

## The Role of Transformative Use: *Revisiting the Fourth Circuit's Fair Use Opinions in Bouchat v. Baltimore Ravens*

JASON M. NOLAN<sup>†</sup>

### ABSTRACT

The Fourth Circuit opinion in *Bouchat v. Baltimore Ravens* illustrates the important role of copyright law's transformative use doctrine in fair use cases. A secondary use of a copyrighted work is transformative if the work was employed in a different manner or for a different purpose. The majority opinion found the use of plaintiff's work in documentary films of the Ravens to be non-transformative and therefore infringing, whereas the dissenting and district court judges found the use to be transformative and as such a fair use.

To determine which opinion is more persuasive, this article reviews the history of transformative use, its application in recent case law, and two alternative fair use tests proposed by scholars. This article concludes that *Bouchat* was decided incorrectly and that the dissenting opinion properly characterized the plaintiff's work as a historical artifact, which the defendants used out of necessity in order to create accurate documentaries.

---

© 2010 Virginia Journal of Law & Technology Association, at <http://www.vjolt.net>.

<sup>†</sup> Patent Examiner, U.S. Patent and Trademark Office, Alexandria, VA; Ph.D., North Carolina State University, 2003; B.S., St. Lawrence University, 1998; J.D. candidate, The Catholic University of America Columbus School of Law, 2012. I gratefully acknowledge the help of the Honorable E.J. Damich, U.S. Court of Federal Claims, Distinguished Lecturer, The Catholic University of America Columbus School of Law. The views in this article are those of the author and do not necessarily reflect the views of the U.S. Patent and Trademark Office.

## TABLE OF CONTENTS

I.	Introduction.....	542
II.	The Doctrines of Fair Use and Transformative Use .....	548
	A. The Doctrine of Fair Use .....	549
	B. The Doctrine of Transformative Use.....	550
	1. Illustrations of Transformative Use .....	553
	2. Illustrations of Non-Transformative Use .....	555
	3. Transformative Use as Distinct from Derivative Works.....	556
	C. Empirical Studies of Transformative Use and Fair Use.....	557
	1. Purpose is Dispositive of Transformativeness .....	557
	2. Transformativeness is Dispositive of Fair Use .....	558
III.	Critiques and Proposals for Fair use Reform.....	559
	A. Analysis from the Perspective of the Audience .....	561
	B. Analysis from the Perspective of the Author .....	562
IV.	The Role of Transformative Use in Recent Case Law .....	563
	A. A Summary of Transformative Use in Case Law .....	564
	B. A Summary of Transformative Use Legal Theories.....	569
	C. A Summary of Transformative Use in the Fourth Circuit .....	570
V.	Revisiting <i>Bouchat v. Baltimore Ravens</i> .....	571
	A. In View of Recent Case Law .....	571
	B. In View of Non-Transformative Fair Use Tests .....	572
	C. In View of Necessity.....	573
	D. In View of the Derivative Work Right.....	574
VI.	Conclusion .....	574



### I. INTRODUCTION

In 1995, Art Modell, then owner of the Cleveland Browns of the National Football League (NFL), announced that he had made a deal with the city of Baltimore to move his football club from Cleveland.<sup>1</sup> Subsequently, the city of Cleveland, among others, filed suit to prevent Modell from taking the club to Baltimore.<sup>2</sup> After extensive negotiations between the NFL, the Browns, and officials from each city, a settlement was reached: the NFL approved the franchise move but stipulated that Cleveland was to retain the Browns' name, colors, and history.<sup>3</sup> Following the settlement, the Baltimore Sun conducted a telephone poll enabling the fans to select a new mascot and nickname for

---

<sup>1</sup>*Baltimore Ravens*, SPORTS ENCYCLOPEDIA, <http://www.sportsecyclopedia.com/nfl/baltrav/ravens.html> (last visited Nov. 8, 2011).

<sup>2</sup>*Id.* See also Jon Morgan, *Deal Clears NFL Path to Baltimore*, BALT. SUN, Feb. 9, 1996, available at <http://www.baltimoresun.com/sports/ravens/bal-modell020996,1,2346653.story> (last visited Nov. 8, 2011) (“The city sought to force the Browns to play the final three seasons of their lease at Cleveland Stadium.”).

<sup>3</sup> Cleveland also retained the Browns' records, awards, and archives. For a summary of the settlement deal, see Morgan, *supra* note 2.

