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Cariou v. Prince

714 F.3d 694 (2d Cir. 2013)

MIDORI K. HIRAI*

BACKGROUND

In 2000, Plaintiff Patrick Cariou, a French professional photographer, published *Yes Rasta*, a book of portrait and landscape photographs he took while living among Rastafarians in Jamaica. Cariou is the sole copyright-holder of these photographs and has never consented to their use by others.

Defendant Richard Prince, a professional appropriation artist and photographer; Gagosian Gallery, Inc.; and Lawrence Gagosian, the owner of Gagosian Gallery, Inc., (collectively “Defendants”) produced and showed, respectively, a series of paintings and collages incorporating Cariou’s *Yes Rasta* photographs. These paintings and collages were part of Prince’s *Canal Zone* show at the Gagosian Gallery, where Gagosian Gallery, Inc. and Lawrence Gagosian (collectively “Gagosian Defendants”) also sold an exhibition catalog that included images of the *Canal Zone* works.

Prince, as an appropriation artist, creates works by taking photographs or images produced by other artists and incorporating them into new works that he presents as his own. He alters others’ works to varying degrees to create his own style of artwork and express his message. Prince’s *Canal Zone* works, which incorporated Cariou’s photographs, related to a post-apocalyptic screenplay that Prince was developing.

Cariou was unaware of Prince’s appropriation of the *Yes Rasta* photos and was planning an exhibition of some of the photographs with gallery owner Cristiane Celle. However, after Celle heard that the *Canal Zone* show used some of the *Yes Rasta* photographs, she decided not to host a *Yes Rasta* show at her gallery to avoid duplication. Celle informed Cariou of the *Canal Zone* show, which was the first Cariou had heard of Prince’s use of his photographs. Cariou subsequently brought suit against the Defendants for copyright infringement.

The Defendants asserted a fair use defense, claiming that Prince’s works were sufficiently transformative so as not to infringe. The district court considered the parties’ cross-filed motions for summary judgment and imposed a requirement that to be considered transformative, a secondary work must “comment on, relate to the historical context of, or critically refer back to the original works.”¹

* Midori Hirai is a 2015 J.D. Candidate at the University of San Francisco School of Law.

1. Cariou v. Prince (*Cariou I*), 784 F. Supp. 2d 337, 348 (S.D.N.Y. 2011).

Applying this standard, the district court found that the Defendants were not entitled to a fair use defense and Cariou should win on summary judgment. The district court further found the Gagosian Defendants liable for vicarious and contributory infringement, permanently enjoined Prince from using Caribou's works, and ordered the Defendants to deliver to Cariou all unsold materials using the *Yes Rasta* photographs.

The Defendants appealed, contending that the *Canal Zone* works are transformative and thus Prince's use of the photos constitutes fair use and that the district court imposed an incorrect standard to determine fair use.

ISSUE

On appeal, the United States Court of Appeals for the Second Circuit considered whether the district court used the incorrect standard to decide the issue of fair use and therefore erred in awarding summary judgment to Cariou.

DECISION

The Second Circuit reversed in part, vacated in part, and remanded the case for further proceedings. The Second Circuit found that the standard for fair use applied by the district court was incorrect and that twenty-five of the thirty paintings at issue were, as a matter of law, transformative. The Second Circuit vacated the permanent injunction issued against the Defendants and remanded to the district court the question of whether the remaining five pieces constituted fair use.

REASONING

The court began its analysis with the legal standard for the fair use defense codified in the Copyright Act of 1976 (the "Act"). The court explained that the fair use defense means to protect everyone who references, or is inspired by, the works of others and to help fulfill the copyright doctrine's goal of increasing activity and progress in the arts to enrich the public.² The Act lays out four non-exclusive factors to be considered in determining fair use: (1) the purpose and character of the use; (2) the nature of the copyrighted work; (3) the amount copied; and (4) the effect of the use on the potential market for the copyrighted work.³ All four factors must be considered when determining whether an artistic work qualifies for the fair use defense.

The first statutory factor, the purpose and character of the use, is the primary focus of any fair use inquiry. The court cited case law to state that to qualify as fair use, the new work must add something to the original work in order to transform it.⁴ This transformative aspect is the exact type

2. *Cariou v. Prince (Cariou II)*, 714 F.3d 694, 705 (2d Cir. 2013).

3. 17 U.S.C. § 107 (2012).

4. *Cariou II*, 714 F.3d at 705.

of secondary use that the fair use doctrine seeks to protect.

