

# MLRC Media Law Conference

Sept. 28-Oct. 1, 2021

## Copyright Fair Use After (And Before) *Warhol v. Goldsmith* and *Google v. Oracle*. Plus Is There A Need To Get Out Of Embedding? And Bonus: What Else Is Going On?

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## I. Recent Fair Use Copyright Cases




- *Walsh v. Townsquare Media, Inc.*, No. 19-cv-4958 (S.D.N.Y. Jun. 1, 2020), [https://www.docketalarm.com/cases/New\\_York\\_Southern\\_District\\_Court/1--19-cv-04958/Walsh\\_v.\\_Townsquare\\_Media\\_Inc/22/](https://www.docketalarm.com/cases/New_York_Southern_District_Court/1--19-cv-04958/Walsh_v._Townsquare_Media_Inc/22/) (holding on motion for judgment on the pleadings that XXL Mag's use of the plaintiff's photograph of Cardi B at a Tom Ford fashion show was a fair use)
- *Harbus v. Manhattan Institute for Policy Research*, No. 1:19-cv-06124 (S.D.N.Y. Apr. 27, 2020), <http://business.cch.com/ipld/HarbusManhattanInstituteforPolicyResearch20204027.pdf> (granting motion to dismiss claim based on appearance of a darkened sliver of plaintiff's photograph in an online New York Post article, finding the use to be fair)
- Docket & Pleadings, *Google LLC v. Oracle America, Inc.*, No. 18-956 (cert. granted Nov. 15 2019), <https://www.supremecourt.gov/search.aspx?filename=/docket/docketfiles/html/public/18-956.html>
  - Question Presented: "2. Whether, as the jury found, petitioner's use of a software interface in the context of creating a new computer program constitutes fair use."
  - See also Order dated May 4, 2020: "The parties are directed to file supplemental letter briefs addressing the appropriate standard of review for the second question presented, including but not limited to the implications of the Seventh Amendment, if any, on that standard."
  - Decision Below: *Oracle America, Inc. v. Google LLC*, 886 F.3d 1179 (Fed. Cir. 2018), [https://scholar.google.com/scholar\\_case?case=10745164935676158704](https://scholar.google.com/scholar_case?case=10745164935676158704)
- *Bassett v. Jensen*, No. 1:18-cv-10576 (D. Mass. May 11, 2020), <https://www.courtlistener.com/recap/gov.uscourts.mad.197136/gov.uscourts.mad.197136.115.0.pdf> (denying summary judgment to defendant on fair use in claim based on appearance of plaintiff's artwork in defendants' pornographic videos)
  - *Bassett v. Jensen*, No. 1:18-cv-10576 (D. Mass. Aug. 6, 2020), <https://www.courtlistener.com/recap/gov.uscourts.mad.197136/gov.uscourts.mad.197136.141.0.pdf> (amending May 11 order to grant summary judgment to plaintiff based on additional evidence submitted to rebut claim of *de minimis* use)
- *Bell v. Wilmott Storage Servs., LLC*, No. 19-55882, 2021 WL 4097499, at \*10 (9th Cir. Sept. 9, 2021)("the *de minimis* analysis is best thought of in terms of the substantiality of the copying, to delineate the boundary between actionable and non-actionable copying. Our long line of precedent and that of the majority of our sister circuits supports the application of the *de minimis* principle in copyright only to questions of substantial

similarity (and potentially fair use), *i.e.*, whether there was *de minimis* copying of the protected work so as to be non-recognizable as a copy. Wholesale copying or reproduction of another's protected work, like the Indianapolis photo, by definition cannot be *de minimis* copying.").

- *Solid Oak Sketches, LLC v. 2K Games, Inc.*, No. 1:16-cv-00724 (S.D.N.Y. Mar. 26, 2020), <https://www.documentcloud.org/documents/6819709-SolidOak.html> (summary judgment granted to defendants on basis of *de minimis* use and fair use in copyright claim asserted by alleged exclusive licensee of copyrights in five tattoos against developers of videogame series in which pro athletes bearing those tattoos were depicted)
- *Cambridge University Press v. Becker*, No. 1:08-cv-1425 (N.D. Ga. Mar. 2, 2020), <https://www.courtlistener.com/recap/gov.uscourts.gand.150651/gov.uscourts.gand.150651.563.0.pdf> (third district court ruling that that fair use protects Georgia State University students' downloading of excerpts of academic works, after Eleventh Circuit twice remanded case for revised fair use analysis)
  - *Cambridge University Press v. Albert*, 906 F.3d 1290 (11th Cir. 2018), [https://scholar.google.com/scholar\\_case?case=11777147774100574804](https://scholar.google.com/scholar_case?case=11777147774100574804)
  - *Cambridge University Press v. Patton*, 769 F.3d 1232 (11th Cir. 2014), [https://scholar.google.com/scholar\\_case?case=12627493296032837499](https://scholar.google.com/scholar_case?case=12627493296032837499)
- *Comerica Bank & Trust, N.A. v. Habib*, No. 17-12418 (D. Mass. Jan. 6, 2020), <https://www.courtlistener.com/recap/gov.uscourts.mad.194174/gov.uscourts.mad.194174.111.0.pdf> (rejecting fair use defense in granting summary judgment to Prince's estate on a claim that defendant's publication on YouTube of low-quality video of The Purple One in concert violated estate's copyrights)
- *Yang v. Mic Networks, Inc.*, No. 18-cv-7628 (S.D.N.Y. Sep. 24, 2019), <https://cases.justia.com/federal/district-courts/new-york/nysdce/1:2018cv07628/499671/26/0.pdf?ts=1569424815> (Mic's use of screenshot of newspaper page showing half of copyrighted photo held to be fair use)
- *Dlugolecki v. Poppel*, No. 2:18-cv-03905 (C.D. Cal. Aug. 22, 2019), <http://www.medialaw.org/images/medialawdaily/08.26.19dlugolecki.pdf> (denying summary judgment on fair use defense to TV network that allegedly used yearbook photos of Meghan Markle without permission)
- *Coleman v. Home Box Office, Inc.*, No. 1:18-cv-03510 (E.D.N.Y. Aug. 6, 2019), <https://www.courtlistener.com/recap/gov.uscourts.nyed.418546/gov.uscourts.nyed.418546.22.0.pdf> (denying motion to dismiss on basis of fair use based on use of plaintiff's painting in documentary about "Slenderman murders")
- *Dr. Seuss Enterprises, L.P. v. ComicMix LLC*, 983 F.3d 443 (9th Cir. 2020), <https://cdn.ca9.uscourts.gov/datastore/opinions/2020/12/18/19-55348.pdf> (mash-up book was not a parody, was not transformative, and was infringing)

- *Andy Warhol Found. for Visual Arts, Inc. v. Goldsmith*, No. 19-2420-CV, 2021 WL 3742835 (2d Cir. Aug. 24, 2021), <https://law.justia.com/cases/federal/appellate-courts/ca2/19-2420/19-2420-2021-03-26.html> (Warhol's "Prince series" were not transformative, as would support fair use defense to claim for copyright infringement);

## II. Google v. Oracle and Andy Warhol Foundation v. Goldsmith – Side-by-Side Excerpts

Google LLC v. Oracle Am., Inc., 141 S. Ct. 1183 (2021)		Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, __ F.4th __, 2021 U.S. App. LEXIS 25277, 2021 WL 3742835 (2d Cir. 2021) as amended August 24, 2021	
Programmer Inputs	Sun Java API	Original	Licensed Use
<p><b>Method Call</b></p> <pre>java.lang.Math.max(4, 10)</pre> <p><i>Copied but not alleged infringement</i></p> <p><i>Copied – Alleged Infringement</i></p>	<p><b>Declaring Code</b></p> <pre>Package java.lang public class Math public static int max(int x, int y)</pre> <p><b>Implementing Code</b> <span style="border: 1px solid blue; padding: 2px;">Not Copied</span></p> <pre>{ if (x &gt; y), return x else return y }</pre>		
		<p><b>Unlicensed Use</b></p> 	

"[T]he fair use of a copyrighted work, . . . for purposes such as criticism, comment, news reporting, teaching . . . scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

"(1)the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;

"(2)the nature of the copyrighted work;

"(3)the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and

"(4)the effect of the use upon the potential market for or value of the copyrighted work."

