No. 14-815

IN THE

Supreme Court of the United States

MICHAEL KIENITZ,

Petitioner,

v.

SCONNIE NATION, LLC, *et al.*,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

BRIEF *AMICUS CURIAE* OF THE MEDIA INSTITUTE IN SUPPORT OF PETITIONER

RODNEY A. SMOLLA
Counsel of Record
225 Herty Drive
Athens, Georgia 30602
(864) 373-3882
rodsmolla@gmail.com

Counsel for Amicus Curiae

257752

COUNSEL PRESS
(800) 274-3321 • (800) 359-6859

TABLE OF CONTENTS

Page

TABLE OF CONTENTS. i

TABLE OF CITED AUTHORITIES iii

BRIEF *AMICUS CURIAE* OF THE MEDIA INSTITUTE IN SUPPORT OF PETITIONER 1

INTERESTS OF *AMICUS CURIAE* 1

SUMMARY OF ARGUMENT. 2

ARGUMENT. 6

I. THIS COURT SHOULD GRANT THE PETITION TO CLARIFY THE CRITICAL DISTINCTION BETWEEN PARODY AND SATIRE IN THE APPLICATION OF THE FAIR USE DOCTRINE. 6

II. THIS COURT SHOULD GRANT THE PETITION TO DISTINGUISH THE NOTION OF "TRANSFORMATION" THAT DEFINES A DERIVATIVE WORK FROM THE "TRANSFORAMATION" REQUIRED TO JUSTIFY FAIR USE. 8

III. THIS COURT SHOULD GRANT THE PETITION TO PREVENT THE FAIR USE DOCTRINE FROM DEVELOPING IN A MANNER THAT EVISCERATES THE COPYRIGHT PROTECION THAT ATTACHES TO PHOTOGRAPHS 14

Table of Contents

Page

IV. THIS COURT SHOULD GRANT THE PETITION TO PREVENT THE FAIR USE DOCTRINE FROM CIRCUMVENTING THE CAREFULLY TAILORED REMEDIAL FLEXIBILITY PROVIDED FOR IN THE COPYRIGHT ACT TO REDRESS INFRINGMENTS 20

CONCLUSION 23

TABLE OF CITED AUTHORITIES

Page

Cases

Bleistein v. Donaldson Lithography Co.,
188 U.S. 239 (1903) 15, 17

Burrow-Giles Lithographic Co. v. Sarony,
111 U.S. 53 (1884) 14

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

Cariou v. Prince,
714 F.3d 694 (2d Cir.), *cert. denied*,
134 S. Ct. 618 (2013) . . . . . *passim*

Graves' Case,
L.R. 4 Q.B. 715 (1869) 14

Gross v. Seligman,
212 F. 930 (2d Cir.1914) 19

Harper & Row Publishers, Inc. v.
Nation Enterprises,
471 U.S. 539 (1985) 21

Jewelers' Circular Pub. Co. v. Keystone Pub. Co.,
274 F. 932 (S.D.N.Y.1921) 15

Kienitz v. Sconnie Nation LLC,
766 F.3d 756 (7th Cir. 2014) . . . . . *passim*

Cited Authorities

Page

Leibovitz v. Paramount Pictures Corp.,
137 F.3d 109 (2d Cir. 1998) 18

Manion v. Coors Brewing Company,
377 F. Supp. 2d 444 (S.D.N.Y. 2005). 17, 18

N.A.A.C.P v. Button,
371 U.S. 415 (1963) 9

New York Times Co. v. Sullivan,
376 U.S. 254 (1964). 9

Rogers v. Koons,
960 F.2d 301 (2d Cir. 1992) 15

SHL Imaging, Inc. v. Artisan House, Inc.,
117 F. Supp. 2d 301 (S.D.N.Y.2000) 19

Stewart v. Abend,
495 U.S. 207 (1990). 10

Thomas v. Weller,
281 N.W.2d 790 (Neb. 1979). 22

Time Inc. v. Bernard Geis Assoc.,
293 F. Supp. 130 (S.D.N.Y. 1968) 19

Wheelock v. Noonan,
108 N.Y. 179, 15 N.E. 67 (1888) 22

Zalewski v. Cicero Builder Dev., Inc.,
754 F.3d 95 (2d Cir. 2014) 20

Cited Authorities

Page

Statutes and Other Authorities

U.S. Const., art. I. § 8, cl. 8 8

17 U.S.C. § 101 10

17 U.S.C. § 107(4) 20

17 U.S.C. § 504(c) 22

Supreme Court Rule 37.6 1

Charles Sanders & Steven Gordon, Strangers in Parodies: *Weird Al and the Law of Musical Satire*, 1 Fordham Intell. Prop. Media & Ent. L.J. 11 (1990) 7

