11-1197-cv

IN THE
UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

PATRICK CARIOU

Plaintiff-Appellee,

v.

RICHARD PRINCE,

Defendant-Appellant,

GAGOSIAN GALLERY, INC., LAWRENCE GAGOSIAN,

Defendants-Appellants.

On Appeal from the United States District Court
for the Southern District of New York

BRIEF OF AMICUS CURIAE THE ANDY WARHOL FOUNDATION FOR THE VISUAL ARTS, INC. IN SUPPORT OF DEFENDANTS-APPELLANTS AND URGING REVERSAL

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CORPORATE DISCLOSURE STATEMENT

Pursuant to Federal Rule of Appellate Procedure 26.1, counsel for amicus curiae certifies the following information:

The Andy Warhol Foundation for the Visual Arts, Inc. has no parent corporation, and no publicly held corporation owns ten percent or more of its stock.

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STATEMENT OF INTEREST

The district court's judgment and the sweeping injunction it issued implicate important rights of free speech and artistic expression. The Andy Warhol Foundation for the Visual Arts, Inc. has an especially strong interest in making sure that copyright law provides sufficient protection for original works of authorship, while preserving the freedom to use those works to create new forms of artistic expression.[1]

Founded upon Mr. Warhol's death, the Foundation advances the visual arts by promoting the creation, presentation and documentation of contemporary art. It has made grants totaling more than $200 million to fund individual artists, scholars, researchers, museums and other organizations, including The Andy Warhol Museum. All of its work is premised upon the belief that art reflects an important cultural dialogue, and that freedom of artistic expression is fundamental to a democratic society.

That commitment is evident in the Foundation's approach to the intellectual property it owns. The Foundation charges licensing fees for the use of Mr. Warhol's work in connection with commercial goods and

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[1] All parties consented to the filing of this brief. No party's counsel authored this brief in whole or in part, and no party or its counsel contributed money that was intended to fund preparing or submitting this brief. Nor did any other person (besides the Warhol Foundation or its counsel) contribute money that was intended to fund preparing or submitting this brief.

services, and those fees provide important support for its funding activities. Like any copyright owner, the Foundation reserves the right to assess on a case-by-case basis whether any particular use might infringe upon its rights. But it makes that assessment with careful consideration of the free speech and expressive interests that are at stake when it comes to the creation of art. The Foundation therefore does not object to other artists building freely on Mr. Warhol's work in the creation of new art, because it recognizes that such freedom is essential to fulfilling copyright's goal of promoting creativity and artistic expression. In short, it applies the same balanced respect for copyright owners and new creators that it urges in the pages below.

INTRODUCTION

Thirty paintings (and a book about them) have been declared unlawful; most have been impounded and stand subject to destruction. Each is a highly expressive work in the *Canal Zone* series by the renowned and controversial artist Richard Prince. The reason these paintings were declared unlawful is because they use imagery from photographs of Rastafarians taken by the artist Patrick Cariou. Some of Prince's paintings use a substantial amount of imagery from Cariou's photographs:

Richard Prince, *It's All Over* (2008) at A-257
Collage, inkjet, and acrylic on canvas; 80 x 120 1/4"

In others, Cariou's work is almost undetectable:

Richard Prince, *Pumpsie Green* (2008) at A-265
Collage, inkjet, and acrylic on canvas; 77 x 100 1/2"

Prince's appropriation is part of a long and important tradition in visual art. For centuries, artists have used existing images to create new works of original expression. These works convey meaning that may be easy or difficult to describe but is nonetheless different than the meaning of the individual elements they incorporate.

The district court's decision in this case threatens this artistic tradition by applying a fair use standard that is contrary to controlling law. It refuses to recognize any expressive interest or transformative meaning other than parody or direct commentary, and adopts the mistaken premise that the meaning of art can be defined strictly by the intent of the artist, or ignored altogether based on the artist's failure to verbalize that meaning to a court's satisfaction. The district court compounded these errors when it enjoined and impounded Prince's work. It ignored the controlling injunction standard set forth by the Supreme Court in *eBay, Inc. v. MercExchange* and all of the equitable factors that account for the important speech and expression interests this injunction implicates.

Serious as they are, these errors conceal a bigger problem. The fair use doctrine is the principal mechanism by which copyright balances the need for strong incentives with the need to leave room for new creativity. It is, in the words of the Supreme Court, a "First Amendment safeguard" that

protects important public speech interests and ensures copyright will not stifle the creativity it is supposed to encourage. In order to fulfill its First Amendment function, fair use analysis must protect expressive interests that go beyond parody or direct commentary, and must acknowledge the meaning of art cannot be determined solely by the opinions of the artist. It must provide enough breathing space for artists to use the images that surround us to say something about the world, or to imagine a different one – even if some think it displeasing or depraved. It should recognize that expressive artistic uses create new meaning that is often difficult to describe, or uncomfortable to view. It should recognize that automatically reserving to copyright owners the market for expressive artistic uses of their work presents the same danger as reserving the market for criticism and parody: copyright owners will often try to censor expression they do not like.

When a court is asked to determine the lawfulness of artistic expression, and forever enjoin its distribution or display, it is especially important to get the standard right. This Court should correct the district court's errors, and clarify the proper application of the fair use analysis and the injunction standard to expressive artistic uses of visual images.