Baltimore's new football club.<sup>4</sup> The Baltimore fans selected *Ravens* in honor of Edgar Allan Poe, the American poet who penned *The Raven* while living in Baltimore.<sup>5</sup>

In his excitement about the new football team, Frederick Bouchat, an amateur artist working as a security guard at a State of Maryland office building in Baltimore, created drawings and designs of what he envisioned as the Ravens helmet logo.<sup>6</sup> Bouchat gave one of his designs to Eugene Conti, a state official working in the same building, and Conti arranged a meeting between Bouchat and John Moag, the chairman of the Maryland Stadium Authority (MSA).<sup>7</sup> At that meeting, Moag was interested in Bouchat's drawings and instructed him to send a few to the MSA for consideration.<sup>8</sup> One of the drawings faxed to the MSA was Bouchat's *Shield Drawing*: a picture of a raven with its wings spread and in its beak a shield displaying the word "RAVENS," a stylized letter "B," and the Maryland state flag.<sup>9</sup>

In 1996, David Modell, a Ravens executive, discussed the development of a Ravens logo with the design director of NFL Properties.<sup>10</sup> Subsequently, the Ravens unveiled their new *Flying B Logo*,<sup>11</sup> which was recognized by Bouchat and his co-workers as Bouchat's design.<sup>12</sup> Bouchat obtained copyright registration for his *Shield Drawing* and filed suit against the Ravens and NFL Properties<sup>13</sup> for infringing his copyright with their *Flying B Logo*.<sup>14</sup>

Over the past decade Bouchat and the Ravens have litigated several claims of copyright infringement.<sup>15</sup> Although the Ravens and the NFL have not used the *Flying B*

---

<sup>4</sup>Baltimore Ravens Football History, [http://www.baltimoreravens.com/News/History/Baltimore\\_Football\\_History.aspx](http://www.baltimoreravens.com/News/History/Baltimore_Football_History.aspx) (last visited Nov. 8, 2011).

<sup>5</sup> *Baltimore Ravens*, *supra* note 1. For a history of Baltimore's professional football teams, *see* Bouchat v. Balt. Ravens Ltd. P'ship, 587 F. Supp. 2d 686, 688-692 (D. Md. 2008) (discussing the Baltimore Colts of the NFL (1947-52 and 1953-84), the Baltimore Stars of the United States Football League (1985), the Baltimore Bombers (denied as a NFL expansion team), and the Baltimore Colts/Stallions of the Canadian Football League (1994-1995)).

<sup>6</sup> Bouchat v. Balt. Ravens, Inc., 241 F.3d 350, 352 (4th Cir. 2001).

<sup>7</sup> *Id.* at 352-53.

<sup>8</sup> *Id.* at 353.

<sup>9</sup> *See, e.g.*, Bouchat v. Balt. Ravens, Inc., 215 F. Supp. 2d 611, 613 (D. Md. 2002) (depicting Bouchat's *Shield Drawing*).

<sup>10</sup> *Bouchat*, 241 F.3d at 353.

<sup>11</sup> *See Bouchat*, 215 F. Supp. 2d at 614 (depicting the Ravens' Flying B Logo).

<sup>12</sup> *Bouchat*, 241 F.3d at 353.

<sup>13</sup> The NFL is an unincorporated association of thirty two separately owned professional football teams. The teams, each of which owns its own name, colors, logos, trademarks, and related intellectual property, formed NFL Properties, LLC to develop, license, and market that property. *See, e.g.*, Am. Needle v. Nat'l Football League, 130 U.S. 2201 (2010).

<sup>14</sup> *Bouchat*, 241 F.3d at 353.

<sup>15</sup> *Bouchat*, 215 F. Supp. 2d at 614; Bouchat v. Balt. Ravens Ltd. P'ship, 587 F. Supp. 2d 686, 693-94 (D. Md. 2008); Bouchat v. Balt. Ravens, Inc., 228 F.3d 489 (4th Cir. 2000); Bouchat v. Balt. Ravens Ltd. P'ship, 346 F.3d 514, 516-18 (4th Cir. 2003); Bouchat v. Balt. Ravens, 506 F.3d 315, 324-26 (4th Cir. 2007). For a review of Bouchat's early lawsuits against the Baltimore Ravens, *see* M. Brent Byars, Bouchat v. Bon-ton Department Stores, Inc.: *Claim Preclusion, Copyright Law, and Massive Infringements*, 21 HARV. J.L. & TECH. 609, 611 (2008) ("[F]uture courts should exercise caution because of the unique factual circumstances of the *Bouchat* litigation; courts should not erroneously rely on any precedent these