Lewis Carroll, *Alice's Adventures in Wonderland 101* (Richard Kelly, ed., Broadview Press 2000) (1865) 16

Pierre Leval, "Toward a Fair Use Standard," 103 Harv. L. Rev. 1105 (1990) 11

BRIEF *AMICUS CURIAE* OF THE MEDIA INSTITUTE IN SUPPORT OF PETITIONER

Amicus Curiae The Media Institute respectfully submits this Brief in Support of the Petitioners urging this Court to grant the Petition for a Writ of Certiorari. All parties have consented to the filing of this Brief.[1]

INTERESTS OF *AMICUS CURIAE*

The Media Institute is a nonprofit research foundation specializing in communications policy issues. The Institute exists to foster such values as freedom of speech, a competitive media and communications industry, excellence in journalism, and protection of intellectual property. Founded in 1979, The Media Institute pursues an active program agenda that encompasses virtually all sectors of the media, ranging from traditional print and broadcast outlets to newer entrants such as cable, satellites, and online services. The Institute publishes books and monographs, prepares regulatory filings and court briefs, convenes conferences, and sponsors a luncheon series in Washington for journalists and communications executives. The Media Institute has evolved into one of the country's leading organizations focusing on the First Amendment and communications policy. The Media Institute takes a strong interest in the

1. Pursuant to Supreme Court Rule 37.6, *Amicus Curiae* states that no counsel for any party authored this Brief in whole or in part and that no entity or person, aside from *Amicus Curiae*, its members, and its counsel, made any monetary contribution toward the preparation or submission of this Brief. The parties have received at least 10 days' notice and both have consented to the filing of this brief.

protection of intellectual property, especially copyright protection, pursuant to the vision of the Framers of the Constitution that robust protection for intellectual property under the Patent and Copyright Clause acts to enhance the marketplace of ideas.

SUMMARY OF ARGUMENT

This Court should grant the Petition to review an errant expansion of the fair use doctrine that is gaining traction among lower courts. This expansion treats a secondary work's "transformative use" of an original copyrighted work as largely sufficient, in itself, to bring the secondary work within the shelter of the fair use doctrine. The Second Circuit began the expansion in *Cariou v. Prince*, 714 F.3d 694 (2d Cir.), *cert. denied*, 134 S.Ct. 618 (2013), by improperly granting fair use protection to "appropriation art," in which the perceived artistic value of the second work comes precisely from its appropriation of a underlying work, even though the second work is not a parody of or comment upon the underlying work. The Seventh Circuit advanced the damage in the case below, *Kienitz v. Sconnie Nation LLC*, 766 F.3d 756 (7th Cir. 2014) (App. 1). While the Seventh Circuit in *Kienitz* rejected the Second Circuit's transformative use doctrine, thereby creating a Circuit split, the court in *Kienitz* proceeded to apply a test every bit as flawed and every bit as destructive of the rights of copyright holders.

There are in reality two splits at large among lower courts germane to this Petition. The first is the doctrinal split between the Second and Seventh Circuits on the role of the transformative use element in fair use analysis. The second, arguably the more significant split, involves the

question of what elements are and are not protected in a photograph of a real object or person, and the extent to which a "lazy appropriator" may make an actual copy of a copyrighted photograph, alter it through colorization, and avoid liability for infringement on the theory that only unprotected elements of the original have been taken. The decision of the Seventh Circuit is in tension with a number of other lower court decisions defining the nature of the protected elements in photography, and this Court's clarification of that issue is sorely needed.

More significant than the divisions among lower courts in their articulation of formal doctrine, however, are the pernicious consequences these emerging lines of errant precedent visit upon the rights of copyright holders, especially photographers. This Brief focuses on four of those highly destructive consequences.

First, both the Seventh Circuit and Second Circuit approaches effectively eviscerate the fundamental distinction between parody and satire, a distinction central to this Court's landmark ruling in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994). In parody some use of an underlying work is unavoidable, because the parodist must mimic in order to make the parody's comedic or critical point. With satire, however, exploitation of the underlying work is easily avoidable. The nascent expansion of fair use doctrine in *Kienitz* and *Cariou* essentially places parody and satire on the same plane. This wrongly grants to satirists a free license to exploit underlying works, even in the absence of any nexus between the message communicated by the satirist and critique of the substance or style of the underlying work.

