

# A NO MAN’S LAND OF FAIR USE: *MARANO V. THE METROPOLITAN MUSEUM OF ART*

*Sarah Landry*<sup>†</sup>

## TABLE OF CONTENTS

INTRODUCTION .....	2026
I. BACKGROUND .....	2031
A. <i>Fair Use Doctrine</i> .....	2032
B. <i>Classifying Fair Use Cases</i> .....	2034
1. Uses to Set Historical Context.....	2034
2. Transformative Adaptations .....	2036
3. Unforeseen Uses.....	2038
C. <i>Recent Cases</i> .....	2039
II. THE FACTS, PROCEDURAL HISTORY, AND HOLDINGS OF <i>MARANO</i> .....	2042
A. <i>Facts</i> .....	2042
B. <i>Procedural History</i> .....	2044
C. <i>Holdings</i> .....	2045
1. Purpose and Character of the Use .....	2045
2. Nature of the Copyrighted Work.....	2047
3. Amount and Substantiality of the Portion Used .....	2047
4. Effect of the Use upon the Market for or Value of the Original .....	2048
5. Balancing the Factors.....	2049
III. ANALYSIS .....	2049
A. <i>Nontransformative and Commercial Use</i> .....	2050

---

<sup>†</sup> Articles Editor, *Cardozo Law Review* (Vol. 44); J.D. Candidate, Benjamin N. Cardozo School of Law (2023); B.A., The George Washington University (2011). I would like to thank Professor Christopher Buccafusco for believing in this Case Note from its earliest inception and for providing invaluable feedback and encouragement throughout the writing process. I would also like to thank my *Cardozo Law Review* colleagues for their hard work in preparing this Case Note for publication. Finally, I am forever grateful to my fiancé and my family for their unconditional love and support.

B. <i>Possibly Factual</i> .....	2053
C. <i>Unreasonable Reproduction</i> .....	2054
D. <i>Market Harm</i> .....	2055
E. <i>A No Man's Land of Fair Use</i> .....	2057
F. <i>The Impact of Warhol and Google</i> .....	2059
CONCLUSION .....	2060

## INTRODUCTION

A “permissions culture” has pervaded art museum practice.<sup>1</sup> Rather than seeking to make fair use of works in appropriate circumstances, museums have defaulted to obtaining reproduction permission, even when it may not be legally necessary.<sup>2</sup> Fair use allows for the reasonable reproduction of copyrighted works without the permission of the copyright holder.<sup>3</sup> Museums have generally avoided fair use for several reasons. The permission-seeking default is self-reinforcing: obtaining permission from artists preserves relationships between museums and artists.<sup>4</sup> Museums are averse to the risk of litigation because of the unpredictability of fair use, and fair use guidance can change quickly in the digital context.<sup>5</sup> In the current digital age, as museums have increased their online activities to share information with the public, the permissions culture has impacted the industry’s ability to engage in online projects due to issues such as the time and money expended obtaining permission.<sup>6</sup> In response, museum organizations are seeking to

---

<sup>1</sup> See PATRICIA AUFDERHEIDE, PETER JASZI, BRYAN BELLO & TIJANA MILOSEVIC, COPYRIGHT, PERMISSIONS, AND FAIR USE AMONG VISUAL ARTISTS AND THE ACADEMIC AND MUSEUM VISUAL ARTS COMMUNITIES: AN ISSUES REPORT 7 (2014), [https://cmsimpact.org/wp-content/uploads/2016/01/fair\\_use\\_for\\_visual\\_arts\\_communities.pdf](https://cmsimpact.org/wp-content/uploads/2016/01/fair_use_for_visual_arts_communities.pdf) [<https://perma.cc/592K-TC8F>]; COLL. ART ASS’N, CODE OF BEST PRACTICES IN FAIR USE FOR THE VISUAL ARTS 6 (2015), [https://cmsimpact.org/wp-content/uploads/2016/01/best\\_practice\\_rfnl.pdf](https://cmsimpact.org/wp-content/uploads/2016/01/best_practice_rfnl.pdf) [<https://perma.cc/BUS4-K3DE>]; Rosemary Chandler, *Putting Fair Use on Display: Ending the Permissions Culture in the Museum Community*, 15 DUKE L. & TECH. REV. 60, 61 (2016).

<sup>2</sup> See ASS’N OF ART MUSEUM DIRS., GUIDELINES FOR THE USE OF COPYRIGHTED MATERIALS AND WORKS OF ART BY ART MUSEUMS 10 (2017), <https://aamd.org/sites/default/files/document/Guidelines%20for%20the%20Use%20of%20Copyrighted%20Materials.pdf> [<https://perma.cc/WN6S-S9EC>].

<sup>3</sup> See 17 U.S.C. § 107; Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 549 (1985).

<sup>4</sup> ASS’N OF ART MUSEUM DIRS., *supra* note 2, at 10; COLL. ART ASS’N, *supra* note 1, at 5–6.

<sup>5</sup> AUFDERHEIDE, JASZI, BELLO & MILOSEVIC, *supra* note 1, at 7, 34. *But see* Matthew Sag, *Predicting Fair Use*, 73 OHIO ST. L.J. 47, 86 (2012) (arguing that “fair use is not nearly so . . . unpredictable as is conventionally assumed”).

<sup>6</sup> See ASS’N OF ART MUSEUM DIRS., *supra* note 2, at 6–7; Chandler, *supra* note 1, at 73.

change the permissions culture, asserting the right of museums to make fair use of copyrighted works by creating best practice guidelines.<sup>7</sup>

Perhaps signaling a shift away from the permissions culture, the Metropolitan Museum of Art (Met) reproduced a copyrighted photograph by the professional photographer Lawrence Marano on its website without his permission.<sup>8</sup> As part of an exhibition exploring rock and roll instruments,<sup>9</sup> the museum exhibited the *Frankenstein* guitar created by the rock musician Eddie Van Halen.<sup>10</sup> In a corresponding webpage about the guitar, the museum displayed Marano's photograph of Van Halen playing the *Frankenstein* guitar.<sup>11</sup> The webpage on which the photo was reproduced exemplifies one of the ways museums have adapted to the digital age: creating online counterparts to physical exhibitions.<sup>12</sup>

The use of Marano's photograph resulted in litigation.<sup>13</sup> The District Court for the Southern District of New York decided *Marano v. Metropolitan Museum of Art* in July 2020, holding that the reproduction of the photo was fair use rather than copyright infringement.<sup>14</sup> In April 2021, the Court of Appeals for the Second Circuit affirmed in a summary order.<sup>15</sup> Although the Second Circuit deems summary orders nonprecedential,<sup>16</sup> *Marano* is nonetheless significant. *Marano* is the first case to consider whether a museum's reproduction of a work in a publication is fair use.<sup>17</sup> It could be seen to validate the move away from

---

<sup>7</sup> See, e.g., ASS'N OF ART MUSEUM DIRS., *supra* note 2, at 4–5; COLL. ART ASS'N, *supra* note 1, at 5.

<sup>8</sup> *Marano v. Metro. Museum of Art*, 472 F. Supp. 3d 76, 80 (S.D.N.Y. 2020), *aff'd*, 844 F. App'x 436 (2d Cir. 2021).

<sup>9</sup> See *Play It Loud: Instruments of Rock & Roll*, METRO. MUSEUM OF ART, <https://www.metmuseum.org/exhibitions/listings/2019/play-it-loud> [https://perma.cc/7KWK-WNDU].

<sup>10</sup> *Marano*, 472 F. Supp. 3d at 81.

<sup>11</sup> "Frankenstein," *Composite Electric Guitar*, METRO. MUSEUM OF ART, <https://www.metmuseum.org/art/collection/search/752454> [https://perma.cc/6K2W-VY5K].

<sup>12</sup> See COLL. ART ASS'N, *supra* note 1, at 12.

<sup>13</sup> *Marano*, 472 F. Supp. 3d 76; *Marano*, 844 F. App'x 436.

<sup>14</sup> *Marano*, 472 F. Supp. 3d at 80.

<sup>15</sup> *Marano*, 844 F. App'x at 437.

<sup>16</sup> 2D CIR. R. 32.1.1(a). Unlike the Second Circuit's local rule, the corresponding Federal Rule of Appellate Procedure does not state whether summary orders should or should not have precedential value. FED. R. APP. P. 32.1; David R. Cleveland, *Local Rules in the Wake of Federal Rule of Appellate Procedure 32.1*, 11 J. APP. PRAC. & PROCESS 19, 20 (2010). The Second Circuit's rule has been criticized for giving insufficient guidance to determine whether a decision should be issued as an opinion or summary order. See *id.* at 38. Further, it has been argued that summary orders are precedent and that decreeing otherwise is unconstitutional. *Id.* at 59.

<sup>17</sup> See ASS'N OF ART MUSEUM DIRS., *supra* note 2, at 13. Other lawsuits have considered this question but not proceeded to trial. See *Rothenberg v. Museum of Fine Arts*, No. 19-CV-03026 (S.D. Tex. dismissed Aug. 6, 2020).

the permissions default for the museum context.<sup>18</sup> Accordingly, *Marano* will be relied upon by courts and lawyers for museums in future cases with factual similarities.<sup>19</sup> Such reliance will occur whether these cases are brought intra- or extracircuit not only because *Marano* addresses a novel context, but also because Second Circuit fair use cases are particularly influential.<sup>20</sup> Moreover, *Marano* has already been cited and discussed by courts, lawyers, and scholars.<sup>21</sup>

*Marano* is distinguishable from the Second Circuit's fair use precedent. Through the reproduction of a photograph on a museum's website, *Marano* involves both art and public access to this art through the internet.<sup>22</sup> In comparison, the Second Circuit cases involving art generally concern the incorporation of artwork by one artist into the work of another.<sup>23</sup> The defendant-artist uses artwork by the plaintiff-

---

<sup>18</sup> For example, through best practice guidelines, documentary filmmakers have succeeded in moving away from the permissions default of licensing certain uses. See James Gibson, *Rights Accretion Redux*, 60 IDEA 45, 54–55 (2020).

<sup>19</sup> See Patrick J. Schiltz, *The Citation of Unpublished Opinions in the Federal Courts of Appeals*, 74 FORDHAM L. REV. 23, 44–45 (2005) (explaining that summary orders are read and cited by judges and lawyers).

<sup>20</sup> See *id.* at 45–46. Regarding influence within the Second Circuit, the District Court for the Southern District of New York found a summary order issued by the court of appeals “highly persuasive” because it was “directly on point.” *Harris v. United Fed’n of Tchrs.*, No. 02 Civ. 3257, 2002 WL 1880391, at \*1 n.2 (S.D.N.Y. Aug. 14, 2002). Moreover, the court stated that the summary order was indicative of how the appellate court would decide a similar case. *Id.* Regarding influence beyond the Second Circuit, fair use decisions of the Second Circuit Court of Appeals have the most extracircuit impact of any other circuit. Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions Updated, 1978–2019*, 10 N.Y.U. J. INTEL. PROP. & ENT. L. 1, 12 (2020). Similarly, fair use decisions of the Southern District of New York have more extracircuit impact than any other district court as well as any appellate court other than those of the Second and Ninth Circuits. *Id.*

<sup>21</sup> The district court opinion has been cited intra- and extracircuit. See Nat’l Rifle Ass’n of Am. v. Cuomo, 480 F. Supp. 3d 404, 416 n.2 (N.D.N.Y. 2020); *Bell v. Eagle Mountain Saginaw Indep. Sch. Dist.*, 27 F.4th 313, 320 (5th Cir. 2022). For discussions on the district court opinion by scholars, see 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.05[B][6] n.337.38 (2022), and 1 ALEXANDER LINDEY & MICHAEL LANDAU, LINDEY ON ENTERTAINMENT, PUBLISHING AND THE ARTS § 1:31.90 (3d ed. 2022). Art lawyers have commented on the circuit court opinion without qualifying that the decision was a summary order. See, e.g., Leila Amineddoleh, *Fair Use in US Law: The Path to Marano v. Metropolitan Museum of Art*, 26 ART ANTIQUITY & L. 355, 361–62 (2021); Patrick H.J. Hughes, *Q&A: Art Law Expert Megan Noh on Andy Warhol’s Fight over Prince Pics*, WESTLAW INTEL. PROP. DAILY BRIEFING, Apr. 14, 2021, 2021 WL 1394894.

<sup>22</sup> See *Marano v. Metro. Museum of Art*, 472 F. Supp. 3d 76 (S.D.N.Y. 2020), *aff’d*, 844 F. App’x 436 (2d Cir. 2021).

<sup>23</sup> See, e.g., *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26 (2d Cir. 2021), *cert. granted*, 142 S. Ct. 1412 (2022) (mem.); *Cariou v. Prince*, 714 F.3d 694 (2d Cir. 2013); *Blanch v. Koons*, 467 F.3d 244 (2d Cir. 2006). In *Warhol*, the court referred to this category of cases as one in which the plaintiff’s and defendant’s works are both visual artworks, discussing *Cariou*, *Blanch*, and *Rogers v. Koons*, 960 F.2d 301 (2d Cir. 1992), as examples. *Warhol*, 11 F.4th at 40. A

artist to create new artwork.<sup>24</sup> Meanwhile, the cases involving public access to information via the internet generally concern the incorporation of works into new technology.<sup>25</sup> The defendant creates a new service through which the public gains access to the plaintiff's work over the internet.<sup>26</sup> While *Marano* bears similarities to both categories of cases, it fits into neither.<sup>27</sup> Nonetheless, the court aligned *Marano* too closely with the art cases and too little with the public access cases.<sup>28</sup> Instead, *Marano* can be placed into a developing category of cases in which a work is used to provide historical context.<sup>29</sup> However, unlike the other cases in this category, *Marano* is the only one in which the plaintiff's work is assertedly used to provide historical context on a different subject than the original.<sup>30</sup> Because *Marano* involves art, public access to art through the internet, and historical context on a different subject than the artwork, the case falls into a no man's land of the fair use doctrine.<sup>31</sup>

To determine whether a use is fair, courts engage in a case-by-case analysis of four nonexclusive statutory factors.<sup>32</sup> Under the first factor, "the purpose and character of the use," finding that a use is transformative weighs strongly in favor of fair use.<sup>33</sup> In analyzing this factor, the court emphasized that *Marano* made the photo to show how Van Halen appears when performing, while the Met used the photo to contextualize the guitar.<sup>34</sup> If the court did not rely on *Marano*'s purpose in creating the photo and on the Met's purpose in reproducing it, the court may not have found the use transformative.<sup>35</sup> In turn, the court may have concluded that the use was not fair.<sup>36</sup> Instead, *Marano*'s photograph could have been understood as providing historical context about the subject of the photo, and the case would no longer diverge from the other

---

case in which a poster of an artist's work was used in the background of a television show is an example of an exception to this pattern. See *Ringgold v. Black Ent. Television, Inc.*, 126 F.3d 70 (2d Cir. 1997).

