

INFRINGING USES, NOT WORKS

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ABSTRACT

We need to rethink how we talk about derivative works after Andy Warhol Foundation v. Goldsmith. Courts and scholars commonly use the term “infringing work” to refer to art like Warhol’s Orange Prince after a ruling that it has infringed someone’s copyright. But the Supreme Court held that whether Orange Prince infringes the copyright in Lynn Goldsmith’s photo of Prince ultimately depends on how it is used. Orange Prince on the cover of a magazine about Prince infringes Goldsmith’s copyright. Orange Prince on a museum wall may not.

Use, then, is the key. Because any work can conceivably be used in a noninfringing way, I argue here that there is no such thing as an infringing work. Conversely, and more controversially, there might also be no such thing as a per se noninfringing derivative. Again, use is key. A work incorporating a prior copyrighted work will necessarily infringe unless it is used in a noninfringing way, such as within the scope of a license or as a fair use.

By clarifying how infringement—at least post-Warhol—is about uses not works, this piece will help courts and scholars better understand and apply the law moving forward, particularly as to controversial derivatives like fanfiction and AI-generated images. To put it bluntly: over 3,000 judicial opinions have said “infringing work.” From here, it should be zero.

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I. INTRODUCTION.....	104
II. HOW <i>WARHOL</i> FOCUSES ON INFRINGING USES, NOT WORKS	110
III. HOW A USE-FOCUS SHOULD INFORM THE SCOPE OF INJUNCTIONS AND DESTRUCTION ORDERS	113
IV. RECONCILING A USE-FOCUS WITH SECTION 103(A).....	121
V. HOW A USE-FOCUS COULD IMPACT GENERATIVE AI.....	124
VI. THE CONVERSE IMPLICATIONS OF A USE-FOCUS.....	126
VII. CONCLUSION	131

I. INTRODUCTION

Is there such thing as an infringing work? Prior to the U.S. Supreme Court’s decision in *Warhol v. Goldsmith*,¹ it seemed that the answer was an uncontroversial and resounding “yes.” Courts have used the phrase in over 3,000 decisions,² with the typical logic being that a creative work (like a painting, book, or film) that infringes on someone else’s copyright is *ipso facto* an infringing work.³ But *Warhol* turns this logic on its head.

1. Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, 598 U.S. 508 (2023).

2. As reflected by the author’s Westlaw search on February 9, 2024.

3. The term “work” is not defined in the U.S. Copyright Act, 17 U.S.C. §§ 101 *et seq.*, but the Act’s language guides us to the following understanding: “[A] ‘work’ is an intangible expression, protected by copyright to the extent it includes original elements. A ‘copy’ is a tangible object in which a work is fixed. Or rather, a ‘work’ is an original expression, protected by copyright in any medium, and a ‘copy’ is a particular object that expresses a work.” Bryan L. Frye, *A Textualist Interpretation of the Visual Artists Rights Act of 1990*, 19 COLO. TECH. L.J. 365, 371 (2021). While a copy can also be used in a noninfringing way, I’m less concerned about the term “infringing copy,” because a pure copy adds no new expression. The term “work” necessarily implies that some expression has been added. *See id.* So, the core issue, which will become evident as this piece proceeds, is that the label “infringing work” risks overbroad restrictions on the lawful uses of, and public access to, that added expression. For further commentary on the meaning of “work” and its ramifications across the spectrum of copyright, see Margot E. Kaminski and Guy Rub, *Copyright’s Framing Problem*, 64 UCLA L. REV. 1102 (2017); Paul Goldstein, *What Is a Copyrighted Work? Why Does It Matter?*, 58 UCLA L. REV. 1175, 1178 (2011); Molly Shaffer Van Houweling, *Author Autonomy and Atomism in Copyright Law*, 96 VA. L. REV. 549, 553 (2010); Justin Hughes, *Size Matters (Or Should) in Copyright Law*, 74 FORDHAM L. REV. 575, 621 (2005); Oren Bracha & Talha Syed, *Copyright’s Atom: The Expressive Work as the Basic Unit of Analysis* (draft manuscript, Jan. 2024) (available at

How so? Justice Sotomayor’s majority opinion focused on whether the challenged use—a reproduction of Andy Warhol’s *Orange Prince* on the cover of a *Vanity Fair* tribute to Prince—infringed the copyright in Lynn Goldsmith’s photograph of Prince.⁴ Implicitly, then, as Justice Gorsuch’s concurring opinion noted, a different use—such as displaying *Orange Prince* on an art museum wall—might not infringe Goldsmith’s copyright.⁵

Under this approach, *Orange Prince* cannot per se be infringing; infringement necessarily depends on how *Orange Prince* is used.

My aim here, then, is to highlight Warhol’s distinction between a derivative work and its uses and to explore some of the further implications.⁶

<https://law.utexas.edu/calendar/uploads/Copyright-s-Atom.docx>). A common theme among these articles is the administrability problems generated by the expanding (or at least increasingly indeterminate) contours of the term “work” in copyright. Though I don’t directly address that issue here, I think its arguably deleterious impacts might be lessened due to Warhol’s increased focus on uses over works in the infringement analysis.

4. *Warhol*, 598 U.S. at 534 (“AWF used the photograph when it licensed an image of Warhol’s *Orange Prince* to Condé Nast in 2016. Only that last use, however, AWF’s commercial licensing of *Orange Prince* to Condé Nast, is alleged to be infringing. We limit our analysis accordingly. In particular, the Court expresses no opinion as to the creation, display, or sale of any of the original *Prince Series* works.”). By “original” here, the Court apparently meant the first physical fixation of *Orange Prince* by Warhol or those under his authority. *See id.*

As detailed in Justice Sotomayor’s majority opinion, and as discussed further in Part IV, *infra*, in 1984 *Vanity Fair* paid Goldsmith’s licensing agent \$400 to use her photograph of Prince as an artist’s reference to create a work of art to accompany an article on Prince’s then-burgeoning stardom. *Warhol*, 598 U.S. at 515. *Vanity Fair* then hired Warhol as that artist. *Id.* Warhol used Goldsmith’s photograph in a silkscreen process ultimately resulting in sixteen adaptations of the photo, each containing varying degrees of aesthetic differences (two were pencil sketches). *Id.* at 517–18. One of those sixteen, known as *Purple Prince*, was used in conjunction with the 1984 feature on Prince. *Id.* at 564–65 (Kagan, J., dissenting). Between Warhol’s death in 1987 and 2016, *Orange Prince* and at least some of the other adaptations were exhibited in museums, sold to collectors, and reproduced in books relating to Warhol, all apparently without Goldsmith’s knowledge. *See id.* at 518–19, 519 n.2.

In 2016, publisher Condé Nast paid the Warhol Foundation \$10,000 to license *Orange Prince* for the cover of a *Vanity Fair* tribute issue following Prince’s unexpected death. *Id.* at 519–20. The *Vanity Fair* cover caught Goldsmith’s attention, particularly because she licenses her photos for magazine covers, and after a dispute with the Warhol Foundation, it ultimately became the use at issue before the Supreme Court. *See id.* at 520, 522.

5. *Id.* at 557–58 (Gorsuch, J., concurring).

6. Gladly, and unsurprisingly, I’m not alone in recognizing and considering this distinction’s implications. *See, e.g.*, Brian L. Frye, *Art Wants to Be Free*, J. INTELL. PROP. L. (forthcoming 2024) (manuscript at 37) (available at SSRN: https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4762351) [<https://perma.cc/2RW7-AJKA>] (“Under *Warhol*, if you create a work that uses an original element from another work, you have to ask whether your use of the element you copied is a fair use every time you use the work you created, depending on how you are using it. In other words, some uses of your work might be infringing and other uses might not.”); Glynn S. Lunney, Jr., *Transforming Fair Use* 5 (Feb. 15, 2024) (unpublished manuscript) (available at SSRN: <https://ssrn.com/abstract=4727801>) (“By requiring fair use to

The first is that, although an unauthorized creation of a derivative is a *prima facie* infringement of the original work,⁷ it should also be considered a presumptively fair use of that work. This is because (a) most, if not all, derivatives can be used in a fair (and thus noninfringing) way, like a museum display of *Orange Prince*, and (b) federal copyright is not infinite, so all uses of a derivative will eventually be noninfringing.⁸ To wit, even though *Orange Prince* on the cover of *Vanity Fair* is an infringing use now, it will cease to infringe once the copyright in Goldsmith's photo expires.⁹ A derivative work is thus not itself infringing; only certain uses of it are infringing, and only over a finite span of time.

Though the expiration of the copyright in the original work may be far off in any given case (typical copyright duration is an author's life plus seventy years),¹⁰ it's still vital to keep expiration in mind, particularly given judges' immense discretionary power to order the destruction of "copies . . . found to have been made or used in violation of the copyright owner's exclusive rights"¹¹ Otherwise a court may improperly target a derivative's existence instead of more narrowly guarding against its unfair use, contrary to *Warhol*. And this concern is not hypothetical, per my discussion below of a recent Order to destroy copies of a *Lord of the Rings* derivative.¹²

be decided for new works on a use-by-use basis, courts going forward will have to decide questions of fair use not once for each new work, but repeatedly, for each use of each new work. The need for repeated rounds of fair use litigation threatens to increase the cost of fair use litigation exponentially.”)

7. See 17 U.S.C. § 106(2). As discussed below, even an *authorized* creation of a derivative is, at least in theory, also a *prima facie* infringement of the original work, and its use is then subject to the existence and scope of a license from the original's owner, which is an affirmative defense. See *infra* Part VI.

8. See U.S. CONST. art. I, § 8, cl. 8 (“Congress shall have power . . . [t]o promote the progress of science . . . by securing for *limited times* to authors . . . the exclusive right to their . . . writings”) (emphasis added). For a discussion regarding “science” as applied to copyright, see David S. Olson, *A Legitimate Interest in Promoting the Progress of Science: Constitutional Constraints on Copyright Laws*, 64 VAND. L. REV. EN BANC 185, 187 (2011) (“At the time of the constitutional convention, the word ‘science’ was understood to have a broad meaning, certainly broader than current definitions referring to areas of research that rely on the scientific method. ‘Science’ referred more generally to knowledge and the liberal arts.”). See also 17 U.S.C. §§ 301-305 (detailing the exact current duration of copyright).

9. See *infra* Part III.

10. See 17 U.S.C. § 302(a); see also *How Long Does Copyright Protection Last?*, U.S. COPYRIGHT OFF., <https://www.copyright.gov/help/faq/faq-duration.html> [<https://perma.cc/985H-ZZR5>].

11. 17 U.S.C. § 503(b); see also Anne-Marie Carstens, *Copyright's Deprivations*, 96 WASH. L. REV. 1275, 1276–77 (2021) (discussing the destruction remedy “and the stunning array of private property that falls within its ambit”). One of a copyright owner's exclusive rights is to prepare or authorize the preparation of derivative works based on the copyrighted work. *Id.* § 106(2).

12. See *infra* Part III.

A second implication of *Warhol's* use-focus is the conflict it seems to present with 17 U.S.C. § 103(a)'s edict that "protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully."¹³ Here, then, any part of *Orange Prince* in which copyrighted aspects of Goldsmith's photo have been unlawfully used is not itself copyrightable.

