

FAIR USE IN THE UNITED STATES: TRANSFORMED, DEFORMED, REFORMED?

JANE C GINSBURG*

Since the United States Supreme Court’s 1994 adoption of “transformative use” as a criterion for evaluating the first statutory fair use factor, “transformative use” analysis has engulfed all of fair use, becoming transformed, and perhaps deformed, in the process. A finding of “transformativeness” often foreordained the ultimate outcome, as the remaining factors, especially the fourth, withered into restatements of the first.

Lately, however, courts are expressing greater scepticism concerning what uses actually “transform” the original content. As a result, courts may be reforming “transformative use” to reinvigorate the other statutory factors, particularly the inquiry into the impact of the use on the potential markets for or value of the copied work. The article concludes with some suggestions for rebalancing the factors.

I. INTRODUCTION

The United States (“US”) *Copyright Act of 1976*¹ codifies the “fair use” doctrine developed by the American courts from the middle of the 19th century. It is the most general exception in US copyright law. Judicious balancing of its four statutory factors assists the happy cohabitation of private rights in works of authorship with public rights of free expression.² It also has tempered claims of copyright infringement in order to foster technological innovation. Many lay the credit—and some, the blame—for the recent expansion of fair use to favour increasingly parasitic new works and aggressively copyright-dependent new business models on the US Supreme Court’s 1994 adoption of “transformative use” as a criterion for evaluating the first statutory fair use factor. As the previous EW Barker Centre for Law & Business Distinguished Visitor in Intellectual Property, Barton Beebe, has observed

* Morton L Janklow Professor of Literary and Artistic Property Law, School of Law, Columbia University. Thanks to Shyamkrishna Balganes, June Besek, David Lindsay, David Louk, Tim Wu, and for research assistance to Anna Iskikian and Brandon Zamudio, both Columbia Law School class of 2020. Professor Jane Ginsburg delivered the second EW Barker Centre for Law & Business Distinguished Visitor in Intellectual Property Lecture at the Faculty of Law, National University of Singapore on 12 November 2019. This article is based upon that lecture.

¹ Pub L No 94-553, 90 Stat 2541 (codified as amended in 17 USC).

² See *eg*, *Harper & Row v Nation Enters*, 471 US 539 at 558 (1985) (copyright is the “engine of free expression”); *Eldred v Ashcroft*, 537 US 186 at 219 (2003); *Golan v Holder*, 565 US 302 at 328 (2012).

(albeit not in last year's lecture), since the US Supreme Court's 1994 adoption of "transformative use" as a criterion for evaluating the first statutory fair use factor ("nature and purpose of the use"), the "transformative use" analysis has engulfed all of fair use, becoming transformed, and perhaps deformed, in the process.³ A finding of "transformativeness" often foreordained the ultimate outcome, as the remaining factors, especially the fourth (impact of the use on the market for or value of the copied work), withered into restatements of the first. Initially deployed to assess whether the challenged use resulted in a *work* that transformed the copied material with "new expression, meaning, or message",⁴ transformative use evolved into transformative *purpose*, enabling a variety of technological fair uses that copied entire works without accompanying commentary, criticism or other substantive intervention in the work's content. Moreover, because fair use is "not an infringement of copyright",⁵ none of these technological fair uses, however profit-making, required any payment to the authors and copyright owners whose works served as "raw material".⁶

Lately, however, the fair use pendulum's outward swing may have arrested, as courts express greater scepticism concerning what uses actually "transform" content copied into new works or repurposed into copyright-voracious systems. As a result, in both new work and new purpose cases, courts may be reforming "transformative use" to reinvigorate the other statutory factors, particularly the inquiry into the impact of the use on the potential markets for or value of the copied work. The restored prominence of the fourth factor should also occasion renewed reflection on its meaning. As digital media bring to the fore new or previously under-examined kinds of harm, courts will need not only to continue to refine their appreciation of a work's markets, but also to expand their analyses beyond the traditional inquiry, *ie*, whether the challenged use substitutes for an actual or potential market for the work. Courts should acknowledge that the statute's designation of "the value of the copyrighted work" identifies an independent kind of harm, and entails considerations distinct from market substitution. Those include creators' economic and moral interests in being recognised as the authors of the copied works.

This article will examine the flow and eddy of the US fair use trajectory, and will consider whether the US experience might offer useful guidance (or cautionary tales) to other jurisdictions, notably Singapore, which are considering adopting or expanding fair use-type copyright exceptions.

³ See generally Barton Beebe, *An Empirical Study of US Copyright Fair Use Opinions, 1978–2005*, 156 U Pennsylvania L Rev 549 (2008). For a more recent empirical study, see Jairui Liu, "An Empirical Study of Transformative Use in Copyright Law" (2019) 22 Stan Tech L Rev 163.

⁴ See *Campbell v Acuff-Rose*, 510 US 569 at 579 (1994) [*Campbell*] (citing Pierre Leval, "Toward a Fair Use Standard" (1990) 103 Harv L Rev 1105).

⁵ 17 USC, *supra* note 1, § 107.

⁶ See *Seltzer v Green Day, Inc.*, 725 F 3d 1170 at 1176 (9th Cir 2013) (finding a "transformative purpose" where defendant "used [the plaintiff's illustration] as 'raw material' in the construction of [a] four-minute video backdrop"); *Bill Graham Archives, LLC v Dorling Kindersley Ltd.*, 386 F Supp 2d 324 at 330 (SDNY 2005) (finding a "transformative purpose" in defendant's reproduction of seven copyrighted images in their entirety). See also *Authors Guild v Google, Inc.*, 804 F 3d 202 at 216, 217 (2015) [*Google Books*] (finding "a highly transformative purpose" in Google's digitisation of entire books for the purpose of enabling a search function); *Authors Guild v HathiTrust*, 755 F 3d 87 at 98 (2d Cir 2014) [*HathiTrust (2d Cir)*].

II. FROM TRANSFORMATIVE WORK, TO TRANSFORMATIVE PURPOSE

A. General Observations

First, a few general comments about fair use in the US. Section 107 of the US *Copyright Act of 1976* codifies the “fair use” doctrine developed by the American courts from the middle of the 19th century.⁷ If applicable, this exception makes unconsented copying from prior works “non-infringing” and thus does not give rise to any payment. Section 107 contains a preamble listing several kinds of uses, notably for criticism, comment, news reporting and teaching, but these examples do not delimit the universe of permitted uses. In fact, the preamble gives a general idea of the scope of the exception (in particular, most, but not all, of the examples concern the inclusion of the copied material in a new work made by the person who carried out the partial copying from an earlier work). Unlike “closed list” systems of copyright exceptions,⁸ or most “fair dealing” exceptions in Commonwealth countries, a use’s absence from the list does not prevent it from being covered by fair use. Moreover, a use’s inclusion on the list does not in itself lead to the conclusion that the use will be considered non-infringing.

On the contrary, the law sets out four non-exhaustive factors “to be considered” by the courts:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for non-profit 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.⁹

These broad, supple, indeed manipulable, criteria afford considerable flexibility in the assessment of fair use. This flexibility has enabled the exception to adapt to new means of expression and communication of works, but gives it at times an unpredictable character.¹⁰ Initially, when codified in 1976, the fair use exception applied primarily to the partial reproduction of material from a first work that the second author reworked into his or her own work (so-called “productive use”¹¹) without harming the current or future exploitation of the first work. However, as

⁷ The decision commonly considered to be the origin of the US fair use doctrine is *Folsom v Marsh*, 9 F Cas 342 at 348 (CCD Mass 1841) (No 4,901). But antecedents, in the form of the “fair abridgement” doctrine, trace back to late 18th century English decisions. See generally, Matthew Sag, “The Prehistory of Fair Use” (2011) 76 Brooklyn L Rev 1371.

⁸ See eg, Directives EC, Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the Harmonisation of Certain Aspects of Copyright and Related Rights in the Information Society, 2001 OJ (L 167) at 10.

⁹ 17 USC, *supra* note 1, § 07.

¹⁰ See eg, *Monge v Maya Magazines, Inc*, 688 F 3d 1164 at 1171 (9th Cir 2012).

¹¹ See *Universal City Studios, Inc v Sony Corp of America*, 659 F 2d 963 at 970 (9th Cir 1981), rev’d 464 US 417 (1984) [*Universal City Studios*]: “[a] second author may not copy something to make the intrinsic, ordinary use out of it, but may copy for so-called ‘productive use’.” See also *Dow Jones & Co, Inc v Board of Trade of City of Chicago*, 546 F Supp 113 at 119 (SDNY 1982).

early as in 1984, the US Supreme Court in *Sony Corp of America v Universal City Studios, Inc*¹² (known as the “*Betamax*” case) held, in the absence of a statutory exception for private copying, that a consumer’s making for time-shifting purposes a copy of a full television program broadcast free of charge on the public airwaves was not a commercial use and did not harm the televised work’s market and was thus fair use. Therefore, the Court deemphasised the non-productive character of the use¹³ and stressed instead the purported non-commercial context of the use. The Supreme Court thus opened the way for an extension beyond creative reuses of content to technological access-enhancing uses and, as we shall see, the lower courts have increasingly taken this path.

The Supreme Court’s subsequent case law has evolved, reducing the weight that it had placed on the commercial nature of the use (deemed to be almost decisive in *Sony*) and on its impact on the market, and instead stressing the “transformative” character of the use. In its 1994 decision in *Campbell*¹⁴ concerning a music parody released on commercial records, the Court provided a gloss to the first criterion by extending the benefit of the exception to a use that “adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message”.¹⁵ It is worth citing more fully the reasoning of the Court because later decisions from the lower courts evidence a shift towards a much broader concept of the “transformative” character of the use. Specifically, they have moved from seeking a “transformative work” to divining a “transformative purpose”; the latter does not imply the creation of a new work. But initially, the “transformation” as expounded by the Supreme Court, resulted from uses that produced new works that gave the copied portions “new expression, meaning or message”.¹⁶

According to the Court’s reasoning, the greater the extent of the transformation, the smaller the significance of the commercial character of the use. The more transformative the use is, the less it will compete with the current or future exploitation of the work (at least, that is what the judges assumed). In *Campbell*, the new work was a parody and the Court stressed that authors should not be able to control the market for works that criticised theirs.¹⁷ The Supreme Court’s analysis nonetheless sowed the seeds for the subsequent conflation of the remaining fair use factors into the first. Later decisions came to conclude that if the use was “transformative”, then the market within which it operated was also “transformative”, and, accordingly, non-competing.¹⁸

B. Transformative Works

Let us consider how “transformative use” analysis appeared to convert the statutory four-factor test into a one-factor inquiry. We can best trace the trajectory through a

¹² 464 US 417 (1984).