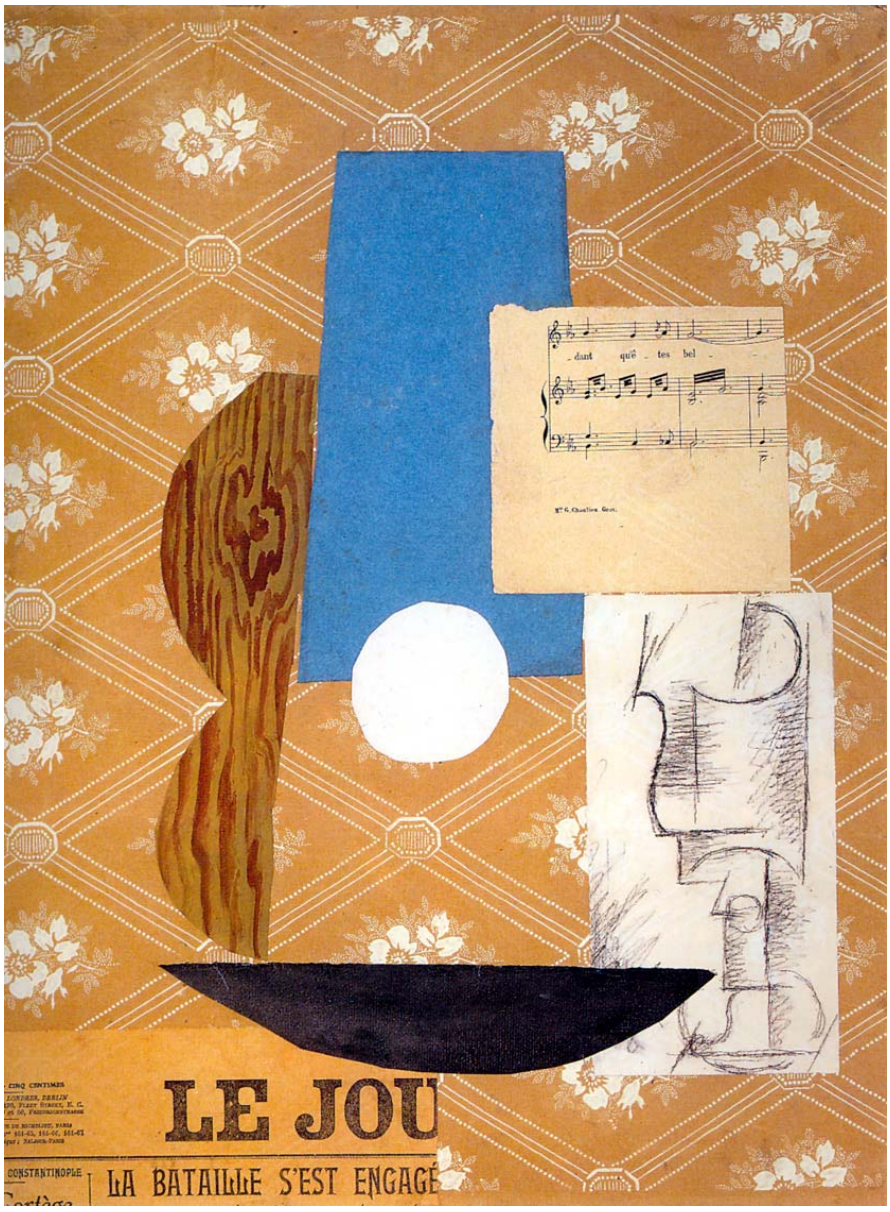
ARGUMENT

I. The Use Of Existing Imagery Is A Critical Component Of Artistic Expression.

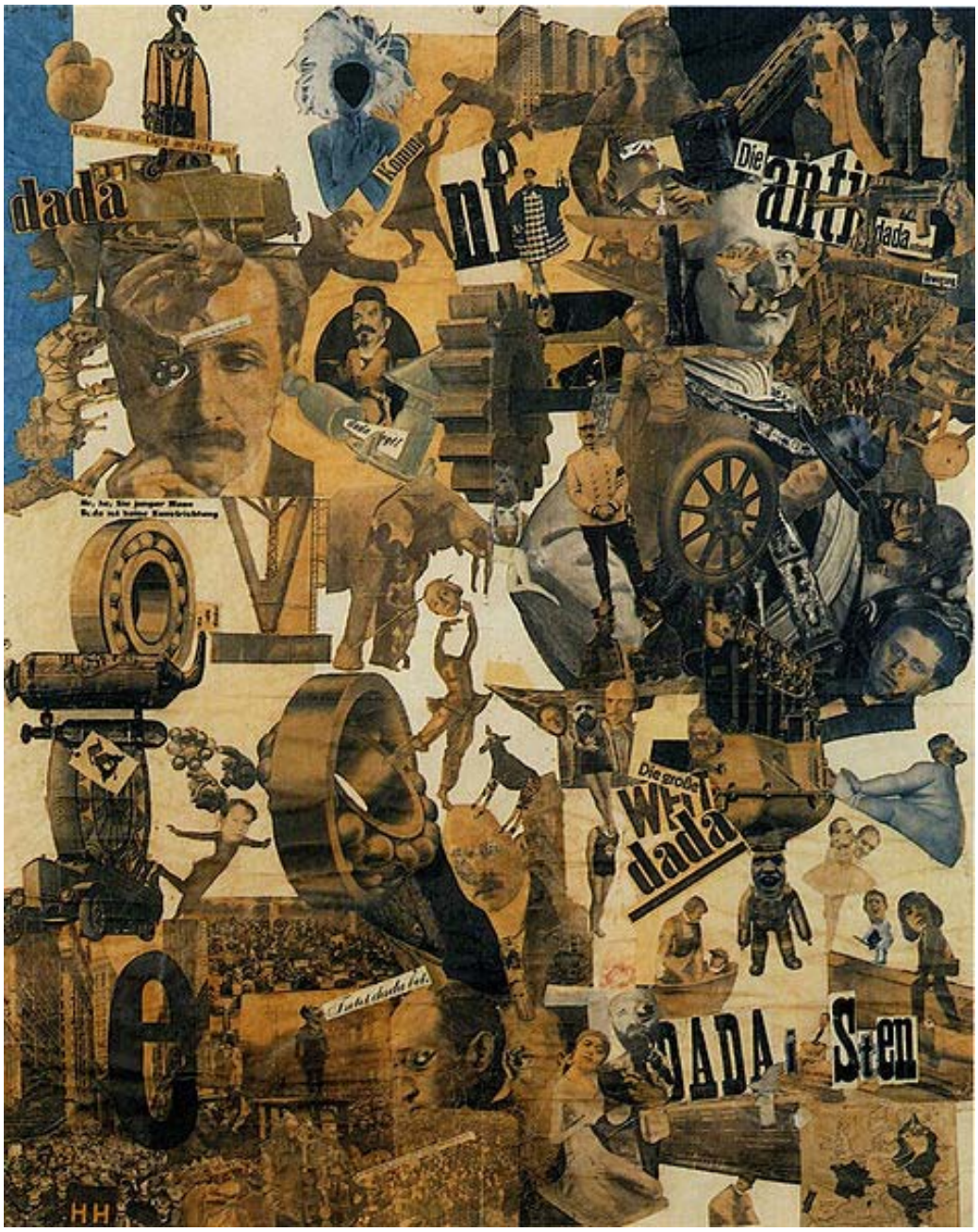
Artists have used existing imagery to create new meaning since long before photography was invented. Museums around the world preserve and display treasured works that appropriate a wide array of imagery from myriad sources, depending upon the artist's need to communicate. These works may pay homage to other artists, engage other art or images, or refer to subjects and ideas represented by other imagery. The author or specific source of the imagery may be easy to identify; in other cases imagery may be used because it is representative of a type or genre, such as documentary photography or advertising. Regardless, audiences attribute distinct new meaning and assign independent value to these creative uses of existing imagery.

Prince's artistic strategy of appropriating and collaging photographic images has origins dating back more than a century. *See* Brandon Taylor, *Collage: The Making of Modern Art* (2004); Richard Flood, Laura Hoptman and Massimiliano Gioni, *Collage: The Unmonumental Picture* (2007). In the early 1900's, artists began incorporating physical material bearing images (and text) into their work to more directly reference the world around them, communicate awareness of burgeoning popular media and explore new

methods for creative expression. The combination – and often the collision – of these disparate images and materials generated new meaning quite different from that attached to the individual elements used, as illustrated by the now canonical examples of Cubist and Dada collage below:



Pablo Picasso, *Guitar, Sheet Music and Glass* (1912)
Collage with gouache on paper; 18 7/8 x 14 3/8"



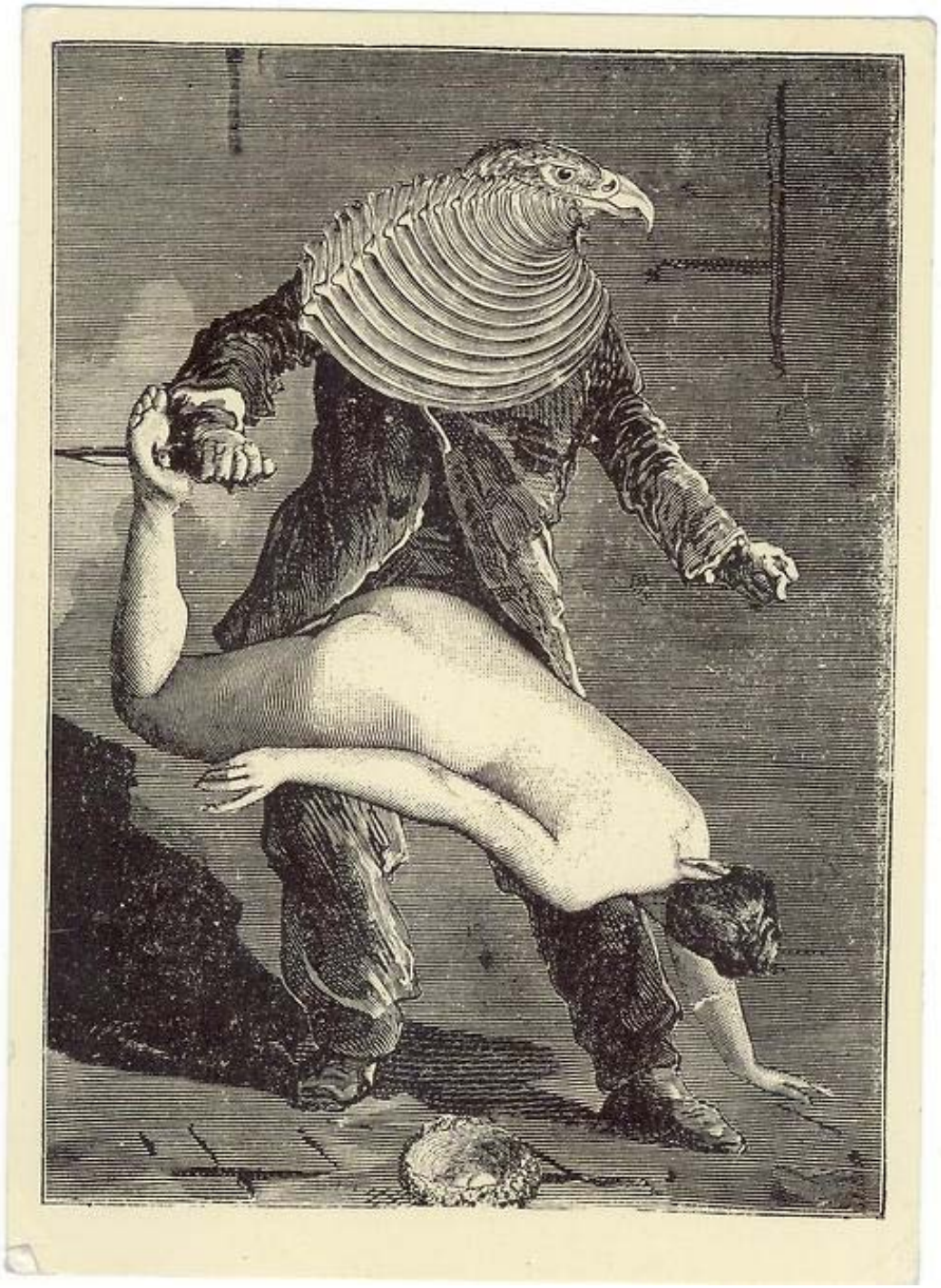
Hanna Hoch, ***Cut With the Kitchen Knife through the Last Weimar Beer-Belly Cultural Epoch in Germany*** **(1919-20)**
Collage with watercolor on paper; 44 7/8 x 35 7/16"

Around the same time, artists developed strategies that took existing "readymade" and "found" objects from everyday or natural contexts, and used them to create new works of art, often with minimal alteration. Marcel Duchamp described this as creating a "new thought for [the] object." *See* Rudolf E. Kuenzli and Francis M. Naumann, *Marcel Duchamp: Artist of the Century* 76 (1989). This practice furthered the understanding of existing images as raw material available for new expression.

