

No. _____

In the Supreme Court of the United States

PATRICK CARIOU,
Petitioner,

v.

RICHARD PRINCE, GAGOSIAN GALLERY, INC.,
and LAWRENCE GAGOSIAN,
Respondents.

*On Petition for a Writ of Certiorari to the
United States Court of Appeals for the Second Circuit*

PETITION FOR A WRIT OF CERTIORARI

DANIEL J. BROOKS
Counsel of Record
THEODORE L. HECHT
KENNETH R. PUHALA
ERIC A. BODEN
SCHNADER HARRISON
SEGAL & LEWIS LLP
140 Broadway, Suite 3100
New York, New York 10005
(212) 973-8000
dbrooks@schnader.com

Counsel for Petitioner

QUESTIONS PRESENTED

Richard Prince, a well-known contemporary “appropriation artist,” produced a series of paintings, incorporating, without permission, photographs taken and copyrighted by Patrick Cariou, a professional photographer. Reversing the district court’s summary judgment determination that Prince, his gallery, and its owner were liable for copyright infringement and had not made fair use of Cariou’s photographs, the Second Circuit concluded that the district court had employed an incorrect fair use standard, but, rather than remanding the fair use analysis of all 30 of Prince’s paintings according to the supposedly correct standard, the majority found 25 of the paintings to be “transformative” as a matter of law (supporting a finding of fair use), based solely on its observation of how the paintings could “reasonably be perceived,” and remanded to the district court the analysis of the five remaining paintings because they did not “sufficiently differ from” Cariou’s source photographs to readily lend themselves to a fair use determination.

Three questions are presented:

1. Whether the first statutory fair use factor, “the purpose and character of the [secondary] use,” requires consideration of the secondary user’s purpose (*i.e.*, his or her justification for appropriating particular copyrighted materials), and not just of the secondary work’s expressive character, as perceived by judges employing their own personal aesthetic sensibilities.

2. Whether the third statutory fair use factor, “the amount and substantiality of the portion used in

relation to the copyrighted work as a whole,” permits substantial appropriation only for purposes such as parody, where it is necessary to “conjure up” enough of the original to ensure that it will be recognizable.

3. Whether the fourth statutory fair use factor, “the effect of the use upon the potential market for or value of the copyrighted work,” protects potential markets even if they have not been aggressively exploited and requires the proponent of a fair use defense to bear the burden of showing a lack of usurpation harm to potential derivative markets.

LIST OF PARTIES

The parties below are listed in the caption.

TABLE OF CONTENTS

QUESTIONS PRESENTED i

LIST OF PARTIES iii

TABLE OF AUTHORITIES ix

PETITION FOR A WRIT OF CERTIORARI 1

OPINIONS BELOW 1

JURISDICTION 1

STATUTORY PROVISIONS INVOLVED 1

STATEMENT OF THE CASE 3

 A. Factual Background 3

 B. Proceedings in the District Court 4

 C. Proceedings in the Court of Appeals 6

REASONS FOR GRANTING THE WRIT 9

I.	THE FIRST FAIR USE FACTOR REQUIRES CONSIDERATION OF THE SECONDARY USER’S PURPOSE – HIS OR HER JUSTIFICATION FOR APPROPRIATING PARTICULAR COPYRIGHTED MATERIALS – AND NOT JUST OF THE SECONDARY WORK’S EXPRESSIVE CHARACTER, AS PERCEIVED BY JUDGES EMPLOYING THEIR OWN PERSONAL AESTHETIC SENSIBILITIES	13
A.	The Second Circuit Decision Incorrectly Failed to Require any Justification for the Taking of Particular Copyrighted Materials, Beyond a Desire by an Appropriation Artist to Use those Materials in Order to Create New Aesthetics	15
B.	<i>Campbell</i> Only Instructs Courts to Determine What Expressive Character May Reasonably Be Perceived in the Context of Determining Whether a Secondary User’s Avowed Purpose is Credible	17
C.	Determining What is “Transformative” Based Exclusively Upon Particular Judges’ Aesthetic Sensibilities Offers Neither Guidance Nor Predictability and Poses the Risk of Incoherent Results, as Occurred Here	18

D. By Focusing Exclusively on the Perceived Transformative Character of Prince’s Paintings, the Second Circuit Decision Conflicts with a Decision of Another Circuit and Renders Superfluous a Number of Important Statutory Provisions	21
II. THE THIRD FAIR USE FACTOR, THE AMOUNT AND SUBSTANTIALITY OF THE PORTION USED, PERMITS SUBSTANTIAL COPYING, ESPECIALLY OF THE HEART OF THE ORIGINAL, ONLY WHERE (UNLIKE HERE) THE SECONDARY USER NEEDS TO “CONJURE UP” ENOUGH OF THE ORIGINAL TO MAKE IT RECOGNIZABLE FOR PURPOSES SUCH AS PARODY	23
III. THE SECOND CIRCUIT’S DECISION THAT CARIOU’S POTENTIAL AND DERIVATIVE MARKETS WERE NOT HARMED CONFLICTS WITH DECISIONS OF THE SUPREME COURT AND OTHER CIRCUITS APPLYING THE FOURTH FAIR USE FACTOR	27
CONCLUSION	31

APPENDIX

Appendix A:	Majority Opinion, Judgment, and Separate Opinion Dissenting in Part of the United States Court of Appeals for the Second Circuit (April 25, 2013)	App. 1
Appendix B:	Memorandum and Order of the United States District Court for the Southern District of New York (March 18, 2011)	App. 36
Appendix C:	Order Denying Petition for Rehearing and Rehearing <i>en banc</i> of the United States Court of Appeals for the Second Circuit (June 10, 2013)	App. 68
Appendix D:	Excerpts of Videotaped Deposition of Richard Prince in the United States District Court for the Southern District of New York (October 6, 2009)	App. 70
Appendix E:	Excerpts of Condensed Deposition Transcript of Christiane Celle in the United States District Court for the Southern District of New York (January 26, 2010)	App. 96

Appendix F:	Excerpts of Appendix to the April 25, 2013 Opinion of the United States Court of Appeals for the Second Circuit, with Index to Appendix and Selected Images of Richard Prince Paintings and Patrick Cariou Source Photographs	App. 102
-------------	---	----------

TABLE OF AUTHORITIES

CASES

<i>Balsley v. LFP, Inc.</i> , 691 F.3d 747 (6th Cir. 2012), <i>cert. denied</i> , 133 S. Ct. 944 (2013)	28, 29
<i>Bill Graham Archives v. Dorling Kindersley Ltd.</i> , 448 F.3d 605 (2d Cir. 2006)	25
<i>Bilski v. Kappos</i> , 130 S. Ct. 3218 (2010)	23
<i>Blanch v. Koons</i> , 467 F.3d 244 (2d Cir. 2006)	21, 27
<i>Campbell v. Acuff-Rose Music, Inc.</i> , 510 U.S. 569 (1994)	<i>passim</i>
<i>Castle Rock Entm't, Inc. v. Carol Publ'g Grp., Inc.</i> , 150 F.3d 132 (2d Cir. 1998)	17
<i>Elsmere Music, Inc. v. National Broadcasting Company</i> , 623 F.2d 252 (2d Cir. 1980)	24
<i>Elvis Presley Enterprises, Inc. v. Passport Video</i> , 349 F.3d 622 (9th Cir. 2003)	22
<i>Fairey v. The Associated Press</i> , No. 09-CV-01123 (AKH) (S.D.N.Y. filed Feb. 9, 2009)	12

Fisher v. Dees,
794 F.2d 432 (9th Cir. 1986) 24

Folsom v. Marsh,
9 F. Cas. 342 (No. 4,901)
(C.C.D. Mass. 1841) 13, 26

*Harper & Row, Publishers, Inc. v. Nation
Enterprises*,
471 U.S. 539 (1985) 24

Kelly v. Arriba SoftCorp.,
336 F.3d 811 (9th Cir. 2003) 25

Morris v. Guetta,
No. CV12-00684 JAK (Rzx),
2013 U.S. Dist. LEXIS 15556
(C.D. Cal. Feb. 4, 2013) 12

Rogers v. Koons,
960 F.2d 301 (2d Cir. 1992) 5, 16

*Worldwide Church of God v. Philadelphia
Church of God, Inc.*,
227 F.3d 1110 (9th Cir. 2000) 16, 28

STATUTES

17 U.S.C. § 101 2, 3, 10, 22, 23

17 U.S.C. § 106(2) 1, 10, 22, 23

17 U.S.C. § 107 2, 5, 10, 13, 22, 23

28 U.S.C. § 1254(1) 1

28 U.S.C. § 1331	3
28 U.S.C. § 1338(a)	3

OTHER AUTHORITIES

Randy Kennedy, <i>Court Rules in Artist's Favor</i> , N.Y. TIMES, April 26, 2013	11
Pierre N. Leval, <i>Toward a Fair Use Standard</i> , 103 Harv. L. Rev. 1105 (1990)	14, 16, 23

PETITION FOR A WRIT OF CERTIORARI

Petitioner, Patrick Cariou, respectfully petitions this Court for a writ of certiorari to review the judgment and opinion of the United States Court of Appeals for the Second Circuit in this case.

OPINIONS BELOW

The opinion of the United States Court of Appeals for the Second Circuit is reported at *Cariou v. Prince*, 714 F.3d 694 (2d Cir. 2013). The Second Circuit reversed in part, vacated in part, and remanded the March 18, 2011 decision of the United States District Court for the Southern District of New York, reported at 784 F. Supp. 2d 337 (S.D.N.Y. 2011). *See* Appendix (“App.”) 1-67.

JURISDICTION

The judgment of the Second Circuit was entered on April 25, 2013. App. 30-31. A petition for rehearing *en banc* was denied on June 10, 2013. App. 68-69. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

Title 17 of the United States Code, Section 106(2) provides in pertinent part that “the owner of copyright under this title has the exclusive rights to do and authorize any of the following: . . . (2) to prepare derivative works based upon the copyrighted work”

Title 17 of the United States Code, Section 101 provides in pertinent part that 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.”

Title 17 of the United States Code, Section 107 provides in pertinent part that: “[T]he fair use of a copyrighted work, . . . , for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include –

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

STATEMENT OF THE CASE

The jurisdiction of the district court was invoked under the Copyright Act of 1976, as amended, 17 U.S.C. § 101, *et seq.*, and under 28 U.S.C. §§ 1331 (federal question) and 1338(a) (copyright).

A. Factual Background

Over a six-year period, Patrick Cariou, a professional photographer, took photographs of dreadlocked Rastafarians in their tropical environment in Jamaica (the “Photographs”), publishing over 100 black-and-white Photographs in a book entitled *Yes Rasta*, which was copyrighted in 2001. The Photographs were portraits of individuals and landscapes. App. 37-38.

In 2005, Richard Prince happened upon a copy of *Yes Rasta* in a bookstore. App. 80. As Prince stated: “I loved the look, and I loved the dreads.” App. 82. He tore 35 pages out of the book, drew on them, affixed the pages to a plywood board, and exhibited this work, entitled *Canal Zone 2007*, in December 2007. App. 79-80. In 2008, Prince decided to produce a series of paintings (together with *Canal Zone 2007*, the “Paintings”) incorporating Cariou’s Photographs. Prince purchased three additional copies of *Yes Rasta*, cut out Photographs from the book, and sent them to a commercial laboratory to be scanned, enlarged and printed onto canvases, in some cases collaging them together with other images and partially painting over them. App. 74, 80-82. Prince never sought Cariou’s permission to use his Photographs in the Paintings. App. 71-72.

The Paintings, 29 of which incorporated Cariou's Photographs, were exhibited and offered for sale by Gagolian Gallery, Inc. (together with its owner, Lawrence Gagolian, "Gagolian") in Manhattan, in November-December 2008. Upon learning of the exhibition, Cariou sent Prince and Gagolian a cease-and-desist letter. App. 56. The show nevertheless continued until its scheduled conclusion. Eight Paintings were sold for a total of \$10,480,000, of which 60% went to Prince and 40% to Gagolian. Seven other Paintings were exchanged for art with an estimated value between \$6 million and \$8 million. App. 55.

B. Proceedings in the District Court

In the absence of any disputed issues of material fact, the parties cross-moved for summary judgment. Based on its review of the deposition testimony and an examination of the Paintings and Photographs, the district court held the defendants liable for copyright infringement and rejected their affirmative defense of fair use.

In analyzing the first fair use factor – the purpose and character of the use, and whether the copying is "transformative" – and the third fair use factor – the amount and substantiality of the portion used, and whether the extent of the copying is consistent with or more than necessary to further the purpose and character of the use – the court focused on Prince's testimony. Prince's testimony was that he preferred appropriating to creating his own work (App. 75); that his decision whether to appropriate work by a disclosed author depended only upon whether he liked the image (App. 78); that the Paintings were very quickly done

and not really thought about (App. 84-85, 88-89); that Cariou's images were not the subject of the Paintings (App. 73, 86-87); that he was not commenting on Cariou's images or technique (App. 89) and had no interest in the original intent of Cariou's photography (App. 93); that he had no message relating to Cariou's Photographs (App. 76, 95); that he only intended to pay homage to other artists and to create beautiful artworks related to musical themes and to a post-apocalyptic screenplay he was writing (App. 51); and that he could have used equivalent material from available alternative sources, including royalty-free stock photographs. App. 90-92. The court concluded from this testimony that Prince's "intent was not transformative." App. 52.

Assessing the defense argument that an appropriation artist's taking of copyrighted works as raw materials for the creation of new aesthetics was fair use *per se*, akin to the preambular examples in § 107 (criticism, comment, news reporting, teaching, scholarship and research), the court addressed the potentially-applicable examples, holding that, to be transformative, Prince's Paintings were required to "in some way comment on, relate to the historical context of, or critically refer back to the original works." App. 49-50. The court held that the *per se* fair use argument proved too much: "If an infringement of copyrightable expression could be justified as fair use solely on the basis of the infringer's claim to a higher or different artistic use . . . there would be no practicable boundary to the fair use defense." App. 50 (quoting *Rogers v. Koons*, 960 F.2d 301, 310 (2d Cir. 1992)). In the court's view, the lack of a transformative intent coupled with

the substantiality of the appropriation tipped the first and third fair use factors against fair use. App. 52, 59.

The second fair use factor, the nature of the copyrighted work, also weighed against fair use because Cariou's Photographs were "highly original and creative artistic works" falling within the core of copyright's protective purposes. App. 57. As to the fourth factor, the effect of the use upon the potential market for the original, the court found that the exhibition of the Paintings harmed Cariou's original market because a gallery owner, Christiane Celle, discontinued plans for a *Yes Rasta* show, where prints of the Photographs would have been offered for sale, because she did not want to appear to be capitalizing on Prince's Paintings or showing work that had been "done already" at the nearby Gagosian Gallery. App. 60. The court also found harm to an identifiable derivative market (the licensing of the Photographs for secondary use by other artists) that creators of original works would normally develop. App. 60-61.

C. Proceedings in the Court of Appeals

The Second Circuit reversed in part, vacated in part, and remanded, finding that the district court had used too narrow a standard because a secondary work may be transformative even if it does not "comment on the original or its author." App. 16. But, rather than remanding the analysis of all 30 Paintings according to the standard it believed to be correct, the majority¹

¹ Circuit Judge Barrington D. Parker wrote the majority opinion, joined by Circuit Judge Peter W. Hall. Circuit Judge J. Clifford

employed its own subjective aesthetic sensibilities to conclude that 25 of the Paintings were “transformative as a matter of law.” App. 19. In reaching this conclusion, the majority relied exclusively upon what could “reasonably be perceived” through observation of the Paintings and disregarded Prince’s testimony. *Id.* The majority remanded the case to the district court to conduct an analysis of the five remaining Paintings because those Paintings “do not sufficiently differ from the photographs of Cariou’s that they incorporate for us confidently to make a determination about their transformative nature as a matter of law.” App. 26.

The partial dissent argued that Prince’s testimony – which, the majority conceded, failed to “explain and defend his use as transformative” (App. 18) – should not be disregarded, particularly in light of Second Circuit precedent taking the secondary user’s explanation of his purpose into account in reviewing fair use. App. 32-33. The partial dissent also took issue with the majority’s reliance on its own “personal art views” as a basis for not remanding the analysis of all 30 Paintings to the district court: “I admit freely that I am not an art critic or expert, [but] fail to see how the majority in its appellate role can ‘confidently’ draw a distinction between the twenty-five works that it has identified as constituting fair use and the five works that do not readily lend themselves to a fair use determination.” App. 34.

Wallace, of the Court of Appeals for the Ninth Circuit, sitting by designation, wrote an opinion concurring in part and dissenting in part.

With respect to the second factor, the nature of the copyrighted work, the Second Circuit agreed with the district court that Cariou's work was "creative" and that this weighed against fair use, but discounted the importance of this factor because Cariou's Photographs were used for a transformative purpose. App. 24. Similarly, regarding the third factor, the amount and substantiality of the use, the Second Circuit held that, even though "many" of Prince's Paintings used Cariou's Photographs "in whole or substantial part" (App. 24-25), this did not weigh against fair use because a secondary user must be permitted to "conjure up" enough of the original to fulfill his transformative purpose. App. 25. As authority for this proposition, the Second Circuit relied upon *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 588 (1994) (App. 25), where this Court, citing a line of parody cases, explained that a parody "must be able to 'conjure up' at least enough of that original to make the object of its critical wit recognizable." (Citation omitted). Left unexplained was why this standard should apply to Prince's non-parodic Paintings.

The Second Circuit held that the fourth factor, the effect of the use upon the potential market for the copyrighted work, favored fair use because Cariou did not aggressively exploit his potential market and Prince's Paintings were supposedly intended for a different audience of well-heeled celebrities. App. 23. The potential market harm resulting from Celle's discontinuation of Cariou's show was written off because, even though Celle decided irrevocably not to put on the *Yes Rasta* show the "minute" she learned of the exhibition of Prince's derivative Paintings at the Gagosian Gallery (App. 98), she also wondered whether

Cariou and Prince had collaborated. App. 22. The Second Circuit found that there was no harm to any potential derivative market because the record was silent as to whether Cariou would have licensed uses such as Prince's (App. 22-23), thus imposing upon Cariou a burden which, under *Campbell*, 510 U.S. at 593-94, properly rests with the proponent of the affirmative defense of fair use.

Cariou's petition for rehearing *en banc* was denied on June 10, 2013. App. 68-69.

REASONS FOR GRANTING THE WRIT

Relying on inapposite snippets from this Court's decision in *Campbell*, the Second Circuit has decided an important question of federal law in ways that conflict with *Campbell*, with decisions of other circuits, and even with prior Second Circuit decisions. The Second Circuit's decision, by giving dispositive significance to whether potentially-infringing secondary works may "reasonably be perceived" as being "transformative" based solely on the aesthetic sensibilities of the particular judges observing the works - and without regard to the secondary user's testimony that he had no reason for appropriating those particular copyrighted works (as opposed to ubiquitously available equivalent materials) - offers neither predictability nor guidance to copyright owners or secondary users (or their counsel), or to lower courts seeking to apply this vague and unworkable standard.

The Second Circuit's decision also nullifies relevant statutory language, rendering superfluous important provisions of the Copyright Act. First, the majority

admitted that Prince failed to “explain and defend his use as transformative,” but disregarded Prince’s testimony about his own subjective purpose and single-mindedly focused instead on the perceived “transformative” character of Prince’s artworks. This effectively rewrites the first fair use factor by calling for an inquiry into the purpose *or* character of the secondary use, when the statutory language looks to the purpose *and* character of that use, as recognized by a decision of another circuit.

Second, although transformativeness is but one prong of the first of four fair use factors, the Second Circuit’s talismanic invocation of the perceived transformative character of the secondary use renders superfluous the third fair use factor, the substantiality of the copying, provided only that a derivative work may reasonably be perceived as being “transformative.” The Second Circuit’s conclusion that, under the third fair use factor, it is permissible to “conjure up” substantial portions of original works in order to fulfill a transformative purpose relies upon, but misreads, this Court’s decision in *Campbell*, which only endorsed substantial appropriation for purposes of parody, where it is necessary to copy enough to make the object of the parodist’s ridicule recognizable.