¹³ *Ibid* at 684.

¹⁴ *Supra* note 4.

¹⁵ *Ibid* at 579.

¹⁶ *Ibid*.

¹⁷ *Ibid* at 592: “there is no protectable derivative market for criticism”.

¹⁸ See eg, *HathiTrust (2d Cir)*, *supra* note 6 at 99: “under Factor Four, any economic ‘harm’ caused by transformative uses does not count because such uses, by definition, do not serve as substitutes for the original work”.

series of appropriation art cases, decided primarily in the Second Circuit. The works subject to takings that allegedly changed their meaning, often with little manipulation of the content, were mainly photographic and pictorial. Initially, before the decision in *Campbell*, the courts showed a rather hostile attitude towards these appropriations, which they viewed as unjustified free-riding. *Rogers v Koons*,¹⁹ for example, involved a black-and-white photo of a couple with a litter of puppies; artist Jeff Koons adapted the image into a brightly coloured sculpture entitled “String of Puppies”. See the photos below.



Photo: Art Rogers



Jeff Koons, *String of Puppies*

¹⁹ 960 F 2d 301 (2d Cir 1992) [*Rogers v Koons*].

The Court of Appeals for the Second Circuit rejected Koons' claim that the sculpture was a parody of the banality of the life of Americans living in affluent suburbs; if Koons' aim was to mock society at large, it was not necessary to copy the plaintiff's particular work. Moreover, the plaintiff's work was too unknown to be the object of a parody (familiarity with the target of the joke being an implicit condition). By way of general condemnation, the court observed:

Here, the essence of Rogers' photograph was copied nearly *in toto*, much more than would have been necessary even if the sculpture had been a parody of the plaintiff's work. In short, it is not really the parody flag that appellants are sailing under, but rather the flag of piracy.²⁰

Subsequently, after *Campbell*, the same Court of Appeals softened its stance, so much so that its decisions seem to amount to an unavowed U-turn. In another case involving Jeff Koons and a photographer, the plaintiff photographer claimed that Koons had copied the most important part of one of her fashion photos and used it in a work entitled "Niagara" consisting of a collage of several photos combining images of women's legs and bare or shod feet (including the photo at issue) with images of fast food and Niagara Falls.²¹ See the photos below.



Andrea Blanch, *Silk Sandals by Gucci* (published in *Allure*, August 2000)

²⁰ *Ibid* at 311.

²¹ *Blanch v Koons*, 467 F 3d 244 at 247, 248 (2d Cir 2006) [*Blanch*].



Jeff Koons, *Niagara* (2000)

This time, the Court accepted the fair use defence, explaining that Koons' use was "transformative", as the copied work served as "raw material" for an entirely different message from the one conveyed by the photographer.²² The Court credited Koons' description of his artistic approach.²³

Koons is, by his own undisputed description, using Blanch's image as fodder for his commentary on the social and aesthetic consequences of mass media. His stated objective is thus not to repackage Blanch's "Silk Sandals", but to employ it "in the creation of new information, new aesthetics, new insights and understandings".²⁴ When, as here, the copyrighted work is used as "raw material", in the furtherance of distinct creative or communicative objectives, the use is transformative.²⁵

In a concurring opinion, one of the judges distinguished *Rogers v Koons* by pointing out that, in the earlier case, Koons' behaviour was parasitic while the juxtaposition of the images in this case was for the purpose of commentary.²⁶ Indeed, it is possible to reconcile the two decisions by observing that, in the first case, Koons used the whole photo and, apart from transforming the image into a three-dimensional work, added little independent input, while, in the second case, the copying was partial and was incorporated into a far more complex second work. In addition, the opinion of the Court and the concurring opinion both stress that where Rogers had suffered harm because Koons had usurped his market for licensing reproductions or adaptations of his photos, Koons did not encroach on any market exploited by Blanch because she admitted that she did not grant licenses to reuse her photos. In considering whether Blanch had suffered harm, the Court declined to take account of potential secondary

²² *Ibid* at 253.

²³ *Ibid* at 252, 253.

²⁴ *Ibid* at 253.

²⁵ *Ibid*.

²⁶ *Ibid* at 262 (Katzmann, J, concurring).

markets that similarly situated photographers might have exploited even if Blanch herself had not.²⁷

More recently, the same Court of Appeals applied the fair use exception in favour of another appropriation artist, Richard Prince, who had copied and reworked (to varying degrees) several photos from *Yes, Rasta*,²⁸ a book that photojournalist Patrick Cariou had published on Jamaican Rastafarians. Prince created a series of 35 paintings, titled *Canal Zone*, in which he enlarged images from *Yes, Rasta* tenfold and transferred them to canvases, sometimes superimposing colours or other elements on the otherwise unchanged images and sometimes incorporating the image in a collage with other images taken from Cariou's book or from other sources. See some of the photos below.



Top photos: Patrick Cariou, *Yes, Rasta*; bottom photos, Richard Prince, *Canal Zone*

Prince asserted fair use, but given his refusal to explain to the District Court what new meaning or new message he was conveying by using Cariou's works, the court denied the alleged transformative character of the use. The Court of Appeals reversed the initial judgment except for five of the thirty paintings that reused Cariou's photos, finding in Prince's works a clear transformation of Cariou's photos and dispensing

²⁷ Cf. *Salinger v Colting*, 607 F 3d 68 (2d Cir 2010) [*Salinger*], which considered market harm from an unauthorised sequel to JD Salinger, *The Catcher in the Rye* (US: Lb Books, 1991) even though Salinger had declined to create or authorise sequels.

²⁸ Patrick Cariou, *Yes, Rasta* (Brooklyn: powerHouse Books, 2000).

the artist from any requirement of explicit commentary:

What is critical is how the work in question appears to the reasonable observer, not simply what an artist might say about a particular piece or body of work. Prince's work could be transformative even without commenting on Cariou's work or on culture, and even without Prince's stated intention to do so.²⁹

Having found that most of the works at issue were transformative in character, the Court then considered the harm suffered by the plaintiff (fourth factor). In earlier decisions, the Court had found market substitution when the publics for the author's and the infringer's works, or for derivative versions, overlapped. The public for Prince's works, on the other hand, the Court stated, was totally different from Cariou's. The latter's book was out of print; he had sold only four prints from the book to acquaintances and his total revenue from *Yes, Rasta* was \$8,000, while Prince exhibited his works in the most exclusive galleries, sold them for over \$2,000,000 and had invited Hollywood stars (such as Robert DeNiro, Angelina Jolie and Brad Pitt) and celebrities from the contemporary art world (including Jeff Koons), to the opening of *Canal Zone*. As poor Cariou could never hope to reach the heights that Richard Prince had achieved, the Court reasoned, it followed that the photographer's and the artist's markets did not overlap, and that Prince's transformative appropriation did not harm Cariou's pitiful market.

This decision is hard to reconcile with same court's decision twenty-one years earlier in *Rogers v Koons*. The earlier decision might be distinguished on the ground that it preceded the Supreme Court's adoption of "transformative use", but the more recent decision leads one to wonder whether it is not an overruling of *Rogers v Koons* rather than a coherent development of case law. Nevertheless, although some aspects of the grounds in *Cariou*, not least the weight that the Court attached to the guestlist for the gallery opening, are questionable (if not shocking), the Court's refusal to require artists to explain themselves is certainly compatible with the free speech goals that fair use furthers.³⁰ Artists are not art critics—no more than judges are³¹—and the copyright law should let their works speak for themselves.³²

That said, the Court of Appeals for the Second Circuit's endorsement of using another artist's works as "raw material" may invite misuse. If a transformative use exploits a transformative market and hence a market that does not encroach on the plaintiff's markets, then a court's acceptance of the "transformativeness" of the use tends to pre-empt the fourth factor. Denominating another artist's work raw material for the creation of transformative works seems to disregard the first author's exclusive

²⁹ *Cariou v Prince*, 714 F 3d 694 at 707 (2d Cir 2013) [*Cariou*].

³⁰ See *Eldred v Ashcroft*, 537 US 186 at 221 (2003) (referencing "copyright's built-in free speech safeguards"); *Golan v Holder*, 565 US 302 at 328, 329 (2012) (clarifying that those safeguards are the idea/expression distinction and the fair use doctrine). See also David Tan, "The Lost Language of the First Amendment in Copyright Fair Use: A Semiotic Perspective of the "Transformative Use" Doctrine Twenty-Five Years On" (2016) 26 *Fordham IP Media & Ent LJ* 311.

³¹ See *Bleistein v Donaldson Lithographing Co*, 188 US 239 at 251, 252 (1903).