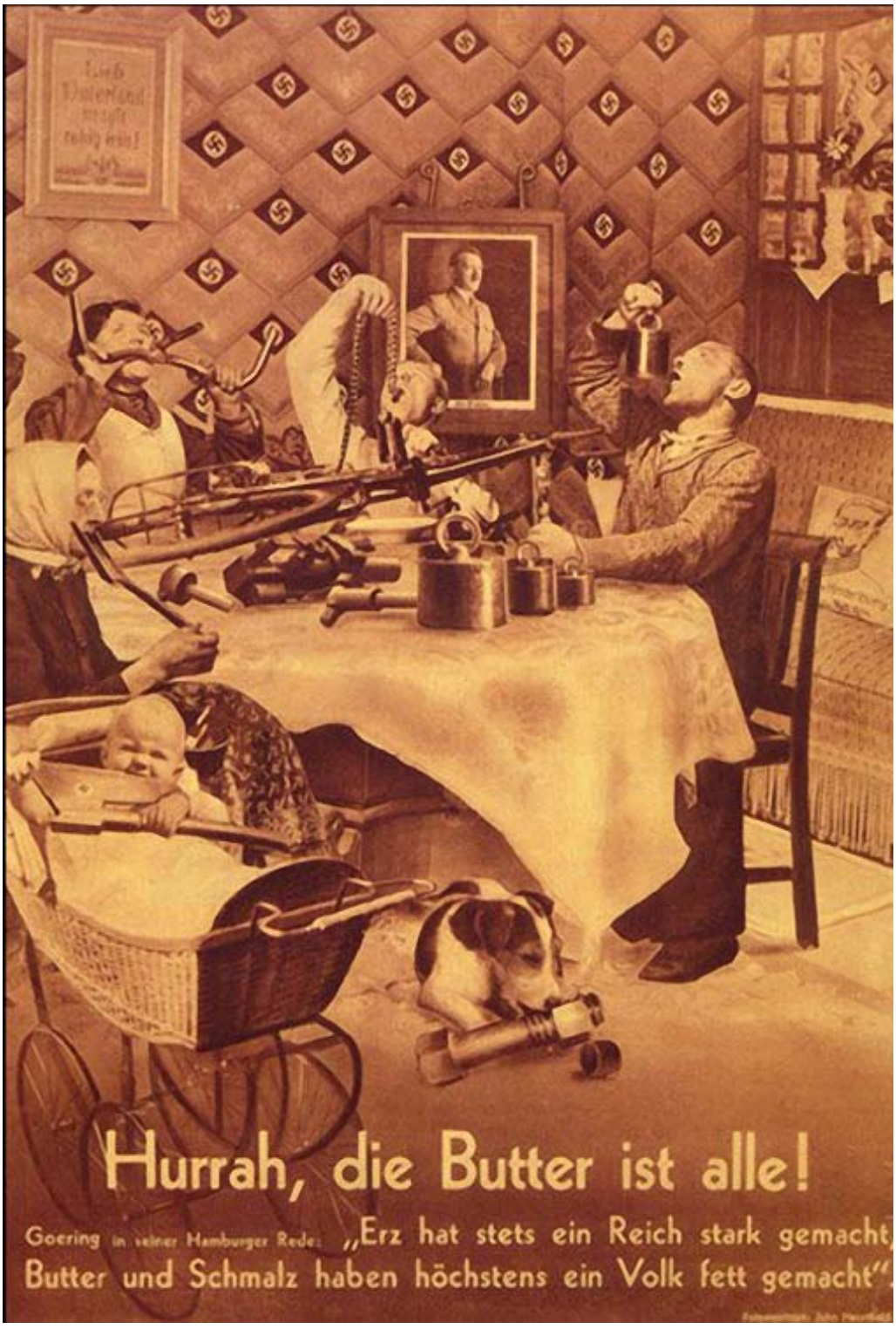
Marcel Duchamp, *L.H.O.O.Q.* (1919)
Pencil on postcard reproduction; 7 3/4 x 4 7/8"

Over the course of the twentieth century, strategies of collage and appropriation of existing imagery evolved. As photo-based imagery and technologies of reproduction became ubiquitous, artists increasingly employed the techniques as well as the imagery of mass media. Max Ernst and John Heartfield created collages that appear to "seamlessly" join numerous images from existing print sources in works intended to be reproduced and distributed in mass publication format. Robert Rauschenberg and Andy Warhol used processes like silk-screening to create repetition both within individual works and within series, adding other dimensions of meaning. Collage and other forms of appropriation have also become prevalent in art using film, video and digital media.

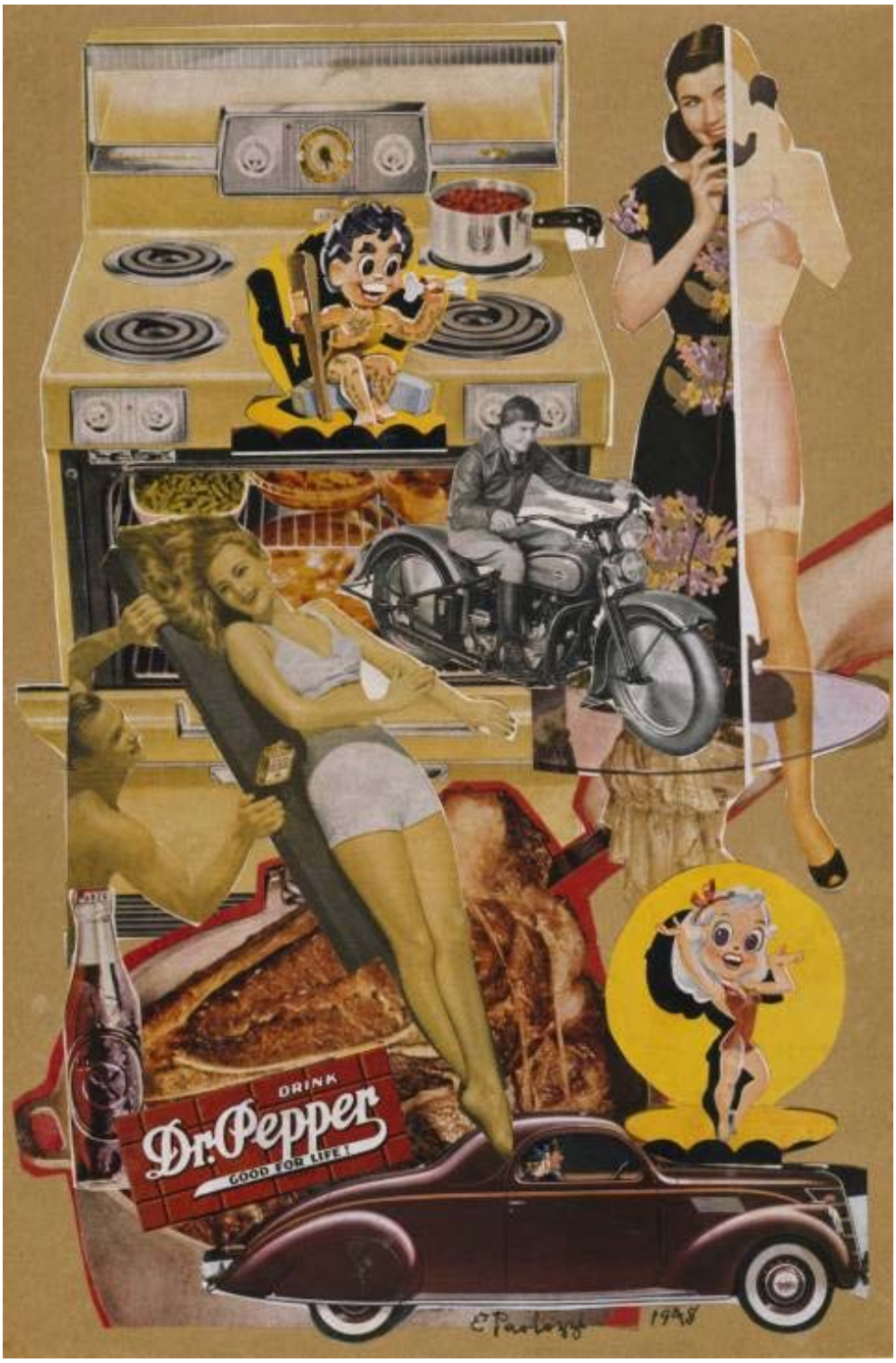
While its history cannot be reduced to neat categories, the enormous range of art that uses existing imagery demonstrates the centrality of this practice in so many strikingly different movements, from Surrealism to "photomontage" to Pop Art, just to mention several well-known examples:



