Jordan Fletcher
FLETCHER LAW PLLC
246 Fifth Avenue, 3rd Floor
New York, NY 10001
Tel: (212) 320-8945
Fax: (347) 983-0046
jordan@fletcherlaw.co

Linda Joy Kattwinkel (admitted *pro hac vice*)
OWEN, WICKERSHAM & ERICKSON, P.C.
One Concord Center
2300 Clayton Road, Suite 1400
Concord, CA 94520
Tel: (415) 882-3200
ljk@owe.com

Attorneys for Plaintiff Michael A. Hayden

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

MICHAEL A. HAYDEN,	:	Case No. 21 Civ. 10249 (TMR)
	:	
Plaintiff,	:	
v.	:	
	:	
JEFF KOONS and JEFF KOONS LLC,	:	
	:	
Defendants.	:	
	:	

PLAINTIFF MICHAEL A. HAYDEN'S
SUPPLEMENTAL MEMORANDUM OF LAW IN FURTHER SUPPORT OF MOTION FOR SUMMARY JUDGMENT AND IN OPPOSITION TO DEFENDANTS' CROSS MOTION FOR SUMMARY JUDGMENT IN LIGHT OF
THE ANDY WARHOL FOUNDATION FOR THE VISUAL ARTS, INC. v. GOLDSMITH

TABLE OF CONTENTS

TABLE OF AUTHORITIES

Cases

Statutes

Treatises

PRELMINARY STATEMENT

In his previous briefing on summary judgment, plaintiff Michael Hayden relied heavily on the Second Circuit's decision in *The Andy Warhol Foundation for Visual Arts v. Goldsmith*, 11 F.4th 26 (2d Cir. 2021) (hereinafter cited as "*AWF*"). In its May 18, 2023 decision (hereinafter cited as "*Warhol*"), the Supreme Court affirmed the Court of Appeals' determination that the first fair use factor weighed against fair use and instead favored defendant-appellee, *i.e.*, the original photographer in that case, Lynn Goldsmith. Writing for the 7-2 majority, Justice Sotomayor also took the opportunity to clarify the first factor test.

Warhol overwhelmingly supports Hayden's motion for summary judgment and shatters defendants Jeff Koons and Jeff Koons LLC's (together, "Defendants") fair use defense. Several key aspects of Justice Sotomayor's opinion bear noting.

First, the *Warhol* Court addressed the first fair use factor, only. *See The Andy Warhol Foundation for Visual Arts v. Goldsmith*, 598 U.S. ___, 143 S.Ct. 1258, 1273-74 (2023) (Sotomayor, J.) (*i.e.*, "*Warhol*"). This leaves the Second Circuit's analysis – and Hayden's prior briefing – with respect to the second, third, and fourth fair use factors intact and unchanged.

Second, the first factor focuses on whether and to what extent the "purpose and character" of a second author's allegedly-infringing use matches that of the original author. In *Warhol*, Justice Sotomayor defined the purposes of the two works at issue narrowly as "portraits of [the musician] Prince used to depict Prince in magazine stories about Prince." *Id.* at 1273; *see also id.* at 1278. Similarly, here, the purpose of Koons' use of Hayden's original serpent-and-boulder sculpture (the "Hayden Work") in the follow-on *Made in Heaven* series was exactly the same as Hayden's original purpose: to serve as a creative set piece on which Ilona Staller would engage in sexually-explicit poses and performances, surrounded by her usual backdrops and wearing her usual

costumes.

Third, the *Warhol* Court underlined the importance of protecting an original author's exclusive right to prepare derivative works. Consequently, fair use cannot trump Hayden's right to create new versions or adaptations of the original Hayden Work in other media, colors, or sizes, or for different types of artistic audiences.

Fourth, a second author's claim to have added "new meaning" to an original work is not, without more, sufficient to render the secondary use "fair." This is particularly the case where the purported new meaning does not act in service of one of the traditional fair use purposes listed in the Copyright Act, such as news reporting, scholarship, research, or criticism directed at the original work. Therefore, the first fair use factor weighs against Koons, here, given that any purported social criticism in which Koons' *Made in Heaven* works engaged was (a) indistinguishable from the social criticism embodied in Ms. Staller's own art, for which the Hayden Work was created; and (b) not targeted at the Hayden Work, Ms. Staller, or her worldview.