³² Of course, artists remain free to explain the new meanings their uses convey, but a finding of fair use does not require artists to self-justify.

right to authorise derivative works, thus problematically expanding fair use.³³ On the other hand, if the derivative works argument reduces to the plaintiff's claim that its market consists of licensing its works for other artists to rework, we encounter a different, but similarly worrisome, problem of circularity.³⁴

As we will see, courts endeavour to extricate themselves from that bind by discounting the transformativeness of the use in the first place; if the defendant has insufficiently reworked the plaintiff's creation, the court can comfortably find an invasion of the plaintiff's markets.³⁵ Of course, this approach puts courts back in the position of second-guessing artistic judgments, but unless judges are simply to genuflect before assertions of artistic prerogative, they will have to examine whether the use in fact "transforms" the copied content, and whether the extent of the copying necessarily advances the transformative objective, or instead simply adds embellishment.³⁶

C. Technological Fair Use and Transformative Purpose

The cases we have considered so far involved a second work that included a second author's input, even if no commentary on the second author's part accompanied the first work's incorporation in the second one. By contrast, another trend in the fair use case law vindicates users who are not authors and whose inputs are not new works at all but rather a new form of dissemination. Courts came to interpret *Campbell's* reference to "something new, with a further purpose"³⁷ to encompass copying, particularly digital copying, that does not add "new expression", so long as the copying

³³ See *Kienitz v Sconnie Nation*, 766 F 3d 756 at 758 (7th Cir 2014) [*Kienitz*]. For examples of transformative fair uses that arguably usurp derivative work rights, see *eg*, *Seltzer v Green Day, Inc.*, 725 F 3d 1170 (9th Cir 2013) (ruling transformative and therefore fair use the wholesale incorporation of a pictorial work into a background video for a Green Day rock concert); *Andy Warhol Found v Goldsmith*, 382 F Supp 3d 312 (SDNY 2019) (silkscreen print incorporating most of photograph of musical performer Prince). See also the discussion of *Goldsmith* below, *infra* notes 65–70.

³⁴ See *eg*, *Cambridge Univ Press v Patton*, 769 F 3d 1232 at 1278 (11th Cir 2014) [*Patton*], noting that: [L]icensing poses a particular threat that the fair use analysis will become circular, and plaintiffs may not head off a defence of fair use by complaining that every potential licensing opportunity represents a potential market for purposes of the fourth fair use factor. . .

See also *Swatch Group Mgmt Servs v Bloomberg LP*, 756 F 3d 73 at 91 (2d Cir 2014) (finding that the plaintiff defined its potential market "so narrowly that it beg[an] to partake of circular reasoning"); *Princeton Univ Press v Michigan Document Servs*, 99 F 3d 1381 at 1387 (6th Cir 1996) (rejecting the defendant's characterisation of the plaintiff's fourth factor argument as "circular"); *Am Geophysical Union v Texaco Inc.*, 60 F 3d 913 at 931 (2d Cir 1994), cert dismissed 516 US 1005 (1995) ("The vice of circular reasoning arises only if the availability of payment is conclusive against fair use"); Lydia P Loren, *Redefining the Market Failure Approach to Fair Use in an Era of Copyright Permission Systems*, 5 J Intellectual Property L 1 at 38–41 (1997) (criticising the argument that "lost" permission fees evince fourth factor harm).

³⁵ See *eg*, *Morris v Guetta*, 2013 US Dist Lexis 15556 (CD Cal 4 Feb 2013) [*Morris*].

³⁶ See *eg*, *Graham v Prince*, 265 F Supp 3d 366 (SDNY 2017) [*Graham*]; *Morris*, *ibid*. In cases involving copying from literary works, courts have been more inclined to inquire whether the defendant took more than it needed for its transformative purpose. See *eg*, *Warner Bros Ent, Inc v RDR Books*, 575 F Supp 2d 513 (SDNY 2008); *Castle Rock Ent, Inc v Carol Pub Group, Inc.*, 150 F 3d 132 (2d Cir 1998). See also *Craft v Kobler*, 667 F Supp 120 at 129 (SDNY 1987) [*Craft*] (Leval, J).

³⁷ *Campbell*, *supra* note 4 at 579.

gives the prior work “new meaning”.³⁸ Fair use cases thus began to drift from ‘transformative work’ to ‘transformative purpose’; in the latter instance, copying of an entire work, without creating a new work, could be excused, particularly if the court perceived a sufficient public benefit in the appropriation.

In the initial shift from ‘transformative work’ to ‘transformative purpose’ the defendant had in fact created an independent work of authorship, even though that work did not significantly alter the copied work. Thus, in *Bill Graham Archives v Dorling Kindersley Lt* (which did not concern digital technologies), the Second Circuit held a coffee-table-book biography’s reduced-sized complete images of posters of the legendary rock band The Grateful Dead were “transformative” because the book used the images of the posters as “historical artifacts” to document the Dead’s concerts, rather than for the posters’ original aesthetic purpose.³⁹ The court distinguished between use of a work to exploit its expression and use of a work as an item of information. But the documentary/aesthetic distinction also significantly expanded the application of the fair use exception to new technological uses that did not yield new works. The search engine practice of permanent storage of works for the purpose of ‘indexing’ was an important early digital beneficiary of the ‘documentary’ or ‘new purpose’ brand of transformativeness.⁴⁰

For example, in *Perfect 10 (amended)*,⁴¹ a controversy involving a search engine’s “highly transformative” indexing of photographs and display of thumbnail images, the court applied the aesthetic/documentary distinction to find that the use did not compete with the plaintiff photographer’s market for sales of high-resolution images. In response to the plaintiff’s contention that the defendant’s use competed with an evolving market for paid downloads of thumbnail images onto cellphones, the court held that the plaintiff had not borne its burden of showing that the market was more than “hypothetical”.⁴² Apparently reminded that fair use is an affirmative defence, and therefore that the defendant bears the burden with respect to market harm, the court reissued its opinion, acknowledging the placement of the burden,⁴³ and deleting the phrase “Perfect 10 has not introduced evidence that Google’s thumbnails would

³⁸ See eg, *Kelly v Arriba Soft Corp*, 336 F 3d 811 at 819 (9th Cir 2002) [*Kelly*]: “[b]y putting a copy of the photograph in the newspaper, the work was transformed into news, creating a new meaning or purpose for the work”.

³⁹ *Bill Graham Archives v Dorling Kindersley Ltd*, 448 F 3d 605 at 609, 610 (2d Cir 2006).

⁴⁰ See eg, *Perfect 10, Inc v Amazon.com, Inc*, 508 F 3d 1146 at 1174, 1175 (9th Cir 2007) [*Perfect 10 (amended)*]; *Kelly*, supra note 38 at 819, 820.

⁴¹ *Ibid* at 1158.

⁴² *Perfect 10, Inc v Amazon.com, Inc*, 487 F 3d 701 at 725 (9th Cir 16 May 2007) [*Perfect 10 (original)*], amended by *Perfect 10 amended*, *ibid*.

⁴³ See *Perfect 10 (original)*, *ibid* at 714:

Because Perfect 10 has the burden of showing a likelihood of success on the merits, the district court held that Perfect 10 also had the burden of demonstrating a likelihood of overcoming Google’s fair use defence under 17 USC. § 107. . . We have not previously ruled on this issue. . . and we now agree with the district court’s ruling. In order to demonstrate its likely success on the merits, the moving party must necessarily demonstrate it will overcome defences raised by the non-moving party.

Compare this with *Perfect 10 (amended)*, *ibid* at 1158:

Because Perfect 10 has the burden of showing a likelihood of success on the merits, the district court held that Perfect 10 also had the burden of demonstrating a likelihood of overcoming Google’s fair use defence under 17 USC. § 107. . . This ruling was erroneous. At trial, the defendant in an infringement action bears the burden of proving fair use.

harm Perfect 10's existing or potential market for full-size images",⁴⁴ but leaving its fair use analysis (including the reference to "the unproven use of Google's thumbnails for cell phone downloads"⁴⁵) unchanged. The court's finding that the indexing function was "highly transformative" appears to have driven its diminution of the significance of market harm. The decision shows that the more "transformative" a court has found the appropriation, the less likely plaintiff can prevail without proving harm, but the more "transformative" the appropriation, the more futile endeavours to show harm may prove.

Other applications of the aesthetic/documentary or expression/information distinction to the inputting of copyrighted works into databases then emerged. In *AV ex rel Vanderhye v iParadigms, LLC*, the Fourth Circuit ruled the constitution of a commercial database of student papers by the "Turn It In" plagiarism detection services a fair use:

" [T]he archiving of plaintiffs' papers was transformative and favoured a finding of 'fair use.' iParadigms' use of these works was completely unrelated to expressive content and was instead aimed at detecting and discouraging plagiarism.⁴⁶"

Thereafter, the Second Circuit in *HathiTrust (2d Cir)*, concerning uses by the University of Michigan library of its holdings, as digitised by Google, found the scanning and permanent storage of full copies of in-copyright books to further the 'transformative use' of allowing 'data mining' of the contents of the books.⁴⁷ Such uses are non-expressive in two senses: they produce no new expression by the copying and storage entities, and the 'mining' of the scanned book seeks not to expose its expression, but rather to extract information.⁴⁸

In light of this progression, the fair use outcome in *Google Books*,⁴⁹ in which a for-profit corporation scanned millions of in-copyright books and permanently stored their full contents in its database, may have seemed inevitable, even though *Google Books* presented two ultimately non-salient differences with *HathiTrust (2d Cir)*. While the University of Michigan is a non-profit educational institution, and (apart from a limited program for the visually impaired) it confined its use of the database to data mining so that it conveyed none of the scanned works' contents to the public, Google is not a charitable entity, and its book search program communicated to the public "snippets"—each generally up to three lines of text—of the books. The court accorded scant weight to the commercial nature of Google's enterprise, stressing that the Second Circuit has "repeatedly rejected the contention that commercial motivation should outweigh a convincing transformative purpose and absence of significant substitutive competition with the original".⁵⁰ Distinguishing between outputs that convey information *about* the scanned book from outputs that convey its *expression*, the court ruled that neither the data mining uses nor the snippet

⁴⁴ *Perfect 10 (amended)*, *ibid* at 1158.

⁴⁵ *Ibid* at 1168.

⁴⁶ 562 F 3d 630 at 640 (4th Cir 2009).

⁴⁷ *HathiTrust (2d Cir)*, *supra* note 6.

⁴⁸ See generally the attached Brief of Digital Humanities and Law Scholars as Amici Curiae in Partial Support of Defendants' Motion for Summary Judgment in *HathiTrust (2d Cir)*, *ibid*, 2012 WL 4808939 (No. 11 CV 6351 (HB)), 2012 WL 3966152.

⁴⁹ *Google Books*, *supra* note 6 *per* Leval J.

