

Cariou v. Prince: Painter or Prince of Thieves?

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Introduction

In an age of appropriation and postmodernism, courts walk a fine line when distinguishing an original work worthy of copyright protection from a flagrant reproduction that simply reissues the same essential piece, adding or subtracting little of value. *Cariou v. Prince* delved into the world of copyright protection, and enunciated and applied traditional standards to an artistic world where many images and original works are recycled to become pieces of other artistic works.¹ The court determined that taking full images for commercial use from a photographer's collection and adding minor changes, such as a blue guitar, a tint, and face blotting,² did not constitute a valid fair use protected under copyright law.³

As with many American protections and principles, the United States' copyright protections find their origins in English predecessors.⁴ The creation of the printing press in the fifteenth century led English authorities to grant printers a monopoly on printing, encapsulated in the Licensing Act of 1662, that solidified the monopoly and granted the Stationer's Company the

¹ *Cariou v. Prince*, 784 F. Supp. 2d 337 (S.D.N.Y. 2011).

² Kyle Chayka, *Will Richard Prince Have to Destroy Rasta Photos?*, HYPERALLERGIC (Mar. 24, 2011) <http://hyperallergic.com/21446/richard-prince-rasta-photos/>

³ *Cariou*, 784 F. Supp. 2d at 355.

⁴ *Copyright Timeline: A History of Copyright in the United States*, ASS'N OF RESEARCH LIBRARIES, <http://www.arl.org/pp/ppcopyright/copyresources/copytimeline.shtml> (last visited Dec. 4, 2011).

sole right to track the printed material.⁵ The act lapsed in 1695, and government protections of original works became minimal.⁶

England addressed booksellers' and publishers' concerns about the abundance of copied material in 1710 by enacting the Statute of Anne.⁷ The statute contained the main principles of copyright law adopted into American jurisprudence: financial protection for registered intellectual property, a termination of protection after which an item became part of the public domain, and penalties for violations of the included protections.⁸ Copyright law in the United States expanded on these basic ideas to broaden copyright protections, define the terms of protection, and incorporate technological advancements.⁹

This comment will focus on how these advancements are applied to appropriation art takings through analyzing *Cariou v. Prince*. In *Part I*, the comment will present the background of the fair use doctrine under which *Cariou* was decided. The fair use doctrine limits an exclusive copyright. The main focus of this portion of the comment will be Congress' codification of the fair use doctrine and that doctrine's interpretation by the courts. In *Part II*, the comment will provide a discussion of *Cariou*. This discussion will present the facts of the case, the issues presented, and the holdings on each issue. *Part III* of the comment will analyze the *Cariou* holdings against the backdrop of the case law, the Copyright Act, and the U.S. Constitution. The comment will conclude by looking at what this decision could mean for future appropriation cases.

⁵ *Id.*

⁶ *Id.*

⁷ *Id.*

⁸ *Primary Sources on Copyright (1450-1900)*, ARTS AND HUMANITIES RESEARCH COUNCIL, http://www.copyrighthistory.org/cgi-bin/kleioc/0010/exec/showTranscription/%22uk_1710%22/start/%22yes%22 (last visited Dec. 4, 2011).

⁹ ASS'N OF RESEARCH LIBRARIES, *supra* note 4.

Part I: Background

The U.S. Constitution provided Congress with the power to grant copyrights by stating that Congress has the 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.”¹⁰ Congress intended copyright protection “to increase and not to impede the harvest of knowledge.”¹¹ Copyright protection extends to original works, meaning works that are independently created and possess some “minimal degree of creativity.”¹²

Congress codified the fair use doctrine, which placed a limit on exclusive copyrights, in the Copyright Act of 1976.¹³ Justice Story presented this legal doctrine in 1841, saying “a reviewer may fairly cite largely from the original work, if his design be really and truly to use the passages for the purposes of fair and reasonable criticism.”¹⁴ When the work “supersedes” the original, supplanting it instead of transforming it, the use of the original work is not a fair use.¹⁵

Fair use is not a bright-line rule, but instead an affirmative defense requiring case specific analysis.¹⁶ Congress listed four factors in 17 U.S.C. § 107 to determine if a use qualified as fair, the first of which is “the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes.”¹⁷ The second factor looks at the nature of the copyrighted work. The third factor asks the court to determine the amount and substantiality of the copyrighted work used. The final factor looks at the effect the secondary use has on the potential market or value of the original copyrighted work.¹⁸

¹⁰ U.S. Const. art. I, § 8, cl. 8.