The Supreme Court did not discuss the relationship between its use-by-use approach and section 103(a), and scholars have reasonably pondered how that approach can be reconciled with section 103(a)'s apparently all-or-nothing approach to a derivative's copyrightability.¹⁴ I suggest here that the most sensible (or perhaps least nonsensical) way forward is to determine whether a derivative was created with an intent to use the original work unfairly.¹⁵ If so, then the original was used unlawfully and there should be no copyright in any part of the derivative pervaded by that original work. Conversely, if the derivative was created with a good faith intent to use it lawfully (e.g., within the scope of a license, with the intent of mere personal use, for a noncommercial sharing within a fanfiction community, or for some other potentially noninfringing purpose),¹⁶ then the original work was not

13. 17 U.S.C. § 103(a).

14. See, e.g., Postings of Pamela Samuelson, Shubha Ghosh, Jim Gibson, Mark Lemley, Brian Frye, Michael Risch, Tyler Ochoa, Jessica Silbey, Guy Rub to IPProfs@listserv.law.unh.edu (Nov. 25, 2023) (on file with author) (reflecting discussions on the topic by several intellectual property scholars); see also Pamela Samuelson, *Did the Solicitor General Hijack the Warhol v. Goldsmith Case?*, 47 COLUM. J.L. & ARTS 513, 531–38 (2024).

15. This aligns well, in my view, with a proposal—which Professors Pam Samuelson and Jessica Silbey have made contemporaneously with my work here—that courts should refrain from nullifying copyright under section 103(a) if it would be inequitable to do so. See generally Pamela Samuelson & Jessica Silbey, *Preventing Unjust Enrichment and Copyright Opportunism: An Equitable Interpretation of Section 103(a)* (forthcoming 2025) (manuscript on file with author). An actor's good-faith intent is a significant (and here, I think, would often be the primary) factor in whether equity would be invoked in that actor's favor. See Thomas W. Merrill, *Anticipatory Remedies for Takings*, 128 HARV. L. REV. 1630, 1669–70 (2015) ("[E]quity consists of a highly articulated system. That system consists of a series of distinct remedial devices, like the injunction, restitution, and the constructive trust. But it has also developed a set of conditions that determine whether equitable relief is appropriate, such as *good faith* and lack of notice, and a set of defenses that can be invoked to defeat the intervention of equity, including unclean hands, laches, and estoppel.") (emphasis added). Another way forward, of course, could involve amending section 103(a), which Professors Samuelson and Silbey have also suggested. See Samuelson & Silbey, *supra*, at 42.

16. See *infra* Parts III-IV for discussions of these different types of noninfringing uses. Furthermore, even scholars who have expressed strong support for Goldsmith's and others' rights to control derivative works recognize that it's not a right to control *all* uses of those works. See, e.g., Peter S. Menell & Lateef Mtima, *Exploring the Economic, Social, and Moral Justice Ramifications of the Warhol Decision*, 47 COLUM. J.L. & ARTS (forthcoming 2024) (manuscript at 65, 74) (available at SSRN: <https://ssrn.com/abstract=4714681>) ("We struggle to see why these follow-on creators should be privileged to use the works of Andrea Blanch, Patrick Cariou,

“unlawfully used” within the meaning of section 103(a), and a later unfair use of the original should not nullify copyright in the derivative.

And here’s how this interpretation of section 103(a) fits into my thesis of infringing uses, not works: even derivatives created with an intent to unlawfully use another’s copyright-protected material should not be deemed per se infringing for all uses. Section 103(a) merely declares that their creators will not be rewarded with their own copyright protection. It does not command that all uses be judged infringing.

The key distinction, then, is between copyright protection and infringement. I think the Warhol Foundation should retain its copyright in Warhol’s aesthetic additions to Goldsmith’s photograph because, as detailed below, they were apparently all created under a license from Goldsmith, even though there was a later use that infringed because it exceeded the scope of that license.¹⁷ Conversely, and as also detailed below, the unauthorized *Lord of the Rings* derivative likely should have no protection of its own, as the evidence strongly suggests that it was created with an intent to engage in unauthorized commercial competition with the Tolkien Estate.¹⁸ But this does not mean that all later uses of that derivative—such as free sharing within a fanfiction community—must be deemed infringing.¹⁹

So, when presented with an infringement claim against a derivative—whether it be *Orange Prince* or a *Lord of the Rings* sequel or one generated using artificial intelligence, as discussed below—a court should adjudicate it solely on a use-by-use basis. If a particular use or uses are found infringing, any injunction should be narrowly tailored to those uses and no others. Similarly, destruction should only be considered in cases involving works where the risk is high that the injunction will not be obeyed. Even then, at least one copy should be preserved—impounded with the court if needed—until the infringed copyright has expired.²⁰

or Lynn Goldsmith without permission. In all of these cases, the follow-on creators are essentially using the fair use doctrine as a means to obtain free raw material for their *commercial gain* without any targeted commentary Requiring future artists who seek to use the work of prior creators as raw material for non-critical uses—e.g., not as commentary, criticism, or parody—to negotiate the terms of appropriation with copyright owners, especially for *commercial uses*, serves the purposes that the drafters of the Copyright Act sought to advance.”) (emphases added).

17. See *infra* Part IV.

18. See *infra* Part III.

19. See *infra* Part III.

20. See 17 U.S.C. § 503(a)(1)(A) (“At any time while an action under this title is pending, the court may order the impounding, on such terms as it may deem reasonable . . . of all copies or phonorecords claimed to have been made or used in violation of the exclusive right of the copyright owner.”). For a prescient discussion of infringement and remedies along a sliding scale, including that “[n]o injunction or other coercive remedies should be issued against

And when faced with a claim that an infringing use has nullified the copyright in a derivative under section 103(a), a court should determine whether that derivative's creation was driven by an intent to use the original work unfairly. Even if it was, it would not make the derivative itself infringing for all uses, it would only stop the derivative's creator (or the creator's transferee) from controlling others' use of the derivative's added aesthetics. In sum, courts should only target and discourage discrete infringing uses, not the creation and existence of derivative works themselves.²¹

Before we proceed further, an important caveat: I'm generally agnostic here as to (1) whether *Warhol's* approach is how fair use has always worked, or at least is supposed to have worked, or if it's a new mode of analysis, (2) whether a use-by-use approach is, on balance, better or worse for our copyright system, and (3) how much it all truly matters. Others are debating these larger issues,²² and these debates should continue. Instead of weighing

whoever makes a solitary copy exclusively for private enjoyment or study," see Paul Edward Geller, *Hiroshige vs. Van Gogh: Resolving the Dilemma of Copyright Scope in Remedying Infringement*, 46 J. COPYRIGHT SOC'Y U.S.A. 39, 61 (1998). My thanks to Professor Jessica Silbey for referring me to this article.

21. On that note, the present draft of the Restatement of Copyright uses the phrase "infringing use" instead of "infringing work," which I think is a good sign. RESTATEMENT OF THE L., COPYRIGHT § 7.04 (AM. L. INST., Tentative Draft No. 4, 2023). One purpose of this piece, then, is to explain why this isn't just a useful catchall, as the Restatement seems to indicate. *See id.* It's the proper way to discuss infringement allegations against derivative works, particularly post-*Warhol*. More generally regarding the potentially outsized impact of changing a single word or phrase, see ERIC FONER, *THE FIREY TRIAL: ABRAHAM LINCOLN AND AMERICAN SLAVERY* 267–68 (2010) ("The Gettysburg Address also contained a subtle but significant shift in wording. Since the mid-1840s, in referring to the United States Lincoln had generally used the word 'Union,' a polity composed of individual states, rather than 'nation,' a unitary entity. In his message to Congress of July 1861, Lincoln had referred to the Union over forty times and the nation only three. Now, he spoke of the nation five times and did not mention the Union at all.").

22. Compare Mark A. Lemley & Rebecca Tushnet, *First Amendment Neglect in Supreme Court Intellectual Property Cases*, 2023 SUP. CT. REV. 85, 86 (2024) ("In *Andy Warhol Foundation v. Goldsmith*, the Court stomped the brakes on thirty years of jurisprudence involving copyright's fair use doctrine, under which providing a new purpose, meaning, or message was held to favor fair use."), and Lunney, *supra* note 6, at 8–9 ("The [*Warhol*] Court's realism is unrealistic. The Court's textualism ignores the statutory text. The Court's purposivism defeats the purpose for which Congress enacted fair use."), with Shyamkrishna Balganesch & Peter S. Menell, *Going "Beyond" Mere Transformation: Warhol and Reconciliation of the Derivative Work Right and Fair Use*, 47 COLUM. J.L. & ARTS (forthcoming 2024) (manuscript at 5) (available at SSRN: <https://ssrn.com/abstract=4714660>) ("While not eliminating the overlapping usage of 'transformed/transformative' in the definition of derivative works and application of the fair use doctrine, the majority opinion explains how the meaning of 'transform' varies between these two provisions, and offers a workable blueprint for reconciling them situationally. Fair use focuses on the use of a work, requires more than mere transformation, and considers commerciality along with a host of other factors. In so doing, *Warhol* restored and better operationalized Congress's text and intent."), Menell & Mtima, *supra*

in on them directly, my goal here is simply to illuminate the implications introduced above. This will hopefully both inform the larger debates and ultimately prove at least of some service in our quest for copyright's elusive but essential balance: an exclusionary right broad and long enough to foster and protect creativity while still narrow and short enough not to smother others who seek to build upon that creativity.²³

Part II below further details how *Warhol* urges us to focus on infringing uses, not works. Part III discusses how this focus should inform the scope of equitable remedies such as injunction and destruction. Part IV then tries to reconcile a use-based focus with the rule prohibiting copyright in parts of derivatives in which preexisting material “has been used unlawfully.” Part V opines on how a use-based approach could impact generative AI technology. And Part VI considers the converse implications: contrary to other scholars’ understanding, or at least their preference, I argue that there might be no such thing as a per se noninfringing derivative (or that it may effectively only be one that directly comments on the original work). So just as an “all” approach to whether a derivative infringes is problematic, so too is a “nothing” approach, at least post-*Warhol*.

II. HOW *WARHOL* FOCUSES ON INFRINGING USES, NOT WORKS

The thrust of the Supreme Court’s majority opinion and concurrence in *Warhol* is that the Court’s only proper focus was on the challenged use—namely the appearance of *Orange Prince* on the cover of *Vanity Fair*’s 2016

note 16, at 74 (“We are hopeful that the *Warhol* decision will promote various dimensions of progress and enhance social justice through its bolstering of authors’ rights, and that escape valves will continue to promote free expression and cumulative creativity.”), Frye, *supra* note 6, at 36 (“Is *Warhol* a big nothingburger? Hurray, spread the news! Or does it mean the end of fair use? If so, better to know than to be surprised. Maybe it’s somewhere in between. It could be worse. Sometimes, even a lemon of an opinion can make a delightful lemonade.”), and Xiyin Tang, *Art After Warhol*, 71 UCLA L. REV. 870, 880–81 (2024) (“My findings tentatively suggest that long-standing legal assumptions about the chilling effect of copyright, at least in the contemporary art world, may be overstated: both because artists work largely independently of the law and because artistic practice itself might be moving away from the appropriative art that has dominated the legal imagination.”).

