

Hope or Nope—Is “Obama Hope” Protected by Idea/Expression Dichotomy, Fair Use Doctrine, & First Amendment?

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Introduction

Andy Warhol once said, “Art is what you can get away with.”¹ Warhol may be one of the most famous modern artists. He is also known for appropriating images from popular culture to create many works, such as paintings of Campbell’s Soup Can and Marilyn Monroe.² “Appropriation art” is generally defined as “a modern art movement that questions the creative act by incorporating imagery or concepts that are lifted, adapted, or directly referenced from a commercial, pop culture, historical art or other precedent, generally without the permission of the original creator.”³ However, this is a legally unfortunate term, particularly in a copyright context.⁴ According to Black’s Law Dictionary, appropriation means “[t]he exercise of control over property; a taking of possession.”⁵ Even Andy Warhol could not get away with appropriating images without facing copyright law problems.⁶ In his final interview, when asked about the copyright situation, he stated, “It’s just like a Coca Cola bottle—when you buy it, you always think that it’s yours and you can do whatever you like with it. . . . I don’t want to get involved, it’s too much trouble.”⁷

Warhol has influenced many modern artists, including visual artist Shepard Fairey.⁸ Fairey created the famous iconic image of the Barack Obama “HOPE” poster, (“Obama Hope”),

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¹ See Andy Warhol Shop, <http://www.thewarholshop.com/quotes.php> (last visited Nov. 13, 2009); The Warhol, Warhol Store, <http://www.warholstore.com/staticpage/Andy-Warhol-Quote---Art-is-What-you-Can-Get-Away-Magnet.html> (last visited Oct. 24, 2010).

² The Andy Warhol Foundation for the Visual Arts, Andy Warhol Biography, <http://www.warholfoundation.org/legacy/biography.html> (last visited Nov. 13, 2009).

³ ArtWeLove, Appropriation Art, <http://artwelove.com/explore/Movements-and-Styles/Appropriation-Art> (last visited Nov. 25, 2009).

⁴ *Blanch v. Koons*, 467 F.3d 244, 246 (2d Cir. 2006).

⁵ Black’s Law Dictionary (8th ed. 2004).

⁶ See Emily Meyers, *Art on Ice: The Chilling Effect of Copyright on Artistic Expression*, 30 COLUM. J.L. & ARTS 219, 225-26 (2007) (citation omitted); see also Gary Comenas, *Andy Warhol’s Flower Paintings*, WARHOLSTARS, <http://www.warholstars.org/chron/Inx/flowers64.html> (last visited, Nov. 13, 2009) (noting that after Warhol was sued for infringing a copyrighted photograph, he became careful about appropriation and started taking photographs for himself).

⁷ Gary Comenas, *Andy Warhol Interview Part Two*, WARHOLSTARS, <http://www.warholstars.org/warhol/warhol1/warhol1n/andy.html> (last visited Nov. 13, 2009) (reproducing transcript of an Interview by Paul Taylor with Andy Warhol, FLASH ART (April 1987)).

⁸ Sebastian Smees, *Street Smart: Shepard Fairey Makes His Mark in an Eye-catching Show at the ICA*, BOSTON GLOBE, Feb. 6, 2009, at G6.

widely seen during the 2008 presidential election.⁹ He also designed another Obama collage that appeared on the cover of Time magazine's Person of the Year 2008 issue.¹⁰ Fairey made headlines in 2009 as he began a copyright infringement dispute with the Associated Press ("AP") regarding the source for his Obama Hope image.¹¹ Nearly eight months after the dispute started, Fairey admitted to lying about the source and destroying the evidence.¹² As discussed in more detail below, Fairey and the AP disputed the real source of the photograph that Fairey appropriated as his visual reference, but he abruptly changed his story and admitted that the source the AP claimed was the real photograph.¹³ Thus, Fairey, like Warhol, could not easily "get away with" his art without getting involved with copyright trouble.

Appropriation art is not a new trend. Many famous painters, such as Paul Gauguin, Paul Cezanne, and Vincent Van Gogh, also used photographs as their creative reference.¹⁴ In contrast, legal problems for appropriation artists are a recent phenomenon, emerging in the 1960s when Pop artists like Andy Warhol came to fame.¹⁵ Strict copyright regulation is making it more difficult for appropriation artists, like Fairey, to use existing images to freely express their artistic creativity. However, it appears counterintuitive that copyright regulation restricts such artistic works considering the protection given to freedom of expression by the First Amendment of the U.S. Constitution.¹⁶ In Fairey's case the First Amendment argument seems even more applicable because he borrowed a public official's image to express his political opinion.

Nevertheless, courts have been reluctant to accept the First Amendment as an affirmative defense in copyright cases where "secondary" users appropriate copyrighted works.¹⁷ As explained below, the Supreme Court reasons that the Copyright Act of 1976¹⁸ accommodates the First Amendment goals by limiting copyright protection to original expression under the idea/expression dichotomy (hence allowing others to use ideas and information), while permitting others to use this original expression under the "fair use" doctrine. The problem with this rationale is that there are no clear distinctions between idea and expression or between fair use and "unfair" use, leaving decisions to a case-by-case basis. Copyright disputes over these issues may increase as Internet technology makes appropriating photograph, videophotographs, videos, music, media coverage, and the like easier for any "artist." For example, is it acceptable to copy a New York Times news article found through Google search, paste it on Facebook or

⁹ Kate Linthicum, *Tagged, He's It Election Becomes Their Turf; Street Artists More Prone to Protest Than Consensus Find a Cause They Can Get Behind: the Presumed Democratic Nominee*, L.A. TIMES, Aug. 23, 2008, at 1.

¹⁰ Richard Stengel, *Person of the Year*, TIME, Dec. 29, 2008, at 4.

¹¹ Randy Kennedy, *Artist Sues the A.P. over Obama Image*, N.Y. TIMES, Mar. 10, 2009, at C1.

¹² Liz Robbins, *New Wrinkle in Obama Poster Dispute*, N.Y. TIMES, Oct. 18, 2009, at A26.

¹³ See Shepard Fairey, *Statement on Associated Press Fair Use Case*, OBEY GIANT, Oct. 16, 2009, <http://obeygiant.com/headlines/associated-press-fair-use-case> (last visited Oct. 26, 2009); Sri Kasi, *AP Statement: Fairey Admits He Sued AP Under False Pretenses*, ASSOCIATED PRESS, Oct. 16, 2009, http://www.ap.org/pages/about/pressreleases/pr_101609a.html (last visited Oct. 26, 2009).

¹⁴ See Antonio Martínez Ron, *Famous Painters Copied Photographs*, FOGONAZOS, Nov. 6, 2006, http://www.fogonazos.es/2006/11/famous-painters-copied-photographs_06.html (last visited Nov. 22, 2009).

¹⁵ Meyers, *supra* note 6, at 225.

¹⁶ U.S. CONST. amend. I.

¹⁷ See Neil Weinstock Netanel, *Locating Copyright Within First Amendment Skein*, 54 STAN. L. REV. 1, 37 (2001).

¹⁸ 17 U.S.C. §§ 101-1332.

Twitter, and comment on it? Can we “Warholize”¹⁹ or “Obamicon”²⁰ pictures found on Flickr to create posters to sell? Can a singer who supports a Democratic presidential candidate prohibit a Republican candidate from using his or her song on a campaign commercial and posting it on YouTube?²¹

Since the Obama Hope case includes very broad issues, such as the tension between copyright and the First Amendment, the case might provide the court with an opportunity to clarify some of copyright law’s unresolved questions. While analyzing the Obama Hope case, this article will thoroughly illustrate the current jurisprudence of copyright law. Part I will explain the factual background and legal disputes of the Obama Hope case. Part II will look into the idea/expression dichotomy in the Copyright Act of 1976 and analyze whether Fairey infringed the AP’s copyright by using its photograph for the Obama Hope. Part III will discuss the fair use doctrine in the Copyright Act and apply it to the Obama Hope case, determining whether it defends Fairey’s use as fair use. Part IV will discuss the First Amendment values and apply constitutional standard of review to the Obama Hope case. Finally, Part V will conclude that Fairey still has hope to survive this ongoing copyright infringement dispute.

I. Background

A. “Obama Hope”

During the 2008 presidential campaign, the iconic image of Barack Obama with his face gazing toward the sky and the word “HOPE” attached below him became ubiquitous nationwide.²² The artist behind this image, Shepard Fairey, a visual artist whose prior works include OBEY Giant,²³ used a photograph of Senator Obama that he found through a Google search.²⁴ The Obama campaign used Fairey’s art to promote Barack Obama’s candidacy for president and Barack Obama himself sent a letter to thank Fairey for the support.²⁵

While Fairey distributed about 300,000 free posters using his Obama Hope image, he also sold 4000 posters for \$45 each.²⁶ In addition, he sold Obama Hope merchandise, such as T-shirts, metal buttons, stickers, and coffee mugs.²⁷ Fairey stressed that he created the image to

¹⁹ Big Huge Labs, Pop Art Poster: Become a Pop Icon!, <http://bighugelabs.com/popart.php> (last visited, Nov. 22, 2009).

²⁰ Webicon.Me, <http://obamiconme.pastemagazine.com> (last visited, Nov. 22, 2009).

²¹ See *Browne v. McCain*, 612 F. Supp. 2d 1118, 1121-22 (C.D. Cal. 2009).

²² Linthicum, *supra* note 9.

²³ See OBEY Giant, <http://obeygiant.com> (last visited Nov. 25, 2009); OBEY Clothing, History about Shepard Fairey, <http://obeyclothing.com/#/history/> (last visited Nov. 25, 2009).

²⁴ Sylvia Rubin, *Promote Your Candidate with T-shirts, Truffles*, S.F. CHRON., Mar. 18, 2008, at F1; Linthicum, *supra* note 9.

²⁵ William Booth, *Obama’s On-the-Wall Endorsement*, WASH. POST, May 19, 2008, at M01.

²⁶ See Complaint for Declaratory Judgment and Injunctive Relief at 5-6, *Fairey v. Associated Press*, 2009 WL 319564, at *5-6 (S.D.N.Y. Feb. 9, 2009)(No. 09 Civ. 01123), available at <http://docs.justia.com/cases/federal/district-courts/new-york/nysdce/1:2009cv01123/340121/1>; Geoff Edgers, *Shepard the Giant—He’s Gone from Street Artist to Creating an Iconic Image of Barack Obama and Having a Solo ICA Show*, BOSTON GLOBE, Jan. 25, 2009, at N1.

²⁷ See Edgers, *supra* note 26; Ben Arnon, *How the Obama “Hope” Poster Reached a Tipping Point and Became a Cultural Phenomenon: An Interview with the Artist Shepard Fairey*, HUFFINGTON POST, Oct. 13, 2008, available at

promote Obama for president and that he reinvested the revenue from the poster and sticker sales to make more Obama Hope merchandise.²⁸ He claimed that he donated the revenue to Obama's presidential campaign.²⁹

After Barack Obama was elected President of the United States, his inaugural committee asked Fairey to create the official poster for the inauguration.³⁰ Fairey used the same illustration of Obama from his own Obama Hope, with the image of the U.S. Capitol and the White House in the background and the logo "Be The Change".³¹ Fairey received royalties on sales of the autographed limited edition posters.³² Later, art collectors obtained the original portrait of the Obama Hope collage Fairey first created and donated the work to the National Portrait Gallery of the Smithsonian Museum in Washington, D.C.³³

B. Disputes

Initially many believed that Fairey designed the Obama Hope image by referring to a Reuters' news photograph.³⁴ A Reuters' photographer even briefly acknowledged that the image was based on his photograph.³⁵ However, it turned out that the referenced photograph was taken by freelance photographer Mannie Garcia, taken while on assignment for the AP at the National Press Club in Washington, D.C. in April 2006.³⁶ Garcia took the photograph of Obama standing next to actor George Clooney at a panel discussion.³⁷

After Fairey admitted that he used the AP's photograph, the AP released a statement, in February 2009, claiming that it owned the photograph's copyright and asked Fairey for credit and compensation for his copyright infringement.³⁸ In response, Fairey filed a lawsuit against the AP seeking declaratory and injunctive relief.³⁹ Fairey claimed that his works did not infringe the

http://www.huffingtonpost.com/ben-arnon/how-the-obama-hope-poster_b_133874.html (last visited Feb. 15, 2010).

²⁸ See Arnon, *supra* note 27.

²⁹ Shepard Fairey, *The AP, Obama, & Referencing*, HUFFINGTON POST, Mar. 26, 2009, available at http://www.huffingtonpost.com/shepard-fairey/the-ap-obama-referencing_b_179562.html (last visited Oct. 26, 2010).

³⁰ Complaint, *supra* note 26, at 7. for Declaratory Judgment and Injunctive Relief at 7, *Fairey*, 2009 WL 319564, at *7 (S.D.N.Y. Feb. 9, 2009), available at <http://docs.justia.com/cases/federal/district-courts/new-york/nysdce/1:2009cv01123/340121/1>.

³¹ *Id.*

³² Edgers, *supra* note 26.

³³ National Portrait Gallery, Collections, Now on View: Portrait of President Barack Obama by Shepard Fairey, <http://www.npg.si.edu/collection/obamaportrait.html> (last visited Jan. 16, 2010).

³⁴ Tom Galish, Scene on the Road, Mystery Solved! The Obama Poster Photographer ID'd, http://blogs.phillynews.com/inquirer/sceneonroad/2009/01/mystery_solved_the_obama_poste.html (Jan. 14, 2009) (last visited Oct. 26, 2010).

³⁵ Reuters Blogs, Iconic Obama Poster Based on Reuters Photo – or Was It?, <http://blogs.reuters.com/photo/2009/01/15/iconic-obama-poster-based-on-reuters-photo>, (Jan. 15, 2009, 13:39 EST) (last visited Oct. 26, 2010).

³⁶ Galish, *supra* note 34.

³⁷ *Id.*; see Appendix *infra*.

³⁸ Hillel Italie, *AP Alleges Copyright Infringement of Obama Image*, ASSOCIATED PRESS, Feb. 4, 2009, http://www.ap.org/pages/about/whatsnew/wn_020409a.html; Paul Colford, *AP Statement on Shepard Fairey Lawsuit*, ASSOCIATED PRESS, Feb 9, 2009, http://www.ap.org/pages/about/pressreleases/pr_020409a.html.statement.

³⁹ Complaint for Declaratory Judgment and Injunctive Relief at 1, *Fairey v. Associated Press*, 2009 WL 319564, at *1 (S.D.N.Y. Feb. 9, 2009)(No. 09 Civ. 01123), available at <http://docs.justia.com/cases/federal/district-courts/new-york/nysdce/1:2009cv01123/340121/1>.