Second, the emerging expansion of the fair use doctrine threatens to envelop and overrun the Copyright Act's protection of derivative works. Derivative works are by definition "transformations," "recastings," or "adaptations" of underlying works. To the extent that such transformation is treated as fair use, the copyright holder's entitlement to control derivative works is largely destroyed.

Third, the holdings in *Kienitz* and *Cariou* have a particularly damaging impact on the copyright protection granted to photographers. The underlying works exploited in both the Second and Seventh Circuit decisions were photographs. The expansion of fair use underway in the courts below invite any "lazy appropriator" to take the free-riding shortcut of exploiting existing copyrighted photographs to create new works, a result inconsistent with both common law precedent and the intent of Congress.

Finally, this expansion of fair use conflates the remedy that may be appropriate in infringement actions arising from the exploitation of photographs with the predicate issue of liability. It may well be that in some cases the economic harm caused by any one isolated piracy of a copyrighted photograph is negligible. The Copyright Act's answer, however, is to tailor the remedy, not to destroy the underlying right. Fair use is a blunt all-or-nothing instrument; when successfully invoked it entirely destroys the copyright holder's rights. The remedial provisions of the Copyright Act, in contrast, contain refined and precise instruments, allowing a court to preserve the right while circumscribing the remedy. Infringements of intellectual property, like trespasses on real property,

often involve only nominal economic damage. Yet the law has always empowered courts to enforce a property owner's right to redress for infringement or trespass, even when economic harm is nominal, by empowering courts to adjust the remedy to fit the equities of the specific case. The Copyright Act, for example, provides for awards of statutory damages in lieu of compensatory damages, and courts retain inherent equitable discretion in awarding and tailoring injunctive relief.

While fair use doctrine does require courts to consider the damage caused in the marketplace by a secondary work, this should not be a door that swings both ways. When the second work creates a substitute in the market for the underlying work, a finding of fair use is almost never warranted. The very fact that the second work acts as a substitute for the first is usually a powerful indicator that the use is not fair. But the converse is not true. It does not follow that the absence of economic damage proves that the use *is* fair. When a lazy appropriator gratuitously copies a photograph to create a satiric work that does not critique the substance or style of the photograph, an infringement occurs. The lack of demonstrable economic harm should not turn what would otherwise be an infringement into a fair use. To the extent the negligible economic harm matters in such a case, it speaks to the fashioning of the remedy, not the existence of the right.

ARGUMENT

I. THIS COURT SHOULD GRANT THE PETITION TO CLARIFY THE CRITICAL DISTINCTION BETWEEN PARODY AND SATIRE IN THE APPLICATION OF THE FAIR USE DOCTRINE.

Campbell's discussion of "transformative use" cannot be separated from *Campbell's* discussion of "parody." In *Campbell* the two concepts were joined at the hip. The recent expansion of fair use is breaking that joint, letting "transformative use" stand on its own, wrenched from its moorings in parody.

The essence of parody is comment or critique of the underlying work. The underlying work must first be mimicked or conjured in some way so that it can be critiqued—typically through comedic ridicule. The "transformation" talked about in *Campbell* was the transformation of the *parodist*—who takes the original work and turns a transformative spin upon it for the purpose of making the parodist's point. As the Court in *Campbell* explained: "For the purposes of copyright law, the nub of the definitions, and the heart of any parodist's claim to quote from existing material, is the use of some elements of a prior author's composition to create a new one that, at least in part, comments on that author's works." *Campbell*, 510 U.S. at 580.

In contrast, when the allegedly infringing work is not a parody—when it does not comment in style or substance on the original work—the justification for the appropriation is drastically reduced, to point that it may vanish altogether: "If, on the contrary, the commentary

has no critical bearing on the substance or style of the original composition, which the alleged infringer merely uses to get attention or to avoid the drudgery in working up something fresh, the claim to fairness in borrowing from another's work diminishes accordingly (if it does not vanish), and other factors, like the extent of its commerciality, loom larger." *Id.* *Campbell* thus contrasted parody with satire. Parody *must* mimic, but satire need not. "Parody needs to mimic an original to make its point, and so has some claim to use the creation of its victim's (or collective victims') imagination, whereas satire can stand on its own two feet and so requires justification for the very act of borrowing." *Id.* at 580-81.