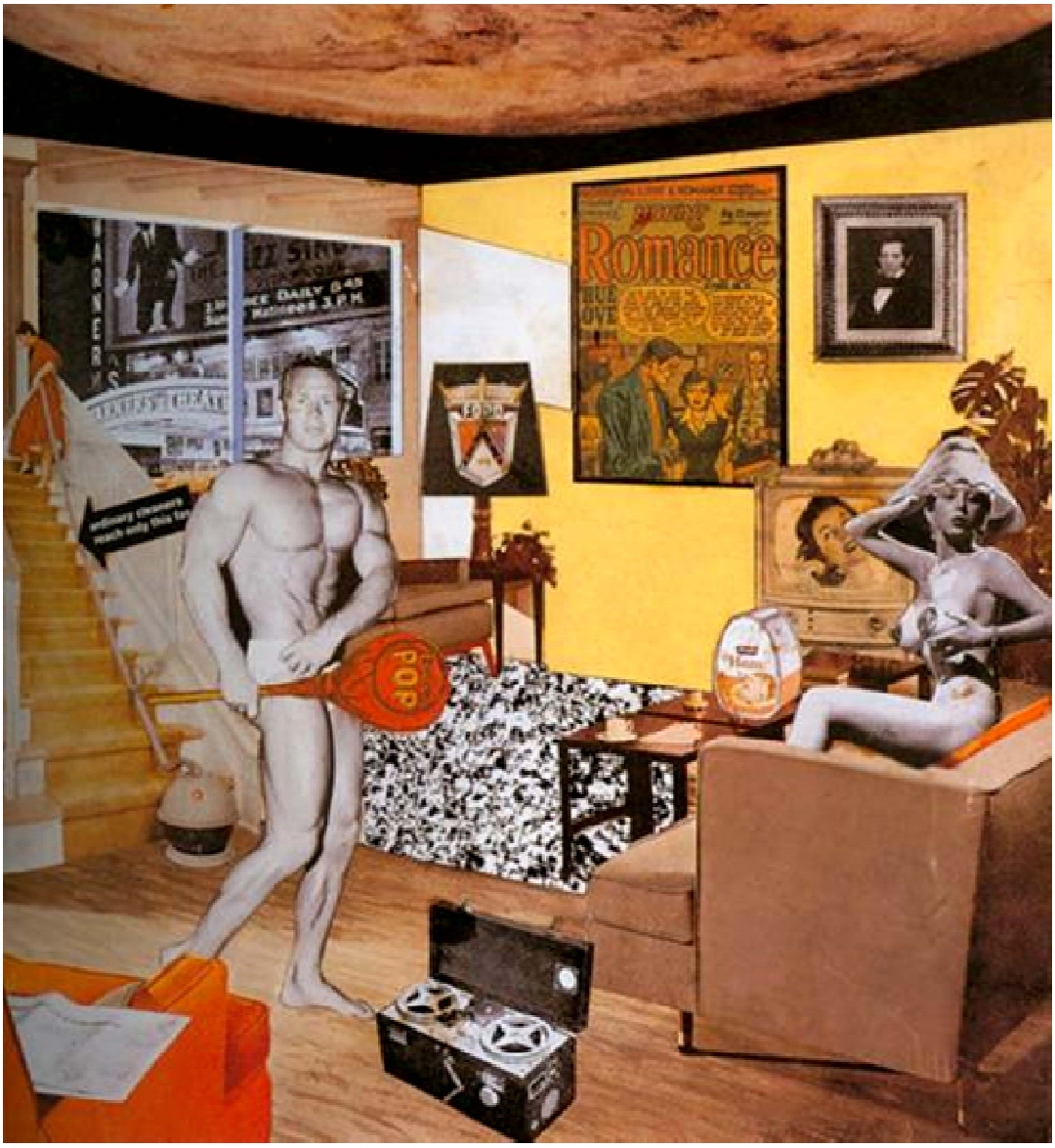
Max Ernst, from ***Une semaine de bonté*** **(1934)**
Published as a graphic novel



John Heartfield, *Hurrah, die Butter ist alle!* (1935)
Published in the *Arbeiter-Illustrierte-Zeitung*



Eduardo Paolozzi, *Dr. Pepper* (1948)
Collage on paper; 14 1/8 x 9 3/8"

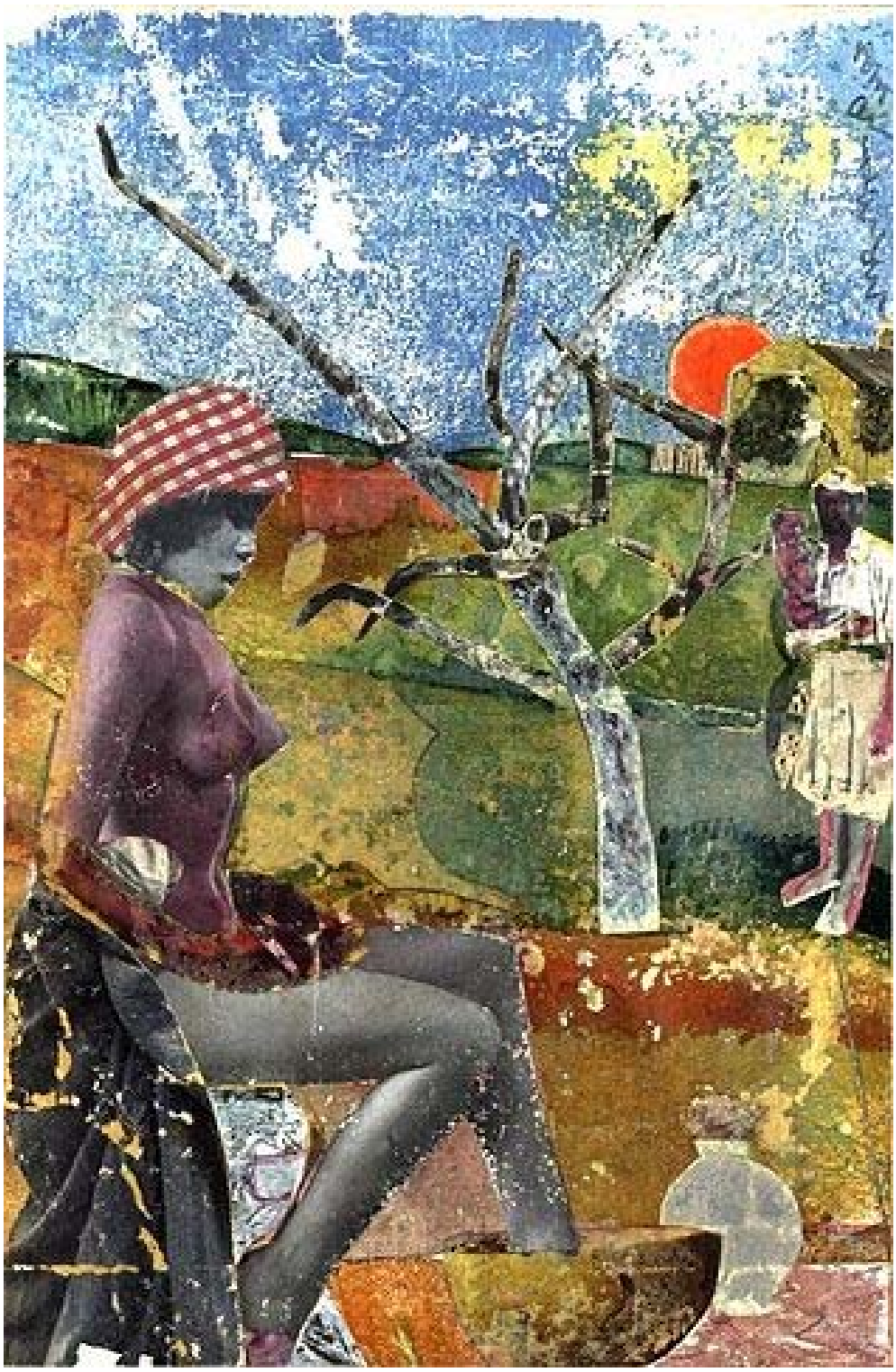


Richard Hamilton, *Just what is it that makes today's homes so different, so appealing?* (1956)
Collage on paper; 10 1/4 x 9 3/4"