<sup>24</sup> See, e.g., *Warhol*, 11 F.4th 26; *Cariou*, 714 F.3d 694; *Blanch*, 467 F.3d 244.

<sup>25</sup> See, e.g., *Capitol Records, LLC v. ReDigi Inc.*, 910 F.3d 649 (2d Cir. 2018); *Authors Guild v. Google, Inc.*, 804 F.3d 202 (2d Cir. 2015).

<sup>26</sup> See, e.g., cases cited *supra* note 25.

<sup>27</sup> See *infra* Section III.E.

<sup>28</sup> See *infra* Sections III.A, III.C.

<sup>29</sup> See Pamela Samuelson, *Unbundling Fair Uses*, 77 *FORDHAM L. REV.* 2537, 2573 (2009); *infra* Section III.E.

<sup>30</sup> See *infra* Section III.E.

<sup>31</sup> See *infra* Section III.E.

<sup>32</sup> See *Marano v. Metro. Museum of Art*, 472 F. Supp. 3d 76, 82 (S.D.N.Y. 2020), *aff'd*, 844 F. App'x 436 (2d Cir. 2021).

<sup>33</sup> 17 U.S.C. § 107; *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

<sup>34</sup> *Marano*, 472 F. Supp. 3d at 84; *Marano*, 844 F. App'x at 438.

<sup>35</sup> See *infra* Section III.A.

<sup>36</sup> See *infra* Sections I.A, I.C, II.C.5, III.A.

historical context cases.<sup>37</sup> Furthermore, the possibility that the Met's use was neither transformative nor fair suggests that reliance by museums on *Marano* in similar contexts may be misguided; asserting a different purpose for the reproduction may not be sufficient for finding fair use.<sup>38</sup> Despite the court's insistence that fair use is deeply fact-specific, it did not fully consider the particular facts of *Marano* when analyzing the statutory factors and analogizing *Marano* to historical context cases.<sup>39</sup>

*Marano* was decided in the shadow of two significant fair use cases. One week prior to *Marano*, a different panel of the same court decided *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*.<sup>40</sup> Three days after *Marano*, the Supreme Court decided *Google LLC v. Oracle America, Inc.*, currently the Court's most significant ruling on fair use in quite some time.<sup>41</sup> One year later, in March 2022, the Supreme Court granted a petition for writ of certiorari in *Warhol*, the Court's first fair use case involving works of visual art.<sup>42</sup> Because the Supreme Court limited the question presented to the first factor, its forthcoming decision should not significantly affect the discussion of factors two through four in this Case Note.<sup>43</sup> While the Court's decision will likely affect what counts as transformative in fair use cases generally, the allegedly infringing work in *Warhol* is a new work of art, so it is not yet clear how the standard the Court announces will be applied to works outside that context.<sup>44</sup> Nonetheless, *Warhol* and *Google* will serve as precedent for future Second Circuit cases involving museum reproduction.

---

<sup>37</sup> See *infra* Section III.E.

<sup>38</sup> See *infra* Section III.A.

<sup>39</sup> See *infra* Sections III.A–III.E.

<sup>40</sup> See *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26 (2d Cir. 2021), *cert. granted*, 142 S. Ct. 1412 (2022) (mem.).

<sup>41</sup> See *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183 (2021); see 4 NIMMER & NIMMER, *supra* note 21, § 13.05[I] (noting that *Google* is “the Court’s most recent foray into fair use—and its only pronouncement of the twenty-first century”).

<sup>42</sup> *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 142 S. Ct. 1412 (2022) (mem.); Erwin Chemerinsky, *Looking Ahead*, 45 L.A. LAW. 16, 19 (2022).

<sup>43</sup> Petition for Writ of Certiorari at i, *Warhol*, 124 S. Ct. 1412 (No. 21-869); *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*, SCOTUS BLOG [hereinafter SCOTUS BLOG], <https://www.scotusblog.com/case-files/cases/andy-warhol-foundation-for-the-visual-arts-inc-v-goldsmith> [<https://perma.cc/A2C5-73FW>]; see *infra* Sections III.B–III.D.

<sup>44</sup> See Kyle Jahner, *High Court’s Tricky Task in Warhol Case Carries Big Implications*, BLOOMBERG L. (Apr. 1, 2022, 5:15 AM), <https://news.bloomberglaw.com/ip-law/high-courts-tricky-task-in-warhol-case-carries-big-implications> [<https://perma.cc/4A6R-37VU>] (“Whatever the justices decide will have far-reaching implications not just for photographers and conceptual artists in Warhol’s mold but for creators of all stripes.”); Chemerinsky, *supra* note 42, at 19 (“Visual art fair use cases may be different in the Court’s eyes from the music and technology fair use cases that the Court has decided so far.”); Sandra Crawshaw-Sparks, David Munkittrick, Anisha Shenai-Khatkhate, Nicole Sockett & Nicole O. Swanson, *Supreme Court to Re-Examine Fair Use: Warhol*

Part I of this Case Note provides a background on fair use, categories of fair use cases, and significant cases decided contemporaneously with *Marano*.<sup>45</sup> Part II outlines *Marano*'s facts, procedural history, and holdings.<sup>46</sup> Part III argues that the court disputably found the Met's use transformative, noncommercial, reasonable, and not harmful to *Marano*'s market.<sup>47</sup> Part III also asserts that *Marano* is distinguishable from the other historical context cases and considers the impact of *Warhol* and *Google* on factors one and two in future cases like *Marano*.<sup>48</sup>

## I. BACKGROUND

The origins of copyright law are derived from the Constitution: "Congress shall have Power . . . To promote the Progress of Science . . . by securing for limited Times to Authors . . . the exclusive Right to their respective Writings . . ." <sup>49</sup> Copyright has been interpreted to have a dual purpose based on this clause. On the one hand, authors receive a benefit by being afforded rights, which incentivizes the creation of artistic works.<sup>50</sup> On the other hand, the public receives a benefit by being afforded access to these works through their creation and the limited monopoly granted to authors.<sup>51</sup> The Supreme Court established that photographs are "writings" and that Congress, consequently, has the power to make photographs copyrightable.<sup>52</sup> Photographs are considered "pictorial, graphic, and sculptural works" subject to copyright protection.<sup>53</sup> Photographers are thus granted a limited monopoly in their photographs to guard their economic incentive in these works.<sup>54</sup> This monetary motivation encourages the creation of works, and the works then benefit the public who is afforded access to them.<sup>55</sup>

---

Foundation v. Goldsmith, PROSKAUER: MINDING YOUR BUSINESS (June 27, 2022), <https://www.mindingyourbusinesslitigation.com/2022/06/supreme-court-to-re-examine-fair-use-warhol-foundation-v-goldsmith> [<https://perma.cc/TYU4-EDAY>] (explaining that while the "decision will impact how fair use is applied to artistic works across the board[,] . . . it will likely have the most significant impact on the work of appropriation artists").

<sup>45</sup> See *infra* Part I.

<sup>46</sup> See *infra* Part II.

<sup>47</sup> See *infra* Sections III.A, III.C–III.D.

<sup>48</sup> See *infra* Sections III.E–III.F.

<sup>49</sup> U.S. CONST. art. I, § 8, cl. 8.

<sup>50</sup> See *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429, 450 (1984).

<sup>51</sup> See *id.* at 429–32.

<sup>52</sup> *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 56–58 (1884).

<sup>53</sup> 17 U.S.C. §§ 101, 102(a)(5).

<sup>54</sup> NANCY E. WOLFF, *THE PROFESSIONAL PHOTOGRAPHER'S LEGAL HANDBOOK* 59 (2007).

<sup>55</sup> See *id.* at 4.

A. *Fair Use Doctrine*

To ensure copyright's dual purposes are served, fair use exists to limit the monopoly granted to creators.<sup>56</sup> If creators were afforded complete protection of their works, public access would be reduced, shifting the balance in favor of creators and minimizing the public benefit.<sup>57</sup> Use of a copyrighted work is fair and not copyright infringement when it balances these goals by providing the public with access to the work without disincentivizing the creator to continue producing.<sup>58</sup> An affirmative defense to copyright infringement, fair use furthers the goals of copyright.<sup>59</sup> To determine whether a use is fair, courts analyze several statutory factors, underscoring that the fair use analysis involves a fact-specific inquiry.<sup>60</sup>

Fair use is codified in Section 107 of the Copyright Act of 1976.<sup>61</sup> The preamble states: "[T]he fair use of a copyrighted work, including . . . for purposes such as criticism, comment, news reporting, teaching . . . , scholarship, or research, is not an infringement of copyright."<sup>62</sup> To determine whether a use is fair, courts consider four nonexclusive factors:

- (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.<sup>63</sup>

---

<sup>56</sup> See Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1109 (1990).

<sup>57</sup> *Id.* ("The copyright law embodies a recognition that creative intellectual activity is vital to the well-being of society. . . . [E]xcessively broad protection would stifle, rather than advance, the objective.").

<sup>58</sup> See *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 608 (2d Cir. 2006) ("The fair use doctrine is a statutory exception to copyright infringement."); Leval, *supra* note 56, at 1110 ("[T]he use must be of a character that serves the copyright objective of stimulating productive thought and public instruction without excessively diminishing the incentives for creativity.").

<sup>59</sup> See *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579, 590 (1994); *Authors Guild v. Google, Inc.*, 804 F.3d 202, 212–13 (2d Cir. 2015); *Am. Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 923 (2d Cir. 1994); Leval, *supra* note 56, at 1109–10.

<sup>60</sup> 17 U.S.C. § 107; see, e.g., *Campbell*, 510 U.S. at 576–77.

<sup>61</sup> § 107.

<sup>62</sup> *Id.*

<sup>63</sup> *Id.*



The preamble gives examples of the types of uses that may be found fair, but this list is not intended to be exhaustive.<sup>64</sup> The Supreme Court has held that the four factors should be considered together.<sup>65</sup> The “purpose and character of the use” considers whether the use of the copyrighted work is transformative, and a finding of transformation favors fair use because the use contributes new visual or conceptual content.<sup>66</sup> The formulation of the transformative test, at least in the context of visual art, is now being reconsidered by the Supreme Court in *Warhol*. The Court is weighing “[w]hether a work of art is ‘transformative’ when it conveys a different meaning or message from its source material,” as the Court has routinely held, or “whether a court is forbidden from considering the meaning of the accused work where it ‘recognizably deriv[es] from’ its source material,” as the Second Circuit has held.<sup>67</sup> As a transformative use typically advances the constitutional purpose of copyright, this determination is currently considered the most important.<sup>68</sup> Accordingly, if a use is found to be transformative but other factors suggest that the use was not fair, those factors are given less weight.<sup>69</sup> This factor also considers whether the use is commercial or for a nonprofit educational purpose.<sup>70</sup> A commercial use does not necessarily mean that it is unfair, just as a nonprofit educational use does not necessarily mean that it is fair.<sup>71</sup> The “nature of the copyrighted work” acknowledges that certain works are more protectable than others.<sup>72</sup> More protectable works weigh against a finding of fair use in theory, but this consideration is often given limited weight when the use is transformative under the first factor.<sup>73</sup> The “amount and substantiality of

---

<sup>64</sup> *Campbell*, 510 U.S. at 576–78.

<sup>65</sup> *Id.* at 578.

<sup>66</sup> *Id.* at 578–79 (explaining that a transformative work “adds something new” through “new expression” or “meaning”).

<sup>67</sup> SCOTUS BLOG, *supra* note 43 (second alteration in original).

<sup>68</sup> *Campbell*, 510 U.S. at 579; *see also* Leval, *supra* note 56, at 1116 (asserting that the transformative inquiry is “the soul of fair use” and that finding a use transformative “seems indispensable to a fair use defense”); Clark D. Asay, Arielle Sloan & Dean Sobczak, *Is Transformative Use Eating the World?*, 61 B.C. L. REV. 905, 967 (2020) (“[T]he vast majority of modern courts use the transformative use concept throughout the fair use inquiry as the dominant means of resolving various fair use questions.”). However, the Supreme Court’s decision in *Warhol* could decrease the significance of this factor. *See* Jahner, *supra* note 44 (predicting that the opinion may “de-emphasize[] transformativeness”).

<sup>69</sup> *Campbell*, 510 U.S. at 579.

<sup>70</sup> 17 U.S.C. § 107(1).

<sup>71</sup> *Campbell*, 510 U.S. at 584.

<sup>72</sup> *Id.* at 586 (quoting § 107(2)).