23. Cf. Oren Bracha, *Not De Minimis: (Improper) Appropriation in Copyright*, 68 AM. U. L. REV. 139, 177 (2018) (“Copyright’s Holy Grail is finding a satisfactory balance point where robust incentives for creation are provided for an acceptable access cost.”); Eldred v. Ashcroft, 537 U.S. 186, 244 (2003) (Breyer, J., dissenting) (“The Copyright Clause and the First Amendment seek related objectives—the creation and dissemination of information. When working in tandem, these provisions mutually reinforce each other, the first serving as an ‘engine of free expression,’ the second assuring that government throws up no obstacle to its dissemination.” (quoting Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 558 (1985))).

issue commemorating the life of Prince—and no other uses.²⁴ The majority took care to note that it “expresse[d] no opinion as to the creation, display, or sale of any of the original *Prince Series* works,” which include *Orange Prince* and the fifteen other derivatives of Goldsmith’s photo.²⁵ Now, while this might be chalked up to Goldsmith’s decision to “[abandon] all claims to relief other than her claim as to the 2016 Condé Nast license and her request for prospective relief as to similar commercial licensing,” per the majority’s footnote, and therefore limited to the procedural details of this one case,²⁶ Justice Sotomayor’s opinion indicates otherwise.

24. There is serious doubt as to whether the Foundation’s licensing was itself an act of infringement, or whether it was at most a case of indirect infringement, which would involve a separate and secondary analysis. See Peter J. Karol, *What’s the Use? The Structural Flaw Undermining Warhol v. Goldsmith*, 71 J. COPYRIGHT SOC’Y (forthcoming 2024) (manuscript at 1–3) (available at SSRN: <https://ssrn.com/abstract=4663576>). But under either analysis—direct or indirect—I think the infringing use remains the focus post-*Warhol*.

My discussion of this focus, moreover, should not be taken as an implicit endorsement of its overall merits, per my agnosticism caveat in Part I, *supra*, or of the merits of other aspects of *Warhol*’s majority or concurring opinions. For instance, I think both opinions could’ve taken a more measured position as to the aesthetic differences between Warhol’s *Orange Prince* and Goldsmith’s photograph. In other words, I question whether the Court’s description, “*Orange Prince* crops, flattens, traces, and colors the photo but otherwise does not alter it,” *Warhol*, 598 U.S. at 522, fully and fairly captures Warhol’s aesthetic alterations and additions. And I think the Court should have at least discussed the possibility of remanding to get a jury’s view on whether and to what extent those aesthetic differences conveyed a different meaning or message to *Vanity Fair*’s readers than had Goldsmith’s photo been used on the cover. Cf. *Google LLC v. Oracle Am., Inc.*, 593 U.S. 1, 23–24 (2021) (affirming that “[f]air use is a mixed question of law and fact” and agreeing with the Federal Circuit’s view that “reviewing courts should appropriately defer to the jury’s findings of underlying facts; but that the ultimate question whether those facts showed a ‘fair use’ is a legal question for judges to decide *de novo*”); Lunney, *supra* note 6, at 46 (“*Orange Prince* re-frames and re-colors Goldsmith’s photo. In doing so, *Orange Prince* proclaims loudly and in unmistakable terms that Goldsmith’s photo is ‘Boring!’ . . . *Orange Prince* exclaims: ‘A black-and-white photo exhibiting the garden variety creativity of a high school yearbook photo is no way to portray a pop icon. Here’s how you portray a pop icon.’”).

Instead, at day’s end, we are left only with the varying aesthetic opinions of thirteen federal judges (nine supreme, three intermediate appellate, and one district) on the meaning and message of *Orange Prince*, an issue of fact which should typically involve the input of the parties’ peers. See WILLIAM F. PATRY, PATRY ON FAIR USE § 3:92 (2024) (discussing how the perception of a work is “not a classic question of law” and how a jury’s involvement on that issue is appropriate where viewers’ perceptions may reasonably differ); cf. Justin Hughes, *The Respective Roles of Judges and Juries in Copyright Fair Use*, 58 HOUS. L. REV. 327, 329 (2020) (discussing the ongoing “lively discussion about the relative roles of judges and juries in fair use determinations”).

25. *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 598 U.S. 508, 534 (2023).

26. See *id.* at 534 n.9. This decision may have been heavily influenced by the U.S. Office of the Solicitor General’s involvement in the case once it reached the Supreme Court. See generally Samuelson, *supra* note 14. Professor Samuelson has further argued that this was not a true abandonment by Goldsmith and that the possibility remained for Goldsmith to have raised other claims for relief on remand. See *id.* at 548–50.

First, though Justice Sotomayor could have refrained (due to Goldsmith's narrowing of her claim) from discussing other uses of *Orange Prince*, she *did* discuss them. And she did so in a way that highlighted their likely noninfringing nature: the Court's own reproduction, public display, and distribution of both *Orange Prince* and Goldsmith's photo within its opinions was covered by fair use, Sotomayor noted,²⁷ just as that doctrine would likely cover using *Orange Prince* for the purpose of teaching.²⁸

Second, Justice Sotomayor also discussed the difference between an infringing and noninfringing use of Warhol's iconic *Campbell's Soup Cans*.²⁹ Reproducing, publicly displaying, and distributing the "Campbell's Soup" logo in a series of paintings for collectors and museums was likely noninfringing, Sotomayor posited,³⁰ while licensing the work to a competing soup business to be reproduced, publicly displayed, and distributed in grocery stores likely would be infringing.³¹

While Justice Sotomayor probably saw this as a necessary explanation for why Warhol's *Soup Cans* were mentioned as a paradigmatic example of fair use in the Court's *Google v. Oracle* ruling just two years earlier,³² as contrasted with its decision on his *Orange Prince*, it still served to highlight the use-focused nature of the Court's infringement inquiry more generally. In other words, the example further clarified the Court's core view of copyright infringement as applied to derivative works: no derivative is per se infringing for all uses, nor is it necessarily *noninfringing* for all uses, even a derivative as iconic and famous as the *Cans*. Context matters.

27. See *Warhol*, 598 U.S. at 550 (noting how doctrines like fair use "account for . . . the dissent's own copying (and the Court's, too)").

28. See *id.* at 534 n.10 ("Had AWF's use been solely for teaching purposes, that clearly would affect the analysis, and the statute permits no other conclusion.").

29. See *id.* at 538–40.

30. *Id.* The Court tells us this is because the *Cans* "make a comment about consumerism." *Id.* (quoting *Google, LLC v. Oracle Am., Inc.*, 593 U.S. 1, 29 (2021)) (acknowledging that this quote originates from the work of Professor Netanel, which is in turn quoted by the Nimmer treatise). But who has determined this meaning? Why isn't it also true that *Orange Prince* is making a comment on pop stardom? See *supra* note 24 for how I think a jury could have made a finding of fact as to what, if any, commentary could be perceived in *Orange Prince*.

31. See *Warhol*, 598 U.S. at 539 n.15 ("The situation might be different if AWF licensed Warhol's *Soup Cans* to a soup business to serve as its logo. That use would share much the same purpose of Campbell's logo, even though *Soup Cans* has some new meaning or message. This hypothetical, though fanciful, is parallel to the situation here: Both Goldsmith and AWF sold images of Prince (AWF's copying Goldsmith's) to magazines to illustrate stories about the celebrity, which is the typical use made of Goldsmith's photographs.").

32. See *id.* at 538 (citing *Google, LLC*, 593 U.S. at 29) ("In *Google*, the Court suggested that [a]n artistic painting might, for example, fall within the scope of fair use even though it precisely replicates a copyrighted advertising logo to make a comment about consumerism. . . . That suggestion refers to Warhol's works that incorporate advertising logos, such as the *Campbell's Soup Cans* series.") (alteration in original) (citations omitted) (internal quotations omitted).

And as to Justice Gorsuch’s concurrence, joined by Justice Jackson, its main purpose was to expound on that very point:

[W]hile our interpretation of the first fair-use factor does not favor the Foundation in this case, it may in others. If, for example, the Foundation had sought to display Mr. Warhol’s image of Prince in a nonprofit museum or a for-profit book commenting on 20th-century art, the purpose and character of that use might well point to fair use Under the law Congress has given us, each challenged use must be assessed on its own terms.³³

Last, I think it illuminating to quantify the opinions’ terminology. Justice Sotomayor wrote “infringing use” once, “particular use” once, “challenged use” twice, “use at issue” six times, but “infringing work” not at all.³⁴ Justice Gorsuch used “challenged use” eight times and “particular use under challenge” twice.³⁵ The only time “infringing work” was used in *any* opinion, including Justice Kagan’s dissent, was once, in the concurrence.³⁶ And even there it was only in the context of discussing whether *Orange Prince* had prima facie infringed Goldsmith’s photo—i.e., was it substantially similar to any of the photo’s protected elements, such as angle, light, and shade—not as to whether *Orange Prince*’s appearance on the cover of *Vanity Fair* was infringing, which, again, depended on the affirmative defense of fair use.³⁷

This all is, I think, a relatively straightforward understanding of the Court’s majority and concurring opinions, particularly as to their use-focus, so I won’t belabor it.³⁸ I’ll instead proceed to discuss some implications.

III. HOW A USE-FOCUS SHOULD INFORM THE SCOPE OF INJUNCTIONS AND DESTRUCTION ORDERS

The *Warhol* decision was strictly concerned with the affirmative defense of fair use, and only one of the defense’s four factors at that.³⁹ But as I

33. *Id.* at 557–58 (Gorsuch, J., concurring).

34. *Id.* at 514–51.

35. *See id.* at 553–58.

36. *See id.* at 557.

37. *See id.* This narrow usage of “infringing work”—only as to whether a work is prima facie infringing of another’s copyright—is a more accurate (if still unnecessary and potentially confusing) use of the term, as I further discuss below. *See infra* Part VI.

38. Again, I’m not saying that I agree with how the Court handled the aesthetics of Warhol’s work here, or that it was correct with respect to its understanding of direct versus indirect copyright infringement. *See supra* note 24.

39. *See Warhol*, 598 U.S. at 515–16 (“In this Court, the sole question presented is whether the first fair use factor, ‘the purpose and character of the use, including whether such use is of a

indicated in Part I, its implications are broader. In particular, *Warhol's* use-focus should help federal courts more precisely tailor the scope of equitable relief—involving orders of injunction and destruction—when faced with infringing uses of copyrighted works. In sum, such an order should be tailored toward the particular use or uses litigated and no others, and it should not target the existence of a derivative itself.

To illustrate, in December 2023, Judge Stephen V. Wilson of the Central District of California issued both (1) a worldwide injunction against the further publication of the *Fellowship of the King*, a work of fanfiction written without the Tolkien Estate's consent, as well as (2) an Order that the writer, Demetrious Polychron, “[p]ermanently destroy all physical and electronic copies of the Infringing Work.”⁴⁰ Polychron's prior aggressive actions (unsuccessfully suing the Tolkien Estate's licensee, Amazon, for allegedly infringing *his* claimed copyright, as further detailed below⁴¹) likely and understandably drew that court's particular ire. But it's provocative cases like these that truly put copyright's principles to the test.