Third, the overarching importance placed by the Second Circuit upon whether a secondary work may reasonably be perceived to be “transformative” (a term not even found in the fair use provision, 17 U.S.C. § 107), effectively obliterates § 106(2), which gives the copyright holder the exclusive right to authorize or prepare “derivative works based upon the copyrighted work,” including, as defined in § 101, any “form in

which a work may be recast, transformed, or adapted.” While a copyright owner thus has the exclusive right to license derivative uses which “transform” the copyrighted original, the Second Circuit’s decision abrogates that statutory right whenever a particular judge perceives a work of appropriation art as “transforming” the original by altering it to create a new aesthetic.

The Second Circuit’s treatment of the fourth fair use factor, the effect of the use upon the potential market for the copyrighted work, creates a circuit split by approving unlimited commercial exploitation of copyrighted work as long as the copyright owner has not been aggressively marketing his work and the secondary user is targeting a supposedly different audience. Overlooking the clear holding in *Campbell*, the Second Circuit also finds that there was no harm to any potential derivative market because the record was silent as to whether Cariou would ever have licensed his Photographs to Prince or other artists. Since, however, fair use is an affirmative defense, *Campbell* establishes that it is the proponents of the defense (Prince and Gagosian) who had the burden of coming forward with evidence of lack of harm to this potential derivative market.

The issues raised by this case have attracted substantial attention in the art world and media. *E.g.*, Randy Kennedy, *Court Rules in Artist’s Favor*, N.Y. TIMES, April 26, 2013, at C25. The appeal to the Second Circuit elicited amicus briefs, on both sides, from The Andy Warhol Foundation for the Visual Arts, The Association of Art Museum Directors and nine prominent museums, Google Inc., and the American

Society of Media Photographers, Inc. and Picture Archive Council of America (a not-for-profit trade association of entities, such as Getty Images, that license still and motion images). These *amici*, like the parties to this case, sought clarity regarding the balance to be struck between incentivizing creativity through copyright protection and permitting referential fair use of copyrighted materials in order to promote that very creativity. Unfortunately, the Second Circuit majority’s “I know it when I see it” approach, should it become widely adopted, risks tilting that balance against copyright owners (particularly photographers who may not have aggressively marketed their easily-copied digitized works), making their rights dependent upon the unpredictable personal art views of randomly-assigned judges. This raises important questions of federal law that, to the extent they are not definitively answered by the Court’s 1994 decision in *Campbell*, continue to arise (e.g., *Morris v. Guetta*, No. CV12-00684 JAK (RZx), 2013 U.S. Dist. LEXIS 15556 (C.D. Cal. Feb. 4, 2013); *Fairey v. The Associated Press*, No. 09-CV-01123 (AKH) (S.D.N.Y. filed Feb. 9, 2009)) and can only be resolved by this Court.

I. THE FIRST FAIR USE FACTOR REQUIRES CONSIDERATION OF THE SECONDARY USER'S PURPOSE - HIS OR HER JUSTIFICATION FOR APPROPRIATING PARTICULAR COPYRIGHTED MATERIALS - AND NOT JUST OF THE SECONDARY WORK'S EXPRESSIVE CHARACTER, AS PERCEIVED BY JUDGES EMPLOYING THEIR OWN PERSONAL AESTHETIC SENSIBILITIES

From its infancy, the fair use defense has focused on the intent, design or purpose of the secondary user. In Justice Story's landmark decision in *Folsom v. Marsh*, 9 F. Cas. 342 (No. 4,901) (C.C.D. Mass. 1841) - which framed the contours of the judge-made fair use doctrine until its codification in the 1976 Copyright Act and influenced not only the wording of the fair use statutory provision (17 U.S.C. § 107), but also this Court's analysis of that provision (*see Campbell*, 510 U.S. at 576-79) - Justice Story stated: "Thus, for example, no one can doubt that a reviewer may fairly cite largely from the original work, if his *design* be really and truly to use the passages for the *purposes* of fair and reasonable criticism." *Folsom*, 9 F. Cas. at 344 (emphasis supplied). As a threshold matter, even before listing the four statutory fair use factors, the preamble to § 107 explicitly concerns itself with the secondary user's purpose, limiting its protection to copying "for *purposes* such as criticism, comment, news reporting, teaching . . . , scholarship, or research." 17 U.S.C. § 107 (emphasis supplied).

In its analysis of the first fair use factor, the purpose and character of the use, the Second Circuit majority disregarded Prince's testimony about his purpose and intent, even while acknowledging that Prince had failed "to explain and defend his use as transformative."² App. 18. Instead, the majority "examin[ed] how [Prince's] artworks may 'reasonably be perceived' in order to assess their transformative nature." App. 19, quoting *Campbell*, 510 U.S. at 582. The majority's consideration of transformativeness derives from *Campbell*'s endorsement of Judge Leval's view that the first fair use factor asks "whether and to what extent the new work is 'transformative.'" *Campbell*, 510 U.S. at 579, quoting Pierre N. Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105, 1111 (1990) ("Leval"). Its reliance, however, on *Campbell* for the proposition that a secondary work's transformative nature can be deduced exclusively from what may "reasonably be perceived" by observing the work, without regard to the secondary user's testimony, is seriously flawed.

² Although the majority stated that it was not "confining [its] inquiry to Prince's explanations of his artworks," App. 18-19, this was really a euphemistic way of saying that it was disregarding that testimony, as the partial dissent pointed out: "I would allow the district court to consider Prince's statements in reviewing fair use. * * * I see no reason to discount Prince's statements as the majority does." App. 32.

A. The Second Circuit Decision Incorrectly Failed to Require any Justification for the Taking of Particular Copyrighted Materials, Beyond a Desire by an Appropriation Artist to Use those Materials in Order to Create New Aesthetics

The Second Circuit majority absolves secondary users who happen to be appropriation artists from any obligation to provide a justification for why they took particular copyrighted materials and incorporated them into their works. This runs afoul of *Campbell*, where, discussing the relationship between the third and first fair use factors, this Court emphasized that attention must be paid to the “persuasiveness” of the “justification for the particular copying done, and the enquiry will harken back to the first of the statutory factors, for, as in prior cases, we recognize that the extent of permissible copying varies with the purpose and character of the use.” *Id.* at 586-87.

By focusing only on what is judicially perceivable, and disregarding Prince’s testimony about why he took Cariou’s specific Photographs, the Second Circuit majority required no justification, persuasive or otherwise, from Prince as to why he appropriated the particular Photographs he took from *Yes Rasta*. Given the defense contention that Cariou’s Photographs were “typical of their genre” (App. 44), there simply was no reason for Prince to hijack Cariou’s specific Photographs, rather than asking Cariou for permission; or taking or commissioning his own photographs; or acquiring other supposedly generic photographs from willing licensors or from the public domain. As Judge

Leval's influential article (cited repeatedly in *Campbell*) notes, the first fair use factor "raises the question of justification." Leval at 1111.³ Randomly stealing copyrighted materials for no reason other than to create new aesthetics cannot, by itself, supply sufficient justification; otherwise, the rights of copyright owners would be eviscerated. As the district court recognized, "[i]f an infringement of copyrightable expression could be justified as fair use solely on the basis of the infringer's claim to a higher or different artistic use . . . there would be no practicable boundary to the fair use defense." App. 50 (quoting *Rogers v. Koons*, 960 F.2d at 310). Erasing that boundary in a case like this is particularly unwarranted because taking without attribution anonymous copyrighted works is not the type of "referential" creative activity that justifies the fair use defense in the first place. See Leval at 1109.

³ Without justification, there cannot be fair use. See *Worldwide Church of God v. Philadelphia Church of God, Inc.*, 227 F.3d 1110, 1120 (9th Cir. 2000) ("The fact that the secondary use does not harm the market for the original gives no assurance that the secondary use is justified. Thus, notwithstanding the importance of the market factor, especially when the market is impaired by the secondary use, it should not overshadow the requirement of justification under the first factor, without which there can be no fair use." (quoting Leval at 1124)).

B. *Campbell* Only Instructs Courts to Determine What Expressive Character May Reasonably Be Perceived in the Context of Determining Whether a Secondary User’s Avowed Purpose is Credible

It is only when a secondary user supplies a “justification for the particular copying done” (*Campbell*, 510 U.S. at 586) – which Prince did not do – that the enquiry into what may “reasonably be perceived” is triggered. It is in the context of evaluating the credibility of the secondary user’s avowed purpose (which in *Campbell* was parody) that *Campbell* instructs courts to examine what may “reasonably be perceived.” As this Court stated: “The threshold question when fair use is raised in defense of parody is whether a parodic character may *reasonably be perceived*.” *Campbell*, 510 U.S. at 582 (emphasis supplied). The examination of the secondary work’s character after the secondary user has asserted a particular purpose is undertaken in order to determine whether the claimed purpose is credible or is pretextual, as courts sometimes find. *E.g.*, *Castle Rock Entm’t, Inc. v. Carol Publ’g Grp., Inc.*, 150 F.3d 132, 136, 142-43 (2d Cir. 1998) (claim that purpose of trivia book was to criticize, expose or comment on television show was contradicted by author’s prior statements and was a *post hoc* rationalization).

If the avowed purpose is not credible, the fair use defense will fail. As the Court put it: “If, on the contrary, the commentary has no critical bearing on the substance or style of the original composition, which the alleged infringer merely uses to get attention or to

avoid the drudgery in working up something fresh, the claim to fairness in borrowing from another's work diminishes accordingly (if it does not vanish), and other factors, like the extent of its commerciality, loom larger." *Campbell*, 510 U.S. at 580. *See also id.* at 600 (Kennedy, J., concurring) ("As future courts apply our fair use analysis, they must take care to ensure that not just any commercial takeoff is rationalized *post hoc* as a parody.")

Because Prince did not "explain and defend his use as transformative" (App. 18), *Campbell* does not require any determination of whether a transformative character may "reasonably be perceived" in Prince's artworks.

C. Determining What is "Transformative" Based Exclusively Upon Particular Judges' Aesthetic Sensibilities Offers Neither Guidance Nor Predictability and Poses the Risk of Incoherent Results, as Occurred Here

Determining whether a secondary use is transformative based solely upon judicial "observation," rather than upon the testimony of the secondary user, is necessarily subjective and unworkable. The flawed nature of this "I know it when I see it" approach is aptly illustrated by the insupportable distinctions drawn by the Second Circuit majority between the Paintings it deemed transformative as a matter of law and the Paintings that, in its view, did not differ

sufficiently from Cariou's Photographs to permit such a determination.⁴

For example, two of the Paintings have as their central element a Cariou Photograph of a man on a donkey. App. 107. Those Paintings, *Charlie Company* and *Back to the Garden*, both juxtapose the Photograph of the man on the donkey with female nudes and partially cover the man's face with painted "lozenges." App. 108. Both Paintings are described as "Collage, inkjet, and acrylic on canvas" and both are large (*Charlie Company* is 131" x 100" and *Back to the Garden* is 80" x 120"). App. 103.

Charlie Company is one of the five Paintings remanded to the district court because they "do not sufficiently differ from the photographs of Cariou's that they incorporate for us confidently to make a determination about their transformative nature as a matter of law." App. 26. As the Second Circuit majority stated, "*Charlie Company* prominently displays four copies of Cariou's photograph of a Rastafarian riding a donkey, substantially unaltered, as well as two copies of a seated nude woman with lozenges covering all six faces." App. 27. The majority believed that *Charlie Company* "is aesthetically similar to Cariou's original work because it maintains the pastoral background and individual focal point of the

⁴ The Paintings and source Photographs are reproduced in the Appendix to the Second Circuit's opinion, available at <http://www.ca2.uscourts.gov/11-1197apx.htm>, excerpted at App. 107-11.

original photograph – in this case, the man on the burro.” *Id.*

Inexplicably, the other Painting appropriating as its “individual focal point” this same image of the man on the donkey, *Back to the Garden*, was one of the 25 deemed by the majority to be “transformative as a matter of law.” App. 25-26. There is no principled basis for this distinction. *Back to the Garden* displays, just as prominently as *Charlie Company* does, two copies of Cariou’s Photograph of the man on the donkey, one of which is *completely unaltered*, without any “lozenges” covering his face, together with two nude women and the same pastoral background. Indisputably, the image of the man on the donkey is more recognizable (differing less from Cariou’s original Photograph) in *Back to the Garden* than in *Charlie Company*. App. 108.

Similarly incoherent is the majority’s conclusion that *Graduation* (remanded to the district court) is not necessarily transformative, but that *Tales of Brave Ulysses*, with four completely unaltered images of the man who appears in *Graduation* with “lozenges” partially covering his face and a blue guitar, can “confidently” be determined to be transformative as a matter of law. *See* App. 109-10. As the partial dissent cogently put it: “I admit freely that I am not an art critic or expert, [but] fail to see how the majority in its appellate role can ‘confidently’ draw a distinction between the twenty-five works that it has identified as constituting fair use and the five works that do not readily lend themselves to a fair use determination.” App. 34.

As the partial dissent also pointed out, the majority's disregard of Prince's testimony and exclusive reliance on its own aesthetic sensibilities is at odds with prior decisions of the Second Circuit, App. 32-33, including *Blanch v. Koons*, 467 F.3d 244, 255 (2d Cir. 2006), a case involving the appropriation of a "slick fashion photograph" in order, appropriation artist Jeff Koons claimed, "to satirize life as it appears when seen through the prism of slick fashion photography[.]" As the Second Circuit stated in *Blanch*: "[W]e need not depend on our own poorly honed artistic sensibilities. Koons explained, without contradiction, why he used Blanch's image[.]" *Id.* (Emphasis supplied). Anomalously, whereas in *Blanch* the Second Circuit credited a self-serving explanation in an affidavit that perhaps should have been taken with a grain of salt, in this case the Second Circuit majority disregarded Prince's deposition testimony concerning his own purpose and intent even though that testimony was against his own interest and, therefore, presumably reliable. Instead, the majority depended on its own "artistic sensibilities," however "poorly honed" and lacking in guidance and predictability they may be.

D. By Focusing Exclusively on the Perceived Transformative Character of Prince's Paintings, the Second Circuit Decision Conflicts with a Decision of Another Circuit and Renders Superfluous a Number of Important Statutory Provisions

The Second Circuit's decision renders superfluous important portions of the statutory text and creates a conflict with a decision of another circuit on an

important question of federal law. The Second Circuit's exclusive focus on the perceived expressive character of Prince's Paintings, without regard to Prince's testimony concerning his purpose, renders nugatory the threshold limitation in the preamble to § 107, protecting copying "for *purposes* such as criticism, comment, news reporting, teaching . . . , scholarship, or research." (Emphasis supplied). Similarly, the single-minded focus on the expressive character of the Paintings, to the exclusion of any consideration of Prince's explanation of his purpose, effectively rewrites the first fair use factor to call for an inquiry into the purpose *or* character of the use, contrary to the statutory language, which addresses the purpose *and* character of the use. This not only overrides the statutory text, but also creates a circuit split.

By finding a transformative expressive character based on its observation of what is "reasonably perceivable," while disregarding the secondary user's failure to justify his use as having a transformative purpose, the Second Circuit's majority opinion conflicts with *Elvis Presley Enterprises, Inc. v. Passport Video*, 349 F.3d 622, 629 (9th Cir. 2003), in which the Ninth Circuit rejected a fair use defense where the defendant had not "offer[ed] up a specific justification regarding its use" of copyrighted still photographs of Elvis Presley in a video documentary about his life.

The Second Circuit's decision also abrogates the copyright owner's exclusive right to prepare and authorize "derivative works based upon the copyrighted work," 17 U.S.C. § 106(2), including any "form in which a work may be recast, transformed, or adapted." *Id.* § 101. The Second Circuit decision nullifies this

exclusive statutory right to create or license derivative works which transform an original whenever, in the opinion of a particular judge, a work of appropriation art may reasonably be perceived as “transforming” an original by altering it to create a new aesthetic. This construction of § 107 (which does not even contain the word “transformative”) so as to override § 106(2)’s grant of the exclusive right to prepare and license derivative works (including those that “transform” the original, as defined in § 101) renders the latter two provisions superfluous, contrary to basic canons of statutory construction. *See Bilski v. Kappos*, 130 S. Ct. 3218, 3228-29 (2010) (reaffirming “the canon against interpreting any statutory provision in a manner that would render another provision superfluous”).

II. THE THIRD FAIR USE FACTOR, THE AMOUNT AND SUBSTANTIALITY OF THE PORTION USED, PERMITS SUBSTANTIAL COPYING, ESPECIALLY OF THE HEART OF THE ORIGINAL, ONLY WHERE (UNLIKE HERE) THE SECONDARY USER NEEDS TO “CONJURE UP” ENOUGH OF THE ORIGINAL TO MAKE IT RECOGNIZABLE FOR PURPOSES SUCH AS PARODY

Campbell, while it was a landmark case recalibrating a fair use defense that had become confusing, result-oriented and “disorderly” (Leval at 1107), was also a parody case. While much of what this Court said in *Campbell* has general applicability to all fair use cases, some of the reasoning and language – which the Second Circuit has inappositely cherry-

picked in this non-parody case – applies specifically to parody.

The Second Circuit relies on *Campbell*, 510 U.S. at 588, for the proposition that a secondary use must be permitted to “conjure up” at least enough of the original “to fulfill its transformative purpose.” App. 25. *Campbell*’s discussion of the need to “conjure up” substantial portions of an original relied, however, on a line of parody cases, including *Elsmere Music, Inc. v. National Broadcasting Company*, 623 F.2d 252, 253 n.1 (2d Cir. 1980) (“the concept of ‘conjuring up’ an original came into the copyright law . . . as a recognition that a parody frequently needs to be more than a fleeting evocation of an original in order to make its humorous point”) and *Fisher v. Dees*, 794 F.2d 432, 439 (9th Cir. 1986) (“Like a speech, a song is difficult to parody effectively without exact or near-exact copying. If the would-be parodist varies the music or meter of the original substantially, it simply will not be recognizable to the general audience. This ‘special need for accuracy,’ provides some license for ‘closer’ parody.”) (citation omitted). See *Campbell*, 510 U.S. at 588.

In *Campbell*, this Court’s approval of substantial copying was clearly limited to parody. After reiterating the normal rule, enunciated in *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 564-66 (1985), that it is improper to appropriate “the heart” of an original work and that substantial verbatim copying “may reveal a dearth of transformative character or purpose[,]” this Court noted that it “part[ed] company with the court below . . . in applying these guides to parody,” because “[p]arody presents a difficult case.” *Campbell*, 510 U.S.

at 588. The Court elaborated: “Parody’s humor, or in any event its comment, necessarily springs from recognizable allusion to its object through distorted imitation. Its art lies in the tension between a known original and its parodic twin. When parody takes aim at a particular original work, the parody must be able to ‘conjure up’ at least enough of that original to make the object of its critical wit recognizable.” *Id.* (citation omitted). Similarly, this Court stated: “Parody needs to mimic an original to make its point, and so has some claim to use the creation of its victim’s . . . imagination” *Id.* at 580-81.⁵

In addition to permitting substantial copying when there is no need to “conjure up” enough of the original to make it recognizable, the Second Circuit decision perversely stands *Campbell* on its head by permitting

⁵ To be sure, certain non-parodic uses also need to copy substantially in order to make the original recognizable. *See, e.g., Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 607, 609-13 (2d Cir. 2006) (images of Grateful Dead concert posters were used in their entirety in a biographical work, a form of “historical scholarship, criticism, and comment that require[s] incorporation of original source material for optimum treatment of [its] subjects[,]” and were “displayed [with] the minimal image size and quality necessary to ensure the reader’s recognition of the images as historical artifacts of Grateful Dead concert events.”); *Kelly v. Arriba SoftCorp.*, 336 F.3d 811, 821(9th Cir. 2003) (it was “necessary” for Internet search engine, which displayed small “thumbnails” of images, to “copy the entire image to allow users to recognize” it and decide whether to “pursue more information[,]” given that partial copying would have made the image “more difficult to identify” thereby “reducing the usefulness of the visual search engine.”) In this case, however, Prince had no comparable need to copy Cariou’s Photographs in whole or substantial part in order to make them recognizable.

substantial copying even when the secondary use supposedly renders the original *unrecognizable*. One of Prince's Paintings, *Djuana Barnes, Natalie Barney, Renee Vivien and Romaine Brooks take over the Guanahani*, appropriates an entire Cariou landscape, upon which Prince superimposed four nude women. App. 111. The Second Circuit approved this copying, stating "the entire source photograph is used but is also heavily obscured and altered to the point that Cariou's original is barely recognizable." App. 25. Even assuming that Cariou's Photograph truly is "barely recognizable" (*but see* App. 111), this analysis ignores Prince's obligation, under the third fair use factor, "persuasive[ly]" to provide a "justification for the particular copying done." *Campbell*, 510 U.S. at 586. There cannot be any conceivable justification for appropriating an entire copyrighted landscape photograph only in order to obscure it and make it unrecognizable, given, especially, the defense contention that Cariou's Photographs were "typical of their genre" (App. 44), and that equivalent alternative materials must, therefore, have been abundantly available.