AP's copyright and that the works were protected by the fair use doctrine.⁴⁰ The AP filed its answers to Fairey's complaint, and asserted counterclaims that it owned a copyright registration in the Obama photograph⁴¹ and that Fairey's use of the photograph without the AP's consent violated the Copyright Act of 1976.⁴² The AP also argued that Fairey could not use the fair use doctrine because he wholly replicated the AP's Obama photograph for Fairey's own commercial benefit.⁴³ Fairey's answer to the AP's counterclaim raised the First Amendment as an affirmative defense.⁴⁴

After these initial pleadings, a factual conflict emerged over the visual reference of Fairey's Obama Hope. Fairey claimed that he found the photograph in which Senator Obama and George Clooney were both in the frame ("Clooney Photo") but that he used only Obama's image as a visual reference.⁴⁵ Fairey stated that he slightly adjusted Obama's eyes and rotated Obama's head, which made Obama in the Clooney Photo look a little out of sync with his Obama Hope image.⁴⁶ Alleging this was a deliberate misrepresentation, the AP asserted that a different Obama photograph was the source of Fairey's image.⁴⁷ The true image ("Obama Photo"),⁴⁸ according to the AP, did not include George Clooney. The AP contended that Fairey deliberately misidentified the Clooney Photo as the true source so that he could argue that he substantially changed the AP's original work.⁴⁹ In his answer to the AP's counterclaim, Fairey denied the accusation.⁵⁰

Freelance photographer Mannie Garcia also claimed that he owned the copyright in the Obama Photo, obtained a Federal Certificate of Registration,⁵¹ and filed a motion to join the suit

york/nysdce/1:2009cv01123/340121/1.

⁴⁰ *Id.* at 10-11.

⁴¹ Answer, Affirmative Defenses and Counterclaims of Defendant, Associated Press, at 25-26, *Fairey v. Associated Press*, 2009 WL 648762, at *25-26 (S.D.N.Y. Mar. 11, 2009)(No. 09 Civ. 01123), available at <http://docs.justia.com/cases/federal/district-courts/new-york/nysdce/1:2009cv01123/340121/13>.

⁴² *Id.* at 10.

⁴³ *Id.* at 13-14.

⁴⁴ Answer and Affirmative Defenses of Plaintiffs and Counterclaim Defendants at 20, *Fairey v. Associated Press*, 2009 WL 1116249, at *20 (S.D.N.Y. Apr. 14, 2009)(No. 09 Civ. 01123), available at <http://docs.justia.com/cases/federal/district-courts/new-york/nysdce/1:2009cv01123/340121/21/>.

⁴⁵ Complaint for Declaratory Judgment and Injunctive Relief at 1, *Fairey v. Associated Press*, 2009 WL 319564, at *1 (S.D.N.Y. Feb. 9, 2009)(No. 09 Civ. 01123), available at <http://docs.justia.com/cases/federal/district-courts/new-york/nysdce/1:2009cv01123/340121/1>; Interview by Terry Gross with Shepard Fairey, National Public Radio (Feb. 2009) [hereinafter *Fairey Interview*], transcript available at <http://www.npr.org/templates/transcript/transcript.php?storyId=101182453> (last visited Jan. 15, 2010).

⁴⁶ *Fairey Interview*, *supra* note 45.

⁴⁷ Answer, Affirmative Defenses and Counterclaims of Defendant, the Associated Press at 42-43, *Fairey v. Associated Press*, 2009 WL 648762, at *42-43 (S.D.N.Y. Mar. 11, 2009)(No. 09 Civ. 01123), available at <http://docs.justia.com/cases/federal/district-courts/new-york/nysdce/1:2009cv01123/340121/13>.

⁴⁸ See Appendix.

⁴⁹ Answer, Affirmative Defenses and Counterclaims, *supra* note 41, at 42-43. Answer, Affirmative Defenses and Counterclaims of Defendant, the Associated Press at 42-43, *Fairey*, 2009 WL 648762, at *42-43 (S.D.N.Y. Mar. 11, 2009).

⁵⁰ Answer and Affirmative Defenses of Plaintiffs and Counterclaim Defendants at 14, *Fairey v. Associated Press*, 2009 WL 1116249, at *14 (S.D.N.Y. Apr. 14, 2009)(No. 09 Civ. 01123), available at <http://docs.justia.com/cases/federal/district-courts/new-york/nysdce/1:2009cv01123/340121/21/>.

⁵¹ Memorandum of Law in Support of Intervenor Mannie Garcia's Motion to Intervene at 4, *Fairey v. Associated Press*, 2009 WL 2142921, at *4 (S.D.N.Y. July 9, 2009)(No. 09 Civ. 01123), available at

as a defendant.⁵² In addition, Garcia answered Fairey's complaint and asserted counterclaims against Fairey and cross-claims against the AP.⁵³ Garcia sought compensation for Fairey's infringement of the copyright that Garcia held in the registered Obama Photo.⁵⁴ He also claimed that he was not an employee of the AP and that he did not assign his copyrights in the photographs to the AP.⁵⁵

In another twist, Fairey filed a motion to amend his complaint regarding the identity of the Obama photograph he used in October 2009.⁵⁶ Fairey admitted that he was "mistaken" about the photograph he used and that he "attempt[ed] to delete the electronic files he had used in creating the illustration" of his Obama Hope image.⁵⁷ The real photograph he used as a visual reference was not the Clooney Photo, but the Obama Photo (without Clooney) as the AP claimed.⁵⁸ On his OBEY website, Fairey wrote that he discovered his mistake early on in this legal dispute and that he attempted to conceal the fact that he submitted false images.⁵⁹ However, in its answer to Fairey's amended complaint, the AP attacked the word "mistake" that Fairey emphasized, and suggested that it was another lie to cover up his initial lie and doubted any genuine mistake.⁶⁰

In November 2009, District Judge Alvin Hellerstein permitted Fairey to switch lawyers despite the AP's objection.⁶¹ It is reported that Judge Hellerstein "called Fairey's acknowledged wrongdoing a 'serious transgression,' but also said [Hellerstein] wanted 'this case to be decided on the merits.'"⁶² In August 2010, jury selection and trial opening statements were set for March 21, 2011.⁶³ Pursuant to Fairey's claims stated above, this article will consider whether Fairey's Obama Hope infringed the AP's copyright, whether the Obama Hope is protected by the fair use

<http://docs.justia.com/cases/federal/district-courts/new-york/nysdce/1:2009cv01123/340121/28>.

⁵² *Id.* at 1.

⁵³ Answer, Affirmative Defenses, Counterclaims and Cross Claims of Defendant-Intervenor Mannie Garcia at 1, *Fairey v. Associated Press*, 2009 WL 2350883, at *1 (S.D.N.Y. July 23, 2009)(No. 09 Civ. 01123), *available at* <http://docs.justia.com/cases/federal/district-courts/new-york/nysdce/1:2009cv01123/340121/33>.

⁵⁴ *Id.* at 16-18.

⁵⁵ *Id.* at 9-10.

⁵⁶ Motion to Amend Pleadings at 2-3, *Fairey v. Associated Press*, No. 09 CIV 01123 (S.D.N.Y. October 16, 2009)(No. 09 Civ. 01123), <http://docs.justia.com/cases/federal/district-courts/new-york/nysdce/1:2009cv01123/340121/41>.

⁵⁷ *Id.* at 2.

⁵⁸ *Id.*

⁵⁹ Shepard Fairey, *Statement on Associated Press Fair Use Case*, OBEY GIANT, Oct. 16, 2009, <http://obeygiant.com/headlines/associated-press-fair-use-case> (last visited Oct. 26, 2009)*supra* note 13.

⁶⁰ The Associated Press's First Amended Answer, Affirmative Defenses and Counterclaims at 55-56, *Fairey v. Associated Press*, 2009 WL 3991104, at *55-56 (S.D.N.Y. Nov. 12, 2009)(No. 09 Civ. 01123), *available at* <http://docs.justia.com/cases/federal/district-courts/new-york/nysdce/1:2009cv01123/340121/54/>.

⁶¹ Hillel Italie, *Judge: 'HOPE' Artist Can Switch Lawyers in AP Suit*, ASSOCIATED PRESS, Nov. 10, 2009, http://www.ap.org/pages/about/whatsnew/wn_111009b.html (noting new attorneys included director of the Berkman Center for Internet and Society at Harvard University); *see* Case Management Order at 2, *Fairey v. Associated Press*, No. 09 CIV 01123 (S.D.N.Y. Nov. 23, 2009)(No. 09 Civ. 01123), <http://docs.justia.com/cases/federal/district-courts/new-york/nysdce/1:2009cv01123/340121/61/> (noting Case Management Plan).

⁶² Italie, *supra* note 61 (noting that Judge Hellerstein reserved motions to sanction until the case was resolved); *see* Paul Colford, *AP Statement: AP Pleased the Court Considers Spoilation and Fabrication of Evidence Serious*, ASSOCIATED PRESS, Nov. 10, 2009, http://www.ap.org/pages/about/pressreleases/wn_111009c.html.

⁶³ Press Releases, *Trial Date Set in AP-Artist Dispute in NYC*, ASSOCIATED PRESS, Aug. 23, 2010, http://www.ap.org/pages/about/whatsnew/wn_082310a.html.

doctrine, and whether the First Amendment applies to Fairey's case. Moreover, although Fairey's bad faith, and the relationship between the AP and Garcia might have significant impact on the trial, this article will focus on the copyright dispute between Fairey and the AP on the merits.

II. Copyright and Idea/Expression Dichotomy

A. *The Copyright Clause and the Copyright Act*

The Copyright Clause (Article I, Section 8) of the U.S. Constitution provides that Congress has the enumerated power to "promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."⁶⁴ Acting on this power, the first Congress passed a bill to protect copyright, which President George Washington signed as the Copyright Act of 1790.⁶⁵ Since then, Congress has amended and revised the statutes several times.⁶⁶ The Copyright Act of 1976 is the last omnibus revision, which is still the general codification today.⁶⁷

B. *Copyrightable Works*

1. Idea/Expression Dichotomy

Section 106 of the Copyright Act of 1976 provides a copyright owner with a bundle of exclusive rights such as the right "to prepare derivative works based upon the copyrighted work" and the right "to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending."⁶⁸ However, under section 102, such copyright protection for an original work is limited to "tangible medium of expression," and does not extend to "any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work."⁶⁹ This idea/expression dichotomy protects an original author's expression, while permitting others to freely use the ideas and information conveyed by the original work.⁷⁰ For instance, the idea of a boy who finds out he is a wizard and attends a school of wizards and witches where he faces a dark wizard who killed his parents, might not be protected by the Act. On the other hand, using substantial amount of "direct quotations or paraphrases, plot details, or summaries of scenes" from the Harry Potter books could be considered copying of the original author's protected expression.⁷¹

2. Originality Requirement

Not every expression is copyrightable. The Supreme Court in the late nineteenth century

⁶⁴ U.S. CONST. art. I, § 8, cl. 8.

⁶⁵ 1 WILLIAM F. PATRY, PATRY ON COPYRIGHT § 1:19 (2009).

⁶⁶ 1-OV MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § Overview (Matthew Bender 2009).

⁶⁷ 1 PATRY, *supra* note 65, § 1:71.

⁶⁸ 17 U.S.C. § 106 (2002).

⁶⁹ 17 U.S.C. § 102 (1990).

⁷⁰ Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 349-50 (1991).

⁷¹ Warner Bros. Entm't Inc. v. RDR Books, 575 F. Supp. 2d 513, 535 (S.D.N.Y. 2008).

concluded that originality was not only a statutory but also a constitutional requirement.⁷² Under the Copyright Act, for the expression of the work to be copyrightable, an author's expression has to be "original."⁷³ The U.S. Supreme Court in *Feist Publications v. Rural Telephone Service* held that "[t]he *sine qua non* of copyright is originality."⁷⁴ "Original," in terms of copyright, means that "the work was independently created by the author (as opposed to copied [sic] from other works), and that it possesses at least some minimal degree of creativity."⁷⁵ While the "requisite level of creativity is extremely low" and even a slight amount of creativity is sufficient, "[o]riginality does not signify novelty" and fortuitous resemblance is still original.⁷⁶

Although facts and ideas are not protected as original works, factual compilations may be sufficiently original to obtain protection.⁷⁷ Indeed, section 103 of the Copyright Act provides that the subject matter of copyright includes compilations.⁷⁸ A "compilation" is defined as "a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship."⁷⁹ Thus, the choices as to selection and arrangement could be original and copyrightable if they are independently compiled and minimally creative.⁸⁰

However, because the facts themselves are not original, the copyright in such compilations is considered "thin."⁸¹ For example, Plaintiff telephone service company in *Feist* published a telephone directory by listing names and telephone numbers of the subscribers in alphabetical order, while Defendant publisher used some of that list and also added the street addresses.⁸² The Court found that the telephone company's directory was a sort of "selection," but that merely alphabetizing the names is not original because it lacked the creativity "necessary to transform mere selection into copyrightable expression."⁸³ This application of a "thin" copyright is likely to be a key to the Obama Hope case.

C. Copyright of Photographs

Since the Copyright Act of March 3, 1865,⁸⁴ photographs have enjoyed copyright protection.⁸⁵ In 1884, the Supreme Court held in *Burrow-Giles Lithographic Co. v. Sarony* that

⁷² *Id.* at 346-47 (noting that definition of the terms "authors" and "writings" in the Copyright Clause presupposes a degree of originality) (citing Trade-Mark Cases, 100 U.S. 82, 84 (1879) and *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884)).

⁷³ 17 U.S.C. § 102(a) (1990) ("[c]opyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression").

⁷⁴ *Feist*, 499 U.S. at 345 (emphasis original).

⁷⁵ *Id.*

⁷⁶ *Id.*

⁷⁷ *Id.* at 348.

⁷⁸ 17 U.S.C. § 103 (1976).

⁷⁹ 17 U.S.C. § 101 (2005).

⁸⁰ *Feist, Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348 (1991).

⁸¹ *Id.* at 349.

⁸² *Id.* at 342-44.

⁸³ *Id.* at 362-63.

⁸⁴ Act of Mar. 3, 1865, ch.126, 13 Stat. 540, 540 (1865); see PATRY, *supra* note 55, § 1:31 (noting that "Civil War photographs . . . had a dramatic effect on the public" before Congress passed the bill).

⁸⁵ *Ets-Hokin v. SKYY Spirits, Inc.*, 225 F.3d 1068, 1074 (9th Cir. 2000).

“the Constitution is broad enough to cover an act authorizing copyright of photographs, so far as they are representatives of original intellectual conceptions of the author.”⁸⁶ There, the Court found a photograph of Oscar Wilde as original.⁸⁷ The photographer’s artistic choices rendering the photograph copyrightable included the posing of Wilde and arrangement of his costumes and accessories “so as to present graceful outlines”; the arrangement and disposition of light and shade; and the suggestion and evocation of the desired expression.⁸⁸ Moreover, a photograph’s likelihood of obtaining copyright protection is not affected by whether the photograph is used in “a museum, an art gallery, a mural, a magazine, or an advertisement.”⁸⁹

As discussed in Section B, the Supreme Court held in *Feist* that the requisite degree of creativity is “extremely low.”⁹⁰ Since the standard of originality for photographs is also low, almost any photograph can pass the originality test.⁹¹ The U.S. Court of Appeals for the Second Circuit, applied this lowered standard, ruling that “[e]lements of originality in a photograph may include posing the subjects, lighting, angle, selection of film and camera, evoking the desired expression, and almost any other variant involved.”⁹² Accordingly, news photographers, who have little control over the subject, could still satisfy this standard if they specifically chose the particular camera, adjusted camera’s angle, selected the right timing, and the like.