As to that provocation, and as recounted in Judge Wilson's summary judgment Order, the record was replete with proof of actual copying and substantial similarities to protected elements within Tolkien's *Lord of the Rings* trilogy.⁴² For example, the *Fellowship of the King* “made use of hundreds of characters from [the *Lord of the Rings* books], including *inter alia* Samwise Gamgee, Rosie Gamgee, Tom Bombadil, Aragorn, Arwen, Legolas, Gimli, El[e]ssar, Galadriel, Elrond, and Sauron.”⁴³ So this was a slam-dunk case of *prima facie* infringement.

This was also a very strong case against fair use, given the commercial and competitive nature of what was apparently the only use at issue:

commercial nature or is for nonprofit educational purposes,’ § 107(1), weighs in favor of AWF's recent commercial licensing to Condé Nast.”)

40. Tolkien Tr. v. Polychron, No. 2:23-cv-04300-SVW-E, 2023 U.S. Dist. LEXIS 226135, at *34 (C.D. Cal. Dec. 14, 2023).

41. *See id.* at *1–5 (“This case arises from a very similar set of underlying facts to those described by this Court in *Polychron v. Bezos*, No. 2:23-cv-02831-SVW-E, 2023 U.S. Dist. LEXIS 141938 (C.D. Cal. Aug. 14, 2023) (the ‘Related Case’). . . . In the Related Case, this Court dismissed Polychron's claims for ‘various types of copyright infringement’ with prejudice. This Court's rationale was that these claims failed as a matter of law because Polychron's ‘work is an unauthorized derivative work that is not entitled to copyright protection.’ In the alternative, this Court also found that ‘if [Polychron's] work were not an unauthorized derivative, he . . . failed to plausibly plead that *Rings of Power* infringes his work directly.’”).

42. *See id.* at *16–22.

43. *Id.* at *20–21. The opinion used the spelling “Elassar,” which I think is just a misspelling of Elessar, another name for Aragorn. And I've now just given myself away as a Tolkienite, a member of what Tolkien apparently called his “deplorable cultus.” *See* Lev Grossman, *Feeding on Fantasy*, TIME (Dec. 2, 2002, 12:00 AM), <https://time.com/archive/6667771/feeding-on-fantasy/> [<https://perma.cc/H7UQ-GJ42>].

Polychron's sales of the *Fellowship of the King* on retail sites in which the *Lord of the Rings* books were being, or could have been, sold.⁴⁴ Not only that, but Polychron sued Amazon, which had created a *Lord of the Rings* prequel television series under the authority of the Tolkien Estate, claiming it was infringing *his* copyright.⁴⁵ Polychron's suit was quickly dismissed, but it was no surprise that the Estate soon sued Polychron, requesting all available monetary and injunctive relief.⁴⁶

In sum, Polychron's *Fellowship of the King* was an unauthorized derivative which was directly competing with the copyright-protected Tolkien originals *and* being asserted in litigation against *authorized* derivatives.⁴⁷ On the surface, then, Judge Wilson seemed eminently justified in bringing down the full weight of copyright law. Why *not* enjoin all uses of the *Fellowship* and order the destruction of all physical and electronic copies?

Well, here's why: not all uses of the *Fellowship* will necessarily infringe when viewed under the lens of *Warhol*. And that's true even in a lopsided case such as this. But the *Warhol* decision was issued just months before Judge Wilson's Order here,⁴⁸ and it did not discuss remedies. Though *Warhol* was cited by the Tolkien Estate in arguing that commercializing the *Fellowship of the King* could not possibly be a fair use,⁴⁹ *Warhol* does not appear to have been cited by Polychron in opposing the Estate's requested injunction, nor

44. Beyond the undisputed evidence of infringement, the online reviews of the *Fellowship of the King* quoted in the Tolkien Estate's lawsuit suggested that the quality of the work was quite suspect, as well. See Complaint for Copyright Infringement at 22–24, Tolkien Trust v. Polychron, No. 2:23-cv-04300 (C.D. Cal. Dec. 14, 2023). One such review: "A friend of mine lent me this book to see what I thought about it as a lifetime Tolkien fan. I had to put it down but I did skim the rest of the book. A lot of the characters are straight from Tolkien's Middle Earth with minor changes and some of the details are from several other fantasy writers. I was not impressed at all, and I cannot recommend this in good faith." *Id.* at 23. And of the six reviews quoted, that was by far the kindest.

45. Polychron v. Bezos, No. 2:23-cv-02831-SVW-E, 2023 WL 6192743, at *14 (C.D. Cal. Aug. 14, 2023) ("Plaintiff alleges that the Amazon Defendants created a television show called *Rings of Power* that was initially set to take place years following the LOTR series, focusing on a Young Aragorn, the future King of Gondor, but subsequently, and after Tolkien viewed Polychron's manuscript, it changed its focus to the three Elven rings and to 6000 years earlier, consistent with Polychron's story. In 2022, Amazon released *Rings of Power* on its streaming platform.") (internal quotation marks omitted) (citation omitted).

46. See *Tolkien Trust*, U.S. Dist. LEXIS 226135, at *5–6.

47. See *id.* at *5.

48. Compare *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*, 598 U.S. 508 (2023) (showing a decision date on May 18, 2023), with *Tolkien Trust*, U.S. Dist. LEXIS 226135 (showing an Order date of December 14, 2023).

49. Plaintiffs the Tolkien Trust and the Tolkien Estate Limited's Reply in Support of Their Motion for Summary Judgment at 3 n.4, *Tolkien Trust v. Polychron*, No. 2:23-cv-04300-SVW-E (C.D. Cal. Dec. 14, 2023).

does it appear that Judge Wilson considered how *Warhol* might apply in that context.⁵⁰

So here's how: first, whether a derivative work, like the *Fellowship of the King*, infringes copyright must be judged use by use, per *Warhol*.⁵¹ The sharing of the *Fellowship of the King* for free and within a fanfiction community would present a strong case for a fair (and therefore noninfringing) use.⁵² The retention of a copy for Polychron's own private, personal joy would pose yet a stronger case.⁵³ So the injunction should have targeted only the commercial sale of *Fellowship of the King*, the sole use litigated in the case.⁵⁴

Second, it appears that the infringed works may now be out of copyright in New Zealand, where the *Lord of the Rings* copyrights apparently expired on January 1, 2024.⁵⁵ So the injunction, issued by a U.S. court and applying only U.S. copyright law, should not have been worldwide in scope.⁵⁶

50. See generally Defendant's Opposition to Plaintiff[s'] Motion for Summary Judgment, *Tolkien Trust*, No. 2:23-cv-04300-SVW-E (showing a lack of citation or reference to *Warhol*); *Tolkien Trust*, U.S. Dist. LEXIS 226135 (showing a lack of citation or reference to *Warhol*).

51. See *supra* Part II.

52. See Steven D. Jamar & Christen B'anca Glenn, *When the Author Owns the World: Copyright Issues Arising from Monetizing Fan Fiction*, 1 TEX. A&M L. REV. 959, 973 (2014) ("The argument for treating non-commercial fan fiction as fair use is straightforward: the fan fiction author is not getting any substantial commercial benefit from the fan fiction (factor one) and the potential market for the copyrighted work is more likely helped than harmed (factor four). Fan fiction probably in general actually helps create or expand the market for the original work much as a movie version of a book boosts sales of the book, e.g., *The Great Gatsby*."); see also Aaron Schwabach, *Fan Works and the Elusive Border Between Derivative and Transformative Uses: A Fanfic Law Retrospective and an Optimistic Look Forward*, 57 LOYOLA L.A. L. REV. (forthcoming 2024) (manuscript at 14–15) (available at SSRN: <https://ssrn.com/abstract=4425161>) (discussing the implications of copyright law on fan work and fanfiction and the thin barrier between what constitutes a derivative use versus a transformative use).

53. See Jessica Litman, *Lawful Personal Use*, 85 TEX. L. REV. 1871, 1910–11 (2007) ("We want people to be able to interact with texts as well as absorb them. Clapping hands, humming along, or playing a song on the piano all, technically, create unlicensed derivative works, as do reading aloud, playacting, and imagining a story's ending differently. They are nonetheless lawful by long tradition; they're precisely the sorts of interaction with copyrighted works that promote the Progress of Science.").

54. See generally *Tolkien Trust*, U.S. Dist. LEXIS 226135 (focusing exclusively on the sale of the *Fellowship of the King*).

55. See Finn Hogan, *Legal Copyright Expires for Lord of the Rings Books but Only in New Zealand, Lawyer Says*, NEWSHUB (Jan. 4, 2024), <https://www.newshub.co.nz/home/new-zealand/2024/01/legal-copyright-expires-for-lord-of-the-rings-books-but-only-in-new-zealand-lawyer-says.html> [<https://perma.cc/S4VA-ME3C>] (noting how, under New Zealand copyright law, "[l]iterary, dramatic, musical or artistic works copyright protection lasts for 50 years after the author dies" and that fifty years after Tolkien's death was January 1, 2024).

56. See Marketa Trimble, *The Territorial Discrepancy Between Intellectual Property Rights Infringement Claims and Remedies*, 23 LEWIS & CLARK L. REV. 501, 541–42 (2019) ("But [where] in a target country (the country that is covered by the extraterritorial reach of the

Third, even in the U.S., the infringed works' copyrights will expire: likely in 2046 for the *Fellowship of the Ring*, 2049 for *The Two Towers*, and 2050 for the *Return of the King*.⁵⁷ So the court should not have ordered the destruction of all copies of the work, given that at some point all uses—even commercially competitive ones—will be noninfringing.⁵⁸ A sensible alternative, if the court thought there to be a substantial risk of noncompliance with the injunction, would have been a more limited order of destruction, one coupled with the impoundment of a copy to be preserved until the infringed copyrights have expired.⁵⁹

injunction) the use . . . is permitted under the country's copyright law. . . [n]ot only does the injunction limit the course creator's conduct in the target country, in conflict with the law of the target country, it also limits the target country's public in their access to and enjoyment of the content, which the target country's law is designed to provide."); Naama Daniel, *Lost in Transit: How Enforcement of Foreign Copyright Judgments Undermines the Right to Research*, 38 AM. U. INT'L L. REV. 87, 137–39 (2023) ("It should be noted that national courts of first and second instances have issued in the past, on occasion, injunctions with an extraterritorial effect due to infringement of intellectual property rights, albeit these injunctions were usually confined and limited in scope. For example, courts in the United States have issued injunctions extending to Mexico, Canada, and Germany. On other occasions, U.S. courts of appeals vacated such injunctions or reaffirmed the territorial scope of the U.S. intellectual property system.").