Prince's statement that the Paintings were very quickly done and not really thought about (App. 84-85), runs counter to Justice Story's admonition that, for fair use to apply, "[t]here must be real, substantial condensation of the materials, and intellectual labor and judgment bestowed thereon; and not merely the facile use of the scissors; or extracts of the essential parts, constituting the chief value of the original work." *Folsom*, 9 F. Cas. at 345. While greater leeway is accorded to parodists, who are entitled to extract the essence of original works they are mocking, Prince had

no comparable need to appropriate Cariou's Photographs "in whole or substantial part" (App. 24-25) in order to make them recognizable. To nevertheless hold, as the Second Circuit did, that Prince "must be [permitted] to "conjure up" *at least* enough of the original' to fulfill [his] transformative purpose," (App. 25) (citations omitted) (emphasis in original) is an exercise in circular reasoning, inviting unlimited copying and effectively eliminating the third fair use factor from consideration under fair use analysis. *Campbell* authorizes nothing of the sort.⁶

III. THE SECOND CIRCUIT'S DECISION THAT CARIOU'S POTENTIAL AND DERIVATIVE MARKETS WERE NOT HARMED CONFLICTS WITH DECISIONS OF THE SUPREME COURT AND OTHER CIRCUITS APPLYING THE FOURTH FAIR USE FACTOR

The Second Circuit found Cariou's potential market was not harmed because Cariou had "not aggressively marketed his work" and Prince's work appealed, in any

⁶ The Second Circuit decision also conflicts with its earlier decision in *Blanch*, 467 F.3d at 248, where, in order "to comment on the commercial images in our consumer culture," Jeff Koons took a fragment of a photograph showing a woman's legs and feet resting on a man's lap in a first-class airplane cabin that "was supposed to have an erotic sense and a sexuality," and fulfilled his transformative purpose by taking "only the legs and feet from the photo [and inverting their orientation], discarding [the rest]." In other words, rather than merely "find[ing] a new way to exploit the creative virtues of the original work" (*id.* at 252), as Prince did here, Koons took "only that portion of the image[s] necessary" to make his point (*id.* at 258).

event, to a different audience, as shown by an “invitation list for a dinner that Gagosian hosted [for the opening of Prince’s show] [including] a number of the wealthy and famous such as the musicians Jay-Z and Beyonce Knowles, artists Damien Hirst and Jeff Koons, professional football player Tom Brady, model Gisele Bundchen, *Vanity Fair* editor Graydon Carter, *Vogue* editor Anna Wintour, authors Jonathan Franzen and Candace Bushnell, and actors Robert DeNiro, Angelina Jolie, and Brad Pitt.” App. 23.

The emphasis on Cariou not having aggressively marketed his work overlooks the statutory focus on *potential markets* and conflicts with decisions of other circuits. See *Balsley v. LFP, Inc.*, 691 F.3d 747, 761 (6th Cir. 2012) (although plaintiffs had “no present intention of exploiting the market” for a compromising photograph of one of the plaintiffs, to which they owned the copyright, “their current desire or ability to avail themselves of the market for the . . . photograph is immaterial to the issue outlined by the statute, namely, whether there is potential for an adverse effect on the market for the photograph should the challenged use become widespread”), *cert. denied*, 133 S. Ct. 944 (2013); *Worldwide Church of God v. Philadelphia Church of God, Inc.*, 227 F.3d 1110, 1119 (9th Cir. 2000) (“Even an author who had disavowed any intention to publish his work during his lifetime was entitled to protection of his copyright, first, because the relevant consideration was the ‘potential market’ and, second, because he has the right to change his mind”).

As for the celebrities named by the Second Circuit who were on Gagosian’s invitation list, while they may

have been *invited* to the dinner, there is no evidence in the record that any of them actually attended the dinner, let alone that any of them purchased one of Prince's Paintings. But, even if certain individuals interested in acquiring Prince's work would not have had any interest in Cariou's photography, it does not follow that all the buzz surrounding the Gagosian exhibition of Prince's Paintings could not have harmed Cariou's potential market by dissuading galleries from showing Cariou's work. The plausibility of this type of harm to Cariou's potential market is exemplified by the decision by one such gallery owner, Christianne Celle, to discontinue plans for a *Yes Rasta* show, where prints of the Photographs would have been offered for sale, due to her not wanting to appear to be capitalizing on Prince's Paintings and not wanting to show work which had been "done already" at the nearby Gagosian Gallery. While the Second Circuit wrote off Celle's testimony on the grounds that she really discontinued plans for the show because she wondered whether Prince and Cariou had been collaborating – overlooking Celle's testimony that she decided irrevocably not to put on the *Yes Rasta* show "the minute" she became aware of the Prince exhibition and immediately replaced Cariou's show with one by another photographer, whose ethnographic photography resembled Cariou's (App. 98, 100-01) – the point is that wholesale, verbatim copying of Cariou's Photographs and prominent marketing and exhibition of the derivative Paintings clearly carried a "potential for an adverse effect on [Cariou's] market" *Balsley*, 691 F.3d at 761.

The Second Circuit also erroneously found no harm to any potential derivative market, stating: "There is

nothing in the record to suggest that Cariou would ever develop or license secondary uses of his work in the vein of Prince's artworks." App. 22-23. While it is true that the record is silent on the issue of harm to this potential derivative market, that silence is attributable to counsel for Prince and Gagosian never asking Cariou during his deposition whether he would have given Prince (or any other artist) a license. Since fair use is an affirmative defense, *Campbell*, 510 U.S. at 590, Prince and Gagosian had the burden of coming forward with evidence of lack of harm to this potential derivative market. As this Court held in *Campbell*, even though "there was no evidence that a potential rap market was harmed in any way by 2 Live Crew's parody," summary judgment in favor of the defendants was inappropriate because "a silent record on an important factor bearing on fair use disintitled the proponent of the defense, 2 Live Crew, to summary judgment." *Id.* at 593-94.

CONCLUSION

For the foregoing reasons, it is respectfully requested that the petition for a writ of certiorari be granted.

Respectfully submitted,

Daniel J. Brooks

Counsel of Record

Theodore L. Hecht

Kenneth R. Puhala

Eric A. Boden

SCHNADER HARRISON SEGAL & LEWIS LLP

140 Broadway, Suite 3100

New York, New York 10005

(212) 973-8000

dbrooks@schnader.com

Counsel for Petitioner Patrick Cariou

August 21, 2013

APPENDIX

APPENDIX

TABLE OF CONTENTS

Appendix A: Majority Opinion, Judgment, and Separate Opinion Dissenting in Part of the United States Court of Appeals for the Second Circuit (April 25, 2013) App. 1

Appendix B: Memorandum and Order of the United States District Court for the Southern District of New York (March 18, 2011) App. 36

Appendix C: Order Denying Petition for Rehearing and Rehearing *en banc* of the United States Court of Appeals for the Second Circuit (June 10, 2013) App. 68

Appendix D: Excerpts of Videotaped Deposition of Richard Prince in the United States District Court for the Southern District of New York (October 6, 2009) App. 70

Appendix E:	Excerpts of Condensed Deposition Transcript of Christiane Celle in the United States District Court for the Southern District of New York (January 26, 2010)	App. 96
Appendix F:	Excerpts of Appendix to the April 25, 2013 Opinion of the United States Court of Appeals for the Second Circuit, with Index to Appendix and Selected Images of Richard Prince Paintings and Patrick Cariou Source Photographs	App. 102

App. 1

APPENDIX A

**UNITED STATES COURT OF APPEALS FOR
THE SECOND CIRCUIT**

Docket No. 11-1197-cv

[Filed April 25, 2013]

PATRICK CARIOU,)
 Plaintiff-Appellee,)
))
 v.))
))
RICHARD PRINCE,)
 Defendant-Appellant,)
))
GAGOSIAN GALLERY, INC.,)
LAWRENCE GAGOSIAN,)
 Defendants-Cross-Defendants-Appellants.)
_____))

August Term, 2011

(Argued: May 21, 2012 Decided: April 25, 2013)

App. 2

Before: B.D.PARKER, HALL, and WALLACE,* Circuit Judges.

Appeal from a judgment of the United States District Court for the Southern District of New York (Batts, *J.*), on Plaintiff-Appellee Patrick Cariou's claim that Defendant-Appellant Richard Prince's artworks infringe on Cariou's registered copyrights in certain photographs. We conclude that the district court applied the incorrect standard to determine whether Prince's artworks make fair use of Cariou's copyrighted photographs. We further conclude that all but five of Prince's works do make fair use of Cariou's copyrighted photographs. With regard to the remaining five Prince artworks, we remand to the district court to consider, in the first instance, whether Prince is entitled to a fair use defense.

REVERSED in part, VACATED in part, and REMANDED.

B.D. PARKER, *J.*, delivered the opinion of the Court, in which HALL, *J.*, joined. WALLACE, *J.*, filed an opinion concurring in part and dissenting in part.

* The Honorable J. Clifford Wallace, United States Circuit Judge of the United States Court of Appeals for the Ninth Circuit, sitting by designation.

App. 3

JOSHUA I. SCHILLER (Jonathan D. Schiller, George F. Carpinello, *on the brief*), Boies, Schiller & Flexner LLP, New York, NY, *for Defendant-Appellant Richard Prince.*

HOLLIS ANNE GONERKA BART, CHAYA WEINBERG-BRODT, DARA G. HAMMERMAN, AZMINA N. JASANI, Withers Bergman LLP, New York, NY, *for Defendants-Appellants Gagosian Gallery, Inc. and Lawrence Gagosian.*

DANIEL J. BROOKS (Seth E. Spitzer, Eric A. Boden, *on the brief*), Schnader Harrison Segal & Lewis LLP, New York, NY, *for Plaintiff-Appellee Patrick Cariou.*

ANTHONY T. FALZONE, JULIE A. AHRENS, DANIEL K. NAZER, Stanford Law School Center for Internet and Society, Stanford, CA; VIRGINIA RUTLEDGE, NEW YORK, NY; ZACHARY J. ALINDER, JOHN A. POLITO, Bingham Mccutchen LLP, San Francisco, CA, *for Amicus The Andy Warhol Foundation for the Visual Arts.*

JOSEPH C. GRATZ, Durie Tangri, LLP, San Francisco, CA; OLIVER METZGER, Google Inc., Mountain View, CA, *for Amicus Google Inc.*

CLIFFORD M. SLOAN, BRADLEY A. KLEIN, Skadden, Arps, Slate, Meagher & Flom LLP, Washington, DC, *for Amici The Association of Art Museum Directors, The Art Institute of Chicago, The Indianapolis Museum of Art, The Metropolitan Museum of Art, The Museum of Modern Art, Museum Associates d.b.a. Los Angeles County Museum of Art, The New*

App. 4

Museum, The Solomon R. Guggenheim Foundation, The Walker Art Center, and The Whitney Museum of American Art.

MICHAEL WILLIAMS, DALE M. CENDALI, CLAUDIA RAY, Kirkland & Ellis LLP, Washington, DC, *for Amici American Society of Media Photographers, Inc., and Picture Archive Council of America.*

BARRINGTON D. PARKER, *Circuit Judge:*

In 2000, Patrick Cariou published *Yes Rasta*, a book of classical portraits and landscape photographs that he took over the course of six years spent living among Rastafarians in Jamaica. Richard Prince altered and incorporated several of Cariou's *Yes Rasta* photographs into a series of paintings and collages, called *Canal Zone*, that he exhibited in 2007 and 2008, first at the Eden Rock hotel in Saint Barthélemy ("St. Barth's") and later at New York's Gagosian Gallery.¹ In addition, Gagosian published and sold an exhibition catalog that contained reproductions of Prince's paintings and images from Prince's workshop.

Cariou sued Prince and Gagosian, alleging that Prince's *Canal Zone* works and exhibition catalog infringed on Cariou's copyrights in the incorporated *Yes Rasta* photographs. The defendants raised a fair use defense. After the parties cross-moved for summary judgment, the United States District Court for the Southern District of New York (Batts, *J.*) granted

¹ We refer to Gagosian Gallery and its owner Lawrence Gagosian collectively as "Gagosian" or the "Gallery."

App. 5

Cariou’s motion, denied the defendants’, and entered a permanent injunction. It compelled the defendants to deliver to Cariou all infringing works that had not yet been sold, for him to destroy, sell, or otherwise dispose of.

Prince and Gagosian principally contend on appeal that Prince’s work is transformative and constitutes fair use of Cariou’s copyrighted photographs, and that the district court imposed an incorrect legal standard when it concluded that, in order to qualify for a fair use defense, Prince’s work must “comment on Cariou, on Cariou’s Photos, or on aspects of popular culture closely associated with Cariou or the Photos.” *Cariou v. Prince*, 784 F. Supp. 2d 337, 349 (S.D.N.Y. 2011). We agree with Appellants that the law does not require that a secondary use comment on the original artist or work, or popular culture, and we conclude that twenty-five of Prince’s artworks do make fair use Cariou’s copyrighted photographs. With regard to the remaining five artworks, we remand to the district court, applying the proper standard, to consider in the first instance whether Prince is entitled to a fair use defense.²

BACKGROUND

The relevant facts, drawn primarily from the parties’ submissions in connection with their cross-motions for summary judgment, are undisputed. Cariou is a professional photographer who, over the

² The district court’s opinion indicated that there are twenty-nine artworks at issue in this case. *See Cariou*, 784 F. Supp. 2d at 344 nn.5, 6. There are actually thirty.

App. 6

course of six years in the mid-1990s, lived and worked among Rastafarians in Jamaica. The relationships that Cariou developed with them allowed him to take a series of portraits and landscape photographs that Cariou published in 2000 in a book titled *Yes Rasta*. As Cariou testified, *Yes Rasta* is “extreme classical photography [and] portraiture,” and he did not “want that book to look pop culture at all.” Cariou Dep. 187:8-15, Jan. 12, 2010.

Cariou’s publisher, PowerHouse Books, Inc., printed 7,000 copies of *Yes Rasta*, in a single printing. Like many, if not most, such works, the book enjoyed limited commercial success. The book is currently out of print. As of January 2010, PowerHouse had sold 5,791 copies, over sixty percent of which sold below the suggested retail price of sixty dollars. PowerHouse has paid Cariou, who holds the copyrights to the *Yes Rasta* photographs, just over \$8,000 from sales of the book. Except for a handful of private sales to personal acquaintances, he has never sold or licensed the individual photographs.

Prince is a well-known appropriation artist. The Tate Gallery has defined appropriation art as “the more or less direct taking over into a work of art a real object or even an existing work of art.” J.A. 446. Prince’s work, going back to the mid-1970s, has involved taking photographs and other images that others have produced and incorporating them into paintings and collages that he then presents, in a different context, as his own. He is a leading exponent of this genre and his work has been displayed in museums around the world, including New York’s Solomon R. Guggenheim Museum and Whitney

App. 7

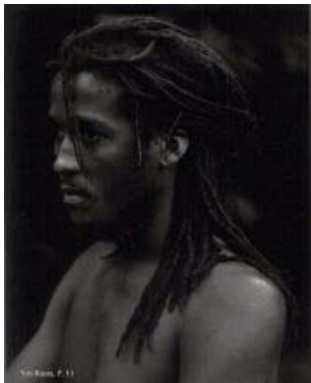
Museum, San Francisco's Museum of Modern Art, Rotterdam's Museum Boijmans van Beuningen, and Basel's Museum fur Gegenwartskunst. As Prince has described his work, he "completely tr[ies] to change [another artist's work] into something that's completely different." Prince Dep. 338:4-8, Oct. 6, 2009.

Prince first came across a copy of *Yes Rasta* in a bookstore in St. Barth's in 2005. Between December 2007 and February 2008, Prince had a show at the Eden Rock hotel in St. Barth's that included a collage, titled *Canal Zone (2007)*, comprising 35 photographs torn out of *Yes Rasta* and pinned to a piece of plywood. Prince altered those photographs significantly, by among other things painting "lozenges" over their subjects' facial features and using only portions of some of the images. In June 2008, Prince purchased three additional copies of *Yes Rasta*. He went on to create thirty additional artworks in the *Canal Zone* series, twenty-nine of which incorporated partial or whole images from *Yes Rasta*.³ The portions of *Yes Rasta* photographs used, and the amount of each artwork that they constitute, vary significantly from piece to piece. In certain works, such as *James Brown Disco Ball*, Prince affixed headshots from *Yes Rasta* onto other appropriated images, all of which Prince placed on a canvas that he had painted. In these, Cariou's work is almost entirely obscured. The Prince artworks also incorporate photographs that have been enlarged

³ Images of the Prince artworks, along with the *Yes Rasta* photographs incorporated therein, appear in the Appendix to this opinion. The Appendix is available at <http://www.ca2.uscourts.gov/11-1197apx.htm>.

App. 8

or tinted, and incorporate photographs appropriated from artists other than Cariou as well. *Yes Rasta* is a book of photographs measuring approximately 9.5" x 12". Prince's artworks, in contrast, comprise inkjet printing and acrylic paint, as well as pasted-on elements, and are several times that size. For instance, *Graduation* measures 72 3/4" x 52 1/2" and *James Brown Disco Ball* 100 1/2" x 104 1/2". The smallest of the Prince artworks measures 40" x 30", or approximately ten times as large as each page of *Yes Rasta*.



Patrick Cariou, Photographs from *Yes Rasta*, pp. 11, 59

App. 9



Richard Prince, *James Brown Disco Ball*

In other works, such as *Graduation*, Cariou's original work is readily apparent: Prince did little more than paint blue lozenges over the subject's eyes and mouth, and paste a picture of a guitar over the subject's body.



Patrick Cariou, Photograph from *Yes Rasta*, p. 118



Richard Prince, *Graduation*

Between November 8 and December 20, 2008, the Gallery put on a show featuring twenty-two of Prince's *Canal Zone* artworks, and also published and sold an exhibition catalog from the show. The catalog included all of the *Canal Zone* artworks (including those not in the Gagosian show) except for one, as well as, among other things, photographs showing *Yes Rasta* photographs in Prince's studio. Prince never sought or received permission from Cariou to use his photographs.

Prior to the Gagosian show, in late August, 2008, a gallery owner named Cristiane Celle contacted Cariou and asked if he would be interested in discussing the possibility of an exhibit in New York City. Celle did not mention *Yes Rasta*, but did express interest in photographs Cariou took of surfers, which he published in 1998 in the aptly titled *Surfers*. Cariou responded

that *Surfers* would be republished in 2008, and inquired whether Celle might also be interested in a book Cariou had recently completed on gypsies. The two subsequently met and discussed Cariou's exhibiting work in Celle's gallery, including prints from *Yes Rasta*. They did not select a date or photographs to exhibit, nor did they finalize any other details about the possible future show.

At some point during the *Canal Zone* show at Gagosian, Celle learned that Cariou's photographs were "in the show with Richard Prince." Celle then phoned Cariou and, when he did not respond, Celle mistakenly concluded that he was "doing something with Richard Prince . . . [Maybe] he's not pursuing me because he's doing something better, bigger with this person. . . . [H]e didn't want to tell the French girl I'm not doing it with you, you know, because we had started a relation and that would have been bad." Celle Dep. 88:15-89:7, Jan. 26, 2010. At that point, Celle decided that she would not put on a "Rasta show" because it had been "done already," and that any future Cariou exhibition she put on would be of photographs from *Surfers*. Celle remained interested in exhibiting prints from *Surfers*, but Cariou never followed through.