Robert Rauschenberg, *Skyway* (1964)
Oil and silkscreen on canvas; 216 x 192"

Andy Warhol, *Orange Car Crash* (1964)
Silkscreen ink and synthetic polymer paint on
two canvases; 105 7/8 x 164 1/8"

Martha Rosler, from ***Bringing the War Home: House Beautiful (Balloons)*** **(1967-72)**
Photomontage; 24 x 20"

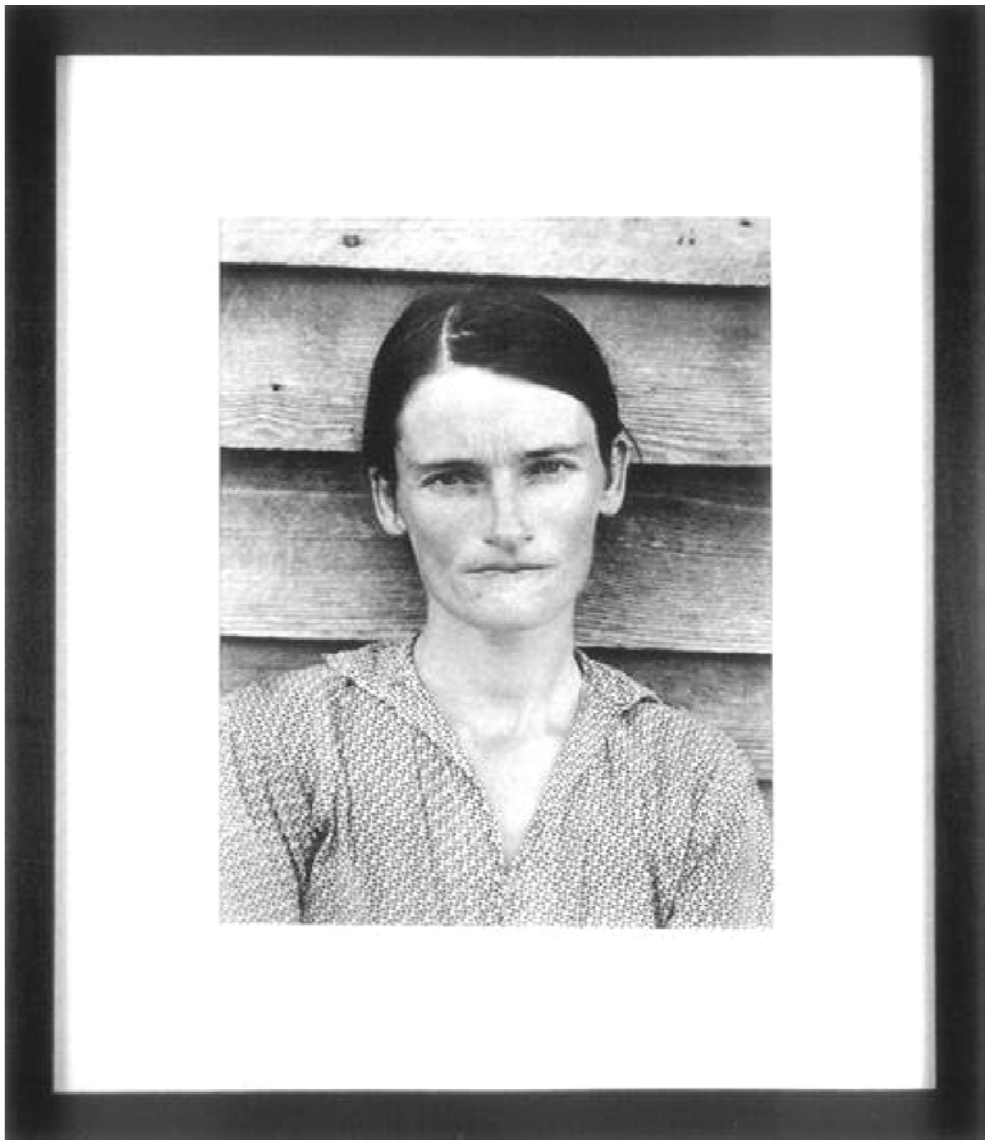


Romare Bearden, *The Calabash* (1970)
Collage of mixed media on paper; 8 7/16 x 7 2/8"

These examples demonstrate that collage and other appropriation strategies may communicate a wide array of messages, subject to multiple and varying interpretations. These works may be understood to address a particular political agenda, question consumerism, oppose war, investigate the function of popular media, or explore gender or racial identity – often simultaneously.

In the late 1970's (and with precursors too numerous to detail here) artists like Richard Prince began using existing imagery to create work which has itself become highly influential, now commonly (though loosely) known as "Appropriation Art." *See* Marvin Heiferman, Lisa Phillips and John G. Hanhardt, *Image World: Art and Media Culture* (1989); Douglas Eklund, *The Pictures Generation, 1974-1984* (2009). As many had done before, these artists used existing imagery from both "high" art and mass media, and frequently employed collage techniques. They also carried forward the readymade strategy, sometimes re-presenting imagery with little or no visual alteration other than the work's appearance in an entirely new cultural frame, creating new meaning precisely by focusing viewers' attention on the social context of the borrowed imagery.

These works have been understood to question the status of authorship, originality and authenticity in our culture. Whether their meaning is apparent to all or not, their place in art history is well established.



Sherrie Levine, *After Walker Evans* (1981)
Gelatin silver print; image 10 x 8"

Richard Prince, *Untitled (cowboy)* (1989)
Ektacolor photograph; 50 x 70"

In still more recent years, artists have continued to appropriate imagery, often to ends that may not be immediately discernible to every viewer. That does not make these works any less meaningful to the significant audiences that do apprehend their new meanings, any more than a particular viewer's failure to understand Goya or Manet meant those artists had nothing to express.

Jeff Koons, *Niagara* (2000)
Oil on canvas; 120 x 168"

Prince's work, and his use of Cariou's photographs, must be evaluated with this long and living tradition in mind. *See Blanch v. Koons*, 467 F.3d 244, 251 (2d Cir. 2006) ("[T]he determination of fair use is an open-ended and context-sensitive inquiry."). A fair use standard that threatens an artist's freedom to use existing images imperils this tradition and the important forms of artistic expression it embodies.

II. The District Court Applied An Inappropriately Narrow Fair Use Standard That Provides Insufficient Protection For Public Speech And Expression Interests.

The fair use standard employed by the district court poses exactly that threat. It is not only wrong as a matter of controlling law, but undermines the shared goals of copyright and the First Amendment by calling into question established modes of artistic expression and chilling future creativity.

A. Fair Use Is A Critical First Amendment Safeguard That Provides Breathing Room For Artistic Expression.

Copyright's ultimate goal is to benefit society by stimulating creativity and assuring wide access to its products. *See Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984); *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975); U.S. Const. art. I, § 8, cl. 8 (empowering Congress to grant authors exclusive rights in their works "to promote the Progress of Science"). It advances that goal by granting authors a specific set of exclusive rights in their original works. *See id.* Those exclusive rights provide economic incentives to create new works, but they also restrict a wide array of speech and expression. *See Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 575-76 (1994) (need to protect authors while allowing others to build on their work is an "inherent tension" as old as the Statute of Anne).

Without appropriate limitations, the exclusive rights and restrictions copyright creates have the potential to impede, not advance, creativity. Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1108-09 (1990). That is because creativity and free expression do not occur in a vacuum; they build on the past. "[A]ll intellectual creative activity is in part derivative. There is no such thing as a wholly original thought or invention. Each advance stands on building blocks fashioned by prior thinkers." *Id.* at 1109. The process of referencing, borrowing from and transforming existing works is essential to expressive and creative activity because "[i]n truth, in literature, in science and in art, there are, and can be, few, if any, things, which in an abstract sense, are strictly new and original throughout." *Campbell*, 510 U.S. at 575 (quoting *Emerson v. Davies*, 8 F. Cas. 615, 619 (No. 4,436) (CCD Mass. 1845)).