<sup>73</sup> *See id.*; *see also* Leval, *supra* note 56, at 1122 (explaining that this factor should not determine whether a use is fair). *But see infra* note 355 and accompanying text (describing the potential resurgence of this factor following *Google*).

the portion used” depends on the first factor; the more transformative the defendant’s use, the greater the use of the original that can be justified.<sup>74</sup> The “effect of the use upon the potential market” involves a two-part inquiry: (1) the market harm resulting from the use and (2) the market harm if the use were widespread.<sup>75</sup>

### B. *Classifying Fair Use Cases*

Responding to claims that fair use is unpredictable, in an in-depth analysis of fair use, Professor Pamela Samuelson classifies fair use cases by the type of use at issue.<sup>76</sup> She argues that by considering the particular category into which a use falls, one may be able to determine whether the use is fair.<sup>77</sup> She further argues that courts should consider these categories in addition to the statutory factors.<sup>78</sup> To better understand *Marano*, this Section will consider three of Samuelson’s categories bearing a relationship to *Marano* using Second Circuit fair use cases.<sup>79</sup>

#### 1. Uses to Set Historical Context

In “uses to set historical context” cases, the plaintiffs’ copyrighted works are reproduced by creators of factual works to provide historical context.<sup>80</sup> Samuelson primarily discusses *Bill Graham Archives v. Dorling Kindersley Ltd.* and briefly mentions several documentary film cases.<sup>81</sup> While the defendants in these cases succeeded on fair use, Samuelson points out that some defendant-documentarians have not when they copiously reproduced the copyrighted works.<sup>82</sup> To understand the

---

<sup>74</sup> *Campbell*, 510 U.S. at 586–87 (quoting § 107(3)).

<sup>75</sup> *Id.* at 590 (quoting § 107(4)) (describing the second inquiry as “whether unrestricted and widespread conduct of the sort engaged in by the defendant . . . would result in a substantially adverse impact on the potential market” for the copyrighted work (quoting 3 NIMMER & NIMMER, *supra* note 21, § 13.05[A][4])). Some opinions do not consider this second inquiry. *See, e.g.*, *Marano v. Metro. Museum of Art*, 472 F. Supp. 3d 76, 87 (S.D.N.Y. 2020), *aff’d*, 844 F. App’x 436 (2d Cir. 2021).

<sup>76</sup> Samuelson, *supra* note 29, at 2540–42 (referring to these “common patterns” as “policy-relevant clusters”).

<sup>77</sup> *Id.* at 2541–42.

<sup>78</sup> *Id.* at 2620–21.

<sup>79</sup> The Supreme Court’s *Google* decision will also be considered. *See infra* Section I.C.

<sup>80</sup> Samuelson, *supra* note 29, at 2573 (“Authors of nonfiction works may . . . use copyrighted materials as a way to set historical context.”).

<sup>81</sup> *Id.* at 2573–74.

<sup>82</sup> *Id.* at 2574.

pattern of the statutory analysis in these cases, including *Marano*, the following discussion will consider all four factors.<sup>83</sup>

*Bill Graham* is a historical context case in which the defendant prevailed on fair use.<sup>84</sup> The Bill Graham Archives sued the publishers of a book about the Grateful Dead for copyright infringement because the book reproduced six Grateful Dead concert posters and one concert ticket without permission.<sup>85</sup> Consisting of 480 pages and more than 2,000 images, the book features a timeline of the band.<sup>86</sup> The concert materials were reproduced at a reduced size in the timeline and interspersed with text about the corresponding concerts as well as graphic art.<sup>87</sup> First, in analyzing the purpose and character of the use, the court emphasized the significantly reduced size of the reproductions, the dynamic design of the pages on which the images appeared, and the fact that the images constituted a small portion of the book.<sup>88</sup> The opinion also underscored that the book is biographical and that the purposes of the original and secondary uses were different; while the original use of the posters and ticket was creative and promotional, the secondary use was historical.<sup>89</sup> Accordingly, the works were transformed in the book.<sup>90</sup> Second, although the nature of the copyrighted works was creative, this factor had little weight because the defendant's use was transformative.<sup>91</sup> Third, the reproductions were reasonable because, despite being reproduced in full, the images were reduced in size to the extent possible without becoming unrecognizable so that the images still served the purpose of providing historical context to the reader.<sup>92</sup> Lastly, because the use was transformative, the loss of licensing fees did not harm the market for the originals.<sup>93</sup> Samuelson classifies this case as a use to set historical context because the book is a nonfiction work and the images provided historical context.<sup>94</sup>

The documentary film cases are likewise historical context cases in which the fair use defense succeeded.<sup>95</sup> *Hofheinz*, the widow of film

---

<sup>83</sup> See *infra* Section II.C.

<sup>84</sup> *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605 (2d Cir. 2006); see Samuelson, *supra* note 29, at 2573–74.

<sup>85</sup> *Bill Graham*, 448 F.3d at 607 & n1. The Archives claimed to own the copyrights. *Id.* at 607.

<sup>86</sup> *Id.* at 607.

<sup>87</sup> *Id.* at 606–07, 613.

<sup>88</sup> *Id.* at 611.

<sup>89</sup> *Id.* at 608–10.

<sup>90</sup> *Id.* at 611.

<sup>91</sup> *Id.* at 612–13.

<sup>92</sup> *Id.* at 613.

<sup>93</sup> *Id.* at 614–15.

<sup>94</sup> See Samuelson, *supra* note 29, at 2573–74.

<sup>95</sup> *Id.* at 2574 & n.261.

producer Nicholson, brought copyright infringement claims against parties responsible for the creation of documentaries incorporating films created by her late husband.<sup>96</sup> In *Hofheinz v. AMC Productions, Inc.*, clips of films made by Nicholson, another producer, and the production company for which they worked were included in a documentary about them.<sup>97</sup> First, the use of the clips was likely transformative; the original purpose of the films was to entertain, but the purpose of the clips was to inform.<sup>98</sup> Second, the works at issue were published and primarily creative, weighing marginally against fair use.<sup>99</sup> Next, the clips were a small portion of the documentary as a whole.<sup>100</sup> Finally, the plaintiff could not show market harm.<sup>101</sup> Finding that three of the four factors favored fair use, the court held that the defendants' use was likely fair.<sup>102</sup> The other cases in this triad follow a similar pattern.<sup>103</sup> Samuelson categorizes these cases as uses to set historical context because the documentaries are nonfiction works and the film clips are used to provide information about the subjects of the documentaries.<sup>104</sup>

## 2. Transformative Adaptations

“Transformative adaptations” cases involve the use of creative works in a way that transforms them into new artistic works.<sup>105</sup> This category encompasses cases involving the incorporation of artwork by one artist

---

<sup>96</sup> See *Hofheinz v. AMC Prods., Inc.*, 147 F. Supp. 2d 127 (E.D.N.Y. 2001); *Hofheinz v. A&E Television Networks*, 146 F. Supp. 2d 442 (S.D.N.Y. 2001); *Hofheinz v. Discovery Commc'ns, Inc.*, No. 00-cv-3802, 2001 WL 1111970 (S.D.N.Y. Sept. 20, 2001). Nicholson produced films for the production company American International Pictures along with his colleague Sam Arkoff. *Hofheinz*, 147 F. Supp. 2d at 130.

<sup>97</sup> *Hofheinz*, 147 F. Supp. 2d at 130, 134.

<sup>98</sup> *Id.* at 137. Because the case proceeded on the plaintiff's motion for a preliminary injunction, the use was found to be likely transformative rather than simply transformative. *Id.* at 129.

<sup>99</sup> *Id.* at 138–39.

<sup>100</sup> *Id.* at 139.

<sup>101</sup> *Id.* at 140.

<sup>102</sup> *Id.* at 141.

<sup>103</sup> In the second case, a documentary about an actor included clips of films in which the actor appeared; the films were produced by Nicholson and his colleagues. *Hofheinz v. A&E Television Networks*, 146 F. Supp. 2d 442, 443–44, 449 (S.D.N.Y. 2001). Factors one, three, and four favored the defendants, and the court found fair use. *Id.* at 446–49. In the third case, a documentary about alien films included clips from a trailer of an alien film likewise produced by Nicholson. *Hofheinz v. Discovery Commc'ns, Inc.*, No. 00-cv-3802, 2001 WL 1111970, at \*2 (S.D.N.Y. Sept. 20, 2001). Factors one, three, and four again favored the defendant, and although the court did not explicitly conclude that the use of the clips was fair, it granted the defendant's motion to dismiss. *Id.* at \*5–7.

<sup>104</sup> See Samuelson, *supra* note 29, at 2573–74.

<sup>105</sup> *Id.* at 2553 (“Sometimes authors transformatively adapt expression from existing works . . . as an expression of artistic imagination.”).

into the work of another artist.<sup>106</sup> Foreshadowing *Warhol*, Samuelson warns that fair use may not be found when an artist does not sufficiently transform the original work.<sup>107</sup> To understand the Supreme Court's consideration of the transformation analysis in *Warhol*,<sup>108</sup> the below discussion will focus on the transformative inquiry.

Fair use was found in the transformative adaptation case *Blanch v. Koons*.<sup>109</sup> Blanch, a professional photographer, sued Koons, a visual artist, for copyright infringement after Koons used part of her photograph *Silk Sandals* in his collage painting *Niagara*.<sup>110</sup> Blanch's purpose in creating the photograph was to convey a sense of sexuality in an image advertising shoes.<sup>111</sup> Koons's purpose in creating the painting was to comment on advertising and consumerism generally.<sup>112</sup> His painting also commented on the societal and artistic connotations of Blanch's photograph specifically.<sup>113</sup> *Niagara* was transformative because of these differing purposes and meanings and because Koons made changes to the original.<sup>114</sup> *Blanch* is the main case Samuelson discusses to explain the transformative adaptations category, and she notes that it embodies fair use cases in which a secondary work artistically transforms the original.<sup>115</sup>

*Cariou v. Prince* is another example of a transformative adaptation case in which fair use was found.<sup>116</sup> Cariou, a professional photographer, sued the artist Richard Prince for copyright infringement after Prince used some of his photographs in a series of paintings and collages entitled *Canal Zone*.<sup>117</sup> Many of the works were transformative because Prince changed the aesthetics and messages of the originals.<sup>118</sup> In contrast to Cariou's calm aesthetic, Prince's works are turbulent.<sup>119</sup> While Cariou created small black-and-white photographs, Prince created large mixed

---

<sup>106</sup> See *id.*; see, e.g., *Blanch v. Koons*, 467 F.3d 244 (2d Cir. 2006); *Cariou v. Prince*, 714 F.3d 694 (2d Cir. 2013); *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26 (2d Cir. 2021), cert. granted, 142 S. Ct. 1412 (2022) (mem.).

<sup>107</sup> Samuelson, *supra* note 29, at 2555; see *infra* Section I.C.

<sup>108</sup> See *supra* note 67 and accompanying text; *infra* Section III.F.

<sup>109</sup> *Blanch*, 467 F.3d 244; see Samuelson, *supra* note 29, at 2553–54.

<sup>110</sup> *Blanch*, 467 F.3d at 246–48. *Niagara* was commissioned by Deutsche Bank and the Guggenheim Museum, and both institutions later exhibited the work. *Id.* at 246–47. Blanch also sued Deutsche Bank and the Guggenheim. *Id.*

<sup>111</sup> *Id.* at 248, 252.

<sup>112</sup> See *id.* at 252–53.

<sup>113</sup> *Id.* at 257.

<sup>114</sup> *Id.* at 253.

<sup>115</sup> Samuelson, *supra* note 29, at 2553 (“*Blanch v. Koons* exemplifies fair use caselaw involving transformative recasting of expression.” (footnote omitted)).

<sup>116</sup> *Cariou v. Prince*, 714 F.3d 694 (2d Cir. 2013). See generally Samuelson, *supra* note 29, at 2553.

<sup>117</sup> *Cariou*, 714 F.3d at 698–99. Cariou also sued Gagosian, Prince's gallery. *Id.* at 698.

<sup>118</sup> *Id.* at 706–08.

<sup>119</sup> *Id.* at 706.

media works with color.<sup>120</sup> Prince's works were transformative because they differed aesthetically from the originals.<sup>121</sup> This is a transformative adaptation case because Prince adapted Cariou's existing photographs into new artistic works through techniques including incorporating them into collages, increasing their sizes, and adding color.<sup>122</sup>

### 3. Unforeseen Uses

The "unforeseen use" cases involve uses that Congress could not have foreseen at the time of the Copyright Act of 1976 because the technologies involved did not yet exist.<sup>123</sup> Examples of such unanticipated innovations include the internet, search engine technologies, and reverse engineering software.<sup>124</sup> This category encompasses cases involving the incorporation of material into new technology through which the public gains access to information.<sup>125</sup> Given the importance of balancing the public benefit of the new product with the impact on the original creator's market, the below discussion will include the transformation and market harm factors.<sup>126</sup>

The fair use defense succeeded in the unforeseen use case *Authors Guild v. Google, Inc.*<sup>127</sup> Without the permission of the books' authors, Google digitized books and made them searchable on the internet, allowing users to search for terms within a book and to view a small portion of the book's text containing the search terms.<sup>128</sup> The authors sued Google for copyright infringement.<sup>129</sup> Google transformed the books by creating digitized copies that enabled searching.<sup>130</sup> Google also had a transformative purpose: to provide information that was otherwise unavailable, thus benefitting the public.<sup>131</sup> The authors' markets for the books were not harmed because the information about the books made

---

<sup>120</sup> *Id.* at 700, 706.

<sup>121</sup> *Id.* at 707–08.

<sup>122</sup> *Id.* at 706; *see supra* note 105 and accompanying text.

<sup>123</sup> Samuelson, *supra* note 29, at 2602; *id.* at 2546 (describing these uses as ones that "Congress did not and could not have anticipated").

<sup>124</sup> *Id.* at 2546.