According to Cariou, he learned about the Gagosian *Canal Zone* show from Celle in December 2008. On December 30, 2008, he sued Prince, the Gagosian Gallery, and Lawrence Gagosian, raising claims of copyright infringement. *See* 17 U.S.C. §§ 106, 501. The defendants asserted a fair use defense, arguing that Prince's artworks are transformative of Cariou's photographs and, accordingly, do not violate Cariou's copyrights. *See, e.g., Campbell v. Acuff-Rose Music,*

Inc., 510 U.S. 569, 578-79 (1994). Ruling on the parties' subsequently-filed cross-motions for summary judgment, the district court (Batts, *J.*) "impose[d] a requirement that the new work in some way comment on, relate to the historical context of, or critically refer back to the original works" in order to be qualify as fair use, and stated that "Prince's Paintings are transformative only to the extent that they comment on the Photos." *Cariou v. Prince*, 784 F. Supp. 2d 337, 348-49 (S.D.N.Y. 2011). The court concluded that "Prince did not intend to comment on Cariou, on Cariou's Photos, or on aspects of popular culture closely associated with Cariou or the Photos when he appropriated the Photos," *id.* at 349, and for that reason rejected the defendants' fair use defense and granted summary judgment to Cariou. The district court also granted sweeping injunctive relief, ordering the defendants to "deliver up for impounding, destruction, or other disposition, as [Cariou] determines, all infringing copies of the Photographs, including the Paintings and unsold copies of the *Canal Zone* exhibition book, in their possession." *Id.* at 355.⁴ This appeal followed.

DISCUSSION

I.

We review a grant of summary judgment *de novo*. See *Blanch v. Koons*, 467 F.3d 244, 249-50 (2d Cir.

⁴ At oral argument, counsel for Cariou indicated that he opposes the destruction of any of the works of art that are the subject of this litigation.

2006). The well known standards for summary judgment set forth in Rule 56(c) apply. *See* Fed. R. Civ. P. 56. “Although fair use is a mixed question of law and fact, this court has on numerous occasions resolved fair use determinations at the summary judgment stage where . . . there are no genuine issues of material fact.” *Blanch*, 467 F.3d at 250 (quotation marks and brackets omitted); *see also Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 560 (1985); *Castle Rock Entm’t, Inc. v. Carol Publ’g Grp., Inc.*, 150 F.3d 132, 137 (2d Cir. 1998). This case lends itself to that approach.

II.

The purpose of the copyright law is “[t]o promote the Progress of Science and useful Arts” U.S. Const., Art. I, § 8, cl. 8. As Judge Pierre Leval of this court has explained, “[t]he copyright is not an inevitable, divine, or natural right that confers on authors the absolute ownership of their creations. It is designed rather to stimulate activity and progress in the arts for the intellectual enrichment of the public.” Pierre N. Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105, 1107 (1990) (hereinafter “Leval”). Fair use is “necessary to fulfill [that] very purpose.” *Campbell*, 510 U.S. at 575. Because “excessively broad protection would stifle, rather than advance, the law’s objective,” fair use doctrine “mediates between” “the property rights [copyright law] establishes in creative works, which must be protected up to a point, and the ability of authors, artists, and the rest of us to express them- or ourselves by reference to the works of others, which must be protected up to a point.” *Blanch*, 467 F.3d at 250 (brackets omitted) (quoting Leval at 1109).

App. 14

The doctrine was codified in the Copyright Act of 1976, which lists four non-exclusive factors that must be considered in determining fair use. Under the statute,

[T]he fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include –

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

17 U.S.C. § 107. As the statute indicates, and as the Supreme Court and our court have recognized, the fair use determination is an open-ended and context-sensitive inquiry. *Campbell*, 510 U.S. at 577-78; *Blanch*, 467 F.3d at 251. The statute “employs the terms ‘including’ and ‘such as’ in the preamble paragraph to indicate the illustrative and not

App. 15

limitative function of the examples given, which thus provide only general guidance about the sorts of copying that courts and Congress most commonly had found to be fair uses.” *Campbell*, 510 U.S. at 577-78 (quotation marks and citation omitted). The “ultimate test of fair use . . . is whether the copyright law’s goal of ‘promoting the Progress of Science and useful Arts’ . . . would be better served by allowing the use than by preventing it.” *Castle Rock*, 150 F.3d at 141 (brackets and citation omitted).

The first statutory factor to consider, which addresses the manner in which the copied work is used, is “[t]he heart of the fair use inquiry.” *Blanch*, 467 F.3d at 251. We ask

whether the new work merely ‘supersedes 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[.]. . . in other words, whether and to what extent the new work is transformative. . . . [T]ransformative works . . . lie at the heart of the fair use doctrine’s guarantee of breathing space

Campbell, 510 U.S. at 579 (citations and some quotation marks omitted) (quoting *Folsom v. Marsh*, 9 F. Cas. 342, 348 *No. 4,901) (C.C.D. Mass. 1841) (Story, *J.*)). “If ‘the secondary use adds value to the original – if [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.’”

Castle Rock, 150 F.3d at 142 (quoting Leval 1111). For a use to be fair, it “must be productive and must employ the quoted matter in a different manner or for a different purpose from the original.” Leval at 1111.

The district court imposed a requirement that, to qualify for a fair use defense, a secondary use must “comment on, relate to the historical context of, or critically refer back to the original works.” *Cariou*, 784 F. Supp. 2d at 348. Certainly, many types of fair use, such as satire and parody, invariably comment on an original work and/or on popular culture. For example, the rap group 2 Live Crew’s parody of Roy Orbison’s “Oh, Pretty Woman” “was clearly intended to ridicule the white-bread original.” *Campbell*, 510 U.S. at 582 (quotation marks omitted). Much of Andy Warhol’s work, including work incorporating appropriated images of Campbell’s soup cans or of Marilyn Monroe, comments on consumer culture and explores the relationship between celebrity culture and advertising. As even *Cariou* concedes, however, the district court’s legal premise was not correct. The law imposes no requirement that a work comment on the original or its author in order to be considered transformative, and a secondary work may constitute a fair use even if it serves some purpose other than those (criticism, comment, news reporting, teaching, scholarship, and research) identified in the preamble to the statute. *Id.* at 577; *Harper & Row*, 471 U.S. at 561. Instead, as the Supreme Court as well as decisions from our court have emphasized, to qualify as a fair use, a new work generally must alter the original with “new expression, meaning, or message.” *Campbell*, 510 U.S. at 579; see also *Blanch*, 467 F.3d at 253 (original must be employed “in the creation of new information, new

App. 17

aesthetics, new insights and understandings” (quotation marks omitted)); *Castle Rock*, 150 F.3d at 142.

Here, our observation of Prince’s artworks themselves convinces us of the transformative nature of all but five, which we discuss separately below. These twenty-five of Prince’s artworks manifest an entirely different aesthetic from Cariou’s photographs. Where Cariou’s serene and deliberately composed portraits and landscape photographs depict the natural beauty of Rastafarians and their surrounding environs, Prince’s crude and jarring works, on the other hand, are hectic and provocative. Cariou’s black-and-white photographs were printed in a 9 1/2" x 12" book. Prince has created collages on canvas that incorporate color, feature distorted human and other forms and settings, and measure between ten and nearly a hundred times the size of the photographs. Prince’s composition, presentation, scale, color palette, and media are fundamentally different and new compared to the photographs, as is the expressive nature of Prince’s work. *See Campbell*, 510 U.S. at 579.

Prince’s deposition testimony further demonstrates his drastically different approach and aesthetic from Cariou’s. Prince testified that he “[doesn’t] have any really interest in what [another artist’s] original intent is because . . . what I do is I completely try to change it into something that’s completely different. . . . I’m trying to make a kind of fantastic, absolutely hip, up to date, contemporary take on the music scene.” Prince Dep. 338:4-339:3, Oct. 6, 2009. As the district court determined, Prince’s *Canal Zone* artworks relate to a “post-apocalyptic screenplay” Prince had planned, and

“emphasize themes [of Prince’s planned screenplay] of equality of the sexes; highlight ‘the three relationships in the world, which are men and women, men and men, and women and women’; and portray a contemporary take on the music scene.” *Cariou*, 784 F. Supp. 2d at 349; *see* Prince Dep. 339:3-7, Oct. 6, 2009.

The district court based its conclusion that Prince’s work is not transformative in large part on Prince’s deposition testimony that he “do[es]n’t really have a message,” that he was not “trying to create anything with a new meaning or a new message,” and that he “do[es]n’t have any . . . interest in [Cariou’s] original intent.” *Cariou*, 784 F. Supp. 2d at 349; *see* Prince Dep. 45:25-46:2, 338:5-6, 360:18-20, Oct. 6, 2009. On appeal, Cariou argues that we must hold Prince to his testimony and that we are not to consider how Prince’s works may reasonably be perceived unless Prince claims that they were satire or parody. No such rule exists, and we do not analyze satire or parody differently from any other transformative use.

It is not surprising that, when transformative use is at issue, the alleged infringer would go to great lengths to explain and defend his use as transformative. Prince did not do so here. However, the fact that Prince did not provide those sorts of explanations in his deposition – which might have lent strong support to his defense – is not dispositive. What is critical is how the work in question appears to the reasonable observer, not simply what an artist might say about a particular piece or body of work. Prince’s work could be transformative even without commenting on Cariou’s work or on culture, and even without Prince’s stated intention to do so. Rather than confining our inquiry

to Prince's explanations of his artworks, we instead examine how the artworks may "reasonably be perceived" in order to assess their transformative nature. *Campbell*, 510 U.S. at 582; *Leibovitz v. Paramount Pictures Corp.*, 137 F.3d 109, 113-14 (2d Cir. 1998) (evaluating parodic nature of advertisement in light of how it "may reasonably be perceived"). The focus of our infringement analysis is primarily on the Prince artworks themselves, and we see twenty-five of them as transformative as a matter of law.

In this respect, the Seventh Circuit's recent decision in *Brownmark Films, LLC v. Comedy Partners*, 682 F.3d 687 (7th Cir. 2012), is instructive. There, the court rejected the appellant's argument that copyright infringement claims cannot be disposed of at the motion-to-dismiss stage, and affirmed the district court's dismissal of such a claim under Fed. R. Civ. P. 12(b)(6). *Brownmark Films*, 682 F.3d at 690. Considering whether an episode of the animated television show *South Park* presented a parody (and therefore a protected fair use) of a viral internet video titled "What What (In The Butt)," the court concluded that "[w]hen the two works . . . are viewed side-by-side, the *South Park* episode is clearly a parody of the original . . . video." *Id.* at 692. For that reason, "the only two pieces of evidence needed to decide the question of fair use in [*Brownmark* were] the original version of [the video] and the episode at issue." *Id.* at 690.

Here, looking at the artworks and the photographs side-by-side, we conclude that Prince's images, except for those we discuss separately below, have a different character, give Cariou's photographs a new expression,

and employ new aesthetics with creative and communicative results distinct from Cariou's. Our conclusion should not be taken to suggest, however, that any cosmetic changes to the photographs would necessarily constitute fair use. A secondary work may modify the original without being transformative. For instance, a derivative work that merely presents the same material but in a new form, such as a book of synopses of television shows, is not transformative. *See Castle Rock*, 150 F.3d at 143; *Twin Peaks Prods., Inc. v. Publ'ns Int'l, Ltd.*, 996 F.2d 1366, 1378 (2d Cir. 1993). In twenty-five of his artworks, Prince has not presented the same material as Cariou in a different manner, but instead has "add[ed] something new" and presented images with a fundamentally different aesthetic. *Leibovitz*, 137 F.3d at 114.

The first fair use factor – the purpose and character of the use – also requires that we consider whether the allegedly infringing work has a commercial or nonprofit educational purpose. *See, e.g., Blanch*, 467 F.3d at 253. That being said, "nearly all of the illustrative uses listed in the preamble paragraph of § 107, including news reporting, comment, criticism, teaching, scholarship, and research . . . are generally conducted for profit." *Campbell*, 510 U.S. at 584 (quotation marks omitted). "The commercial/nonprofit dichotomy concerns the unfairness that arises when a secondary user makes unauthorized use of copyrighted material to capture significant revenues as a direct consequence of copying the original work." *Am. Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 922 (2d Cir. 1994). This factor must be applied with caution because, as the Supreme Court has recognized, Congress "could not have intended" a rule that commercial uses are

presumptively unfair. *Campbell*, 510 U.S. at 584. Instead, “[t]he 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.” *Id.* at 579. Although there is no question that Prince’s artworks are commercial, we do not place much significance on that fact due to the transformative nature of the work.

We turn next to the fourth statutory factor, the effect of the secondary use upon the potential market for the value of the copyrighted work, because such discussion further demonstrates the significant differences between Prince’s work, generally, and Cariou’s. Much of the district court’s conclusion that Prince and Gagosian infringed on Cariou’s copyrights was apparently driven by the fact that Celle decided not to host a *Yes Rasta* show at her gallery once she learned of the Gagosian *Canal Zone* show. The district court determined that this factor weighs against Prince because he “has unfairly damaged both the actual and potential markets for Cariou’s original work and the potential market for derivative use licenses for Cariou’s original work.” *Cariou*, 784 F. Supp. 2d at 353.

Contrary to the district court’s conclusion, the application of this factor does not focus principally on the question of damage to Cariou’s derivative market. We have made clear that “our concern is not whether the secondary use suppresses or even destroys the market for the original work or its potential derivatives, but whether the secondary use *usurps* the market of the original work.” *Blanch*, 467 F.3d at 258 (quotation marks omitted) (emphasis added); *NXIVM Corp. v. Ross Inst.*, 364 F.3d 471, 481-82 (2d Cir. 2004).

“The market for potential derivative uses includes only those that creators of original works would in general develop or license others to develop.” *Campbell*, 510 U.S. at 592. Our court has concluded that an accused infringer has usurped the market for copyrighted works, including the derivative market, where the infringer’s target audience and the nature of the infringing content is the same as the original. For instance, a book of trivia about the television show *Seinfeld* usurped the show’s market because the trivia book “substitute[d] for a derivative market that a television program copyright owner . . . would in general develop or license others to develop.” *Castle Rock*, 150 F.3d at 145 (quotation marks omitted). Conducting this analysis, we are mindful that “[t]he more transformative the secondary use, the less likelihood that the secondary use substitutes for the original,” even though “the fair use, being transformative, might well harm, or even destroy, the market for the original.” *Id.*

As discussed above, Celle did not decide against putting on a *Yes Rasta* show because it had already been done at Gagosian, but rather because she mistakenly believed that Cariou had collaborated with Prince on the Gagosian show. Although certain of Prince’s artworks contain significant portions of certain of Cariou’s photographs, neither Prince nor the *Canal Zone* show usurped the market for those photographs. Prince’s audience is very different from Cariou’s, and there is no evidence that Prince’s work ever touched – much less usurped – either the primary or derivative market for Cariou’s work. There is nothing in the record to suggest that Cariou would ever develop or license secondary uses of his work in the vein of

Prince's artworks. Nor does anything in the record suggest that Prince's artworks had any impact on the marketing of the photographs. Indeed, Cariou has not aggressively marketed his work, and has earned just over \$8,000 in royalties from *Yes Rasta* since its publication. He has sold four prints from the book, and only to personal acquaintances.

Prince's work appeals to an entirely different sort of collector than Cariou's. Certain of the *Canal Zone* artworks have sold for two million or more dollars. The invitation list for a dinner that Gagolian hosted in conjunction with the opening of the *Canal Zone* show included a number of the wealthy and famous such as the musicians Jay-Z and Beyonce Knowles, artists Damien Hirst and Jeff Koons, professional football player Tom Brady, model Gisele Bundchen, *Vanity Fair* editor Graydon Carter, *Vogue* editor Anna Wintour, authors Jonathan Franzen and Candace Bushnell, and actors Robert DeNiro, Angelina Jolie, and Brad Pitt. Prince sold eight artworks for a total of \$10,480,000, and exchanged seven others for works by painter Larry Rivers and by sculptor Richard Serra. Cariou on the other hand has not actively marketed his work or sold work for significant sums, and nothing in the record suggests that anyone will not now purchase Cariou's work, or derivative non-transformative works (whether Cariou's own or licensed by him) as a result of the market space that Prince's work has taken up. This fair use factor therefore weighs in Prince's favor.

The next statutory factor that we consider, the nature of the copyrighted work, "calls for recognition that some works are closer to the core of intended copyright protection than others, with the consequence

that fair use is more difficult to establish when the former works are copied.” *Campbell*, 510 U.S. at 586. We consider “(1) whether the work is expressive or creative, . . . with a greater leeway being allowed to a claim of fair use where the work is factual or informational, and (2) whether the work is published or unpublished, with the scope for fair use involving unpublished works being considerably narrower.” *Blanch*, 467 F.3d at 256 (quoting 2 Howard B. Abrams, *The Law of Copyright*, § 15:52 (2006)).

Here, there is no dispute that Cariou’s work is creative and published. Accordingly, this factor weighs against a fair use determination. However, just as with the commercial character of Prince’s work, this factor “may be of limited usefulness where,” as here, “the creative work of art is being used for a transformative purpose.” *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 612 (2d Cir. 2006).

The final factor that we consider in our fair use inquiry is “the amount and substantiality of the portion used in relation to the copyrighted work as a whole.” 17 U.S.C. § 107(3). We ask “whether the quantity and value of the materials used[] are reasonable in relation to the purpose of the copying.” *Blanch*, 467 F.3d at 257 (quotation marks omitted). In other words, we consider the proportion of the original work used, and not how much of the secondary work comprises the original.

Many of Prince’s works use Cariou’s photographs, in particular the portrait of the dreadlocked Rastafarian at page 118 of *Yes Rasta*, the Rastafarian on a burro at pages 83 to 84, and the dreadlocked and bearded

Rastafarian at page 108, in whole or substantial part. In some works, such as *Charlie Company*, Prince did not alter the source photograph very much at all. In others, such as *Djuana Barnes*, *Natalie Barney*, *Renee Vivien and Romaine Brooks take over the Guanahani*, the entire source photograph is used but is also heavily obscured and altered to the point that Cariou's original is barely recognizable. Although "[n]either our court nor any of our sister circuits has ever ruled that the copying of an entire work favors fair use[,] . . . courts have concluded that such copying does not necessarily weigh against fair use because copying the entirety of a work is sometimes necessary to make a fair use of the image." *Bill Graham*, 448 F.3d at 613. "[T]he third-factor inquiry must take into account that the extent of permissible copying varies with the purpose and character of the use." *Id.* (internal quotation marks omitted).

The district court determined that Prince's "taking was substantially greater than necessary." *Cariou*, 784 F. Supp. 2d at 352. We are not clear as to how the district court could arrive at such a conclusion. In any event, the law does not require that the secondary artist may take no more than is necessary. See *Campbell*, 510 U.S. at 588; *Leibovitz*, 137 F.3d at 114. We consider not only the quantity of the materials taken but also "their quality and importance" to the original work. *Campbell*, 510 U.S. at 587. The secondary use "must be [permitted] to 'conjure up' at least enough of the original" to fulfill its transformative purpose. *Id.* at 588 (emphasis added); *Leibovitz*, 137 F.3d at 114. Prince used key portions of certain of Cariou's photographs. In doing that, however, we determine that in twenty-five of his artworks, Prince

transformed those photographs into something new and different and, as a result, this factor weighs heavily in Prince's favor.

As indicated above, there are five artworks that, upon our review, present closer questions. Specifically, *Graduation*, *Meditation*, *Canal Zone (2008)*, *Canal Zone (2007)*, and *Charlie Company* do not sufficiently differ from the photographs of Cariou's that they incorporate for us confidently to make a determination about their transformative nature as a matter of law. Although the minimal alterations that Prince made in those instances moved the work in a different direction from Cariou's classical portraiture and landscape photos, we can not say with certainty at this point whether those artworks present a "new expression, meaning, or message." *Campbell*, 510 U.S. at 579.

Certainly, there are key differences in those artworks compared to the photographs they incorporate. *Graduation*, for instance, is tinted blue, and the jungle background is in softer focus than in Cariou's original. Lozenges painted over the subject's eyes and mouth – an alteration that appears frequently throughout the *Canal Zone* artworks – make the subject appear anonymous, rather than as the strong individual who appears in the original. Along with the enlarged hands and electric guitar that Prince pasted onto his canvas, those alterations create the impression that the subject is not quite human. Cariou's photograph, on the other hand, presents a human being in his natural habitat, looking intently ahead. Where the photograph presents someone comfortably at home in nature, *Graduation* combines divergent elements to create a sense of discomfort. However, we cannot say

App. 27

for sure whether *Graduation* constitutes fair use or whether Prince has transformed Cariou's work enough to render it transformative.