⁵⁰ *Ibid* at 219.

views exploited the copied works for their expressive value. Hence “the creation of complete digital copies of copyrighted works [results in] transformative fair uses when the copies ‘served a different function from the original’.”⁵¹

With respect to the data mining uses that yield little or no copyrighted expression, there is a powerful argument that exploiting a work for its non-expressive information (bibliographic or bean-counting, *ie*, how many times and in what works a given word or phrase appears) is not even *prima-facie* infringing, and that the digitization of lawfully possessed copies (loaned from the University of Michigan Library) to create a database that enables non-expressive, but progress-of-knowledge-enhancing outputs must therefore be equally free.⁵² By contrast, the snippet views did convey limited amounts of expression, but the court repeatedly emphasised the very constrained and controlled, “fragmentary and scattered”, “cumbersome, disjointed, and incomplete nature of the aggregation of snippets made available through snippet view”.⁵³ As a result, and endeavouring to avoid slippery-slope expansion of the content or presentation of fair use-permissible snippets, the court emphasised that “*at least as presently structured by Google, the snippet view does not reveal matter that offers the marketplace a significantly competing substitute for the copyrighted work*”.⁵⁴

Like *Cariou*, *Google Books* may mark the outermost swing of the fair use pendulum.⁵⁵ As we will see in the next section, courts, particularly appellate courts, are more critically examining assertions of “transformativeness”, and are restoring emphasis on the fourth factor: market harm. But if courts are retreating from the excesses of “transformative use”, re-emphasis of the inquiry into economic harm may be introducing new distortions, as courts’ evaluations of cognisable harm diverge.

III. THE PENDULUM RETURNS?

A. More Critical Assessments of “Transformativeness” in New Work Cases

Given the trend toward an “if ‘transformative’, then fair use” formula,⁵⁶ it may not be surprising that the recent retrenchments closely scrutinised the allegedly transformative character of the use, whether with respect to new works or to new

⁵¹ *Ibid* at 217.

⁵² *Cf Segal Enters v Accolade, Inc*, 977 F 2d 1510 (9th Cir 1992) (holding that the creation of a verbatim intermediate copy in order to produce a non-infringing complementary program is fair use, where the intermediate copy does not appear to have been retained following the creation of the second program).

⁵³ *Google Books*, *supra* note 6 at 223, 224.

⁵⁴ *Ibid* at 222 [emphasis added].

⁵⁵ See *TCA Corp v McCollum*, 839 F 3d 168 at 181 (2d Cir 2016) [*McCollum*] (calling *Cariou*, *supra* note 29: “the high-water mark of our court’s recognition of transformative works”). See also Melville B Nimmer & David Nimmer, *Nimmer on Copyright* (New York: Matthew Bender Elite Products) vol 4 at § 13.05[B][6], stating with respect to *Cariou*, *supra* note 29:

It would seem that the pendulum has swung too far in the direction of recognizing any alteration as transformative, such that this doctrine now threatens to swallow fair use. It is respectfully submitted that a correction is needed in the law.

⁵⁶ As part of this trend, the first factor has tended to swallow up the second factor (nature of the copyrighted work—a consideration that courts enunciate then largely ignore), as well as the third factor (amount and substantiality of the copying), since taking an entire work can still be consonant with a transformative purpose. See generally Beebe, *supra* note 3 at 588–591 (discussing the “stampeding” of the factors).

technological forms of dissemination. The first notable breach in the defence concerned a play that had interpolated a famous dialogue from an Abbott and Costello motion picture. The District Court had found that the play's verbatim incorporation of the prior work was transformative because the play's overall context was completely different from the copied work. The transformative character of the use in turn led the court to disregard the film producer's market for licensing extracts from the film's dialogues. The Second Circuit reversed, criticising the lower court's "flawed" reasoning that conflated "the general artistic and critical purpose and character of the Play" with the specific use of the copied dialogue. "The district court did not explain how defendants' extensive copying of a famous comedy routine was necessary to this purpose, much less how the character of the Routine was transformed by defendants' use".⁵⁷ The court went on to find the verbatim incorporation non-transformative. In response to the defendants' contention that the play made a different dramatic use of the copied content, the court retorted:

The 'dramatic' purpose served by the Routine in the Play appears to be as a 'McGuffin,' that is, as a theatrical device that sets up the plot, but is of little or no significance in itself. To advance the plot of the play, [the playwright] needed [the protagonist] to lie about *something* and for [another character] to call him on it. But the particular subject of the lie—the Routine—appears irrelevant to that purpose.⁵⁸

Here, the protagonist lied about creating the Abbott and Costello dialogue himself. But the protagonist could have lied about having created *any* dialogue; there was no particular reason that character needed to plagiarise the plaintiff's work. The court's analysis recalls (but does not cite) its earlier determination in *Rogers v Koons*, that if Koons sought to satirise the banality of suburban life, he did not need Art Rogers' photograph to make that point.⁵⁹ The court's willingness to engage in literary analysis, labelling the use of the Routine a "McGuffin", indicates that the Second Circuit may be greeting assertions of transformative use more sceptically.

The Fourth Circuit took a similarly closer look at the allegedly transformative character of the use in reversing a District Court's determination that the unauthorised incorporation of a photographic view of Washington D.C.'s Adams Morgan neighbourhood into a website showing D.C. tourist attractions related to a film festival transformed the purpose of the copied work and therefore was a fair use.⁶⁰ The Fourth Circuit rebuked the District Court's credulous acceptance of the transformative use defence:

Violent Hues used the Photo expressly for its content—that is, to depict Adams Morgan—rather than for data organization or historical preservation. Instead, Violent Hues' sole claim to transformation is that its secondary use of the Photo provided film festival attendees with 'information' regarding Adams Morgan. But

⁵⁷ *McCollum*, *supra* note 55 at 179.

⁵⁸ *Ibid* at 182 [emphasis in original].

⁵⁹ *Rogers v Koons*, *supra* note 19 at 310.

⁶⁰ *Brammer v Violent Hues Prods*, 922 F 3d 255 (4th Cir 2019) [*Violent Hues (4th Cir)*], reversing *Brammer v Violent Hues Prods*, 2018 US Dist Lexis 98003 (ED Va 11 June 2018) [*Violent Hues (DC)*].

such a use does not necessarily create a new function or meaning that expands human thought; if this were so, virtually all illustrative uses of photography would qualify as transformative.⁶¹

The Fourth Circuit’s reproach may help rein in some of the doctrinal sprawl that “informational” transformative uses have spawned. The informational/aesthetic distinction is problematic, particularly as applied to photographs because photographs manifest both qualities. All photographs are “informational” in displaying the appearance of their subjects. As original works of authorship, they also are “aesthetic” in the way they portray their subjects. As *Violent Hues* (4th Cir) illustrates, distinctions based on the purpose of the copying—assigning different fair use consequences to copying in order to communicate the photograph’s subject, as opposed to copying in order to exploit the expressive qualities of the portrayal—makes no sense. Unless the quality of the copy is so poor as to make the rendition unfit for further communication, “informational” copying will inevitably exploit expression. If “informational” copying to show what the subject of the photograph looks like were a “transformative” fair use, then most photographs would effectively no longer enjoy copyright protection.

One District Court has used *Cariou* as the baseline comparison to query the transformativeness of an appropriation more extensive and less re-manipulated than the *Canal Zone* images the Second Circuit ruled fair use as a matter of law. In *Graham*,⁶² another controversy involving Richard Prince’s appropriation of a different photographer’s image of a Rastafarian (see images below), the District Court rejected a motion to dismiss, in an analysis strongly suggesting that a subsequent trial on the merits would lead to a rejection of the fair use defence.



The court recalled that in *Cariou*, “[t]he majority stressed the substantial aesthetic differences between the works, pointing out that Prince ‘fundamentally’ altered

⁶¹ *Violent Hues* (4th Cir), *ibid* at 264.

⁶² *Supra* note 36.

the original photographs' 'composition, presentation, scale, colour palette, and media'.⁶³ By contrast, in Graham's case:

[A reasonable] observer must conclude that Prince's *Untitled* does not so 'heavily obscure and alter' Graham's *Rastafarian Smoking a Joint* that it renders the original photograph 'barely recognizable.' The primary image in both works is the photograph itself. Prince has not materially altered [Graham's work].⁶⁴

In ruling Prince's use not transformative as a matter of law, the court emphasised that Graham's image, virtually unchanged, constituted almost the entirety of Prince's work. The court distinguished Koons's *Niagara*, in which Andrea Blanch's photo formed part of a much larger and more complex composition:

Koons incorporated the legs from that photograph into a massive collage painting featuring three *other* pairs of women's legs, 'dangling prominently over images of confections,' including trays of pastries and ice-cream, 'with a grassy field and Niagara Falls in the background'.⁶⁵

The court's analysis evokes a variant of the quip "copying from one source is infringement; copying from multiple sources is research"⁶⁶: appropriating and altering multiple images "transforms" each one; appropriating a single work *in toto* and verbatim is not "transformative" as a matter of law.

But the pendulum's return does not follow a continuous arc; these decisions may not sound the death knell of defendant-deferential assessments of transformativeness in appropriation art. Courts may continue to apply a capacious concept of transformativeness, endorsing wholesale use of other creators' works as "raw material", perhaps because judges remain uneasy about second-guessing artistic judgments. The problematic reasoning of *Andy Warhol Foundation for the Visual Arts, Inc v Goldsmith*⁶⁷ underscores the court's reluctance to impose copyright liability on an artist celebrated for his reworking of other artists' images. There, the declaratory judgment defendant took a photograph of Prince in 1981 (see below). Vanity Fair licensed the photograph in 1984 for \$400 "for use as an artist's reference in connection with an article to be published in Vanity Fair Magazine". Vanity Fair commissioned Andy Warhol to create an illustration based on the photograph and it published Warhol's illustration to accompany an article about Prince in the November 1984 issue of Vanity Fair (see below). The illustration published in Vanity Fair was one of a series of 16 silkscreen paintings, prints and drawings Warhol created based on Goldsmith's photograph.