Treating satire as inferior to parody for fair use purposes will cause no troublesome disruptions on the laudable work of satirists or the important place of satire in our cultural and our constitutional traditions. Requiring a satirist to obtain a license for the privilege of exploiting an underlying work imposes no untoward burden on the art of satire. The most successful music satirist in modern American popular culture, "Weird Al" Yankovic, always obtains copyright permission from the copyright holders of the underlying music that he appropriates for his ingenious song satires (even though some of Yankovic's songs are arguably parodies). *See* Charles Sanders & Steven Gordon, *Strangers in Parodies: Weird Al and the Law of Musical Satire*, 1 Fordham Intell. Prop. Media & Ent. L.J. 11 (1990).

The burden of imposing an obligation on the satirist to obtain a license, but not on the parodist, is justified by the straightforward analysis explained so cogently in *Campbell*. The societal interests vindicated by the fair use

doctrine are grounded in the underlying constitutional purposes of copyright itself—"[t]o promote the Progress of Science and the useful Arts." U.S. Const., art. I. § 8, cl. 8; *Campbell*, 510 U.S. at 575. That progress would be imperiled if parodists could not lift from originals. Progress is not imperiled, however, when a satirist who has no need to lift from an original pirates it merely to "avoid the drudgery in working up something fresh." *Id.* at 580.

In this case, the Seventh Circuit called Sconnie out for what it was—a lazy appropriator. *Kienitz*, 766 F.3d at 759 (App. 6) ("There's no good reason why defendants should be allowed to appropriate someone else's copyrighted efforts as the starting point in their lampoon, . . . [t]he fair-use privilege under § 107 is not designed to protect lazy appropriators."). Once so exposed, the satirist forfeits any persuasive claim to the shelter of the fair use doctrine. The fair use doctrine is best understood as a common-law and statutory easement, permitting the free appropriation of the intellectual property of the copyright holder in the service of larger societal interests. Laziness, however, is not among them.

II. THIS COURT SHOULD GRANT THE PETITION TO DISTINGUISH THE NOTION OF "TRANSFORMATION" THAT DEFINES A DERIVATIVE WORK FROM THE "TRANSFORAMATION" REQUIRED TO JUSTIFY FAIR USE.

"Transformation" is a concept that resides in two places in copyright law—it is an important factor in fair use analysis and a core defining characteristic of a

derivative work. Transformation, however, cannot mean the same thing in both instances. This Court's attention is urgently needed to clarify what sort of transformation counts in the balance for fair use purposes, and what sort of transformation does not.

Addressing the fair use version of transformation, this Court in *Campbell* explained that "[a]lthough such transformative use is not absolutely necessary for a finding of fair use, . . the goal of copyright, to promote science and the arts, is generally furthered by the creation of transformative works." *Campbell*, 510 U.S. at 579 (citation omitted). The Court thus held that "[s]uch works thus lie at the heart of the fair use doctrine's guarantee of breathing space within the confines of copyright." *Id.* (citation omitted). The Court's use of the phrase "breathing space," coupled with the Court's lengthy discussion of the differences between parody and satire, indicate that the "transformation" the Court in *Campbell* was describing was transformation arising from critique of the original work—the "transformation" required of the parodist, however, in order to mock the work being mimicked. "Breathing space" was a term borrowed from free speech jurisprudence. *See New York Times Co. v. Sullivan*, 376 U.S. 254, 298 (1964) ("The prized American right 'to speak one's mind' . . . needs 'breathing space to survive.'") (quoting *N.A.A.C.P v. Button*, 371 U.S. 415, 433 (1963) (citation omitted). In an unmistakable allusion to the free speech values embedded in the fair use doctrine, the Court in *Campbell* thus explained that breathing space is needed to prevent copyright from acting as a monopoly that immunizes the original creator from critique or comment upon the original work. *Campbell*, 510 U.S. at 579.

In contrast, Congress also used the word "transformed" in its definition of "derivative work":

> A "derivative work" is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, *transformed*, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a "derivative work".

17 U.S.C. § 101 (emphasis added). To lift a photograph and use it to produce a t-shirt is a quintessential example of a derivative work. *See Stewart v. Abend*, 495 U.S. 207, 220 (1990) (articulating the importance of derivative works, observing that "[a]n author holds a bundle of exclusive rights in the copyrighted work, among them the right to copy and the right to incorporate the work into derivative works"). If a derivative work, as defined by Congress, includes "any form" by which a work may be "recast, transformed, or adapted," it is simply incoherent to treat any work that is "transformative" as protected "fair use." 17 U.S.C. § 101. This would equate "fair use" with "derivative work" and flip the law on its head.