We have the same concerns with *Meditation*, *Canal Zone (2007)*, *Canal Zone (2008)*, and *Charlie Company*. Each of those artworks differs from, but is still similar in key aesthetic ways, to Cariou's photographs. In *Meditation*, Prince again added lozenges and a guitar to the same photograph that he incorporated into *Graduation*, this time cutting the subject out of his background, switching the direction he is facing, and taping that image onto a blank canvas. In *Canal Zone (2007)*, Prince created a gridded collage using 31 different photographs of Cariou's, many of them in whole or significant part, with alterations of some of those photographs limited to lozenges or cartoonish appendages painted or drawn on. *Canal Zone (2008)* incorporates six photographs of Cariou's in whole or in part, including the same subject as *Meditation* and *Graduation*. Prince placed the subject, with lozenges and guitar, on a background comprising components of various landscape photographs, taped together. The cumulative effect is of the subject in a habitat replete with lush greenery, not dissimilar from many of Cariou's *Yes Rasta* photographs. And *Charlie Company* prominently displays four copies of Cariou's photograph of a Rastafarian riding a donkey, substantially unaltered, as well as two copies of a seated nude woman with lozenges covering all six faces. Like the other works just discussed, *Charlie Company* is aesthetically similar to Cariou's original work because it maintains the pastoral background and individual focal point of the original photograph – in this case, the man on the burro. While the lozenges,

repetition of the images, and addition of the nude female unarguably change the tenor of the piece, it is unclear whether these alterations amount to a sufficient transformation of the original work of art such that the new work is transformative.

We believe the district court is best situated to determine, in the first instance, whether such relatively minimal alterations render *Graduation*, *Meditation*, *Canal Zone (2007)*, *Canal Zone (2008)*, and *Charlie Company* fair uses (including whether the artworks are transformative) or whether any impermissibly infringes on Cariou's copyrights in his original photographs. We remand for that determination.

III.

In addition to its conclusion that Prince is liable for infringing on Cariou's copyrights, the district court determined that the Gagosian defendants are liable as vicarious and contributory infringers. *Cariou*, 784 F. Supp. 2d at 354. With regard to the twenty-five of Prince's artworks, which, as we have held, do not infringe on Cariou's copyrights, neither Lawrence Gagosian nor the Gallery may be liable as a vicarious or contributory infringer. *See Faulkner v. Nat'l Geographic Enters., Inc.*, 409 F.3d 26, 40 (2d Cir. 2005). If the district court concludes on remand that Prince is liable as a direct infringer with regard to any of the remaining five works, the district court should determine whether the Gagosian defendants should be held liable, directly or secondarily, as a consequence of their actions with regard to those works. *See Copyright Act*, 17 U.S.C. §§ 106(1), (2), (3), (5).

CONCLUSION

For the reasons discussed, we hold that all except five (*Graduation*, *Meditation*, *Canal Zone (2007)*, *Canal Zone (2008)*, and *Charlie Company*) of Prince's artworks make fair use of Cariou's photographs. We express no view as to whether the five are also entitled to a fair use defense. We REMAND with respect to those five so that the district court, applying the proper standard, can determine in the first instance whether any of them infringes on Cariou's copyrights or whether Prince is entitled to a fair use defense with regard to those artworks as well. The judgment of the district court is **REVERSED** in part and **VACATED** in part.⁵ The case is **REMANDED** for further proceedings consistent with this opinion.

⁵ Because we reverse the district court with regard to the twenty-five of the artworks, and leave open the question of fair use with regard to the remaining five, we vacate the district court's injunction. In the event that Prince and Gagosian are ultimately held liable for copyright infringement, and in light of all parties' agreement at oral argument that the destruction of Prince's artwork would be improper and against the public interest, a position with which we agree, the district court should revisit what injunctive relief, if any, is appropriate. *See eBay, Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 391 (2006); *Salinger v. Colting*, 607 F.3d 68, 77 (2d Cir. 2010).

**UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT**

Docket No. 11-1197

[Filed April 25, 2013]

Patrick Cariou,)
)
Plaintiff-Appellee,)
)
v.)
)
Richard Prince,)
)
Defendant-Appellant,)
)
Gagosian Gallery, Inc.,)
Lawrence Gagosian,)
)
Defendants-Cross-)
Defendants-Appellants.)

At a Stated Term of the United States Court of Appeals for the Second Circuit, held at the Thurgood Marshall United States Courthouse, 40 Foley Square, in the City of New York, on the 25th day of April, two thousand and thirteen.

Before: BARRINGTON D. PARKER,
PETER W. HALL,

App. 31

J. CLIFFORD WALLACE,*
Circuit Judges.

JUDGMENT

The appeal in the above captioned case from a judgment of the United States District Court for the Southern District of New York was argued on the district court's record and the parties' briefs. Upon consideration thereof,

IT IS HEREBY ORDERED, ADJUDGED and DECREED that the judgment of the district court is REVERSED in part, and VACATED in part, and the case is REMANDED in accordance with the opinion of this court.

For The Court:

Catherine O'Hagan Wolfe,
Clerk of Court

The image shows a handwritten signature in cursive that reads "Catherine O'Hagan Wolfe". The signature is written over a circular official seal. The seal contains the text "UNITED STATES", "SECOND CIRCUIT", and "COURT OF APPEALS" around its perimeter.

* The Honorable J. Clifford Wallace, United States Circuit Judge of the United States Court of Appeals for the Ninth Circuit, sitting by designation.

WALLACE, J., Senior Circuit Judge, concurring in part and dissenting in part:

I agree with the bulk of the majority decision as to the law, including the majority's determination that the district court incorrectly imposed a requirement that the allegedly infringing works comment on the original works to be entitled to a fair use defense. *See Cariou v. Prince*, 784 F. Supp. 2d 337, 348–49 (S.D.N.Y. 2011). I nevertheless part company with the majority.

While we *may*, as an appellate court, determine that secondary works are fair use in certain instances, *see Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 560 (1985), in the usual case, after correcting an erroneous legal standard employed by the district court, we would remand for reconsideration. This standard, I suggest, should apply here where factual determinations must be reevaluated—and perhaps new evidence or expert opinions will be deemed necessary by the fact finder—after which a new decision can be made under the corrected legal analysis. But the majority short-circuits this time-tested search for a just result under the law. I would not apply the shortcut but would set aside the summary judgment, remand the entire case to the district court, and allow the district court to analyze material evidence under the proper standard.

Unlike the majority, I would allow the district court to consider Prince's statements in reviewing fair use. While not the sine qua non of fair use, *see Blanch v. Koons*, 467 F.3d 244, 255 n.5 (2d Cir. 2006), I see no reason to discount Prince's statements as the majority does. While it may seem intuitive to assume that a

defendant claiming fair use would typically give self-serving ex post facto testimony to support a defense, this Court has nevertheless relied on such statements when making this inquiry—even if just to confirm its own analysis. *See id.* at 252–53, 255; *see also Castle Rock Entm't, Inc. v. Carol Publ'g Grp., Inc.*, 150 F.3d 132, 142 (2d Cir. 1998) (looking to statements of the allegedly infringing work's creators when analyzing the purpose and character of the secondary work). Thus, I view Prince's statements—which, as Prince acknowledges, consist of “his view of the purpose and effect of each of the individual [p]aintings”—as relevant to the transformativeness analysis.

The majority relies on the Seventh Circuit's decision in *Brownmark Films, LLC v. Comedy Partners*, 682 F.3d 687 (7th Cir. 2012), for the proposition that all the Court needs to do here to determine transformativeness is view the original work and the secondary work and, apparently, employ its own artistic judgment. In my view, *Brownmark* cannot be extended so far. *Brownmark* arose under an unusual procedural posture: a motion to dismiss based on a non-pleaded fair use affirmative defense converted into a motion for summary judgment on appeal. *See id.* The court in *Brownmark* determined that it needed only to review the allegedly infringing video against the original to determine that the secondary work was permissible parody. *Id.* at 692–93. It appears to me, however, that *Brownmark* left open the possibility that additional evidence could be relevant to the fair use inquiry in a different procedural context. *See id.* at 692 n.2 (identifying that the defendant could have put forth additional evidence to bolster its fair use defense if the case arose from a typical summary judgment motion);

id. at 692 (stating that the district court was only required to consider the original and secondary videos, “especially in light of [the plaintiff’s] failure to make any concrete contention” as to the secondary video’s potential market impact).

Further, *Brownmark* apparently arose in the context of a clear case of parody—so obvious that the appeals court affirmed the district court’s conclusion that fair use was evident from even a “fleeting glance” at the original and secondary works. *Id.* at 689–90. I do not believe that the transformativeness of Prince’s works—which have not been presented as parody or satire—can be so readily determined. Because this case arises after extensive discovery and argument by the parties, I disagree that we must limit our inquiry to our own artistic perceptions of the original and secondary works.

Indeed, while I admit freely that I am not an art critic or expert, I fail to see how the majority in its appellate role can “confidently” draw a distinction between the twenty-five works that it has identified as constituting fair use and the five works that do not readily lend themselves to a fair use determination. This, mind you, is done on a summary judgment review with no understanding of what additional evidence may be presented on remand. I also fail to see a principled reason for remanding to the district court *only* the five works the majority identifies as close calls, although I agree that they must be sent back to the trial court. If the district court is in the best position to determine fair use as to some paintings, why is the same not true as to all paintings? Certainly we are not merely to use our personal art views to make the new legal

application to the facts of this case. *Cf. Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 582 (1994) (“[I]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of [a work], outside of the narrowest and most obvious limits”), quoting *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903). It would be extremely uncomfortable for me to do so in my appellate capacity, let alone my limited art experience.

In my view, because the district court takes the primary role in determining the facts and applying the law to the facts in fair use cases, after which we exercise our appellate review if called upon to do so, I conclude that as to each painting, “the district court is best situated to determine, in the first instance,” whether Prince is entitled to a fair use defense in light of the correct legal standard. *See* majority opinion at 22. I mean no disrespect to the majority, but I, for one, do not believe that I am in a position to make these fact- and opinion-intensive decisions on the twenty-five works that passed the majority’s judicial observation. I do not know what additional facts will become relevant under the corrected rule of law, nor am I trained to make art opinions *ab initio*.

I would thus remand the entire case—all thirty of Prince’s paintings—for further proceedings in the district court on an open record to take such additional testimony as needed and apply the correct legal standard. On this basis, therefore, I respectfully dissent.

* * *

APPENDIX B

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK**

08 Civ. 11327 (DAB)

[Filed March 18, 2011]

PATRICK CARIOU,)
)
Plaintiff,)
)
-against-)
)
RICHARD PRINCE, GAGOSIAN)
GALLERY, INC., LAWRENCE)
GAGOSIAN, and RIZZOLI)
INTERNATIONAL PUBLICATIONS, INC.)
)
Defendants.)

MEMORANDUM & ORDER

DEBORAH A. BATTS, United States District Judge.

This matter is now before the Court on cross-motions for summary judgment. Defendants Richard Prince, Gagosian Gallery, Inc., and Lawrence Gagosian seek a determination that their use of Plaintiff's copyrighted photographs was a fair use under the

relevant section of the Copyright Act, 17 U.S.C. §§ 107(1)-(4), and that Plaintiff's claim for conspiracy to violate his rights under the Copyright Act is barred by law.¹ Plaintiff seeks summary judgment in his favor on the issue of liability for copyright infringement.

For reasons detailed herein, the Court finds (1) that Defendants' infringing use of Plaintiff's copyrighted photographs was not fair use under the Copyright Act; and (2) that Plaintiff's conspiracy claim is barred by law. Accordingly, Defendants' Motion is GRANTED in part, and Plaintiff's Motion is GRANTED in its entirety.

I. BACKGROUND

Familiarity with the affidavits, declarations, deposition transcripts, and other evidence before the Court is assumed, and the undisputed facts are set forth here only briefly.

Plaintiff Patrick Cariou ("Plaintiff" or "Cariou") is a professional photographer. PC Tr. 45-46, 279-80.² Cariou spent time with Rastafarians in Jamaica over the course of some six years, gaining their trust and

¹ Named Defendant Rizzoli International Publications, Inc. was voluntarily dismissed from this action by stipulation of dismissal entered by the Court on February 5, 2010.

² "PC. Tr.," used herein, refers to the transcript of Patrick Cariou's deposition testimony. "RP Tr.," "CC Tr.," "LG Tr." and "AM Tr." refer to the deposition transcripts of Richard Prince, Christiane Celle, Lawrence Gagosian, and Alison McDonald, respectively. Similarly, "RP. Aff." refers to the affidavit filed by Richard Prince.

taking their portraits. PC Tr. 34-48. In 2000, Cariou published a book of photographs which were taken during his time in Jamaica. Brooks Decl. Ex. L. The book, titled Yes, Rasta and released by PowerHouse Books (“Yes, Rasta”), contained both portraits of Rastafarian individuals (and others) in Jamaica and landscape photos taken by Cariou in Jamaica.³ Id.

Cariou testified at length about the creative choices he made in determining which equipment to use in taking his photos, the staging choices he made when composing and taking individual photos, and the techniques and processes he used (and directed others to use) when developing the photos. See e.g., PC Tr. 49-66, 133-34, 137-38, 143-44, 152, 169. Cariou also testified that he was heavily involved in the layout, editing, and printing of the Yes, Rasta book. Id.; PC Tr. at 180-208. According to the colophon page included in Yes, Rasta, Cariou is the sole copyright holder in the images that appear in Yes, Rasta. Brooks Decl. Ex. L.

Defendant Richard Prince (“Prince”) is a well-known “appropriation artist” who has shown at numerous museums and other institutions, including a solo show at the Guggenheim Museum in New York City. RP Aff. ¶¶ 3, 5. Defendant Gagosian Gallery, Inc. (the “Gallery”) is an art dealer and gallery which represents Prince and markets the artworks he creates. LG Tr. 22-25; RP Tr. 270, 294. Defendant Lawrence Gagosian (“Gagosian”; collectively with the Gallery, the

³ The portraits and landscape photographs Cariou published in Yes, Rasta are collectively referred to herein as the “Photos,” “Cariou’s Photos,” or the “Yes, Rasta Photos.”

“Gagosian Defendants”) is the President, founder, and owner of the Gagosian Gallery, Inc. LG Tr. at 16.⁴

In or about December 2007 through February 2008, Prince showed artwork at the Eden Rock hotel in St. Barts. See RP Tr. at 187-88. Among the works shown was a collage entitled Canal Zone (2007), which consisted of 35 photographs torn from Yes, Rasta and attached to a wooden backer board. See RP Decl. Comp. Ex. A. at 20-24; see also RP Tr. at 179-80. Prince painted over some portions of the 35 photographs, and used only portions of some of the photos, while others were used in their entirety or nearly so. See generally RP Decl. Comp. Ex. A at 20-24. Though Canal Zone (2007) was not sold, Prince sold other artworks at that show through Gagosian. RP Tr. 187-88, 197-98. Portions of Canal Zone (2007) were reproduced in a magazine article about Prince’s Canal Zone show at the Gagosian Gallery. RP Tr. at 198-201. Prince intended that Canal Zone (2007) serve as an introduction to the characters he intended to use in a screenplay and in a planned series of artworks, also to be entitled Canal Zone. RP Aff. ¶ 48.

Prince ultimately completed 29 paintings in his contemplated Canal Zone series, 28 of which included images taken from Yes, Rasta.⁵ See RP Decl. Comp. Ex. A. Some of the paintings, like “Graduation (2008)” and

⁴ Gagosian testified that he “may have given” “a small piece” of the Gallery to his sister. LG Tr. at 17.

⁵ The allegedly infringing works in the Canal Zone series, together with Canal Zone (2007), are referred to collectively herein as the “Paintings,” “Prince’s Paintings,” or the “Canal Zone Paintings.”

“Canal Zone (2008),” consist almost entirely of images taken from Yes, Rasta, albeit collaged, enlarged, cropped, tinted, and/or over-painted, while others, like “Ile de France (2008)” use portions of Yes, Rasta Photos as collage elements and also include appropriated photos from other sources and more substantial original painting.⁶ See RP Decl. Comp. Ex. A (comparing Prince paintings with Cariou Photos used therein); compare Brooks Decl. Ex. M (Canal Zone catalog) with Brooks Decl. Ex. L (Yes, Rasta book). In total, Prince admits using at least 41 Photos from Yes, Rasta as elements of Canal Zone Paintings. RP Decl. ¶ 24.

The Gallery showed 22 of the 29 Canal Zone paintings at one of its Manhattan locations from November 8, 2008 to December 20, 2008. Brooks Decl. Ex. M at 1; LG Tr. at 25, 50; RP Aff. at Ex. A. The Gallery also published and sold an exhibition catalog from that show, similarly entitled Canal Zone, which contained reproductions of many of the Canal Zone Paintings (including some Paintings which were not shown at the Gallery) and photographs of Yes, Rasta Photos in Prince’s studio. See Brooks Decl. Ex. M (Canal Zone exhibition catalog). The Gagosian employee who was the Managing Editor of the catalog testified that she never inquired as to the source of the Rastafarian photographs contained therein. AC Tr. at 42.

⁶ In reaching its determination herein, the Court has examined fully the exhibits and reproductions provided by the Parties and has compared the 29 Canal Zone paintings with the Yes, Rasta Photos. The Court sees no need to describe each work in great detail.

App. 41

Other than by private sale to individuals Cariou knew and liked, the Photos have never been sold or licensed for use other than in the Yes, Rasta book. PC Tr. 86-94. However, Cariou testified that he was negotiating with gallery owner Christiane Celle (“Celle”), who planned to show and sell prints of the Yes, Rasta Photos at her Manhattan gallery, prior to the Canal Zone show’s opening. PC Tr. at 96-98; see CC Tr. 39-40, 42-44. Cariou also testified that he intended in the future to issue artists’ editions of the Photos, which would be offered for sale to collectors. PC Tr. 92-94; 97-98.

Celle originally planned to exhibit between 30 and 40 of the Photos at her gallery, with multiple prints of each to be sold at prices ranging from \$3,000.00 to \$20,000.00, depending on size. cc Tr. at 40-42, 46, 66-68, 127-28, 153-55. She also planned to have Yes, Rasta reprinted for a book signing to be held during the show at her gallery. CC Tr. at 87-88, 155-56. However, when Celle became aware of the Canal Zone exhibition at the Gagosian Gallery, she cancelled the show she and Cariou had discussed. PC Tr. at 98; CC Tr. 63-64, 71. Celle testified that she decided to cancel the show because she did not want to seem to be capitalizing on Prince’s success and notoriety, CC Tr. at 89, 105-06, and because she did not want to exhibit work which had been “done already” at another gallery, CC Tr. 89, 91, 105.

II. DISCUSSION

A. Summary Judgment

A district court should grant summary judgment when there is “no genuine issue as to any material fact,” and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c); see also Hermes Int’l v. Lederer de Paris Fifth Ave., Inc., 219 F.3d 104, 107 (2d Cir. 2000). Genuine issues of material fact cannot be created by mere conclusory allegations; summary judgment is appropriate only when, “after drawing all reasonable inferences in favor of a non-movant, no reasonable trier of fact could find in favor of that party.” Heublein v. United States, 996 F.2d 1455, 1461 (2d Cir. 1993) (citing Matsushita Elec. Industr. Co. v. Zenith Radio Corp., 475 U.S. 574, 587-88 (1986)).

In assessing when summary judgment should be granted, “there must be more than a ‘scintilla of evidence’ in the non-movant’s favor; there must be evidence upon which a fact-finder could reasonably find for the non-movant.” Id. (citing Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 252 (1986)). While a court must always “resolv[e] ambiguities and draw [] reasonable inferences against the moving party,” Knight v. U.S. Fire Ins. Co., 804 F.2d 9, 11 (2d Cir. 1986) (citing Anderson, 477 U.S. at 252), the non-movant may not rely upon “mere speculation or conjecture as to the true nature of the facts to overcome a motion for summary judgment.” Id. at 12. Instead, when the moving party has documented particular facts in the record, “the opposing party must set forth specific facts showing that there is a genuine issue for

trial.” Williams v. Smith, 781 F.2d 319, 323 (2d Cir. 1986) (quotation omitted). Establishing such facts requires going beyond the allegations of the pleadings, as the moment has arrived “to put up or shut up.” Weinstock v. Columbia Univ., 224 F. 3d 33, 41 (2d Cir. 2000) (citation omitted). Unsupported allegations in the pleadings thus cannot create a material issue of fact. Id.