17 USC § 107

**Google LLC v. Oracle Am., Inc., 141 S. Ct. 1183 (2021)**

**Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith, \_\_\_ F.4th \_\_\_, 2021 U.S. App. LEXIS 25277, 2021 WL 3742835 (2d Cir. 2021) as amended August 24, 2021**

### **A. "The Nature of the Copyrighted Work"**

### **B. The Nature of the Copyrighted Work**

Second Circuit: [This] factor directs courts to consider the nature of the copyrighted work, including (1) whether it is "expressive or creative . . . or more factual, with a greater leeway being allowed to a claim of fair use where the work is factual or informational, and (2) whether the work is published or unpublished, with the scope of fair use involving unpublished works being considerably narrower."

The declaring code at issue here resembles other copyrighted works in that it is part of a computer program. ... It differs, however, from many other kinds of copyrightable computer code. It is inextricably bound together with [THINGS THAT ARE NOT COPYRIGHTABLE OR WERE NOT COPIED, INCLUDING THE SYSTEM OF DIVIDING COMPUTER TASKS, THE COMMANDS PROGRAMMERS USE KNOWN HERE AS METHOD CALLS (SUCH AS JAVA.LANG.MATH.MAX, ETC.), AND IMPLEMENTING CODE.]

Moreover, the copied declaring code and the uncopied implementing programs call for, and reflect, different kinds of capabilities.

[IMPLEMENTING CODE IS REALLY CREATIVE] ...

The declaring code (inseparable from the programmer's method calls) embodies a different kind of creativity. Sun Java's creators, for example, tried to find declaring code names that would prove intuitively easy to remember [INCLUDING SO USERS WOULD BE RELUCTANT TO SWITCH AWAY]. ... The testimony at trial was replete with examples of witnesses drawing this

... That Goldsmith, through LGL, made the Goldsmith Photograph available for a single use on limited terms does not change its status as an unpublished work nor diminish the law's protection of her choice of "when to make a work public and whether to withhold a work to shore up demand." ... Further, though we have previously held that this factor "may be of limited usefulness where the creative work is being used for a transformative purpose," *Bill Graham Archives*, 448 F.3d at 612, this relates only to the weight assigned to it, not whom it favors. ...

**Having recognized the Goldsmith Photograph as both creative and unpublished, the district court should have found this factor to favor Goldsmith** irrespective of whether it adjudged the Prince Series works transformative within the meaning of the first factor. And, because we disagree that the Prince Series works are transformative, we would accord this factor correspondingly greater weight.

critical line between the user-centered declaratory code and the innovative implementing code.

**These features mean that, as part of a user interface, the declaring code differs to some degree from the mine run of computer programs.** Like other computer programs, it is functional in nature. But **unlike many other programs, its use is inherently bound together with uncopyrightable ideas (general task division and organization) and new creative expression (Android’s implementing code).** Unlike many other programs, its value in significant part derives from the value that those who do not hold copyrights, namely, computer programmers, invest of their own time and effort to learn the API’s system. And unlike many other programs, its value lies in its efforts to encourage programmers to learn and to use that system so that they will use (and continue to use) Sun-related implementing programs that Google did not copy.

In our view, for the reasons just described, the declaring code is, if copyrightable at all, further than are most computer programs (such as the implementing code) from the core of copyright.

## **B. “The Purpose and Character of the Use”**

### **[transformative nature]**

In the context of fair use, we have considered whether the copier’s use “adds something new, with a further purpose or different character, altering” the copyrighted work “with new expression, meaning or message.” *Id.*, at 579, 114 S. Ct. 1164, 127 L. Ed. 2d 500. Commentators have put the matter more broadly, asking whether the copier’s use “fulfill[s] the objective of copyright law to stimulate creativity for public illumination.” Leval 1111. In answering this question, we have used the word “transformative” to describe a copying use that adds something new and important. *Campbell*, 510 U. S., at 579, 114 S. Ct. 1164, 127 L. Ed. 2d 500. **An “artistic painting” might, for example, fall within the scope of fair use even though it precisely replicates a copyrighted “advertising logo to make a comment about consumerism.”** 4 Nimmer on Copyright

## **A. The Purpose and Character of The Use**

### **1. Transformative Works and Derivative Works**

Following the Supreme Court's decision in *Campbell*, our assessment of this first factor has focused chiefly on the degree to which the use is “transformative,” *i.e.*, “whether the new work merely supersedes the objects of the original creation, or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message.” 510 U.S. at 579 (internal quotations marks and citations omitted) (alterations adopted); *see also Google*, 141 S. Ct. at 1203 (“[W]e have used the word ‘transformative’ to describe a copying use that adds something new and important.”). **We evaluate whether a work is transformative by examining how it may “reasonably be perceived.”** *Cariou*, 714 F.3d at 707, quoting *Campbell*, 510 U.S. at 582;

§13.05[A][1][b] (quoting Netanel, *Making Sense of Fair Use*, 15 Lewis & Clark L. Rev. 715, 746 (2011)). Or, as we held in *Campbell*, a parody can be transformative because it comments on the original or criticizes it, for “[p]arody needs to mimic an original to make its point.” 510 U. S., at 580-581, 114 S. Ct. 1164, 127 L. Ed. 2d 500.

Google copied portions of the Sun Java API precisely, and it did so in part for the same reason that Sun created those portions, namely, to enable programmers to call up implementing programs that would accomplish particular tasks. But since virtually any unauthorized use of a copyrighted computer program (say, for teaching or research) would do the same, to stop here would severely limit the scope of fair use in the functional context of computer programs. **Rather, in determining whether a use is “transformative,” we must go further and examine the copying’s more specifically described “purpose[s]” and “character.”** 17 U. S. C. §107(1).

Here Google’s use of the Sun Java API seeks to create new products. ... Its new product offers programmers a highly creative and innovative tool for a smartphone environment. To the extent that Google used parts of the Sun Java API to create a new platform that could be readily used by programmers, its use was consistent with that creative “progress” that is the basic constitutional objective of copyright itself.

[Google] copied the API (which Sun created for use in desktop and laptop computers) only insofar as needed to [FOR THE PHONE ENVIRONMENT AND] to allow programmers to call upon those tasks without discarding a portion of a familiar programming language and learning a new one. **To repeat, Google, through Android, provided a new collection of tasks operating in a distinct and different computing environment. Those tasks were carried out through the use of new implementing code (that Google wrote) designed to operate within that new environment.** Some of the *amici* refer to what Google did as “reimplementation,” defined as the “building of a system . . . that repurposes the same words and syntaxes” of an existing system—in this case so that programmers who had learned

*see also, e.g., Leibovitz v. Paramount Pictures Corp.*, 137 F.3d 109, 113-15 (2d Cir. 1998).

Although the most straightforward cases of fair use thus involve a secondary work that comments on the original in some fashion, **in *Cariou v. Prince*, we rejected the proposition that a secondary work *must* comment on the original in order to qualify as fair use.** See 714 F.3d at 706. ... we observed that **Prince had incorporated Cariou's "serene and deliberately composed portraits and landscape photographs" into his own "crude and jarring works . . . [that] incorporate[d] color, feature[d] distorted human and other forms and settings, and measure[d] between ten and nearly a hundred times the size of the photographs."** *Id.* Thus, we concluded that these works “used [Cariou's photographs] as raw material, transformed in the creation of new information, new aesthetics, new insights and understandings,” and were transformative within the meaning of this first factor. *Id.*, quoting *Castle Rock Entertainment v. Carol Publ'g Group*, 150 F.3d 132, 142 (2d Cir. 1998).