<sup>125</sup> *See id.* at 2602; *see, e.g.*, *Authors Guild v. Google, Inc.*, 804 F.3d 202 (2d Cir. 2015); *Capitol Records, LLC v. ReDigi Inc.*, 910 F.3d 649 (2d Cir. 2018); *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183 (2021).

<sup>126</sup> *See* Samuelson, *supra* note 29, at 2614.

<sup>127</sup> *Authors Guild*, 804 F.3d 202; *see infra* note 133 and accompanying text.

<sup>128</sup> *Authors Guild*, 804 F.3d at 207.

<sup>129</sup> *Id.* at 206–07.

<sup>130</sup> *Id.* at 216–17.

<sup>131</sup> *Id.* at 215–17, 220–22.

available by Google was not a competing substitute for the originals even if there was some loss of sales.<sup>132</sup> *Authors Guild* is an unforeseen use case because it involves both the internet and search engine technology.<sup>133</sup>

In contrast, in the unforeseen use case *Capitol Records, LLC v. ReDigi Inc.*, the defendant's fair use defense did not prevail.<sup>134</sup> ReDigi developed an online marketplace allowing individuals who had legally purchased copyrighted digital music files to resell those files.<sup>135</sup> Several record companies holding the copyrights to music that had been resold sued for copyright infringement.<sup>136</sup> ReDigi's platform was not transformative because it neither altered the original works nor provided information about them.<sup>137</sup> Because a transformative purpose was minimal or nonexistent, the commercial character of the use was given more weight than usual.<sup>138</sup> Overshadowing the doomed fair use defense, the reproductions directly competed with the plaintiffs' markets.<sup>139</sup> This market harm was not outweighed by the benefit ReDigi's program provided to digital music purchasers.<sup>140</sup> Although unsuccessful, *Capitol Records* is an example of an unforeseen use case because it involves the internet and new technology.<sup>141</sup>

### C. Recent Cases

The Supreme Court's forthcoming decision in *Warhol* and recent decision in *Google* will serve as precedent for transformative adaptation and unforeseen use cases.<sup>142</sup>

In *Warhol*, the Second Circuit found the artist Warhol's use of professional photographer Goldsmith's photograph unfair.<sup>143</sup> Goldsmith licensed a photograph she took of the musician Prince to Vanity Fair for

---

<sup>132</sup> *Id.* at 221–22.

<sup>133</sup> See Samuelson, *supra* note 29, at 2602, 2610–11.

<sup>134</sup> *Capitol Records, LLC v. ReDigi Inc.*, 910 F.3d 649 (2d Cir. 2018); see *infra* note 141 and accompanying text.

<sup>135</sup> *Capitol Records*, 910 F.3d at 652.

<sup>136</sup> *Id.* at 652.

<sup>137</sup> *Id.* at 660–61.

<sup>138</sup> *Id.* at 661.

<sup>139</sup> *Id.* at 661–63.

<sup>140</sup> *Id.* at 664.

<sup>141</sup> See Samuelson, *supra* note 29, at 2602 (explaining that unforeseen uses include “new uses of copyrighted works enabled by advances in technology”).

<sup>142</sup> *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 142 S. Ct. 1412 (2022) (mem.); *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183 (2021); see *infra* text accompanying notes 151–54, 164–67.

<sup>143</sup> *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 32 (2d Cir. 2021), *cert. granted*, 142 S. Ct. 1412 (2022) (mem.).

“use as an artist reference.”<sup>144</sup> Vanity Fair commissioned Warhol to create a work from this photograph, and the work was then reproduced in the magazine.<sup>145</sup> However, Warhol continued to use the photograph, creating fifteen more works, which, together with the original commission, comprise the *Prince Series*.<sup>146</sup> Decades later, when Goldsmith discovered that Warhol had continued to use her photograph, she informed the Andy Warhol Foundation that the works violated her copyright, leading to litigation.<sup>147</sup> In a lengthy analysis of transformation, the court found that because Warhol superimposed his style onto Goldsmith’s photograph, creating a work that continued to be recognizable as the original, the work was not transformative.<sup>148</sup> Because both parties had licensed their works to magazines for reproduction, their markets overlapped, harming Goldsmith’s licensing market to magazines through lost royalties.<sup>149</sup> Finding for the plaintiff on all four factors, the court held that Warhol’s use was not fair.<sup>150</sup>

Although the court found that Warhol’s uses of Goldsmith’s photograph were not transformative, this case nonetheless falls into the transformative adaptation line of cases.<sup>151</sup> Warhol adapted Goldsmith’s photograph, an existing work, to create a series of prints and drawings.<sup>152</sup> He transformed the photograph—unsuccessfully according to the court—by, for example, cropping the image to retain only Prince’s head and not his torso, changing the image from black and white to bright colors, and omitting features of the original to give the musician a flattened appearance.<sup>153</sup> Thus, this case is an example of a failed transformative adaptation.<sup>154</sup>

In *Google*, the Supreme Court found Google’s partial use of Oracle’s code fair.<sup>155</sup> Oracle owns the copyright to Java SE, a computer program that has been used by software developers to create new programs by using the Java programming language.<sup>156</sup> Google created an Application

---

<sup>144</sup> *Id.* at 33–34.

<sup>145</sup> *Id.* at 34.

<sup>146</sup> *Id.*

<sup>147</sup> *Id.* at 35. The Foundation holds the copyrights to Warhol’s *Prince Series* following the artist’s death. *Id.*

<sup>148</sup> *See id.* at 37–44.

<sup>149</sup> *Id.* at 49–50. Notably, however, Goldsmith had not licensed the photograph at issue. *Id.* at 49.

<sup>150</sup> *Id.* at 51.

<sup>151</sup> *Id.* at 42–43; *see supra* note 105 and accompanying text.

<sup>152</sup> *Warhol*, 11 F.4th at 34.

<sup>153</sup> *See id.* at 34 (depicting Goldsmith’s photograph and Warhol’s resulting work); *id.* at 46.

<sup>154</sup> *See supra* note 105 and accompanying text.

<sup>155</sup> *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1197 (2021).

<sup>156</sup> *Id.* at 1190.



Programming Interface (API), a library of tasks from which programmers can select code for each task that they would like a program to implement.<sup>157</sup> The API consisted of millions of lines of new code and around 11,500 lines of copied code from Java SE.<sup>158</sup> As a result, Oracle sued Google for copyright infringement.<sup>159</sup> The Court foregrounded that Google used the code for Android smartphones whereas prior use of the code was primarily for computers.<sup>160</sup> This new use required creativity and led to the creation of new products.<sup>161</sup> Google's product did not harm Oracle's market because the markets do not overlap, and the product was not a substitute.<sup>162</sup> Finding for the defendant on all four factors, the Court held that Google's use was fair.<sup>163</sup>

This case falls into the unforeseen uses category.<sup>164</sup> One of Samuelson's subcategories of unforeseen uses is "competition- and innovation-promoting uses in the software industry."<sup>165</sup> Samuelson notes that cases in this subcategory include instances in which a copyrighted work is copied to create a new product that is found to be fair use.<sup>166</sup> By using existing material to create new technology, *Google* is therefore an example of an unforeseen use case.<sup>167</sup>

The Second Circuit's *Warhol* decision and the Supreme Court's *Google* decision offer different perspectives on what qualifies as transformative use.<sup>168</sup> In *Warhol*, the creation of new artistic works was not transformative even though they differed aesthetically from the original to some extent.<sup>169</sup> In contrast to the *Blanch* and *Cariou* cases, the aesthetic differences were insufficient to render the defendant's work transformative.<sup>170</sup> In *Google*, the repurposing of computer code was transformative even though the defendant copied 11,500 lines of code

---

<sup>157</sup> *Id.* at 1191.

<sup>158</sup> *Id.*

<sup>159</sup> *Id.* at 1194.

<sup>160</sup> *Id.* at 1202–03, 1205.

<sup>161</sup> *Id.*

<sup>162</sup> *Id.* at 1206–07.

<sup>163</sup> *Id.* at 1208–09.

<sup>164</sup> See Samuelson, *supra* note 29, at 2602.

<sup>165</sup> *Id.* at 2605.

<sup>166</sup> *Id.* at 2605–06.

<sup>167</sup> *Id.* at 2602, 2605–06.

<sup>168</sup> Suzanne Y. Bell, Chase Brennick, Simon J. Frankel & Adrian Perry, *Supreme Court and Second Circuit Issue Conflicting Messages on Fair Use Doctrine*, 33 INTELL. PROP. & TECH. L.J. 8, 8–9 (2021); Hughes, *supra* note 21 (“[C]ommentators have generally perceived the Supreme Court’s view of transformativeness as applied in *Google* to be broad and expansive, unlike the retrenchment of the doctrine that the 2d Circuit’s *Goldsmith* opinion represents.”).

<sup>169</sup> *Warhol*, 11 F.4th at 41–42.

<sup>170</sup> See *supra* Section I.B.2; *Warhol*, 11 F.4th at 42.

exactly because Google used this code in a new context: in smartphones rather than computers.<sup>171</sup> While the Second Circuit conceived of transformation narrowly in *Warhol*, curtailing its prior formulations of transformativeness, the Supreme Court conceived of transformation broadly in *Google*.<sup>172</sup>

The above cases show, as Samuelson argues, that cases within particular categories follow patterns enabling one to predict whether a particular use will be found fair.<sup>173</sup> A transformative adaptation case may not be found fair if the defendant did not transform the plaintiff's work sufficiently.<sup>174</sup> The defendant's use in *Warhol* was not transformative according to the court, and the use was deemed unfair.<sup>175</sup> Among the possibilities for finding an unforeseen use case unfair is if the defendant's use served as a substitute for the plaintiff's market.<sup>176</sup> The defendant's use in *Capitol Records* supplanted the plaintiff's market and thus the use was not fair.<sup>177</sup> In addition to these category-specific patterns, more broadly, if the defendant's use is not transformative, it will not be considered fair, as seen in *Capitol Records* and *Warhol*.<sup>178</sup>

## II. THE FACTS, PROCEDURAL HISTORY, AND HOLDINGS OF *MARANO*

### A. *Facts*

Marano is a professional photographer, and the Met is an art museum that displays international art from a period spanning 5,000 years.<sup>179</sup> In 2019, the Met exhibition *Play It Loud: Instruments of Rock & Roll* displayed the *Frankenstein* guitar, an instrument assembled and painted by the rock musician Van Halen.<sup>180</sup> In conjunction with the physical exhibition in the museum, corresponding information about the

---

<sup>171</sup> Google LLC v. Oracle Am., Inc., 141 S. Ct. 1183, 1203–04 (2021).

<sup>172</sup> Bell, Brennick, Frankel & Perry, *supra* note 168, at 8–9; Hughes, *supra* note 21.

<sup>173</sup> Samuelson, *supra* note 29, at 2541–42.

<sup>174</sup> *See id.* at 2555.

<sup>175</sup> *Warhol*, 11 F.4th at 42, 51.

<sup>176</sup> Samuelson, *supra* note 29, at 2610.

<sup>177</sup> Capitol Records, LLC v. ReDigi Inc., 910 F.3d 649, 661 (2d Cir. 2018).

<sup>178</sup> *Id.* at 661, 663; *Warhol*, 11 F.4th at 42, 51.

<sup>179</sup> Marano v. Metro. Museum of Art, 472 F. Supp. 3d 76, 80 (S.D.N.Y. 2020), *aff'd*, 844 F. App'x 436 (2d Cir. 2021); Larry Marano (@larrymaranophoto), INSTAGRAM, <https://www.instagram.com/larrymaranophoto/?hl=en> (last visited Jan. 6, 2022) (“Professional music industry photographer, with over 40 years experience capturing Rock n Roll icons.”); *About the Met*, METRO. MUSEUM OF ART, <https://www.metmuseum.org/about-the-met> [<https://perma.cc/DLF3-9UN2>].

<sup>180</sup> *Marano*, 472 F. Supp. 3d at 80–81; *see Play It Loud: Instruments of Rock & Roll*, *supra* note 10.

exhibition was displayed on the Met's website, including information on the objects in *Play It Loud*.<sup>181</sup> The Met reproduced Marano's copyrighted Van Halen photo on its website without Marano's permission.<sup>182</sup> The Met stated that it obtained permission to reproduce the photo from Van Halen, the photo's subject, and that it had accidentally left out the image credit to Marano on the website.<sup>183</sup>

Figure 1

### "Frankenstein," composite electric guitar

1975

Edward Lodewijk "Eddie" Van Halen

Not on view

Aptly nicknamed "Frankenstein," this guitar was pieced together by Eddie Van Halen from modified factory seconds and mismatched odd-lot parts, then spray-painted. It represents an effort to combine some of the most desirable elements of Gibson and Fender guitars into a single instrument that was not commercially available at the time. Van Halen was continually striving to achieve the ultimate guitar for tone, playability, dependability, and functionality. The unique guitar embodies not only his groundbreaking and unorthodox playing style but also his ingenuity in design and engineering. One of the most recognizable guitars of all time, it spawned legions of copies from other manufacturers and inspired generations of fans to design their own instruments.

Technical Description:  
Contoured ash Strat-style body and two-piece maple neck; 25½ in. scale; spray-painted red finish with



Due to rights restrictions, this image cannot be enlarged, viewed at full screen, or downloaded.

Photo by Larry Marano/Getty Images



The photo captures Van Halen playing the *Frankenstein* guitar at an October 1982 concert at Madison Square Garden in New York City.<sup>184</sup> First published in January 1986, the photo's copyright was registered in March 2019.<sup>185</sup> Prior to the Met's reproduction, the photo was available

<sup>181</sup> See *Play It Loud: Instruments of Rock & Roll*, *supra* note 10; see, e.g., "Frankenstein," *Composite Electric Guitar*, *supra* note 11.