A court faced with cross-motions for summary judgment need not “grant judgment as a matter of law for one side or the other,” but “must evaluate each party’s motion on its own merits, taking care in each instance to draw all reasonable inferences against the party whose motion is under consideration.” Heublein, Inc. v. United States, 996 F.2d 1455, 1461 (2d Cir. 1993) (quoting Schwabenbauer v. Bd. of Educ. of Olean, 667 F.2d 305, 313-14 (2d Cir. 1981)).

To prevail on a copyright infringement claim, two elements must be proven: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original. See Harper & Row, 471 U.S. at 548; Feist Publ’ns., Inc. v. Rural Tel. Serv. Co., Inc., 499 US at 348, 363 (1991) (holding that alphabetical arrangement of names in telephone directory was not protected by copyright, since alphabetical arrangement “is not only unoriginal, it is practically inevitable.”). To be “original,” a copyrighted work must have been independently created by the author and must possess “at least some minimal degree of creativity,” although “the requisite level of creativity is extremely low; even a slight amount will suffice.” Id. at 345. “The vast majority of works make the grade quite easily, as they

possess some creative spark, ‘no matter how crude, humble or obvious’ it might be.” Id. (citation omitted).

“[T]he applicability of [the fair use defense to copyright infringement] presents mixed questions of law and fact,” Arista Records, LLC v. Doe 3, 604 F.3d 110 (2d Cir. 2010) (citing Harper & Row Pubs., Inc. v. Nation Enters., 471 U.S. 539, 560 (1985)), but may nevertheless be determined on a motion for summary judgment where the record contains facts sufficient to evaluate each of the statutory factors, Harper & Row at 560.

B. Copyright in the Photos

Cariou’s ownership of a valid copyright in the Photos is undisputed. However, Defendants assert that Cariou’s Photos are mere compilations of facts concerning Rastafarians and the Jamaican landscape, arranged with minimum creativity in a manner typical of their genre, and that the Photos are therefore not protectable as a matter of law, despite Plaintiff’s extensive testimony about the creative choices he made in taking, processing, developing, and selecting them.⁷

Unfortunately for Defendants, it has been a matter of settled law for well over one hundred years that creative photographs are worthy of copyright protection even when they depict real people and natural

⁷ Defendant’s arguments concerning whether ideas can be protected by copyright are irrelevant to this case: Plaintiff seeks recourse for Prince’s use of his original creative works, not for any use of or infringement on the ideas they portray.

environments. See, e.g., Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 60 (1884) (photographic portrait of Oscar Wilde was original creative work, since photographer posed the subject, selected his clothing, background, light and shade, and “suggest[ed] and evok[ed] the desired expression”); Rogers v. Koons, 960 F.2d 301, 307 (2d Cir. 1992) (“Elements of originality in a photograph may include posing the subjects, lighting, angle, selection of film and camera, evoking the desired expression, and almost any other variant involved.”), cert. denied, 506 U.S. 934 (1992); Mannion v. Coors Brewing Co., 377 F. Supp. 2d 444, 450 (S.D.N.Y. 2005) (“Almost any photograph ‘may claim the necessary originality to support a copyright.’”) (citation omitted); Eastern Am. Trio Prods., Inc. v. Tang Elec. Corp., 97 F. Supp. 2d 395, 417 (S.D.N.Y. 2000) (photographs of “common industrial items” were protectable); Monster Comm.’s, Inc. v. Turner Broad. Sys. Inc., 935 F. Supp. 490, 494 (S.D.N.Y. 1996) (“photographic images of actual people, places and events may be as creative and deserving of protection as purely fanciful creations”).

Accordingly, Cariou’s Photos are worthy of copyright protection.

C. Fair Use

From the infancy of copyright protection, some opportunity for fair use of copyrighted materials has been thought necessary to fulfill copyright’s very purpose, “[t]o promote the Progress of Science and useful Arts” Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 575 (1994) (quoting U.S. Const., Art. I, § 8, cl. 8). At the Constitutional level, while the “Copyright Clause and the First Amendment [are]

intuitively in conflict, [they] were drafted to work together to prevent censorship” such that “the balance between the First Amendment and copyright is preserved, in part, by the idea/expression dichotomy and the doctrine of fair use.” Suntrust Bank, 268 F.3d at 1263 (citing Eldred v. Reno, 239 F.3d 372, 375 (D.C. Cir. 2001) (quoting Harper & Row, 471 U.S. at 560)).

“Copyright law thus must address the inevitable tension between the property rights it establishes in creative works, which must be protected up to a point, and the ability of authors, artists, and the rest of us to express them- or ourselves by reference to the works of others, which must be protected up to a point. The fair-use doctrine mediates between the two sets of interests, determining where each set of interests ceases to control.” Blanch v. Koons, 467 F.3d 244, 250 (2d Cir. 2006); see also Warner Bros. Entertainment Inc., v. RDR Books, 575 F.Supp.2d 513, 540 (S.D.N.Y. 2008) (“At stake in this case are the incentive to create original works which copyright protection fosters and the freedom to produce secondary works which monopoly protection of copyright stifles – both interests benefit the public.”) (quoting Pierre N. Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105, 1109 (1990) (hereinafter “Leval”) (noting that although “the monopoly created by copyright ... rewards the individual author in order to benefit the public[,]” on the other hand “the monopoly protection of intellectual property that impeded referential analysis and the development of new ideas out of old would strangle the creative process.”)

App. 47

The doctrine of Fair Use was codified in Section 107 of the 1976 Copyright Act. Section 107 calls for a four-factor test:

Limitations on exclusive rights: Fair use:

Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include-

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

17 U.S.C. § 107.

In applying the fair use doctrine, “[t]he task is not to be simplified with bright-line rules, for the statute,

like the doctrine it recognizes, calls for case-by-case analysis.” Campbell, 510 U.S. at 577-78. In conducting that analysis, “all [of the four factors] are to be explored, and the results weighed together in light of the purposes of copyright.” Id.

D. Applying the Four-Factor Analysis

1. The Purpose and Character of Prince’s Use of the Photos

i. Transformative Use

“The central purpose of the inquiry into the first factor is to determine, in Justice Story’s words, 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.’” Salinger v. Colting, No. 09 Civ. 5095 (DAB), 641 F.Supp.2d 250, 256 (rev’d on other grounds 607 F.3d 68 (2d Cir. 2010); Campbell, 510 U.S. at 579 (internal quotations and citations omitted). Although a transformative use is not strictly required for the Defendant to establish the defense of fair use, “the goal of copyright, to promote science and the arts, is generally furthered by the creation of transformative works. Such works thus lie at the heart of the fair use doctrine’s guarantee of breathing space within the confines of copyright, and 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.” Id. (citing Sony Corp. of America v. Universal City Studios, Inc.,

464 U.S. 417, 478-80 (U.S. 1984) (Blackmun, J., dissenting).

The inquiry into the first factor of the fair use test, “the purpose and character of the use,’ may be guided by the examples given in the preamble to § 107, looking to whether the use is for criticism, or comment, or news reporting, and the like.” Campbell, 510 U.S. at 578-79 (citing 17 U.S.C. § 107) (identifying parody as a use akin to the illustrative uses identified in the preamble).

As the Second Circuit clearly noted in Castle Rock, the fact that a work “recast[s], transform[s], or adapt[s] an original work into a new mode of presentation,” thus making it a “derivative work” under 17 U.S.C. § 101, does not make the work “transformative” in the sense of the first fair use factor. Castle Rock, 150 F.3d at 143. Nevertheless, Defendants invite this Court to find that use of copyrighted materials as raw materials in creating “appropriation art” which does not comment on the copyrighted original is a fair use akin to those identified in the preamble to § 107.

The cases Defendants cite for the proposition that use of copyrighted materials as “raw ingredients” in the creation of new works is per se fair use do not support their position, and the Court is aware of no precedent holding that such use is fair absent transformative comment on the original. To the contrary, the illustrative fair uses listed in the preamble to § 107 – “criticism, comment, news reporting, teaching [...], scholarship, [and] research” – all have at their core a focus on the original works or their historical context, and all of the precedent this Court can identify imposes a requirement that the new work in some way

comment on, relate to the historical context of, or critically refer back to the original works. See, e.g., Campbell, 510 U.S. at 579 (transformative use is use that “alter[s] the first with new expression, meaning, or message”); Bourne v. Twentieth Century Fox Film Corp., 602 F.Supp.2d 499 (S.D.N.Y. Mar. 15, 2009) (Batts, J.) (parody song which commented both on the copyrighted original and on famous person associated with original was transformative); Blanch v. Koons, 467 F.3d at 252-53 (use of copyrighted fashion advertisement as “raw material” was transformative because artist used it to comment on the role such advertisements play in our culture and on the attitudes the original and other advertisements like it promote); Liebowitz v. Paramount Pictures Corp., 137 F.3d 109, 114 (2d Cir. 1998) (superimposition of Leslie Nielsen’s face on photo of body intended to resemble pregnant Demi Moore commented on original photo of Moore by holding its pretentiousness up to ridicule). C.f. Rogers v. Koons, 960 F.2d 301, 310 (2d Cir. 1992), cert. denied, 506 U.S. 934 (1992) (sculpture drawn from copyrighted photograph was not fair use because while the sculpture was a “satirical critique of our materialistic society, it is difficult to discern any parody of [or comment on] the photograph. . . itself.”)

“If an infringement of copyrightable expression could be justified as fair use solely on the basis of the infringer’s claim to a higher or different artistic use . . . there would be no practicable boundary to the fair use defense.” Rogers v. Koons, 960 F.2d at 310. The Court therefore declines Defendants’ invitation to find that appropriation art is per se fair use, regardless of whether or not the new artwork in any way comments on the original works appropriated. Accordingly,

Prince's Paintings are transformative only to the extent that they comment on the Photos; to the extent they merely recast, transform, or adapt the Photos, Prince's Paintings are instead infringing derivative works. See Castle Rock, 150 F.3d at 143.

Prince testified that he has no interest in the original meaning of the photographs he uses. See e.g., RP Tr. at 338. Prince testified that he doesn't "really have a message" he attempts to communicate when making art. RP Tr. at 45-46. In creating the Paintings, Prince did not intend to comment on any aspects of the original works or on the broader culture. See e.g., RP Tr. at 357-60; 362-64. Prince's intent in creating the Canal Zone paintings was to pay homage or tribute to other painters, including Picasso, Cezanne, Warhol, and de Kooning, see RP Tr. at 164-67, 300-01, and to create beautiful artworks which related to musical themes and to a post-apocalyptic screenplay he was writing which featured a reggae band, see, e.g., RP Tr. 7, 30, 207-08, 218, 232, 251-52. Prince intended to emphasize themes of equality of the sexes; highlight "the three relationships in the world, which are men and women, men and men, and women and women"; and portray a contemporary take on the music scene. RP Tr. 338-39. With regard to the paintings in which Prince collaged guitars onto portraits of Rastafarian men which were taken from Yes, Rasta, Prince testified that his message related to the fact that the men had become guitar players. See, e.g., RP Tr. at 340 ("[H]e's playing the guitar now, it looks like he's playing the guitar, it looks as if he's always played the guitar, that's what my message was."); see also RP Tr. 166-68, 279.

Prince also testified that his purpose in appropriating other people's originals for use in his artwork is that doing so helps him "get as much fact into [his] work and reduce[] the amount of speculation." RP Tr. at 44. That is, he chooses the photographs he appropriates for what he perceives to be their truth – suggesting that his purpose in using Cariou's Rastafarian portraits was the same as Cariou's original purpose in taking them: a desire to communicate to the viewer core truths about Rastafarians and their culture. See Bill Graham Archives v. Dorling Kindersley Ltd., 448 F.3d 605, 609 (2d Cir. 2006) (considering, in weighing transformativeness, whether the new purpose in using an original work was "plainly different from the original purpose for which it was created.")

On the facts before the Court, it is apparent that Prince did not intend to comment on Cariou, on Cariou's Photos, or on aspects of popular culture closely associated with Cariou or the Photos when he appropriated the Photos, and Price's own testimony shows that his intent was not transformative within the meaning of Section 107, though Prince intended his overall work to be creative and new.

As this Court and others in this jurisdiction have found, where a work is not "consistently transformative," and "lacks restraint in using [Plaintiff's] original expression for its inherent . . . aesthetic value," the "transformative character of [that work] is diminished." Salinger v. Colting, No. 09 Civ. 5095 (DAB), 641 F.Supp.2d 250, 262 (rev'd on other grounds 607 F. 3d 68 (2d Cir. 2010)); Warner Bros. Enter. Inc. v. RDR Books 575 F.Supp.2d 513, 544

(S.D.N.Y. 2008) (citing Bill Graham Archives v. Dorling Kindersley Ltd., 448 F.3d 605 (2d Cir. 2006). See Suntrust Bank, 268 F.3d at 1280 (Marcus, J., concurring) (finding that issue of transformative character cuts “decisively in [Defendant’s] favor” where the ratio of “the borrowed and the new elements” is “very low, and the incongruity between them wide”).

Accordingly, while there may be some minimal transformative element intended in Prince’s use of the Photos, the overall transformativeness varies from work to work depending on the amount of copying. In the works most heavily drawn from Cariou’s Photos, such as those in which Prince uses entire photographs or unaltered portraits taken from Yes, Rasta, there is vanishingly little, if any, transformative element; in those where Cariou’s Photos play a comparatively minor role, Defendant has a stronger argument that his work is transformative of Cariou’s original Photos.⁸ Overall, because the transformative content of Prince’s paintings is minimal at best, and because that element is not consistent throughout the 28 paintings in which Prince used the Photos, the “transformative use” prong of the first § 107 factor weighs heavily against a finding of fair use.

⁸ Many of the Paintings which have the strongest claim to transformative use are also those in which the amount and substantiality of the Photos used is least reasonable: those which feature, as their central elements, strikingly original Rastafarian portraits taken from Yes, Rasta Photos. See discussion of third Section 107 factor, infra. For that reason, even the most transformative Paintings have only a weak claim to fair use, since the four § 107 factors must be “weighed together in light of the purposes of copyright.” Campbell, 510 U.S. at 577-78.

ii. Commerciality

The second prong of the first factor of the § 107 test asks whether the otherwise infringing work “serves a commercial purpose or nonprofit educational purpose.” Suntrust Bank, 268 F.3d at 1269 (citing § 107(1)). The less transformative a work, the more importance should be attached to “the extent of its commerciality” in determining whether the first factor favors a finding of fair use. Campbell, 510 U.S. at 580-81 (if “the commentary has no critical bearing on the substance or style of the original composition . . . the claim to fairness in borrowing from another’s work diminishes accordingly (if it does not vanish), and other factors, like the extent of its commerciality loom larger.”); see American Geophysical Union v. Texaco Inc., 60 F.3d 913, 922 {2d Cir. 1995) (“The greater the private economic rewards reaped by the secondary user (to the exclusion of broader public benefits), the more likely the first factor will favor the copyright holder and the less likely the use will be considered fair.”)[C]ourts are more willing to find a secondary use fair when it produces a value that benefits the broader public interest.” Blanch v. Koons, 467 F.3d 244, 253-54. “Notwithstanding the fact that artists are sometimes paid and museums sometimes earn money, the public exhibition of art is widely . . . considered to have value that benefits the wider public interest.” Id. (citations and internal quotations omitted).

The Canal Zone show at the Gagosian Gallery was advertised in seven different newspapers, five of which included reproductions of Cariou’s Photos as altered by Prince. AM Tr. at 42-50; LG Tr. at 36. The Gagosian Defendants sent some 7,500 invitation cards, featuring

a reproduction of a Prince work containing a Cariou Photo, to clients of the Gallery, LG Tr. at 35, AM Tr. at 29-33, and sold the leftover invitations to a poster company, AM Tr. at 55-59. As a result of these and other marketing efforts, Gagosian Gallery sold eight of the Canal Zone Paintings for a total of \$10,480,000.00, 60% of which went to Prince and 40% of which went to Gagosian Gallery. Brooks Dec. Ex. P ¶ 2 and Ex. A; LG Tr. at 48. Seven other Canal Zone Paintings were exchanged for art with an estimated value between \$6,000,000.00 and \$8,000,000.00. Brooks Dec. Ex P ¶ 3; LG Tr. at 136-37, 149-50. Gagosian Gallery sold \$6,784.00 worth of Canal Zone exhibition catalogs. Brooks Dec. Ex. P ¶ 4. The facts before the Court do not establish whether any of the Paintings have ever been made available for public viewing other than when they were offered for sale at the Gallery.

This Court recognizes the inherent public interest and cultural value of public exhibition of art and of an overall increase in public access to artwork. However, the facts before the Court show that Defendants' use and exploitation of the Photos was also substantially commercial, especially where the Gagosian Defendants are concerned. Accordingly, given the overall low transformative content of Prince's Paintings, the commerciality prong of the first § 107 factor weighs against a finding of fair use.

iii. Bad Faith

The first § 107 factor requires the Court to consider "the propriety of a defendant's conduct," which is an integral part of the Court's analysis of the character of the use. NXIVM Corp. v. Ross Inst., 364 F.3d 471, 478

(2d Cir. 2004) (citations omitted). Though not in itself determinative, “it has been considered relevant within this subfactor that a defendant could have acquired the copyrighted [material] legitimately.” Id.

Here, Prince testified that he does not have a different standard or weigh different considerations when appropriating works with a disclosed author than he does when using materials that are in the public domain; to Prince, the question of whether an image is appropriate for his use is “just a question of whether [he] like[s] the image.” RP Tr. at 100. Prince’s employee contacted the publisher of Yes, Rasta to purchase additional copies of the book, but apparently neither Prince nor his employee ever asked the publisher about licensing or otherwise sought permission to use Yes, Rasta or the Photos contained therein legitimately. RP Tr. 236-41, 183. Nor did Prince attempt to contact Cariou by email and inquire about usage rights to the Photos, even though Yes, Rasta clearly identified Cariou as the sole copyright holder and even though Cariou’s publicly-accessible website includes an email address at which he may be reached. See PC Tr. 238-40, 254, 260. Under these circumstances, Prince’s bad faith is evident. Moreover, since the record establishes that the Gagosian Defendants were aware that Prince is an habitual user of other artists’ copyrighted work, without permission, and because the record is equally clear that the Gagosian Defendants neither inquired into whether Prince had obtained permission to use the Photos contained in the Canal Zone Paintings nor ceased their commercial exploitation of the Paintings after receiving Cariou’s cease-and-desist notice, the bad faith of the Gagosian Defendants is equally clear.

Because Prince's use was at most only minimally transformative of Cariou's Photos, because the use was substantially though not exclusively commercial, and because Prince and the Gagosian Defendants acted in bad faith, the first factor in the fair use analysis weighs heavily in favor of Plaintiff.

2. The Nature of the Copyrighted Work

"The more the copyrighted matter is at the center of the protected concerns of the copyright law, the more the other factors, including justification, must favor the secondary user in order to earn a fair use finding." Leval at 1122. "The statutory articulation of this factor derives from Justice Story's mention . . . of the 'value of the materials used.' Justice Story's word choice is more communicative than our statute's 'nature of,' as it suggests that some protected matter is more 'valued' under copyright than others. This should not be seen as an invitation to judges to pass on [artistic] quality, but rather to consider whether the protected [work] is of the creative or instructive type that the copyright laws value and seek to foster." *Id.* at 1117. A key distinction that has emerged "in the decisions evaluating the second factor [is] whether the work is expressive or creative, such as a work of fiction, or more factual, with a greater leeway being allowed to a claim of fair use where the work is factual or informational." 2 Abrams, *The Law of Copyright*, § 15:52 (2006).