D. Standard of Review

To establish copyright infringement, Plaintiff authors must prove (1) the “ownership of a valid copyright” and (2) the alleged infringer’s “copying of constituent elements of the work” (3) that are original.⁹³ As for the first element, under section 410 of the Copyright Act, “the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright.”⁹⁴ However, the presumption of validity may be rebutted if, for example, the work is not original.⁹⁵ Note that although “such registration is not a condition of copyright protection,”⁹⁶ the Copyright Act incentivizes copyright owners to register with the Copyright Office especially because “no civil action for infringement of the copyright in any United States work shall be instituted until preregistration or registration of the copyright claim has been made.”⁹⁷

Turning to the second element, the authors must show that the alleged infringers “actually copied” the original author’s works.⁹⁸ Actual copying “may be established by direct or indirect evidence.”⁹⁹ In addition to actual copying, the authors must demonstrate that there is “substantial

⁸⁶ *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884).

⁸⁷ *Id.* at 60.

⁸⁸ *Id.*

⁸⁹ *Ets-Hokin*, 225 F.3d at 1075.

⁹⁰ *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 346 (1991).

⁹¹ *Ets-Hokin*, 225 F.3d at 1076-77.

⁹² *Rogers v. Koons*, 960 F.2d 301, 307 (2d Cir. 1992).

⁹³ *See Boisson v. Banian, Ltd.*, 273 F.3d 262, 267 (2d Cir. 2001) (quoting *Feist*, 499 U.S. at 361-64).

⁹⁴ 17 U.S.C. § 410(c) (1976).

⁹⁵ *Folio Impressions, Inc. v. Byer California*, 937 F.2d 759, 763 (2d Cir. 1991).

⁹⁶ 17 U.S.C. § 408(a) (2005).

⁹⁷ 17 U.S.C. § 411(a) (2008); *see* U.S. Copyright Office, Copyright Basics, <http://www.copyright.gov/circs/circ1.pdf>.

⁹⁸ *Boisson*, 273 F.3d at 267-68.

⁹⁹ *Id.* at 267 (“[i]ndirect evidence may include proof of ‘access to the copyrighted work, similarities that are

similarity” between the protectable elements of his or her original works and the secondary works.¹⁰⁰ This requirement means that even when there is actual copying, “no legal consequences will follow from that fact unless the copying is substantial.”¹⁰¹ Although “actual” copying requires only that the infringing works copy something from the protected works, “actionable” copying (substantial similarity) requires that the copying be both qualitatively and quantitatively sufficient to support the legal conclusion of copyright infringement.¹⁰² “The qualitative component concerns the copying of expression,” while “quantitative component generally concerns the amount [and sometimes observability] of the copyrighted work that is copied.”¹⁰³

The Second Circuit admitted that determining such “substantial similarity” to prove copyright infringement, “presents one of the most difficult questions in copyright law, and one which is the least susceptible of helpful generalizations.”¹⁰⁴ Nonetheless, based on the Supreme Court’s analysis of “thin” originality in *Feist*, it seems clear that “more similarity is required when less protectible matter is at issue.”¹⁰⁵ There is no precise threshold or bright line for substantiality.¹⁰⁶ The test for substantial similarity varies by jurisdiction. For example, the Ninth Circuit recognizes that creative expression in the original work can receive only limited protection when the similarity between the copyrightable elements and the secondary works are de minimis.¹⁰⁷ Employing this sliding scale approach, the Ninth Circuit stated that “[w]hen the range of protectable and unauthorized expression is narrow, the appropriate standard for illicit copying is virtual identity.”¹⁰⁸

More importantly, as the federal court that covers New York, the Second Circuit generally determines substantial similarity by using the ordinary observer test: “whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work.”¹⁰⁹ Yet the Second Circuit also relies on the “thin” analysis.¹¹⁰ When the court

probative of copying between the works, and expert testimony.” (citation omitted)).

¹⁰⁰ *Id.* at 267-68; see *Laureyssens v. Idea Group, Inc.*, 964 F.2d 131, 140 (2d Cir. 1992) (“[i]f actual copying is established, a plaintiff must then show that the copying amounts to an improper appropriation by demonstrating that substantial similarity to protected material exists between the two works”).

¹⁰¹ *NIMMER*, *supra* note 66, § 13.03[A].

¹⁰² *Ringgold v. Black Entm’t Television, Inc.*, 126 F.3d 70, 75 (2d Cir. 1997).

¹⁰³ *Id.*

¹⁰⁴ *Warner Bros., Inc. v. Am. Broad. Cos.*, 654 F.2d 204, 208 (2d Cir. 1981) (citation omitted).

¹⁰⁵ *NIMMER*, *supra* note 66, § 13.03[A].

¹⁰⁶ *Ringgold*, 126 F.3d at 75-76.

¹⁰⁷ *Apple Computer v. Microsoft Corp.*, 35 F.3d 1435, 1439 (9th Cir. 1994).

¹⁰⁸ *Id.* The Tenth Circuit Court similarly held that “if substantial similarity is the normal measure required to demonstrate infringement, ‘supersubstantial’ similarity must pertain when dealing with ‘thin’ works.” *Jacobsen v. Deseret Book Co.*, 287 F.3d 936, 943 (10th Cir. 2002).

¹⁰⁹ *Rogers v. Koons*, 960 F.2d at 301, 307 (2d Cir. 1992) (quoting *Ideal Toy Corp. v. Fab-Lu Ltd.*, 360 F.2d 1021, 1022 (2d Cir. 1966)). The court also described the test in another way, asking whether “the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same.” *Id.* (quoting *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960)).

¹¹⁰ See, e.g., *Beaudin v. Ben & Jerry's Homemade, Inc.*, 95 F.3d 1, 2 (2d Cir. 1996) (“[w]here the quantum of originality is slight and the resulting copyright is ‘thin,’ infringement will be established only by very close copying because the majority of the work is unprotectable.”); *Key Publ’ns, Inc. v. Chinatown Today Publ’g. Enters., Inc.*, 945 F.2d 509, 514 (2d Cir. 1991) (“[t]he appropriate inquiry is narrowed in the case of a compilation. . . . and a finding of substantial similarity or even absolute identity as to matters in the public domain will not suffice to prove

decided a case involving copyright infringement of carpet designs, the court stated that “[t]here may arise visual-arts cases in which the ‘selection, coordination, and arrangement’ . . . is so aesthetically complex and sophisticated that the copyright is more than ‘thin.’”¹¹¹ In that case, however, since Plaintiff carpet designer used public domain images (i.e. not under copyright protection) for his carpet,¹¹² the court held that “the selective deletion of elements from the [public domain image], while idiosyncratic, was relatively simple and supports only a thin copyright.”¹¹³ But the holding was not that simple. Although the district court decided there was no infringement because of the original design’s thin copyright and the significant change made by Defendant’s secondary design,¹¹⁴ the Second Circuit vacated the judgment, reasoning that Defendant, another carpet designer, “copied the original and ‘particular’ or ‘same’ selections embodied” in the original public domain carpet design.¹¹⁵

As for the third element (material taken is original), “Plaintiffs’ certificates of registration constitute prima facie evidence of the validity not only of their copyrights, but also of the originality of their works.”¹¹⁶ In addition, as discussed above, the threshold for originality is very low. However, courts have clarified that only a particular expression of an idea is copyrightable and not every element of copyrighted work is protected.¹¹⁷ “[A]n element within a work may be unprotectable even if other elements, or the work as a whole” are original and protected.¹¹⁸

E. Application to the Obama Hope Case

1. The AP Owns Valid Copyright in the Obama Photo

Despite their legal dispute, this article will assume that the AP hired Garcia to take news photographs in 2006, and that Garcia assigned the copyright registration in the Obama Photo to the AP. Thus, the first issue is whether the AP is a valid copyright owner of the Obama Photo. Since the AP holds a copyright registration in the Obama Photo,¹¹⁹ it presumptively owns a valid copyright of the photograph. However, registration of work does not guarantee ownership of a valid copyright and the presumption may be rebutted if the Obama Photo is not original.¹²⁰

2. The Obama Photo Is Original but the Copyright Protection Is “Thin”

As discussed above, registering the photograph presumptively indicates a photograph’s originality. However, the AP could claim originality in the Obama Photo even without

infringement”).

¹¹¹ *Tufenkian Imp./Exp. Ventures, Inc. v. Einstein Moomjy, Inc.*, 338 F.3d 127, 136 n.13 (2d Cir. 2003).

¹¹² *Id.* at 129.

¹¹³ *Id.* at 136 n.13.

¹¹⁴ *Tufenkian Imp./Exp. Ventures, Inc. v. Einstein Moomjy, Inc.*, 237 F. Supp. 2d 376, 384, 388 (S.D.N.Y. 2002), vacated, 338 F.3d 127 (2d Cir. 2003).

¹¹⁵ *Tufenkian*, 338 F.3d at 136-37.

¹¹⁶ *Boisson v. Baniar, Ltd.*, 273 F.3d 262, 268 (2d Cir. 2001).

¹¹⁷ *Id.*

¹¹⁸ *Id.* at 268-69.

¹¹⁹ Answer, Affirmative Defenses and Counterclaims of Defendant, the Associated Press at 25-26, *Fairey v. Associated Press*, WL 648762, at *25-26 (S.D.N.Y. Mar. 11, 2009)(No. 09 Civ. 01123), available at <http://docs.justia.com/cases/federal/district-courts/new-york/nysdce/1:2009cv01123/340121/13>.

¹²⁰ See *Boisson*, 273 F.3d at 267-68.

registration. Garcia explained that while he was on the AP's assignment to cover George Clooney at the National Press Club, Garcia waited for Senator Obama "to turn his head a little bit . . . patiently making a few pictures here and there . . . looking for a moment" that Garcia thought was just right.¹²¹ Garcia expressed the right moment as: "'...and then it happened. Boom, I was there. I was ready.'"¹²² Of course, Garcia did not pose Obama, choose the lighting, or arrange the background, but he decided the timing, chose to focus on Obama rather than Clooney, selected the particular camera and lens, and finally chose to submit that particular picture out of the many images he took that night.¹²³ The U.S. District Court for the Southern District of New York ruled that selection of film, camera, lens, and filter would not alone make the photograph original.¹²⁴ Nonetheless, considering the low requisite level for originality, Garcia's Obama Photo is likely original.¹²⁵

However, the entire Obama Photo may not be necessarily protected.¹²⁶ Here kicks in the "thin" analysis adopted by the Supreme Court in *Feist*. There are several reasons to believe that the Obama Photo is like the telephone directory compilation where the protectable expression is limited. First, as an elected official, Senator Obama was certainly a public figure and not an exclusive image for one particular entity, like the AP. Obama was rather a fact and a familiar idea, analogous to a telephone number. In addition, news reporting is very factual.

Second, as seen in Part I, there was initial confusion over Fairey's referenced photograph. Even Garcia conceded that he did not recognize his own photograph,¹²⁷ implying that anybody could have produced a similar image and thus the "merger doctrine" may be applicable. "Under the merger doctrine, courts will not protect a copyrighted work from infringement if the idea underlying the copyrighted work can be expressed in only one way, lest there be a monopoly on the underlying idea."¹²⁸ The Second Circuit prefers that the merger doctrine applies "in determining whether actionable infringement has occurred, rather than whether a copyright is valid."¹²⁹

Third, although the low originality threshold will help the Obama Photo attain protection, Garcia's limited control over the subject may make the originality of the Photo "thin." Under the circumstances of the panel discussion, it is clear that only Senator Obama had control over his expression, conveying his image of hope, wisdom, future, and leadership, which Fairey later

¹²¹ Interview by Terry Gross with Mannie Garcia, National Public Radio (Feb. 2009) [hereinafter *Garcia Interview*], transcript available at <http://www.npr.org/templates/transcript/transcript.php?storyId=101184444> (last visited Jan. 15, 2010).

¹²² *Id.*

¹²³ Answer, Affirmative Defenses, Counterclaims and Cross Claims of Defendant-Intervenor Mannie Garcia at 14, *Fairey v. Associated Press*, 2009 WL 2350883, at *14 (S.D.N.Y. July 23, 2009)(No. 09 Civ. 01123), available at <http://docs.justia.com/cases/federal/district-courts/new-york/nysdce/1:2009cv01123/340121/33>.

¹²⁴ *Mannion v. Coors Brewing Co.*, 377 F. Supp. 2d 444, 451 (S.D.N.Y. 2005).

¹²⁵ *Ets-Hokin v. SKYY Spirits, Inc.*, 225 F.3d 1068, 1076-77 (9th Cir. 2000).

¹²⁶ See *Boisson v. Banian, Ltd.*, 273 F.3d 262, 268 (2d Cir. 2001).

¹²⁷ *Garcia Interview*, *supra* note 121.

¹²⁸ See *Ets-Hokin*, 225 F.3d at 1082.

¹²⁹ *Kregos v. Associated Press*, 937 F.2d 700, 705 (2d Cir. 1991); *Cf. Hart v. Dan Chase Taxidermy Supply Co.*, 86 F.3d 320, 322 (2d Cir. 1996) ("[t]here may be highly unusual cases in which virtually all of an idea's possible expressions are before a district court at the copyrightability stage. In such rare cases it may perhaps be possible to determine the merger issue while deciding whether a given expression is copyrightable").

emphasized in his Obama Hope image.¹³⁰ Garcia's protected expression in the Obama Photo seems limited to an angle of Obama's face, lighting and focus of the entire image, and the ratio of the photograph. Accordingly, thin originality of the Obama Photo will likely leave many elements of the photograph unprotected.

3. Comparison with *Rogers v. Koons*

Fairey's confession that he "actually" copied the AP's Obama Photo for his Obama Hope¹³¹ raises the next question on whether his copying is "actionable." As stated above, this answer depends on whether there is substantial similarity between the protectable elements of the Obama Photo and the Obama Hope.¹³² Since the copyrightable expression in the Obama Photo is very "thin," the similarity may need to be "supersubstantial," if not identical.¹³³

This argument explains why the AP and Fairey battled over the reference of Fairey's Obama Hope image despite seemingly little difference between the Obama Photo and the Clooney Photo. In its answer to Fairey's amended counterclaim, the AP denounced that "by claiming to have used the Clooney Photo, Fairey was attempting to argue that he made more changes to the AP's copyrighted image than he actually did . . . and that he took a less substantial portion of the original than he did in reality."¹³⁴ If Fairey had really used Obama's image cut out of the Clooney Photo and adjusted Obama's eyes, the similarity between the original and secondary images would be less substantial. On the other hand, if a lay person compares the Obama Photo to the Obama Hope poster, that lay person may well find the two works substantially similar as a matter of fact.¹³⁵

However, as a matter of law, Fairey can still rely on the idea/expression dichotomy through the "thin" approach from *Feist*. His claim may receive support by distinguishing this case from a similar appropriation art case, *Rogers v. Koons*, in which the Second Circuit held that there was copyright infringement.¹³⁶ In that case, Plaintiff, professional photographer, took a photograph of a married couple with eight puppies ("Puppies"),¹³⁷ based on which Defendant appropriation artist then created a sculpture ("String of Puppies").¹³⁸ The court found that Puppies was original, that Plaintiff owned a copyright in Puppies, that Defendant actually copied the original work, and that there was substantial similarity between the two works.¹³⁹

¹³⁰ See *Fairey Interview*, *supra* note 45.