<sup>182</sup> *Marano*, 472 F. Supp. 3d at 80; see *infra* Figure 1 (providing a screenshot of the current webpage). The Met also reproduced the photo in a video promoting the exhibition on its website and in the museum itself on an "informational placard" adjacent to the *Frankenstein* guitar. Declaration of Linda Steinman in Support of Dismissal of This Action Under the Fair Use Exception to the Copyright Act at 4, *Marano*, 472 F. Supp. 3d 76 (No. 19-cv-08606) [hereinafter Declaration]; see also "Frankenstein," *Composite Electric Guitar*, *supra* note 11. These two additional reproductions were not mentioned in the complaint. Declaration, *supra*, at 4.

<sup>183</sup> Declaration, *supra* note 182, at 3.

<sup>184</sup> Brief for Plaintiff-Appellant at 9, *Marano v. Metro. Museum of Art*, 844 Fed. App'x 436 (2d Cir. 2021) (No. 20-3104); *Marano*, 472 F. Supp. 3d at 80.

<sup>185</sup> U.S. Copyright Registration No. VA0002142049 (registered Mar. 8, 2019).

to license through Getty Images, where it remains available.<sup>186</sup> The photo has been licensed to various online publications.<sup>187</sup>

The Met reproduced the photo on the object page for the guitar.<sup>188</sup> The left side of this page displayed text about the guitar and Van Halen, and the right side of the page displayed a photograph of the guitar installed at the museum with a thumbnail of the image below and two additional thumbnails.<sup>189</sup> The second photograph was also an image of the guitar displayed at the Met.<sup>190</sup> The third image was Marano's photo.<sup>191</sup> By clicking on a thumbnail, visitors to the page could enlarge the corresponding image.<sup>192</sup> Beneath the text and images, the page included the object details for the *Frankenstein* guitar, such as its date, medium, and dimensions.<sup>193</sup>

### B. Procedural History

Marano brought a copyright infringement claim against the Met, arguing that the reproduction of the photo on the museum's website infringed his copyright.<sup>194</sup> Prior to the Met's reply to Marano's complaint, the district court ordered Marano to show cause as to why fair use should not result in dismissal of the lawsuit.<sup>195</sup> Because the court determined that Marano did not show that the Met's use was unfair, the court dismissed

---

<sup>186</sup> Brief for Plaintiff-Appellant, *supra* note 184, at 9; *see also Van Halen File Photos*, GETTY IMAGES, <https://www.gettyimages.com/detail/news-photo/eddie-van-halen-of-van-halen-performs-on-the-hide-your-news-photo/136658761?adppopup=true> [https://perma.cc/X5RA-RUZK].

<sup>187</sup> *See, e.g.*, Ethan Sacks, *Eric Clapton Headlines Daily News' List of Greatest Guitarists of All Time—but Who Else Made the Cut?*, N.Y. DAILY NEWS (Mar. 30, 2015, 6:00 AM), <https://www.nydailynews.com/entertainment/music/clapton-headlines-news-list-greatest-guitarists-article-1.2164559> [https://perma.cc/GXY6-6A3R]; Al Shipley, *Eddie Van Halen's 10 Best Solos*, SPIN (Oct. 7, 2020, 1:00 PM), <https://www.spin.com/2020/10/eddie-van-halens-10-best-solos> [https://perma.cc/PPM3-DJAD]; Anne Steele, *Eddie Van Halen Dies at 65*, WALL ST. J. (Oct. 6, 2020, 6:25 PM), <https://www.wsj.com/articles/eddie-van-halen-dies-at-65-11602015589> [https://perma.cc/JJ8D-SGKA].

<sup>188</sup> *Marano*, 472 F. Supp. 3d at 81; *see also supra* Figure 1.

<sup>189</sup> "*Frankenstein*," *Composite Electric Guitar*, *supra* note 11; *Marano*, 472 F. Supp. 3d at 81. When the complaint was filed, the webpage also contained a fourth image, an installation view of the exhibition. *See* Declaration, *supra* note 182, at exhibit B. After the complaint was filed, the page was modified to include an image credit to Marano. *Marano*, 472 F. Supp. 3d at 81 n.6. The page currently also includes a credit to Getty Images and a rights restrictions notice. *See supra* Figure 1.

<sup>190</sup> *Marano*, 472 F. Supp. 3d at 81.

<sup>191</sup> *Id.*

<sup>192</sup> *Id.*

<sup>193</sup> "*Frankenstein*," *Composite Electric Guitar*, *supra* note 11.

<sup>194</sup> *Marano*, 472 F. Supp. 3d at 80.

<sup>195</sup> *Id.*

his complaint, and his subsequent motion for reconsideration was denied.<sup>196</sup> Marano appealed the dismissal, but the circuit court affirmed by summary order.<sup>197</sup> The Supreme Court denied Marano's petition for certiorari.<sup>198</sup>

### C. Holdings

The district and circuit courts' holdings for each statutory factor and overall fair use determination will be discussed together. Because the circuit court issued a summary order, the district court's opinion is more thorough, devoting several paragraphs to each factor.<sup>199</sup> In contrast, the circuit court's opinion includes only a single sentence for some of the factors, affirming the findings of the district court.<sup>200</sup> Given the circuit court's brief, nonprecedential opinion, and the fact that the court agreed with the district court's determinations, the following discussion will focus on the opinion of the lower court.

#### 1. Purpose and Character of the Use

The courts held that the purpose and character of the use weighed in favor of fair use.<sup>201</sup> In analyzing this factor, the courts engaged in a two-part inquiry, considering whether the use was transformative and whether the use was commercial.<sup>202</sup> Following *Bill Graham*, the district court found the Met's use transformative for three reasons.<sup>203</sup> First, Marano's purpose in creating the photo differed from the Met's purpose in reproducing the photo.<sup>204</sup> While Marano's purpose was to reveal "what Van Halen looks like in performance," the Met's purpose was to "spotlight[] the 'Frankenstein' guitar."<sup>205</sup> Marano wanted the photo to show that Van Halen was innovative and unconventional, whereas the

---

<sup>196</sup> *Id.*; Marano v. Metro. Museum of Art, No. 19-CV-8606, 2020 WL 4735117, at \*1 (S.D.N.Y. Aug. 14, 2020), *aff'd*, 844 F. App'x 436 (2d Cir. 2021).

<sup>197</sup> Marano, 844 F. App'x at 437.

<sup>198</sup> Marano v. Metro. Museum of Art, 142 S. Ct. 213 (2021) (mem.).

<sup>199</sup> See Marano, 472 F. Supp. 3d 76.

<sup>200</sup> See Marano, 844 F. App'x 439.

<sup>201</sup> Marano, 472 F. Supp. 3d at 86; Marano, 844 F. App'x at 439.

<sup>202</sup> Marano, 472 F. Supp. 3d at 83; Marano, 844 F. App'x at 438–39.

<sup>203</sup> Marano, 472 F. Supp. 3d at 84–85.

<sup>204</sup> *Id.* at 84.

<sup>205</sup> *Id.*

Met wanted the photo to provide additional information on the guitar.<sup>206</sup> Second, the Met used the photo in an educational context, showing that the guitar was an important and influential instrument.<sup>207</sup> Third, the use was transformative because the photo was one image on an object page for an exhibition comprised of 185 objects and because this page contained text and additional images.<sup>208</sup> Thus, the photo was a small portion of the overall website for the exhibition and was not particularly prominent on the object page.<sup>209</sup> The court rejected Marano's argument that the Met's use was not transformative because it did not comment on the photo, instead asserting that it was not necessary for the Met to discuss the photo directly because it was used to provide context for the guitar.<sup>210</sup>

The circuit court agreed that the Met's use was transformative because the museum focused on the instrument and because Marano and the Met had different purposes in creating and using the photo.<sup>211</sup> The Met placed the photo in a different context—a context focused on the design and importance of the guitar rather than a context focused on Van Halen himself.<sup>212</sup> This different context resulted in a different significance for the photo, adding to its meaning.<sup>213</sup>

Next, the district court found the use noncommercial, noting that the Met is a nonprofit institution.<sup>214</sup> It was unlikely that the photo played a part in causing visitors to go to the museum and paying admission fees to the Met.<sup>215</sup> The court reasoned that even if discovery could show that the photo resulted in paid visits to the museum, such a finding would be outweighed by the finding of transformation.<sup>216</sup> The circuit court agreed, emphasizing that the Met's website is free and has artistic and educational purposes—purposes that are noncommercial.<sup>217</sup> The courts concluded that the first factor weighed in favor of fair use because the Met's use was transformative and noncommercial.<sup>218</sup>

---

<sup>206</sup> *Id.* (noting that Marano sought to show that Van Halen was “groundbreaking and unorthodox”).

<sup>207</sup> *Id.* at 84–85 (“[T]he Met used Plaintiff's Photo in a scholarly context.”).

<sup>208</sup> *Id.* at 85.

<sup>209</sup> *Id.*

<sup>210</sup> *Id.*

<sup>211</sup> *Marano v. Metro. Museum of Art*, 844 F. App'x 436, 438 (2d Cir. 2021).

<sup>212</sup> *Id.*

<sup>213</sup> *Id.* at 438–39.

<sup>214</sup> *Marano*, 472 F. Supp. 3d at 85–86.

<sup>215</sup> *Id.* at 86. The Met charges admission to visitors who do not live in New York. *Id.* at 85.

<sup>216</sup> *Id.* at 86.

<sup>217</sup> *Marano*, 844 F. App'x at 438–39.

<sup>218</sup> *Marano*, 472 F. Supp. 3d at 86; *Marano*, 844 F. App'x at 439.

## 2. Nature of the Copyrighted Work

The nature of the copyrighted work tilted slightly against a fair use finding.<sup>219</sup> For this factor, courts consider two inquiries: whether the plaintiff's work is creative or factual and whether the work is published or unpublished.<sup>220</sup> First, the district court stated that the photo is incontestably creative, noting that photographs of real people and events may be considered creative.<sup>221</sup> Although finding the work creative would typically weigh against fair use, the court reasoned that this finding had little weight because the Met's use was transformative.<sup>222</sup> Because the Met used the photo for its historical but not artistic merit, the fact that the photo is a creative work did not weigh in favor of fair use as it might have otherwise.<sup>223</sup> The circuit court agreed that the photo is a creative artwork and that this determination had little effect because the use was transformative.<sup>224</sup> Second, after noting that unpublished works are afforded greater protection, the district court stated simply that the photo is published.<sup>225</sup> The circuit court did not address the publication status of the photo.<sup>226</sup> The district court concluded that the second factor possibly weighed marginally against fair use.<sup>227</sup> The circuit court did not come to a separate conclusion about the weight of this factor but noted that the finding of transformation under the first factor weighing in favor of fair use was consistent with the other three factors.<sup>228</sup>

## 3. Amount and Substantiality of the Portion Used

The amount copied factor was found to be neutral.<sup>229</sup> The district court assessed whether the amount of the photo used was reasonable in relation to the way in which it was used.<sup>230</sup> The court reasoned that reproduction of a work as a whole can be essential to the purpose for

---

<sup>219</sup> *Marano*, 472 F. Supp. 3d at 86.

<sup>220</sup> *Id.*

<sup>221</sup> *Id.* (stating that the photo is "indisputably creative").

<sup>222</sup> *Id.*

<sup>223</sup> *Id.*

<sup>224</sup> *Marano v. Metro. Museum of Art*, 844 F. App'x 436, 439 (2d Cir. 2021).

<sup>225</sup> *Marano*, 472 F. Supp. 3d at 86.

<sup>226</sup> *See Marano*, 844 F. App'x at 439.

<sup>227</sup> *Marano*, 472 F. Supp. 3d at 86.

<sup>228</sup> *Marano*, 844 F. App'x at 439.

<sup>229</sup> *Marano*, 472 F. Supp. 3d at 87 (finding that this factor "does not weigh against a finding of fair use").

<sup>230</sup> *Id.* at 86.

which it is used.<sup>231</sup> The Met reproduced the photo in its entirety, but this reproduction was reasonable when considered in the context of the first factor—the use of the photo for historical context.<sup>232</sup> Also, the reproduction of the photo as a thumbnail along with other images, appearing on a page with text, reduced the photo’s artistic force.<sup>233</sup> The circuit court agreed that the reproduction of the photo as a whole was required for the photo to serve its historical function.<sup>234</sup> The district court concluded that this factor did not impact the potential for finding fair use because despite the Met’s use of the entire photo, the use was otherwise measured and for historical purposes.<sup>235</sup>

#### 4. Effect of the Use upon the Market for or Value of the Original

The market harm factor weighed in favor of the Met.<sup>236</sup> The district court evaluated whether the Met’s use appropriated the photo or offered a rival replacement for it, noting that these possibilities are less likely the more the original work is transformed.<sup>237</sup> The court first considered whether the Met harmed Marano’s traditional market.<sup>238</sup> Rejecting Marano’s assertion that museums are a possible market for the photo and his request for discovery on this question, the court reasoned that Marano cannot develop a market for transformative uses of the photo to prevent it from being used fairly.<sup>239</sup> Instead, the court maintained that Marano’s traditional market for the photo consists of photography collectors of rock musicians and possibly but improbably museums for exhibitions about musicians.<sup>240</sup> However, because the Met’s use was transformative, at issue was a transformative market rather than a traditional one.<sup>241</sup> In this context, Marano’s loss of reproduction fees did not qualify as market harm.<sup>242</sup> The court held that it was doubtful the market for the photo was harmed by the Met’s transformative use.<sup>243</sup> The circuit court agreed that

---

<sup>231</sup> *Id.*

<sup>232</sup> *Id.*

<sup>233</sup> *Id.* at 87 (asserting that the arrangement of the webpage “limit[ed] the visual impact of the Photo’s artistic expression”).

<sup>234</sup> *Marano v. Metro. Museum of Art*, 844 F. App’x 436, 439 (2d Cir. 2021).