Fifth, copyright law does not afford a "celebrity privilege" to famous appropriation artists simply because of their fame. Thus, calling a second work a "Warhol" – or, in the case at bar, a "Koons" – does not make it transformative for fair use purposes.

Finally, a second work's commercial character is relevant to the fair use analysis. Thus, the status of Koons' *Made in Heaven* works as "high-priced art," *cf. Rogers v. Koons*, 960 F.2d 306, 312 (2d Cir. 1992), *cert. denied,* 506 U.S. 934 (1992), further supports a first-factor finding against fair use, particularly where the purpose of Koons' second use was functionally identical to the original purpose of the Hayden Work.

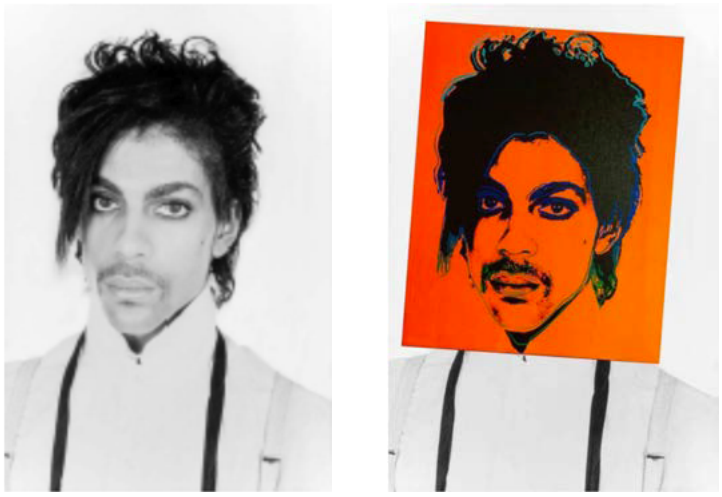
ARGUMENT

A. *Warhol*'s "Purpose of the Use" Test Favors Hayden

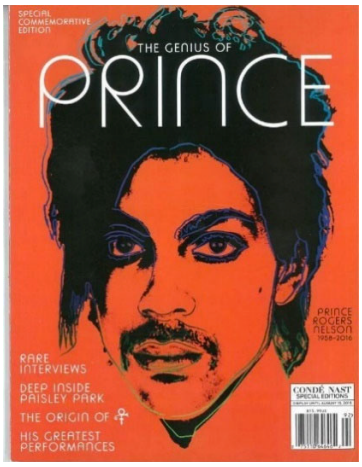
1. The First Factor "Purpose of Use" Test Under *Warhol*

The *Warhol* Court held unequivocally that the first fair use factor "asks whether *and to what extent* the [allegedly infringing] use at issue has a purpose or character different from the original [work]." *Warhol*, 143 S.Ct. at 1275 (quoting *Campbell v. Acuff-Rose Music Inc.*, 510 U.S. 569, 579 (1994)) (emphasis in original) (quotation marks omitted). This difference is always a "matter of degree." *Id*. "The larger the difference, the more likely the first factor weighs in favor of fair use. The smaller the difference, the less likely." *Id*. Indeed, "the use of an original work to achieve a purpose that is the same as, or highly similar to, that of the original work is more likely to substitute for, or supplant, the [original] work," *id.* at 1274 (internal punctuation and quotation marks omitted), and "undermines the goal of copyright." *Id.* at 1276. Although "[m]ost copying has some further purpose, in the sense that copying is socially useful *ex post*, [and] [m]any secondary works add something new," the *Warhol* majority emphasized, "[t]hat alone does not render such uses fair." *Id.* at 1275.

The *Warhol* Court defined the purpose of the works before it narrowly. Whereas the Court of Appeals had stated that "purpose and function of the two works at issue . . . is identical, not merely in the broad sense that they are created as works of visual art, but also in the narrow but essential sense that they are portraits of the same person," *id.* at 1279 n.11 (quoting *AWF*, 11. F.4th at 42), the Supreme Court went even "further," holding that, "in the context of the particular use at issue," *id.*, both works were "portraits of Prince used to depict Prince in magazine stories about Prince." *Id.* at 1273; *see also id.* at 1278.



At left: Goldsmith's original portrait photograph.
At right: Warhol's orange silkscreen portrait of Prince
superimposed on Goldsmith's original. *Warhol*, 143 S.Ct. at 1271 (Figure 6).