¹¹ *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 545 (1985).

¹² *Fiest Publications, Inc. v. Rural Telephone Serv. Co., Inc.*, 499 U.S. 340, 345 (1991).

¹³ 17 U.S.C. § 107.

¹⁴ *Folsom v. Marsh*, 9 F. Cas. 342, 344 (C.C.D. Mass. 1841).

¹⁵ *See Id.* at 344-45.

¹⁶ *See Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577 (1994); *Harper & Row*, 471 U.S. at 561.

¹⁷ 17 U.S.C. § 107.

¹⁸ *Id.*

When looking at the purpose and character of the work, courts determine if the second product so altered the original product as to transform it into something else.¹⁹ When the work is more transformative, other factors such as the commercialization of a product are not given as much weight.²⁰ For the second factor, courts determine if the nature of the original work falls “closer to the core of intended copyright protection than others.”²¹ If it does, the secondary use is less likely to be protected, but this factor is rarely dispositive.²²

The third factor, the amount and substantiality of a work copied, has both a qualitative and a quantitative component.²³ Courts look at how much material was copied, and also how much the copied material maintains its original, creative expression in the secondary use.²⁴

Finally, courts look to the fourth factor to determine if the secondary use usurped the market for the first work.²⁵ This factor is no longer as important as it once was,²⁶ but it still weighs heavily in deciding whether a secondary use truly supplanted the place of the first use, tying it closely to the transformation and commercialization analyses of the first factor.²⁷

Part II: Cariou v. Prince- The Facts and Holding

In *Cariou v. Prince*, photographer Patrick Cariou sued appropriation artist Richard Prince, gallery owner Lawrence Gagosian, and the Gagosian Gallery, Inc., for misappropriation

¹⁹ Campbell, 510 U.S. at 579.

²⁰ *Id.*

²¹ *Id.* at 586; see also Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1117 (1990) (“[C]onsider whether the protected writing is of the creative or instructive type that the copyright laws value and seek to foster.”).

²² Leval, *supra* note 15, at 1122; see Campbell, 510 U.S. at 586 (lamenting that the Copyright Act’s second factor did little to separate the “fair use sheep from the infringing goats” when public or expressive works are at issue).

²³ Harper & Row, 471 U.S. at 565.

²⁴ Castle Rock Entm’t, Inc. v. Carol Pub’g Grp., Inc., 150 F.3d 132, 138 (2d Cir. 1998).

²⁵ *Id.* at 258.

²⁶ See Harper & Row, 471 U.S. at 566 (“This last factor is undoubtedly the single most important element of fair use.”).

²⁷ Campbell, 510 U.S. at 591.

of his photography under the Copyright Act.²⁸ Cariou spent six years in Jamaica photographing Rastafarians and published a compilation of the images entitled *Yes, Rasta*.²⁹ The photographer staged the portraits, chose his equipment, and determined the techniques to be used in developing the photographs.³⁰ In addition to the original photography, Cariou also remained heavily involved in formatting and editing the book.³¹

Prince used images from Cariou's book in twenty-eight of twenty-nine of his Canal Zone series, using forty-one of Cariou's photos in all.³² Prince did not ask for permission to use the copyrighted material, and neither did the gallery where he showed Canal Zone.³³ The Gagosian Gallery showed twenty-two of the twenty-nine paintings, created and sold an exhibition catalog including pieces with Cariou's work, and distributed invitation cards featuring pieces that included Cariou's work.³⁴ All told, the gallery sold eight paintings for \$10,480,000.00—sixty percent of which Prince received—exchanged seven more paintings for between \$6,000,000 and \$8,000,000 more in art, and collected nearly \$7,000 in exhibit paraphernalia.³⁵

As a result of the Gagosian Gallery show, Cariou's planned show at another gallery was cancelled because the owner did not wish to hold an exhibit that had been "done already."³⁶ Cariou had planned to sell copies of his book and prints of his photographs at the exhibit, including thirty to forty photographs ranging in price from \$3,000 to \$20,000.³⁷ Even after

²⁸ Cariou, 784 F. Supp. 2d at 342.