... *Cariou* ... [WAS] the “high-water mark of our court's recognition of transformative works.” ... While we remain bound by *Cariou*, and have no occasion or desire to question its correctness on its own facts, our review of the decision below persuades us that some clarification is in order.

... the district court appears to have read *Cariou* as having announced such a rule, to wit, that any secondary work is *necessarily* transformative as a matter of law “[i]f looking at the works side-by-side, the secondary work has a different character, a new expression, and employs new aesthetics with [distinct] creative and communicative results.” *Warhol*, 382 F. Supp. 3d at 325-26 (internal quotation marks omitted) (alterations adopted). Although a literal construction of certain passages of *Cariou* may support that proposition, such a reading stretches the decision too far.

Of course, the alteration of an original work “with ‘new expression, meaning, or message,’” *Cariou*, 714 F.3d at 706, quoting *Campbell*, 510 U.S.



an existing system could put their basic skills to use in a new one. Brief for R Street Institute et al. as *Amici Curiae* 2.

The record here demonstrates the numerous ways in which reimplementing an interface can further the development of computer programs. The jury heard that shared interfaces are necessary for different programs to speak to each other. It heard that the reimplementation of interfaces is necessary if programmers are to be able to use their acquired skills. It heard that the reuse of APIs is common in the industry. It heard that Sun itself had used pre-existing interfaces in creating Java. And it heard that Sun executives thought that widespread use of the Java programming language, including use on a smartphone platform, would benefit the company.

These and related facts convince us that the “purpose and character” of Google’s copying was transformative—to the point where this factor too weighs in favor of fair use.

at 579, whether by the use of "new aesthetics," *id.*, quoting *Blanch*, 467 F.3d at 253, by placing the work "in a different context," *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1165 (9th Cir. 2007) (internal quotation marks omitted), or by any other means is the *sine qua non* of transformativeness. **It does not follow, however, that any secondary work that adds a new aesthetic or new expression to its source material is necessarily transformative.**

Consider .... In *Graduation* [SEE BELOW], Prince added blue "lozenges" over the eyes and mouth of Cariou's subject and pasted an image of hands playing a blue guitar over his hands. *Id.* Both of these works certainly imbued the originals from which they derive with a "new aesthetic;" notwithstanding, we could not "confidently . . . make a determination about their transformative nature as a matter of law." *Id.*

Moreover, there exists an entire class of secondary works that add "new expression, meaning, or message" to their source material, *Campbell*, 510 U.S. at 579, but may nonetheless fail to qualify as fair use: derivative works. ... Thus, as we have previously observed, an overly liberal standard of transformativeness, such as that employed by the district court in this case, risks crowding out statutory protections for derivative works. ... Consider, for example, a film adaptation of a novel. ...

In evaluating the extent to which a work is transformative in the fair use context, we consider the "purpose and character" of the primary and secondary works. *Google*, 141 S. Ct. at 1204. In *Bill Graham Archives v. Dorling Kindersley Ltd.*, for example, we held that the reproduction in a book about the Grateful Dead of images of posters originally created to advertise Grateful Dead concerts was transformative because that use was "plainly different from the original purpose for which they were created." 448 F.3d 605, 609-10 (2d Cir. 2006).



(Bill Graham)

Archives; images not included in *Warhol* opinion)

Likewise, in *HathiTrust* we held that the defendants' creation of a searchable "digital corpus" comprising scanned copies of tens of millions of books that enabled researchers, scholars, and others to pinpoint the exact page of any book in the catalogue on which the searched term was used was a "quintessentially transformative use." [Same in *Authors Guild*] ... And most recently, in *Google*, the Supreme Court held that fair use protected Google's "precise[]" copying of certain computer programming language in part because Google sought "to create new products . . . [and] expand the use and usefulness of . . . smartphones" with it.

**But purpose is perhaps a less useful metric where, as here, our task is to assess the transformative nature of works of visual art that, at least at a high level of generality, share the same overarching purpose (i.e., to serve as works of visual art). [WHETHER ARTIST SAYS THEY INTEND TO COMMENT ON MODERN SOCIETY IS NOT DETERMINATIVE]**

**Matters become simpler, however, when we compare the works at issue in each case against their respective source materials.** The sculpture at issue in *Rogers* was a three-dimensional colorized version of the photograph on which it was based. See 960 F.2d at 305. In *Blanch*, however, Koons used Blanch's photograph, depicting a woman's legs in high-heeled shoes, as part of a larger work in which he set it alongside several other similar photographs with "changes of its colors, the background against which it is portrayed, the medium, the size of the objects pictured, [and] the objects' details." 467 F.3d at 253. In so doing, Koons used Blanch's photograph "as raw material for an entirely different type of art . . . that comment[ed] on existing images by juxtaposing them against others." *Id.* at 262 (Katzmann, J., concurring). And in *Cariou*, the copyrighted works found to have been fairly used were, in most cases, juxtaposed with other photographs and "obscured and altered to the point that Cariou's original [was] barely recognizable." 714 F.3d at 710.



(*Cariou*, Richard Prince: "James Brown Disco Ball"; image

not included in *Warhol* opinion)

The works that were found potentially infringing in *Cariou*, however, were ones in which the original was altered in ways that did not incorporate other images and that superimposed other elements that did not obscure the original image and in which the original image remained, as in the Koons sculpture at issue in *Rogers*, a major if not dominant component of the impression created by the allegedly infringing work. See *id.* at 710-11.



(*Cariou*, Richard Prince: "Graduation");

image not included in *Warhol* opinion)

**A common thread running through these cases is that, where a secondary work does not obviously comment on or relate back to the original or use the original for a purpose other than that for which it was created, the bare assertion of a "higher or different artistic use," *Rogers*, 960 F.2d at 310, is insufficient to render a work transformative.** Rather, the secondary work itself must reasonably be perceived as embodying a distinct artistic purpose, one that conveys a new meaning or message separate from its source material. While we cannot, nor do we attempt to, catalog all of the ways in which an artist may achieve that end, we note that the works that have done so thus far have themselves been distinct works of art that draw from numerous sources, rather than works that simply alter or recast a single work with a new aesthetic.

Which brings us back to the Prince Series. The district court held that the Prince Series works are transformative because they "can reasonably be perceived to have transformed Prince from a vulnerable, uncomfortable person to an iconic, larger-than-life figure." *Warhol*, 382 F. Supp. 3d at 326. That was error.

[W]hether a work is transformative cannot turn merely on the stated or perceived intent of the artist or the meaning or

impression that a critic — or for that matter, a judge — draws from the work. ... In conducting this inquiry, however, the district judge should not assume the role of art critic and seek to ascertain the intent behind or meaning of the works at issue. ...

**Instead, the judge must examine whether the secondary work's use of its source material is in service of a "fundamentally different and new" artistic purpose and character, such that the secondary work stands apart from the "raw material" used to create it. *Cariou*, 714 F.3d at 706** (internal quotation marks omitted). Although we do not hold that the primary work must be "barely recognizable" within the secondary work, as was the case with the works held transformative in *Cariou*, *id.* at 710, **the secondary work's transformative purpose and character must, at a bare minimum, comprise something more than the imposition of another artist's style on the primary work such that the secondary work remains both recognizably deriving from, and retaining the essential elements of, its source material.**

With this clarification, viewing the works side-by-side, we conclude that the Prince Series is not "transformative" within the meaning of the first factor. ...