The capacity of people to participate in culture and express themselves resides squarely in their ability to reference, change, modify, dissect and criticize existing expression. *See* Neil W. Netanel, *Copyright's Paradox* 43 (2008). For that reason, copyright law must be construed to support the First Amendment's core values of freedom of speech and expression.

The fair use doctrine is the primary mechanism that balances the tension between copyright protection and creative expression. It is a critical "First Amendment safeguard" that helps ensure "copyright's limited monopolies [will remain] compatible with free speech principles," *Eldred v. Ashcroft*, 537 U.S. 186, 219-20 (2003), by providing "breathing space" for new expression that incorporates existing works. *See Campbell*, 510 U.S. at 579.

Breathing space is especially important in the First Amendment context because uncertainty chills speech. That is the reason the First Amendment demands an actual malice rule. *See New York Times Co. v. Sullivan*, 376 U.S. 254, 279-80 (1964). It is also the reason excessively vague regulations of speech are invalid. *See, e.g., Brown v. Entm't Merchs. Ass'n*, 131 S.Ct. 2729, 2743 (2011) ("Vague laws force potential speakers to 'steer far wider of the unlawful zone' ... than if the boundaries of the forbidden areas were clearly marked.").

While fair use may be an "equitable rule of reason," *Sony*, 464 U.S. at 448, it is a rule of reason that marks the boundary between lawful and unlawful speech. Like other First Amendment doctrines, fair use should be interpreted to minimize uncertainties that may chill expressive speech and artistic creativity.

B. The Court Should Apply The Fair Use Standard With Its First Amendment Function In Mind.

A proper fair use analysis must account for its First Amendment function. The standard applied by the district court in this case ignored that function, as well as the controlling law. The Court should take this opportunity to assure the necessary breathing room for the expressive, artistic use of visual images in paintings and other mediums by clarifying the manner in which a court should assess the first and fourth factors.

1. A Wide Array Of Transformative Meaning Should Be Recognized In The Expressive Use Of Existing Images In Visual Art.

The first fair use factor is the purpose and character of the defendant's use, with special emphasis on whether the use is transformative. *See Campbell*, 510 U.S. at 578-579; 17 U.S.C. § 107. The district court committed two important errors in its first factor analysis. First, it held that "Prince's [p]aintings are transformative only to the extent they comment on" Cariou's photographs. SPA-18. Second, it assessed the meaning of Prince's work based entirely on Prince's testimony, not the reasonable perceptions of the viewer. SPA-18-20. Both aspects of the Court's analysis are contrary to controlling law, and narrow the fair use analysis in ways that undermine its First Amendment function.

In *Campbell*, the Supreme Court drew a critical distinction between superseding and transformative uses. 510 U.S. at 578-79. It recognized works that add new meaning and expression tend to promote copyright's speech-enhancing purpose. *Id.* While *Campbell* involved parody, it did not hold or even suggest that transformativeness is limited to new works that parody the original or comment on it directly. It recognized that parody was but one example of a new work that provided "social benefit." *Id.* at 579. In that case, the benefit was shedding new light on the subject of the parody by criticizing it. *See id.* at 580. There is, of course, a wide array of other uses that provide similarly substantial social benefits without criticizing or commenting on the original work. *See* Google Br. at 4-17.

This Court has expressly "disagree[d]" with the suggestion that "comment or criticism" is required to show transformative use. *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 609 (2006). That conclusion is plainly correct under *Campbell*, because commentary is not the only "new expression, meaning, or message" a new work might deliver, and commentary is not the only way a second work may "add[] value to the original." *Campbell*, 510 U.S. at 579; *See also Blanch*, 467 F.3d at 251. Nor is physical alteration required. *See Bill Graham*, 448 F.3d at 610-11 (use of unaltered concert posters found transformative). Accordingly, it was not

even necessary that appropriated images be collaged, as many were in this case, in order to be transformative. All that is required is a meaning, message or purpose that is "separate and distinct" from the original. *Id.* at 610; *see Blanch*, 467 F.3d at 252. This requirement is met where an artist uses an image as "fodder" for social commentary, or "raw material" with which to pursue "distinct creative or communicative objectives." *Blanch*, 467 F.3d at 253.

Prince passes that test easily. Cariou's objective was "classical … portraiture." A-1550 at 187:8-15. His photographs of Rastafarians appear to celebrate the Rastafarians by depicting them respectfully in their actual environment:

See A-Ex. 2.

Whatever Prince's purpose was, it was not that. Prince uses elements of Cariou's utopian images to depict a post-apocalyptic world that exists only in Prince's imagination. *See* A-747 at ¶ 16; A-750 at ¶ 22. He has transported the Rastafarians to a foreign realm that is distinctly unlike the one depicted in Cariou's photographs. Prince turns the Rastafarians themselves into something unnatural using double imagery and garish over-painting, and surrounds them with an array of nude women in highly sexualized and conventionalized poses that invoke still other realms ranging from the canon of modernism (with references to Picasso and DeKooning) to

amateur erotica, and pornography. *See* A-751 at ¶ 27. Cariou's photographs suggest an Eden of natural purity. Prince has debauched it. The contrast in expression could hardly be more striking:

Richard Prince, *Naked Confessions* (2008), at A-259
Collage, inkjet, and acrylic on canvas; 45 1/4 x 46"

Richard Prince, *The Other Side of the Island* (2008), at A-260
Acrylic, collage, oil crayon, charcoal, and inkjet on canvas; 82 x 132"

That the precise meaning of Prince's works may not be immediately clear to all does not mean his work is not transformative. *See Campbell*, 510 U.S. at 582-83 ("novelty" can make new works "repulsive until the public [has] learned the new language in which the[] author spoke"). However that meaning is defined, Prince's message and creative objective are plainly different than Cariou's.

The district court found Prince's work was not transformative based entirely on Prince's apparent inability to verbalize the meaning of it to the court's satisfaction, and the court's own conclusions about Prince's

subjective intent. *See* SPA-17-20. But transformative meaning must be assessed first and foremost by observation of the work itself, and whether new meaning and expression may be reasonably perceived from it. *See Campbell*, 510 U.S. at 582-83. In *Campbell*, the Court did not demand testimony from 2 Live Crew, or speculate about their subjective intentions. It concluded that elements of parody could reasonably be perceived from the work itself, and that was enough to establish its new meaning and expression. *See id.*

There is a good reason for that. Ultimately, the meaning of art is defined by the viewer, not a judge, or even the artist himself. A viewer's reaction to a work of art is shaped by the viewer's personality, emotions, values, experience and knowledge. So while it is plainly dangerous for those trained in the law to judge the worth or meaning of art, *see Campbell*, 510 U.S. at 582-83, it is equally dangerous to pretend the meaning of art can be defined solely by the intention of the artist herself, much less her ability to articulate that intention to the satisfaction of judges and lawyers. *See Pleasant Grove City v. Summum*, 555 U.S. 460, 476 (2009) (recognizing "it frequently is not possible to identify a single 'message' that is conveyed" by a government monument, and the sentiments it expresses "may be quite different from those of . . . its creator"); *Hurley v. Irish-Am. Gay Lesbian &*

Bisexual Group of Boston, 515 U.S. 557, 569 (1995) ("a narrow, succinctly articulable message is not a condition of constitutional protection" for expressive speech).

That is not to say the testimony of the artist is irrelevant. If, as in *Blanch*, the artist can explain the intended meaning of his work and how it differs from the work he borrowed, that testimony may be quite informative. But the failure to provide an explanation as polished as the one Jeff Koons provided in *Blanch* cannot be fatal. If it were, then every artist who works within this tradition will be forced to concoct a narrative that appeals to legal sensibilities, and the law will succeed in protecting only those artists who are scripted by counsel.

Other rules that protect First Amendment interests do not ask the speaker to demonstrate the value of her speech, or require her to persuade a judge of its worth. Neither does copyright. *See Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) (Holmes, J.) ("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."). The long tradition of appropriating existing images in the context of collage and other expressive practices described in Section I clearly demonstrates the important new meaning and expression these uses deliver. The Court

should recognize that the use of existing images in visual art may convey a wide array of transformative meaning that goes far beyond direct commentary on the original and is not limited by the expressed intentions of the artist.