The most rational way to reconcile the notion of transformation in fair use doctrine with the notion of transformation in derivative works is to draw the line exactly as *Campbell* suggested it be drawn. When the prior work is taken and new material is added to transform

it in a manner that does not critique or comment upon the underlying work, it is the sort of transformation that characterizes a derivative work and may not be done without a license from the copyright holder. On the other hand, when the transformation falls within a *unique subset* of transformations in which the underlying work is in some manner being critiqued or commented upon, it may qualify as the sort of transformation that counts positively toward a finding of fair use.

Judge Pierre Leval's law review article on fair use is arguably the most influential scholarly effort ever written on the doctrine, in no small part because of this Court's heavy reliance on the article in its opinion in *Campbell*. *See* Pierre Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105 (1990). The ubiquitous influence of Judge Leval's article in *Campbell* may have set an all-time record. *See Campbell*, 510 U.S. at 576, 576 n. 8, 578, 578 n.10, 579, 585 n.18, 586, 587, 590, 591 n.21, 592, 593 n.23 (citations to the article).

If the Court in *Campbell* was heavily channeling Judge Leval's analysis of fair use, it was simultaneously channeling Judge Leval's emphasis on the element of "transformation" in fair use analysis. *See Campbell*, 510 U.S. at 575-77. The centerpiece of Judge Leval's article was his exploration of transformative use, which he conceived as *entirely* about critique or comment (broadly defined) on the original. Indeed, Judge Leval's article, like *Campbell*'s later elaboration, explicitly contrasted transformation in the sense of a nexus to the substance or style of the original, and free-riding, which ought *not* be protected. Leval, 103 Harv. L. Rev. at 1111, 1116 ("Transformative uses may include criticizing the quoted

work, exposing the character of the original author, proving a fact, or summarizing an idea argued in the original in order to defend or rebut it. They also may include parody, symbolism, aesthetic declarations, and innumerable other uses. . . .The first fair use factor calls for a careful evaluation whether the particular quotation is of the transformative type that advances knowledge and the progress of the arts *or whether it merely repackages, free riding on another's creations*. If a quotation of copyrighted matter reveals no transformative purpose, fair use should perhaps be rejected without further inquiry into the other factors. Factor One is the soul of fair use. A finding of justification under this factor seems indispensable to a fair use defense.") (emphasis supplied).

Curiously, the Seventh Circuit's opinion in *Kienitz* got this point exactly right, and properly *rejected* the analysis in *Cariou*:

> We're skeptical of *Cariou's* approach, because asking exclusively whether something is "transformative" not only replaces the list in § 107 but also could override 17 U.S.C. § 106(2), which protects derivative works. To say that a new use transforms the work is precisely to say that it is derivative and thus, one might suppose, protected under § 106(2). *Cariou* and its predecessors in the Second Circuit do not explain how every "transformative use" can be "fair use" without extinguishing the author's rights under § 106(2).

Kienitz, 766 F.3d at 758 (App. 4).

So much, so good. But after ostensibly rejecting the Second Circuit's *Cariou* transformation test, the Seventh Circuit replaced it with a "test" every bit as bad, excusing a blatant act of infringement under the fair use doctrine merely because the infringer, in the Seventh Circuit's view, worked enough changes on the original photograph to strip that photograph of the elements that merited the original's copyright protection in the first place. *Id.* at 759 (App. 4-5).

Inexplicably, the Seventh Circuit actually *conceded* that there are no cogent policy reasons for protecting the appropriation of the Kienitz photograph. The Seventh Circuit thus conceded that the piracy of the Kienitz photograph was gratuitous. Sconnie Nation did not need to take Kienitz' photograph in order to make t-shirts depicting and criticizing Mayor Soglin. Sconnie could have taken its own photograph or simply drawn the Mayor's face. As the Seventh Circuit admitted:

> First, defendants did not need to use the copyrighted work. They wanted to mock the Mayor, not to comment on Kienitz's skills as a photographer or his artistry in producing this particular photograph. There's no good reason why defendants should be allowed to appropriate someone else's copyrighted efforts as the starting point in their lampoon, when so many noncopyrighted alternatives (including snapshots they could have taken themselves) were available. The fair-use privilege under § 107 is not designed to protect lazy appropriators. Its goal instead is to facilitate a class of uses that would not be possible if users always had

> to negotiate with copyright proprietors. (Many copyright owners would block all parodies, for example, and the administrative costs of finding and obtaining consent from copyright holders would frustrate many academic uses.)