*Logo* on uniforms or playing fields since 1998, the *Flying B Logo* is currently visible on team memorabilia and in video highlight films of the Baltimore Ravens first three seasons (1996–1998).<sup>16</sup> In *Bouchat v. Baltimore Ravens Ltd. Partnership*, the most recent battle of this legal saga in the U.S. Court of Appeals for the Fourth Circuit, one issue involved whether the continued use of the *Flying B Logo* in the season highlight films and in photos of players wearing team memorabilia that are displayed in the Ravens' corporate lobby were copyright infringements or fair use.<sup>17</sup> Having been denied actual damages in previous suits,<sup>18</sup> and unable to seek statutory damages,<sup>19</sup> Bouchat sought an injunction that would prevent the aforementioned displays of the *Flying B Logo* in addition to an order for the destruction of those items on which the *Flying B Logo* appears.<sup>20</sup>

In a fair use analysis, a court must evaluate the alleged infringing work (“secondary use”) in light of the copyrighted work (“original”) under the four factors set forth in 17 U.S.C. § 107.<sup>21</sup> The doctrine of transformative use is part of the first fair use factor, which probes the purpose and character of the secondary use.<sup>22</sup> A court must consider the purpose of the original use, the purpose of the secondary use, and then ascertain whether there is a distinction between the two purposes.<sup>23</sup> Further, a court must consider whether a defendant’s secondary use of a copyrighted work *adds something new* to the original; in other words, whether the defendant transformed the original purpose. A use is transformative if it “employ[s] the quoted matter in a different manner or for a different purpose from the original.”<sup>24</sup> More often than not, when a court determines that a secondary use is transformative, it will also conclude that the use is permissible under the doctrine of fair use.<sup>25</sup>

In *Bouchat*, the Fourth Circuit concluded that there were distinct purposes between the original and secondary uses of the *Flying B Logo* in the Ravens’ corporate

---

cases may establish with respect to the virtual representation and claim preclusion doctrines in the copyright context.”).

<sup>16</sup> *Bouchat v. Balt. Ravens Ltd. P’ship*, 619 F.3d 301, 317-18 (4th Cir. 2010). For the remainder of this Article, this case shall be referred to as “Bouchat” or “Bouchat v. Baltimore Ravens.”

<sup>17</sup> *Id.* at 313. See generally 17 U.S.C. § 501(a) (“Anyone who violates any of the exclusive rights of the copyright owner as provided in sections 106 through 122 . . . is an infringer of the copyright.”); 17 U.S.C. § 107 (1976) (“[F]air use of a copyrighted work . . . is not an infringement of copyright.”).

<sup>18</sup> 346 F.3d at 517 (affirming the jury finding that there was no profit attributable to the infringement of Bouchat’s copyright in the Shield Drawing); 506 F.3d at 525-26 (finding that claim preclusion prevents Bouchat from obtaining actual damages from license arrangements between the NFLP and various retailers).

<sup>19</sup> 17 U.S.C. § 412 (2002) (“[N]o award of statutory damages or of attorney’s fees, as provided by sections 504 and 505, shall be made for – (1) any infringement of copyright in an unpublished work commenced before the effective date of its registration.”).

<sup>20</sup> *Bouchat v. Balt. Ravens Ltd. P’ship*, 587 F. Supp. 2d 686, 694 (D. Md. 2008). Copyright registration is not a prerequisite for the remedies under 17 U.S.C. §§ 502, 503.

<sup>21</sup> See *infra* Part II.A.

<sup>22</sup> 17 U.S.C. § 107.

<sup>23</sup> *Id.*

<sup>24</sup> Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1111 (1990).

<sup>25</sup> See *infra* Part II.C.2 (explaining that when a secondary use is transformative and noncommercial, a court will generally hold that the use does not infringe the copyright because it constitutes fair use).