²⁹ *Id.* at 343.

³⁰ *Id.*

³¹ *Id.*

³² *Id.* at 344.

³³ *Id.* at 351.

³⁴ *Id.* at 344, 355.

³⁵ *Id.* at 350-51.

³⁶ *Id.* at 344.

³⁷ *Id.*

receiving a cease-and-desist letter from Cariou, the gallery continued to display Prince's work that included large portions of Cariou's photographs.³⁸

The court found the photographs were properly protected under copyright protection, and Cariou had a valid sole copyright to those photographs.³⁹ Once that basic step was out of the way, the court then entered into the more strenuous task of determining whether Prince's use constituted a fair use exception to copyright protection. Although the analysis includes all four factors, the main focus was on the first and fourth factors: specifically, the court looked at Prince's purpose in using the photographs, and also at the effect on Cariou's potential market for the photographs.⁴⁰ The court implemented an aggregate analysis—looking at the exhibit as a whole instead of as individual works that comprised the exhibit—to decide all four factors favored Cariou: Prince failed to present a valid fair use affirmative defense.⁴¹

In addition, the court determined the Gagosian Gallery and owner Lawrence Gagosian were liable for copyright infringement as well as contributory and vicarious liability.⁴² The Gagosian Gallery used material copied from Prince's Canal Zone in its materials, creating an independent copyright infringement by the gallery on Cariou's right to reproduce and prepare derivative works from his photography.⁴³

The court found vicarious liability because the gallery handled all the marketing for Canal Zone and the gallery owner showed the pieces in his private home prior to the show.⁴⁴ The gallery had worked with Prince in the past and knew he appropriated other artists' works,

³⁸ *Id.* at 351.

³⁹ *Id.* at 343.

⁴⁰ *Id.* at 352-53.

⁴¹ *Id.* at 354.

⁴² *Id.* at 354-55.

⁴³ *Id.* at 355.

⁴⁴ *Id.*

information the court deemed important in deciding prior knowledge created a “right and ability” to ensure Prince had licenses for his work.⁴⁵

The court stopped short of saying the gallery owner had a responsibility to be sure Prince obtained permission, but it did imply that such a responsibility might have existed.⁴⁶ Because copyright infringement claims could include contributory and vicarious liability claims, the court determined that a conspiracy claim was duplicative and could not lie against a defendant.⁴⁷

The court granted Cariou an injunction against Prince, Gagosian Gallery, and Lawrence Gagosian for the future use of Cariou’s photographs.⁴⁸ The Canal Zone work also could not be displayed or sold any longer.⁴⁹ The court gave the gallery and Prince ten days to deliver any item that used Cariou’s copyrighted work to Cariou, giving Cariou the option to impound, destroy, or dispose of the items as he determined was appropriate.⁵⁰ The court also required that the gallery, gallery owner, and Prince notify any “current or future owners” of the paintings that the works could not be legally displayed.⁵¹

Part III: Cariou’s Holding Remains True to the Principles of Copyright Protection

The copyright monopoly “rewards the individual author in order to benefit the public.”⁵² Others can use parts of the protected work that are not original, meaning the parts that do not “display the stamp of the author’s originality.”⁵³ Because “no such thing as a wholly original

⁴⁵ *Id.* 354-55.

⁴⁶ *Id.* at 354.

⁴⁷ *Id.* at 355.

⁴⁸ *Id.* at 355.

⁴⁹ *Id.*

⁵⁰ *Id.* at 355-56.

⁵¹ *Id.* at 356.

⁵² *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 477 (1984).