Id. at 759 (App. 6). This analysis was entirely sound. There was *no need* for Sconnie to take Kienitz's work. Yet a use cannot be fair when it cannot be justified. A use cannot be justified when it is entirely gratuitous—when laziness, pure and simple, is the only plausible explanation for the taking. Having started with such an elegant wind-up, however, the Seventh Circuit failed to deliver the pitch. The court instead balked, granting Sconnie a fair use defense because of the changes it made to the Kienitz photograph. *Id.* at 759 (App. 4-5).

III. THIS COURT SHOULD GRANT THE PETITION TO PREVENT THE FAIR USE DOCTRINE FROM DEVELOPING IN A MANNER THAT EVISCERATES THE COPYRIGHT PROTECION THAT ATTACHES TO PHOTOGRAPHS.

Photography is no orphaned poor relation in copyright law. To the contrary, many of the great cases that have shaped the law of copyright have involved protection of the rights of photographers. *See, e.g., Graves' Case*, L.R. 4 Q.B. 715, 723 (1869) (Blackburn, J.) ("[A]ll photographs are copies of some object, such as a painting or a statue. And it seems to me that a photograph taken from a picture is an original photograph, insofar that to copy it is an infringement of this statute."); *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884) (sustaining copyright protection for photographs of Oscar Wilde);

Rogers v. Koons, 960 F.2d 301, 307 (2d Cir. 1992) ("Elements of originality in a photograph may include posing the subjects, lighting, angle, selection of film and camera, evoking the desired expression, and almost any other variant involved.") (citation omitted); *Jewelers' Circular Pub. Co. v. Keystone Pub. Co.*, 274 F. 932, 934 (S.D.N.Y.1921) (Hand, J) ("[N]o photograph, however simple, can be unaffected by the personal influence of the author.").

The photographic portrait of Mayor Soglin was captured from real life. But that reality does not defeat the copyright protection that inures in that realistic photo. As Justice Holmes explained:

> It is obvious also that the plaintiff's case is not affected by the fact, if it be one, that the pictures represent actual groups,—visible things. They seem from the testimony to have been composed from hints or description, not from sight of a performance. But even if they had been drawn from the life, that fact would not deprive them of protection. The opposite proposition would mean that a portrait by Velasquez or Whistler was common property because others might try their hand on the same face.

Bleistein v. Donaldson Lithography Co., 188 U.S. 239, 249 (1903).

The damage done to the art of photography by the Seventh Circuit was accomplished in the four load-bearing sentences upon which the decision rested:

> Defendants removed so much of the original that, as with the Cheshire Cat, only the smile remains. Defendants started with a low-resolution version posted on the City's website, so much of the original's detail never had a chance to reach the copy; the original's background is gone; its colors and shading are gone; the expression in Soglin's eyes can no longer be read; after the posterization (and reproduction by silk-screening), the effect of the lighting in the original is almost extinguished. What is left, besides a hint of Soglin's smile, is the outline of his face, which can't be copyrighted. Defendants could have achieved the same effect by starting with a snap-shot taken on the street.

Kienitz, 766 F.3d at 759 (App. 4-5).

The Seventh Circuit's Cheshire Cat analysis, while impishly literate, was conceptually flawed. The body of the Cheshire Cat in *Alice* was able to mystically disappear, leaving only its lingering grin. Alice reflected that she had "often seen a cat without a grin," but never "a grin without a cat!" Lewis Carroll, *Alice's Adventures in Wonderland* 101 (Richard Kelly, ed., Broadview Press 2000) (1865). Kienitz' photograph of Soglin, however, did not disappear when transferred to the t-shirt. It was copied verbatim, transferred, and altered, processes quite different from those imagined by Lewis Carroll, whether considered through the looking glasses of literature, logic, or law.

Imagine that a photographer *does* photograph a real cat, caught in Cheshire Cat smile. A lazy t-shirt vendor has

no right to pirate the photo, change the color of the cat to green, and use the resulting image to produce silk-screen t-shirts for profit. It is still the *photographer's photograph* that has been taken, and while there may be no ownership in the image of a cat or a cat's Cheshire smile, there *is* ownership in the photographer's photographic copy of the cat. In the words of Justice Holmes: "Others are free to copy the original. They are not free to copy the copy." *Bleistein*, 188 U.S. at 249 (citations omitted).