¹³¹ Motion to Amend Pleadings at 2-4, *Fairey v. Associated Press*, No. 09 CIV 01123, (S.D.N.Y. October 16, 2009)(No. 09 CIV 01123), <http://docs.justia.com/cases/federal/district-courts/new-york/nysdce/1:2009cv01123/340121/41>.

¹³² See *Boisson v. Banian, Ltd.*, 273 F.3d 262, 267-68 (2d Cir. 2001).

¹³³ See *Jacobsen v. Deseret Book Co.*, 287 F.3d 936, 943 (10th Cir. 2002); *Apple Computer v. Microsoft Corp.*, 35 F.3d 1435, 1439 (9th Cir. 1994).

¹³⁴ Notice of Motion of the Associated Press's Motion for Leave to Amend Answer, Affirmative Defenses and Counterclaims Pursuant to Rule 15(a) and Rule 21 of the Federal Rules of Civil Procedure at 56, *Fairey v. Associated Press*, No. 09 CIV 01123 (S.D.N.Y. October 20, 2009)(No. 09 CIV 01123), <http://docs.justia.com/cases/federal/district-courts/new-york/nysdce/1:2009cv01123/340121/42>.

¹³⁵ See Appendix *infra*.

¹³⁶ *Rogers v. Koons*, 960 F.2d 301, 308. (2d Cir. 1992).

¹³⁷ *Id.* at 303-04.

¹³⁸ *Id.* at 304-05.

¹³⁹ *Id.* at 307-08.

Superficially, it seems this decision could have somewhat negative implications for Fairey, but important distinctions could strengthen Fairey's argument.

First, Defendant in *Rogers* created a sculpture by "faithfully" imitating Plaintiff's photograph expression "as per photo."¹⁴⁰ Although Fairey may also have closely followed the expressions in the Obama Photo, the appropriation seems justified given the photo's minimal originality, in which the expression almost "merges" with the photograph's idea of Senator Obama.¹⁴¹ Since there were only a few ways to express the photograph's ideas, Fairey could hardly modify the original expression. Second, the original Puppies photograph in *Rogers* depicting a married couple sitting on a bench and holding eight new German Shepherd puppies, seems to have "thick" originality because of the creative and unique expression.¹⁴² This protection may be supported by the fact that somebody familiar with the picture immediately recognized it as a copy.¹⁴³ On the contrary, Garcia himself did not realize that his own photograph was used even when the Obama Hope image was everywhere during the presidential election season.¹⁴⁴ Third, when Plaintiff in *Rogers* took the Puppies photograph, he "drew on his years of artistic development" and controlled the subjects.¹⁴⁵ Garcia may have used his artistic skills when he took the Obama Photo and selected one of the photographs to submit to the AP, but his use of artistic leeway was very limited. Garcia described the restricted and forced condition in which he took photographs of Obama, stating, "it was at the Press Club, and there's nothing glorious about this room. It's a very tiny, cramped room, and we were crammed in there, and I'm literally on my knees in front of the table."¹⁴⁶ It is reasonable to believe that Obama entirely controlled his own expression and the photographers could not have taken the photographs much differently.

4. Similarity Between Obama Photo and Obama Hope Is not Substantial

In comparing the *Rogers* case with the *Fairey* case, the court should hold that there is no substantial similarity between the Obama Photo and the Obama Hope. Although Fairey used the entire Obama Photo, he made it into a collage by playing with colors of red, white, and blue; eliminating facial lines; creating geometric shapes; and adding bold "HOPE" lettering.¹⁴⁷ The sliding scale test would lead a court to find that the Obama Hope is sufficiently distinct from the Obama Photo because the original copyrighted expression is thin. Under the ordinary observer test adopted by the Second Circuit, in contrasting the Obama Hope image with the protectable elements of the Obama Photo, it is likely that an average observer -- even the original photographer himself -- would not recognize the Obama Hope as appropriated from the copyrighted Obama Photo.¹⁴⁸ Accordingly, Fairey should succeed in his argument that there is

¹⁴⁰ *Id.* at 307.

¹⁴¹ See *Ets-Hokin v. SKYY Spirits, Inc.*, 225 F.3d 1068, 1082 (9th Cir. 2000).

¹⁴² See Appendix *infra*.

¹⁴³ *Rogers*, 960 F.2d at 305.

¹⁴⁴ *Garcia Interview*, *supra* note 121.

¹⁴⁵ See *Rogers*, 960 F.2d at 304 ("[h]e selected the light, the location, the bench on which the [couple] is seated and the arrangement of the small dogs. He also made creative judgments concerning technical matters with his camera and the use of natural light.").

¹⁴⁶ *Garcia Interview*, *supra* note 121.

¹⁴⁷ William Booth, *Making Political Art*, WASH. POST, May 19, 2008, at M06.

¹⁴⁸ See *Rogers*, 960 F.2d at 307-08.

no copyright infringement.

III. The Copyright Act and the Fair Use Doctrine

A. Fair Use Defense

Even where a court holds that there is substantial similarity between original and secondary works, the statutory fair use defense “allows the public to use not only facts and ideas contained in a copyrighted work, but also expression itself in certain circumstances.”¹⁴⁹ Section 107 of the Copyright Act sets forth four factors for consideration in fair use:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.¹⁵⁰

The preamble to the section enumerates some examples of potential fair use “such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research.”¹⁵¹

“From the infancy of copyright protection,” before the fair use doctrine was codified as an affirmative defense in the Copyright Act of 1976, “some opportunity for fair use of copyrighted materials has been thought necessary to fulfill copyright’s very purpose”¹⁵² under the Copyright Clause in order “to promote the Progress of Science and useful Arts.”¹⁵³ Congress intended that the traditional fair use doctrine both permit and require courts to avoid rigid application of copyright protection when the black letter law stifles the very purpose that the law was designed to foster.¹⁵⁴ Moreover, section 107 does not attempt to define fair use or provide a rule that may automatically determine what particular use is deemed fair.¹⁵⁵ Without any bright-line rules under the statute, courts must determine fair use on a case-by-case basis, considering the totality of circumstances.¹⁵⁶ One commentator observed that “each of the [four] factors is defined in only the most general terms, so that courts are left with almost complete discretion in determining whether any given factor is present in any particular case.”¹⁵⁷

¹⁴⁹ *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003).

¹⁵⁰ 17 U.S.C. § 107 (1992).

¹⁵¹ *Id.*

¹⁵² *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 575 (1994).

¹⁵³ U.S. CONST. art. 1, § 8, cl. 8.

¹⁵⁴ *Campbell*, 510 U.S. at 577.

¹⁵⁵ NIMMER, *supra* note 66, § 13.05[A].

¹⁵⁶ *Campbell*, 510 U.S. at 577-78. *See Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 561 (1985) (“no generally applicable definition is possible, and each case raising the question must be decided on its own facts”).

¹⁵⁷ 4-13 NIMMER, *supra* note 66, § 13.05[A].

B. Earlier Use of Fair Use

Until the early 1990s, it seems that courts emphasized economic aspects when judges applied the fair use doctrine. The Supreme Court in *Sony Corp. of America v. Universal City Studios, Inc.* held that “every commercial use of copyrighted material is presumptively an unfair exploitation of the monopoly privilege that belongs to the owner of the copyright.”¹⁵⁸ The Court in *Harper & Row, Publishers, Inc. v. Nation Enterprises* followed the emphasis on economic aspect of *Sony Corp.*, stating that the fourth factor, the effect of the use upon the potential market, was “undoubtedly the single most important element of fair use.”¹⁵⁹

In *Harper*, Defendant publisher published a short article, using portions of Plaintiff’s unpublished manuscript of an autobiography written by former President Gerald Ford.¹⁶⁰ As a result, Plaintiff publisher lost out on a prior agreement with Time Magazine for sale of the memoir’s exclusive publication rights.¹⁶¹ The Second Circuit held that Defendant’s publication was fair use partly because “the purpose of the article was news reporting” under the first factor.¹⁶² The Supreme Court reversed. Although the Court acknowledged that Defendant’s news reporting purpose was one of the examples enumerated in section 107,¹⁶³ the Court stressed that “[Defendant’s] use had not merely the incidental effect but the *intended purpose* of supplanting the copyright holder’s commercially valuable right of first publication.”¹⁶⁴

Emphasis among the four fair use factors apparently shifted soon after Judge Pierre Leval of the U.S. District Court for the Southern District of New York wrote an influential article for the Harvard Law Review in 1990.¹⁶⁵ As discussed below, his most important contribution was introduction of “transformative use.” In short, for secondary use to be considered fair, it is crucial that the secondary user adds new meaning and different purpose to the original work.

C. Recent Use of Fair Use and Courts’ Application

1. First Factor - The Purpose and Character of the Secondary Use

In considering the first factor of fair use (the purpose and character of the secondary use), courts “must weigh the strength of the secondary user’s justification against the copyright owner’s interest.”¹⁶⁶ Specifically, Judge Leval pointed out that the key question to such justification would be “whether, and to what extent, the challenged use is transformative.”¹⁶⁷ The “transformative use” must employ the original work “in a different manner or for a different

¹⁵⁸ *Harper*, 471 U.S. at 562.

¹⁵⁹ *Id.* at 566-67.

¹⁶⁰ *Id.* at 542.

¹⁶¹ *Id.*

¹⁶² *Id.* at 545.

¹⁶³ *Id.* at 561.

¹⁶⁴ *Id.* at 562 (emphasis in original).

¹⁶⁵ See 1 ALEXANDER LINDEY & MICHAEL LANDAU, LINDEY ON ENTERTAINMENT, PUBLISHING AND THE ARTS § 1:25 (3d ed. 2009); see also NIMMER, *supra* note 66, § 13.05[1][b].

¹⁶⁶ Pierre Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1111 (1990).

¹⁶⁷ *Id.*

purpose from the original.”¹⁶⁸ Thus, as Judge Leval wrote, the secondary work is unlikely transformative if it “merely repackages or republishes the original.”¹⁶⁹ On the other hand, if the secondary work adds value by using the original work “as raw material, transformed in the creation of new information, new aesthetics, new insights and understandings[,] this is the very type of activity that the fair use doctrine intends to protect for the enrichment of society.”¹⁷⁰

Adopting the transformative use doctrine in *Campbell v. Acuff-Rose Music*, the Supreme Court framed the central purpose of the inquiry under the first factor as determining “whether the new work merely ‘supersedes the objects’ of the original creation . . . or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message.”¹⁷¹ Judge Leval conceded that transformation does not guarantee success in winning fair use arguments.¹⁷² In this regard, while the Supreme Court held that “transformative use is not absolutely necessary,” it concluded that “the goal of copyright, to promote science and the arts, is generally furthered by the creation of transformative works.”¹⁷³ The Court further emphasized the importance of transformation, ruling that “the more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use.”¹⁷⁴

In *Campbell*, rap music group 2 Live Crew wrote a song, “Pretty Woman,” which was a parody of Roy Orbison’s original song “Oh, Pretty Woman.”¹⁷⁵ The Supreme Court reversed the judgment for Plaintiff copyright holder, reasoning that the Sixth Circuit erred in applying the old presumption that commercial use of copyrighted material was unfair.¹⁷⁶ In overruling the decision, the Court stated that many non-infringing activities would constitute commercial use, including even those illustrated in section 107 of the Copyright Act, and that “the mere fact that a use is educational and not for profit does not insulate it from a finding of infringement, any more than the commercial character of a use bars a finding of fairness.”¹⁷⁷ Then the Court held that Defendant’s *Pretty Woman* was a transformative work since it could reasonably perceive the parody song as commenting on and criticizing the original work.¹⁷⁸

After the Supreme Court adopted transformative use in *Campbell*, the Second Circuit started emphasizing transformative use when determining the first factor of fair use.¹⁷⁹ The court ruled that the first factor is the “heart” of fair use¹⁸⁰ and it stressed the importance of transformative nature of the work for this factor.¹⁸¹ Specifically, the court found a transformative use when Defendant used the original work as raw material “in the furtherance of distinct

¹⁶⁸ *Id.*

¹⁶⁹ *Id.*

¹⁷⁰ *Id.*

¹⁷¹ *Campbell v. Acuff-Rose Music*, 510 U.S. at 569, 579. (1994).

¹⁷² Leval, *supra* note 166, at 1111-12.

¹⁷³ *Campbell*, 510 U.S. at 579.

¹⁷⁴ *Id.*

¹⁷⁵ *Id.* at 572.

¹⁷⁶ *Id.* at 583-84.

¹⁷⁷ *Id.* at 584.

¹⁷⁸ *Id.* at 583.

¹⁷⁹ *Blanch v. Koons*, 467 F.3d 244, 251 (2d Cir. 2006).

¹⁸⁰ *Davis v. Gap, Inc.*, 246 F.3d 152, 174 (2d Cir. 2001).

¹⁸¹ *Bill Graham Archives v. Dorling-Kindersley Ltd.*, 448 F.3d 605, 608 (2d Cir. 2006).

creative or communicative objectives.”¹⁸² On the other hand, the Second Circuit “declined to find a transformative use when the defendant has done no more than find a new way to exploit the creative virtues of the original work.”¹⁸³

Also it may be important to note that although a court might weigh-in Defendant’s “bad faith,” it is not dispositive for determining fair use.¹⁸⁴ The Second Circuit in *NXIVM Corp. v. Ross Institute* thoroughly explored the question of bad faith in a fair use argument and concluded that “even if the bad faith subfactor weighs in plaintiffs’ favor, the first factor still favors defendants in light of the transformative nature of the secondary use as criticism.”¹⁸⁵ This ruling might at least ease Fairey’s admission about his “mistake.”

2. Second Factor - The Nature of the Copyrighted Work

As Judge Leval pointed out, it seems that courts only superficially and barely discuss the second factor, the nature of the copyrighted work.¹⁸⁶ Instead of analyzing the statutory language’s plain meaning, Leval directed attention to Justice Story’s reference to the “value of the materials used.”¹⁸⁷ Leval noted the latter “suggests that some protected matter is more ‘valued’ under copyright law than others.”¹⁸⁸ He summarized that the second factor concerns “protection of the reasonable expectation” of the original author/creator.¹⁸⁹ It follows that “the more the copyrighted matter is at the center of the protected concerns of the copyright law, the more the other factors, including justification, must favor the secondary user in order to earn a fair use finding.”¹⁹⁰

The Supreme Court also used Justice Story’s words in *Campbell*, and recognized that “some [original] works are closer to the core of intended copyright protection than others,” where it is more difficult for the Court to find fair use when the secondary work merely copied the original work.¹⁹¹ In that case, the Court held that the first line and bass riff of the original song were the author’s creative expression that fell within “the core of the copyright’s protected purposes.”¹⁹² However, the Court concluded this factor was not helpful to determine fair use because parodies almost invariably copy the original author’s creative work.¹⁹³

The Second Circuit in *Blanch v. Koons* helpfully characterized two types of distinctions regarding the nature of copyrighted works in evaluating the second factor: “(1) whether the work is expressive or creative . . . or more factual . . . and (2) whether the work is published or

¹⁸² *Blanch*, 467 F.3d at 253.