<sup>235</sup> *Marano*, 472 F. Supp. 3d at 87.

<sup>236</sup> *Id.* at 87–88.

<sup>237</sup> *Id.* at 87.

<sup>238</sup> *Id.*

<sup>239</sup> *Id.*

<sup>240</sup> *Id.*

<sup>241</sup> *Id.*

<sup>242</sup> *Id.* at 88.

<sup>243</sup> *Id.* at 87.



a licensing market could not be considered and noted that the record did not indicate that the Met's reproduction could harm another market for the photo or reduce its value.<sup>244</sup> The district court concluded that this factor favored fair use.<sup>245</sup>

### 5. Balancing the Factors

Upon balancing the factors, the district court found the Met's use fair, largely because it found the Met's use transformative under the first factor, impacting the subsequent determinations.<sup>246</sup> The circuit court did not separately weigh the factors but similarly reasoned that the finding of transformation and the balance of the remaining factors suggested that the Met's use was fair.<sup>247</sup> Rejecting Marano's argument that a fair use outcome would result in museums being able to claim fair use when using photographs in exhibitions for educational purposes, the circuit court emphasized that the lower court's assessment correctly focused on the particular facts of the case.<sup>248</sup> Furthermore, the court determined that the district court's balancing was correct and held that it did not err in ruling that the use was fair.<sup>249</sup>

## III. ANALYSIS

Despite the Second Circuit's insistence upon the fact-specific nature of fair use, the court paradoxically sought to fit *Marano* into its existing fair use jurisprudence.<sup>250</sup> A comparison to these other cases suggests that the court's determinations on each of the statutory factors are uncertain.<sup>251</sup> As a result, the Met's use may not be fair.<sup>252</sup> Moreover, a comparison to categories of fair use cases reveals that *Marano* falls into neither the transformative adaptation nor unforeseen use classifications and that *Marano* is distinguishable from the historical context cases.<sup>253</sup>

---

<sup>244</sup> *Marano v. Metro. Museum of Art*, 844 F. App'x 436, 439 (2d Cir. 2021).

<sup>245</sup> *Marano*, 472 F. Supp. 3d at 88.

<sup>246</sup> *Id.*

<sup>247</sup> *Marano*, 844 F. App'x at 439.

<sup>248</sup> *Id.*

<sup>249</sup> *Id.*

<sup>250</sup> See *infra* Sections III.A–III.E.

<sup>251</sup> See *infra* Sections III.A–III.D.

<sup>252</sup> See *supra* Sections I.A, I.C, II.C.5; *infra* Sections III.A, III.C–III.D; see also LINDEY & LANDAU, *supra* note 21 (noting that *Marano*, like *Bill Graham*, “is another case in which the court goes too far in finding fair use”).

<sup>253</sup> See *infra* Section III.E.

Lastly, the recent and anticipated fair use guidance offered by the Supreme Court may affect the outcome of factors one and two in particular in future museum reproduction cases.<sup>254</sup>

#### A. *Nontransformative and Commercial Use*

In analyzing transformation under the first factor, the court relied too heavily on purpose, followed the transformative adaptation cases in asserting that the Met did not need to comment on the original, and did not sufficiently consider the way in which the photo was reproduced.<sup>255</sup> Therefore, the Met's use may not have been transformative.<sup>256</sup>

The Second Circuit diverges on whether the transformative inquiry should consider the plaintiff's purpose in creating the work and the defendant's purpose in using the work.<sup>257</sup> In *Blanch*, the court emphasized that the purposes Blanch had in creating the photograph and Koons had in using the photograph were distinct.<sup>258</sup> In contrast, in *Cariou*, the court declined to consider Prince's purpose in using Cariou's photographs.<sup>259</sup> Similarly, in *Warhol*, rather than considering Goldsmith's and Warhol's purposes, the court reasoned that whether a work is transformative cannot depend on the secondary user's intent, asserting that such reliance could lead to finding too many uses transformative.<sup>260</sup> In comparison, the *Marano* court relied on the stated intent of Marano as well as that of the Met in determining that the Met's use was transformative.<sup>261</sup> Returning to the earlier test from *Blanch*, the court focused on the supposedly different purposes that Marano had in creating the photo and the Met

---

<sup>254</sup> See *infra* Section III.F.

<sup>255</sup> See *Marano v. Metro. Museum of Art*, 844 F. App'x 436, 438 (2d Cir. 2021); *Marano v. Metro. Museum of Art*, 472 F. Supp. 3d 76, 85 (S.D.N.Y. 2020), *aff'd*, 844 F. App'x 436.

<sup>256</sup> The court found the Met's use transformative because it concluded that Marano and the Met used the photo for different purposes, the Met used the photo in an educational context, and the photo was not a significant portion of the website. *Marano*, 472 F. Supp. 3d at 84–85; see LINDEY & LANDAU, *supra* note 21 (“To find a ‘transformative use’ where, in reality, nothing is being transformed at all does not ‘promote the Progress of Science . . . It is an attempt to not pay any royalties to the author. The fair use doctrine must be reined in a little.’”).

<sup>257</sup> Compare *Blanch v. Koons*, 467 F.3d 244, 252 (2d Cir. 2006), with *Cariou v. Prince*, 714 F.3d 694, 706 (2d Cir. 2013), and *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 40–41 (2d Cir. 2021), *cert. granted*, 142 S. Ct. 1412 (2022) (mem.).

<sup>258</sup> *Blanch*, 467 F.3d at 252.

<sup>259</sup> See *Cariou*, 714 F.3d at 707.

<sup>260</sup> *Warhol*, 11 F.4th at 40–41 (“[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. Were it otherwise, the law may well ‘recogniz[e] any alteration as transformative.’” (quoting 4 NIMMER & NIMMER, *supra* note 21, § 13.05[B][6])).

<sup>261</sup> *Marano v. Metro. Museum of Art*, 844 F. App'x 436, 438 (2d Cir. 2021).

had in reproducing it.<sup>262</sup> If the *Marano* court had not focused on purpose, it may not have found the Met's use transformative.

The court also diverges on whether the defendant's work must refer directly to the plaintiff's work.<sup>263</sup> The *Authors Guild* and *Capitol Records* unforeseen use cases considered whether the defendant's use comments on, criticizes, or provides information about the plaintiff's work.<sup>264</sup> In *Authors Guild*, the court stated that Google's purpose in reproducing the plaintiffs' works was to provide information *about* those works, finding the use transformative.<sup>265</sup> In *Capitol Records*, the court noted that ReDigi did not transform the plaintiffs' works because it *did not* comment on or provide information about them.<sup>266</sup> Although both of these cases were decided after *Cariou*, in *Warhol*, the court reiterated the *Cariou* court's rejection of the requirement that the defendant's work comment *on* the copyrighted work.<sup>267</sup> Likewise, the *Marano* court rebuffed this same requirement.<sup>268</sup> Therefore, the court sometimes requires the defendant to comment on or provide information about the plaintiff's work and sometimes asserts that the defendant does not need to do so.<sup>269</sup> If the *Marano* court had followed its unforeseen use precedents, it may not have found the Met's use transformative because the museum did not provide commentary or information about the photo.<sup>270</sup>

Also, despite the court's attempts to analogize *Marano* to *Bill Graham*, it did not consider the facts relevant to the transformative inquiry as thoroughly.<sup>271</sup> In *Bill Graham*, the court carefully compared the size of the original works to the reproductions in the book, finding that the works had been significantly reduced in scale and that the defendant reproduced the images at the smallest size needed for the book's

---

<sup>262</sup> *Id.*

<sup>263</sup> Compare *Authors Guild v. Google, Inc.*, 804 F.3d 202, 215–17 (2d Cir. 2015), and *Capitol Records, LLC v. ReDigi Inc.*, 910 F.3d 649, 660–61 (2d Cir. 2018), with *Warhol*, 11 F.4th at 38.

<sup>264</sup> *Authors Guild*, 804 F.3d at 215–16; *Capitol Records*, 910 F.3d at 660–61; see *supra* Section I.B.3.

<sup>265</sup> *Authors Guild*, 804 F.3d at 217.

<sup>266</sup> *Capitol Records*, 910 F.3d at 661.

<sup>267</sup> *Warhol*, 11 F.4th at 38; see *Cariou v. Prince*, 714 F.3d 694, 698 (2d Cir. 2013).

<sup>268</sup> *Marano v. Metro. Museum of Art*, 472 F. Supp. 3d 76, 85 (S.D.N.Y. 2020), *aff'd*, 844 F. App'x 436 (2d Cir. 2021).

<sup>269</sup> Compare *Authors Guild*, 804 F.3d at 217, and *Capitol Records*, 910 F.3d at 661, with *Cariou*, 714 F.3d at 698, and *Warhol*, 11 F.4th at 38, and *Marano*, 472 F. Supp. 3d at 85.

<sup>270</sup> See *Authors Guild*, 804 F.3d at 217; *Capitol Records*, 910 F.3d at 661; *Marano*, 472 F. Supp. 3d at 85.

<sup>271</sup> See LINDEY & LANDAU, *supra* note 21 (stating that *Marano* follows “the illogic” of *Bill Graham*). Compare *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 611 (2d Cir. 2006), with *Marano*, 472 F. Supp. 3d at 85.

purpose.<sup>272</sup> This finding supported the court's conclusion that the defendant's use was transformative.<sup>273</sup> In contrast, in *Marano*, the court failed to consider the original size of the photo, the size at which it was reproduced, and whether the size was appropriate for the website's purpose.<sup>274</sup> It is unclear, therefore, whether the Met's reproduction is sufficiently insignificant to the Met's purpose, which may weigh against transformation.<sup>275</sup>

Next, in analyzing commercial use under the first factor, the *Marano* court did not consider that nonprofit educational uses may nonetheless be commercial uses.<sup>276</sup> A comparison to other cases suggests that the Met's use may have been commercial.<sup>277</sup>

The Supreme Court has held that the proper inquiry for determining whether a use is commercial "is not whether the sole motive of the use is monetary gain but whether the user stands to profit from exploitation of the copyrighted material without paying the customary price."<sup>278</sup> By juxtaposing "monetary gain" with "profit," the Court implied that "profit" means something broader than whether the user benefits financially from the use.<sup>279</sup> The *Marano* court did not consider whether the Met benefitted from the use of the photo other than through direct financial compensation.<sup>280</sup> Other courts have found that educational uses of copyrighted works by nonprofit institutions were commercial because the institutions gained nonfinancial, professional windfalls.<sup>281</sup> A nonprofit educational use is not presumptively fair.<sup>282</sup> Also, the court ignored the fact that the Met did not pay the "customary price" to use the photo.<sup>283</sup> Because reproduction of the photo is typically licensed for a fee, the Met benefitted by not paying for the use.<sup>284</sup> Courts have questioned

---

<sup>272</sup> *Bill Graham*, 448 F.3d at 611 ("[T]he largest reproduction of a BGA image in *Illustrated Trip* is less than . . . 1/20 the size of the original. And no BGA image takes up more than one-eighth of a page in a book or is given more prominence than any other image on the page.").

<sup>273</sup> *Id.*

<sup>274</sup> *See Marano*, 472 F. Supp. 3d at 85.

<sup>275</sup> The court's conclusion that the reproduction was insignificant supported its finding of transformative use. *Id.*

<sup>276</sup> *See id.* at 85–86; *Cambridge Univ. Press v. Patton*, 769 F.3d 1232, 1265–66 (11th Cir. 2014).

<sup>277</sup> *See, e.g., Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 562 (1985); *Cambridge Univ. Press*, 769 F.3d at 1265–66; *Encyc. Britannica Educ. Corp. v. Crooks*, 542 F. Supp. 1156, 1175–76 (W.D.N.Y. 1982).

<sup>278</sup> *Harper & Row*, 471 U.S. at 562.

<sup>279</sup> *Cambridge Univ. Press*, 769 F.3d at 1265–66.

<sup>280</sup> *See Marano*, 472 F. Supp. 3d at 87.

<sup>281</sup> *Cambridge Univ. Press*, 769 F.3d at 1265–66.

<sup>282</sup> *See* 4 NIMMER & NIMMER, *supra* note 21, § 13.05[A][1][c]; *Encyc. Britannica*, 542 F. Supp. at 1175–76.

<sup>283</sup> *See Marano*, 472 F. Supp. 3d at 87.

<sup>284</sup> *See Van Halen File Photos*, *supra* note 186; *Cambridge Univ. Press*, 769 F.3d at 1265–66.

the validity of the customary price inquiry because not paying a fee would prevent any use from being noncommercial.<sup>285</sup> However, the court should not have solely relied on the lack of direct financial benefit and should have considered the broader nonfinancial benefit to the Met. In doing so, the court could have found the use commercial.<sup>286</sup>

### B. *Possibly Factual*

Under the nature of the copyrighted work factor, the court did not consider the possibility that the photo was factual, nor did it explain why the photo was creative.<sup>287</sup> A comparison to other cases reveals that the photo is not necessarily creative.<sup>288</sup>

In finding the photo creative, the court provided little reasoning other than parenthetically noting that photographs of people and events can be creative rather than factual.<sup>289</sup> However, the Second Circuit has not always found photographs documenting people at events creative.<sup>290</sup> In *Harbus v. Manhattan Institute for Policy Research, Inc.*, a professional photographer's image of Andrew Cuomo giving a speech was deemed an informational rather than a creative work.<sup>291</sup> In concluding that the photograph was factual, the court relied on the photographer's statement that the purpose of the image was to show how Cuomo appeared when giving a speech and on the fact that other courts had found photographs for nonaesthetic purposes noncreative works.<sup>292</sup> Further, the court asserted that the plaintiff had made little artistic choice in creating the photo.<sup>293</sup>

Marano similarly stated that the purpose of the photo was to show how Van Halen appeared when performing, and the photo likewise documents a real person at a particular event.<sup>294</sup> Even so, Marano described his creative decisions in making the photo, such as the particular camera used, the vantage point from which the photo was

---

<sup>285</sup> See, e.g., *Cambridge Univ. Press*, 769 F.3d at 1265.