After Prince's death in 2016, Vanity Fair obtained a license from the Andy Warhol Foundation to republish one of the Warhol images (a different one than the magazine had printed in 1984) on the cover of a special issue of the magazine devoted to the

⁶³ *Ibid* at 378 (citing *Cariou*, *supra* note 29 at 706). The court in *Graham*, *ibid*, noted that "[t]hese changes were sufficient to render twenty-five of the thirty Canal Zone works at issue transformative as a matter of law".

⁶⁴ *Ibid* at 381 (citing *Cariou*, *supra* note 29 at 710).

⁶⁵ *Ibid* (citing *Blanch*, *supra* note 21 at 247).

⁶⁶ *Ibid* at 381, 382.

⁶⁷ 382 F Supp 3d 312 (SDNY 2019) [*Andy Warhol Foundation*].

performer, which appears on the left, below. *Vanity Fair* did not obtain a license from Goldsmith, nor did its special issue credit her source photograph, although the November 1984 issue had included a source credit.



Photo: Lynn Goldsmith



Andy Warhol, *Prince* (for *Vanity Fair*)

In concluding on a motion for summary judgment that Warhol's use of Goldsmith's photograph was fair use, the court held Warhol's use to be transformative. While Goldsmith portrayed Prince as "not a comfortable person" and a "vulnerable human being", the Warhol series, according to the court:

[C]an reasonably be perceived. . . to have transformed Prince from a vulnerable, uncomfortable person to an iconic, larger-than-life figure. The humanity Prince embodies in Goldsmith's photograph is gone. Moreover, each Prince Series work

is immediately recognizable as a ‘Warhol’ rather than as a photograph of Prince—in the same way that Warhol’s famous representations of Marilyn Monroe and Mao are recognizable as ‘Warhols,’ not as realistic photographs of those persons. . . [The Warhol series] add[s] something new to the world of art and the public would be deprived of this contribution if the works could not be distributed.⁶⁸

The court appears to be suggesting that the more characteristic and celebrated an artist’s style, the broader his entitlement to adopt others’ works. While the Warhol version may be “immediately recognizable” as an iteration of his brand of representation, it is far from clear that no reasonable jury could find that, despite the works’ “aesthetic differences”, Goldsmith’s photograph not only remains identifiable in Warhol’s version but also that its essence persists. “Transformation” may be in the beholding; Warhol may have “transformed Prince from a vulnerable, uncomfortable person to an iconic, larger-than-life figure”. But it does not follow that the “icon” symbolises power or self-satisfaction. A reasonable jury might equally well perceive a heightening of the “humanity” that, for the court, Warholisation drained from the image.

As in *Cariou*, the transformative character of the use influenced the court’s evaluation of the fourth factor as well, in terms all too reminiscent of the Second Circuit’s: “[i]t is plain that the markets for a Warhol and for a Goldsmith fine-art or other type of print are different”.⁶⁹ Like Richard Prince, Warhol’s celebrity sells his works, while Goldsmith shares Cariou’s obscurity. The court was similarly dismissive of Goldsmith’s claim that the Warhol prints usurped her licensing market:

Goldsmith’s evidence and arguments do not show that the Prince Series works are market substitutes for her photograph. She provides no reason to conclude that potential licensees will view Warhol’s Prince Series, consisting of stylized works manifesting a uniquely Warhol aesthetic, as a substitute for her intimate and realistic photograph of Prince. Although Goldsmith points out that her photographs and Warhol’s works have both appeared in magazines and on album covers, this does not suggest that a magazine or record company would license a transformative Warhol work in lieu of a realistic Goldsmith photograph.⁷⁰

The court did not consider whether the relevant markets include the one of licensing to Warhol himself (and to other artists who would use Goldsmith’s work as “source material”). Rather, the court’s analysis suggests that Warhol may permissibly preempt Goldsmith’s opportunities to license her work simply by being more famous and recognisable than she. One might instead inquire, akin to the Second Circuit in *McCullum* and in *Rogers*, if the public wants “a Warhol”, must it be a Warhol of a Goldsmith?⁷¹ The court’s approach lends support to the criticism that a

⁶⁸ *Ibid* at 326. The court appears to have assumed that Goldsmith’s remedies, had she prevailed, would have included injunctive relief. That outcome, however, is by no means certain. See *eg, Salinger, supra* note 27 (following Supreme Court’s decision in *eBay Inc v MercExchange, LLC*, 547 US 388 (2006), requiring showing of irreparable harm from infringing sequel of *The Catcher in the Rye, supra* note 27).

⁶⁹ *Andy Warhol Foundation, ibid* at 330.

⁷⁰ *Ibid* at 330, 331.

⁷¹ Proper credit might have resolved the case. See the discussion below in Part II(D).

“transformative use” exemption conflicts with the statutory grant of exclusive rights to make derivative works; the statute defines these as encompassing any “form in which a work may be recast, *transformed*, or adapted”.⁷²

B. More Critical Assessments of “Transformativeness” in New Purpose Cases

With respect to new technological uses, recent cases show courts are more critically examining the transformative character of allegedly repurposed disseminations. In *VHT, Inc v Zillow Group, Inc*,⁷³ the VHT photo service claimed that the Zillow real estate database had incorporated VHT’s photographers’ images of home interiors into Zillow’s Digs database to show the interiors of the houses that are on the Zillow database. Zillow acquired copies of the plaintiff’s images, without the photographers’ authorisation, and indexed them in order to allow them to come up on the search for Digs. Zillow defended the ensuing infringement action on the ground that it was a search engine, and under Ninth Circuit precedent, copying by search engines was transformative and therefore fair use.

The District Court disagreed, and the Ninth Circuit affirmed. It emphasised that “the label ‘search engine’ is not a talismanic term that serves as an on-off switch as to fair use”.⁷⁴ It distinguished prior search engine cases in which the output was a non-substitutional thumbnail photo; or, as in *Google Books*, where the output either contained no expression at all or merely non-substitutional “snippets” which could not be cumulated into a full page or other quantity that might in some way be substitutional. The court thus recognised that a transformativeness inquiry does not stop at observing that defendant’s use involves a search function; rather, the court must examine what the search program delivers once it has identified the targeted content. In the earlier cases, what the program delivered did not substitute for the copied content. In *VHT v Zillow*, by contrast, Zillow delivered high-resolution, full-quality photographs which competed with the plaintiff’s licensing of those photographs for uses that included exactly the kinds of uses Zillow was making: to display the interiors of homes listed in the database.

The Ninth Circuit’s analysis offers a variation on the relationship of transformativeness and competition. Many of the cases we have reviewed derive a finding of non-substitution from the initial characterisation of the use as transformative (transformative use = transformative, *ie*, non-competing, market). In *VHT v Zillow*, the capacity of Zillow’s use to usurp a market for the photographs confirmed the use’s non-transformative character.

A further step along the path of transformative use breaks the equation between transformativeness and market harm to acknowledge that, even if a use is transformative, it might nonetheless harm the actual or potential markets for the copied work, and therefore not be “fair”. *Fox News Network v TVEyes, Inc*⁷⁵ presented such

⁷² 17 USC, *supra* note 1, § 101 [emphasis added]. See *eg*, *Google Books*, *supra* note 6 at 215 (2d Cir 2015): “[a] further complication that can result from oversimplified reliance on whether the copying involves transformation is that the word ‘transform’ also plays a role in defining ‘derivative works,’ over which the original rights holder retains exclusive control”; *Kienitz*, *supra* note 33.

⁷³ 918 F 3d 723 (9th Cir 2019) [*VHT v Zillow*].

⁷⁴ *Ibid* at 742.

⁷⁵ 43 F Supp 3d 379 (SDNY 2014) [*TVEyes (DC)*], *rev’d*, 883 F 3d 169 (2d Cir 2018) [*TVEyes (2d Cir)*].

an instance. The District Court, and majority and concurring opinions in the Second Circuit also reveal diverging assessments of transformativeness. The defendant TVEyes was a commercial “media monitoring” service which copied and stored radio and television news broadcasts in their entirety to enable its subscribers to retrieve portions of broadcasts that interest them by keyword searches of TVEyes’ database. It can be likened to a digital and visual version of the old “clipping services” where employees read newspapers to extract all the articles in which their clients’ names appeared. Except that, in this case, it was the client who not only chose the search themes but also did the extracting thanks to the access that TVEyes’ database afforded to the entire content of radio and television news broadcasts. The video clips provided by the service in response to search queries generally lasted from two to ten minutes.

The District Court held that the service was covered by fair use on the ground that it transformed the purpose of the broadcasts. Like the District Court in *Violent Hues (DC)*, the analysis in *TVEyes (DC)* analysis illustrates how far out lower courts perceived the fair use pendulum to have swung. In the District Court’s view, the video clips were “transformative” because their purpose was to let the researcher know “what was said” in the television reports, rather than telling viewers “this is what you should know”.⁷⁶ Not only is this distinction elusive, but as the Fourth Circuit warned in *Violent Hues (4th Cir)*, the approach in *TVEyes (DC)*—“this is what the copied work said”—may end up converting any work, including its expression, into a piece of information, thus justifying the copying as “documentary” fair use.

The Second Circuit reversed, but still found the use “somewhat transformative”, not as a documentary use, but because TVEyes “utilizes technology to achieve the transformative purpose of improving the efficiency of delivering content”.⁷⁷ The majority’s liberal (not to say profligate) perception of transformativeness provoked a caustic concurrence from Judge Kaplan (sitting by designation). If the use was “somewhat transformative” because it enhanced user convenience in viewing the desired extracts, he charged, then transformative use will inevitably conflict with copyright owners’ exploitation of their works: “[n]ew efficiency-enhancing content delivery technologies that will seek to distribute copyrighted material owned by others doubtless now or soon will exist.”⁷⁸

While the majority’s willingness to characterise defendant’s content-delivery as “transformative” (albeit “modest at best”⁷⁹) strains the concept of transformativeness, it is significant that the court rejected the fair use defence notwithstanding a finding of transformative use. Because the duration of the clips equalled or exceeded the totality of each extracted news story (factor 3), and because there was a “plausibly exploitable market” for deferred viewing of television content, TVEyes’ service plainly “usurped a function for which Fox is entitled to demand compensation under a licensing agreement”.⁸⁰ Transformativeness did not sweep all before it, and the court trained renewed attention on the third, and particularly, fourth fair use factors.