¹⁸³ *Id.* at 252.

¹⁸⁴ *NXIVM Corp. v. Ross Inst.*, 364 F.3d 471, 478-79 (2d Cir. 2004).

¹⁸⁵ *Id.*

¹⁸⁶ Leval, *supra* note 166, at 1116.

¹⁸⁷ *Id.* at 1117 (citation omitted).

¹⁸⁸ *Id.* (citation omitted).

¹⁸⁹ *Id.* at 1122.

¹⁹⁰ *Id.*

¹⁹¹ *Campbell v. Acuff-Rose Music*, 510 U.S. at 569, 586 (1994) (citing various cases to illustrate the “core” works and their copies).

¹⁹² *Id.*

¹⁹³ *Id.*

unpublished.”¹⁹⁴ Consequently, the creative nature of the original work typically favors the copyright holder.¹⁹⁵ Nonetheless, the second factor’s usefulness may be limited when the original creative work is used for a transformative purpose.¹⁹⁶

3. Third Factor - The Amount and Substantiality of the Portion Used

To determine the third factor, the amount and substantiality of the original portion used, a court examines both quantitative and qualitative aspects of the secondary work,¹⁹⁷ asking whether “the quantity and value of the materials used are reasonable” for the purpose of the copying.¹⁹⁸ As the Supreme Court noted, “the extent of permissible copying varies with the purpose and character of the use.”¹⁹⁹ For example, the copying is “not fair use when more of the original is copied than necessary.”²⁰⁰ However, even copying an entire work does not necessarily weigh against fair use because it is sometimes inevitable.²⁰¹ Additionally, Judge Leval stated the third factor has further significance in consideration of the first and fourth factors.²⁰² In assessing justification under the first factor, “an important inquiry is whether the selection and quantity of the material taken are reasonable in relation to the purported justification.”²⁰³ In relation to the market effect under the fourth factor, which is discussed more below, the qualitative aspect of substantiality “can assist in the assessment of the likely impact on the market for the copyrighted work.”²⁰⁴ Regarding the relation between the third and fourth factors, the Supreme Court agreed that “a work composed primarily of an original, particularly its heart, with little added or changed, is more likely to be a merely superseding use, fulfilling demand for the original [market].”²⁰⁵

For example, Defendant in *Harper* copied only part of President Ford’s memoir, but the newsworthiness and licensability of the copied portions constituted “the heart of the book.”²⁰⁶ Since “a taking may not be excused merely because it is insubstantial [in amount] with respect to the infringing work,” the Court held that what Defendant copied was not a “meager” or an “infinitesimal” amount of original Ford’s language.²⁰⁷ On the other hand, 2 Live Crew in *Campbell* did copy the opening part of the original song, but thereafter markedly departed from it. Hence, using a substantial portion of Plaintiff’s song was not necessarily copying.²⁰⁸

¹⁹⁴ *Blanch v. Koons*, 467 F.3d at 244, 256. (2d Cir. 2006).

¹⁹⁵ *Id.* (quoting *Bill Graham Archives v. Dorling-Kindersley Ltd.*, 448 F.3d 605, 612 (2d Cir. 2006)).

¹⁹⁶ *Id.*

¹⁹⁷ *Bill Graham Archives*, 448 F.3d at 613.

¹⁹⁸ *Blanch*, 467 F.3d at 257.

¹⁹⁹ *Campbell v. Acuff-Rose Music*, 510 U.S. at 569, 586-87 (1994).

²⁰⁰ *Rogers v. Koons*, 960 F.2d at 301, 311. (2d Cir. 1992).

²⁰¹ *Bill Graham Archives*, 448 F.3d at 613.

²⁰² Leval, *supra* note 166, at 1123.

²⁰³ *Id.*

²⁰⁴ *Id.*

²⁰⁵ *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 587-88 (1994) (also noting that “[t]he facts bearing on this factor will also tend to address the fourth, by revealing the degree to which the [secondary work] may serve as a market substitute for the original or potentially licensed derivatives”).

²⁰⁶ *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 554-56. (1985).

²⁰⁷ *Id.*

²⁰⁸ *Campbell*, 510 U.S. at 588-89.

4. Fourth Factor - Effect on the Market

In analyzing the fourth factor, effect of the use on the market, a court needs to consider not only the extent of actual market harm caused by the alleged infringement but also “whether unrestricted and widespread conduct of the sort engaged in by the defendant . . . would result in a substantially adverse impact on the potential market’ for the original.”²⁰⁹ Similar to other factors, the Supreme Court noted that “[m]arket harm is a matter of degree, and the importance of this factor will vary, not only with the amount of harm, but also with the relative strength of the showing on the other factors.”²¹⁰ In particular, the Court mentioned that if the secondary use is transformative, “market substitution is at least less certain, and market harm may not be so readily inferred.”²¹¹ The Court’s ruling reflected Judge Leval’s notion²¹² that the fourth factor should weigh against finding fair use “only when the market is impaired because the quoted material serves the consumer as a substitute, or, in [Justice] Story’s words ‘supersede[s] the use of the original’”²¹³ Simply put, if each work serves different purposes, “it is more likely that the new work will not affect the market for the original in a way cognizable under this factor, that is, by acting as a substitute for it.”²¹⁴ A transformative work would not become a substitute for the original work.

The Second Circuit recognized that the Supreme Court retreated from its earlier emphasis on the fourth factor.²¹⁵ Following the Supreme Court’s interpretation of the fourth factor, the Second Circuit looked to actual market harm and to “whether[] if the challenged use becomes widespread, it will adversely affect the potential market for copyrighted work.”²¹⁶ In one case, the court described, “our concern is not whether the secondary use suppresses or even destroys the market for the original work or its potential derivatives, but whether the secondary use usurps the market of the original work.”²¹⁷ This distinction indicates that courts do not care even if lethal parody or harsh criticism might destroy demand for the original work; courts only consider market substitution effects where the original and the secondary works compete in the same market.²¹⁸ The court also tries to balance between the benefit that the public receives if the secondary use is permitted and the personal gain the copyright owner receives if the use is denied.²¹⁹

A somewhat uncertain question is how to measure the market effect. Courts are cautious about being too deferential to the impact on potential licensing revenues.²²⁰ Since secondary

²⁰⁹ *Id.* at 590.

²¹⁰ *Id.* at 591 n.21.

²¹¹ *Id.* at 591.

²¹² *Id.* (also noting that the original and parody songs “usually serve different market functions”).

²¹³ Leval, *supra* note 166, at 1125 (alteration in original).

²¹⁴ *Campbell*, 510 U.S. at 591.

²¹⁵ *Blanch v. Koons*, 467 F.3d 244, 258 n.8 (2d Cir. 2006). Regarding the earlier interpretation, Judge Leval had cautioned that “the Supreme Court ha[d] somewhat overstated its importance.” Leval, *supra* note 166, at 1124.

²¹⁶ *Bill Graham Archives v. Dorling-Kindersley Ltd.*, 448 F.3d 605, 613 (2d Cir. 2006) (citing *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 568. (1985)).

²¹⁷ *Blanch*, 467 F.3d at 258 (“The market for potential derivative uses includes only those that creators of original works would in general develop or license others to develop.”).

²¹⁸ *See Campbell*, 510 U.S. at 591-93.

²¹⁹ *Bill Graham Archives*, 448 F.3d at 613.

²²⁰ *Id.* at 614.

users “copy” the original work without paying the fee, the fourth factor would always favor the copyright holder.²²¹ Thus, instead courts must look at the impact on “potential licensing revenues for ‘traditional, reasonable, or likely to be developed markets.’”²²² When the original work and the secondary work are transformatively different, “a copyright holder cannot prevent others from entering fair use markets merely ‘by developing or licensing parody, news reporting, educational or other transformative uses of its own creative work.’”²²³

For example, in *Campbell*, the copyright holder contended that there was a rap market because Defendant recorded a rap parody and another rap group sought a license for a different rap derivative.²²⁴ But the Court rejected the claim, reasoning that “there was no evidence that a potential [non-parody] rap market was harmed in any way by [Defendant’s] parody, rap version.”²²⁵ After all, “the only harm to derivatives that need concern [the Court] . . . is the harm of market substitution.”²²⁶

5. Second Circuit’s Decisions in Recent Appropriation Cases

In 2006, the Second Circuit decided two visual appropriation cases and found fair use for both Defendants. It is possible that Fairey had these cases in mind when he chose to file a suit in New York. One case is *Bill Graham Archives v. Dorling-Kindersley, Ltd.*, another is *Blanch v. Koons*.

(1) *Bill Graham Archives v. Dorling-Kindersley, Ltd.*

Defendant publisher in *Bill Graham Archives v. Dorling-Kindersley, Ltd.* published a biography of a famous music group using the group’s concert posters to create graphic images in the book.²²⁷ Plaintiff copyright holder of the posters refused permission of the use but Defendant appropriated seven images which became “displayed in significantly reduced form and [] accompanied by captions describing the concerts they represent.”²²⁸ As for the first fair use factor, since Defendant used the posters for its biography, plainly different from the original works’ purpose of artistic expression and promotion, the court found its use transformative.²²⁹ The manner of the images’ display in the book strengthened that conclusion since the images were significantly reduced in size, made reproductions combined with texts and other images, used a collage effect, and the like.²³⁰

The court found that the second and the third factors have limited weight in its fair use analysis because Defendant’s use of the original work was for the transformative purpose.²³¹ It

²²¹ *Id.*

²²² *Id.* at 613.

²²³ *Id.*

²²⁴ *Campbell*, 510 U.S. at 593.

²²⁵ *Id.*

²²⁶ *Id.*

²²⁷ *Bill Graham Archives*, 448 F.3d at 607.

²²⁸ *Id.*

²²⁹ *Id.* at 609-10.

²³⁰ *Id.* at 611.

²³¹ *Id.* at 612-13.

also emphasized Defendant's reduced-size reproductions of the original images even though they were entirely copied.²³² In terms of the fourth factor, since Defendant's use of Plaintiff's original images fell within a transformative market, Plaintiff did not suffer market harm as a result of losing license fees.²³³

(2) *Blanch v. Koons*

Defendant appropriation artist (the same artist who created String of Puppies) in *Blanch v. Koons* created a collage painting by copying part of the original copyrighted photograph taken by Plaintiff fashion photographer.²³⁴ Plaintiff's photograph appeared in Allure magazine, and "depicted a woman's lower legs and feet."²³⁵ Defendant scanned the original photograph into his computer and created the collage image by discarding background and altering the appearance.²³⁶ Defendant sold the painting to Deutsche Bank, which displayed it at the Guggenheim Museum.²³⁷

In weighing the first fair use factor, the court concluded that Defendant's work constituted transformative use because he used Plaintiff's photograph from a beauty magazine and then changed the image's size and appearance and received commission fee for exhibition in the art gallery.²³⁸ Despite the profitability of Defendant's secondary work, the court discounted its commercial nature since the new work was substantially transformative.²³⁹ The court found that the second factor did not have significant implication for the overall fair use analysis because, again, Defendant's work had a transformative purpose.²⁴⁰

The court concluded that the third factor weighed distinctly in Defendant's favor because his copying was reasonable in light of his transformative purpose "to convey the fact of the photograph to viewers of the painting, and in light of the quantity, quality, and importance of the material used."²⁴¹ Turning to the fourth factor, as Plaintiff admitted that she had not published or licensed her original photograph, that she had never licensed her photographs for derivative visual works, and that she did not suffer any economic harm from Defendant's use of her photograph, the court held that Defendant's painting "had no deleterious effect upon the potential market for or value of the copyrighted work."²⁴²

D. Application to Obama Hope Case

1. First Factor

²³² *Id.*

²³³ *Id.* at 614-15.

²³⁴ *Blanch v. Koons*, 467 F.3d 244, 246. (2d Cir. 2006).

²³⁵ *Id.* at 247-48.

²³⁶ *Id.* at 248.

²³⁷ *Id.*

²³⁸ *Id.*

²³⁹ *Id.* at 254.

²⁴⁰ *Id.* at 257.

²⁴¹ *Id.*

²⁴² *Id.* at 258.

From Fairey's words and actions during the presidential campaign, it is apparent that his purpose in creating the Obama Hope image was to help the candidacy of Barack Obama by stressing Obama's messages of "hope" and "change." Believing that Obama's supporters were mainly young and progressive people, Fairey designed the iconic and simple image reflecting pop culture.²⁴³ On the other hand, the AP used Garcia's Obama Photo for news reporting in 2006. The AP assigned Garcia to take photographs of George Clooney regarding a discussion of the human rights crisis in Darfur.²⁴⁴ It is unlikely that the AP, a news agency, intended to use that particular photograph to mobilize and inspire voters to support candidate Barack Obama for President of the United States. Accordingly, it seems reasonable for the court to hold that Fairey's use of the Obama Photo had a different purpose, meaning, and value, making the two works transformatively different.

In terms of the commercial use, Fairey eventually made some profit by using the AP's Obama Photo.²⁴⁵ However, he did not originally intend to make such a profit, which was incidental and only a result of the presidential election. The purpose of Fairey's use was more public than commercial,²⁴⁶ and had "value that benefits the broader public interest."²⁴⁷ Even assuming that Fairey used the Obama Photo for profit, it would not change the fact that the Obama Hope image had different meaning and value. Moreover, it seems Fairey had a genuine creative rationale for borrowing Garcia's photograph, "rather than using it merely to get attention or to avoid the drudgery in working up something fresh."²⁴⁸ It would have been very difficult for Fairey to create Obama's image without referring to a photograph someone took.

Thus, the Obama Hope image did not supersede the objects of the original creation but "instead add[ed] something new, with a further purpose or different character, altering the first with new expression, meaning, or message."²⁴⁹ It is also important to take into account Fairey's use of collage in a palette of red, white, and blue with the word "HOPE" as an artistic manner and adding new expression. This is analogous to the defendants' works in the two Second Circuit cases discussed above. Therefore, Fairey's use satisfies the elements of transformative use, making the first fair use factor weigh in favor of Fairey.

2. Second Factor

As discussed in Part II, Garcia's Obama Photo was creative and original. However, the nature of Garcia's photograph was also factual given that it was originally published for its news

²⁴³ See Arnon, *supra* note 27.

²⁴⁴ Garcia Interview, *supra* note 121.