lobby. It held that the continued use of the *Flying B Logo* in the corporate lobby was transformative and ultimately fair use.<sup>26</sup> As rationalized by the majority of the court, the transformative purpose for displaying old tickets that bear the *Flying B Logo* and for displaying a photo collage depicting the Ravens first-ever draft picks (Ray Lewis and Jonathan Ogden—each wearing a team uniform and helmet displaying the *Flying B Logo*) was to document the inaugural season.<sup>27</sup> The court determined that the defendant's use of the *Flying B Logo* in the Ravens headquarters was in “an area that is dedicated to the history of the team”<sup>28</sup> and characterized the context of the use as “museum-like.”<sup>29</sup> In such a context, the court considered the secondary purpose for displaying the *Flying B Logo* to be historical in nature; that is, it presents a fact to the interested public, whereas it held the original purpose to be a symbol for the Ravens.<sup>30</sup> A historical use of a copyrighted work is analogous to those categories of copying identified in the preamble of Section 107 that had traditionally been considered fair use, such as news reporting, scholarship, and research.<sup>31</sup>

Conversely, the court concluded that the secondary purpose of using the *Flying B Logo* in the season highlight films was not distinct from its original purpose, not transformative, and not a fair use.<sup>32</sup> Judge Michael, the author of the majority opinion, articulated his position with the following hypothetical:

In the first [scenario], an individual at home in her living room in 1996 watches a Ravens football game on television. The Flying B logo on the helmets of one team helps her identify the team as the Ravens. In the second [scenario], an individual at home today (2010) in his living room watches the 1996 Ravens season highlight film. The Flying B logo on the helmets of one team helps him identify the team as the Ravens. The logo plays the same role in each example. Its *purpose* is not transformed in the highlight film, viewed some fourteen years later.<sup>33</sup>

In the hypothetical, Judge Michael identified the “purpose” of the *Flying B Logo* but he failed to identify the purpose for using the *Flying B Logo* in the highlight films. An individual that enters the corporate lobby of the Ravens today would see the *Flying B Logo* on photographs of players and understand that the logo identifies each of the players as Ravens. That purpose will never change, and that was Judge Michael's point. However, the purpose of using the *Flying B Logo* in the highlight films was not to identify which players are Ravens. The purpose of using the logo was identical to the

---

<sup>26</sup> Bouchat v. Balt. Ravens Ltd. P'ship, 619 F.3d 301, 317-18 (4th Cir. 2010).

<sup>27</sup> *Id.* at 307, 314.

<sup>28</sup> *Id.* at 313-4.

<sup>29</sup> *Id.* at 314.

<sup>30</sup> *Id.*

<sup>31</sup> *Id.* See also Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 561 (1985) (“News reporting is one of the examples enumerated in § 107 to ‘give some idea of the sort of activities the courts might regard as fair use under the circumstances.’ Senate Report, at 61.”).

<sup>32</sup> 619 F.3d. at 313 (“[T]he depiction of the Flying B logo in the season highlight films sold by the NFL and the highlight film played during the Ravens home football games is an infringement of Bouchat's copyright.”).

<sup>33</sup> *Id.* at 309 (emphasis added).

purpose of creating the Ravens highlight films—to accurately represent the historical years of the team.<sup>34</sup> Because the *Flying B Logo* could not be extracted from a video and still permit the videographer to accurately present historical season highlights, the use of the logo was necessary to synthesize a quality NFL highlight film.

The majority opinion is flawed because it overemphasized the commercial nature of the highlight videos,<sup>35</sup> it ignored the fact that the *Flying B Logo* is no longer used as the Ravens logo and is literally historical,<sup>36</sup> and it refused to consider that the purpose of the *Flying B Logo* transformed from a team logo to a historic artifact that documented the actual occurrence of sporting events.<sup>37</sup> In his dissent, Judge Niemeyer acknowledged that “transformation is fundamental and critical to an analysis of fair use, inasmuch as transformation lies at the ‘heart’ of the fair use doctrine.”<sup>38</sup> Accordingly, he would have affirmed District Court Judge Garbis’ conclusions—that both secondary uses of the *Flying B Logo* were transformative and fair uses of the Bouchat’s *Shield Drawing*. As Judge Niemeyer put it:

These memorabilia and game highlights are historical and biographical, and the Ravens’ only purpose in displaying the Flying B Logo now is to recount and recall that history, as the district court held. *The incidental and necessary display of the Flying B Logo in connection with these items is totally transformative of the use of the Flying B Logo*—changing from its use as the symbol identifying the Ravens’ franchise to its use as an incidental and necessary part of history.<sup>39</sup>

Arguing that the use of the *Flying B Logo* was “an incidental and necessary part of history,”<sup>40</sup> Judge Niemeyer was indicating that the films would have been either impossible or impractical to create if the *Flying B Logo* was extracted from each highlight. Logically, the *Flying B Logo* is historical in its nature because it is no longer the symbol used to identify the Ravens players—a fact ignored by the majority.<sup>41</sup> Further, the dissent allotted proper weight<sup>42</sup> and correctly summarized the legal rule with respect to the commercial nature of the video highlight films.<sup>43</sup> Implicitly, the dissent also

---

<sup>34</sup> *Id.* at 321 (Niemeyer, J., dissenting) (“The Ravens’ use of the Flying B Logo is therefore necessary for its *new purpose* of recounting and recalling franchise history . . .”).