⁵³ *Harper & Row*, 471 U.S. at 547-48.

thought or invention”⁵⁴ exists, the slightest amount of creativity suffices to warrant protection as a new creation.⁵⁵ An artist can appropriate almost the full content of an advertisement without violating copyright protections when the ingenuity of the original is largely the background and nature of the piece, and the secondary use cuts the center from the original, rearranges it, colors it, and sets it against a different backdrop with a different expression and meaning.⁵⁶

Regardless of how little is necessary to transform a work into something new, though, the purpose of copyright law and the very incentive it gives to originators to create would be lost if another entity could take a whole work, add a mustache, sell it as the entity’s own, and evade copyright infringement. The doctrine of fair use exists to promote the secondary use of another’s work in order to further benefit the public.⁵⁷ Thus, both the original creative seed and the ensuing adaptations work together to attain the constitutional goal of progress in science and art.⁵⁸ To differentiate between protected and unprotected infringement, then, courts must determine if the Copyright Clause’s ultimate goal is better met by allowing an infringement or preventing it.⁵⁹

A. Prince’s paintings added little to the character and purpose of Cariou’s photographs

In balancing these inextricably bound benefits of copyright protection and the fair use doctrine, the *Cariou* court determined the creative seed warranted more protection than the

⁵⁴ Leval, *supra* note 15, at 1109. *See also* Campbell, 510 U.S. at 575 (“[T]here are, and can be, few, if any, things, which in an abstract sense, are strictly new and original thought.”) (quotation marks omitted).

⁵⁵ Feist, 499 U.S. at 345.

⁵⁶ Blanch v. Koons, 467 F.3d 244 (2d Cir. App. 2006)

⁵⁷ *See* Leval, *supra* note 15, at 1110 (stating a use is fair when it stimulates “productive thought and public instruction” without infringing on original creativity).

⁵⁸ U.S. Const. art. 1 § 8, cl. 8; Campbell, 510 U.S. at 575.

⁵⁹ Castle Rock Entm’t, 150 F.3d at 141.

infringing adaptation. The works were not transformative because they merely added props to the portraits with no new meaning or goal in mind.⁶⁰

Prince admitted he was not commenting on the portraits, but rather veiling the images within the context as his overall work.⁶¹ Although Prince distinguished Cariou's portrayal of the Rastafarians by making them look like musicians, Prince mitigated his reinvention by explaining his commercial plan to use the Cariou's characters as fodder for a post-apocalyptic screenplay featuring a reggae band.⁶²

Commercial use weighs against fair use because it "supplants the copyright holder's commercially valuable rights."⁶³ Where copyright laws exist to give originators incentive to put time, effort, and skill into creative pursuits, protecting the rights of originators to capitalize financially on those efforts is rational. A secondary users exploitation of original work for financial gain demeans the creative process that the originator used, and that exploitation without some form of transformation also ties in heavily to the fourth factor: usurping a potential market for the original work.

In addition to considering transformation and commercialism when looking at the character and purpose of the secondary use, some courts look at whether the appropriator took the copyrighted material in good faith.⁶⁴ The *Cariou* court engaged in this analysis, determining Prince acted in bad faith.⁶⁵ The court came to this determination after concluding Prince could have asked Cariou for permission to reproduce the photographs, but he did not perform this step before appropriating the images.⁶⁶

⁶⁰ Cariou, F. Supp. 2d at 349.

⁶¹ *Id.*

⁶² *Id.*

⁶³ Harper & Row, 471 U.S. at 562.

⁶⁴ Leval, *supra* note 15, at 1126.

⁶⁵ Cariou, 784 F. Supp. 2d at 351.

⁶⁶ *Id.*

The court should not have engaged in the analysis of good or bad faith because an appropriation under the Copyright Act remains an appropriation regardless of the offending party's best or worst intentions.⁶⁷ Even without determining bad faith, the *Cariou* court could have relied on the lack of transformation and blatant commercialization of Cariou's photographs by Prince to determine the purpose and character of the use constituted an infringement. By determining good or bad faith, the court adds the equivalent of an additional factor to its analysis.⁶⁸ This factor does not serve the purpose of copyright protection, which exists to protect the creators of socially useful material.⁶⁹ The creator of an original work still loses a commercial opportunity when a work is taken, and the appropriator who fails to transform a work still infringes on a copyright.