As in the case of such paradigmatically derivative works, there can be no meaningful dispute that the overarching purpose and function of the two works at issue here is identical, not merely in the broad sense that they are created as works of visual art, but also in the narrow but essential sense that they are portraits of the same person. See *Gaylord v. United States*, 595 F.3d 1364, 1372-73 (Fed. Cir. 2010) (photograph of Korean War Memorial used on stamp not transformative despite "different expressive character" brought about by subdued lighting and snow since sculpture and stamp shared purpose of "honor[ing] veterans of the Korean War"). Although this observation does not *per se* preclude a conclusion that the Prince Series makes fair use of the Goldsmith Photograph, the district court's conclusion rests significantly on the transformative character of Warhol's work. But the Prince Series works can't bear that weight.

Warhol created the series chiefly by removing certain elements from the Goldsmith Photograph, such as depth and contrast, and embellishing the flattened images with "loud, unnatural colors." ... Crucially, the Prince Series retains the essential elements of the Goldsmith Photograph without significantly adding to or altering those elements.

Indeed, the differences between the Goldsmith Photograph and the Prince Series here are in many respects less substantial than those made to the five works that we could not find transformative as a matter of law in *Cariou*. ...Richard Prince added material that pulled them in new directions. See, e.g., *Cariou*, 714 F.3d at 711 ("Where [Cariou's] photograph presents someone comfortably at home in nature, [Prince's] *Graduation* combines divergent elements to present a sense of discomfort.").

In contrast, the Prince Series retains the essential elements of its source material, and Warhol's modifications serve chiefly to magnify some elements of that material and minimize others. While the cumulative effect of those alterations may change the Goldsmith Photograph in ways that give a different impression of its subject, the Goldsmith Photograph remains the recognizable foundation upon which the Prince Series is built.

Finally, we feel compelled to clarify that it is entirely irrelevant to this analysis that "each Prince Series work is immediately recognizable as a 'Warhol.'" *Warhol*, 382 F. Supp. 3d at 326. Entertaining that logic would inevitably create a celebrity-plagiarist privilege; ...

### [commercial use and "bad faith"]

There is no doubt that a finding that copying was not commercial in nature tips the scales in favor of fair use. But the inverse is not necessarily true, as many common fair uses are indisputably commercial. For instance, the text of §107 includes examples like "news reporting," which is often done for commercial profit. So even though Google's use was a commercial endeavor—a fact no party disputed, see 886 F. 3d, at 1197—that is not dispositive of the first factor, particularly in light of the inherently transformative role that the reimplementaion played in the new Android system.

As for bad faith, our decision in *Campbell* expressed some skepticism about whether bad faith has any role in a fair use analysis. 510 U. S., at 585, n. 18, 114 S. Ct. 1164, 127 L. Ed. 2d 500. We find this skepticism justifiable, as "[c]opyright is not a privilege reserved for the well-behaved." Leval 1126. We have no occasion here to say whether good faith is as a general matter a helpful inquiry. We simply note that given the strength of the other factors pointing toward fair use and the jury finding in Google's favor on hotly contested evidence, that factbound consideration is not determinative in this context.

### 2. Commercial Use

...And, since "[t]he crux of the profit/nonprofit distinction is . . . whether the user stands to profit from exploitation of the copyrighted material without paying the customary price," *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 562, 105 S. Ct. 2218, 85 L. Ed. 2d 588 (1985), the commercial nature of a secondary use is of decreased importance when the use is sufficiently transformative such that the primary author should not reasonably expect to be compensated. *See, e.g., Blanch*, 467 F.3d at 254.

We agree with the district court that the Prince Series works are commercial in nature, but that they produce an artistic value that serves the greater public interest. ... Nevertheless, just as we cannot hold that the Prince Series is transformative as a matter of law, neither can we conclude that Warhol and AWF are entitled to monetize it without paying Goldsmith the "customary price" for the rights to her work, even if that monetization is used for the benefit of the public.

[T]he extent to which it serves the public interest, ... may be highly relevant when assessing equitable remedies, including whether to enjoin the distribution or order the destruction of infringing works. But ...the fact that a commercial non-transformative work may also serve the public interest or that the profits from its commercial use are turned to the promotion of non-commercial ends does not factor significantly in favor of finding fair use under the circumstances present here.

### C. “The Amount and Substantiality of the Portion Used”

If one considers the declaring code in isolation, the quantitative amount of what Google copied was large. Google copied the declaring code for 37 packages of the Sun Java API, totaling approximately 11,500 lines of code. Those lines of code amount to virtually all the declaring code needed to call up hundreds of different tasks. On the other hand, if one considers the entire set of software material in the Sun Java API, the quantitative amount copied was small. The total set of Sun Java API computer code, including implementing code, amounted to 2.86 million lines, of which the copied 11,500 lines were only 0.4 percent. App. 212.

**The question here is whether those 11,500 lines of code should be viewed in isolation or as one part of the considerably greater whole.** We have said that even a small amount of copying may fall outside of the scope of fair use where the excerpt copied consists of the “heart” of the original work’s creative expression. Harper & Row, 471 U. S., at 564-565, 105 S. Ct. 2218, 85 L. Ed. 2d 588. On the other hand, copying a larger amount of material can fall within the scope of fair use where the material copied captures little of the material’s creative expression or is central to a copier’s valid purpose. See, e.g., Campbell, 510 U. S., at 588, 114 S. Ct. 1164, 127 L. Ed. 2d 500; New Era Publications Int’l, ApS v. Carol Publishing Group, 904 F. 2d 152, 158 (CA2 1990). ...

Several features of Google’s copying suggest that the better way to look at the numbers is to take into account the several million lines that Google did not copy. For one thing, the Sun Java API is inseparably bound to those task-implementing lines. Its purpose is to call them up. For another, Google copied those lines not because of their creativity, their beauty, or even (in a sense) because of their purpose. **It copied them because programmers had already learned to work with the Sun Java API’s system, and it would have been difficult, perhaps prohibitively so, to attract programmers to build its Android smartphone system without**

### C. The Amount and Substantiality of the Use

... The ultimate question under this factor is whether "the quantity and value of the materials used are reasonable in relation to the purpose of the copying." Campbell, 510 U.S. at 586 (citation and internal quotation marks omitted). ... we have rejected the proposition that this factor necessarily favors the copyright holder even where the secondary user has copied the primary work *in toto* in service of a legitimate secondary purpose. ...

In this case, AWF argues, and the district court concluded, that this factor weighs in its favor because, by cropping and flattening the Goldsmith Photograph, thereby removing or minimizing its use of light, contrast, shading, and other expressive qualities, Warhol removed nearly all of its copyrightable elements. We do not agree.

... As applied to photographs, [COPYRIGHT] protection encompasses the photographer's "posing the subjects, lighting, angle, selection of film and camera, evoking the desired expression, and almost any other variant involved." Id. at 307. ...

... while Goldsmith has no monopoly on Prince's face, the law grants her a broad monopoly on its image as it appears in her photographs of him, including the Goldsmith Photograph. ... And where, as here, the secondary user has used the photograph itself, rather than, for example, a similar photograph, the photograph's specific depiction of its subject cannot be neatly reduced to discrete qualities such as contrast, shading, and depth of field that can be stripped away, taking the image's entitlement to copyright protection along with it.

With that in mind, we readily conclude that the Prince Series borrows significantly from the Goldsmith Photograph, both quantitatively and qualitatively. While Warhol did indeed crop and flatten the Goldsmith Photograph, the end product is not merely a screenprint identifiably based

**them.** Further, Google’s basic purpose was to create a different task-related system for a different computing environment (smartphones) and to create a platform—the Android platform—that would help achieve and popularize that objective. The “substantiality” factor will generally weigh in favor of fair use where, as here, the amount of copying was tethered to a valid, and transformative, purpose. *Supra*, at 25-26; see *Campbell*, 510 U. S., at 586-587, 114 S. Ct. 1164, 127 L. Ed. 2d 500 (explaining that the factor three “enquiry will harken back to the first of the statutory factors, for . . . the extent of permissible copying varies with the purpose and character of the use”).