²⁴⁵ See, e.g., Answer and Affirmative Defenses of Plaintiffs and Counterclaim Defendants at 2, *Fairey v. Associated Press*, 2009 WL 1116249, at *2 (S.D.N.Y. Apr. 14, 2009) (No. 09 Civ. 01123), available at <http://docs.justia.com/cases/federal/district-courts/new-york/nysdce/1:2009cv01123/340121/21/> (admitting that he sold sweatshirts bearing the "Obama Hope" image for \$60 each at the website); Edgers, *supra* note 26 (noting that Fairey was paid royalties for President Obama's inauguration posters); National Portrait Gallery, Portrait of President Barack Obama by Shepard Fairey, <http://www.npg.si.edu/collection/obamaportrait.html> (Fairey's original Obama Hope collage was obtained by art collectors and donated to the National Portrait Gallery of the Smithsonian Museum).

²⁴⁶ See Arnon, *supra* note 27.

²⁴⁷ *Blanch v. Koons*, 467 F.3d 244, 254. (2d Cir. 2006).

²⁴⁸ *Id.* at 255.

²⁴⁹ *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 579 (1994).

reporting purpose. A copyrighted work is more subject to fair use when it is published to the public.²⁵⁰ Thus, the Obama Photo should receive only “thin” protection and face fair use scrutiny. Accordingly, even though the Obama Photo has original expression, the transformative manner of use of the Obama Hope image is likely to convince the court to discount the second factor as having “limited usefulness.”²⁵¹ Thus, this factor is, at most, neutral in assessing fair use in this case.

3. Third Factor

It is true that Fairey used almost the entire image of Obama in the Obama Photo, but borrowing the entire work was inevitable in view of Fairey’s purpose. The Obama Hope image would have conveyed little of Obama’s messages of hope and change if his face was cut in half or the size reduced rather than enlarged. Similar to Defendant’s collage painting in *Blanch*, Fairey’s copying was reasonable given his transformative purpose “to convey the fact of the photograph to viewers of the painting,” and in light of the quality and value of the material he used.²⁵² Accordingly, Fairey’s copying does not seem excessive or more than necessary, and this factor favors Fairey, or at least does not disfavor him.

4. Fourth Factor

Because Garcia took the Obama Photo for the AP in 2006 and Fairey used it for the presidential election campaign in 2008, it is apparent that the Obama Hope image did not suppress the demand of the Obama Photo. In addition, considering that the AP used the Obama Photo for news reporting purpose in 2006, it seems unlikely that the AP would have developed a potential derivative market where it could have reasonably profited from the Obama Photo by using or licensing it for Obama’s campaign. In contrast, Fairey developed his own transformative market for the Obama Hope image, which apparently served a different market than the potential news market of the Obama Photo. Even if the AP had used the photograph for presidential election poster or sticker to support Obama, it is unclear how much substitution the Obama Hope image would have caused by usurping the AP’s share of election merchandise.

As to the balance between the interests of the public and the copyright owner,²⁵³ the public received a benefit of democracy as a result of Fairey’s use of the Obama Photo for political campaign, while the AP would have received little gain even though the use was denied. It follows that Fairey’s secondary use did not usurp the potential market of the AP’s copyrighted photograph. In fact, Fairey’s use ironically increased value of Garcia’s photograph and probably his reputation.²⁵⁴ Accordingly, this factor favors finding for Fairey’s fair use defense.

5. Conclusion

²⁵⁰ See Leval, *supra* note 166, at 1119-20.

²⁵¹ *Bill Graham Archives v. Dorling-Kindersley Ltd.*, 448 F.3d 605, 612. (2d Cir. 2006).

²⁵² *Blanch*, 467 F.3d at 257-58.

²⁵³ *Bill Graham Archives*, 448 F.3d at 613.

²⁵⁴ See Noam Cohen, *Viewing Journalism As a Work Of Art*, N.Y. TIMES, Mar. 24, 2009, at 2 (“the [Garcia’s] picture is now on sale at a Chelsea gallery in a limited edition of 200. The prints are going for \$1,200 apiece, and at least one has been purchased by a fine-arts museum.”).

Overall, considering the foregoing factors, the Second Circuit is likely to decide that Fairey's copying of the AP's Obama Photo was a fair use. Thus, even if the court decides that Fairey infringed the AP's copyright in the Obama Photo, his use will be protected.

IV. First Amendment and Political Use

A. Relationship Between the Copyright Act and the First Amendment

1. External Conflict

The First Amendment of the U.S. Constitution states that "Congress shall make no law . . . abridging the freedom of speech, or of the press."²⁵⁵ This Amendment is somewhat contradictory to the Copyright Clause of the Constitution, which grants Congress the power to enact copyright legislation "by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."²⁵⁶ On the one hand, the Constitution prohibits Congress from limiting people's freedom of speech and expression, but on the other hand, the Constitution authorizes Congress to limit the right of people to use copyrighted expression without the copyright owner's permission.²⁵⁷ Professor Melville B. Nimmer called this constitutional tension an "external conflict" as the conflict arises outside copyright laws.²⁵⁸

2. Internal Conflict

According to Nimmer, in addition to external conflict, copyright laws themselves create "internal conflict."²⁵⁹ Under the Copyright Clause, Congress may authorize the limited grant of monopoly privileges to copyright owners for an important public purpose.²⁶⁰ The purpose of the Copyright Clause is "to motivate the creative activity of authors and inventors by the provision of a special reward, and allow the public access to the products of an author or inventor's genius after the limited period of exclusive control has expired."²⁶¹ Through the limited statutory monopoly, copyright laws encourage an original author's creative work, but the ultimate goal is "to stimulate artistic creativity for the general public good" by "promoting broad public availability of literature, music, and the other arts."²⁶²

However, the original author's self-interest and the public interest sometimes conflict with each other.²⁶³ This internal conflict happens simply because the public demands the copyrighted work at a low cost, while original authors demand the reward for creative labor.²⁶⁴ More importantly, as in the Obama Hope case, there is also a temporal conflict between current authors who create an original expression and future authors who use such an expression in

²⁵⁵ U.S. CONST. amend. I.

²⁵⁶ U.S. CONST. art. I, § 8.

²⁵⁷ NIMMER, *supra* note 66, § 19E.01[B].

²⁵⁸ *Id.*

²⁵⁹ *Id.* at § 19E.01[C].

²⁶⁰ Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 429 (1984).

²⁶¹ *Id.*

²⁶² Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156 (1975).

²⁶³ NIMMER, *supra* note 66, § 19E.01[C].

²⁶⁴ *Id.*

derivative works.²⁶⁵

3. Courts' View—Reluctance to Invoke the First Amendment

Despite a governmental restriction on freedom of speech, the Supreme Court has been reluctant to invoke a First Amendment defense for secondary users in copyright cases. In *Harper & Row, Publishers, Inc. v. Nation Enters.*, the first of only two cases in which the Supreme Court directly addressed these conflicts,²⁶⁶ the Court turned to the idea/expression dichotomy, and adopted the notion that the dichotomy strikes “a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author’s expression.”²⁶⁷ The Court based its rationale on an originalist theory: the Framers of the U.S. Constitution “intended copyright itself to be the engine of free expression. By establishing a marketable right to the use of one’s expression, copyright supplies the economic incentive to create and disseminate ideas.”²⁶⁸ The Court then concluded that since the First Amendment protections were already embodied in the Copyright Act through the idea/expression dichotomy and the fair use doctrine, it did not have to recognize a separate First Amendment defense to create a broader direct exception to copyright.²⁶⁹

Nearly two decades later, the Court in *Eldred v. Ashcroft* again rejected a First Amendment challenge to the Sonny Bono Copyright Term Extension Act of 1998 (“CTEA”), which extended the duration of existing and future copyrights by twenty years.²⁷⁰ Plaintiffs in that case contended that the CTEA regulated free speech, and would require First Amendment scrutiny.²⁷¹ However, the Court found First Amendment scrutiny unnecessary. Since the Framers adopted the Copyright Clause and the First Amendment close in time, the Court interpreted that the Framers considered that “copyright’s limited monopolies are compatible with free speech principles.”²⁷² Furthermore, the Court reasoned that “copyright law contains built-in First Amendment accommodations.”²⁷³ First, the Copyright Act embraces the idea/expression dichotomy with copyright protection limited only to expression.²⁷⁴ Second, the fair use defense under section 107 of the Copyright Act “allows the public to use expression itself in certain circumstances.”²⁷⁵ Following the Supreme Court’s view, the Second Circuit has not invoked the First Amendment because the “fair use doctrine encompasses all claims of first amendment in the copyright field.”²⁷⁶

To clarify this, *Nimmer on Copyright* used “labor division” and “ambassador” analogies. “Under this labor division argument, copyright laws and the First Amendment divide the areas of

²⁶⁵ *Id.* at § 19E.01[C] n.27.

²⁶⁶ Eugene Volokh, *Freedom of Speech & Intellectual Property: Some Thought After Eldred 44 Liquormart, & Bartnicki*, 40 HOUS. L. REV. 697, 698 & n.2. (another case is *Eldred v. Ashcroft*, 537 U.S. 186 (2003)).

²⁶⁷ *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. at 539, 556. (1985).

²⁶⁸ *Id.* at 558.

²⁶⁹ *Id.* at 560.

²⁷⁰ *Eldred v. Ashcroft*, 537 U.S. at 186, 222 (2003).

²⁷¹ *Id.* at 193-94.

²⁷² *Id.* at 186, 218-19.

²⁷³ *Id.* at 219.

²⁷⁴ *Id.*

²⁷⁵ *Id.*

²⁷⁶ *See Sarl Louis Feraud Int’l v. Viewfinder, Inc.*, 489 F.3d 474, 482 (2d Cir. 2007) (citations omitted).

responsibility, to achieve the same goal.”²⁷⁷ While “[c]opyright law is responsible for the production of creative works,”²⁷⁸ “[t]he First Amendment is responsible for the protection of that production” from governmental encroachment.²⁷⁹ Under the ambassador analogy, the idea/expression dichotomy and the fair use doctrine act as an ambassador “within the territory of copyright law and represent[] the interests of the foreign land of First Amendment.”²⁸⁰

Behind the courts’ reluctance to invoke the First Amendment, some judges may have the “constitutional avoidance” canon in mind. Generally “when the constitutionality of a statute is assailed, if the statute be reasonably susceptible of two interpretations, by one of which it would be unconstitutional and by the other valid, it is [courts’] plain duty to adopt that construction which will save the statute from constitutional infirmity.”²⁸¹ Though courts have not explicitly mentioned it in copyright cases, one district court candidly applied this time-honored canon to the copyright statute.²⁸² In theory, if the Copyright Act and the First Amendment operated at cross-purposes, the First Amendment would invalidate the Act.²⁸³ However, the court argued, “[r]ather than strike down an entire act as overbroad in such a situation, the judiciary prefers to interpret such a statute as narrowly as needed to preserve it for the effectuation of those of its purposes deemed consistent with the Constitution.”²⁸⁴ Moreover, courts would usually adhere to the principle of *stare decisis*, deferring to past precedents.²⁸⁵

B. Criticisms of the Court’s View

1. Dissenters’ First Amendment Concerns in the Supreme Court Cases

In his dissenting opinion in *Harper*, Justice Brennan emphasized the importance of First Amendment values in copyright infringement cases.²⁸⁶ Especially concerned about a limitation of public debate, Justice Brennan stated that “every citizen must be permitted freely to marshal ideas and facts in the advocacy of particular political choices.”²⁸⁷ He argued that copyright laws served as the engine of free expression “only when the statutory monopoly does not choke off

²⁷⁷ NIMMER, *supra* note 66, § 19E.05[B].

²⁷⁸ *Id.*

²⁷⁹ *Id.*

²⁸⁰ NIMMER, *supra* note 66, § 19E.01[D].

²⁸¹ *United States ex rel. Att’y Gen. v. Delaware & Hudson Co.*, 213 U.S. 366, 407-08 (1909); *see, e.g.*, *United States v. Booker*, 543 U.S. 220, 286 (2005) (“[W]here a statute is susceptible of two constructions, by one of which grave and doubtful constitutional questions arise and by the other of which such questions are avoided, our duty is to adopt the latter.”); *Edward J. DeBartolo Corp. v. Fla. Gulf Coast Bldg. & Constr. Trades Council*, 485 U.S. 568, 575 (1988) (“[W]here an otherwise acceptable construction of a statute would raise serious constitutional problems, the Court will construe the statute to avoid such problems unless such construction is plainly contrary to the intent of Congress.”).

²⁸² *Triangle Publ’ns, Inc. v. Knight-Ridder Newspapers, Inc.*, 445 F. Supp. 875 (S.D. Fla. 1978), *aff’d*, 626 F.2d 1171 (5th Cir. 1980).

²⁸³ *Id.*

²⁸⁴ *Id.* (referring to Justice Brandeis’s concurring opinion in *Ashwander v. Tenn. Valley Auth.*, 297 U.S. 288, 346, 348 (1936) (Brandeis, J., concurring)).

²⁸⁵ *Citizens United v. Fed. Election Comm’n*, 130 S. Ct. 876, 911-12 (2010).

²⁸⁶ *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 582 (1985) (Brennan, J., dissenting).

²⁸⁷ *Id.* at 582 n.4 (“It would be perverse to prohibit government from limiting the financial resources upon which a political speaker may draw . . . but to permit government to limit the intellectual resources upon which that speaker may draw.”).

multifarious indirect uses and consequent broad dissemination of information and ideas.”²⁸⁸ Thus, “[t]o ensure the progress of arts and sciences and the integrity of First Amendment values, ideas and information must not be freighted with claims of proprietary right.”²⁸⁹ Accordingly, Justice Brennan disagreed with the majority, expressing his concern that the holding would curtail the free use of knowledge and ideas while “risk[ing] the robust debate of public issues that is the ‘essence of self-government.’”²⁹⁰

Justice Breyer, dissenting in *Eldred*, also pointed out the First Amendment issue.²⁹¹ He agreed that when the Copyright Clause and the First Amendment work in tandem they reinforce a mutual goal, with “the first serving as an engine of free expression . . . the second assuring the government throws up no obstacle to its dissemination.”²⁹² However, a particular statute, like the CTEA in that case, which “exceeds proper Copyright Clause bounds may set Clause and Amendment at cross-purposes, thereby depriving the public of the speech-related benefits that the Founders, through both, have promised.”²⁹³ Justice Breyer concluded that the Court should “review plausible claims that a copyright statute seriously, and unjustifiably, restricts the dissemination of speech somewhat more carefully than reference to this Court’s traditional Copyright Clause jurisprudence might suggest.”²⁹⁴ Although he dismissed the necessity of First Amendment strict scrutiny or intermediate scrutiny, he recommended a stricter review than the majority’s approach,²⁹⁵ implying a “rational basis with bite” test as adopted in Equal Protection and Due Process cases because it is more exacting scrutiny than the typical deferential rational basis test.²⁹⁶

2. Eldred’s Implications

As seen above, the Supreme Court in *Eldred* found it “appropriate to construe copyright’s internal safeguards to accommodate First Amendment concerns.”²⁹⁷ The majority concluded that “copyright’s built-in free speech safeguards are *generally* adequate to address” First Amendment concerns.²⁹⁸ One commentator called attention to the word “generally,” which seems to imply there are some situations where courts might find the built-in safeguards—the idea/expression dichotomy and the fair use doctrine—inadequate to protect First Amendment values.²⁹⁹ In addition, although the court below decided that “copyrights are categorically immune from challenges under the First Amendment,”³⁰⁰ the Supreme Court rejected its language as speaking

²⁸⁸ *Id.* at 589.