A person or entity's taking of a work, regardless of knowledge, is a taking. To hold otherwise because a person was unaware of a previous work or that his or her actions constituted an infringement defeats the constitutional goal of incentivizing creativity.⁷⁰ This distinction allows appropriating parties to copy original work and commercialize that taking without penalty simply because they did not mean to infringe. It is akin to telling a child that stealing a candy bar from a store is acceptable because the child did not know it had to purchase the candy bar before leaving the store. Although the lack of knowledge might be appropriate in determining how to deal with punishment for the theft, it does not change that the action is a theft. Including an analysis of behavioral justification goes beyond the scope of Copyright law.

⁶⁷ Leval, *supra* note 15, at 1126.

⁶⁸ *See id.* at 1125.

⁶⁹ *Id.* at 1126.

⁷⁰ *See id.*

Instead, a court should factor good and bad faith into determinations of damages or relief in copyright cases.⁷¹ This analysis would look nearly identical to the current analysis, but with an additional consideration after the court determines if an infringement has occurred. After making the initial determination on the factors as they exist in the Copyright Act of 1976, the court could then look at evidence as to the good or bad faith of the parties' actions.

In *Cariou*, this analysis would have related to the relief granted to the photographer. The court determined that a defendant's conduct played into the character of the defendant's use of copyrighted material.⁷² Prince did not ask for permission to use the work, even when he received a copyrighted copy of the book; the gallery did not determine if Prince had permission, even though the owner was aware Prince used copyrighted material without permission.⁷³ Also, the gallery continued to display and profit from the works after receiving a cease-and-desist letter, putting them on notice of a possible infringement.⁷⁴

When determining if the work, profits, and any additional fines should be granted to Cariou, the court could have analyzed the bad faith of the parties and found those unjustified actions supported additional or more stringent penalties. Although this creates a level of analysis for copyright damages, it does not interfere with the court's appropriate analysis of the character and purpose of a use. It also leaves the court leeway to account for bad faith in the area of relief. This is an area where courts are more accustomed to including a defendant's behavior. Tweaking the proper place to consider bad faith also prevents a court from holding a valid fair use an infringement solely because it was completed in bad faith. It also prevents courts from holding an improper infringement as valid because it was performed in good faith.

⁷¹ *Id.*

⁷² *Cariou*, 784 F. Supp. 2d at 351.

⁷³ *Id.*

⁷⁴ *Id.*

Although *Cariou* came to the correct conclusion when it determined that Prince's paintings were not transformative and their commercial nature limited any fair use under the first factor of the Copyright Act, the bad faith analysis was unnecessary and misplaced within this factor.

B. Considering the nature of a work in an appropriation case

The nature of work protected by the Copyright Act can fall within two distinctions.⁷⁵ The first is if it constitutes an expressive or creative work as opposed to a factual work, with factual works garnering less copyright protection.⁷⁶ The second is if a work is published or unpublished, with unpublished works receiving more protection.⁷⁷ When a second work transforms an original work, it favors the secondary use as a comment on the original work providing additional "social and aesthetic meaning."⁷⁸

The *Cariou* court gave a rather cursory discussion of the nature of the photographs, stating "Cariou's Photos are highly original and creative artistic works" within the core material the act protects.⁷⁹ The court jumped to a qualitative conclusion about the nature of Cariou's work, outside the realm of its expertise. As Justice Holmes elucidated, "[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of [a work]."⁸⁰ The decision recognized that a court should not determine if a piece has artistic quality, and then proceeded to find the photos are artistic works because they are "creative expressions for public dissemination."⁸¹

⁷⁵ Blanch, 467 F.3d at 256.

⁷⁶ *Id.*

⁷⁷ *Id.*

⁷⁸ *Id.* at 257.

⁷⁹ *Cariou*, 784 F. Supp. 2d at 352.

⁸⁰ *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903), *quoted in* *Campbell*, 510 U.S. at 582.

⁸¹ *Cariou*, 784 F. Supp. 2d at 352.

Still, the conclusion was likely correct because photographers' images are almost always guaranteed copyright protection.⁸² The court did not have to reach any conclusion on this factor, though, as the nature of the work is not determinative and the additional factors weighed in favor of Cariou for the purpose of this decision.⁸³

Because photographs are inherently copyright protected and expressive works, a minimally transformative use weighs this factor toward Cariou.⁸⁴ When the issue is the transformative use of a copyrightable work, though, the fact an original work should be copyright protected does little to say if the secondary use violated that.⁸⁵ This is similar to a parody where the original work deserves copyright protection, but it acts only as a jumping off point for some further protected discourse.⁸⁶ The secondary use could or could not be a fair use, but the nature of the original work does little to assist in that analysis aside from determining what was already known in this case: photographs deserve copyright protection.