This Court may examine for itself the original photograph Kienitz and Sconnie's t-shirt rendition of that photo. Even to an amateur's unschooled eye it is plain that the protected elements of the original have been replicated. To dismiss this manifest infringement as no more serious than absconding with the smile of the Cheshire Cat is to degrade the copyright protection of all photographs drawn from reality.

Tellingly, the significant photography cases in other federal courts have not involved appropriations so brazen as that in *Kienitz*, in which the second user actually lifts the photograph of the original photographer and alters it through photo-shopping or moving it to a new medium. In cases in which other courts have struggled with the fair use question, the defendant has *not* lifted the actual photo, but taken a new photo that mimics elements of the original.

In *Manion v. Coors Brewing Company*, 377 F. Supp. 2d 444 (S.D.N.Y. 2005), for example, the court described the protected elements of a photograph of the popular professional basketball player Kevin Garnett. The allegedly infringing work was not lifted mechanically from

the original Garnett photo, but was rather a new image created through photographing an African-American model posing in a manner mimicking the original Garnett photo. The court in *Manion* eschewed the sort of mechanistic analysis employed by the court in *Kienitz*. In a key passage, the court correctly observed:

> It sometimes is said that "copyright in the photograph conveys no rights over the subject matter conveyed in the photograph." But this is not always true. It of course is correct that the photographer of a building or tree or other pre-existing object has no right to prevent others from photographing the same thing. That is because originality depends upon independent creation, and the photographer did not create that object. By contrast, if a photographer arranges or otherwise creates the subject that his camera captures, he may have the right to prevent others from producing works that depict that subject.

Id. at 450 (internal footnote citations omitted). In a simplistic literal sense, the court observed, there was no copyright protection inuring to Garnett's face, hands, or torso. *Id.* at 455. Even so, however, the court soundly held that originality may subsist in what the court described as the photographer's *rendition* of the underlying subject. *Id.* at 452. *See also Leibovitz v. Paramount Pictures Corp*., 137 F.3d 109 (2d Cir. 1998) (finding fair use in a parody by Paramount Pictures of a famous photograph by Annie Leibovitz on the cover of *Vanity Fair* of a nude and pregnant Demi Moore, but noting that even though Paramount had taken its own new photograph using a

model made up to resemble Demi Moore, it had copied enough elements of the original Liebovitz photograph to have rendered the Paramount photograph an infringement had it not been saved as a parody and fair use).

For the purposes of this Petition, the essential point is that the Seventh Circuit's decision in *Kienitz*, with its exceptionally ungenerous holding as to what elements are protected in a photograph, is a dramatic conceptual departure from the assumptions and understandings of other courts. *See, e.g., Gross v. Seligman*, 212 F. 930, 931 (2d Cir.1914) ("exercise of artistic talent" reflected in "pose, light, and shade, etc."); *SHL Imaging, Inc. v. Artisan House, Inc.*, 117 F. Supp. 2d 301, 311 (S.D.N.Y.2000) ("What makes plaintiff's photographs original is the totality of the precise lighting selection, angle of the camera, lens and filter selection."). While courts have labored over the extent to which a second *new* photograph largely duplicating the first is infringing, until *Kienitz* there appeared to be no doubt that to audaciously copy and morph the original was out of bounds. It is no answer for the Seventh Circuit to say that there is no copyright in Mayor Soglin's face. This is not a suit brought by Soglin for appropriation of name or likeness. This is a suit brought by Kienitz for appropriation of his photograph.

There are rare cases in which a photograph or video captures the only extant images of a highly newsworthy public event, so that secondary use of the photograph might be deemed a fair use because it is impossible otherwise to analyze the underlying event. *See Time Inc. v. Bernard Geis Assoc.*, 293 F.Supp. 130 (S.D.N.Y. 1968) (involving the unique video footage captured by Abraham Zapruder of the assassination of President Kennedy.)

Under the "merger doctrine" copyright protection may be denied when the idea underlying the copyrighted work can be expressed in only one way. *See Zalewski v. Cicero Builder Dev., Inc.,* 754 F.3d 95, 102-03, (2d Cir. 2014).

In the Kienitz photo, however, as in the vast run of cases, the photograph and the underlying reality are not merged, and the photograph stands on its own as the exclusive property of the photographer. The Seventh Circuit's analysis threatens to render photography a free-fire zone for free-riders. Even with parody—where the case for fair use is at its zenith—protection is not absolute, as the Court in *Campbell* repeatedly warned. *See Campbell,* 510 U.S. at 581 (noting that "parody may or may not be fair use" and "like any other use, has to work its way through the relevant factors, and be judged case by case, in light of the ends of the copyright law"). When the level of comment on the original work is zero, the willingness of courts to extend fair use protection to a free-riding appropriator should approach zero tolerance.

