer & Mark A. Lemley, *The Audience in Intellectual Property Infringement*, 112 Mich. L. Rev. 1251 (2014). But virtually all of those perspectives see something new and important in Warhol's work. Fair use is supposed to "guarantee [] breathing space within the confines of copyright[.]" *Campbell*, 510 U.S. at 579. The silkscreen prints by Andy Warhol are some of the most widely recognized and iconic works of the twentieth century, taught to every student of modern art. *See* 1 H.H. Arnason & Elizabeth C. Mansfield, *History of Modern Art* 477 (7th ed. 2013) (introductory textbook on modern art discussing how Warhol's silkscreens "examin[e] . . . contemporary American folk heroes and glamourous movie stars"); *see also* The Metropolitan Museum of Art, *Andy Warhol, Marilyn*, in *The Metropolitan Museum of Art Guide* 233 (2012) ("Warhol's embrace of commercial methods transformed Marilyn's image" by recasting it as a consumer product). But if fair use does not even protect these familiar works, it is difficult to see how there can be any breathing room for new artists or forms of art that challenge a judge's notions of what counts as art.

By insisting that courts evaluate art only from the perspective of someone who sees only what is on the surface, the panel opinion not only excludes a wide swath of transformative works from the protection of fair use, but also contravenes the Supreme Court's guidance that speech can convey a wide variety of messages, even if those messages are not facially obvious to a court. The panel's failure to

consider the variety of meanings that can be attached to a particular work by different observers is therefore inconsistent with the Supreme Court's speech jurisprudence. Just as the Court in *Summum* could not properly take the monument at issue in that case at face value, just as the Court in *Tam* could not properly take the trademark at issue in that case at face value, just as the Court in *Hurley* could not take the parade at issue in that case at face value, so the court in this case may not take the painting at issue in this case at face value.

"First Amendment protections do not apply only to those who speak clearly, whose jokes are funny, and whose parodies succeed." *Yankee Pub. Inc. v. News Am. Pub. Inc.*, 809 F. Supp. 267, 280 (S.D.N.Y. 1992) (Leval, J.) (quoted in *Campbell*, 510 U.S. at 579). And likewise, First Amendment protections do not apply only to artists whose message appears plainly on the face of their artwork. This Court should take the case *en banc* to resolve the irreconcilable conflict between the panel opinion and the Supreme Court's context-focused First Amendment analyses in *Cohen*, *Hurley*, *Summum*, and *Tam*.

CONCLUSION

For these reasons, rehearing should be granted to ensure that this Court's fair use precedent comports with the First Amendment.

Dated: April 30, 2021

Respectfully submitted,

By: */s/ Mark A. Lemley*

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CERTIFICATE OF COMPLIANCE

I hereby certify that this brief, according to the word-processing program with which it was prepared, complies with Rule 29(b) of the Federal Rules of Appellate Procedure in that it has a typeface of 14 points and contains 2,588 words.

DATED: April 30, 2021

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CERTIFICATE OF SERVICE

I hereby certify that on April 30, 2021, I electronically filed the foregoing with the Clerk of the Court for the United States Court of Appeals for the Second Circuit by using the CM/ECF system. I certify that all participants in the case are registered CM/ECF users and that service will be accomplished by the CM/ECF System.

DATED: April 30, 2021

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