⁷⁶ *TVEyes (DC)*, *ibid* at 393.

⁷⁷ *TVEyes (2d Cir)*, *ibid* at 177, 178.

⁷⁸ *Ibid* at 183 *per* Kaplan, J, concurring.

⁷⁹ *Ibid* at 181 (majority opinion).

⁸⁰ *Ibid*.

Similarly, in *Capitol Records, LLC v ReDigi Inc.*,⁸¹ concerning an online service that brokered sales of “used” MP3 files, the Second Circuit recalled its generous characterisation of transformativeness in new purpose cases: “a secondary use may be transformative if it provides information about the original, ‘or expands its utility’.”⁸² As with the (dubiously) transformative purpose of enhancing consumer access, utility-expansion can encompass a good deal of exploitation, and thus risks denominating all but the most directly competing uses “transformative”. In *ReDigi*, the Second Circuit nonetheless found a “total absence (or at least very low degree) of transformative purpose”,⁸³ because ReDigi “essentially . . . provide[s] a market for the resale of digital music files, which resales compete with sales of the same recorded music by the rights holder”.⁸⁴ The parenthetical “at least a very low degree” suggests the court may still seek to discern some shard of transformativeness, but such strained perceptions do not matter if the court maintains its principal focus on the economic consequences of the scarcely repurposed use. Because ReDigi’s copying competed directly with sales of the plaintiff’s works, the court ruled that the fourth factor “weighs powerfully against fair use”.⁸⁵

Judge Leval’s opinion in *Google Books* hypothesises a different instance in which market impact might outweigh even a highly transformative use, in that case, of indexing and data mining or snippet-delivery; the opinion also identifies a new kind of market harm:

If, in the course of making an arguable fair use of a copyrighted work, a secondary user unreasonably exposed the rights holder to destruction of the value of the copyright resulting from the public’s opportunity to employ the secondary use as a substitute for purchase of the original (even though this was not the intent of the secondary user), this might well furnish a substantial rebuttal to the secondary user’s claim of fair use. For this reason, the *Arriba Soft* and *Perfect 10* courts, in upholding the secondary user’s claim of fair use, observed that thumbnail images, which transformatively provided an Internet pathway to the original images, were of sufficiently low resolution that they were not usable as effective substitutes for the originals.⁸⁶

The court found that Google had taken “effective measures . . . to guard against piratical hacking”,⁸⁷ so that the risk of security failure did not defeat a fair use defence. But, by negative inference, no matter how “transformative” the use, if its implementation depends on manipulation of permanently stored copies that are inadequately secured, then the threat to the copyright owner’s market should offset the transformativeness of the use. If the deployment of effective security assures us that the market for the work won’t be compromised by runaway copies, then ineffective security deprives

⁸¹ 910 F 3d 649 (2d Cir 2018) [*ReDigi*].

⁸² *Ibid* at 661, citing *Google Books*, *supra* note 6 at 214.

⁸³ *Ibid*.

⁸⁴ *Ibid*.

⁸⁵ *Ibid* at 663.

⁸⁶ *Google Books*, *supra* note 6 at 227.

⁸⁷ *Ibid* at 228.

us of that assurance, and undermines a fair use defence. Thus, in *Google Books*, had the authors rebutted Google's showing, the prospective economic harm from porous security should have weighted the scales more heavily against fair use even though full text retention and searchability were necessary to generate the transformative outputs. As the court acknowledged:

Even if the *purpose* of the copying is for a valuably transformative purpose, such copying might nonetheless harm the value of the copyrighted original if done in a manner that results in widespread revelation of sufficiently significant portions of the original as to make available a significantly competing substitute.⁸⁸

Importantly, the focus on security failures demonstrates that fair use of digital content is not static: if the subsequent inadequacy of security measures brings prospective economic harm to the fore, it may render a previously fair use unfair. When the facts that supported the fair use finding change, so should the legal conclusion. Thus, for example, advances in hacking should oblige the proprietor of a database containing copyrighted works to update its security, lest a level previously sufficient, and therefore supportive of fair use, later become inadequate and therefore inconsistent with fair use. Even where the use is "highly transformative", courts should closely scrutinise the impermeability of a prospective fair user's digital protections. Google's security may be "impressive",⁸⁹ and Google may have every incentive to maintain it, but not every user capable of scanning and storing in-copyright works for non-infringing, "transformative" purposes, may have the resources, expertise or inclination to safeguard the copied content.

C. *The Reinvigoration of the Fourth Factor*

We have seen that at its apogee, a finding of "transformative use" tended to dictate, even distort, analysis of the fourth, market harm, factor. The District Court's opinion in *Violent Hues (DC)*, and its correction by the Fourth Circuit, make the point. The District Court, having found the use "transformative", then (placing the burden of proof on the wrong party) ruled that the plaintiff did not show market harm because he made two sales of the Photo after *Violent Hues*' use began.⁹⁰ The Fourth Circuit rejoined: "[t]hat cannot be correct. If the mere fact of subsequent sales served to defeat a claim of market harm, then commercially successful works could hardly ever satisfy this factor."⁹¹

If courts less readily find transformative use, one might expect them to focus more rigorously on market harm. In fact, however, a more critical examination of "transformativeness" under the first factor may nonetheless still lead to

⁸⁸ *Ibid* at 223 [emphasis in original].

⁸⁹ *Ibid* at 228.

⁹⁰ *Violent Hues (DC)*, *supra* note 60, *rev'd Violent Hues (4th Cir)*, *supra* note 60.

⁹¹ *Violent Hues (4th Cir)*, *ibid* at 268, 269.

“stampeding”⁹² the other factors, but in the opposite direction: if the use was commercial and not transformative, courts apply a presumption of market harm.⁹³ Calling it a “presumption”, however, is misleading, since presumptions are burden-shifting devices, and the defendant already bears the burden of making out the affirmative defence of fair use.⁹⁴ More likely, one should understand the label “presumption” here to mean that the defendant may not be likely to meet its burden, since courts tend to perceive non-transformative uses as substitutional.⁹⁵ In other words, “transformativeness” may remain decisive, but the equation has flipped. The formula “if transformative work/purpose, then no market harm” meets its corollary: “[i]f commercial and not transformative, then market harm.” Thus, fair use continues to reduce to a one-factor test, but one that cuts both ways.

Fortunately, the fair use calculus is not always so simplistic. Some case law indicates that defendants may nonetheless escape the flip side of the transformativeness coin. For example, a defendant might show that the non-transformative use at issue does not usurp any relevant markets because, even if the market exists in the abstract, neither the plaintiff nor similarly situated copyright owners have exploited those markets. The ongoing litigation between Georgia State University and Cambridge University Press and other academic book publishers over electronic “course reserves” (essentially, the technological successor to photocopied coursepacks) rings several changes on the theme of cognisable market harm where the use is non-transformative (albeit also noncommercial). Initially, the District Court had ruled that the publishers’ failure to license excerpts of books for enrolled students’ online consultation through the university library would weigh the fair use finding against the publishers.

In effect, the court made fair use contingent on a license-it-or-lose-it standard.⁹⁶ The Eleventh Circuit reversed in part, criticising the District Court’s methodology, but did not substantially disagree with the significance the District Court accorded the absence of a licensing program for some of the plaintiffs’ works.⁹⁷

On remand, the District Court concluded that even as to books for which the publishers had offered licenses for digital access, factor four nonetheless favoured the university in most instances because the publishers had earned only trivial income from licensing electronic course copying of the work at issue, and therefore the cumulative impact remained too small to weigh the fourth factor in the publishers’ favour.⁹⁸ The Eleventh Circuit again vacated in part, ruling that the District Court

⁹² See Beebe, *supra* note 3; see also Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, (2006) 94 Cal L Rev 1581, at 1614, 1615.

⁹³ See *eg.*, *Campbell*, *supra* note 60; *Violent Hues (4th Cir)*, *supra* note 93 at 268; *Disney Enterprises, Inc v VidAngel, Inc*, 869 F 3d 848 at 861 (9th Cir 2017) [*VidAngel*]: “[b]ecause the district court concluded that VidAngel’s use was commercial and not transformative, it was not error to presume likely market harm”.

⁹⁴ See the above discussion of *Perfect 10 (original)* and *Perfect 10 (amended)*, *supra* notes 40-44. See also *Campbell*, *supra* note 4 at 590; *Google Books*, *supra* note 6 at 213.

⁹⁵ See *eg.*, *Violent Hues (4th Cir)*, *supra* note 60; *VidAngel*, *supra* note 93.

⁹⁶ See *Cambridge Univ Press v Becker*, 863 F Supp 2d 1190 (ND Ga 2012), *aff’d in part, rev’d in part (sub nom Patton)*, *supra* note 34).

⁹⁷ *Ibid* at 1277.

⁹⁸ *Cambridge Univ Press v Becker*, 371 F Supp 3d 1218 (ND Ga 2016), *aff’d in part, vacated in part (sub nom Cambridge Univ Press v Albert)*, 906 F 3d 1290 (11th Cir 2018) [*Albert*].

should have retained its original finding of market harm as to the works for which the publishers had offered licenses.⁹⁹

An extant licensing program therefore may establish that the same use, unlicensed, will cause economic harm; one should not, however, immediately make the negative inference of absence of cognisable harm when the plaintiff declines to license the use that the defendant is exploiting. The plaintiff may have economic reasons to forego a particular market, as the Eleventh Circuit recognised in its first decision in *Cambridge University Press*:

Of course, it need not always be true that a publisher's decision not to make a work available for digital permissions conclusively establishes that the publisher envisioned little or no demand, and that the value of the permissions market is zero. After all, a number of other factors might influence a publisher's distribution decision: the publisher may not yet have figured out how to sell work in a different medium, or it might want to restrict circulation in one medium to promote another.¹⁰⁰

In addition, an author might also decline to exploit a particular market, for example, for sequels¹⁰¹ or other spin-offs,¹⁰² because she seeks to preserve her artistic vision for the work. The Second Circuit has recognised that:

It would. . . not serve the ends of the Copyright Act—i.e., to advance the arts—if artists were denied their monopoly over derivative versions of their creative works merely because they made the artistic decision not to saturate those markets with variations of their original.¹⁰³

Renewed emphasis on the fourth factor may prompt courts to question the nature and viability of the plaintiff's market for her work. For example, in *Cambridge University Press*, the District Court considered the publishers' licensing market too trivial to amount to cognisable harm.¹⁰⁴ The Eleventh Circuit reversed on that ground, but the denigration of the plaintiff's licensing markets in *Cariou* and *Goldstein* suggests that the approach may remain available elsewhere, and might tempt courts in other circuits to discount the worth of those markets. In *Philpot v WOS, Inc.*,¹⁰⁵

⁹⁹ *Albert, ibid.*

¹⁰⁰ *Patton, supra* note 34 at 1277.