57. See Robert Brauneis, *A Brief Illustrated Chronicle of Retroactive Copyright Term Extension*, 62 J. COPYRIGHT SOC'Y 479, 482 (2015) (showing a maximum ninety-five-year term retroactively applied to works published between 1923 and 1977); see also Bruce E. Boyden, *One Public Domain to Rule Them All*, MARQ. L. SCH. FAC. BLOG (Oct. 5, 2011), <https://law.marquette.edu/facultyblog/2011/10/one-public-domain-to-rule-them-all/> [<https://perma.cc/26V8-6Z4T>] (noting how Tolkien's works may have been out of copyright for a time in the U.S. due to a failure to comply with prior U.S. copyright formalities but also how the copyrights were restored via the 1994 Uruguay Round Agreements Act, which was later upheld as constitutional in *Golan v. Holder*, 565 U.S. 302 (2012)).

58. See U.S. COPYRIGHT OFF., *supra* note 10; see also *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 598 U.S. 508, 550 (2023) ("Finally, copyright law is replete with escape valves: the idea-expression distinction; the general rule that facts may not receive protection; the requirement of originality; the legal standard for actionable copying; *the limited duration of copyright*; and, yes, the defense of fair use, including all its factors, such as whether the amount taken is reasonable in relation to the purpose of the use.") (emphasis added). Professor Frye suggests that a derivative work creator's fair use case could be bolstered by abandoning any claim to copyright, i.e., dedicating it to the public domain. See Frye, *supra* note 6, at 40–41. Though I think this couldn't hurt a case for fair use in any given context, I also don't think a court should place any particular emphasis on, or a requirement of, a step like that. As long as a derivative work is used in a fair way (e.g., for personal use or shared for free) during the term of the original work's copyright, there is no reason that upon the original copyright's expiration the derivative's owner couldn't validly enforce a copyright in the derivative. But I more generally take Professor Frye's point to be that if someone else uses the derivative in an unfair way before the original copyright expires, an abandonment could help insulate the derivative's creator from secondary liability for that use, which may be true.

59. 17 U.S.C. § 503(a)(1)(A) (providing that "[a]t any time while an action under this title is pending, the court may order the impounding, on such terms as it may deem reasonable . . . of all copies or phonorecords claimed to have been made or used in violation of the exclusive right of the copyright owner").

Now, in the digital age, an indefinite number of copies of Polychron's *Fellowship* are already out in the world, in the possession of people outside of Polychron's control.⁶⁰ This includes a copy attached as an exhibit to the Tolkien Estate's own pleadings.⁶¹ So, yes, the court's Order is not truly eliminating the work. But that isn't the same as saying that the Order is proper.

The *Fellowship of the King* is not an infringing work. *Warhol* instructs us that there is no such thing: no derivative necessarily infringes as to all uses for all time. The *Fellowship* was simply used in an infringing way. So Polychron should have had the opportunity to retain possession of a copy of his work—or at least regain it, from impoundment, upon the expiration of the Tolkien copyrights—and then one day resume use.

Judge Wilson's Order should have been more limited. And other judges, when issuing orders of injunction, impoundment, and destruction, should take heed of *Warhol*'s use-based approach.⁶²

60. See, e.g., *Tolkien Trust*, U.S. Dist. LEXIS 226135, at *25 (quoting a letter from Polychron to the Tolkien Trust: "While promoting [the *Fellowship of the King*] last year, my temps sent out hundreds of PDF's to their networks. Once you email a PDF, you can't take it back and you can't stop anyone from forwarding it.").

61. Declaration of Lacy H. Koonce, III in Support of Defendants' Motion to Dismiss Plaintiff's First Amended Complaint at Exhibit F, *Polychron v. Bezos*, 2023 WL 6192743 (C.D. Cal. Aug. 14, 2023) (No. 2:23-cv-02831-SVW-E). That the Tolkien Estate apparently did not seek the court's permission to file the exhibit under seal further demonstrates that the Estate's real problem with the *Fellowship* was not its existence but how Polychron was using it, i.e., he was selling it and claiming the Trust's licensees had infringed its copyright. See Defendants The Tolkien Estate Limited, The Tolkien Trust and Simon Tolkien's Notice of Motion and Motion to Dismiss Amended Complaint Pursuant to Rule 12(B)(6); Memorandum of Points and Authorities, *Polychron v. Bezos*, 2023 WL 6192743 (C.D. Cal. Aug. 14, 2023) (No. 2:23-cv-02831-SVW-E).

62. The overbroad nature of the Polychron injunction is reflective of a larger trend noted by other scholars: that judges often ignore any possible value associated with works that have been used in an infringing manner. Cf., e.g., Pamela Samuelson, *Withholding Injunctions in Copyright Cases: Impacts of Ebay*, 63 WM. & MARY L. REV. 773, 837 n.435 (2022) ("It is common for courts to assert that the public interest is best served by enforcing copyrights."). Professor Patry has summarized the situation well:

One might think, given . . . the multivalent nature of copyright—encompassing both plaintiffs and defendants who create new works themselves—that any decision to grant or deny an injunction would incorporate this multivalent nature into the analysis. Such an assumption would be wrong. In all but the rarest instances the public interest is eliminated by equating it exclusively with plaintiffs. Courts frequently make unsupported pronouncements like . . . "preserving the integrity of the nation's intellectual property laws serves the public interest," "the public interest is also served by upholding the rights of copyright owners, 'otherwise the rationale for protecting copyright, that of encouraging creativity, would be undermined,'" "[t]he public interest is served in protecting the holders of valid copyrights from infringing activity," and "the public interest is affirmatively served by requiring continuing strict adherence to intellectual property law." A forceful expression of this bias is found in a 1982 Eastern District of Pennsylvania opinion, *Klitzner v. H.K. James & Co.*: "[I]t

But one further injunction-related issue merits discussion: could the logic of trademark law’s “safe-distance rule” justify Judge Wilson’s Order in the context of copyright?⁶³ This rule permits a judge “to issue injunctions that sweep even more broadly than the Lanham Act would permit against a manufacturer who has not already been found liable for trademark infringement.”⁶⁴ To my knowledge, the Sixth Circuit is the only court to have been expressly asked to apply the safe-distance rule to a copyright case, and it declined to do so, writing that “the rule was crafted to address the fact that, in the trademark context, an infringing mark is likely to confuse consumers” and that “[t]he same concern of limiting confusion of different products is not apparent in the copyright context.”⁶⁵

Implicitly, though, the D.C. Circuit seemed to apply something akin to the safe-distance rule when it upheld an injunction against an infringer of Disney’s copyrights in Mickey and Minnie Mouse, one that also prohibited future infringements of not just the mice, but also of other characters not previously at issue in the case, such as Donald Duck, Huey, Duey, Louie, Pluto, Goofy, and Roger Rabbit.⁶⁶ There the court wrote that when “liability has been determined adversely to the infringer, there has been a history of continuing infringement[,] and a significant threat of future infringement remains, it is appropriate to permanently enjoin the future infringement of works owned by the plaintiff but not in suit.”⁶⁷

In light of the above, I think judges should have some leeway in the context of copyright to go beyond the litigated issues in crafting an injunction, but under *Warhol*, not to go beyond the type of use litigated. To wit, instead of enjoining Polychron from “[c]opying, distributing, selling, performing,

is virtually axiomatic that the public interest can only be served by upholding copyright protections and correspondingly, preventing the misappropriation of the skills, creative energies, and resources which are invested in the protected work.” This passage was cited with approval by the Third Circuit the following year. It has been embellished in further paeans and has been repeated by others.

6 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 22:64 (2007) (internal citations omitted). Now, as Patry also notes, application of this supposedly virtual axiom likely does no harm in cases of total copying with no added creativity—often called piracy or counterfeiting—but the problem is where the letter and spirit of this language infects the harder cases, particularly those involving derivative works. *See id.*; *see also supra* text accompanying note 3.

63. Thank you to Professor Rebecca Tushnet for bringing the safe-distance issue to my attention.

64. *Sunbeam Prods. v. W. Bend Co.*, 123 F.3d 246, 260 (5th Cir. 1997), *abrogated on other grounds by* *TraFFix Devices Inc. v. Mktg. Displays Inc.*, 532 U.S. 23 (2001).

65. *ECIMOS, LLC v. Carrier Corp.*, 971 F.3d 616, 644 (6th Cir. 2020).

66. *See Walt Disney Co. v. Powell*, 897 F.2d 565, 566 (D.C. Cir. 1990).

67. *Id.* at 568; *see also* 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 30:4 (5th ed. 2024) (elaborating further on when and why the “safe-distance rule” is useful to the courts when deciding to issue an injunction to halt trademark infringement).

displaying, or preparing derivative works based on any copyrighted work by Professor J.R.R. Tolkien including *The Lord of the Rings*,⁶⁸ Judge Wilson should have enjoined only the “selling” of derivatives based on Tolkien’s works.

Now, I do think it’s fine for the injunction to cover all such works of Tolkien’s, even if Polychron didn’t previously use a particular book or character. In that sense, I agree with the safe-distance logic implicitly applied by the D.C. Circuit,⁶⁹ and I think it passes muster under *Warhol*. But going beyond the litigated use not only runs contrary to *Warhol*, it conflicts with the safe-distance rule itself: namely, how it’s rooted in market competition, which private use (for example) would typically not affect.⁷⁰

Applying a safe-distance logic to enjoining otherwise fair uses would also ignore copyright’s limited duration. A trademark has no expiration date; as long as a mark’s owner does not abandon its use, it can exist indefinitely, and its owner can thus indefinitely protect it from confusingly similar competitive uses.⁷¹ But upon a copyright’s expiration, the law of copyright places absolutely no limits on competition.⁷²

For example, what if Polychron comes up with an idea for another Tolkien-derived novel, one that could become very popular? Under Judge Wilson’s Order, Polychron must (to avoid contempt of court) delay writing it until Tolkien’s copyrights expire, at which point the injunction will also expire or can at least be dissolved upon request.⁷³ But in the meantime what if the inspiration leaves him, or worse, he becomes incapacitated or dies? Society would then lose the opportunity for that novel, and the progress which

68. Tolkien Trust v. Polychron, 2023 U.S. Dist. LEXIS 226135, at *34 (C.D. Cal. Dec. 14, 2023).

69. *See id.*

70. This is part of what I think informed the Sixth Circuit’s refusal to apply the safe-distance rule when enjoining copyright infringement. *See ECIMOS*, 971 F.3d at 644 (noting that the rule was crafted to address the fact that infringing marks can “confuse consumers”) (emphasis added).

71. *See* 2 MCCARTHY, *supra* note 67, § 6:8.

72. *See* 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 2.16 (Matthew Bender rev. ed. 2024) (“While trademarks endure as long as the mark is used, copyrights eventually expire. Upon expiration of the copyright, others have the right to reproduce the literary work and to use the title to identify the work. For example, once the copyright to *Gone with the Wind* expires, a variety of publishers may wish to market copies of the work.”) (citations omitted) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164 (Fed. Cir. 2002)).