The challenged "Orange Prince" Warhol use, displayed on the cover of a
Conde Nast special edition magazine after Prince's death in 2016. *Warhol*, 143 S.Ct. at 1270 (Figure 5).

The original Goldsmith photograph and AWF's copying use of it therefore "share[d] substantially the same purpose." *Id.* at 1273, 1280. Even if, as AWF argued, Warhol's secondary image portrayed Prince in a somewhat different expressive light than Goldsmith's original photograph (*i.e.*, "iconic" vs. "photorealistic"), the Court held that "that degree of difference is not enough for the first factor to favor AWF." *Id.* at 1285.

Crucially, the *Warhol* majority reaffirmed the importance of a copyright owner's derivative

rights. Under the Copyright Act, a copyright owner has "the exclusive right" to prepare "derivative works" from their original work, in "any other form in which a work may be recast, transformed, or adapted." *Id.* at 1275 (quoting 17 U.S.C. §§ 101 and 106(2)). The *Warhol* Court observed that, although a "use that has a further purpose or different character is said to be 'transformative,'" an "overbroad concept of transformative use, one that includes any further purpose, or any different character, would narrow the copyright owner's exclusive right to create derivative works." *Id.* In order to "preserve that right, the degree of transformation required to make 'transformative' use of an original must go beyond that required to qualify as a derivative." *Id*. Indeed, derivative work transformations "may be substantial, like the adaptation of a book into a movie." *Id*. Such an adaptation "might win awards for its significant creative contribution; alter the meaning of a classic novel; and add important new expression, such as images, performances, original music, and lyrics." *Id.* at 1282 (internal punctuation omitted). But, the *Warhol* Court observed, "that does not in itself dispense with the need for licensing." *Id.*

2. The Purpose of Koons' Use Weighs Against Fair Use

Here, the *Warhol* Court's explication of the "purpose of the use" portion of the first fair use factor overwhelmingly favors Hayden. As Hayden has already noted in his prior briefing, Koons used the Hayden Work for the *exact same* purpose it was meant for, in the exact same way it was meant to be used: as a creative set piece on which Ilona Staller (*i.e.*, "Cicciolina") would engage in sexual poses and performances, alone and with others.[1]

[1] In this respect, Koons' use here was entirely unlike the "recontextualize[d]" collage use he made of the magazine article raw materials at issue in *Blanch v. Koons*, 467 F.3d 244, 247 (2d Cir. 2006). Koons did not, *e.g.*, chop up the Hayden Work and turn it into a two-dimensional mosaic of storm clouds, nor did he repurpose Hayden's serpent-and-boulders as, *e.g.*, an ice cream truck. Rather, Hayden created a serpent-and-boulders platform for Ms. Staller to perform sex acts on, alone and with others, and Koons used the Hayden Work as a serpent-and-boulders platform on which Ms. Staller performed sex acts with Koons.

To the extent Koons argues that he repurposed Hayden's sculpture – which was created to be displayed and used in Ms. Staller's live stage and film performances – into fine artworks for display in galleries, museums, and on billboards, that new purpose falls well within the scope of Hayden's exclusive derivative rights. Similarly, Koons' purported addition of a new stylistic "mood," or his recasting of Hayden's three-dimensional Styrofoam, gauze, plaster, and paint sculpture into a two-dimensional lithograph billboard; two-dimensional oil-on-canvas painting; and a three-dimensional wood and paint sculpture, all fall well within the scope of Hayden's derivative works rights.

For all these reasons, the "purpose of the use" test weighs heavily in favor of Hayden and against fair use.

B. Any New Meaning in the Koons Works Is Insufficient to Prevail on the First Factor

While Koons has argued extensively that his copies added new meaning to the Hayden Work, *see* Defs' MSJ Br. (ECF 65 at 20-12), the *Warhol* Court affirmed the Second Circuit's holding that "the bare assertion of a 'higher or different artistic use' is insufficient to render a work transformative." *AWF*, 11 F.4th at 411. Indeed, Justice Sotomayor stated clearly that, although new expression, meaning or message may be relevant to whether a copyright use has a sufficiently distinct purpose or character, it is not, without more, dispositive of the first factor. *Warhol*, 143 S.Ct. at 1273. The Court held that the first fair use factor *cannot* be understood to weigh in favor "of any use that adds some new expression, meaning, or message. Otherwise, 'transformative use' would swallow the copyright owner's exclusive right to prepare derivative works." *Id.* at 1282. This is because "[m]any derivative works, including musical arrangements, film and stage adaptations, sequels, spinoffs, and others that recast, transform or adapt the original, add new

expression meaning, or message, or provide new information, new aesthetics, new insights and understandings." *Id.* (internal quotation marks and punctuation omitted).