IV. THIS COURT SHOULD GRANT THE PETITION TO PREVENT THE FAIR USE DOCTRINE FROM CIRCUMVENTING THE CAREFULLY TAILORED REMEDIAL FLEXIBILITY PROVIDED FOR IN THE COPYRIGHT ACT TO REDRESS INFRINGMENTS.

It is a truism of fair use analysis that courts should consider the damage caused in the marketplace by a secondary work. Congress explicitly instructed courts in Section 107 to consider "the effect of the use upon the potential market for or value of the copyrighted work." 17 U.S.C. § 107(4). Yet this should not be a door that swings both ways.

When the second work creates a substitute in the market for the underlying work, a finding of fair use is almost never warranted. This was the key to the Court's holding in *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539 (1985), in which the *Nation* magazine scooped and quoted from the heart of President Gerald Ford's most newsworthy revelations in his forthcoming memoir, effectively substituting the reading of the article for the reading of the book. As *Harper & Row* clearly demonstrates, the very fact that the second work acts as a substitute for the first is usually a powerful indicator that the use is not fair.

But the converse is not true. It does not follow that the absence of economic damage proves that the use *is* fair. When a lazy appropriator gratuitously copies a photograph to create a satiric work that does not critique the substance or style of the photograph, an infringement occurs, and the lack of demonstrable economic harm should not turn what would otherwise be an infringement into a fair use. To the extent that the negligible nature of the economic harm matters in such a case, it speaks to the fashioning of the remedy, not the existence of the right.

The decision below improperly conflated right with remedy. The fair use doctrine is a blunt instrument. Once activated, the intellectual property claim of the copyright holder is entirely eliminated. Fair use operates in an all-or-nothing manner, working to entirely extinguish liability. In contrast, the Copyright Act's remedial scheme provides courts with very precise and delicate instruments. A court may tailor the remedies to the equities, thereby vindicating the regime of rights that Congress has created.

It may well be that a plaintiff such as Kienitz may only be able to establish modest compensatory damages for the appropriation of his photograph. Indeed, a plaintiff such as Kienitz might well elect to forgo compensatory damages altogether and instead seek recovery of statutory damages as provided in the Copyright Act. See 17 U.S.C. § 504(c) (allowing a plaintiff to elect statutory damages of not less than $750 or more than $30,000 as the court deems just, in lieu of actual damages and disgorging of profits of the infringer). Similarly, as this Court instructed in *Campbell*, courts have inherent equitable discretion over whether to grant an injunction, and may grant or refuse injunctive relief, or tailor the nature of any injunction, to reflect the balance of interests in any given case. *Campbell*, 510 U.S. at 578 n.10.

The integrity of the intellectual property is undermined when courts confuse the scope of the remedy with the size of the right. A landowner is entitled to redress from the trespasser who repeatedly encroaches on the owner's land, even when the damage to the land appears nominal. *See Thomas v. Weller*, 281 N.W.2d 790 (Neb. 1979) (enjoining deer hunter who annually trespassed on plaintiff's land); *Wheelock v. Noonan*, 108 N.Y. 179, 15 N.E. 67 (1888) (affirming the right to injunctive relief for the removal of rocks deposited on a plaintiff's property in an early landmark New York decision). The law does not look in isolation at the individual violation, but takes into account the larger systemic interest, shared by owner and society alike, in preserving the integrity of property.

The Seventh Circuit actually saw this point clearly, correctly observing that even if Kienitz could not point to much economic damage from the taking of this one

photograph, he was still damaged in a larger systemic sense:

> [T]his use may injure Kienitz's long-range commercial opportunities, even though it does not reduce the value he derives from this particular picture. He promises his subjects that the photos will be licensed only for dignified uses. Fewer people will hire or cooperate with Kienitz if they think that the high quality of his work will make the photos more effective when used against them!

Kienitz, 766 F.3d at 759-60 (App. 7).

Yet again, almost inexplicably, the Seventh Circuit opinion seemed to lack the courage of its own conviction.

CONCLUSION

The Media Institute respectfully urges this Court to grant the Petition for Certiorari.

Respectfully submitted,

Rodney A. Smolla
Counsel of Record
225 Herty Drive
Athens, Georgia 30602
(864) 373-3882
rodsmolla@gmail.com

Counsel for Amicus Curiae