¹⁰¹ *Cf Salinger, supra* note 27 (JD Salinger did not authorise sequels to *The Catcher in the Rye, supra* note 27).

¹⁰² *Cf Castle Rock Ent, Inc v Carol Pub Group, Inc*, 150 F 3d 132 (2d Cir 1998) (Jerry Seinfeld declined to license trivia quiz book about *Seinfeld* television show).

¹⁰³ *Ibid* at 146. The court found the quiz book's use of the *Seinfeld* shows non-transformative because the purpose of the quiz book was not to educate, analyse, criticize or comment, but rather to repackage the *Seinfeld* programs to entertain the reader and to "sate *Seinfeld* fans' passion" for the show. *Ibid* at 142, 143.

¹⁰⁴ The focus on whether and how successfully the copyright owner has exploited the work risks initiating a race to the market, particularly for new technological modes of exploitation. When a new market is developing, the copyright owner may be deriving little or nothing from participating in that market, or may find itself catching up with more technologically adept copiers.

¹⁰⁵ No 18-CV-339-RP, 2019 WL 1767208 (WD Tex 22 April 2019) [*Philpot*].

a District Court in the Fifth Circuit weighed the fourth factor against a photographer who made his images of musical concert performers available for free, subject to Creative Commons attribution licenses. The plaintiff earned almost no money from his photographs, but often was paid in kind, with concert tickets, drinks and food. The defendant's online celebrity news site incorporated two of the plaintiff's photos, which it had downloaded from third party sites, unchanged and without attribution. The defendant sought summary judgment, urging fair use. The court stated that the issue of transformativeness could not be determined on summary judgment, but concluded on the record before it that the fourth factor favoured the defendant because he made his photographs available for free, losing money annually. The plaintiff contested the characterisation of the market for his work, to no avail:

Philpot responds that his photographs are not offered for free; they are offered for the price of attribution, which has economic value as advertising for his work....[T]his factor looks at the market for the original work and derivatives from that work, not at the market for the plaintiff's work in general. Although the Court accepts that attribution might lead someone to purchase one of Philpot's works, he fails to explain how any amount of advertisement might lead to being paid for two works that he makes available for free.¹⁰⁶

The court's perception of the plaintiff as a copyright troll ("the principal way that Philpot appears to make money from his photography is settlement agreements in copyright lawsuits"¹⁰⁷) may have obscured an important issue regarding the kind of harm cognisable under the fourth factor. Suppose an author, subject to attribution, makes some of her work available for free as a "draw" for other works, or indeed for services not necessarily involving the creation of works of authorship. Copying the "free" work may not diminish its market because the author has effectively relinquished any claim to compensation for that work. But in asserting that the fourth "factor looks at the market for the original work and derivatives from *that work*, not at the market for the plaintiff's work in general" [emphasis added], the court may be undermining "loss leader" business models of this kind.

The statute, however, does not require a court to constrain its conception of cognisable harm to the market for the copied work. Factor four requires courts to assess "the effect of the use upon the potential market for *or value of* the copyrighted work".¹⁰⁸ "Value of" ranges more broadly than "market for" (indeed, reading the two synonymously would violate the principle that words in a statute are to be given independent meaning¹⁰⁹). Unattributed copying of a work deprives it of its value as a "draw" for other works (or services).

¹⁰⁶ *Ibid* at *7.

¹⁰⁷ *Ibid*.

¹⁰⁸ 17 USC § 107(4) [emphasis added].

¹⁰⁹ See *eg*, *Quality King Distributors v L'anza Research Int'l, Inc*, 523 US 135 at 145-48 (1998) (Supreme Court considering whether one potential interpretation of the 17 USC, *supra* note 1, would render one of its provisions superfluous). See also Michael J Madison, "A Pattern-Oriented Approach to Fair Use" (2004) 45 *Wm & Mary L Rev* 1525 at 1562: "[w]hat should we make of the disjunctive 'potential market for or value' of the work? 'Market' and 'value' might be the same thing, but the linguistic distinction appears purposive".

D. Reforming Fair Use: The “Value” of the Copyrighted Work

Very little case law or secondary authority specifically confront the contention that the “value of the copyrighted work” should mean something not synonymous with markets for the copyrighted work.¹¹⁰ The most pertinent authority may be *Video Pipeline, Inc v Buena Vista Home Entertainment, Inc*,¹¹¹ which ruled that a defendant who copied and compiled film trailers was not likely to succeed on the merits of its fair use defence when the copyright owner introduced evidence of its movie trailers’ advertising value, including for other works:

Video Pipeline takes too narrow a view of the harm contemplated by this fourth factor. The statute directs us to consider “the effect of the use upon the...value of the copyrighted work,” not only the effect upon the “market,” however narrowly that term is defined. And the value “need not be limited to monetary rewards; compensation may take a variety of forms.” . . . Disney introduced evidence that it has entered an agreement to cross-link its trailers with the Apple Computer home page and that it uses on its own websites “the draw of the availability of authentic trailers to advertise, cross-market and cross-sell other products, and to obtain valuable marketing information from visitors who chose [sic] to register at the site or make a purchase there.” . . . In light of Video Pipeline’s commercial use of the clip previews and Disney’s use of its trailers as described by the record evidence, we easily conclude that there is a sufficient market for, or *other value in*, movie previews such that the use of an infringing work could have a harmful effect cognizable under the fourth factor.¹¹²

Thus, unlike the District Court in *Philpot*, the Third Circuit accepts that the relevant “value” need not lie solely in the sales of the copied work; when the copying undermines the ability of that work to serve as a “draw” for other works or economic benefits, it has deleteriously impacted the “value of the copyrighted work”.

Moreover, the “value” of the work need not be monetary.¹¹³ Indeed, the “linguistic disjunction”¹¹⁴ between “potential market for” and “value of” the copyrighted work permits an inference that the relevant value may encompass other kinds of authorial concerns. For example, in *Chicago School Reform Board of Trustees v Substance, Inc*,¹¹⁵ the Seventh Circuit held the disclosure of secure test questions was not a fair use. The District Court had emphasised the unauthorised publication’s harm to the

¹¹⁰ See Madison, *ibid* at 10. Madison notes the “purposive” “linguistic disjunction” between “market” and “value”, but does not explore what independent meaning “value of the copyrighted work” might have.

¹¹¹ 342 F 3d 191 (3d Cir 2003) [*Video Pipeline*], abrogated on other grounds by *TD Bank NA v Hill*, 928 F 3d 259 (3d Cir 2019).

¹¹² *Video Pipeline, ibid* at 202 [emphasis added], citing *Worldwide Church of God v Philadelphia Church of God, Inc*, 227 F 3d 1110 at 1119 (9th Cir 2000).

¹¹³ See eg, *Soc’y of Holy Transfiguration Monastery, Inc v Gregory*, 689 F 3d 29 at 64 (1st Cir 2012): (“the fourth factor of the fair use inquiry cannot be reduced to strictly monetary terms”).

¹¹⁴ See Madison, *supra* note 109.

¹¹⁵ 79 F Supp 2d 919 (ND Ill 2000), *aff’d* 354 F 3d 624 (7th Cir 2003).

tests' educational value¹¹⁶ and Judge Posner agreed: “[Defendant] is destroying the *value of the tests and the fact that it's not a market value has no significance* once the right to copyright unpublished works is conceded, as it must be”.¹¹⁷

A work's “value” may also be reputational, but the author will not reap economic or moral benefits unless the public identifies the work with its author. Authorship attribution has not typically featured in the fair use inquiry, perhaps because in most cases, the copied work's author either is generally known (as is usually the case in parodies), or has been credited (as in scholarly commentary). But increasingly, digital uses, such as that at issue in *Philpot*, sever the work from its author's name. When the currency in which the author trades is reputational rather than directly monetary, unattributed copying, even—or especially—from copies made available for free, will have a deleterious impact upon the value of the copyrighted work.¹¹⁸

Treating the use's impact on the copied work's value as an inquiry distinct from assessing harm to the copied work's potential market allows the fair use doctrine to consider additional interests relevant to authorship incentives and consumer information. Were factor four confined to the economic prospects for the *copied* work, then copyright doctrine might discourage the development of means of making works available that are not based on selling copies of or access to the copied work. Loss leader business models—similar to those employed by the band The Grateful Dead—allow copying or accessing the copyrighted work without direct charge. But they anticipate that the consumer attracted by the free content will purchase or subscribe to other works or goods or services, or simply will remain on the copyright owner's site long enough to be exposed to advertisements.¹¹⁹ The “value of” the copyrighted work inheres in the viability of these business models, but inquiring only about harm to the potential market for the copied work overlooks the broader economic calculus. Similarly, a reading of factor four that bypasses the “value of” the copied work ignores moral and reputational interests which may not directly implicate the economic returns from the copied work, but which underpin the author's incentives to create.

¹¹⁶ *Ibid* at 933, 934:

Defendants' publication of the tests significantly decreased that value, and the court need not determine at this time the monetary damage Defendants caused. The court finds no difference between a copyright holder losing future profits because of a copyright infringement and the Board losing its future educational value of its copyrighted work.

¹¹⁷ 354 F 3d at 627 [emphasis added].