<sup>286</sup> See *id.* at 1265–66.

<sup>287</sup> See *Marano*, 472 F. Supp. 3d at 86; *Marano v. Metro. Museum of Art*, 844 F. App'x 436, 439 (2d Cir. 2021).

<sup>288</sup> See, e.g., *Harbus v. Manhattan Inst. for Pol'y Rsch., Inc.*, No. 19 Civ. 6124, 2020 WL 1990866, at \*15 (S.D.N.Y. Apr. 27, 2020).

<sup>289</sup> *Marano*, 472 F. Supp. 3d at 86.

<sup>290</sup> See, e.g., *Harbus*, 2020 WL 1990866, at \*15.

<sup>291</sup> *Id.*

<sup>292</sup> *Id.*

<sup>293</sup> *Id.* at \*16.

<sup>294</sup> *Marano*, 472 F. Supp. 3d at 84; Brief for Plaintiff-Appellant, *supra* note 184, at 9.

taken, and the lighting.<sup>295</sup> These individual choices were not discussed by the court, even though the Second Circuit describes such choices in other opinions.<sup>296</sup> For example, in *Warhol*, the court explained that Goldsmith selected the cameras used, put makeup on Prince, and chose the lighting, concluding that the photograph was creative.<sup>297</sup> While *Harbus* suggests the possibility that Marano's photo may not be a creative work, *Harbus* nonetheless acknowledged that some photos of people and events may be considered creative works.<sup>298</sup> *Warhol* suggests that the *Marano* court should have explored this question more thoroughly.<sup>299</sup>

### C. Unreasonable Reproduction

Under the amount copied factor, the court did not explain what qualifies as a reduced size nor did it consider the ability of website visitors to enlarge the Photo.<sup>300</sup> These insufficient factual considerations suggest that the Met's reproduction may have been unreasonable.<sup>301</sup>

The court cited *Bill Graham* and *Kelly v. Arriba Soft Corp.*, cases which also involved reproductions of works in their entireties.<sup>302</sup> In *Bill Graham*, by minimizing the image size and quality, the defendant's complete reproduction of the images was reasonable for the purpose of providing historical context.<sup>303</sup> In *Kelly*, the defendant displayed complete images as thumbnails in response to an internet search; clicking on the thumbnails allowed users to enlarge the images.<sup>304</sup> *Kelly* found that showing thumbnails of entire images was necessary to the search engine's purpose.<sup>305</sup> Notably, however, the court did not decide whether the ability to enlarge these images was also necessary.<sup>306</sup> In *Marano*, the court relied on the fact that the photo was reproduced at a reduced size in finding the

---

<sup>295</sup> Memorandum of Law in Response to Order to Show Cause Re: Inapplicability of Fair Use Doctrine at 6, *Marano*, 472 F. Supp. 3d 76 (No. 19-cv-08606).

<sup>296</sup> See *Marano*, 472 F. Supp. 3d 76; *Marano v. Metro. Museum of Art*, 844 F. App'x 436 (2d Cir. 2021); see, e.g., *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 33 (2d Cir. 2021), cert. granted, 142 S. Ct. 1412 (2022) (mem.).

<sup>297</sup> *Warhol*, 11 F.4th at 33, 45.

<sup>298</sup> *Harbus*, 2020 WL 1990866, at \*16.

<sup>299</sup> See *Warhol*, 11 F.4th at 33, 45.

<sup>300</sup> See *Marano*, 472 F. Supp. 3d at 87.

<sup>301</sup> The court supported its conclusion that the Met's reproduction was reasonable by stating that the Met "reduced the size of the Photo." *Id.* at 86–87.

<sup>302</sup> *Id.*

<sup>303</sup> *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 613 (2d Cir. 2006).

<sup>304</sup> *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 821 (9th Cir. 2003).

<sup>305</sup> *Id.*

<sup>306</sup> *Id.*

reproduction reasonable, but it did not explain what it meant by a reduced size.<sup>307</sup> Thus, it is not clear whether this refers to the fact that the photo was a thumbnail or reproduced in smaller dimensions or lower resolution than the original.<sup>308</sup>

The reproductions in *Marano* and *Bill Graham* are not particularly analogous given that printed images in a book cannot be enlarged unlike the photo on the Met's website.<sup>309</sup> Yet, by citing to *Kelly*, the court acknowledged, without fully exploring, the more analogous context of image reproductions on the internet.<sup>310</sup> The fact that the Met reproduced the photo on its website consequently makes this component of the case analogous to an unforeseen use, but the court failed to consider the implications of this technology.<sup>311</sup> The district court's determination that the reproduction of the photo at a reduced size diminished its "visual impact" ignores the fact that the thumbnail can be enlarged.<sup>312</sup> When a visitor to the webpage clicks on the thumbnail, the photo is a substantial portion of the page and the primary visual impact.<sup>313</sup> *Kelly* leaves open the possibility that the ability to enlarge the photo makes the Met's use unreasonable.<sup>314</sup>

#### D. Market Harm

Lastly, in considering the market harm factor, the court incorrectly determined Marano's traditional market and declined to consider his licensing market.<sup>315</sup> A comparison to other cases suggests that Marano's market may have been harmed.<sup>316</sup>

The court fundamentally misunderstood the nature of Marano's profession and his market when it stated that Marano's traditional market

---

<sup>307</sup> See *Marano*, 472 F. Supp. 3d at 86–87.

<sup>308</sup> See *id.* at 87.

<sup>309</sup> See *id.* at 81.

<sup>310</sup> See *id.* at 86–87; *Kelly*, 336 F.3d at 821.

<sup>311</sup> See Samuelson, *supra* note 29, at 2602; *supra* Section I.B.3; *Marano*, 472 F. Supp. 3d at 86–87.

<sup>312</sup> *Marano*, 472 F. Supp. 3d at 87; see *id.* at 81.

<sup>313</sup> See *supra* Figure 1; "Frankenstein," *Composite Electric Guitar*, *supra* note 11.

<sup>314</sup> See *Kelly*, 336 F.3d at 821.

<sup>315</sup> See *Marano*, 472 F. Supp. 3d at 87–88; *Marano v. Metro. Museum of Art*, 844 F. App'x 436, 439 (2d Cir. 2021).

<sup>316</sup> See, e.g., *Am. Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 929–31 (2d Cir. 1994); *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 49–51 (2d Cir. 2021), *cert. granted*, 142 S. Ct. 1412 (2022) (mem.). Even if Marano's market was not harmed, the Met's use would not necessarily be fair. See Leval, *supra* note 56, at 1124 ("The fact that the secondary use does not harm the market for the original gives no assurance that the secondary use is justified.").

is photography collectors of iconic rock musicians.<sup>317</sup> Marano is not a fine art photographer whose traditional market would be photography collectors.<sup>318</sup> As a professional photographer, licensing fees are a traditional market for his work, so his licensing income will be impacted.<sup>319</sup> In fact, licensing fees are how professional photographers monetize their works.<sup>320</sup> Countless photographs by Marano are available to license for a fee from Getty Images, including for noncommercial websites.<sup>321</sup> Had discovery been conducted, information about Marano's licensing market could have been obtained by looking at past licenses for his work through Getty Images.<sup>322</sup> Such information would have allowed the court to better understand Marano's market and if it was harmed.<sup>323</sup>

Courts have been reluctant to find the loss of licensing revenue as evidence of market harm because of a circularity problem: in fair use cases, the defendant could have paid a fee to license the work, but if this means the plaintiff's market was harmed, then this factor would always favor the plaintiff.<sup>324</sup> However, courts have likewise acknowledged that this circularity may be avoided by considering certain markets, including traditional markets.<sup>325</sup> Although the *Marano* court determined incorrectly, and without support, that Marano's traditional market was

---

<sup>317</sup> *Marano*, 472 F. Supp. 3d at 87 (asserting that Marano's traditional market is "collectors of photographs of rock legends or other persons seeking to showcase Van Halen").

<sup>318</sup> By contrast, *Magnum Photos International, Inc. v. Houk Gallery, Inc.* involved the reproduction of photographs by Cartier-Bresson, a "French humanist photographer" (not a professional photographer) whose works were offered for sale by a gallery. No. 16-CV-7030, 2018 WL 4538902, at \*1–2 (S.D.N.Y. Sept. 21, 2018).

<sup>319</sup> See WOLFF, *supra* note 54, at 59 (noting that for professional photographers, "[t]he cash flow derives from licenses for use of the works").

<sup>320</sup> See Declaration, *supra* note 182, at 2; WOLFF, *supra* note 54, at 3 ("[C]opyright is the legal groundwork that ensures the basic *economic return* for [photographers] as much as any technical skill and business savvy. . . . [C]opyright law is . . . part of the photographer's livelihood.").

<sup>321</sup> By *Larry Marano*, GETTY IMAGES, <https://www.gettyimages.com/search/photographer?photographer=larry%20marano&family=editorial&asettype=image&sort=mostpopular> [https://perma.cc/7HEH-6A]8].

<sup>322</sup> For example, in *Michael Grecco Productions, Inc. v. Livingly Media, Inc.*, the court considered evidence regarding whether Getty Images had licensed the plaintiff's photographs and the revenue earned from such licensing in finding market harm. No. 20-CV-00151, 2021 WL 2546749, at \*30–31 (C.D. Cal. Apr. 16, 2021).

<sup>323</sup> In fact, courts have used the pricing information on Getty Images to calculate the amount of damages a plaintiff is owed for copyright infringement; courts use these prices because they are indicative of the fair market value for the use of the work at issue. *Juliff v. Headout, Inc.*, No. 20 Civ. 699, 2021 WL 3887764, at \*4 (S.D.N.Y. Aug. 31, 2021).

<sup>324</sup> See, e.g., *Blanch v. Koons*, 467 F.3d 244, 258 n.9 (2d Cir. 2006) ("And it is of course circular to assert simply that if we were to hold in [Blanch's] favor she could then charge Koons for further use of 'Silk Sandals.'"); see 4 NIMMER & NIMMER, *supra* note 21, § 13.05[A][4] ("A danger of circularity is posed . . . in every fair use case that plaintiff suffers a loss of a *potential* market if that potential is . . . the theoretical market for licensing the very use at bar." (emphasis added)).

<sup>325</sup> See, e.g., *Am. Geophysical Union v. Texaco Inc.*, 60 F.3d 913, 930 (2d Cir. 1994).



not a licensing market, it acknowledged that licensing income for traditional markets should be considered.<sup>326</sup> Therefore, the court left open the possibility for such an inquiry. Moreover, the Second Circuit has explicitly considered licensing markets in analyzing market harm.<sup>327</sup>

For example, in *American Geophysical Union v. Texaco, Inc.*, the court held that the impact on licensing is an appropriate consideration for traditional markets.<sup>328</sup> A licensing scheme existed for photocopies of academic articles, and the court found that unauthorized photocopies were unfair because there was a market for such photocopies and a means to pay for them.<sup>329</sup> Consideration of licensing was thus appropriate because there was a method for licensing.<sup>330</sup> This case is instructive for *Marano*. Licensing is a traditional market for Marano's work, and a licensing scheme exists for reproductions of his photographs through Getty Images.<sup>331</sup> Therefore, the Met's reproduction could be found unfair because there was a market for such reproductions and payment could have been made through the licensing service.<sup>332</sup>

#### E. *A No Man's Land of Fair Use*

Turning to the taxonomy of fair use cases, *Marano* fits into neither the transformative adaptation nor the unforeseen use categories.<sup>333</sup> Although *Marano* involves the use of an existing, expressive work, the photo was not transformatively adapted by the Met into "an expression of artistic imagination."<sup>334</sup> Although *Marano* involves internet use, a use not foreseen at the time of the Copyright Act of 1976, the Met's use does not involve the creation of new technology.<sup>335</sup> Accordingly, *Marano* does not fit within either classification.<sup>336</sup>

---

<sup>326</sup> See *Marano v. Metro. Museum of Art*, 472 F. Supp. 3d 76, 87 (S.D.N.Y. 2020), *aff'd*, 844 F. App'x 436 (2d Cir. 2021).

<sup>327</sup> See, e.g., *Am. Geophysical Union*, 60 F.3d at 929–31; *Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 49–51 (2d Cir. 2021), *cert. granted*, 142 S. Ct. 1412 (2022) (mem.).

<sup>328</sup> *Am. Geophysical Union*, 60 F.3d at 930.

<sup>329</sup> *Id.* at 930–31.

<sup>330</sup> *Id.*

<sup>331</sup> See Declaration, *supra* note 182, at 2; WOLFF, *supra* note 54, at 3; *By Larry Marano, GETTY IMAGES*, *supra* note 321.

<sup>332</sup> See Gibson, *supra* note 18, at 49–50 (noting that a licensing market "militates against a fair use finding").

<sup>333</sup> See Samuelson, *supra* note 29, at 2553–54, 2602.

<sup>334</sup> See *id.* at 2553.

<sup>335</sup> See Deborah R. Gerhardt, *Copyright Publication on the Internet*, 60 IDEA 1, 3 (2020).

<sup>336</sup> *But see Marano v. Metro. Museum of Art*, 472 F. Supp. 3d 76, 83 (S.D.N.Y. 2020) ("The Second Circuit's decision in *Bill Graham* all but decides this case."), *aff'd*, 844 F. App'x 436 (2d Cir. 2021); see Samuelson, *supra* note 29, at 2553, 2602.