²⁸⁹ *Id.*

²⁹⁰ *Id.* at 604 (citation omitted).

²⁹¹ *Eldred v. Ashcroft*, 537 U.S. at 186, 244 (2003) (Breyer, J., dissenting).

²⁹² *Id.*

²⁹³ *Id.*

²⁹⁴ *Id.*

²⁹⁵ *Id.* at 244-45 (referring to *Cleburne v. Cleburne Living Ctr., Inc.*, 473 U.S. 432, 446-450 (1985); *Plyler v. Doe*, 457 U.S. 202, 223-224 (1982); *Dep’t of Agric. v. Moreno*, 413 U.S. 528, 534-538 (1973)).

²⁹⁶ See generally Gerald Gunther, *Foreword: In Search of Evolving Doctrine on a Changing Court: A Model for a Newer Equal Protection*, 86 HARV. L. REV. 1, 21 (1972) (“these cases found bite in the equal protection clause after explicitly voicing the traditionally toothless minimal scrutiny standard”).

²⁹⁷ *Eldred*, 537 U.S. at 221 n.24. (majority opinion).

²⁹⁸ *Id.* at 221 (emphasis added).

²⁹⁹ NIMMER, *supra* note 66, § 19.05[C][2].

³⁰⁰ *Eldred v. Reno*, 239 F.3d 372, 375 (D.C. Cir. 2001), *aff’d sub nom.*, *Eldred v. Ashcroft*, 537 U.S. 186 (2003).

too broadly.³⁰¹ Also the Court's language indicates that First Amendment scrutiny might be necessary if Congress "altered the traditional contours of copyright protection."³⁰² Consequently, the case implied that the majority of the Court did not rule out addressing First Amendment based challenges to the copyright statute in the future.³⁰³

3. First Amendment Concerns in the Obama Hope Case

Copyright limitation on Fairey's use of the Obama Photo would raise First Amendment issues for several reasons. First, Fairey's expression concerns political speech through his Obama Hope image. As explained below, a political speech is categorized as one of the most important First Amendment goals, "self-governance." The Supreme Court has repeatedly stressed its significance. For example, in a libel case where Defendant newspaper company referred to a criminal record of Plaintiff political candidate in its column,³⁰⁴ the Court stated that "it can hardly be doubted that the constitutional guarantee has its fullest and most urgent application precisely to the conduct of campaigns for political office."³⁰⁵ Such notion is more apparent in campaign finance cases: "Discussion of public issues and debate on the qualifications of candidates are integral to the operation of the system of government established by our Constitution. The First Amendment affords the broadest protection to such political expression"³⁰⁶ "[P]olitical speech must prevail against laws that would suppress it, whether by design or inadvertence."³⁰⁷

In one case, Chief Justice Roberts even stated that "[t]he Government may not suppress lawful speech as the means to suppress unlawful speech. Protected speech does not become unprotected merely because it resembles the latter."³⁰⁸ There, the Court reviewed the constitutionality of the campaign finance law which prohibited corporations from broadcasting campaign advertisement shortly before election.³⁰⁹ While the principal opinion (by two Justices) decided that the regulation was unconstitutional as applied to plaintiff's general policy-issue advertisement,³¹⁰ three concurring Justices noted that the statute facially violated the First Amendment.³¹¹ The Court eventually held that the regulation was facially unconstitutional in a later case involving an anti-Hillary Clinton documentary film.³¹² Considering that the Court prohibits governmental regulation over campaign financial resources under the First Amendment principle, it seems perverse for the Court to permit the copyright limitation on the intellectual resources (i.e. Obama Photo) that Fairey can use for the political campaign.³¹³

³⁰¹ *Eldred*, 537 U.S. at 221.

³⁰² *Id.*

³⁰³ NIMMER, *supra* note 66, § 19.05[C][2].

³⁰⁴ *Monitor Patriot Co. v. Roy*, 401 U.S. 265, 266-67 (1971).

³⁰⁵ *Id.* at 271-72.

³⁰⁶ *Buckley v. Valeo*, 424 U.S. 1, 14 (1976) ("there is practically universal agreement that a major purpose of that Amendment was to protect the free discussion of governmental affairs . . . of course includ[ing] discussions of candidates") (citation omitted).

³⁰⁷ *Citizens United v. Fed. Election Comm'n*, 130 S. Ct. 876, 898 (2010).

³⁰⁸ *Fed. Election Comm'n v. Wis. Right to Life, Inc.*, 551 U.S. 449, 475 (2007).

³⁰⁹ *Id.* at 455-57.

³¹⁰ *Id.* at 481-82.

³¹¹ *Id.* at 501-04 (2007) (Scalia, J., concurring).

³¹² *Citizens United*, 130 S. Ct. at 913.

³¹³ *See Harper & Row, Publ'g, Inc. v. Nation Enters.*, 471 U.S. 539, 582 n.4 (1985) (Brennan, J., dissenting).

The second reason for the First Amendment concern is that the limitation on Fairey's use would undermine the internal safeguards (idea/expression dichotomy and fair use doctrine) of the Copyright Act, which are supposed to serve the First Amendment's interest. As stated in Part II, since Obama had almost exclusive control over his expression when Garcia took his photograph, the Obama Photo has such thin originality that its idea and expression almost merge.³¹⁴ Theoretically, the idea/expression dichotomy allows secondary authors to use the idea conveyed by the original author so that the government does not abridge the secondary authors' freedom of speech. However, as in the Obama Hope case, where idea and expression are almost identical, the copyright limitation may fail to serve as the engine of free expression, working at cross-purposes with the First Amendment. As one commentator pointed out, the notoriously unpredictable nature of the internal safeguards might induce considerable speaker self-censorship.³¹⁵

Third, unlike typical artistic photographs, the subject of the Obama Photo was an elected public official. Since an opportunity to take good photographs of politicians is normally limited to media, it is difficult for the public to obtain desirable photographs. Similarly, it was likely near impossible for Fairey to find an ideal photograph that could fit his image of Obama unless borrowing one from another source.³¹⁶ Thus, the AP's claim seems analogous to a hypothetical situation where a reporter transcribes Obama's public speech, and asserts the copyright protection in it. Under the First Amendment, the government cannot prevent people freely using such a transcribed speech to express an individual's own opinion.

C. First Amendment Approach

1. Purposes of Free Speech

There are several theories for protecting freedom of speech, but the three classic First Amendment values are "self-governance," "marketplace of ideas," and "autonomy/self-fulfillment."³¹⁷ The "self-governance" theory stems from the idea that democracy can be furthered only through free public speech.³¹⁸ The "marketplace of ideas" theory asserts that freedom of speech is essential to discover truth.³¹⁹ In his dissenting opinion in *Abrams v. United States*, Justice Holmes wrote "that the best test of truth is the power of the thought to get itself accepted in the competition of the market, and that truth is the only ground upon which their wishes safely can be carried out."³²⁰ The more expansive "autonomy/self-fulfillment" theory

³¹⁴ See *Ets-Hokin v. SKYY Spirits, Inc.*, 225 F.3d 1068, 1082 (9th Cir. 2000).

³¹⁵ Neil W. Netanel, *Copyright and the First Amendment: What Eldred Misses—and Portends*, Copyright And Free Speech: Comparative And International Analyses, OXFORD UNIVERSITY PRESS, 2005, available at <http://www.ssrn.com/abstract=614642>.

³¹⁶ See *Fairey Interview*, *supra* note 45 (noting that Fairey looked for the photograph with "the direction of the gaze which [he] felt looked presidential, looked like Obama had some vision and some leadership, and that combined with the way that the light was falling").

³¹⁷ *Leachman v. Rector & Visitors of Univ. of Va.*, 691 F. Supp. 961, 964 (W.D. Va. 1988), *aff'd*, 915 F.2d 1564 (4th Cir. 1990); ERWIN CHERMERINSKY, CONSTITUTIONAL LAW: PRINCIPLES & POLICIES 926 (3d ed., Aspen Publishers 2006); 1 RODNEY A. SMOLLA, SMOLLA & NIMMER ON FREEDOM OF SPEECH § 2:3 (2009).

³¹⁸ CHERMERINSKY, *supra* note 319, at 926-27; SMOLLA, *supra* note 319, § 2:6.

³¹⁹ CHERMERINSKY, *supra* note 319, at 927-28; SMOLLA, *supra* note 319, § 2:4.

³²⁰ *Abrams v. United States*, 250 U.S. 616, 630 (1919) (Holmes, J., dissenting).

emphasizes freedom of speech and expression as “an essential aspect of personhood and autonomy,”³²¹ and stresses its value to “the dignity and self-realization of individual human beings.”³²²

2. Basic First Amendment Analysis

When courts review First Amendment cases that involve freedom of speech, the judges “[invoke] the content-based/content-neutral distinction as the basis for [a court’s] decision.”³²³ Although there are unprotected or less protected categories such as obscenity and defamation, “the First Amendment means that government [generally] has no power to restrict expression because of its message, its ideas, its subject matter, or its content.”³²⁴ Thus, except a few limited areas, “[c]ontent-based regulations are presumptively invalid.”³²⁵ The Supreme Court in *Turner Broadcasting System v. Federal Communication Commission* defined this two-tier standard of review: while courts “apply the most exacting scrutiny to regulations that suppress, disadvantage, or impose differential burdens upon speech because of its content,”³²⁶ they apply an intermediate level of scrutiny to “regulations that are unrelated to the content of speech.”³²⁷ Therefore, content-based regulations on speech are generally subject to strict scrutiny but content-neutral regulations are usually subject to intermediate scrutiny.

For the regulation of speech to be content-neutral, the government must be neutral in both viewpoint and subject matter.³²⁸ “Viewpoint neutral means that the government cannot regulate speech based on the ideology of the message,”³²⁹ while “[s]ubject matter neutral means that the government cannot regulate speech based on the topic of the speech.”³³⁰ When the government regulation is content-based, strict scrutiny applies: “If a statute regulates speech based on its content, it must be narrowly tailored to promote a compelling Government interest. If a less restrictive alternative would serve the Government’s purpose, the legislature must use that alternative.”³³¹ However, when the subject matter of a speech and expression is unprotected or less protected, the government’s regulation usually need only satisfy intermediate scrutiny, although strict scrutiny may still apply to content-based regulations.³³² Such unprotected or less protected subjects include “incitement of illegal activity, fighting words and provocation of hostile audiences, obscenity and sexually oriented speech, defamatory speech . . . [and] commercial speech.”³³³

³²¹ CHEMERINSKY, *supra* note 319, at 929.

³²² SMOLLA, *supra* note 319, § 2:5.

³²³ CHEMERINSKY, *supra* note 319, at 932.

³²⁴ *Ashcroft v. Am. Civil Liberties Union*, 535 U.S. 564, 573-74 (2002).

³²⁵ *R.A.V. v. St. Paul*, 505 U.S. 377, 382 (1992).

³²⁶ *Turner Broad. Sys. v. Fed. Comm’n Comm’n*, 512 U.S. 622, 642 (1994).

³²⁷ *Id.*

³²⁸ CHEMERINSKY, *supra* note 319, at 934.

³²⁹ *Id.* (it would not be “viewpoint neutral” “for the government to say that pro-choice demonstrations are allowed in the park but antiabortion demonstrations are not allowed”).

³³⁰ *Id.* at 934-35 (noting that it would not be “subject matter neutral” if a law allowed speech about labor or regulated only sexual speech).

³³¹ *United States v. Playboy Entm’t Group, Inc.*, 529 U.S. 803, 813 (2000) (citation omitted).

³³² CHEMERINSKY, *supra* note 319, at 986-87.

³³³ *Id.* at 931.

A difficult task is to define intermediate scrutiny. The jurisprudence of the First Amendment is not so simple and the Supreme Court has applied various tests on an almost ad-hoc basis.³³⁴ There are some cases where the Court defined intermediate scrutiny; one case that might be applicable to the Obama Hope case is *Members of the City Council of Los Angeles v. Taxpayers for Vincent*, where the Court reviewed the constitutionality of a municipal ordinance that prohibited the posting of signs on public property.³³⁵ Since the regulation extended to signs for political campaigns, supporters for a city council candidate filed a suit to enjoin enforcement of the ordinance.³³⁶ The Court recognized the risk of a sweeping statute to “repeatedly chill the exercise of expressive activity by many individuals.”³³⁷ Nonetheless, the Court rejected the facial challenge on overbreadth grounds, reasoning that such a constitutional challenge requires “a realistic danger that the statute itself will significantly compromise recognized First Amendment protections of parties not before the Court.”³³⁸

Instead, the Court examined the case on an “as applied” basis because the challenge was basically against the ordinance as applied to Plaintiffs’ activities.³³⁹ For reviewing the regulation, the viewpoint-neutrality nature of the ordinance called for the Court to apply intermediate scrutiny:

A government regulation is sufficiently justified if it is within the constitutional power of the Government; if it furthers an important or substantial governmental interest; if the governmental interest is unrelated to the suppression of free expression; and if the incidental restriction on alleged First Amendment freedoms is no greater than is essential to the furtherance of that interest.³⁴⁰

In addition, the Court there noted that “[w]hile the First Amendment does not guarantee the right to employ every conceivable method of communication at all times and in all places, a restriction on expressive activity may be invalid if the remaining modes of communication are inadequate.”³⁴¹ Under this scrutiny, the Court rejected the as-applied challenge because the plaintiffs had other means to express in the same public place such as speaking and distributing literature.³⁴²

3. Limited First Amendment Application in Copyright Cases

As of today, there has been only one case where any court ruled that a part of the Copyright Act violated the First Amendment.³⁴³ In *Golan v. Gonzales*, the Tenth Circuit

³³⁴ See SMOLLA, *supra* note 319, § 2:63.

³³⁵ *Members of the City Council of Los Angeles v. Taxpayers for Vincent*, 466 U.S. 789, 791-92 (1984).

³³⁶ *Id.* at 792-93.

³³⁷ *Id.* at 800.

³³⁸ *Id.* at 789, 801 (1984). See *United States v. Williams*, 128 S. Ct. 1830, 1839 (2008) (“[a]ccording to our First Amendment overbreadth doctrine, a statute is facially invalid if it prohibits a substantial amount of protected speech. The doctrine seeks to strike a balance between competing social costs.”).

³³⁹ *Vincent*, 466 U.S. at 802-03.

³⁴⁰ *Id.* at 804-05.

³⁴¹ *Id.* at 812.