C. A whole exhibit based on another's work represents a substantial taking

The third factor does more to elucidate the propriety or impropriety of a taking in an appropriation case than maybe all other factors except the first. This factor of the Copyright Act focuses on whether the "amount and substantiality of the portion used"⁸⁷ from the original is reasonable within the purpose and character of the use.⁸⁸ The appropriator bears the burden of persuading the court that his or her use is reasonable.⁸⁹

⁸² *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884).

⁸³ *See* *Campbell*, 510 U.S. at 569 (determining the nature of a work failed to provide insight into a copyright infringement case when a work is transformative of an expressive work).

⁸⁴ *Castle Rock Entm't, Inc.*, 150 F.3d at 144.

⁸⁵ *Id.*

⁸⁶ *Id.*

⁸⁷ 17 U.S.C. § 107(3).

⁸⁸ *Castle Rock Entm't*, 150 F.3d at 144.

⁸⁹ *Campbell*, 510 U.S. at 587.

In addition to relating directly back to the first factor, the purpose and character of the use, the third factor also relates to the fourth factor.⁹⁰ If a work wholly and qualitatively violates the act, it could “substitute for the original or potentially licensed derivatives.”⁹¹ Generally, a wholly reproduced work is a taking.⁹²

Prince substantially used forty-one of Cariou’s images by depicting the central characters and images, often in whole.⁹³ The photographs appeared in all but one of Prince’s Canal Zone works, and they were not substantially altered.⁹⁴ The initial integrity of the photographs was maintained in whole to be clearly recognizable as the original.⁹⁵ Even if it had not been so large a part of the secondary work, when a taking is substantial in terms of the original work, it is a taking.⁹⁶ Because whole photographs were used that were central to the “overwhelming quality and importance” of the original work, the court determined the third factor favored Cariou.⁹⁷

The court’s analysis is correct on this factor, although it could have expanded on the lack of persuasion implemented by Prince to show Canal Zone was not a fair use. The United States Supreme Court deemed this factor could turn on the “persuasiveness of a parodist’s justification.”⁹⁸ The *Cariou* court did address Prince’s testimony when it determined he failed to transform the new piece under the first factor, but that same testimony was vital to understanding why whole photographs might have been vital to his work in a qualitative sense.⁹⁹

⁹⁰ *Id.*

⁹¹ *Id.*

⁹² *Weissman v. Freeman*, 868 F.2d 1313, 1325 (2d Cir. 1989).

⁹³ *Cariou*, 784 F. Supp. 2d at 352.

⁹⁴ *Id.* at 344.

⁹⁵ *See id.* at 350.

⁹⁶ *Harper & Row*, 471 U.S. at 565.

⁹⁷ *Cariou*, 784 F. Supp. 2d at 352.

⁹⁸ *Campbell*, 510 U.S. at 586.

⁹⁹ *Cariou*, 784 F. Supp. 2d at 349.

Prince said he wished to use Cariou's photos "to emphasize themes of equality of the sexes," and give viewers a "contemporary take on the music scene."¹⁰⁰ This evidence could have implied a fair use. If Prince used so many of Cariou's original pieces because they best helped him portray his own original idea, that could imply a substantive change to the works, no matter how much he used. At the same time, Prince stated he had "no interest in the original meaning of the photographs," instead using them to portray a truth about Rastafarians, which was Cariou's goal.¹⁰¹

Thus, Prince's purpose was the same as Cariou's: to show Rastafarians and their culture.¹⁰² His additional qualitative goal was to show the people in the photographs were musicians.¹⁰³ This justification does not explain why he had to use Cariou's particular photos to express this idea, or why whole photographs needed to be included in the vast majority of Canal Zone's pieces to express musicality.