73. *See id.* § 14.06(C)(2)(a)(ii) (“Given the constitutional limitation on how long copyrights last, it is of the essence to the field that all protection eventually lapses. Accordingly, it would appear nominally impermissible to issue a permanent injunction that is literally *permanent*. In other words, the court should enjoin infringement on the copyright for however many years its term may continue to subsist—but not past that expiration.”).

our Constitution champions would be stifled.⁷⁴ However, if Polychron could at least lawfully write the novel now, it could still be published when the *Lord of the Rings* copyrights expired, even if he died before then. This would enure to society's benefit, in line with copyright's proper balance.⁷⁵

This discussion of the safe-distance rule ultimately reinforces, to my mind, the distinction between uses and works after *Warhol*. The former can be infringing and, if they are, they should be enjoined; the latter can and should be neither.

IV. RECONCILING A USE-FOCUS WITH SECTION 103(A)

But what about 17 U.S.C. § 103(a) and its edict that “protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully”?⁷⁶

Here this means that any part of the *Fellowship of the King* in which the copyright-protected aspects of Tolkien's *Lord of the Rings* have been used unlawfully is not itself copyrightable. The prevailing judicial interpretation of this is that if Tolkien's material “pervades” Polychron's book, then none of the book, not even the characters and situations Polychron created, will be protected by copyright.⁷⁷

74. See *supra* note 8.

75. See *supra* note 23 and accompanying text. Further to this issue of creation before copyright's expiration, see Judge Richard Posner's half-joking (though, as relates to my thesis here, prescient) remark in *Gracen v. Bradford Exch.*, 698 F.2d 300, 303 (7th Cir. 1983), “[m]iss Gracen testified in her deposition that Foster . . . said he would return the [unauthorized derivative] painting [of Dorothy from MGM's *Wizard of Oz*] to her; and we must ask what he thought she would do with the painting when she got it back, if they failed to come to terms. Destroy it? Keep it in a closet till MGM's copyright expired?”

76. 17 U.S.C. § 103(a).

77. See, e.g., PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 2:16 (3d ed. Supp. II 2023) (“[S]ection 103(a) will entirely bar copyright for a derivative work such as a translation or motion picture that unlawfully borrows from a copyrighted story. Because, characteristically, the unlawfully borrowed story will in these cases pervade the entire derivative work, there will be no ‘part of the work’ in which it has not been used unlawfully.”). This seems to apply to the *Fellowship of the King*; there is likely no part that is fully distinct from the Tolkien originals. But if there is a part or parts of a derivative work that have not used the original at all, then those parts alone could escape the ambit of section 103(a). See *Bucklew v. Hawkins, Ash, Baptie & Co., LLP*, 329 F.3d 923, 930 (7th Cir. 2003) (“[I]f the original expression added by the unauthorized preparer of a derivative work is clearly detachable from the original work itself, so that no confusion, or disruption of the copyright owner's plans for the exploitation of his work, would be created by allowing the unauthorized preparer to copyright his original expression, the unauthorized preparer might be allowed to do so”); see also 2 PATRY ON COPYRIGHT, *supra* note 62, § 3:59 (“Unfortunately . . . courts . . . have not always grasped the distinction between the availability of copyright for unauthorized derivative works and infringement of a copyright owner's right to prepare derivative works The two are not mutually exclusive, as previously

Warhol did not discuss the relationship between section 103(a) and its use-by-use approach, and scholars have reasonably pondered how that approach can be reconciled with section 103(a)'s largely all-or-nothing approach to a derivative's copyrightability.⁷⁸ For my part, I see two viable interpretations.

The first is that if and when the owner of an alleged copyright in a derivative has been judged to use copyright-protected material unlawfully, the alleged copyright will at that point be deemed invalid. But this devolves quickly: what if, as may have been the situation in *Warhol*,⁷⁹ the creation of the derivative was licensed, but its later use exceeded the scope of the license and was therefore unlawful? Should the Warhol Foundation, from this point on, lose all ability to control the reproduction, distribution, adaptation, and public display of *Orange Prince*, even though its creation was lawful and it was apparently used lawfully between 1984 and 2016?⁸⁰ Perhaps, but it seems extreme and beyond the intent of Congress, whose apparent concern was deterring the creation of unauthorized derivatives.⁸¹

The other interpretation, then, one likely closer to the spirit of section 103(a), is that "used unlawfully" should be judged as of the time of the derivative's creation. How would this play out? Courts, I think, must make some determination of the intent of the derivative's creator in order to decide whether another's copyright-protected material was "used unlawfully."

Was the derivative created with the intent to engage in unauthorized competition with the original work? If so, then the original was used unlawfully and there should be no copyright in any part of the derivative pervaded by that original work. Conversely, was the derivative created with a good faith intent to use it lawfully, e.g., within the scope of a license, with the intent of mere personal use, for a noncommercial sharing within a fanfiction community, or for some other potentially noninfringing purpose?⁸² If so, then the original work was not "unlawfully used" within the meaning of section 103(a), and a later unfair use of the original should not nullify copyright in the derivative.

noted: The lyricist who writes original lyrics and reproduces them without permission along with another's copyrighted musical composition violates the copyright in the musical composition; yet, the lyricist is still entitled to copyright in the lyrics and may therefore sue third parties who copy them.").

78. See, e.g., Samuelson, Ghosh, Gibson, Lemley, Frye, Risch, Ochoa, Silbey, Rub, *supra* note 14 (reflecting discussions on the topic by several intellectual property scholars).

79. See *supra* note 4 and accompanying text, for an overview of the situation in *Warhol*.

80. Warhol likely created *Orange Prince* in 1984, and it was not until 2016 that it appeared on the cover of *Vanity Fair*. See *supra* note 4 and accompanying text.

81. See 8 NIMMER & NIMMER, *supra* note 72, § 103 app. 4 ("[T]he bill prevents an infringer from benefiting, through copyright protection, from committing an unlawful act Thus, an unauthorized translation of a novel could not be copyrighted at all").

82. See *supra* Part III, for discussions of these different types of noninfringing uses.

This latter approach, I think, best reconciles a fraught relationship between use-based infringement and section 103(a)'s categorical exclusion of certain derivatives from the protection of copyright. Yes, it ventures into a derivative creator's intent, which will always be a challenging inquest,⁸³ but I think that challenge is relatively small compared to the ramifications of the first interpretation, where later uses (including those by the heirs of a derivative's creator) could effectively nullify a copyright previously thought to be valid. So it seems the lesser of two evils post-*Warhol*.

However, even derivatives created with an intent to unlawfully use another's copyright-protected material should not be deemed per se infringing for all uses. Section 103(a) merely declares that their creators will not be rewarded with their own copyright protection. It does not command that all uses be judged infringing.

We should distinguish between protection and infringement. Polychron likely should have no copyright protection of his own in the *Fellowship of the King*, as the record strongly suggests that Polychron created the *Fellowship* with an intent to unfairly use it in unauthorized competition with the Tolkien Estate.⁸⁴ But that doesn't mean that all its uses (e.g., teachers excerpting it for a copyright class, fanfiction communities sharing it for free, or even Polychron's own purely personal use)⁸⁵ will necessarily infringe.

In sum, the *Fellowship* was likely created with the intent to unlawfully use Tolkien's works, and those works pervade it, so it should not have its own copyright protection. But whether other uses of the *Fellowship* infringe the copyrights in Tolkien's works must still be judged on their own merits. So, if today someone (even Polychron himself) downloaded the *Fellowship* from the court record and shared it within a fanfiction community, then that use of the *Fellowship* would likely be a noninfringing fair use of Tolkien's works.⁸⁶ Again, under *Warhol*, we should talk of infringing (and noninfringing) uses, not works, and section 103(a) does not suggest we speak otherwise.

83. Where infringement allegations are levied against older derivatives whose creators have died, like with *Orange Prince* or Twain's *A True Story*, and who therefore cannot testify in their own defense, courts should take much greater care not to impute malintent. See, e.g., Timothy J. McFarlin, *A Copyright Restored: Mark Twain, Mary Ann Cord, and How to Right a Longstanding Wrong*, 2023 WIS. L. REV. 45, 82–83 (discussing the care courts should take in adjudicating infringement claims involving older derivative works). So only in rare cases—ones with clear and convincing evidence of an intent to use unlawfully, such as unambiguous admissions in the creator's contemporaneous writings—should a court find that section 103(a) nullifies copyright. See, e.g., *id.*

84. See *supra* Part III.

85. See *supra* Part III.

86. Though distributing the *Fellowship* for free within a fanfiction community would likely be a deemed a noninfringing use for purposes of copyright law, if Polychron did it he would likely be violating the terms of Judge Wilson's injunction, which in my view is precisely the problem. See *supra* Part III.

V. HOW A USE-FOCUS COULD IMPACT GENERATIVE AI

While others are diving more directly into the topic of artificial intelligence and copyright,⁸⁷ it's hard not to contemplate how *Warhol's* use-focused approach will impact this groundbreaking technology, so I'll venture a few thoughts. The main one is that by ensuring we speak of infringing uses, not works, we can help promote a balanced reaction to AI and its outputs.⁸⁸

The AI systems that are causing the most copyright-related consternation are the ones available to the public—the most prominent to date being ChatGPT, Dall-E, Midjourney, and Bing—which anyone with an internet connection can prompt to generate words and images that, so far at least, are often substantially similar to copyright-protected works.⁸⁹ For example, the *New York Times* has shown examples of how prompts can cause these platforms to generate derivative images.⁹⁰

The prompt “popular movie screencap” for instance, allegedly caused Midjourney to generate an image of the Marvel character Iron Man.⁹¹ The Midjourney-generated image is likely prima facie infringing; it is substantially similar to the protected elements of the Marvel character Iron Man's visual

87. See, e.g., Peter K. Yu, *The Future Path of Artificial Intelligence and Copyright Law in the Asian Pacific*, 96 COMPUTERS & L. (forthcoming 2024), https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4707592 [<https://perma.cc/TF58-6V3B>]; Matthew Sag, *Fairness and Fair Use in Generative AI*, 92 FORDHAM L. REV. 1887 (2024); Mark A. Lemley, *How Generative AI Turns Copyright Upside Down*, 25 COLUM. SCI. & TECH. L. REV. 21 (2024); Daryl Lim, *Generative AI and Copyright: Principles, Priorities and Practicalities*, 18 J. INTEL. PROP. L. & PRAC. 841 (2023); Edward Lee, *Prompting Progress: Authorship in the Age of AI*, 76 FLA. L. REV. (forthcoming 2024) (available at SSRN: https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4609687) [<https://perma.cc/3YDH-EEUP>]; Oren Bracha, *The Work of Copyright in the Age of Machine Production*, U. TEX. LEGAL STUD. RSCH. PAPER (forthcoming 2024) (available at SSRN: https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4581738) [<https://perma.cc/VKW8-XTPC>]; Carys J. Craig, *The Relational Robot: A Normative Lens for AI Legal Neutrality* (Reviewing RYAN ABBOTT, THE REASONABLE ROBOT, Cambridge University Press, 2020), 25 JERUSALEM REV. LEGAL STUD. 24 (2022); Steven D. Jamar, *An Intellectual Property Social Justice Perspective on IP Protection for Artificial Intelligence Programs*, in CAMBRIDGE HANDBOOK ON INTELLECTUAL PROPERTY & SOCIAL JUSTICE 380 (Steven D. Jamar & Lateef Mtima eds., 2024); Mark A. Lemley & Bryan Casey, *Fair Learning*, 99 TEX. L. REV. 743, 748 (2021).