We do not agree with the Federal Circuit’s conclusion that Google could have achieved its Java-compatibility objective by copying only the 170 lines of code that are “necessary to write in the Java language.” 886 F. 3d, at 1206. In our view, that conclusion views Google’s legitimate objectives too narrowly. **Google’s basic objective was not simply to make the Java programming language usable on its Android systems. It was to permit programmers to make use of their knowledge and experience using the Sun Java API when they wrote new programs for smartphones with the Android platform.** In principle, Google might have created its own, different system of declaring code. But the jury could have found that its doing so would not have achieved that basic objective. In a sense, the declaring code was the key that it needed to unlock the programmers’ creative energies. And it needed those energies to create and to improve its own innovative Android systems.

We consequently believe that this “substantiality” factor weighs in favor of fair use.

on a photograph of Prince. Rather **it is a screenprint readily identifiable as deriving from a *specific* photograph of Prince, the Goldsmith Photograph.** ... the Warhol images are instantly recognizable as depictions or images of the Goldsmith Photograph itself.

To confirm this, one need look no further than the other photographs of Prince that AWF submitted in support of its motion below to evidence its contention that Prince's pose was not unique to the Goldsmith Photograph. ... we have little doubt that the Prince Series would be quite different had Warhol used one of them instead of the Goldsmith Photograph to create it. ... [And] many of the aspects of Prince's appearance in the Prince Series works, such as the way in which his hair appears shorter on the left side of his face, are present in the Goldsmith Photograph yet absent even from some other photographs that Goldsmith took of Prince during the same photo session. In other words, whatever the effect of Warhol's alterations, the "essence of [Goldsmith's] photograph was copied" and persists in the Prince Series. ...

**Nor can Warhol's appropriation of the Goldsmith Photograph be deemed reasonable in relation to his purpose.** While Warhol presumably required a photograph of Prince to create the Prince Series, AWF proffers no reason why he required *Goldsmith's* photograph. ...

To be clear, we do not hold that this factor will always favor the copyright holder where the work at issue is a photograph and the photograph remains identifiable in the secondary work. But this case is not *Kienitz v. Sconnie Nation LLC*, in which a panel of the Seventh Circuit held that a t-shirt design that incorporated a photograph in a manner that stripped away nearly every expressive element such that, "as with the Cheshire Cat, only the [subject's] smile remain[ed]" was fair use. 766 F.3d 756, 759 (7th Cir. 2014). ...

The district court, reasoning that Warhol had taken only the unprotected elements of the Goldsmith Photograph in service of a transformative



	purpose, held that this factor strongly favored AWF. Because we disagree on both counts, we conclude that this factor strongly favors Goldsmith.
<p><b>D. Market Effects</b></p>	<p><b>D. The Effect of the Use on the Market for the Original</b></p>
<p>...As we pointed out in <i>Campbell</i>, “verbatim copying of the original in its entirety for commercial purposes” may well produce a market substitute for an author’s work. <u>510 U. S., at 591, 114 S. Ct. 1164, 127 L. Ed. 2d 500.</u> Making a film of an author’s book may similarly mean potential or presumed losses to the copyright owner. Those losses normally conflict with copyright’s basic objective: providing authors with exclusive rights that will spur creative expression.</p> <p>But a potential loss of revenue is not the whole story. We here must consider not just the amount but also the source of the loss. As we pointed out in <i>Campbell</i>, a “lethal parody, like a scathing theatre review,” may “kill[] demand for the original.” <u><i>Id.</i>, at 591-592, 114 S. Ct. 1164, 127 L. Ed. 2d 500.</u> Yet this kind of harm, even if directly translated into foregone dollars, is not “cognizable under the Copyright Act.” <u><i>Id.</i>, at 592, 114 S. Ct. 1164, 127 L. Ed. 2d 500.</u></p> <p>Further, we must take into account the public benefits the copying will likely produce. ...</p> <p>As to the likely amount of loss, the jury could have found that Android did not harm the actual or potential markets for Java SE. And it could have found that Sun itself (now Oracle) would not have been able to enter those markets successfully whether Google did, or did not, copy a part of its API. First, evidence at trial demonstrated that, regardless of Android’s smartphone technology, Sun was poorly positioned to succeed in the mobile phone market. ...</p> <p>Second, the jury was repeatedly told that devices using Google’s Android platform were different in kind from those that licensed Sun’s technology.</p>	<p>The fourth factor asks “whether, if the challenged use becomes widespread, it will adversely affect the potential market for the copyrighted work.” <u><i>Bill Graham Archives</i>, 448 F.3d at 613.</u> “Analysis of this factor requires us to balance the benefit the public will derive if the use is permitted and the personal gain the copyright owner will receive if the use is denied.” <u><i>Wright v. Warner Books, Inc.</i>, 953 F.2d 731, 739 (2d Cir. 1991)</u> (internal quotation marks omitted). In assessing market harm, we ask not whether the second work would <i>damage</i> the market for the first (by, for example, devaluing it through parody or criticism), but whether it <i>usurps</i> the market for the first by offering a competing substitute. <i>See, e.g., Bill Graham Archives</i>, 448 F.3d at 614. This analysis embraces both the primary market for the work and any derivative markets that exist or that its author might reasonably license others to develop, regardless of whether the particular author claiming infringement has elected to develop such markets. ...</p> <p>We agree with the district court that the primary market for the Warhol Prince Series (that is, the market for the original works) and the Goldsmith Photograph do not meaningfully overlap, and Goldsmith does not seriously challenge that determination on appeal. We cannot, however, endorse the district court’s implicit rationale that the market for Warhol’s works is the market for “Warhols,” as doing so would permit this aspect of the fourth factor always to weigh in favor of the alleged infringer so long as he is sufficiently successful to have generated an active market for his own work. Notwithstanding, we see no reason to disturb the district court’s overall conclusion that the two works occupy distinct markets, at least as far as direct sales are concerned.</p>

[THE BROADER INDUSTRY DISTINGUISHED BETWEEN SMARTPHONES AND SIMPLER "FEATURE PHONES."] ... This record evidence demonstrates that, rather than just "repurposing [Sun's] code from larger computers to smaller computers," *post*, at 16, Google's Android platform was part of a distinct (and more advanced) market than Java software.

... In other words, the jury could have understood Android and Java SE as operating in two distinct markets. ...

Oracle presented evidence to the contrary. **Indeed, the Federal Circuit held that the "market effects" factor militated against fair use in part because Sun had tried to enter the Android market.** 886 F. 3d, at 1209 (Sun sought licensing agreement with Google). But those licensing negotiations concerned much more than 37 packages of declaring code, covering topics like "the implementation of [Java's] code" and "branding and cooperation" between the firms. App. 245; **see also 4 Nimmer on Copyright §13.05[A][4] (cautioning against the "danger of circularity posed" by considering unrealized licensing opportunities because "it is a given in every fair use case that plaintiff suffers a loss of a potential market if that potential is defined as the theoretical market for licensing the very use at bar")**. In any event, the jury's fair use determination means that neither Sun's effort to obtain a license nor Oracle's conflicting evidence can overcome evidence indicating that, at a minimum, it would have been difficult for Sun to enter the smartphone market, even had Google not used portions of the Sun Java API.

**On the other hand, Google's copying helped Google make a vast amount of money from its Android platform. And enforcement of the Sun Java API copyright might give Oracle a significant share of these funds. It is important, however, to consider why and how Oracle might have become entitled to this money.** When a new interface, like an API or a spreadsheet program, first comes on the market, it may attract new users because of its expressive qualities, such as a better visual screen or because of its superior functionality. As time passes, however, it may be

We are unpersuaded, however, by the district court's conclusion that the Prince Series poses no threat to Goldsmith's *licensing* markets. ... Rather, we must also consider whether "unrestricted and widespread conduct of the sort engaged in by [AWF] would result in a substantially adverse impact on the potential market" for the Goldsmith Photograph. Campbell, 510 U.S. at 590 (internal quotation marks omitted) (alterations adopted)); *see also Fox News Network, LLC v. TVEyes, Inc.*, 883 F.3d 169, 179 (2d Cir. 2018).

