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No Fair Use Of Picasso Art Images: *De Fontbrune v. Wofsy* By Robert W. Clarida and Thomas Kjellberg

While the Supreme Court weighs a potentially momentous ruling on fair use, photography and fine art in *The Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*, the Ninth Circuit recently adjudicated a fair use claim involving photographs of hundreds of works by perhaps the only twentieth-century artist even more famous than Warhol: Pablo Picasso. In *De Fontbrune v. Wofsy*, 39 F.4th 1214 (9th Cir. 2022) (“*Wofsy*”), the plaintiff sought to enforce a French judgment against defendant’s unauthorized duplication of over 1400 photographs of Picasso artworks in its so-called “Picasso Project.” The photos had originally been made by or for plaintiff’s predecessor beginning in the 1930s for an authorized *catalogue raisonné* of Picasso’s work, the so-called “Zervos Catalogue,” and were held by the French courts to be protectable in their own right as photographs. Defendant challenged the enforcement of the French judgment in the U.S. on a number of grounds, including the claim that the judgment violated U.S. public policy by imposing liability on activities that would be shielded by the fair use doctrine had they occurred in the U.S. A California district court agreed, and granted summary judgment to defendant on that basis.

On appeal, the Ninth Circuit reversed. Citing Supreme Court precedent, it acknowledged that fair use is one of the “built-in First Amendment accommodations” that ease the apparent tension between free expression and U.S. copyright law, but held that defendant’s use of plaintiff’s photographs was simply not fair use. In a footnote, it made clear that “[w]e leave for another day the question of whether a defendant’s lack of opportunity to assert a clearly

meritorious fair use defense would render a foreign judgment repugnant to the public policy of the United States or of California” (emphasis original).

The Ninth Circuit’s Fair Use Analysis

Originally developed as a judge-made equitable rule of reason, fair use is now codified in section 107 of the Copyright Act, which provides that the following non-exclusive factors shall be considered in determining whether a particular use is a 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.

Looking first to the “purpose and character of the use,” the Ninth Circuit recognized that defendant’s use of the photographs was commercial, which “tends to weigh against a finding of fair use.” Commerciality is not dispositive, however, because the “central purpose” of the first factor is to determine whether the defendant’s new work is “‘transformative’ — that is, whether it ‘adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message’.” *Wofsy* at 1224, quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994). The district court had weighed this factor in defendant’s favor because its publication was “intended for libraries, academic institutions, art collectors, and auction houses,” and thus aligned with the illustrative fair uses listed in the preamble of [section 107](#): “criticism, comment, news reporting, teaching ... scholarship, or research.”

The Ninth Circuit rejected this conclusion, finding that “the end-user’s utilization of the product is largely irrelevant.” *Id.*, quoting *Zomba Enters., Inc. v. Panorama Recs., Inc.*, 491 F.3d 574, 582 (6th Cir. 2007). Nor could the Ninth Circuit identify any other transformative aspect of

defendant's use, distinguishing cases such as *Kelly v. Arriba Soft Corp.*, 336 F.3d 811 (9th Cir. 2003) in which even exact copies of photographs have been held transformative when employed for a different purpose than the original. Here, both works served to "present the works of Picasso," and defendant's organization of the images and inclusion of informative captions was not sufficiently transformative to favor defendant under the first fair use factor. It might have been helpful for the court to provide sample pages from the Picasso Project to illustrate this point, because certainly one can imagine cases in which "informative captions" might have significant transformative value.

With respect to the second factor, the nature of the copyrighted work, defendant argued that the plaintiff's photographs were factual, documentary images, and thus defendant should have a broader claim to fair use. The Ninth Circuit was not persuaded, noting that "[p]hotos are generally viewed as creative, aesthetic expressions of a scene or image and have long been the subject of copyright. This is so especially when they are created for public viewing. Even 'point-and-shoot' photographs that are not highly artistic can merit copyright protection." *Wofsy* at 1225 (citations and internal quotations omitted). In such passages the court is perhaps eliding the difference between the sliding-scale "creativity" element of the second fair use factor and the *de minimis* threshold of creativity required for copyright protection; in a footnote, it made clear that the copyrightability of the photos under U.S. law had not been raised on appeal, and it therefore declined to address the issue. In any event, the court did not actually weigh the second factor in plaintiff's favor, but merely concluded that "[t]he photographs' creative qualities prevent this factor from weighing heavily, if at all, in favor of fair use." *Id.* at 1226.

Under the third fair use factor, the amount and substantiality of the portion used, the Ninth Circuit noted that copying of an entire work "militates against a finding of fair use," and

where there is no arguably transformative purpose, as in *Kelly*, the factor should weigh against defendant. The district court had relied on the fact that defendant's Picasso Project reproduced only 1,492 photos out of more than 16,000 in plaintiff's work, but the Ninth Circuit emphasized that each copied photo was reproduced in its entirety. Further, while defendant asserted fair use of the Zervos Catalogue in its entirety, the French judgment the plaintiff sought to enforce assessed penalties for each infringed photograph, so the court concluded that it "need not analyze fair use with respect to the Zervos Catalogue as a whole."

The final statutory fair use factor, which looks to actual or potential harm to the market for or value of plaintiff's work, also favored plaintiff. Defendant showed evidence that auction prices for the Zervos Catalogue had actually increased during the time that the Picasso Project was on the market, but the Ninth Circuit rejected this as irrelevant to the question of the market for the photographs:

While this is circumstantial evidence that *The Picasso Project* has not depressed the market for the *Zervos Catalogue*, it proves nothing about the effect on the market for licensing the disputed photographs. The record supplies no evidence that widespread appropriation of those photographs in published books would only negligibly affect the market for the photographs.

Wofsy at 1226.

Summarizing the fourth factor, the court concluded that defendant's use of the photographs was commercial and non-transformative, and with no evidence countering the resulting "presumption of market harm," for which the Court cited *Disney Enters., Inc. v. VidAngel, Inc.*, 869 F.3d 848, 861 (9th Cir. 2017), the fourth factor weighed against fair use. Although the use of the term "presumption" is often questionable in the fair use context, here the court may only have been making the point that defendant's evidence on the issue was not enough to sustain its claim of fair use.

The Ninth Circuit in *Wofsy* set forth its ultimate conclusion on the fair use question as follows:

Fair use may depend on factual findings, but the ultimate question of whether facts indicate fair use is legal in nature. After weighing the four factors above, we have serious doubts that a fair use defense would protect the copying of the photographs at issue, even if the nature of the copyrighted works were to favor fair use. Because it is at least highly debatable—if not absolutely clear—that a fair use defense would not protect the conduct underlying the judgment of which *Sicre de Fontbrune* seeks recognition, *Wofsy*'s inability to urge a fair use defense in France does not place the French judgment in “direct and definite conflict with fundamental American constitutional principles.” *Sicre de Fontbrune* is therefore entitled to partial summary judgment on this defense.

Id. at 1226-1227.

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