Here, the Court finds that Cariou's Photos are highly original and creative artistic works and that they constitute "creative expression for public dissemination" and thus "fall[] within the core of the copyright's protective purposes." Campbell, 510 U.S. at

586. Consequently, this factor weighs against a finding of fair use.

3. The Amount and Substantiality of the Portion Used

The “amount and substantiality of the portion of the copyrighted work used [] must be examined in context [and] the inquiry must focus on whether the extent of [the] copying is consistent with or more than necessary to further the purpose and character of the use.” Castle Rock, 150 F.3d at 144 (quoting Campbell, 510 U.S. at 586-87) (internal quotations omitted). The Court must examine not only “the quantity of the materials used, but their quality and importance too.” Warner Bros. Enter., Inc., 575 F.Supp. at 546 (quoting Campbell 510 U.S. at 587).

“[W]hatever the use, generally it may not constitute a fair use if the entire work is reproduced.” Weissmann v. Freeman, 868 F.2d 1313, 1325 (2d Cir. 1989) (citing 3 Nimmer on Copyright § 13.05[A] at 13-80). Moreover, the amount and substantiality factor weighs in favor of the copyright holder “where the portion used was essentially the heart of the copyrighted work.” Wright v. Warner Books, Inc., 953 F.2d 731, 738 (2d Cir. 1991) (quoting Harper & Row, 471 U.S. at 565) (internal quotations omitted).

“As the statutory language indicates, a taking may not be excused merely because it is insubstantial with respect to the *infringing* work.” Harper & Row v. Nation Enters., 471 U.S. at 565 (citation omitted) (emphasis in original) (quoting Judge Learned Hand, who “cogently remarked, ‘no plagiarist can excuse the

wrong by showing how much of his work he did not pirate.”)

In a number of his Paintings, Prince appropriated entire Photos, and in the majority of his Paintings, Prince appropriated the central figures depicted in portraits taken by Cariou and published in Yes, Rasta. Those central figures are of overwhelming quality and importance to Cariou’s Photos, going to the very heart of his work. Accordingly, the amount of Prince’s taking was substantially greater than necessary, given the slight transformative value of his secondary use, and the third factor weighs heavily against a finding of fair use.

4. The Effect of the Use Upon the Potential Market for or Value of the Copyrighted Work

The fourth fair use factor requires courts “to consider not only the extent of market harm caused by the particular actions of the alleged infringer, but also whether unrestricted and widespread conduct of the sort engaged in by the defendant would result in a substantially adverse impact on the potential market for the original.” Campbell, 510 U.S. at 590 (internal quotations omitted) . The inquiry “must take account not only of harm to the original but also of harm to the market for derivative works.” Id. Harm to the market for derivatives weighs against a finding of fair use “because the licensing of derivatives is an important economic incentive to the creation of originals.” Id. at 593. “Potential derivative uses include only those that creators of original works would in general develop or license others to develop.” Warner Bros. Enter., Inc., 575 F.Supp. at 549 (quoting Campbell, 510 U.S. at 592)

(internal quotation marks omitted). See also id. at 550-51 (finding that where Defendant’s derivative work “is only marginally transformative, [it] is likely to supplant the market for [Plaintiff’s derivative work]”) (citing Campbell, 510 U.S. at 591).

Defendants’ protestations that Cariou has not marketed his Photos more aggressively (or, indeed, as aggressively as Prince has marketed his Paintings) are unavailing. As the Second Circuit has previously emphasized, the “potential market” for the copyrighted work and its derivatives must be examined, even if the “author has disavowed any intention to publish them during his lifetime,” given that an author “has the right to change his mind” and is “entitled to protect his opportunity to sell his [works].” J.D. Salinger v. Random House, Inc., 811 F.2d 90, 99 (2d Cir. 1987) (emphasis omitted); see Castle Rock, 150 F.3d at 145-46 (finding the fourth factor to favor Plaintiff even where Plaintiff “has evidenced little if any interest in exploiting this market for derivative works” because copyright law must “respect that creative and economic choice”). The fact that Plaintiff has not marketed his work more aggressively is therefore irrelevant.

Here, it is undisputed that a gallery owner discontinued plans to show the Yes, Rasta Photos, and to offer them for sale to collectors, because she did not want to appear to be capitalizing on Prince’s Paintings and did not want to show work which had been “done already” at the nearby Gagosian Gallery. CC Tr. 89, 91, 105. It is therefore clear that the market for Cariou’s Photos was usurped by Defendants. Moreover, licensing original works for secondary use by other artists is the kind of derivative use “that creators of

original works would in general develop,” Warner Bros. Enter., Inc., 575 F.Supp. at 549, and widespread unlicensed use in new artworks would destroy the market for such licenses, see Campbell, 510 U.S. at 590. Accordingly, the Court finds that Prince has unfairly damaged both the actual and potential markets for Cariou’s original work and the potential market for derivative use licenses for Cariou’s original work.

Because Defendants’ secondary use has unfairly damaged the original market for the Photos and, if widespread, would likely destroy an identifiable derivative market for the Photos, the fourth § 107 factor weighs against a finding of fair use.

5. Aggregate Analysis

The Court has considered the four factors set forth in § 107, and found that none favors a finding of fair use. Moreover, “the monopoly created by copyright” does not unduly “impede[] referential analysis [or] the development of new ideas out of old” when copyright law is enforced under circumstances like those presented here. Leval at 1109. Accordingly, the purposes of copyright are best served by extending protection to Cariou’s Photos.

Having conducted a case-specific analysis of the four factors laid out in 17 U.S.C. § 107 in light of the purposes of copyright, the Court finds that Defendants are not entitled to the defense of fair use.

E. Liability of the Gagosian Defendants

Copyright infringement has two elements: “(1) ownership of a valid copyright, and (2) copying of constituent elements of the work which are original.” Feist, 499 U.S. at 361.

Here, it is uncontroverted that the Gagosian Defendants copied original constituent elements of Cariou’s copyrighted Photos when they published the Canal Zone exhibition catalog, created and distributed invitation cards featuring reproductions of Cariou’s Photos, and otherwise distributed reproductions of Cariou’s work as appropriated by Prince. Moreover, by exhibiting and selling Prince’s unauthorized works, the Gagosian Defendants infringed Cariou’s exclusive rights, as copyright owner of the Photos, to reproduce, prepare derivative works based upon, distribute, sell, and display the Photographs. See Copyright Act, 17 U.S.C. § 106(1), (2), (3), and (5). The Court therefore finds the Gagosian Defendants directly liable for copyright infringement.

The Gagosian Defendants are also liable as vicarious and contributory infringers.

“The concept of vicarious copyright infringement was developed in the Second Circuit as an outgrowth of the agency principles of *respondiat superior*.” Faulkner v. Nat’l Geo. Soc., 211 F.Supp.2d 450, 472 (S.D.N.Y. 2002) (citations omitted). “Vicarious liability extends beyond an employer/employee relationship to cases in which a defendant has the right and ability to supervise the infringing activity and also has a direct financial interest in such activities. Benefit and control

are the signposts of vicarious liability.” Id. (citations omitted).

Here, the record establishes that Gagosian was “handling everything” to do with the marketing of the Canal Zone Paintings beginning at the time Price first showed Canal Zone (2007), which Prince thought of as a “preview” of the characters he would use in the Canal Zone Paintings, in December, 2007. See, e.g., RP Tr. at 185-87 (describing Gagosian’s role in the Eden Rock show and describing Gagosian’s home as an “off-off-off Broadway” location where previously unseen paintings could be shown and sold) . The Court therefore finds that the Gagosian Defendants had the right and ability to supervise Price’s work, or at the very least the right and ability (and perhaps even responsibility) to ensure that Prince obtained licenses to use the Photos before they made Prince’s Paintings available for sale. The financial benefit of the infringing use to the Gagosian Defendants is self-evident. Accordingly, the Gagosian Defendants are liable as vicarious infringers.

“One who, with knowledge of the infringing activity, induces, causes, or materially contributes to the infringing conduct of another, may be held liable as a contributory infringer.” Faulkner, 211 F.Supp.2d at 473 (citations and quotations omitted) In other words, “the standard for contributory infringement has two prongs, the ‘knowledge’ prong and the ‘material contribution’ prong.” Id. “Knowledge of the infringing activity may be actual or constructive . . . In other words, this prong is satisfied if the defendant knew or should have known of the infringing activity at the time of its material contribution.” Id. at 474 (citations and quotations omitted). “Advertising or otherwise promoting an

infringing product or service may be sufficient to satisfy the material contribution prong.” Id. at 473-74.

Here, the Gagosian Defendants were well aware of (and capitalized on) Prince’s reputation as an appropriation artist who rejects the constricts of copyright law, but they never inquired into the propriety of Prince’s use of the Photos. The Court concludes that the Gagosian Defendants knew or should have known of the infringement at the time that they reproduced, advertised, marketed, and otherwise promoted the Paintings. Accordingly, the Court finds that the Gagosian Defendants are liable as contributory infringers.

Because Plaintiff has established a prima facie case of copyright infringement as against all Defendants, and because the defense of fair use does not apply, Plaintiff’s Motion for Summary Judgment on the issue of liability is GRANTED in its entirety.

F. Plaintiff’s Claim for Conspiracy Under the Copyright Act

Defendants argue that Plaintiff’s fifth claim for relief, which charges conspiracy to violate his rights under the Copyright Act, must be dismissed as failing to state a claim on which relief may be granted.

No Party has called the Court’s attention to any Second Circuit or Supreme Court authority which provides that a cause of action for conspiracy to violate the Copyright Act may lie under New York or Federal law. Nor is conspiracy proscribed by the Copyright Act itself. See generally Copyright Act, 17 U.S.C. § 501 et

seq.; Calloway v. Marvel Entertainment Group, No. 82 Civ. 8697 (RWS), 1983 WL 1152, at *5 (S.D.N.Y. 1983).

In the absence of contrary authority, the Court finds Judge Sweet's reasoning in Irwin v. ZDF Enterprises GmbH, No. 04 CIV. 8027 (RWS), 2006 WL 374960 (S.D.N.Y. February 16, 2006) persuasive. In Irwin, Judge Sweet considered whether the Copyright Act foreclosed a common law conspiracy claim based on copyright infringement and determined that "[b]ecause copyright law already recognizes the concepts of contributory infringement and vicarious copyright infringement . . . which extend joint and several liability to those who participate in the copyright infringement . . . [a] civil conspiracy claim does not add substantively to the underlying federal copyright claim. . . Irwin at *4 (citations and quotations omitted).

The Court therefore finds that Plaintiff's Fifth Cause of Action must be dismissed.

III. CONCLUSION

For reasons stated herein, the Court GRANTS Plaintiff's Motion for Summary Judgment on the issues of copyright infringement, fair use, and liability. The Court DENIES Defendants' Motion for Summary Judgment except as pertains to Plaintiff's Fifth Cause of Action, for conspiracy, which is DISMISSED.

It is further ORDERED:

That, pursuant to 17 U.S.C. § 502, Defendants, their directors, officers, agents, servants, employees, and attorneys, and all persons in active concert or

participation with them, are hereby enjoined and restrained permanently from infringing the copyright in the Photographs, or any other of Plaintiff's works, in any manner, and from reproducing, adapting, displaying, publishing, advertising, promoting, selling, offering for sale, marketing, distributing, or otherwise disposing of the Photographs or any copies of the Photographs, or any other of Plaintiff's works, and from participating or assisting in or authorizing such conduct in any way.

That Defendants shall within ten days of the date of this Order deliver up for impounding, destruction, or other disposition, as Plaintiff determines, all infringing copies of the Photographs, including the Paintings and unsold copies of the Canal Zone exhibition book, in their possession, custody, or control and all transparencies, plates, masters, tapes, film negatives, discs, and other articles for making such infringing copies.

That Defendants shall notify in writing any current or future owners of the Paintings of whom they are or become aware that the Paintings infringe the copyright in the Photographs, that the Paintings were not lawfully made under the Copyright Act of 1976, and that the Paintings cannot lawfully be displayed under 17 U.S.C. § 109(c).

That the Parties shall appear before this Court on May 6, 2011 at 11:00am for a status conference regarding damages, profits, and Plaintiff's costs and reasonable attorney's fees.

SO ORDERED.

App. 67

Dated: New York, New York

March 18, 2011

/s/ Deborah A. Batts
Deborah A. Batts
United States District Judge

APPENDIX C

**UNITED STATES COURT OF APPEALS FOR
THE SECOND CIRCUIT**

Docket No. 11-1197

[Filed June 10, 2013]

Patrick Cariou,)
)
Plaintiff - Appellee,)
)
v.)
)
Richard Prince,)
)
Defendant - Appellant,)
)
Gagosian Gallery, Inc., Lawrence Gagosian,)
)
Defendants - Cross -)
Defendants - Appellants.)

At a stated term of the United States Court of Appeals for the Second Circuit, held at the Thurgood Marshall United States Courthouse, 40 Foley Square, in the City of New York, on the 10th day of June, two thousand thirteen,

App. 69

Appellee Patrick Cariou filed a petition for panel rehearing, or, in the alternative, for rehearing *en banc*. The panel that determined the appeal has considered the request for panel rehearing, and the active members of the Court have considered the request for rehearing *en banc*.

IT IS HEREBY ORDERED that the petition is denied.

FOR THE COURT:

Catherine O'Hagan Wolfe, Clerk

A handwritten signature in cursive script that reads "Catherine O'Hagan Wolfe". The signature is written in black ink and is positioned to the left of a circular official seal.



APPENDIX D

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK**

Index No.: 08 CIV 11327 (DAB)

**EXCERPTS OF VIDEOTAPED
DEPOSITION OF RICHARD PRINCE
New York, New York
Tuesday, October 6, 2009**

PATRICK CARIOU,)
Plaintiff,)
)
vs.)
)
RICHARD PRINCE, GAGOSIAN)
GALLERY, INC., LAWRENCE)
GAGOSIAN, and RIZZOLI)
INTERNATIONAL PUBLICATIONS,)
INC.,)
Defendants.)

Reported by:
Bryan Nilsen, RPR
JOB NO. 304040

* * *

[p.28]

The answer says that you were not specifically authorized to use Plaintiff's photographs, do you see that?

A. I wasn't specifically authorized?

Q. That's what this says.

A. Okay.

Q. Is that true?

MR. HAYES: Object to the form of the question, calls for a legal conclusion.

You can answer if you understand it.

Q. You can answer.

A. I still don't understand why I'm -- I wasn't specifically authorized.

Q. Did you ever ask Mr. Cariou, who is sitting here, the plaintiff, for permission to use his photographs from the Yes Rasta book?

A. I didn't really use his photographs.

Q. Okay. Did you make use of them in any way?

A. I made use of them, yes.

Q. Did you ask his permission to make use of them?

A. No.

[p.29]

Q. Did he specifically give you permission to use --

A. No.

Q. Did he generally give you permission to use the photographs?

A. No.

Q. Now, you say that the use you made of the portions of the photographs -- withdrawn.

This answer says that the use you made of portions of the photographs in your artworks was a proper artistic practice. Do you agree with that?

MR. HAYES: Again, object to the form of the question on the grounds it asks for a legal conclusion and attempts to make the witness an expert.

But you can answer the question if you understand it.

A. I did use, in fact, portions of photographs that appear in his book. Whether they were for proper artistic practice, that's a -- that's something I can't really -- I would have to define proper. And I'm not sure if there's any type of definition for proper

[p.30]

artistic practice.

But I did, in fact, use portions of images that appear in his books. Eventually, for paintings that I made into this -- they were sort of ingredient -- part of a recipe ingredients that were eventually made into this show that I titled Canal Zone.

Q. Were his photographs the subject of your-

A. No.

Q.-- artworks?

A. No.

Q. The subject was some post-apocalyptic vision of what would happen after a nuclear war on a remote island?

A. No, that was -- that's a subtext of the whole Canal Zone type of pitch. It first appeared when I was thinking about this project.

Q. Okay. You know what, we'll get to that. I've got -- your lawyers produced all the documents. We'll go through them.

A. Okay.

Q. And I'm pretty sure what your answer is going to be, but when you say -- when the

[p.39]

the Canal Zone show isn't is a fact that you scanned some of Plaintiffs images directly onto the canvas?

A. No.

MR. HAYES: Objection.

MS. BART: Objection, form.

A. No.

Q. Did somebody do that at your request?

MS. BART: Same objection.

A. What I would do is send -- after I tore the image out of the book--

Q. You're talking about Plaintiff's book?

A. Yes.

I would send it off to a commercial lab. And I believe it's called inkjet process.

Q. Right

A. Now, I don't know too much about it except that it -- you're able to reproduce in almost any scale onto different surfaces. The surface which I chose was canvas.

App. 75

Q. Right And the name of the lab that you used?

* * *

[p.44]

Q. You're speaking in the past tense, fair enough, because I'm asking you about --

A. Yeah, this is what I'm -- I'm trying to approximate what I was feeling thirty years ago.

Q. Let's talk about now. Do you still find it more satisfying to appropriate than to create your own work?

A. Yeah, I do. I feel that I like to get as much fact into my work and reduce the amount of speculation. I believe there's too much -- I like an artwork where that when you see something, like a cowboy or a girlfriend, mean these are, in fact, true.

Q. Or a nurse?

A. Or a nurse, or a hood.

Q. And you feel, if it's not yours --

MR. HAYES: Let him finish.

MR. BROOKS: I'm sorry.

MR. HAYES: Have you finished your answer?

THE WITNESS: I'm sorry. Yes.

App. 76

* * *

[p.45]

* * *

Q. Is it part of your message now that your artwork is more believable because it was taken from someone else?

A. I don't have a -- I don't really

[p.46]

have a message.

Q. Okay. Is appropriating images from other people, does that also make your job easier in creating a new image?

A. No. Not really, no.

Q. Does it make it harder?

A. No, it's just something that -- something that I do and I love to do, and I've always -- you know, I've been doing this for quite a while.

Q. Right.

When you began to engage in the practice of rephotographing the work of others did you consider yourself at that time to be a skilled photographer?

A. No.

App. 77

MR. BROOKS: Let's mark as Plaintiff's Exhibit 4 an article, or actually an interview with Bates stamp pages C226 through 228.

And this was I believe produced in response to your discovery requests on Friday.

MS. BART: We got them actually on

* * *

[p.100]

to think about making it again instead of making it new. Making it new was an Ezra Pound way of thinking, paren, industrial, close paren, and, quote, making it again, unquote, is a more R. Prince way of doing it, paren, technological, close paren. Advertising images aren't really associated with an author, more with a product. slash company, and for the most part put out or, quote, art directed, unquote: They kind of end up having a life of their own. It's not like you're taking them from anyone.

I know the answer goes on, but that part that I quoted is similar to what you were testifying to about half an hour ago, correct?

A. Yes.

Q. That's your view, okay.

A. Yes.

App. 78

Q. Do you have a different standard or artistic practice for taking images when there is a disclosed author and it's not an advertisement?

A. No, not really. It's just a question of whether I like the image.

Q. If you like it then you'll consider

* * *

[p.166]

an homage to De Kooning at the time.

I don't believe there was a direct interest in making or pointing to that particular painting. It was more about the fact that I was interested in Picasso paying homage to a previous artist.

And I think, point of fact, I would cite Cézanne's bathers as a more -- interest in mine of making the Canal Zone paintings.

Q. Okay. Are you saying that one of the points or one of the messages in the Canal Zone paintings was to evoke Cézanne's bather paintings?

A. I think if in fact there was a message, it was -- there was three people, yes, specifically Cézanne's bathers because of the composition, Picasso's hands and feet, and the masks that were on the De Kooning women.

App. 79

Q. Did you put the masks on the De Kooning women or were they there already?

A. Sometimes yes, sometimes no.

* * *

[p.182]

wood?

THE WITNESS: Yeah.

MR. BROOKS: I'm sorry?

MR. HAYES: It's like masonite, like masonite manufactured wood.

MR. BROOKS: Okay.

BY MR. BROOKS:

Q. Now, did you have an assistant helping you with the creation of Canal Zone 2007 or did you do it yourself?

A. I did it myself.

Q. And did you send it to a lab to be completed?

A. No. This is a -- this is just what I would refer to as an original collage.

Q. Okay. So you tore out these pictures -- you nailed them to the piece of plywood?

A. Yes.

Q. So it wasn't -- then it wasn't enlarged?

A. This particular piece?

Q. Yes.

A. No.

* * *

[p.236]

A. No.

MS. BART: Objection, form.