In addition, the quantity of Cariou's work used and the lack of a specific qualitative reason for choosing Cariou's work could show Prince was superseding Cariou's market for the original photographs.¹⁰⁴ A usurped market is not as important if the secondary use reasonably relates to the purpose of the copying.¹⁰⁵ Prince did not persuade the court that he needed the sheer amount of Cariou's work he used in order to accomplish any secondary qualitative expression.¹⁰⁶ This was the court's holding, and it was correctly found and stated.

¹⁰⁰ *Id.* (internal quotations omitted).

¹⁰¹ *Id.*

¹⁰² *Id.*

¹⁰³ *Id.*

¹⁰⁴ *Campbell*, 510 U.S. at 587 (discussing that taking a large portion of a work could show both a lack of "transformative character or purpose under the first factor, or a greater likelihood of market harm under the fourth").

¹⁰⁵ *Blanch*, 467 F.3d at 258.

¹⁰⁶ *Cariou*, 2011 WL 1044915, at *11.

D. Prince effectively usurped Cariou's market

From the Statute of Anne in 1710, copyright protection has existed to protect an original author's right to benefit from his or her creative expression.¹⁰⁷ By protecting a creator's financial benefit, the statute aimed to encourage further creative development.¹⁰⁸ Similarly, the fair use doctrine's main purpose is to promote additional creative development by allowing the copyrighted ideas of one person to be further developed into new ideas for the public benefit and edification.¹⁰⁹ Courts must determine if the fair use limits the financial incentive for creation, leading to the creation of the fourth factor under the 1976 Copyright Act. A use could be a taking if "the effect of the use upon the potential market for the copyrighted work" negates a financial incentive to create.¹¹⁰

The Supreme Court determined that a duplication of the original in its entirety supersedes the original object and acts as a replacement for it.¹¹¹ When the question is transformation, though, it is not so clear that a work usurps a market.¹¹² Courts must determine if the "secondary use usurps the market for the original work" without focusing on possible derivative markets.¹¹³ In other words, if the "unrestricted and widespread conduct" of appropriation by a defendant would create a "substantially adverse impact" for the original, the secondary use supersedes the original's marketability.¹¹⁴

In *Cariou*, the photographer lost the ability to present his work in a gallery or sell the original pieces at that show because the owner did not wish to stage a show that had been "done

¹⁰⁷ ARTS AND HUMANITIES RESEARCH COUNCIL, *supra* note 8.

¹⁰⁸ *Id.*

¹⁰⁹ Leval, *supra* note 15 at 1110.

¹¹⁰ 17 U.S.C. § 107(4).

¹¹¹ Campbell, 510 U.S. at 592 (citing Folsom *supra* at 348) (internal quotation omitted).

¹¹² *Id.*

¹¹³ Blanch, 467 F.3d at 258.

¹¹⁴ Campbell, 510 U.S. at 590.

already.”¹¹⁵ In addition to showing Cariou’s photographs, the gallery had also used his original works as presented by Prince to market the show and sell books of the work.¹¹⁶ Prince’s Canal Zone defined usurping a potential market, replacing Cariou’s work to such an extent that there was no longer a market for the original.

The court had ample evidence of market replacement, something not always present in transformative use cases. Unlike other cases where it may be difficult to determine if album sales have dropped or book sales decline due to a secondary use, Cariou presented definitive evidence that Prince’s taking eliminated a potential market for his photographs. This was perhaps the easiest decision the court had in the case, and the court decided it properly.

E. Relief

Chapter 5 of the Copyright Act allows a party who proves copyright infringement to place an injunction on future use and collect damages for the taking.¹¹⁷ The injunction is to “prevent or restrain infringement.”¹¹⁸ The court may also allow impoundment of the taking or order the destruction of the infringing work, as it deems appropriate.¹¹⁹ The injured party may also receive damages, and this portion includes discretion for the court to increase or decrease the damages depending on the infringing party’s willful intention to copy the original work.¹²⁰

This is the proper place to consider good or bad faith. In *Cariou*, the evidence of bad faith found by the court should be considered here to determine if the statutory damages should

¹¹⁵ Cariou, 784 F. Supp. 2d at 344.

¹¹⁶ *Id.*

¹¹⁷ 17 U.S.C. §§ 501-4.