<sup>35</sup> *Id.* at 308 (“The core commercial purpose of the highlight films does not align with the preamble’s protected purposes of comment, news reporting, research, and the like.”).

<sup>36</sup> *Id.* at 310 (“Unlike in Bill Graham Archives, where the concert photos were put to a transformative use (and no longer served the original advertising purpose), the logo here continues to identify the Ravens, as it did originally.”).

<sup>37</sup> *Id.* at 309 (“Simply filming football games that include the copyrighted logo does not transform the purpose behind the logo’s use into a historical one.”).

<sup>38</sup> *Id.* at 320.

<sup>39</sup> *Id.* at 320 (emphasis added).

<sup>40</sup> *Id.*

<sup>41</sup> *Id.* at 321 (“[I]t is simply inaccurate to say, as the majority does, that the Flying B Logo is being used by the Ravens for the same purpose today that it was in the years 1996–98.”).

<sup>42</sup> *Id.* ([A]ny monetary motive in recounting and recalling history through memorabilia and highlights is based on the value of the *history*, not the value of the Flying B Logo.”) (emphasis in original).

<sup>43</sup> *Id.* at 321–22 (“[T]he inquiry into the commercial nature of a use under the first statutory factor of § 107 is not whether the Ravens received money from the sale of the memorabilia or video highlights—as

reflects the subtle difference between a copyrighted work's purpose and the purpose of using the copyrighted work in a new context. Judge Niemeyer equated the purpose of using of the *Flying B Logo* with the purpose of creating the highlight videos: each purpose was to document the Ravens early seasons.<sup>44</sup>

The Fourth Circuit opinions in *Bouchat v. Baltimore Ravens* illustrate the important role that transformative use plays in a fair use analysis. The majority concluded that the use of the *Flying B Logo* in the highlight films was not transformative and ultimately infringing, whereas the dissenting and district court judges each concluded that such a use was transformative and fair. Unfortunately, the Fourth Circuit opinions also illustrate why a determination of transformativeness, as well as fair use in general, may be a problematic enquiry for judges. Defining the purpose of using a copyrighted work is a difficulty that arises in many cases because there may be more than one purpose, and higher courts have not provided explicit guidance as to which purposes are transformative.

This Article reviews recent federal court opinions pertaining to the role of transformative use under the statutory test for fair use. The four-factor test for fair use set forth in 17 U.S.C. § 107 resulted in sound decisions in most instances.<sup>45</sup> The opinions favored the alleged copyright infringer when he or she could prove that the secondary use changed the protected work in a different manner or used it for a different purpose.<sup>46</sup> Similarly, the district court judge, the dissenting judge, and the majority judges in *Bouchat* each concluded that the use of the *Flying B Logo* in the Ravens' corporate headquarters was a fair use.<sup>47</sup> But recent federal court decisions also provide that comparing the purposes of a copyrighted work and a secondary use may lead to disputable opinions and reversed judgments.<sup>48</sup> As just seen in *Bouchat*, the use of the *Flying B Logo* in the highlight videos presents such an example.

This Article also reviews two recently proposed fair use tests that do not consider the transformativeness of a secondary use. Because the statutory test for fair use was drafted with open-ended language,<sup>49</sup> this Article proposes that a court should analyze fair use with these tests as additional factors. The proposed tests would ask whether the use of the *Flying B Logo* in NFL highlight videos would have been foreseeable to Bouchat at the time he created his *Shield Drawing* and whether the secondary use is likely to generate a new audience for the copyrighted work (i.e., whether the audience for the *Flying B Logo* in 1996–1998 is the same as the audience for the highlight videos in the current era). Although the framework of the fair use doctrine generally prohibits a

---

the majority finds important—but whether the Ravens ‘stand to profit from exploitation of the copyrighted matter.’”) (quoting *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 562 (1985)).

<sup>44</sup> *Id.*

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

<sup>46</sup> *Id.*

<sup>47</sup> *Bouchat v. Balt. Ravens Ltd. P'ship*, 587 F. Supp. 2d 686, 697 (D. Md. 2008); 619 F.3d 301, 317, 320.