³⁴² *Id.*

³⁴³ Stanford Law School, The Center for Internet and Society, Anthony Falzone, *URAA Held Unconstitutional*, Apr. 3, 2009, <http://cyberlaw.stanford.edu/node/6149>.

reviewed section 514 of the Uruguay Round Agreements Act (“URAA”),³⁴⁴ which required some literary and artistic works removed from the public domain.³⁴⁵ The court remanded the case to the district court for First Amendment scrutiny³⁴⁶ because the URAA “altered the traditional contours of copyright protection” by extending a limited monopoly.³⁴⁷

Subsequently retrying the case, the district court held that section 514 of the URAA violated the First Amendment.³⁴⁸ As both parties conceded that section 514 was content-neutral, the court applied intermediate level of First Amendment scrutiny.³⁴⁹ Since the court’s review of Congress’ judgment is deferential, the court only asked whether the regulation was “substantially broader than necessary to achieve the government’s interest.”³⁵⁰ To answer this question, “the [c]ourt ask[ed] whether the regulation suppresses a substantial amount of protected [public] speech judged in relation to the Government’s legitimate interest.”³⁵¹ If the statute “leaves unprotected a substantial amount of speech not tied to the Government’s interest . . . it is overbroad and unconstitutional.”³⁵² The court placed the burden of proof on the government.³⁵³

Similarly, Justice Breyer, dissenting in *Eldred*, suggested ad-hoc balancing, stating that a copyright statute might be unconstitutional: “(1) if the significant benefits that it bestows are private, not public; (2) if it threatens seriously to undermine the expressive values that the Copyright Clause embodies; and (3) if it cannot find justification in any significant Clause-related objective.”³⁵⁴ Based on this three-part test, he would have decided that the CTEA violated the First Amendment.³⁵⁵

D. Application to the Obama Hope Case

1. External Constitutional Challenge - Prohibiting use of a media photo of a public figure violates the First Amendment as applied to the Obama Hope case

As discussed in Section A, courts tend to avoid determining the constitutionality of the Copyright Act itself. Further, *Fairey* is not a case where Congress altered the traditional contours of copyright protection. However, the First Amendment’s fundamental goals should justify a free speech analysis in this case. *Fairey* created the Obama Hope image for a political purpose to support his choice of presidential candidate Obama.³⁵⁶ As discussed above regarding the First

³⁴⁴ Uruguay Round Agreements Act, Pub. L. No. 103-465, § 514, 108 Stat. 4809, 4976-81 (1994), codified as amended at 17 U.S.C. §§ 104A, 109 (1998 & 2008).

³⁴⁵ *Golan v. Gonzales*, 501 F.3d 1179, 1181-83 (10th Cir. 2007) (“[s]ection 514 of the URAA implements Article 18 of the Berne Convention for the Protection of Literary and Artistic Works[, which] requires member countries to afford the same copyright protection to foreign authors as they provide their own authors”).

³⁴⁶ *Id.* at 1196.

³⁴⁷ *Id.* at 1192.

³⁴⁸ *Golan v. Holder*, 611 F. Supp. 2d 1165, 1177 (D. Colo. 2009).

³⁴⁹ *Id.* at 1170-71.

³⁵⁰ *Id.* at 1171.

³⁵¹ *Id.*

³⁵² *Id.* (quoting *Ashcroft v. Free Speech Coal.*, 535 U.S. 234, 256 (2002)).

³⁵³ *Id.* at 1172.

³⁵⁴ *Eldred v. Ashcroft*, 537 U.S. 186, 245 (2003) (Breyer, J., dissenting).

³⁵⁵ *Id.* at 266-67.

³⁵⁶ *See, e.g.*, Amended Complaint for Declaratory Judgment and Injunctive Relief at 1, *Fairey v. Associated Press*,

Amendment concerns, this case is distinct from previous major copyright cases in that the Obama Hope issue directly involves core First Amendment values—the original work is a public official’s photograph and the purpose of the secondary work was to support the official’s election campaign. It is reasonable to say that the Obama Hope image’s expression can be categorized as speech relating to self-governance, one of the most important goals the First Amendment is designed to protect.³⁵⁷ Hence, the court can validly review the constitutionality of the case by invoking the First Amendment.

The next issue is whether Fairey’s First Amendment challenge against the Copyright Act will be on its face or on its application. Similar to the challenged statute in *Vincent*, the Copyright Act might have an overbreadth problem that “may inhibit the constitutionally protected speech of third parties.”³⁵⁸ However, considering copyright’s long history promoting creation and dissemination of information, important goals of the First Amendment, it seems that there is little “realistic danger that the statute itself will significantly compromise recognized First Amendment protections of [third] parties.”³⁵⁹ In addition, “because of the wide-reaching effects of striking down a statute on its face,” the Court treats the overbreadth doctrine as “strong medicine” and employs it only as a last resort.³⁶⁰ Thus, Fairey’s possible constitutional challenge will not be facial, but as applied to the Obama Hope case.³⁶¹

As stated above, the Supreme Court implicated the First Amendment in cases where federal statutes regulated campaign financial resources on an as-applied basis.³⁶² Accordingly, there seems no problem for the court to apply the same analysis to the Obama Hope case where the Copyright Act regulates Fairey’s campaign intellectual resources. Note that although the Obama Hope case is a dispute between private parties, as in *New York Times v. Sullivan*, a court can infer that the Copyright Act, as applied to this case, imposes invalid restrictions on Fairey’s freedom of speech.³⁶³

The next inquiry arises regarding the appropriate standard of review for this case. On the one hand, different treatment of certain works, by asserting that some of them have higher value under the fair use doctrine, might deem copyright laws content-based.³⁶⁴ On the other hand, the Copyright Act seems content-neutral because the Act regulates all infringing speech and expression without referring to the work’s viewpoints or subject matter. The Act’s “target is not the viewpoint, subject matter, or even communicative impact of the infringer’s speech, but rather

No. 09 CIV 01123 attachment 1 (S.D.N.Y. October 16, 2009), <http://docs.justia.com/cases/federal/district-courts/new-york/nysdce/1:2009cv01123/340121/41/1.html>; see Arnon, *supra* note 27.

³⁵⁷ See *Leachman v. Rector & Visitors of Univ. of Va.*, 691 F. Supp. 961, 964 (W.D. Va. 1988), *aff’d*, 915 F.2d 1564; CHEMERINSKY, *supra* note 319, at 926; SMOLLA, *supra* note 319, § 2:3.

³⁵⁸ *Members of the City Council of Los Angeles v. Taxpayers for Vincent*, 466 U.S. 789, 798 (1984).

³⁵⁹ *Id.* at 801.

³⁶⁰ *New York v. Ferber*, 458 U.S. 747, 768-69 (1982). The Court there also invoked the constitutional avoidance canon, noting that “[w]hen a federal court is dealing with a federal statute challenged as overbroad, it should, of course, construe the statute to avoid constitutional problems, if the statute is subject to such a limiting construction.” *Id.* at 769 n.24.

³⁶¹ See *Vincent*, 466 U.S. at 802-03 & n.22.

³⁶² See *Fed. Election Comm’n v. Wis. Right to Life, Inc.*, 551 U.S. 449, 457 (2007); *Buckley v. Valeo*, 424 U.S. 1, 14 (1976).

³⁶³ See *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 265 (1964).

³⁶⁴ Volokh, *supra* note 268, at 708.

the infringement's deleterious impact on the copyright incentive."³⁶⁵ For the sake of argument, this article will assume the Act's content-neutrality and analyze the Obama Hope case by adopting intermediate scrutiny, which is more deferential to the government, and raising a bar for Fairey to overcome. Moreover, since Fairey asserted the First Amendment as one of his affirmative defenses,³⁶⁶ the burden may be imposed on him to prove the Act's unconstitutionality as applied to his case.

For intermediate scrutiny, the test in *Vincent* will be applicable.³⁶⁷ As for the government's interest, accomplishing the goals of the Copyright Clause seems important/substantial and even compelling. Moreover, the government's interest is theoretically unrelated to the suppression of free expression despite the regulation on the secondary use of the copyrighted expression. But a difficult question is whether the scope of the incidental restriction on Fairey's expression is substantially broader than necessary for the government to accomplish the ends.³⁶⁸ Although the restriction on Fairey's expressive activity may be called "incidental" as a result of the government's attempt to protect copyright, as in other copyright cases, here the copyright owner (the AP) is in a position to determine whether to regulate Fairey's expressive activity. Accordingly, as the Court in *Vincent* implied, a crucial question will be whether Fairey had the adequate remaining modes of communication.³⁶⁹

The copyright restriction on Fairey's expressive activity could deprive him of his only adequate communication method. If the Copyright Act prevents Fairey from using the AP's Obama Photo to express his support for Obama through his Obama Hope image, it is likely that Fairey would have been forced to look for another Obama photograph, possibly leading to a different legal dispute. After all, Senator Obama is a public official who served all the people. Meanwhile, individuals had little chance to take good photographs of him, unlike the media and its professional photographers. Especially in this case, originality of the Obama Photo is thin and its expression is almost identical with its idea.³⁷⁰ Prohibiting the public from using such a factual photograph of a public official to express political thought seems to be substantially broader than necessary to protect media's old copyrighted photograph. Such regulations will likely chill public debate and stifle freedom of speech, which undermines not only Fairey's interest to speak freely, but also the public's ability to receive information. Certainly Fairey had other ways to express his political viewpoint, but other methods would not have been as adequate or effective as his art. Therefore, the copyright restriction as applied to this case violates the First Amendment.

2. Internal Constitutional Challenge—Fairey's political use of the Obama Photo would reinforce his claim under the Copyright Act's internal safeguards

To the extent that courts tend to avoid "external" First Amendment invocation, Fairey

³⁶⁵ Netanel, *supra* note 17, at 49.

³⁶⁶ Motion to Amend/Correct 21 Answer to Counterclaim, 1 Complaint, 35 Answer to Counterclaim at 21 Exhibit B part 2, *Fairey v. Associated Press*, No. 09 CIV 01123 (S.D.N.Y. October 16, 2009), <http://docs.justia.com/cases/federal/district-courts/new-york/nysdce/1:2009cv01123/340121/41/5.html>.

³⁶⁷ *Members of the City Council of Los Angeles v. Taxpayers for Vincent*, 466 U.S. 789, 804-05 (1984).

³⁶⁸ *See id.*

³⁶⁹ *Id.* at 812.

³⁷⁰ *See Ets-Hokin v. SKYY Spirits, Inc.*, 225 F.3d 1068, 1082 (9th Cir. 2000).

could assert a First Amendment defense accommodated by the Copyright Act's internal safeguards (idea/expression dichotomy and the fair use doctrine).³⁷¹ As *Nimmer on Copyright* suggests, since the Act embodies idea/expression dichotomy and the fair use doctrine in order to serve as an "ambassador" representing the Amendment's interest, the court should recognize the Act's spirit.³⁷² Moreover, the Third Circuit stated that:

The spirit of the First Amendment applies to the copyright laws at least to the extent that the courts should not tolerate any attempted interference with the public's right to be informed regarding matters of general interest when anyone seeks to use the copyright statute which was designed to protect interests of quite a different nature.³⁷³

Professor Neil W. Netanel suggested that employing First Amendment principles is necessary for copyright's internal safeguards to actually protect First Amendment values.³⁷⁴ Thus, emphasizing First Amendment values will likely reinforce Fairey's claim under the internal safeguards of the Copyright Act discussed in Part II and III above.

First, as in the Obama Hope case, when it is difficult to distinguish an idea from its expression, and when originality is "thin," courts should inject more spirit of the First Amendment when reviewing copyright infringement issues.³⁷⁵ As noted above, courts consider substantial similarity by comparing an original work and its secondary work qualitatively as well as quantitatively.³⁷⁶ In light of the First Amendment's goal, Fairey should stress his use of the Obama Photo as political speech for a self-governance purpose. If the court invalidates his expressive activity as copyright infringement in order to protect an old photograph of a public official, such a regulation will seriously undermine both the First Amendment goal and the Copyright Act's purpose. Consequently, despite the quantitative similarity between Fairey's image and the photograph, there is no substantial qualitative similarity between an old media photograph of a politician and an iconic collage of a presidential candidate. Particularly in this case, since the original idea of Obama and his expression are almost identical, copyright limitation on Fairey's expressive activity based on the idea/expression dichotomy seems to fail to serve the First Amendment interest.

Second, a fair use defense, especially transformative use, may be the place where the spirit of the First Amendment can work more effectively.³⁷⁷ Based on the inquiry for transformative use, Fairey can emphasize that his political use had completely different purpose

³⁷¹ See *Eldred v. Ashcroft*, 537 U.S. 186, 221 n.24 (2003) (comparing to *United States v. X-Citement Video, Inc.*, 513 U.S. 64, 78 (1994)).

³⁷² See NIMMER, *supra* note 66, § 19E.05 [C][2].

³⁷³ *Video Pipeline, Inc. v. Buena Vista Home Entm't, Inc.*, 342 F.3d 191, 205 (3d Cir. 2003).

³⁷⁴ Netanel, *supra* note 317, at 31.

³⁷⁵ See NIMMER, *supra* note 66, § 19E.05[C][2] ("the explicit instruction to construe the copyright mechanisms to carry the weight of the First Amendment may inject a fresh spirit into the [idea/expression and fair use] doctrines, especially in borderline cases").

³⁷⁶ See *Ringgold v. Black Entm't Television, Inc.*, 126 F.3d 70, 75 (2d Cir. 1997).

³⁷⁷ See NIMMER, *supra* note 66, § 19E.05[C][2] ("the fair use defense is recognized as not merely a nicety of copyright law. It is tasked by the Constitution to be the First Amendment's ambassador in the territory of copyright, to champion free speech concerns; hence, it cannot be abolished or even narrowed.").

from the AP's commercial or journalistic use, which is strongly factual. In addition to the Obama Hope image's new purpose and character discussed in Part III, the court should also take First Amendment values into consideration. For example, in analyzing the first factor of fair use, the Ninth Circuit stated that parody has "socially significant value as free speech under the First Amendment."³⁷⁸ Since political speech arguably has more significant value than parody, the court should recognize the self-governance value of the First Amendment in Fairey's use. Emphasis on political use will also make a difference in the fourth factor, effect on the market. It is very unlikely that such political speech for the presidential campaign usurps any actual or potential derivative markets of the AP's unused news photograph because the two works serve completely different markets. The political use of the Obama Hope image was transformatively different from journalistic use of the Obama Photo.

V. Conclusion

Overall, despite his admission that he deleted evidence, Fairey has a significant chance to win his case. First, Fairey's Obama Hope is protected by the idea/expression dichotomy because his work is not substantially similar to the Obama Photo's protected elements. Since the Obama Photo has thin originality and its idea and expression could almost merge, Fairey's modification of the original work is likely sufficient. Second, even assuming that the court finds substantial similarity between both works, Fairey created the Obama Hope image for such a different purpose that the fair use doctrine protects his work. Third, in light of the First Amendment's purpose, Fairey's political use of the original AP photograph depicting a public official should exonerate Fairey's appropriation. The Copyright Act as applied to this case violates the First Amendment, while the Amendment's value would strengthen Fairey's claim for non-substantial similarity and his fair use defense. There is still hope for Fairey.

³⁷⁸ *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 801 (9th Cir. 2003).

Appendix



Obama Hope Collage by Shepard Fairey



© 2007 Jim Young / Reuters



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Jim Young/Reuters



© 2006 Mannie Garcia / The Associated Press



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Obama Photo by the AP/Mannie Garcia



Obama Hope Poster by Shepard Fairey



Clooney Photo by the AP/Mannie Garcia



Puppies by Art Rogers



String of Puppies by Jeff Koons