[ALLOCATION OF BURDEN OF PROOF] ... While our prior cases have suggested that the rightsholder bears some initial burden of identifying relevant markets, we have never held that the rightsholder bears the burden of showing actual market harm. Nor would we so hold. Fair use is an affirmative defense; ....

In any case, whatever the scope of Goldsmith's initial burden, she satisfied it here. Setting aside AWF's licensing of Prince Series works for use in museum exhibits and publications about Warhol, which is not particularly relevant for the reasons set out in our discussion of the primary market for the works, **there is no material dispute that both Goldsmith and AWF have sought to license (and indeed have successfully licensed) their respective depictions of Prince to popular print magazines to accompany articles about him.** As Goldsmith succinctly states: "both [works] are illustrations of the same famous musician with the same overlapping customer base." Appellants' Br. at 50. Contrary to AWF's assertions, that is more than enough. *See Cariou, 714 F.3d at 709* (" [A]n accused infringer has usurped the market for copyrighted works . . . where the infringer's target audience and the nature of the infringing content is the same as the original."). And, since Goldsmith has identified a relevant market, AWF's failure to put forth any evidence that the availability of the Prince Series works poses no threat to Goldsmith's actual or potential revenue in that market tilts the scales toward Goldsmith.

Further, the district court entirely overlooked the potential harm to Goldsmith's derivative market, which is likewise substantial. Most directly,

valuable for a different reason, namely, because users, including programmers, are just used to it. They have already learned how to work with it. See Lotus Development Corp., 49 F. 3d, at 821 (Boudin, J., concurring).

The record here is filled with evidence that this factor accounts for Google's desire to use the Sun Java API. See, e.g., App. 169-170, 213-214. **This source of Android's profitability has much to do with third parties' (say, programmers') investment in Sun Java programs. It has correspondingly less to do with Sun's investment in creating the Sun Java API. We have no reason to believe that the Copyright Act seeks to protect third parties' investment in learning how to operate a created work.** Cf. Campbell, 510 U. S., at 591-592, 114 S. Ct. 1164, 127 L. Ed. 2d 500 (discussing the need to identify those harms that are "cognizable under the Copyright Act").

Finally, **given programmers' investment in learning the Sun Java API, to allow enforcement of Oracle's copyright here would risk harm to the public.** Given the costs and difficulties of producing alternative APIs with similar appeal to programmers, allowing enforcement here would make of the Sun Java API's declaring code a lock limiting the future creativity of new programs. Oracle alone would hold the key. The result could well prove highly profitable to Oracle (or other firms holding a copyright in computer interfaces). But those profits could well flow from creative improvements, new applications, and new uses developed by users who have learned to work with that interface. To that extent, the lock would interfere with, not further, copyright's basic creativity objectives. ...

The uncertain nature of Sun's ability to compete in Android's market place, the sources of its lost revenue, and the risk of creativity-related harms to the public, when taken together, convince that this fourth factor—market effects—also weighs in favor of fair use.

AWF's licensing of the Prince Series works to Condé Nast without crediting or paying Goldsmith deprived her of royalty payments to which she would have otherwise been entitled. **Although we do not always consider lost royalties from the challenged use itself under the fourth factor (as any fair use necessarily involves the secondary user using the primary work without paying for the right to do so), we do consider them where the secondary use occurs within a traditional or reasonable market for the primary work.** See Fox News, 883 F.3d at 180; On Davis v. Gap, Inc., 246 F.3d 152, 176 (2d Cir. 2001). ...

We also must consider the impact on this market if the sort of copying in which Warhol engaged were to become a widespread practice. That harm is also self-evident. There currently exists a market to license photographs of musicians, such as the Goldsmith Photograph, to serve as the basis of a stylized derivative image; permitting this use would effectively destroy that broader market, ...

Finally, our analysis of the fourth factor also "take[s] into account the public benefits the copying will likely produce." Google, 141 S. Ct. at 1206; ...AWF argues that weighing the public benefit cuts in its favor because "[d]enying fair-use protection to works like Warhol's will chill the creation of art that employs pre-existing imagery to convey a distinct message." Reply in Supp. of Pet. for Reh'g at 7-8. We disagree. Nothing in this opinion stifles the creation of art that may reasonably be perceived as conveying a new meaning or message, and embodying a new purpose, separate from its source material. AWF also lists the possible consequences that it contends will flow if we deny fair use in this case. **As discussed supra, however, those consequences would be significant to a district court primarily when assessing appropriate equitable relief for a copyright violation.** And here, Goldsmith expressly disclaims seeking some of the most extreme remedies available to copyright owners. See 17 U.S.C. 503(b). Moreover, what encroaches on Goldsmith's market is AWF's commercial licensing of the Prince Series, not Warhol's original creation. **Thus, art that is not turned into a commercial replica of its source**

	<p>material, and that otherwise occupies a separate primary market, has significantly more "breathing space" than the commercial licensing of the Prince Series. <i>Campbell</i>, 510 U.S. at 579.</p>
<p><b>[weighing]</b></p>	<p><b>E. Weighing the Factors</b></p>
<p>The fact that computer programs are primarily functional makes it difficult to apply traditional copyright concepts in that technological world. See <i>Lotus Development Corp.</i>, 49 F. 3d, at 820 (Boudin, J., concurring). In doing so here, we have not changed the nature of those concepts. We do not overturn or modify our earlier cases involving fair use—cases, for example, that involve “knockoff” products, journalistic writings, and parodies. ...</p> <p>We reach the conclusion that in this case, where Google reimplemented a user interface, taking only what was needed to allow users to put their accrued talents to work in a new and transformative program, Google’s copying of the Sun Java API was a fair use of that material as a matter of law. The Federal Circuit’s contrary judgment is reversed, and the case is remanded for further proceedings in conformity with this opinion.</p>	<p>...Having considered each of the four factors, we find that each favors Goldsmith. Further, although the factors are not exclusive, AWF has not identified any additional relevant considerations unique to this case that we should take into account. Accordingly, we hold that AWF’s defense of fair use fails as a matter of law.</p>
	<p><b>F. The Effect of Google</b></p>
	<p>... AWF’s argument that <i>Google</i> undermines our analysis rests on a misreading of both the Supreme Court’s opinion and ours, misinterpreting both opinions as adopting hard and fast categorical rules of fair use. To the contrary, both opinions recognize that determinations of fair use are highly contextual and fact specific, and are not easily reduced to rigid rules. ...</p> <p>In particular, the Supreme Court in <i>Google</i> took pains to emphasize that the unusual context of that case, which involved copyrights in computer code, may well make its conclusions less applicable to contexts such as ours. ... The Court repeatedly emphasized that “[t]he fact that computer programs are primarily functional makes it difficult to apply traditional copyright concepts in that technological world.” <i>Id.</i> at 1208.</p>

Just as AWF misreads the fact-and context-specific finding of fair use in *Google* as dictating a result in the very different context before us, it misreads our opinion as "effectively outlawing" an entire "genre" of art "widely viewed as one of the great artistic innovations of the modern era." ... [NOT SO]...

We merely insist that, just as artists must pay for their paint, canvas, neon tubes, marble, film, or digital cameras, if they choose to incorporate the existing copyrighted expression of other artists in ways that draw their purpose and character from that work (as by using a copyrighted portrait of a person to create another portrait of the same person, recognizably derived from the copyrighted portrait, so that someone seeking a portrait of that person might interchangeably use either one), they must pay for that material as well. As the Supreme Court again recognized in *Google*, the aims of copyright law are "sometimes conflicting." *Google*, 141 S. Ct. at 1197. The issue here does not pit novel forms of art against philistine censorship, but rather involves a conflict between artists each seeking to profit from his or her own creative efforts. ...