<sup>48</sup> See, e.g., *Gaylord v. U.S.*, 595 F.3d 1364, 1372-74 (Fed. Cir. 2010) (reversing the Federal Court of Claims' determination that the secondary use was transformative).

<sup>49</sup> See 17 U.S.C. § 107 (2006) (“[T]he factors to be considered shall *include* . . . .”) (emphasis added).

predictable outcome,<sup>50</sup> this Article argues that by considering the most difficult fact patterns under multiple legal tests a court will be able to analyze fair use without solely relying on the difficult prospect of defining the purpose of a secondary use.

In Part II of this Article, the doctrines of fair use and transformative use are introduced and illustrated with cases that are regarded as highly precedential. Further, Part II summarizes the findings of two empirical studies pertaining to the role of transformative use in fair use. In Part III, critiques and proposals for fair use reform are presented, including scholarly commentary that identifies the perspective of the original author and the intended audience as potential sources of guidance. Part IV provides a summary of recent case law, including the previous opinions of the Fourth Circuit pertaining to transformative use. Next, Part V revisits the decision in *Bouchat v. Baltimore Ravens* in view of Parts III and IV. Part VI concludes with a summary of this Article's thesis, findings, and suggestions.

## II. THE DOCTRINES OF FAIR USE AND TRANSFORMATIVE USE

Copyright law protects “original works of authorship” that are fixed in a tangible form of expression.<sup>51</sup> This includes writings, drawings, sculptures, photographs, songs, movies, etc. By establishing a limited monopoly<sup>52</sup> for authors over their work, copyright law furthers its constitutional objective of enhancing the public welfare<sup>53</sup> while simultaneously allowing authors “to reap the rewards of their endeavors.”<sup>54</sup> However, it has been acknowledged in various ways that “[n]early any creative work can be shown to be built upon the works of those who came before.”<sup>55</sup> Since a primary objective of

---

<sup>50</sup> See, e.g., *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577 (1994) (clarifying that the statute calls for a case-by-case analysis and that bright-line rules are to be avoided); Gideon Parchomovsky & Kevin A. Goldman, *Fair Use Harbors*, 93 VA. L. REV. 1483, 1496 (2007) (“[T]he repeated application of the fair use doctrine has resulted in it growing increasingly unpredictable.”).

<sup>51</sup> 17 U.S.C. § 501(a) (2006) (“Anyone who violates any of the exclusive rights of the copyright owner as provided in sections 106 through 122 . . . is an infringer of the copyright.”); U.S. COPYRIGHT OFFICE, COPYRIGHT BASICS, available at <http://www.copyright.gov/circs/circ1.pdf> (last visited Oct. 18, 2010);

<sup>52</sup> See 17 U.S.C. § 302(a) (2006) (“Copyright in a work . . . subsists from its creation . . . for a term consisting of the life of the author and 70 years after the author’s death.”). For exclusive rights (i.e., monopoly), see 17 U.S.C. § 106 (2006).

<sup>53</sup> U.S. CONST. art. I, § 8, cl. 8 (“To promote the Progress of Science and the useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”).

<sup>54</sup> Jisuk Woo, *Redefining the “Transformative Use” of Copyrighted Works: Toward a Fair Use Standard in the Digital Environment*, 27 HASTINGS COMM. & ENT. L.J. 51, 54 (2004); see also *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 477 (1984) (“The monopoly created by copyright thus rewards the individual author in order to benefit the public.”). But see Michael J. Madison, *Beyond Creativity: Copyright as Knowledge Law* 12 VAND. J. ENT. & TECH. L. 817 (2010) (arguing that “knowledge should be restored as copyright’s core concept”).

<sup>55</sup> Mike Masnick, *The Myth of Original Creators*, TECHDIRT, available at <http://www.techdirt.com/articles/20090629/0230145396.shtml> (noting that “Shakespeare used in writing King Lear, some of which he apparently copied verbatim. . . . even our own copyright law is copied from others’.”); see also *Emerson v. Davies*, 8 F.Cas. 615, 619 (No. 4,436) (C.C.D. Mass. 1845) (J. Story) (“In truth, in literature, in science and in art, there are, and can be, few, if any, things, which in an abstract sense, are strictly new and original throughout. Every book in literature, science and art, borrows, and must necessarily borrow, and use much which was well known and used before.”); Jessica Litman, *The Public*



copyright law is to enhance public welfare, the exclusive rights possessed by a copyright owner must be adjusted as to not stifle the future creativity of others.<sup>56</sup> In *Time, Inc. v. Bernard Geis Ass'n*, the Second Circuit explained: “Despite such exclusive rights, the courts have nonetheless recognized that copying or other appropriation of a copyrighted work will not entail liability if it is reasonable or ‘fair.’”<sup>57</sup> The following section provides a background on fair use, a doctrine that balances the utilitarian interests of an original author against those of a secondary author.