Thus, absent a new or substantially different purpose, Koons' self-serving claims that he imbued the Hayden Work with novel Garden of Eden symbolism and elevated aesthetics or meaning do not support a finding in favor of fair use on the first factor.[2] *Id.* at 1286 ("[a] secondary author is not necessarily at liberty to make wholesale takings of the original author's expression merely because of how well the original author's expression would convey the secondary author's different message." (quoting *Authors Guild v. Google, Inc.*, 804 F.3d 202, 215 (2d Cir. 2015))). *See also id.* at 1285 ("[t]he application of an artist's characteristic style to bring out a particular meaning that was available in the [original work] is less likely to constitute a further purpose."). In fact, the *Warhol* Court confirmed that the subjective intent of a second artist – *i.e.*, Koons, here – is not relevant to the first factor analysis at all. *Id.* at 1284 ("The Court of Appeals noted, correctly, that 'whether 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… [O]therwise, the law may well "recogniz[e] any alteration as transformative."'" (quoting *AWF*, 11 F.4th at 41 (quoting 4 Nimmer, Copyright §13.05(B)(6)))). "Whether the purpose and character of a use weighs in favor of fair use is, instead, an objective inquiry into what use was made, *i.e.*, what the user does with the original work." *Id.*

The types of objectively-manifested meanings that tend to demonstrate a new purpose for fair use are those specified in the section 107 of the Copyright Act: criticism, comment, news reporting, teaching, scholarship, or research. *Id.* at 1273. Yet, even criticism or commentary, when

[2] Hayden has previously shown that objectively apparent meanings in Koons' *Made in Heaven* works replicated the meanings embodied in Ms. Staller's performance art, for which the Hayden Work was originally created and used. *See* Pl.'s MSJ Br. (ECF 54) at 19-20.

they have "no critical bearing on the substance or style of the original composition," possess a "claim to fairness in borrowing" that "diminishes accordingly (if it does not vanish)" altogether. *Id.* at 1276.

Here, while Koons claims to have been engaged in commentary on society at large, he also admits that his *Made in Heaven* works were not parody, nor were they intended to be critical of Ms. Staller, her work, or the Hayden Work. *See* Def's Resp. to Pl.'s 56.1 (ECF 64) ¶ 105. Thus, just like AWF's claim that Warhol's "Orange Prince" work was intended as commentary on celebrity in the role of society at large, rather than an attack on Goldsmith's original photograph, Koons' supposed commentary in his *Made in Heaven* works falls at the first factor's "lowest ebb."[3] *Id.* at 1285. *See also id.* at 1286 n.21 ("Although targeting [of the original work] is not always required, fair use is an affirmative defense, and [the second author] bears the burden to justify its taking of [the original author's] work with some reason other than, 'I can make it better.'"). "An independent justification like this [*i.e.*, where "copying is reasonably necessary to achieve the new user's purpose"] is particularly relevant to assessing fair use where an original work and copying use share the same or highly similar purposes, or where wide dissemination of a secondary work would otherwise run the risk of substitution for the original or licensed derivatives of it." *Id.* at 1277. Koons, however, admitted that he believed he was able to achieve the artistic and critical purposes of his *Made in Heaven* works without using the Hayden Work at all. *See* Pl.'s 56.1 (ECF 55) ¶¶ 98-99 (Koons admitted that he was able to communicate his message successfully in 24 of 30 *Made in Heaven* that did not depict the Hayden Work). *See also Graham v. Prince*, 15 Civ. 10160, 2023 WL 3383029, *13 (S.D.N.Y. May 11, 2023) (holding that appropriation artist Richard

[3] For this reason, Koons's assertion that he intended to engage in a dialogue with traditional depictions of Adam and Eve contained in other artworks, such as Massacio's *Expulsion of Adam and Eve from Eden*, does not support to his fair use defense, here.

Prince's fine art prints, which reproduced other individuals' Instagram photographs, were not transformative) ("[Defendant admits that he] could have used many other images of Rastafarians . . . and it would have had the same visual impact or value as the Rastafarian in [plaintiff's original photograph]. . . . [This] suggests that [Prince's] commentary has no critical bearing on the substance or style of the original composition.") (quoting *Campbell*, 510 U.S. at 580 and citing *Authors Guild*, 804 F.3d at 215) (internal quotation marks omitted).