2. Courts Should Be Cautious In Recognizing A Right To Control Markets For Expressive, Artistic Uses Like Prince's.

The fourth factor is "the effect of the use upon the potential market for or value of the copyrighted work." 17 U.S.C. § 107(4). Analysis of it "requires a balancing of the benefit the public will derive if the use is permitted" versus "the personal gain the copyright owner will receive if the use is denied." *Bill Graham*, 448 F.3d at 613; *see Wright v. Warner Books, Inc.*, 953 F.2d 731, 739 (2d Cir. 1991).

a. Substantial Public Benefit

The public benefits of permitting uses like Prince's are obvious and well-established, yet the district court ignored them entirely. The public has a strong and substantial interest in encouraging the production of expressive works of art, and in receiving the benefits of artistic expression. *See Salinger v. Colting*, 607 F.3d 68, 82 (2010) ("The public's interest in free expression . . . is significant and is distinct from the parties' speech interests."). The public's First Amendment interest in access to expressive works is rooted in

the "public's interest in receiving information" and the need to preserve the free and open exchange of ideas. *Id.* (quoting *Pac. Gas & Elec. Co. v. Pub. Utils. Comm'n of Cal.*, 475 U.S. 1, 8 (1986)); *see, e.g.*, *Red Lion Broad. v. FCC*, 395 U.S. 367, 390 (1969) (recognizing "the right of the public to receive suitable access to social, political, esthetic, moral, and other ideas"); *Abend v. MCA, Inc.*, 863 F.2d 1465, 1479 (9th Cir. 1988) (recognizing the public interest in seeing a feature film), *aff'd on other grounds sub nom. Stewart v. Abend*, 495 U.S. 207 (1990); *Trust Co. Bank v. Putnam Publ'g Group, Inc.*, 5 U.S.P.Q.2d 1874, 1877 (C.D. Cal 1988) (recognizing the "strong public interest favoring the publication of books and novels").

b. No Cognizable Harm

The district court concluded the fourth factor weighed against Prince because his use (1) damaged the market for Cariou's photographs, and (2) denied Cariou revenue from derivative uses in new works of art like Prince's. *See* SPA-28-30. The first conclusion is wrong because Cariou admitted he took his photographs to publish them in a book, and to the extent he has ever sold them individually it was only sporadically to acquaintances in private. *See* A-583 at 157:4-158:11; A-607-08; A-858 at ¶ 136; A-1525-26 at 88:11-89:20. There is no evidence Cariou lost a single sale of his work, or that the value of it diminished in any way. *See id.* The

real impact of Prince's use has been to make more people aware of Cariou's work as result of Cariou's lawsuit.

This is not a case involving the reproduction of copyrighted images in retail goods (such as totebags and keychains), or in the promotion of other products or services. Those uses could present very different questions of market harm, especially where a defendant's goods are plausible substitutes for the plaintiff's work, or a defendant uses the copyrighted work to advertise, sell or promote goods or services. The use of an image in these contexts might also implicate trademark or copyright protection, or publicity rights. None of those concerns is present here, where Prince's use was confined to his art. In short, what was true in *Blanch v. Koons* is true here:

> [Prince's] use of [Cariou's] photograph[s] did not cause any harm to [his] career or upset any plans [he] had for [the *Yes, Rasta* photographs] or any other photograph, and . . . the value of [Cariou's photographs] did not decrease as the result of [Prince's] alleged infringement.

Blanch, 467 F.3d at 258.

The Court's conclusion about harm to derivative markets is equally flawed, because it assumes that harm to all derivative markets is protectable. The Supreme Court recognized, for instance, that "there is no protectable derivative market for criticism." *Campbell*, 510 U.S. at 592. That market is not reserved to copyright owners because they would be expected to censor

a substantial part of that speech market. *See id.* Similarly, this Court has recognized that the market for transformative uses is not reserved to copyright owners. *See Bill Graham*, 448 F.3d at 615 ("Copyright owners may not preempt exploitation of transformative markets" by charging licenses for what would otherwise be fair use). That principle is especially important here, because reserving to copyright owners like Cariou the market for expressive artistic uses of visual images in mediums like collage presents the same censorship problem. It enables copyright owners to prevent the expressive use of their images in new works of art they happen not to like. There is every reason to believe that concern is relevant here, where Prince has debased the images of the Rastafarians that Cariou represented as pure, noble and idyllic. *See Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 805 (9th Cir. 2003) (finding it unlikely that Mattel would ever license denigrating pictures of the Barbie doll).

In addition, recognizing a market for expressive artistic uses of visual images in mediums like collage would often impose substantial costs on the creation of original artistic expression. In many situations, artists who wish to use existing imagery to work in the medium of collage would need to consult a lawyer, and often obtain a license. While commercially successful artists like Prince may be able to bear that expense, many others would not.

The total magnitude of these costs overwhelm any marginal impact that recognizing this licensing market might have on the incentive to create anything new. The possibility that a visual artist might one day license a given photograph (or other visual image) for use in a painting, collage or other expressive work of art is simply too remote to have a substantial impact on the decision of whether to create new photographs (or other visual images) or not.

Artists should not need to hire lawyers to make art. If copyright owners "may not preempt exploitation of transformative markets," *Bill Graham*, 448 F.3d at 615, they certainly should not be allowed to claim the market for expressive, artistic uses of visual images. If they are, it will result in substantial expressive harm without providing any corresponding increase in economic incentives to create new works.

C. Injunctions Against Expressive Artistic Uses Should Be Granted Only Upon A Clear Showing Of Specific And Substantial Irreparable Harm Sufficient To Outweigh Public Speech And Expression Interests.

A permanent injunction may not be granted automatically upon a finding of infringement. *See eBay Inc. v. MercExchange, L.L.C.*, 547 U.S 388, 392-93 (2006); *New York Times Co, Inc. v. Tasini*, 533 U.S. 483, 505 (2001) (citing *Campbell*, 510 U.S. at 578 n.10). In order to obtain one, it is the plaintiff's burden to demonstrate:

> (1) that it has suffered an irreparable injury; (2) that remedies available at law, such as monetary damages, are inadequate to compensate for that injury; (3) that, considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted; and (4) that the public interest would not be disserved by a permanent injunction.

eBay, 547 U.S. at 391. In deciding whether to grant or deny an injunction, the court must consider each of these factors. *See id.* Here, the district court failed to consider any of these factors, so its injunction must be vacated. *See id.* at 394; *Salinger*, 607 F.3d at 79-80.

Where a court is asked to issue an injunction against an artistic expressive use like this one, the speech and expression interests of the public and the artist are especially compelling, and it is especially important to demand clear evidence of specific irreparable harm sufficient to overcome these interests. The Court should therefore clarify the appropriate injunction standard to be applied on remand.

1. The District Court's Injunction Analysis Ignored Important Public Speech Interests.

There are profound First Amendment interests involved when a court is asked to enjoin the distribution or display of expressive or creative works. *See, e.g., Vance v. Universal Amusement Co., Inc.*, 445 U.S. 308, 315-16 (1980); *see also Bose Corp. v. Consumers Union of U.S., Inc.*, 466 U.S. 485 (1984); *Metro. Opera Ass'n, Inc. v. Local 100*, 239 F.3d 172, 176 (2d Cir.

2001). Those interests are not limited to the author or speaker. *See Salinger*, 607 F.3d at 82. The public itself has an important First Amendment interest in access to expressive works. *See id.* (citing *Pac. Gas & Elec.*, 475 U.S. at 8); *Red Lion*, 395 U.S. at 390; *Abend*, 863 F.2d at 1479 (recognizing the public interest in seeing a feature film); p. 34, above. That interest is rooted in the fundamental public interest in the free and open exchange of ideas and information. *See, e.g., Associated Press v. U.S.*, 326 U.S. 1, 20 (1945); *Lovell v. City of Griffin*, 303 U.S. 444, 452 (1938).

The public's interest in access to expressive works is not diminished where a copyright has been asserted. Where a defendant's work contains additional expression, there is still a "strong public interest in the publication of [that] work." *Campbell*, 510 U.S. at 578 n.10; *accord Rosemont Enters., Inc. v. Random House, Inc.*, 366 F.2d 303 (2d Cir. 1966) (reversing preliminary injunction against biography of Howard Hughes and recognizing copyright injunctions pose the same dangers as other restraints on speech); *Suntrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1276 (11th Cir. 2001) (reversing preliminary injunction against publication of *The Wind Done Gone* and recognizing public interest in access to expressive works).