### III. Copyright: Embedding and In-Line Linking

#### “Server Test” Cases

- *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146 (9th Cir. 2007), [https://scholar.google.com/scholar\\_case?case=9280547131690965273](https://scholar.google.com/scholar_case?case=9280547131690965273) (search engine’s framing of image hosted on and displayed from third-party server does not constitute “display” as that term is used in Copyright Act)
- *Goldman v. Breitbart News Network, LLC*, 302 F. Supp. 3d 585 (S.D.N.Y. 2018), [https://scholar.google.com/scholar\\_case?case=16328126076918281333](https://scholar.google.com/scholar_case?case=16328126076918281333) (rejecting the *Perfect 10* “server test” as inapplicable to appearance of image on news website and as not “adequately grounded in the text of the Copyright Act”)
- *Free Speech Sys., LLC v. Menzel*, 390 F. Supp. 3d 1162 (N.D. Cal. 2019), [https://scholar.google.com/scholar\\_case?case=14860053210869430037](https://scholar.google.com/scholar_case?case=14860053210869430037) (noting question as to whether *Perfect 10*’s “server test” applies outside of the search engine context)
- *MidlevelU, Inc. v. ACI Information Group*, No. 9:18-cv-80843 (S.D. Fla. Sept. 10, 2019), <https://www.courtlistener.com/recap/gov.uscourts.flsd.530379/gov.uscourts.flsd.530379.93.0.pdf> (denying motion for summary judgment, and noting that *Perfect 10* depended not upon whether a defendant uses in-line linking or framing technology in particular but where the allegedly infringing content resides)
- *Nicklen v. Sinclair Broad. Grp., Inc.*, No. 20-CV-10300 (JSR), 2021 WL 3239510, at \*4 (S.D.N.Y. July 30, 2021), <https://casetext.com/case/nicklen-v-sinclair-broadcast-group-inc> (denying motion to dismiss and rejecting server test: *Perfect 10*’s reasoning should be cabined to facts specific to the case)

#### License Cases

- *Sinclair v. Ziff Davis, LLC*, No. 18-cv-2020 (S.D.N.Y. Apr. 13, 2020), <https://www.courtlistener.com/recap/gov.uscourts.nysd.487498/gov.uscourts.nysd.487498.31.0.pdf> (dismissing claim based on embedding of plaintiff’s photo from Instagram because, under Instagram’s assorted terms of service, (1) users who post photos grant Instagram the right to sublicense other users to display those photos and (2) Instagram grants such a sublicense to all users of its embedding API)
- *McGucken v. Newsweek LLC*, No. 1:19-cv-09617 (S.D.N.Y. Jun. 1, 2020), <https://www.courtlistener.com/recap/gov.uscourts.nysd.524753/gov.uscourts.nysd.524753.35.0.pdf> (in case with similar facts to *Sinclair*, finding that Instagram obtained the right to sublicense embedding of photos, but holding that court could not determine at the 12(b)(6) stage that Instagram had in fact granted its users that sublicense)

- Timothy B. Lee, *Instagram just threw users of its embedding API under the bus*, Ars Technica (Jun. 4, 2020), <https://arstechnica.com/tech-policy/2020/06/instagram-just-threw-users-of-its-embedding-api-under-the-bus/> (“While our terms allow us to grant a sub-license, we do not grant one for our embeds API,’ a Facebook company spokesperson told Ars in a Thursday email. ‘Our platform policies require third parties to have the necessary rights from applicable rights holders. This includes ensuring they have a license to share this content, if a license is required by law.’”)
- *Sinclair v. Ziff Davis, LLC v. Mashable, Inc.*, No. 18-cv-2020 (S.D.N.Y. Jun. 24, 2020), <https://www.courtlistener.com/recap/gov.uscourts.nysd.487498/gov.uscourts.nysd.487498.41.0.pdf> (granting reconsideration of April 13 order and conforming it to June 1 ruling in *McGucken*)

## IV. Substantial Similarity

- *Alfred v. Walt Disney Co.*, No. 19-55669 (9th Cir. Jul. 22, 2020) (unpub. decision), [https://scholar.google.com/scholar\\_case?case=3380900838737469206](https://scholar.google.com/scholar_case?case=3380900838737469206) (reversing dismissal of copyright claim over film *Pirates of the Caribbean: Curse of the Black Pearl* and noting that expert testimony could be useful)
- *Zindel v. Fox Searchlight Pictures*, No. 18-56087 (9th Cir. Jun. 22, 2020) (unpub. decision), [https://scholar.google.com/scholar\\_case?case=14123175495488595486](https://scholar.google.com/scholar_case?case=14123175495488595486) (reversing dismissal of copyright claim over film *The Shape of Water* and stating that courts must be cautious about granting motions to dismiss on the basis of a lack of substantial similarity)
- *Purohit v. Legend Pictures, LLC*, No. 18-1907 (D. Del. Mar. 24, 2020), [https://scholar.google.com/scholar\\_case?case=8651242971931313646](https://scholar.google.com/scholar_case?case=8651242971931313646) (dismissing claim over film *Krampus* based on lack of substantial similarity)



## V. Copyright: DMCA Litigation and Legislative Activity

### Eligibility for DMCA Safe Harbor

- *Feingold v. RageOn, Inc.*, No. 1:18-cv-02055 (S.D.N.Y. Jul. 15, 2020), <http://business.cch.com/ipld/FeingoldRageOn20200715.pdf> (online print-on-demand vendor did not qualify for DMCA protection because it profited directly from sale of infringing goods and did not expeditiously remove infringing merchandise)
- *Nintendo of America, Inc. v. Storman*, No. 2:19-cv-07818 (C.D. Cal. Jan. 15, 2020), <https://torrentfreak.com/images/dismissrom.pdf> (denying motion to dismiss on DMCA defense as premature)
- *Mon Cheri Bridals, LLC v. Cloudflare, Inc.*, No. 19-cv-01356 (C.D. Cal. Jul. 11, 2019), <https://torrentfreak.com/images/cloudflarebridal.pdf> (allegations that content delivery network Cloudflare was aware of third party infringement across its service were sufficient to avoid a motion to dismiss)
- *Downs v. Oath Inc.*, No. 1:18-cv-10337 (S.D.N.Y. May 22, 2019), <https://digitalcommons.law.scu.edu/cgi/viewcontent.cgi?article=2950&context=historical> (summary judgment granted to Huffington Post on copyright claim over photo uploaded by third-party “contributor”; § 512(c) applied notwithstanding an editor’s review of the photo for potential illegality)

### Section 512(f) Claims on Fraudulent Takedown Notices

- *Johnson v. New Destiny Christian Center Church*, No. 19-11070 (11th Cir. Sept. 4, 2020) (unpub. dec.), <https://media.ca11.uscourts.gov/opinions/unpub/files/201911070.pdf> (affirming summary judgment granted on § 512(f) claim on basis of affidavits from counsel for sender of DMCA notice saying that they considered the challenged use to be infringing)
- *Beyond Blond Productions, LLC v. Heldman*, No. 2:20-cv-05581 (C.D. Cal. Aug. 17, 2020), <https://www.courtlistener.com/recap/gov.uscourts.cacd.786276/gov.uscourts.cacd.786276.26.0.pdf> (state law claims over fraudulent takedown demands preempted by § 512(f) to the extent that demands were based on copyright rather than trademark concerns)
  - *Beyond Blond Productions, LLC v. Heldman*, No. 2:20-cv-05581 (C.D. Cal. Aug. 14, 2020), <https://www.courtlistener.com/recap/gov.uscourts.cacd.786276/gov.uscourts.cacd.786276.25.0.pdf> (granting preliminary injunction requiring defendant to withdraw DMCA notices on basis of likelihood that plaintiff’s conduct was not infringing)