¹¹⁸ See *eg*, *Weissmann v Freeman*, 868 F 2d 1313 at 1326 (2d Cir 1989) [*Weissmann*]: “[t]he rewards that Congress planned for copyright holders of scientific works to reap *arguably include promotion and advancement in academia*. . . In scholarly circles. . . recognition of one's scientific achievements is a vital part of one's professional life.” [emphasis added]; *Greaver v National Ass'n of Corporate Directors*, No. C.A. 94–2127(WBB), 1997 WL 34605245 (DDC 19 Nov 1997): “[i]n the ‘consulting world,’ as in other fields such as academia where ‘profit is ill-measured in dollars,’ . . . *recognition as an authoritative voice is the measure of the value of one's work*”, quoting *Weissmann* at 1324 [emphasis added].

¹¹⁹ David M Scott & Brian Halligan, *Marketing Lessons from The Grateful Dead: What Every Business Can Learn from the Most Iconic Band in History* (New Jersey: Wiley, 2010) at xx–xxi. See also Jared Lindzon, “The Grateful Dead as Business Pioneers” (23 March 2016) *Fortune*, online: [Fortune <https://fortune.com/2016/03/23/grateful-dead-business-lessons/>](https://fortune.com/2016/03/23/grateful-dead-business-lessons/).

IV. OBJECT LESSONS?

In summary, if “transformativeness” (or its absence) no longer foreordains fair use outcomes, and courts attend more closely to the impact of the use (transformative or not) on the market for or the value of the work, they will need to enrich their appreciation of that factor. Courts should adopt a broad understanding of substitution effects to cover actual and potential derivative markets: the relevant referent may not be markets that the plaintiff is exploiting, but markets that similarly situated copyright owners might exploit. Failure to license secondary uses may not betoken the insignificance of a market the copyright owner foregoes (and therefore, under license-it-or-lose-it, open to third-party exploitation), but rather a strategic or artistic decision not to exploit.

Similarly, the “value” of a work should be understood to encompass not only the monetisation of that work, but also the role the work plays in the broader economic or artistic agenda of its creator. Specifically, failure to attribute authorship presumptively compromises the value of the work, and should weigh heavily against a finding of fair use. It is all the more important in jurisdictions like the US and Singapore, which—despite international obligations¹²⁰—lack general provisions on moral rights, to take authorship attribution into account in evaluating fair use. (I note that the fair dealing provisions in sections 35 and 109 of the Singapore *Copyright Act*¹²¹ do not include an obligation of “sufficient acknowledgement” of source and authorship. But they do instruct courts to address “the effect of the dealing upon the potential market for, *or value of*, the work”. Of course, a true, affirmative, attribution right would be better still, and I understand that may be in prospect in Singapore,¹²² albeit, alas, not currently in the US.)

What other lessons might jurisdictions seeking to adopt or expand a fair use exception draw from the saga of transformative use in the US?¹²³ Judge Pierre Leval, whose 1990 law review article coined the term “transformative use”, has cautioned that:

The word ‘transformative’ cannot be taken too literally as a sufficient key to understanding the elements of fair use. It is rather a suggestive symbol for a complex thought, and does not mean that any and all changes made to an author’s original text will necessarily support a finding of fair use.¹²⁴

But, as the *Google Books* decision in which he offered that disclaimer reveals, making *no* changes to an author’s original text may nonetheless qualify as “transformative” fair use. Such statements and outcomes might well befuddle non-US lawyers (or for that matter, many US lawyers). Moreover, US case law suggests that too often the

¹²⁰ See *Berne Convention for the Protection of Literary and Artistic Works*, 9 September 1886, 828 UNTS 221 art 6bis (minimum protections include authors’ rights of attribution and integrity).

¹²¹ (Cap 63, 2006 Rev Ed Sing) [*SG Copyright Act*].

¹²² See Intellectual Property Office of Singapore, Singapore Copyright Review Report 19-21 (17 January 2019), Proposal 4 (to introduce a right of attribution), online: Ministry of Law <<https://app.mlaw.govsg/news/press-releases/singapore-copyright-review-report-2019>>.

¹²³ For a review of adoption of fair use or fair use-inspired exceptions outside the US, see Peter Yu, “Fair Use and its Global Paradigm Evolution” [2019] U Ill L Rev 111.

¹²⁴ *Google Books*, *supra* note 6 at 214.

label does not symbolise a “complex thought”, but rather implements a simplistic conclusion. Perhaps, as the Seventh Circuit has acerbically recommended, one should stick to the statutory language, particularly the fourth factor, and cease trying to label uses as “transformative” or not.¹²⁵

Other countries’ lawyers and judges, not immersed in the ebb and flow of US fair use decisions, might find that our caselaw resists coherent synthesis. Arguably, it is difficult to ascertain the outliers from the dominant direction. Or, put another way, depending on one’s critique of or aspiration for the copyright system, one observer’s outlier is another’s foundational ruling.

Nonetheless, it may be possible to discern some coherence in the morass of transformative use decisions. I cannot claim credit for these guideposts: authorship attribution goes to a great copyright litigator, Dale Cendali, of Kirkland and Ellis, New York. With respect to allegedly transformative works, she inquires whether the defendant “took too much, and did too little” with the copied material.¹²⁶ Examining the amount of the copying (factor 3) in light of how the allegedly transformative work treats the copied material (factor 1) should help determine the substitution effect (factor 4) of the portion taken. *McCollum* and *Graham* illustrate the application of this principle.¹²⁷ Of course, room for disagreement remains in determining both how much copying is “too much” relative to the new meaning or message the defendant seeks to convey, and how small an increment of the defendant’s additional authorship is “too little”. As a result, these criteria may seem like subjective value judgments, but in fact the inquiry recalls one of the principal elements of the Berne Convention Article 10 quotation right: the “extent” of permitted quotations may “not exceed that justified by the purpose”. Moreover, these criteria are consistent with prior caselaw inquiring whether the defendant went beyond the copying necessary to support the defendant’s arguments or critique, but rather made the defendant’s work more “lively and entertaining”.¹²⁸ Similarly, in the same decision in which the Supreme Court adopted “transformative use”, it also cautioned against copying to “avoid the drudgery in working up something fresh” or “merely... to get attention”.¹²⁹

With respect to transformative purposes (when the defendant has not created a new work that builds on its predecessor), Cendali urges courts to distinguish between “finding” and “delivering”.¹³⁰ Copying to enable searching or identifying works is one thing, but the fairness of the use should turn on what the use delivers. If the output

¹²⁵ *Kienitz*, *supra* note 33 at 758.

¹²⁶ *Warner Bros Ent Inc v RDR Books*, 575 F Supp 2d 513 (SDNY 2008) (No 07-CV-9667), 2008 WL 2062743. See the Plaintiff Warner Bros Entertainment, Inc, and J K Rowling’s Opening Statement at 27. The court there found that the purpose of the *Harry Potter Lexicon*’s excerpts from the Harry Potter books was “not consistently transformative” and that the defendant copied more than it needed to for its transformative purposes.

¹²⁷ *Ibid.*

¹²⁸ *Craft*, *supra* note 36 at 129: “Kobler’s takings are far too numerous and with too little instructional justification to support the conclusion of fair use... Stravinsky’s colourful epigrams animate the narrative. I think Kobler might agree that they are the liveliest and most entertaining part of the biography.”

¹²⁹ *Campbell*, *supra* note 4 at 580.

¹³⁰ See the attached Memorandum of Law in Support of Plaintiff Fox News Network, LLC’s Renewed Motion for Summary Judgment in *TVEyes (DC)*, *supra* note 75, No 1:13-cv-05315-AKH, 2015 WL 4656263, Document No 134 at 1.

provides access to substantial and unaltered portions of copyrighted expression, the delivery is not fair use. If the output discloses no copyrighted expression, or only non-substitutional amounts of it, then the delivery may be deemed a fair use. The find/deliver distinction explains the different outcomes in *iParadigms*, *HathiTrust* and *Google Books* on the one hand, and *VHT v Zillow* and *TVEyes*, on the other.

The distinction also can describe the sole (so far) decision of the Singaporean courts applying Singapore's fair use-like fair dealing provision,¹³¹ *Global Yellow Pages Ltd v Promedia Directories Pte Ltd*.¹³² There, advertizing to several US "transformative use" cases, the Singapore Court of Appeal held that copying from a prior telephone directory was fair dealing when "*in essence*, what was copied by Promedia was the *data* in GYP's directories. There is no evidence, however, that such data as was copied was then reproduced in the same *form* in which it had appeared in GYP's directories".¹³³ Similarly:

[E]ven though the scanning and photocopying took place in a commercial setting, the purpose of the dealing in this case was to access the data that was contained in the listings, and had nothing to do with the use of the particular arrangement of that data, which is what attracted copyright in the first place.¹³⁴

Thus, the defendant's search engine may have "found" all of the plaintiff's listings, but what the defendant "delivered" in its rival directories did not reproduce the copyrightable expression from those listings.

The Singapore Court of Appeal's decision is fully consistent with pre-transformative use US fair use case law upholding the intermediate copying of videogame code in order to produce functionally equivalent or compatible games that did not copy the code's expressive elements.¹³⁵ Ironically, these cases involved neither a transformative purpose (since the objective was to compete with the copied work) nor the creation of a new work that transformed the copied work's expression (since the new output copied no expression). My NYU colleague, Diane Zimmerman, casting a jaundiced eye on "transformative use", once quipped, "the more things change, the less they seem transformed".¹³⁶ I hope this lecture has shown that while fair use may require *reform*—including from the predations of "transformative use"—it need not be "transformed".

¹³¹ *SG Copyright Act*, *supra* note 121, s 35.

¹³² [2017] 2 SLR 185 (CA).

¹³³ *Ibid* at para 9 [emphasis in original].

¹³⁴ *Ibid* at para 88.

¹³⁵ See *eg*, *Sega Enters Ltd v Accolade, Inc*, 977 F 2d 1510 at 1520–27 (9th Cir 1992).

¹³⁶ Diane Leenheer Zimmerman, "The More Things Change, The Less They Seem Transformed: Some Reflections on Fair Use" (1998) 46 J Copyright Soc USA 251.