Q. Now, you mentioned that you bought a copy of Yes Rasta in a bookstore you think in about 2005 in St Barth's?

A. Yes.

Q. When you decided to make the paintings did you then buy additional copies of Yes Rasta?

A. I believe we were informed that the book was out of print when I bought the -- I don't actually know -- I believe we got them on eBay. I really don't know where we got the additional books.

Q. All right But you did get additional books?

A. Yes.

Q. How many?

A. I think we bought maybe four additional books.

Q. In 2008?

A. Yes.

MR. BROOKS: Let's mark as Plaintiff's Exhibit 27 a one-page document

[p.237]

Bates stamped PR38.

(Plaintiff's Exhibit 27, PR38, was marked for identification, as of this date.)

(Discussion off the record.)

MR. BROOKS: It's been pointed out to me -- and, for the record, I skipped Exhibit 26 as well.

MR. HAYES: So this is 27?

MR. BROOKS: This is 27. There will not be an Exhibit Plaintiff's 26.

BY Mr. BROOKS:

Q. Mr. Prince, you say you bought the three -- well, you said you bought four books.

Does this refresh your recollection that you actually bought three additional books?

App. 82

A. As I said, I wasn't sure -- three or four, I guess it says three here.

* * *

[p.261]

* * *

Now, down a few lines you said, But I love the look, comma, and I love the dreads.

What did you mean by that?

A. What do you mean what do I mean by that? I just said it. I love the look and I love the dreads.

Q. What did you love about the look?

A. I love the way they looked.

Q. How so?

* * *

[p.267]

There's no -- there's no plan.

Q. Right. Is there a message?

A. There certainly is a message.

Q. What is the message?

A. The message is to make great art that makes people feel good. That's my message. Now, I know it might not be someone else's, but I believe that's also the way I've always defined art.

Q. Now, you're talking again about the guy who lands in St. Barth's. This is on the next page. And it says so he and his relatives take over a hotel, they take over Eden Rock. Do you see that?

A. Yes.

Q. Now, there actually are no pictures in the Canal Zone paintings of the guy who got off the plane and his relatives, is that right or not right?

MR. HAYES: Objection to the form.

A. There are no pictures of Charlie Company and --

Q. Right.

A. There might be, there might not be.

* * *

[p.273]

A. So anyway -- oh, okay, Fulton Ryder is the pseudonym. So anyway? Yes.

Q. So anyway, the Rastas and the lesbians started starring in these pictures and were kind of like bands, there were like five people to a picture and every picture has a title to it. It sort of becomes an allegory.

It's just something I needed to get out of my system. The pictures are very quickly done, they're not really thought about, and there's a collage element to them that's very primitive. Paste up, cutting with scissors, and squeegeed on with paint. It's something that I can do by myself and I like that aspect of it. I don't need assistants. I don't need anybody.

What did you mean by the pictures are not really thought about? Did you mean by you?

A. I like to paint a painting and finish it within a day, day and a half tops. I like instant paintings.

Q. In the case of these painting what did you mean that they're not really thought about?

[p.274]

A. That's --

MS. BART: Objection, form, and asked and answered.

A. I'm trying to answer your question. That's what I mean. I like -- I like when I do things fast. I think they should be done very quickly. I think when they drag on, you know, you can overthink it. I don't like a painting that's overcooked.

Q. Okay. I understand your answer, but I was asking about these paintings, not what you generally like.

A. No, I'm talking about these specific paintings. They were done day, half a day, some of them took two hours. That's what was so satisfying about the process. You know, Especially Around Midnight, a painting that you had previously said that I didn't remember the title to --

Q. No, that was Île-de-France.

A. You didn't say that. You pointed to an e-mail from Eric Brown suggesting that Eric thought that I didn't remember the title.

Q. Île-de-France.

* * *

[p.278]

MR. HAYES: Objection, form.

Q. You can answer.

A. Yes.

Q. Were the naked women that you found in various places an ingredient in the paintings?

MS. BART: Objection, form.

MR. HAYES: Objection, form.

A. Yes.

Q. Were the Rastas an ingredient in the paintings?

App. 86

MS. BART: Objection, form.

MR. HAYES: Objection, form.

A. Yes.

Q. Was the tropical foliage in the background behind the Rastas in the Yes Rasta photos, was that an ingredient in the paintings?

A. Yes.

MS. BART: Objection, form.

A. Sorry.

Q. What's the answer?

A. Yes.

Q. Were the paintings-- were any of those things, the guitars, the naked women, the

[p.279]

Rastas, or the tropical foliage, the subject matter of the paintings?

MS. BART: Objection, form, compound question.

MR. HAYES: Objection, form.

Q. You can answer.

A. Were any of those -- any of those one -- I believe the primary subject, the primary ingredient is probably the guitar.

Q. Okay. And, what's the primary subject of the paintings?

MR. HAYES: Objection to form.

MS. BART: Same.

A. I think the guitar. The guitar is a brilliant, brilliant contribution.

Q. And, again, I know you testified to this before, where did you find the guitars again? I'm not trying to trip you up. Was it one book or several books? I don't remember.

A. One source was Guitar Magazine.

Q. Okay. So there's kind of a rock-and-roll theme to these paintings?

MR. HAYES: Objection to form.

MS. BART: Same.

[p.280]

Q. You can answer.

A. I would say heavy metal, but, yes, rock and roll.

Q. Sorry. Okay.

App. 88

Can you look at page 77, which is I think the last page of this interview.

I'm going to read this answer at the top. Well, I should read the question on the previous page. Why did you get sick of doing the De Kooning paintings? It seemed like you did more nurse paintings than De Koonings.

And then you answered, Yeah, I did more nurses, but with De Koonings, I'd just done it. I didn't like the idea that in the end I had to pay attention to someone else's work. And I wanted to get rid of the color. So the thing is that, you know, two years of doing the De Koonings was enough. It was enough of my attention. The Rastas came really fast. And they're going to be over really fast too.

Can you explain what you meant when you said the Rastas came really fast and they're going to be over really fast too?

A. The Rasta -- the Canal Zone

[p.281]

paintings, which part of those paintings, an element of those paintings are the Rastas.

The reason I believe they were going -- they came really fast and they were going to be over fast is I was in the middle of other bodies of work that I needed to pay attention to.

Q. You needed to pay attention to the other bodies of work?

A. Yes.

(Discussion off the record.)

THE VIDEOGRAPHER: 4:25. Off the record. End of tape 4.

(Recess taken: 4:25 p.m.)

(Proceedings resumed: 4:29 p.m.)

THE VIDEOGRAPHER: 4:29. On the record. Beginning of tape 5.

BY MR. BROOKS:

Q. In these paintings that you made for the Canal Zone show were you commenting on the Rasta photos in the Yes Rasta book?

A. No.

Q. Were you commenting on Mr. Cariou's technique or methodology in taking those photos?

[p.282]

A. No.

Q. I know you don't have your own plane, but you could fly commercial to Jamaica, correct, if you wanted to?

App. 90

MR. HAYES: Objection to form, speculation.

A. I suppose so.

Q. So if you wanted pictures of Rastas you could have flown to Jamaica and taken your own pictures, correct?

MS. BART: Objection to form.

* * *

[p.290]

* * *

(Plaintiff's Exhibit 30, photos from iStockphoto.com, was marked for identification, as of this date.)

Q. Have you seen Exhibit 30?

A. Have I seen this exhibit before?

Q. Well, look at it now. Have you had an opportunity to look at it now?

A. No --

MR. HAYES: He wants you to take an opportunity to look at it.

Q. Yes, please do.

MR. HAYES: Please take a look at it.

App. 91

A. Yes, I've looked at it now.

Q. So it's six photos?

A. Yes.

Q. I'm aware you weren't aware of

[p.291]

iStockphoto, but now that you see these photos would these have been appropriate ingredients for your Canal Zone paintings?

MR. HAYES: Objection as to form.

MS. BART: Objection, form.

Q. You can answer.

A. Not really because they're in color.

I guess I could have transformed them to black and white. But, again, I wasn't aware of this particular company.

Q. Well, I hear what you're saying. One of them is black and white.

A. Oh, it is?

Q. I think the fourth one is black and white.

A. A little lavender in it.

App. 92

Q. Okay. So that one is not suitable either?

MS. BART: Objection, form.

MR. HAYES: Same objection.

Q. Is that what you're saying?

A. I mean are you asking me if I had seen this --

Q. Would you have used it?

[p.292]

A. -- like four years ago, three years, two years ago, a year ago?

Q. Yeah.

MR. HAYES: Objection to the form of the question. Calls for speculation.

A. I don't know.

Q. You might have used them?

A. It's possible.

MO MS. BART: Objection. Move to strike as speculative.

MR. BROOKS: Let's mark as Plaintiff's Exhibit 31 three pages from -- I believe from the Gagosian Gallery website Bates stamped C8 through 10.

(Plaintiffs Exhibit 31, three pages from Gagosian Gallery website, was marked for identification, as of this date.)

Q. Mr. Prince, I've placed in front of you Plaintiff's Exhibit 31. It says that the Canal Zone show was going to be November 8th to December 20th, 2008, is that your recollection?

A. Yes.

Q. And then under this picture, do you know which painting that is, the one at the top?

* * *

[p.338]

mine.

I know that that's not the original intent of the image, but I don't have any -- don't have any really interest in what the original intent is because my -- because what I do is I completely try to change it into something that's completely different.

Q. And just again, what is your intent, what are you changing it into?

A. To make great artworks that I make people feel good.

Q. But is this -- let's take 116 since you seem to prefer to talk about 116.

MR. HAYES: Object to the form, if there's a question.

Q. Which is this painting Back to the Garden, right? Okay?

A. Mm-hmm. Yes, I'm sorry.

Q. What is your message or what is the meaning of this painting, what is it that you're trying to get across?

A. I'm trying --

MR. HAYES: Object to the form.

A. As I said, I'm trying to make a

* * *

[p.360]

argumentative.

A. You're right. This is a very reductive painting. This is very minimal --

Q. I meant your answer. Never mind.

You said you did it because you did it and I'm trying to understand why you did it.

MR. HAYES: Objection to form.

MS. BART: And asked and answered.

App. 95

Q. Let me withdraw that.

A. Okay. I can answer it.

Q. No, let me withdraw it. I'm going to ask you more specific questions.

In superimposing these four images over the landscape from Yes Rasta, right, were you commenting on any aspects of culture?

A. No.

Q. Were you trying to create anything with a new meaning or a new message?

A. No.

* * *

APPENDIX E

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK**

Index No.: 08 CIV 11327 (DAB)

**Excerpts of Condensed Transcript
DEPOSITION OF
CHRISTIANE CELLE
Tuesday, January 26, 2010
10:00 a.m.**

PATRICK CARIOU,)
Plaintiff,)
)
vs.)
)
RICHARD PRINCE, GAGOSIAN)
GALLERY, INC., LAWRENCE)
GAGOSIAN, and RIZZOLI)
INTERNATIONAL PUBLICATIONS,)
INC.,)
Defendants.)

Schnader Harrison Segal & Lewis LLP
140 Broadway, Suite 3100
New York, New York 10005-1101

Reported by:
Bryan Nilsen, RPR

App. 97

Telephone: 212.687.8010
Toll Free: 800.944.9454
Facsimile: 212.557.5972

One Penn Plaza
Suite 4715
New York, N.Y. 10119

* * *

[p.89]

why I left a message, you know, for him to call me back. Because for me he had done it with Gagosian and Prince and the big show and then he didn't want to tell the French girl I'm not doing it with you, you know, because we had started a relation and that would have been bad. And I was not sure about that.

But I was thinking if it's done already I'm not going to do now a Rasta show showing, you know, the work. It looks like I'm trying to take advantage of the success of Richard Prince and saying, wow, great, let me do the Rasta, and now I'm going to show this.

So at the time I knew that if I will do something with Patrick it will be probably the Surfer. But I could not do anymore the Rasta because it was already in Chelsea, a beautiful gallery in Chelsea.

And Gagosian is a very famous gallery, so if the work was shown there already with another artist together, you know, I was not sure if Patrick had decided to do something with Richard Prince.

App. 98

And that was my first idea because,

* * *

[p.91]

Q. And where do you advertise?

A. In Photograph Magazine. It's like a small booklet, like a photographic guide mostly.

Q. As of the end of January of 2009 had you made any arrangements for advertisements of a show of photographs by Mr. Cariou?

A. No, because the minute I figure out that there was a Chelsea show of his work, you know, I knew that it was over.

Q. At any time prior to January 29th of 2009 had you ordered any advertisements for a show for Mr. Carlou?

A. No.

Q. Had you printed any invitations?

A. No.

Q. Had you made any arrangements with Powerhouse Books to reprint Yes Rasta?

A. No, because it was more Patrick's decision to do that. But we were committed to do something.

Q. Okay. Now, turning to the third page of this document, this is where I guess if you can identify -- this appears to be a different e-mail.

* * *

[p.105]

But I told him that there was no way I could do a Rasta show because it looks like I'm trying to capitalize on, you know, the Richard Prince notoriety and say, wow, he did this, I'm going to do a show now and show the Rasta work, it looks like I'm trying to take advantage of the situation. And I say there's no way I can do a show right now.

Q. And in that conversation did Mr. Cariou try to persuade you to proceed with the show?

A. At the time I think he was very preoccupied by the whole situation more than focusing on my conversation.

Q. Preoccupied by the lawsuit?

A. Yes.

Q. Rather than focusing on your show in your conversation?

A. Yes, he was very preoccupied with it because it was something very important for him.

And I kind of apologize and say, you know what, this has been -- you know, since November I heard, I

App. 100

call you, you didn't call me back, and I was thinking, you know, I really

* * *

[p.123]

Q. And did he tell you the price point at which they were sold?

A. No.

MR. BROOKS: Objection, asked and answered.

Q. Did he tell you how many?

A. No.

Q. You decided not to proceed, at least for the present, with the Cariou exhibit regarding Yes Rasta photographs in or about January of '09?

A. No, actually I decided the end of November, December, and I met -- at the time when I saw the Richard Prince situation, I committed with another photographer called Lyle Owerko. I met him actually end of November about the same time that there was, you know, the situation that learned that Richard Prince and Patrick Cariou had maybe done something together.

So I decided to do my show in April with a different photographer called Lyle Owerko. And my goal was to replace probably Patrick with that work. And it's

App. 101

[p.124]

exactly what I did, I just opened my gallery with that show.

* * *

APPENDIX F

**Excerpts of Appendix to the April 25, 2013
Opinion of the United States Court of Appeals
for the Second Circuit, with Index to Appendix
and Selected Images of Richard Prince
Paintings and Patrick Cariou Source
Photographs**

Index to Appendix

Richard Prince Painting and Description	Page Number(s) of the Patrick Cariou Photograph(s) in <i>Yes Rasta</i>¹
<i>Graduation</i> , Collage, inkjet, and acrylic on canvas, 72 3/4" x 52 1/2"	P. 118
<i>Meditation</i> , Collage, inkjet, and acrylic on canvas, 58" x 46"	P. 118

¹ Where only a portion of Cariou's photograph or photographs is incorporated into Prince's work, we indicate that portion with a white box overlaid on the reproduced image of Cariou's photograph.

App. 103

<p><i>Canal Zone (2008)</i>, Collage, inkjet, and acrylic on canvas, 107" x 119 1/2"</p>	<p>P. 33, Pp. 79-80, P. 88, Pp. 95-96, P. 118, Pp. 159-160</p>
<p><i>The Ocean Club</i>, Collage, inkjet, and acrylic on canvas, 76" x 100 1/2"</p>	<p>P. 33, Pp. 79-80, P. 88, Pp. 95-96, P. 118, Pp. 159-160</p>
<p><i>Charlie Company</i>, Collage, inkjet, and acrylic on canvas, 131" x 100"</p>	<p>Pp. 83-84</p>
<p><i>Back to the Garden</i>, Collage, inkjet, and acrylic on canvas, 80" x 120"</p>	<p>Pp. 83-84</p>
<p><i>Cheese and Crackers</i>, Collage, inkjet, and acrylic on canvas, 91 1/2" x 140"</p>	<p>P. 118</p>
<p><i>Mr. Jones</i>, Collage, inkjet, and acrylic on canvas, 91 1/2" x 128"</p>	<p>P. 118</p>
<p><i>The Other Side of the Island</i>, Acrylic, collage, oil crayon, charcoal, and inkjet on canvas, 84" x 132"</p>	<p>P. 108, P. 118</p>
<p><i>Naked Confessions</i>, Collage, inkjet, and acrylic on canvas, 45 1/4" x 46"</p>	<p>P. 47</p>

App. 104

<i>Specially Round Midnight</i> , Collage, inkjet, and acrylic on canvas, 100 1/2" x 154"	P. 108, P. 118
<i>Zippping the System</i> , Collage, inkjet, and acrylic on canvas, 71 1/2" x 110 1/2"	P. 108, P. 118
<i>Color Me Mine</i> , Collage, inkjet, and acrylic on canvas, 59 1/4" x 80 1/2"	P. 48
<i>James Brown Disco Ball</i> , Collage, inkjet, and acrylic on canvas, 100 1/2" x 154 1/2"	P. 11, P. 59
<i>Inquisition</i> , Collage, inkjet, and acrylic on canvas, 100 1/2" x 77"	P. 20, P. 59, P. 62
<i>Uncle Tom, Dick and Harry</i> , Collage, inkjet, and acrylic on canvas, 81 1/2" x 57 1/2"	P. 5, P. 11, P. 22, P. 48

App. 105

<p><i>Canal Zone (2007)</i>, mixed media on homosote, 48" x 82 3/4"</p>	<p>Pp. 1-2, P. 5, P. 6, P. 11, P. 14, P. 16, P. 17, P. 20, P. 21, P. 23, Pp. 45-46, P. 48, Pp. 51-52, P. 53, Pp. 55-56, P. 59, P. 62, Pp. 77-78, Pp. 79-80, Pp. 83-84, Pp. 89-90, P. 98, Pp. 101-102, P. 108, Pp. 111-112, P. 118, P. 125, P. 142, P. 146, Pp. 147-148, P. 150</p>
<p><i>Tales of Brave Ulysses</i>, Collage, inkjet, and acrylic on canvas, 80" x 120 1/4"</p>	<p>P. 118</p>
<p><i>Escape Goat</i>, Collage, inkjet, and acrylic on canvas, 92" x 122"</p>	<p>P. 118</p>
<p><i>On the Beach</i>, Collage, inkjet, and acrylic on canvas, 59" x 90 1/4"</p>	<p>Pp. 1-2, P. 108</p>
<p><i>Cookie Crumbles</i>, Collage, inkjet, and acrylic on canvas, 76" x 100 1/2"</p>	<p>P. 128</p>
<p><i>It's All Over</i>, Collage, inkjet, and acrylic on canvas, 80" x 120 1/4"</p>	<p>P. 108</p>

App. 106

<i>Ile de France</i> , Collage, inkjet, and acrylic on canvas, 77 1/4" x 100 1/2"	P. 6
<i>Djuana Barnes, Natalie Barney, Renee Vivien and Romaine Brooks take over the Guanahani</i> , Collage, inkjet, and acrylic on canvas, 52 1/2" x 90 1/2"	P. 133-134
<i>Mina Loy, Janet Flanner, Radclyffe Hall, Una Trowbridge and Oscar Wilde's niece Dolly Wild</i> , Collage, inkjet, and acrylic on canvas, 77 1/2" x 120 1/2"	P. 13, P. 59, P. 118, P. 143
<i>Quarry</i> , Collage, inkjet, and acrylic on canvas, 57 3/4" x 132"	P. 13, P. 22, P. 143
<i>Untitled</i> , Ektacolor photograph, 40" x 26 1/4"	P. 13
<i>Untitled (Rasta)</i> , Collage, inkjet, and acrylic on canvas, 40" x 30"	P. 118
<i>Untitled (Rasta)</i> , Collage, inkjet, and acrylic on canvas, 40" x 30"	P. 118
<i>Pumpsie Green</i> , Collage, inkjet, and acrylic on canvas, 77" x 100 1/2"	P. 13

App. 107



Yes Rasta, pp. 83-84

App. 108



Charlie Company



Back to the Garden

App. 109



Yes Rasta, p. 118

App. 110



Graduation



Tales of Brave Ulysses

App. 111



Yes Rasta, pp. 133-134



Djuana Barnes, Natalie Barney, Renee Vivien and Romaine Brooks take over the Guanahani