88. A related but separate issue involves whether the unauthorized reproduction of copyrighted works involved in training AI systems—i.e., copying at the input stage, rather than the output stage—constitutes infringement. See *infra* notes 95-97 and accompanying text for my discussion of inputs.

89. See Stuart A. Thompson, *We Asked AI to Create the Joker. It Generated a Copyrighted Image*, N.Y. TIMES (Jan. 25, 2024), <https://www.nytimes.com/interactive/2024/01/25/business/ai-image-generators-openai-microsoft-midjourney-copyright.html> [<https://perma.cc/ATX2-3Q6X>].

90. E.g., *id.*

91. *Id.*

appearance and was likely actually copied from published images of Marvel’s Iron Man character.⁹²

So, the key issue post-*Warhol* is how the public is using images like this Midjourney derivative. Are users turning around and selling it? Are they using it as a substitute for an image of Iron Man that they would otherwise have purchased from Marvel or its licensees? If they are, then the AI platforms will run the risk of contributory liability under previous Supreme Court rulings like *Sony* and *Grokster*.⁹³ But if not, and if instead these images are being used, at least to some extent, in a way that doesn’t compete with the original works, then that would seem to be a “substantial noninfringing use,” the prescient phrase from *Sony*.⁹⁴

This factual inquiry is essential, and it’s one that might be missed if we don’t appreciate the impact of infringing uses, not works. It’s all too easy to frame the question as being whether people are using Midjourney to generate infringing works. And the answer to that is an easy yes, in the prima facie sense. But as *Warhol* instructs, this is not the end of the inquiry: even prima

92. *See id.*

93. *See generally* *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984) (finding that the distributors of home video technology were not contributorily liable for copyright infringement primarily because the technology could be used to record television shows to watch later, at the viewer’s convenience, which was deemed a fair use of copies that were concededly prima facie infringing); *MGM Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913 (2005) (finding that the distributors of peer to peer file sharing technology could be contributorily liable for copyright infringement even though the technology may have been capable of substantial noninfringing uses, mainly due to the distributors’ “words and deeds” showing “a purpose to cause and profit from third-party acts of copyright infringement”). Professor Nimmer has pithily summarized how “the twin snares of *Sony* and *Grokster*” may be avoided:

So what is to be done about a carefully vetted service that has attracted millions in venture capital, which realistically it can earn back only on the supposition that its users engage in massive copyright infringement? If its founders have been cautious, neither advertising its infringing capabilities nor discussing them in internal memoranda, prospectuses to investors, emails, etc., then it escapes *Grokster*-type liability. If it has the capacity to be used for substantial non-infringing uses—even if no reasonable businessman would anticipate that utilization—then it has avoided *Sony*-type liability as well.

3 NIMMER & NIMMER, *supra* note 72, § 12.04; *see also* Katherine Lee et al., *Talkin’ ‘Bout AI Generation: Copyright and the Generative-AI Supply Chain*, J. COPYRIGHT SOC’Y (forthcoming 2024) (manuscript 95–98) (available at SSRN: https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4762060) [<https://perma.cc/ZD6X-RKE6>] (discussing how generative AI may or may not fall avoid these twin snares).

94. Indeed, the *Warhol* majority looked in part to *Sony* to support its statement that “[t]he same copying may be fair when used for one purpose but not another,” parenthetically describing that decision as “(contrasting the recording of TV ‘for a commercial or profit-making purpose’ with ‘private home use’).” *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 598 U.S. 508, 511, 533 (2023) (quoting *Sony*, 464 U.S. at 449–51).

facie infringements can be put to noninfringing uses.⁹⁵ The focus must ultimately be on whether and to what extent the images or other derivatives are being used fairly or unfairly once they have been generated. Only then can AI's outputs be properly judged in line with *Warhol*.

This use-focused output inquiry is likely also relevant to the related but distinct question of whether the unauthorized reproduction of copyrighted works involved in training AI systems—i.e., copying at the input stage rather than the output stage—constitutes infringement.⁹⁶ If unauthorized copying at the input stage can ultimately be shown to be but a means to the end of generating outputs that the public is using in substantially noninfringing ways, then *Warhol* could, albeit indirectly, impact the fair use analysis for AI's inputs as well.

And given that the destruction remedy has been sought against not just the input copies and the output derivatives, but against entire training models,⁹⁷ *Warhol's* use-focused inquiry could indeed help determine generative AI's continuing existence.⁹⁸

VI. THE CONVERSE IMPLICATIONS OF A USE-FOCUS

I've so far discussed how *Warhol* instructs against an "all" approach to infringement, i.e., that certain derivatives are infringing works, period, no matter how they are used. But there's also the converse: a "nothing" approach. That is, there's a belief among proponents of a broad fair use right (to which I'm admittedly sympathetic) that certain derivatives are noninfringing from

95. See *supra* Part II.

96. See generally Michael D. Murray, *Generative AI Art: Copyright Infringement and Fair Use*, 26 SMU SCI. & TECH. L. REV. 259 (2023) (arguing that the AI training systems are not actually copying works). Professor Murray has also discussed the implications of *Warhol*, particularly as to how aesthetic changes to the original work should factor into the fair use analysis. See generally Michael D. Murray, *Copyright Transformative Use After Andy Warhol*, FOUNDATION MODELS AND FAIR USE, 24 WAKE FOREST J. BUS. & INTELL. PROP. L. 21 (2023).

97. See, e.g., Christa Laser, *OpenAI and Microsoft Move to Dismiss New York Times Copyright Lawsuit re Training and Outputs of ChatGPT*, INNOVATION L. BLOG (Mar. 6, 2024), <https://www.christalaser.com/blog/analysis-of-openai-and-microsoft-motion-to-dismiss-new-york-times-lawsuit-regarding-copyright-infringement-in-ai-training-of-chatgpt> [<https://perma.cc/2CKT-5J9Q>]; see also Lee et al., *supra* note 93, at 129–30 ("For example, a court could order the destruction of a style-transfer system that allows users to regenerate one image using the artistic style of another, on the theory that a user could prompt it with a copyrighted image and generate an infringing derivative work.")

98. For a detailed discussion of how fair use law should impact the further development of generative AI models, see generally Peter Henderson et al., *Foundation Models and Fair Use*, J. MACH. LEARNING RSCH., Sept. 2023, at 1–79.

the moment of creation and can never infringe no matter how they are used.⁹⁹ I think that can't be right either after *Warhol*.

Returning to the details of that case, the Warhol Foundation sought a declaration that all sixteen images in Warhol's *Prince Series* were fair use, and U.S. District Judge Koeltl granted that relief, ruling on summary judgment that the entire *Prince Series* was protected by fair use.¹⁰⁰

In light of Justices Sotomayor's and Gorsuch's opinions, we can see how Judge Koeltl's ruling essentially mirrored the overbroad relief granted against Polychron's *Fellowship of the King*. Just as Judge Wilson's Order went beyond the litigated use as against the derivative,¹⁰¹ Judge Koeltl's Order went beyond the litigated use in the derivative's favor.¹⁰²

And that went too far. Not every use of every image of the *Prince Series* will necessarily be fair under one unified analysis. Each image has some aesthetic differences from the others, which should first be considered.¹⁰³ Next, the use of each should also be considered, particularly whether and to what extent each image is being used in commercial competition with Goldsmith's photo. As Justice Gorsuch noted, a display in a museum is not exactly the same as a display and distribution on a magazine cover.¹⁰⁴ So in order to have properly adjudicated the Foundation's requested declaration, the district court should have analyzed each work's aesthetics in the context of the particular use or uses threatened by Goldsmith's infringement claim.

Judge Koeltl instead found that all sixteen images in the *Prince Series* were "transformative works" under the same analysis, thereby implicitly finding all of them noninfringing for all uses.¹⁰⁵ In this thinking, the judge was not alone. Many courts and scholars prior to Judge Koeltl have promoted this concept of a "transformative work," taking that term from *Campbell v. Acuff-Rose*, a fair use ruling in favor of the group 2 Live Crew's derivative version of Roy Orbison's song "Oh, Pretty Woman."¹⁰⁶ They've typically applied it

99. See, e.g., Lemley & Tushnet, *supra* note 22, at 88–93 (discussing the view that some derivatives are "transformative works" that should not have "to be justified anew with each use" and criticizing *Warhol* for suggesting otherwise).

100. *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 382 F. Supp. 3d 312, 316, 331 (S.D.N.Y. 2019).

101. See *supra* Part III.

102. See *generally Warhol*, 382 F. Supp. 3d 312.

103. See *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 598 U.S. 508, 511, 552 (2023) (showing all sixteen images and their differences in color and design).

104. *Id.* at 557–58 (Gorsuch, J., concurring).

105. *Warhol*, 382 F. Supp. 3d at 327, 331.

106. See Lemley & Tushnet, *supra* note 22, at 88–89; *Bouchat v. Baltimore Ravens Ltd. P'ship*, 737 F.3d 932, 939 (4th Cir. 2013) (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994)) ("Transformative works rarely violate copyright protections because 'the goal of copyright, to promote science and the arts, is generally furthered by the creation of

to derivatives that, though still substantially similar to protectable elements within the original work (otherwise they wouldn't be derivative), have otherwise expressed a substantially different meaning or message than the original, either via modified aesthetics, the context of the use, or both.¹⁰⁷

But even *Campbell* concluded with a caveat. Justice Souter wrote that the answer to whether 2 Live Crew's derivative infringed the Roy Orbison original could depend on if it would be used in competition with an authorized rap version of "Oh, Pretty Woman."¹⁰⁸ In sum, the context of the use still mattered despite the derivative's substantially different aesthetics.¹⁰⁹

Warhol demonstrates the importance of *Campbell's* caveat. Justices Sotomayor's and Gorsuch's opinions effectively instruct that labeling something a "transformative work" can't mean that it's noninfringing for all uses.¹¹⁰ At most, the label is a judicial determination that a derivative work's aesthetic changes or additions to the original work are significant.

Now, this might mean that all *expected* uses of the derivative are likely to be noninfringing—nobody expects the Warhol Foundation to actually license the *Cans* to a competitor of Campbell Soup Company—but that isn't the same as declaring the *Cans* to be a per se noninfringing work.¹¹¹ As Justice

transformative works. Such works thus lie at the heart of the fair use doctrine's guarantee of breathing space within the confines of copyright.").

107. See, e.g., Mala Chatterjee, *Lockean Copyright Versus Lockean Property*, 12 J. LEGAL ANALYSIS 136, 169–70 (2020) (citing Amy Adler, *Fair Use and the Future of Art*, 91 N.Y.U. L. REV. 559, 614 (2016)) (summarizing how courts typically "tackle the question of whether something counts as a transformative work by asking whether it has a new meaning or message, substantively different aesthetic properties, or produces a different impression on viewers"); David Tan & Angus J. Wilson, *Copyright Fair Use and the Digital Carnivalesque: Towards a New Lexicon of Transformative Internet Memes*, 31 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 864, 911 (2021) (positing how "even a visually non-transformative work may be contextually transformative because it has introduced new ideas fundamentally different from the original").