- *Ningbo Mizhihe I&E Co., Ltd. v. Does*, No. 1:19-cv-06666 (S.D.N.Y. Apr. 30, 2020), <https://www.courtlistener.com/recap/gov.uscourts.nysd.519412/gov.uscourts.nysd.519412.104.0.pdf> (§ 512(f) counterclaim dismissed for failure to plead that sender of DMCA notice made a knowing misrepresentation)
- *Hughes v. Benjamin*, No. 17-cv-6493 (S.D.N.Y. Feb. 3, 2020), <https://cases.justia.com/federal/district-courts/new-york/nysdce/1:2017cv06493/479687/39/0.pdf?ts=1580811786> (§ 512(f) claim for misrepresentation in DMCA counternotice dismissed because statements as reasonably understood were true)

### Removal of Content-Management Information

- *Mango v. BuzzFeed, Inc.*, No. 19-446-cv (2nd Cir. Aug. 13, 2020), [https://scholar.google.com/scholar\\_case?case=11105026792052443007](https://scholar.google.com/scholar_case?case=11105026792052443007) (DMCA claim for removal of copyright management information does not require proof that defendant knew conduct would lead to future third-party infringement)
- *BWP Media USA Inc. v. Polyvore, Inc.*, 922 F.3d 42 (2nd Cir. 2019), [https://scholar.google.com/scholar\\_case?case=1462221474384808916](https://scholar.google.com/scholar_case?case=1462221474384808916) (reversing grant of summary judgment to operators of photo collage creation website, which allowed users to upload photos that would be automatically indexed and made accessible to other users; stripping of metadata does not preclude DMCA safe harbor protection but other factual questions as to site's qualifications for safe harbor precluded summary judgment)
- *Mills v. Netflix, Inc.*, No. 2:19-cv-07618 (C.D. Cal. Feb. 3, 2020), <http://www.medialaw.org/images/medialawdaily/02.04.20mills.pdf> (DMCA claim for removal of copyright management information dismissed for failure to plead specific allegations as to how identifiable infringements would be affected by defendants' alleged removing or altering of CMI, a pattern of conduct demonstrating defendants knew or had reason to know their actions would cause future infringement, or non-conclusory facts that Defendants intended to induce infringement)

### Contributory Infringement Claims

- *ALS Scan, Inc. v. Steadfast Networks, LLC*, No. 18-55615 (9th Cir. Jul. 17, 2020) (unpub. dec.), <https://cdn.ca9.uscourts.gov/datastore/memoranda/2020/07/17/18-55615.pdf> (data center service provider has taken sufficient measures to avoid contributory infringement claim by forwarding DMCA notices to hosting website)

### Circumvention

- *Philips North America, LLC v. Summit Imaging Inc.*, No. 19-1745 (W.D. Wash. Mar. 30, 2020), <https://www.courtlistener.com/recap/gov.uscourts.wawd.279392/gov.uscourts.wawd.279392.104.0.pdf>

[392.35.0.pdf](#) (allegations that defendant hacked plaintiff's software to enable plaintiff's customers to use features they had not paid for were sufficient to state claims for contributory infringement and under § 1201 of the DMCA)

- *Green v. U.S. Department of Justice*, No. 1:16-cv-01942 (D.D.C. Jun. 27, 2019), <https://www.courtlistener.com/recap/gov.uscourts.dcd.180539/gov.uscourts.dcd.180539.25.0.pdf> (denying motion to dismiss on claim by two technology researchers that anticircumvention and anti-trafficking provisions of DMCA unconstitutionally chill their First Amendment rights to research and to publish information about security flaws)

## Legislative Activity

- *The Copyright Alternative in Small-Claims Enforcement ("CASE") Act*, Public Law 116-260, <https://www.congress.gov/bill/116th-congress/house-bill/2426/text>
- Video and Written Testimony, *The Digital Millennium Copyright Act at 22: What is it, why was it enacted, and where are we now*, U.S. Senate Committee on the Judiciary Subcommittee on Intellectual Property (Feb. 11, 2020), <https://www.judiciary.senate.gov/meetings/the-digital-millennium-copyright-act-at-22-what-is-it-why-it-was-enacted-and-where-are-we-now>
- *Section 512 of Title 17: A Report of the Register of Copyrights*, U.S. Copyright Office (May 2020), <https://www.copyright.gov/policy/section512/section-512-full-report.pdf>
  - Exchange of correspondence between U.S. Copyright Office and Sens. Thom Tillis and Patrick Leahy regarding additional questions with respect to Section 512 (May 29, 2020/Jun. 29, 2020) <https://www.copyright.gov/laws/hearings/response-to-may-29-2020-letter.pdf>
- Video and Written Testimony, *Is the DMCA's Notice-and-Takedown System Working in the 21st Century?*, U.S. Senate Committee on the Judiciary Subcommittee on Intellectual Property (Jun. 2, 2020), <https://www.judiciary.senate.gov/meetings/is-the-dmcas-notice-and-takedown-system-working-in-the-21st-century>
- *Copyright and State Sovereign Immunity*, A Report of the Register of Copyrights (Aug. 2021), <https://www.copyright.gov/policy/state-sovereign-immunity/Sovereign%20Immunity%20Report%20final.pdf>

## VI. Copyright: Statute of Limitations, Damages, and Fee Awards

### Statute of Limitations and Related Damages Issues

- *Sohm v. Scholastic Inc.*, No. 18-2110 (2nd Cir. May 12, 2020), [https://scholar.google.com/scholar\\_case?case=138891714652427380](https://scholar.google.com/scholar_case?case=138891714652427380) (discovery rule applies to statute of limitations in Copyright Act claims; nevertheless, damages limited to three years prior to commencement of action regardless of application of discovery rule)

### Enforcement of Damage Awards

- *SAS Institute, Inc. v. World Programming Ltd.*, No. 19-1290 (4th Cir. Mar. 12, 2020), <https://www.ca4.uscourts.gov/opinions/191290.P.pdf> (in long-running copyright controversy over reverse-engineered software that spanned Atlantic, interests in comity did not prevent district court from entering orders to ensure that money judgment from a U.S. court was enforceable)
- *Dish Network L.L.C. v. TVizion LLC*, No. 8:18-cv-00727 (C.D. Cal. Mar. 27, 2020), <https://www.courtlistener.com/recap/gov.uscourts.cacd.708656/gov.uscourts.cacd.708656.108.0.pdf> (amending \$6 million copyright judgment against streaming company to apply to defendant company's successor organizations)

### Attorneys' Fees

- *Doc's Dream, LLC v. Dolores Press, Inc.*, No. 18-56073 (9th Cir. May 13, 2020), <http://cdn.ca9.uscourts.gov/datastore/opinions/2020/05/13/18-56073.pdf> (declaratory judgment action that turns on existence of copyright and whether copyright is infringed arises under Copyright Act and gives court discretion to award attorneys' fees under § 505)
- *Philpot v. L.M. Communications II of South Carolina, Inc.*, No. 5:17-cv-00173 (E.D. Ky. May 15, 2020), <https://www.courtlistener.com/recap/gov.uscourts.kyed.82876/gov.uscourts.kyed.82876.128.0.pdf> (photographer who succeeded in infringement claim denied attorneys' fees based on his business model of making image freely available under Creative Commons license and then suing when attribution was insufficient)
- *FameFlynet, Inc. v. Jasmine Enterprises Inc.*, No. 1:17-cv-04749 (N.D. Ill. Aug. 8, 2019), [https://www.courtlistener.com/recap/gov.uscourts.ilnd.341543/gov.uscourts.ilnd.341543.125.0\\_2.pdf](https://www.courtlistener.com/recap/gov.uscourts.ilnd.341543/gov.uscourts.ilnd.341543.125.0_2.pdf) (reducing copyright plaintiff's fee request by over 95%; demand for fees in excess of \$240K made no sense when case settled for \$5,000)