### A. The Doctrine of Fair Use

Section 107 of the Copyright Act of 1976 establishes the affirmative defense to copyright infringement: fair use. The fair use doctrine is an equitable rule of reason, so each case must be decided on its own facts and courts must balance the interests of each party.<sup>58</sup> As such, the statute requires courts to consider the following nonexclusive factors when balancing interests:

In determining whether the use made of a work in a particular case is a fair use the factors to be considered shall include--(1) *the purpose and character of the use*, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) *the nature of the copyrighted work*; (3) *the amount and substantiality of the portion used in relation to the copyrighted work as a whole*; and (4) *the effect of the use upon the potential market for or value of the copyrighted work*.<sup>59</sup>

In 1985, the Supreme Court asserted that the “last factor is undoubtedly the single most important element of fair use.”<sup>60</sup> However, since Justice O’Connor made that

---

*Domain*, 39 EMORY L.J. 965, 966–67 (1990) (“To say that every new work is in some sense based on the works that preceded it is such a truism that it has long been a clich[é], invoked but not examined. But the very act of authorship in any medium is more akin to translation and recombination than it is to creating Aphrodite from the foam of the sea. Composers recombine sounds they have heard before; playwrights base their characters on bits and pieces drawn from real human beings and other playwrights’ characters; novelists draw their plots from lives and other plots within their experience; software writers use the logic they find in other software; lawyers transform old arguments to fit new facts; cinematographers, actors, choreographers, architects, and sculptors all engage in the process of adapting, transforming, and recombining what is already ‘out there’ in some other form. This is not parasitism: it is the essence of authorship.”) (citations omitted).

<sup>56</sup> *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 105 S.Ct. 2218, 2225 (1985) (“[A] prohibition of such use would inhibit subsequent writers from attempting to improve upon prior works and thus . . . frustrate the very ends sought to be attained.”) (quoting H. BALL, *THE LAW OF COPYRIGHT AND LITERARY PROPERTY* 260 (1944)); *see also Sony Corp.*, 464 U.S. at 479 (“The fair use doctrine must strike a balance between the dual risks created by the copyright system: on the one hand, that depriving authors of their monopoly will reduce their incentive to create, and, on the other, that granting authors a complete monopoly will reduce the creative ability of others.”).

<sup>57</sup> *Time Inc. v. Bernard Geis Assoc.*, 293 F. Supp. 130, 144 (S.D.N.Y. 1968).

<sup>58</sup> *Gaylord v. U.S.*, 595 F.3d 1364, 1372 (Fed. Cir. 2010); *see also Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577 (1994) (clarifying that the statute calls for a case-by-case analysis and that bright-line rules are to be avoided).

<sup>59</sup> 17 U.S.C. § 107 (2006) (emphasis added).

<sup>60</sup> *Harper & Row Publishers*, 105 S.Ct. at 2233.

pronouncement, both commentators<sup>61</sup> and fair use jurisprudence<sup>62</sup> have provided that the first factor is likely to be more dispositive of fair use. Regardless of the weight given to a particular factor, the Court cautioned: “Nor may the four statutory factors be treated in isolation, one from another. All are to be explored, and the results weighed together, in light of the purposes of copyright.”<sup>63</sup> In addition to the purposes of copyright law, a court must be cognizant of the Section 107 preamble, which identifies broad examples of copying that provide a context in which fair use may arise and that were traditionally considered fair use at common law (e.g., using multiple copies for classroom teaching and news reporting).<sup>64</sup>

As mentioned in Part I, the doctrine of transformative use is considered within the framework of the first factor. The development and application of this doctrine is presented in the following section.