108. See *Campbell*, 510 U.S. 569 at 593–94. The Court predicted that the "evidentiary hole" on this factual issue would "doubtless be plugged on remand." *Id.* at 594. But the case settled before that could happen. See *Acuff-Rose Settles Suit with Rap Group*, COM. APPEAL (Memphis), June 5, 1996, at 14.

109. See Michael W. Carroll & Peter A. Jaszi, *The Triumph of Three Big Ideas in Fair Use Jurisprudence*, 99 TUL. L. REV. (forthcoming Dec. 2024) (manuscript at 58–59) (available at SSRN: <https://ssrn.com/abstract=4778293>) [<https://perma.cc/A8ZD-VU4M>] ("The phrase 'transformative works' originated in *Campbell's* discussion of how a use may qualify as transformative because it results in the creation of a new and different work. However, this has been misunderstood to suggest that if a work is deemed transformative because of the context of its creation, further use of the work is necessarily transformative.").

110. See *supra* Part II.

111. For further information about the genesis of Warhol's *Soup Cans* and the Campbell Soup Company's view of them, see Katherine D. Bennett, *Warhol's 15 Minutes' of Fame Are Not Up Yet*, CNN, <https://www.Cnn.Com/2012/09/05/living/campbell-soup-company-andy-warhol/index.Html> [<https://perma.Cc/4UWS-QK5X>] (Sept. 5, 2012, 8:33 PM) ("Campbell Soup

Sotomayor put it, “not all of Warhol’s works, nor all uses of them, give rise to the same fair use analysis.”¹¹² We should recognize the possibility, as Sotomayor did, that even a venerated work like Warhol’s *Cans* could potentially be used in an infringing way. Again, context should always matter, despite the understandable desire for the more clear-cut and expansive approach evoked by the term “transformative work.”

I do think, however, that some derivatives target the original work with aesthetics which so directly critique, parody, or otherwise comment on the original such that these derivatives will be effectively transformative for all uses. That is, it’s not just that the derivative will likely be deemed fair for all expected uses. With some derivatives it’s difficult or impossible to conceive of any unfair use. *The Wind Done Gone* critiquing *Gone with the Wind*¹¹³ and the Coors commercial parodying the Energizer Bunny¹¹⁴ are two good candidates for this category of derivative work.

Now, because the courts treat fair use as an affirmative defense,¹¹⁵ a user of even these derivatives still must prove that a reasonable observer would perceive the critique, parody, or comment in any given context.¹¹⁶ But, again, as to this limited category of work, this will likely be an easy burden to meet in every context. In a practical sense, then, I think it’s accurate to refer to these as “transformative works.” But for precision’s sake, and to discourage the flip-side term “infringing work,” I still suggest something like “transformative for all conceivable uses” as the preferred terminology.

But what, again, about *Orange Prince*? It may well have been created with Goldsmith’s consent,¹¹⁷ and if so, why isn’t it a per se noninfringing

Company never commissioned Warhol to paint the original soup cans. Former president and CEO of the company, William Beverly Murphy, initially had reservations about Warhol’s work 50 years ago, and Campbell took a ‘wait and see approach’ before fully supporting him. Now, the company takes great pride in its association with the iconic artist.”)

112. *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 598 U.S. 508, 539 (2023).

113. *See SunTrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1259 (11th Cir. 2001); *see also* 4 NIMMER & NIMMER, *supra* note 72, § 13F.12[D][1] (discussing *Suntrust Bank v. Houghton Mifflin Co.*, where the owners of the copyright in Margaret Mitchell’s *Gone With the Wind* sought to enjoin publication of Alice Randall’s *The Wind Done Gone*).

114. *See* *Eveready Battery Co. v. Adolph Coors Co.*, 765 F. Supp. 440, 441–42 (N.D. Ill. 1991). Another thank you to Professor Rebecca Tushnet for suggesting this as a potential example.

115. 3 NIMMER & NIMMER, *supra* note 72, § 12.11[F].

116. *See* 1 PATRY ON FAIR USE, *supra* note 24, § 3:92; *see also* Susan L. Faaland, Comment, *Parody and Fair Use: The Critical Question*, 57 WASH. L. REV. 163, 188–91 (1981).

117. *See* Pamela Samuelson, Mark Gergen, and Eugene Volokh, *What’s Wrong and What’s Missing in the SG’s Amicus Brief in Andy Warhol Foundation v. Goldsmith*, VOLOKH CONSPIRACY (Sept. 6, 2022, 8:13 AM), <https://reason.com/volokh/2022/09/06/whats-wrong-and-whats-missing-in-the-sgs-amicus-brief-in-andy-warhol-foundation-v-goldsmith/> [https://perma.cc/2X3T-KHFE] (“One way in which the license between *Vanity Fair* and Goldsmith’s

derivative? In 1984, when *Vanity Fair* paid Goldsmith for a license to have an artist use her Prince photo as a reference, Warhol created *Purple Prince*, which was ultimately used in connection with a *Vanity Fair* feature on Prince that year.¹¹⁸ The other fifteen images in the *Prince Series*, including *Orange Prince*, may have been created at that same time as part of Warhol's process and perhaps as different options for the magazine's editors.¹¹⁹ If that's true, then why isn't *Orange Prince* noninfringing for all uses for all time?

The reason, I think, is that derivative works are by definition *prima facie* infringing.¹²⁰ Even when the creation of a derivative is authorized—commonly called “licensed” in copyright-speak—the existence of that license is treated by the courts as an affirmative defense.¹²¹ In other words, even a licensed derivative is *prima facie* infringing of the original work, such that the burden of proof will ultimately be on the user to prove both the existence of a license and that a given use is within its scope.¹²²

This is ultimately why I think the *Warhol* case couldn't have been an easy “there was a license” win for the Warhol Foundation.¹²³ Even if the Foundation could prove that Goldsmith authorized the creation of *Orange Prince* in 1984, that wouldn't automatically mean that its use on the cover of the 2016 Prince tribute issue was within that license's scope. Even a licensed derivative may infringe if its use exceeds the scope of the license.¹²⁴ This is

agent might be important is that the sixteen prints created by Warhol under the *Vanity Fair* license may be authorized derivative works.”).

118. *Id.* For a deep discussion of the use of a photo as an artist reference and how it should help us understand the *Warhol* case, see generally Jessica M. Silbey & Eva E. Subotnik, *What the Warhol Court Got Wrong: Use as an Artist Reference and the Derivative Work Doctrine*, 47 COLUM. J.L. & ARTS 353 (2024).

119. *See id.*; Frye, *supra* note 6, at 10.

120. *See* 17 U.S.C. § 106(2) (“Subject to sections 107 through 122, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following . . . to prepare derivative works based upon the copyrighted work.”); *see also* Chicago Bd. of Educ. v. Substance, Inc., 354 F.3d 624, 628 (7th Cir. 2003) (“Ty was trying to enjoin the publication of Beanie Babies collectors’ guides that contained criticisms of some of the Beanie Babies, with accompanying photographs that constituted derivative works of the soft-sculpture Beanie Babies and hence *prima facie* infringements of Ty’s copyrights.”).

121. *See, e.g.*, 2 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 5:133 (2007) (“All courts agree that the assertion of a license to excuse otherwise infringing conduct is an affirmative defense, the burden of which rests on the party putting forth the license.”).

122. *Id.* Professor Patry notes that though some decisions suggest that the burden may shift to the owner of the original work regarding whether a particular use exceeds the scope of a license, these decisions do not alter the fact that, to meet its burden on the affirmative defense of a license, a user will still need to submit evidence “that the license covers the use in question.” *Id.*

123. But see Frye, *supra* note 6, at 27–30, for a different view on this.

124. 2 PATRY, *supra* note 121, § 5:126. “Scope” also includes the expiration or termination of a license, as illustrated by the case of *Stewart v. Abend*, 495 U.S. 207 (1990). There, a short

true even for a derivative work whose continued use is permitted by law after the termination of a license. Even then, the terms of that license will continue to govern the scope of permissible uses.¹²⁵

After *Warhol*, the use of derivative works, even those whose creation was licensed and those that incorporate transformative aesthetics, is the ultimate issue when analyzing infringement. To help curb the extreme of an “all” approach, i.e., labeling a derivative an “infringing work,” and to best strike a balanced understanding of *Warhol*’s implications, we should take care to avoid the opposite extreme of a “nothing” approach.¹²⁶ Said another way, just as we should speak of infringing uses, not works, we should also speak mainly of transformative uses, not works.

VII. CONCLUSION

Copyright is inherently messy.¹²⁷ A society that protects free expression while also enforcing exclusionary rights in intangible aesthetics must, I think, abandon hope of perfect labels like “infringing works” and “transformative works.” We should recognize the messiness of the enterprise—the imperfect

story, “It Had to be Murder,” authored by Cornell Woolrich, was licensed as the basis for the film *Rear Window*, which ultimately included much of what could be labeled the transformative expression of director Alfred Hitchcock and actors like Jimmy Stewart. But the further use of that film was deemed infringing once the license to the short story was terminated by Woolrich’s heirs upon their renewal of the copyright in his story. The Court held, under the 1909 Act, that though the derivative film was made under a license, once the license was terminated the film either needed a new license or it would infringe the renewed copyright in the story. *See id.* at 207–10. The Court noted how the result would have differed under the current Act, as a previously licensed derivative may continue to be utilized under the terms of that license even after termination under 17 U.S.C. § 304. But in so noting, the Court further observed how this illustrates the principle that even an authorized derivative will continue to be subject to the terms of that authorization. *See id.* at 226 (“[A] derivative work prepared under authority of a grant of a transfer or license of the copyright that is made before the expiration of the original term of copyright may continue to be used *under the terms of the grant* . . .”) (quoting 17 U.S.C. § 304)) (emphasis added).

125. *See id.* at 226–27.

126. “The extremism on one side [of copyright] begets extremism on the other, a fact we should have learned many, many times over” Lawrence Lessig, *On Laws That Choke Creativity*, TED (Mar. 2007), https://www.ted.com/talks/lawrence_lessig_laws_that_choke_creativity?source=post_page-4aa99ded4ce4-&subtitle=en [<https://perma.cc/NGE2-ZEZF>].

127. *Cf.* Balganesch & Menell, *supra* note 22, at 42 (“Fair use is messy: contextual, fact-intensive, and above all else necessitating the exercise of statutory interpretation and equitable judgment.”). I was pleased to see the synchronicity between my thought on copyright’s messiness and this observation by Professors Balganesch and Menell in their own piece on *Warhol*’s implications. *See id.* But as I say here, it’s not just fair use that’s messy, it’s all of copyright.

realities of use-focused infringement after *Warhol*—if we’re going to make the best of it.¹²⁸

In this way, the *Warhol* litigation is perhaps a fitting microcosm. Is *Orange Prince* infringing? It depends on how we use it. Is *Warhol* a good decision? That may similarly depend.

128. This messiness won’t change unless and until the Supreme Court issues a contrary decision or Congress amends the Copyright Act, neither of which is likely at least any time soon. See Frye, *supra* note 6, at 2, 17–18. Even then, trying to make copyright too tidy is apt to be a fool’s errand.