¹¹⁸ 17 U.S.C. § 502(a).

¹¹⁹ 17 U.S.C. § 503.

¹²⁰ 17 U.S.C. § 504(c)(2).

be increased because of willful disregard for the original copyright. This is a likely conclusion, but the proper place for this analysis is in damages and not in the statutory factors of fair use.

The court also went beyond its discretion in allowing Cariou to decide if he would destroy Canal Zone.¹²¹ The disposition section of the Copyright Act states, “the court may order the destruction or other reasonable disposition” of an infringing work.¹²² The section does not allow the court to leave the decision to the plaintiff.

Copyrights by their very nature expire, and materials become part of the public domain. Numerous parodies of Leonardo DaVinci’s Last Supper portray Jesus’ final supper with different characters or materials,¹²³ and the same artist’s Mona Lisa has received a similar treatment.¹²⁴ Some of these parodies serve a religious, political, or cultural purpose, adding to the public discourse. Others might serve no additional purpose except for commercial recognition based on the recognition of the original. Regardless, all of the uses are protected because DaVinci’s original works are not protected by any copyright.

Allowing the destruction of Canal Zone is an extreme form of relief. When Cariou’s copyright expires, Prince’s work will no longer be an appropriation under the Copyright Act. At that point plastering an exact copy of a Cariou photograph on a billboard in Time’s Square will be no more an infringement than putting a moustache on the Mona Lisa.

Although Prince’s actions infringed on Cariou’s copyright, giving Cariou royalties and reparations by blocking the display of Canal Zone until Cariou’s copyright expires better meets the goal of protecting the originator’s work than destruction. It also prevents society from losing

¹²¹ Cariou, 784 F. Supp. 2d at 355.

¹²² 17 U.S.C. § 503(b).

¹²³ Jeremy Barker, *Suddenly Last Supper*, POPPED CULTURE (Apr. 2, 2007), <http://culturepopped.blogspot.com/2007/04/suddenly-last-supper.html#update> (last updated April 2009).

¹²⁴ Robert A. Baron, *Mona Lisa Joins the Middle Class*, MONA LISA IMAGES FOR A MODERN WORLD, http://www.studiolo.org/Mona/MONASV09.htm#MIDDLE_CLASS (last visited Dec. 4, 2011).

any possible future benefit Prince's Canal Zone could impart. Without making any determination on the artistic value of Prince's work, the court could have impounded any piece comprising Canal Zone until such time as Cariou's copyright terminated.

Conclusion

The only case to cite *Cariou* at the time of this writing favorably quoted the *Cariou* court's definition of transformation as something that comments on, relates historically to, or critically refers to the original work.¹²⁵ In an era where movies reinvent plays that were originally based on books, it is difficult to know how much transformation is really necessary to make a work original in its own right, what nature is protected, how much is too much, or when a market value is usurped.

The Second Circuit for the United States Court of Appeals has agreed to hear Prince's appeal in this case, stating "there remains a continuing controversy capable of redress."¹²⁶ Observers expect a hearing in 2012.¹²⁷ The court could determine the use is transformative or uphold the lower court's decision that Prince's Canal Zone is an inappropriate taking. Regardless, this decision will have large implications for appropriation artists and the galleries that show those artists' works in the future.

The lower court's decision, based on the facts presented and the works by both artists, furthered the intent of the Copyright Act. The Copyright Act sets forth guidelines to help a court determine when an infringement is a violation, but courts must still make a value judgment. *Cariou* balanced the goals of copyright protection against the benefits of secondary uses properly

¹²⁵ LaChappelle v. Fenty, No.11Civ.945, 2011 WL 2947007 *1, *6 (S.D.N.Y. Jul. 20, 2011).

¹²⁶ Rachel Corbett, *Cariou v. Prince: A Win for Richard Prince in Copyright Case*, ARTNET <http://www.artnet.com/magazineus/news/corbett/prince-wins-right-to-appeal-in-cariou-v-prince.asp> (last visited Dec. 4, 2011).

¹²⁷ *Id.*

and determined there was a violation. Although some might argue Prince's work did constitute new material, simply glancing at the photos next to his work belies the truth. An appropriation disguised by a blue guitar is still an appropriation.