In deciding *Marano*, the district court relied heavily upon *Bill Graham*, placing *Marano* into the uses to set historical context category.<sup>337</sup> Indeed, *Marano* fits Samuelson's definition: Marano's copyrighted work was reproduced by the Met, the Met reproduced the photo on its website in creating a nonfiction work about the *Frankenstein* guitar, and the photo was used to provide historical context about this guitar.<sup>338</sup> Although these cases may seem to fit into the same category, they do not fit together neatly. The uses in *Bill Graham* and the documentary film cases provide historical context in a different way than the use in *Marano*.<sup>339</sup> In *Bill Graham*, the posters and ticket were used by the defendant to inform readers more directly.<sup>340</sup> The posters and ticket were from Grateful Dead concerts, and the book was about the Grateful Dead, creating a direct relationship between the plaintiff's and defendant's works.<sup>341</sup> Similarly, in *AMC Productions*, the film clips were from films produced by Nicholson and his colleagues, and the documentary was about them, likewise establishing a direct relationship between the works.<sup>342</sup> In contrast, in *Marano*, the Met argued that the relationship between the photo and the website was less direct; the photo was about Van Halen, but the website was about the *Frankenstein* guitar, creating a more tangential relationship between the works.<sup>343</sup> The direct relationship between the subjects of the original and secondary works in *Bill Graham* and the documentary cases led to the court finding the uses transformative.<sup>344</sup> Inconsistently, the less direct relationship between the subjects of the original and secondary works in *Marano* led to the court finding the use transformative.<sup>345</sup>

Also, *Bill Graham* and the documentary film cases involve uses of the original source material to provide historical context *on the same subject*.<sup>346</sup> Thus, the cases that have been placed into this category other

---

<sup>337</sup> *Marano*, 472 F. Supp. 3d at 83–84; see *supra* Section I.B.1; Samuelson, *supra* note 29, at 2573.

<sup>338</sup> *Marano*, 472 F. Supp. 3d at 80–81; see *supra* Section I.B.1; Samuelson, *supra* note 29, at 2573.

<sup>339</sup> Compare *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 606 (2d Cir. 2006), and *Hofheinz v. AMC Prods., Inc.*, 147 F. Supp. 2d 127, 130, 137 (E.D.N.Y. 2001), with *Marano*, 472 F. Supp. 3d at 84.

<sup>340</sup> *Bill Graham*, 448 F.3d at 606–07.

<sup>341</sup> *Id.*

<sup>342</sup> *AMC Prods.*, 147 F. Supp. 2d at 130, 137.

<sup>343</sup> *Marano*, 472 F. Supp. 3d at 84.

<sup>344</sup> See *Bill Graham*, 448 F.3d at 609; *Hofheinz v. A&E Television Networks*, 146 F. Supp. 2d 442, 446–47 (S.D.N.Y. 2001); *AMC Prods.*, 147 F. Supp. 2d at 137; *Hofheinz v. Discovery Commc'ns, Inc.*, No. 00 Civ. 3802, 2001 WL 1111970, at \*14–15 (S.D.N.Y. Sept. 20, 2001).

<sup>345</sup> *Marano*, 472 F. Supp. 3d at 84–85.

<sup>346</sup> See *Bill Graham*, 448 F.3d at 606–07; *A&E Television Networks*, 146 F. Supp. 2d at 443–44; *AMC Prods.*, 147 F. Supp. 2d at 130; *Hofheinz*, 2001 WL 1111970, at \*2, \*4; see also Samuelson, *supra* note 29, at 2574 (noting that documentary films frequently “illustrate a phenomenon on which their films are focused”).

than *Marano* use the copyrighted work to provide historical context *about* the subject of that work rather than a different subject.<sup>347</sup> This difference does not suggest that *Marano* is more clearly fair use than these other cases, however; in fact, biographical works like those in *Bill Graham* and *AMC Productions* have repeatedly been found fair.<sup>348</sup> *Bill Graham* and two of the documentaries are biographical, but in *Marano*, the Met and the court took pains to assert that the Met's use was decidedly *not* biographical.<sup>349</sup> *Marano* is, therefore, distinguishable from the other cases in this category.

#### F. *The Impact of Warhol and Google*

For future cases like *Marano*, the Supreme Court's forthcoming *Warhol* decision and its recent *Google* decision will serve as precedent. Given that *Warhol* will affect the transformative test and *Google* shifts the emphasis placed on the nature of the copyrighted work, it is worth considering how these decisions might impact similar museum reproduction cases.<sup>350</sup>

Considering the first factor, if the *Warhol* Court upholds its prior conception of transformative as conveying a different meaning or message from the original work, the question of what qualifies as a new meaning or message in a context like *Marano* may remain unanswered.<sup>351</sup> Is asserting that the new work has a different purpose than the original sufficient to establish new meaning, or is placing the work in a new context sufficient to establish a new message?<sup>352</sup> If the Court instead affirms the Second Circuit's holding that meaning may not be considered where the new work visibly stems from the original work, how will this restriction apply to uses like the Met's where the original work is copied

---

<sup>347</sup> Compare *Bill Graham*, 448 F.3d at 606–07, and *A&E Television Networks*, 146 F. Supp. 2d at 443–44, and *AMC Prods.*, 147 F. Supp. 2d at 130, and *Hofheinz*, 2001 WL 1111970, at \*2, \*4, with *Marano*, 472 F. Supp. 3d at 84.

<sup>348</sup> *Bill Graham*, 448 F.3d at 609; *AMC Prods.*, 147 F. Supp. 2d at 137–38.

<sup>349</sup> *Bill Graham*, 448 F.3d at 609; *A&E Television Networks*, 146 F. Supp. 2d at 443; *AMC Prods.*, 147 F. Supp. 2d at 138; *Marano*, 472 F. Supp. 3d at 84, 88; *Marano v. Metro. Museum of Art*, 844 F. App'x 436, 438 (2d Cir. 2021).

<sup>350</sup> Hughes, *supra* note 21 (“It’s clear that the fair use doctrine is actively in flux . . .”).

<sup>351</sup> See SCOTUS BLOG, *supra* note 43.

<sup>352</sup> See *supra* text accompanying notes 204–06; Kyle Jahner, *Justices Search for Middle Way in Warhol-Prince Fair Use Fight*, BLOOMBERG L. (Oct. 17, 2022, 5:20 AM), <https://news.bloomberglaw.com/ip-law/justices-search-for-middle-way-in-warhol-prince-fair-use-fight> [<https://perma.cc/96JN-42UA>] (noting that the court “may clarify whether the key to transformativeness lies in the nature of its content, or in its use”).

exactly?<sup>353</sup> While *Marano*'s focus on purpose and context may be consistent with *Google*, it is unclear how the *Warhol* court's reformulation of what is considered transformative will impact uses similar to the Met's.<sup>354</sup>

In terms of the nature of the copyrighted work, *Google* signals a potential shift in this analysis. In contrast to the little weight afforded to the second factor by other courts, the Supreme Court highlighted its importance.<sup>355</sup> Notably, even though the Court went on to find that *Google*'s use was transformative, it kept the analysis of the first and second factors separate and did not use the finding of transformation to accord greater weight to the conclusion that the second factor weighed in favor of fair use.<sup>356</sup> Therefore, the *Google* opinion suggests not only that the second factor is gaining in importance but also that the second factor should be considered independently of the first.<sup>357</sup> Applying these considerations to *Marano*, the court's finding that the photo was creative could have resulted in a determination that this factor weighed against fair use irrespective of the Met's transformative use.<sup>358</sup> Furthermore, rather than concluding that this factor weighed slightly against fair use—if at all—it could have been given more weight in the overall fair use determination.<sup>359</sup> For forthcoming cases similar to *Marano*, then, the nature of the copyrighted work may be considered independently of transformativeness and may be more influential in the overall fair use outcome.<sup>360</sup>

## CONCLUSION

Even though museums may recognize that there are instances in which they may make fair use of an image, museums tend to seek

---

<sup>353</sup> See SCOTUS BLOG, *supra* note 43; Crawshaw-Sparks, Munkittrick, Shenai-Khatkhate, Sockett & O. Swanson, *supra* note 44 (explaining that the decision “will likely have the most significant impact on the work of appropriation artists”).

<sup>354</sup> Hughes, *supra* note 21 (explaining that “the focus on the changed context of the secondary use” in *Google* may be seen as “consistent with the 2nd Circuit’s analysis in the *Marano* opinion”).

<sup>355</sup> *Google LLC v. Oracle Am., Inc.*, 141 S. Ct. 1183, 1201 (2021); Mark A. Lemley, *Disappearing Content*, 101 B.U.L. REV. 1255, 1270 n.73 (2021) (stating that *Google* “emphasiz[ed] the importance of the second factor,” but this factor “rarely matters at all in some circuits”); 4 NIMMER & NIMMER, *supra* note 21, § 13.05[I][4][a] (explaining that *Google* affords this factor “primary status”).

<sup>356</sup> See *Google*, 141 S. Ct. at 1202–04.

<sup>357</sup> See *id.*

<sup>358</sup> See *Marano v. Metro. Museum of Art*, 472 F. Supp. 3d 76, 86 (S.D.N.Y. 2020), *aff'd*, 844 F. App'x 436 (2d Cir. 2021).

<sup>359</sup> See *id.*

<sup>360</sup> See *Google*, 141 S. Ct. at 1201–02; Lemley, *supra* note 355, at 1270 n.73.

permission to reproduce images generally.<sup>361</sup> In fact, when such an industry-wide custom exists, courts frequently find that breaking with such custom negates the fair use defense.<sup>362</sup> While fair use guidelines circulated by museum organizations note that there are instances in which museums may make fair use of an image, that the statutory factors must be considered, and that legal advice should be sought, these guidelines nonetheless rely on existing case law to predict the types of uses that will or will not be considered fair.<sup>363</sup> Contrary to predictions that a “test case” for fair use by museums would not emerge, *Marano* is the test case.<sup>364</sup> *Marano* is the first fair use case involving the unauthorized reproduction of a copyrighted work by a museum.<sup>365</sup> Accordingly, it is not difficult to foresee that the next round of updates to these guidelines will include *Marano* and that museums will in fact rely on the most on-point case to date.<sup>366</sup> However, because the Met’s reproduction was disputably transformative, reasonable, and not harmful to Marano’s market, the reproduction could have been found unfair.<sup>367</sup> Accordingly, future reliance on *Marano* by museums may be misguided.

*Marano* exemplifies inconsistencies in the Second Circuit’s fair use jurisprudence generally and within the historical context category in particular.<sup>368</sup> The court failed to consider the implications of internet reproduction, associating *Marano* too closely with transformative adaptations rather than unforeseen uses.<sup>369</sup> In comparison, museum guidelines recognize the significance of the shift to online practices.<sup>370</sup> They recommend more thorough considerations for the fair use of online images than those undertaken by the court, such as suggesting that the more information the webpage contains about the work, the larger the

---

<sup>361</sup> ASS’N OF ART MUSEUM DIRS., *supra* note 2, at 4–5, 10.

<sup>362</sup> Jennifer E. Rothman, *The Questionable Use of Custom in Intellectual Property*, 93 VA. L. REV. 1899, 1902 (2007) (“[C]ourts often consider nonconformity with an industry’s clearance practices as a basis to reject any defense to the use of another’s IP without the explicit consent of the IP owner.”).

<sup>363</sup> See ASS’N OF ART MUSEUM DIRS., *supra* note 2, at 5–7, 13–14, 34–37.

<sup>364</sup> See Chandler, *supra* note 1, at 75–76.

<sup>365</sup> See ASS’N OF ART MUSEUM DIRS., *supra* note 2, at 10.

<sup>366</sup> See Amelia K. Brankov, *Copyright Considerations as Art Galleries and Museums Move Online in the Wake of Covid-19*, 93 N.Y. ST. BAR J. 44, 46 (2021) (stating that *Marano* supports the view in the Association of Art Museum Directors’ guidelines that “the reproduction of thumbnail-size images of works in a searchable database is fair use”).

<sup>367</sup> See *supra* Sections I.A, I.C, II.C.5, III.A–III.B, III.D.

<sup>368</sup> See *supra* Sections III.A–III.E.

<sup>369</sup> See *supra* Section III.A.

<sup>370</sup> See ASS’N OF ART MUSEUM DIRS., *supra* note 2, at 4; COLLEGE ART ASS’N, *supra* note 1, at 6.

image that may be reproduced.<sup>371</sup> Moreover, unlike the other uses to set historical context, the court pettifogged to find the Met's use transformative.<sup>372</sup> Because the Supreme Court denied certiorari, the inconsistencies of uses to set historical context will remain unresolved.<sup>373</sup> As *Marano* involves both visual art and technology, the resolution of analogous cases lies somewhere in between *Warhol* and *Google*.<sup>374</sup>

---

<sup>371</sup> See ASS'N OF ART MUSEUM DIRS., *supra* note 2, at 12–13; COLLEGE ART ASS'N, *supra* note 1, at 12; see also Brankov, *supra* note 366, at 46 (noting that the “approach to fair use” in museum guidelines is “more nuanced” than the approach in *Marano*).

<sup>372</sup> See *supra* Section III.A.

<sup>373</sup> *Marano v. Metro. Museum of Art*, 142 S. Ct. 213 (2021) (mem.).

<sup>374</sup> See Q&A: *With Warhol Foundation v. Goldsmith on the Supreme Court Docket*, Amy Adler Discusses Fair Use in Contemporary Art Law, NYU L.: NEWS (Aug. 10, 2022), <https://www.law.nyu.edu/news/-amy-adler-warhol-goldsmith-art-law> [<https://perma.cc/L764-KMSR>] (“The implications of [*Warhol*] are not just for visual art; the implications are for creativity itself.”); 4 NIMMER & NIMMER, *supra* note 21, § 13.05[1][6][d] (explaining that “[m]any implications of [*Google*] are readily generalizable to other classes of works” aside from software).