The district court imposed a requirement on this first factor that, to qualify as fair use, the new work must “comment on, relate to the historical context of, or critically refer back to the original works.”⁵ Prince’s work was found not to comment on Cariou or his work, so the district court rejected Defendants’ fair use defense. However, the Second Circuit held that while certain types of fair use, such as satire and parody, comment on, or otherwise refer back to, the original work, such commentary or reference is not required for a fair use defense. Rather, the court stated, the correct standard is whether the new work generally changes the original with “new expression, meaning, or message.”⁶

After applying the correct standard to Prince’s works, the court found that, given Prince’s different approach to the artwork, his different aesthetic (considering size, composition, scale, color palette, and media) and his different intent (stated by Prince as “I completely try to change it into something that’s completely different . . . a kind of fantastic, absolutely hip, up to date, contemporary take on the music scene”⁷), twenty-five of the thirty works at issue had the requisite transformative nature to qualify for a fair use defense. Viewing Cariou’s original works and Prince’s new works side-by-side, the court found that these twenty-five works had new expression that made Prince’s work distinct from Cariou’s and “presented images with a fundamentally different aesthetic.”⁸ The court noted that not all cosmetic changes to photographs would constitute fair use. However, in this case, the twenty-five works had more than mere cosmetic changes and were deemed to be transformative as a matter of law.

Although Prince’s works had an underlying commercial purpose, another aspect of the first statutory factor’s inquiry, the court found that because the works were so transformative, the commercial nature of the works did not count against Prince.

The court then turned to the fourth statutory factor and considered the effect on the potential market for the original works. The district court looked at Celle’s decision not to hold a *Yes Rasta* show at her gallery after she learned of the Gagosian *Canal Zone* show and, because of this decision, declared that Prince’s work “unfairly damaged both the actual and potential markets for Cariou’s original work and the potential market for derivative licenses for Cariou’s original work.”⁹ However, the Second Circuit decided that the district court had applied the incorrect standard when it focused on Cariou’s derivative market. The district court should have determined whether the secondary use usurped the original work’s market by targeting the same audience and offering non-transformative infringing content of the same nature as the original work.

5. *Cariou I*, 784 F. Supp. 2d at 348.

6. *Cariou II*, 714 F.3d at 706.

7. *Id.* at 707.

8. *Id.*

9. *Cariou I*, 784 F. Supp. 2d at 353.

Given the transformative nature of Prince's works, Prince's and Cariou's works target different audiences and have different natures. Therefore, when the Second Circuit applied the correct standard of copyright infringement, the fourth statutory factor weighed in Prince's favor.

Turning next to the second statutory factor, the nature of the copyrighted work, the court acknowledged that Cariou's original works were both creative and published. Given that the established standard is: (1) whether the work is expressive or creative, as opposed to factual or informational; and (2) whether the work is published or unpublished,¹⁰ this factor weighed in Cariou's favor. However, the court found the factor to be of limited use given the transformative nature of Prince's works. The court found no evidence that Cariou would have developed, or licensed use of, his work in a way that would have caused Prince's use to usurp Cariou's derivative market. Additionally, the court took into account the lack of evidence that Prince's work had any effect on Cariou's marketing of the photographs and considered Cariou's marketing minimal at best.

The third statutory factor considers "the amount and substantiality of the portion used in relation to the copyrighted work as a whole."¹¹ Thus, the Second Circuit determined the amount of Cariou's original work used in the new works. The district court stated that Prince's taking of Cariou's work was "substantially greater than necessary."¹² The Second Circuit found this standard incorrect; the law has no requirement that an artist take only what is necessary. Due to the transformative nature of Prince's works, the court found this factor weighed in Prince's favor.

In this case, the key component of the fair use defense revolved around the transformative nature of Prince's works. Twenty-five were determined to be transformative as a matter of law. However, the remaining five had only minimal alterations and were thus not considered to be transformative as a matter of law. The Second Circuit remanded the question of whether the works are transformative or infringing to the district court for consideration under the proper standards.

The district court had also found the Gagosian Defendants liable as vicarious and contributory infringers. As far as Prince's twenty-five non-infringing works, the Second Circuit found that the Gagosian Defendants were not liable as vicarious or contributory infringers. The determination of their liability for the remaining five works was remanded to the district court to be determined along with the transformative nature of the remaining works. If the remaining five works are determined to have a transformative nature, then all of Prince's works will be considered fair use, and therefore they will not constitute copyright infringement. If the remaining five works do not have a transformative nature, then those five

10. *Cariou II*, 714 F.3d at 709.

11. 17 U.S.C. § 107(3).

12. *Cariou I*, 784 F. Supp. 2d at 352.

works will not be entitled to a fair use defense, meaning they will constitute copyright infringement, and Cariou may be entitled to relief for the unauthorized use of his work.