Finally, like the Court of Appeals before it, the *Warhol* Court explicitly rejected a "celebrity-plagiarist privilege" in copyright law that considers a work to be "transformative" merely because of the fame of the secondary author, or because the viewing public might prefer the aesthetics or message of the second work over the first. *Warhol*, 143 S.Ct. at 1272, 1284 n.19, *id*. at 1278 n.11. *See also id.* at 1272 ("[T]he fact that Martin Scorsese's recent film *The Irishman* is recognizably 'a Scorsese' does not absolve him of the obligation to license the original book." (quoting *AWF*, 11 F.4th at 43); *id.* at 1284 n.19 ("A court need not, indeed should not, assess the relative worth of two works to decide a claim of fair use. Otherwise, some works of genius would be sure to miss appreciation, and, [a]t the other end, copyright would be denied to [works] which appealed to a public less educated than the judge.").

C. <u>The Commercial Nature of the Koons Works Weighs Against Fair Use</u>

Finally, the commercial nature of Koons' *Made in Heaven* works weighs against fair use.

In *Warhol*, Justice Sotomayor confirmed the continuing relevance of a second work's commercial nature to the fair use analysis. *Id.* at 1276 ("[T]he fact that a use is commercial as opposed to nonprofit is an additional element of the first fair use factor." (quotation marks omitted)). Specifically, the *Warhol* Court held that, "[i]f an original work and a secondary use share the same or highly similar purposes, and the secondary use is of a commercial nature, the

first factor is likely to weigh against fair use, absent some other justification for copying." *Id.* at 1277. *See also id.* at 1280 ([T]he undisputed commercial character of AWF's use, though not dispositive, tends to weigh against a finding of fair use." (quotation marks omitted)).

Similarly, here, the commercial nature of Koons' *Made in Heaven* works – which Defendants have conceded, *see* Defs' Resp. to Pl.'s 56.1 (ECF 64) ¶¶ 82-85, 87-88 – weighs against fair use.[4]

D. Summary

Based on all the foregoing, given that (a) Koons' use of the Hayden Work in his *Made in Heaven* series shared the same, or highly similar purpose, to the purpose of the Hayden Work, and (b) Koons' use had a commercial character, the first fair use factor continues to weigh heavily against fair use under the Supreme Court's ruling in *Warhol*.

The analysis of the three other fair use factors remains unchanged from the *Warhol* Court Appeals' formulation, and each of those also weigh against fair use.

CONCLUSION

For all the reasons discussed above, the Court should grant Plaintiff's motion for summary judgment in its entirety.

[4] Although the *Warhol* Court explicitly declined to decide whether its ruling applied to sales or displays of Warhol's original fine arts works – *i.e.*, as opposed to the specific magazine licensing use before the Court, *see id.* at 1277-78, numerous courts, including the Second Circuit, have consistently found that such fine arts uses are obviously commercial. *See*, *e.g., Rogers*, 960 F.2d at 312 (holding Koons' fine arts sculpture displayed and sold in galleries was "primarily commercial in nature."); *Cariou v. Prince*, 714 F.3d 694, 706 (2d Cir. 2013), *cert. denied*, 571 U.S. 1018, U.S. (2013) (there is no question that [Richard] Prince's [fine arts works sold in galleries] are commercial."); *Graham*, 2023 WL 3383029 at *14 (finding fine art prints to be commercial use) ("The core concern addressed by this [commercial use] sub-factor is 'the unfairness that arises when a secondary user makes unauthorized use of copyrighted material to capture significant revenues as a direct consequence of copying the original work.'" (quoting *Blanch*, 467 F.3d at 253)).

Dated: New York, New York
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FLETCHER LAW, PLLC

By: _____

Jordan Fletcher
246 Fifth Avenue, 3rd Floor
New York, NY 10001
jordan@fletcherlaw.co
(212) 320-8945
Counsel for Plaintiff Michael A. Hayden

OWEN, WICKERSHAM & ERICKSON, P.C.

Linda Joy Kattwinkel (admitted *pro hac vice*)
One Concord Center
2300 Clayton Road, Suite 1400
Concord, CA 94520
ljk@owe.com
(415) 882-3200
Counsel for Plaintiff Michael A. Hayden