That remains true even where the defendant's work is found to infringe. *See Abend*, 863 F.2d at 1479 ("injunction [against an infringing derivative work] could cause public injury by denying the public the opportunity to view a classic film"); 3 M. Nimmer & D. Nimmer, *Nimmer on Copyright* §14.06[B] (2001) ("The interest in dissemination of an infringing work may justify a confinement of the remedy to a money recovery.").

Infringing or not, the Prince's *Canal Zone* paintings are expressive and creative. Cariou's photographs fed Prince's imagination, and Prince used those photographs to help construct his vision of an "artificial reality" and explore themes of sexual equality – or what he called "the three relationships in the world, which are men and women, men and men, and women and women." A-1244 at 283:21-284:2; A-1258 at 337:23-338:9; SPA-18. Whether Prince was effective in exploring these themes or not, the public has an important First Amendment interest in receiving the expression and imagination contained in Prince's work. *See Cohen v. California*, 403 U.S. 15, 25 (1971) ("[W]holly neutral futilities come under the protection of free speech as fully as do Keats' poems or Donne's sermons.") (internal quotations omitted); *see also Campbell*, 510 U.S. at

582. This public interest must be an important factor in the injunction analysis.

2. The District Court's Injunction Analysis Ignored Prince's Speech Interests, His Economic Interests And His Statutory Rights.

Personal expression is a core speech right. *See, e.g.*, *Cohen*, 403 U.S. at 25. The fact Prince chose to express himself in a visual medium does not diminish his speech and expression interests. *See Hurley*, 515 U.S. at 569 (recognizing the paintings of Jackson Pollock are "unquestionably shielded" by the First Amendment because "the Constitution looks beyond written or spoken words as mediums of expression"). The fact that the meaning or message of Prince's work may be difficult to discern does not diminish his expressive interest, either. *See id.* at 569-70 ("a narrow, succinctly articulable message is not a condition of constitutional protection"). Nor does the fact Prince chose to express himself in part by using elements of Cariou's photographs: "First Amendment protection [does not] require a speaker to generate, as an original matter, each item featured in the communication." *Id.* at 570; *accord New York Times Co. v. U.S.*, 403 U.S. 713 (1971) (per curiam) (recognizing newspaper's First Amendment interest in publishing work authored by government employees).

What is at stake here is Prince's right to share his imagination, and to express the visions that Cariou's photographs helped create in Prince's mind. The freedom to imagine, and to express what is imagined, is critical to art and free expression itself. *See* Jed Rubenfeld, *The Freedom of Imagination: Copyright's Constitutionality*, 112 YALE L.J. 1, 38 (2002) (it is the freedom to imagine – "to conceive as far as one is able how the world might be, or might have been, or could never be" – that best explains the reason the First Amendment protects high art as well as low). While that freedom may or may not outweigh the competing interests of the copyright owner, it must also be an important part of the injunction analysis.

In addition to ignoring Prince's First Amendment interests, the district court ignored Prince's economic interests. The combined value of his thirty paintings currently totals millions of dollars. *See* A-1254-55 at 323:8-325:10. There can be little dispute that a substantial, if not overwhelming, portion of that value is due to the creativity and expression Prince added and his artistic reputation. By forcing Prince to forfeit his works in their entirety, or turn them over to Cariou, the district court's injunction delivers to Cariou the *entire* value of Prince's work – an economic windfall that goes well beyond the monetary remedies authorized by the Copyright Act. *See* 17 U.S.C. § 504 (limiting monetary remedies to statutory damages, or actual

damages and "any profits of the infringer that are ***attributable to the infringement***") (emphasis added). By subjecting Prince's work to destruction, the injunction also violates Prince's statutory right to prevent the destruction of his work. *See* 17 U.S.C. § 106A(a)(3)(B) (author of work of visual art shall have the right "to prevent any destruction of a work of recognized stature").

Here, Cariou provides no evidence of any hardship comparable to Prince's. Cariou's speech rights are unaffected, because he spoke freely when he created and published his photographs, and he remains free to publish, show, sell and distribute them.[2] There is no evidence that one gallery's temporary reluctance to show his work caused the loss of a single sale. Nor is there any evidence that Prince's paintings diminished the value of Cariou's photographs, or interfered with sales of Cariou's book. (Pp. 35-36, above.) In the absence of an injunction, Cariou will not suffer any discernable or specific harm. Yet under the present injunction, Prince suffers profound First Amendment harm and forfeits millions of dollars to which

[2] A plaintiff who has not yet published a work may have an interest in not speaking. *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 559 (1985); *see Salinger*, 607 F.3d at 81. That interest is not present here because Cariou chose to speak when he published his work.

Cariou has no legal claim. The balance of hardships therefore tilts strongly against an injunction.

3. Only A Clear Showing Of Specific And Substantial Irreparable Harm Should Be Sufficient To Overcome The Important Public And Private Speech Interests An Injunction Would Impair Here.

In order to obtain a permanent injunction, a plaintiff must show that he has suffered an irreparable injury and that legal remedies such as money damages are not adequate to compensate for that injury. *See eBay*, 574 U.S. at 391; *Salinger*, 607 F.3d at 78, 80. In other words, a plaintiff seeking injunctive relief in a copyright case must demonstrate irreparable injury, not simply "presume" it. *See id.*; Richard Dannay, *Copyright Injunctions And Fair Use*, 55 J. COPY. SOC'Y 449, 460 (2008).

Some courts have suggested the fact a defendant will continue to infringe absent a permanent injunction is by itself sufficient to show irreparable harm and inadequacy of legal remedies. *See, e.g.*, *Lauratex Textile Corp. v. Allton Knitting Mills Inc.*, 519 F. Supp. 730, 732 (S.D.N.Y. 1981). That is plainly improper, because it means irreparable harm follows automatically from infringement, which is precisely the presumption that controlling law prohibits. *See eBay*, 547 U.S at 392; *Tasini*, 533 U.S. at 505 (citing *Campbell*, 510 U.S. at 578 n.10); *Salinger*, 607 F.3d at 78, 80.

Irreparable harm may exist where a defendant seeks to "scoop" the copyright owner by publishing a close substitute for the plaintiff's work prior to first publication. *See Harper & Row*, 471 U.S. at 569; *HarperCollins Publishers, L.L.C. v. Gawker Media LLC*, 721 F. Supp. 2d 303, 307 (S.D.N.Y. 2010). It may also exist where a defendant continues to manufacture works that are ready substitutes in function and appearance to plaintiff's work. *See Salinger*, 607 F.3d at 81. Neither harm exists here because Cariou published his work long ago and there is no evidence that Prince's one-of-a-kind art works selling for hundreds of thousands of dollars are plausible substitutes for Cariou's photographs or his book.

Here, the only plausible harm to Cariou the district court identified was the temporary inability to show his work at one gallery – which appears to have been Cariou's choice in any event (A-1528-29 at 100:20 to 104:6; A-1608 at 123:9-25) and lost revenue from selling or licensing his photographs. Yet an injunction could not force any gallery to show Cariou's work. As for lost sales or licensing revenue, Cariou has not proved any, or explained why money damages would be insufficient to compensate him for lost revenue. *See eBay*, 547 U.S. at 391 ("A plaintiff [seeking a permanent injunction] must demonstrate . . . that remedies available at law, such as monetary damages, are inadequate to compensate for that injury"). Insofar as

Cariou simply does not like Prince's paintings, that is precisely the censorship problem that highlights the important speech rights at stake here.

Where a court is asked to enjoin an expressive artistic use like this one, a plaintiff should be required to make a clear showing of specific irreparable harm that cannot be cured by money damages and is substantial enough to overcome the important public and private speech interest the permanent injunction would impair. Even where such an injunction is appropriate, these speech and expression interests should inform its scope. It should be narrowly tailored and should not impose any greater burdens on speech and expression rights than those necessary to address the specific, irreparable harm a plaintiff demonstrates. Here, the supposed harm that Cariou would suffer absent an injunction is neither concrete nor irreparable, and does not outweigh the important speech interests this injunction destroys. It certainly does not justify the sweeping injunction the district court issued, much less the destruction of thirty paintings by a renowned artist.

III. CONCLUSION

The Court should reverse the district court's summary judgment in favor of Cariou and vacate the injunction.

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CERTIFICATE OF COMPLIANCE

Pursuant to Federal Rule of Appellate Procedure 32(a)(7)(C), I certify that this brief complies with the typeface requirements of Rule 32(a)(5)(A), because it is written in 14-pt Times New Roman font, and with the type-volume limitations of Rule 32(a)(7)(B), because it contains 6986 words, excluding the portions excluded under Rule 32(a)(7)(A)(iii). This count is based on the word-count feature of Microsoft Word.

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