## B. The Doctrine of Transformative Use

The term “transformative use” was coined by Judge Leval in his 1990 law review article titled *Toward a Fair Use Standard*:

In analyzing a fair use defense, it is not sufficient simply to conclude whether or not justification exists. The question remains how powerful, or persuasive, is the justification, because the court must weigh the strength of the secondary user’s justification against factors favoring the copyright owner. I believe the answer . . . turns primarily on whether, and to what extent, the challenged use is transformative. *The use must be productive and must employ the quoted matter in a different manner or for a different purpose from the original.*<sup>65</sup>

*Toward a Fair Use Standard* was published after the famous Supreme Court case, *Sony Corp. of Am. v. Universal City Studios, Inc.* (“Betamax”).<sup>66</sup> In *Betamax*, the issue before the Court was whether or not home video recording (also referred to as “time shifting”) was fair use.<sup>67</sup> In its analysis, the Court focused on the first and fourth fair use factors. In particular, the inquiry was whether home recording was of a commercial

---

<sup>61</sup> See Pierre N. Leval, *Nimmer Lecture: Fair Use Rescued*, 44 UCLA L. REV. 1449, 1459 (1997). Lamenting an assertion in *Harper & Row*, the author stated:

This observation was dictum; it played no role in the justification of the holding. But dictum uttered by a high court is followed as if it had been a holding. It can cause great harm. Justice O’Connor cited no cases as authority for that dictum. And, indeed, there were none. *Id.*

<sup>62</sup> See *infra* Parts II.B, II.C, IV.A. and IV.C.

<sup>63</sup> *Campbell*, 510 U.S. at 578.

<sup>64</sup> MARSHALL A. LEAFFER, UNDERSTANDING COPYRIGHT LAW 489 (5th ed. 2010); Ass’n of Am. Med. Colls. v. Mikaelian, 571 F. Supp. 144, 151 (E.D. Pa. 1983), *aff’d*, 734 F.2d 3 (3d Cir. 1984) (“At the threshold, to qualify for ‘fair use’ exemption from suit under the Copyright Act, the party asserting the fair use defense must show that he is engaged in one of the activities enumerated in § 107.”); *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 549 (1985) (“The statutory formulation of the defense of fair use in the Copyright Act reflects the intent of Congress to codify the common-law doctrine.”).

<sup>65</sup> Leval, *supra* note 24, at 1111 (emphasis added).

<sup>66</sup> See *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984).

<sup>67</sup> *Id.* at 442.

nature or for nonprofit purposes,<sup>68</sup> and whether home recording had an effect upon the potential market for or value of the copyrighted work.<sup>69</sup> Framing the issue in this manner and considering the plaintiff's admission that harm was unlikely,<sup>70</sup> the Court found that the equitable balance favored a conclusion of fair use.<sup>71</sup> Per *Betamax*, an individual may record a television program, without adding anything new (i.e., merely reproducing it), and assert the defense of fair use against the copyright owner.

In dissent, Justice Blackmun, expressed concern regarding the defendant's reproductive use.<sup>72</sup> He acknowledged that in some situations the strict enforcement of the monopoly created by copyright would inhibit the goals of copyright.<sup>73</sup> Those situations of fair use, he said, are recognized in the preamble of Section 107 of the Copyright Act:

Each of these uses, however, reflects a common theme: each is a *productive* use, resulting in some added benefit to the public beyond that produced by the first author's work. The fair use doctrine, in other words, permits works to be used for "socially laudable purposes." I am aware of no case in which the reproduction of a copyrighted work for the sole benefit of the user has been held to be fair use. I do not suggest, of course, that every productive use is a fair use. . . . But when a user reproduces an entire work and uses it for its original purpose, with no added benefit to the public, the doctrine of fair use does not apply."<sup>74</sup>

As set forth above, the dissenting opinion emphasized the distinction between productive and reproductive use. Justice Blackmun argued that the reproductive and ordinary copying of a video will generally not benefit the public and should be thwarted by a plaintiff that can "prove only a *potential* for harm."<sup>75</sup> Nevertheless, the majority in *Betamax* held that the reproductive use was fair; so *Betamax* supports the premise that "one can successfully assert fair use even if the use does not fall squarely within those listed in the preamble, and even if it is far from being a productive use that transforms the copyrighted work."<sup>76</sup>

In *Betamax*, Justice Blackmun cautioned that the Court had yet to provide guidance with respect to applying the four factors of Section 107.<sup>77</sup> As a result, Justice

---

<sup>68</sup> *Id.*

<sup>69</sup> *Id.* at 451.

<sup>70</sup> *Id.* at 451. At trial, plaintiff's experts admitted "time-shifting without librarying would not result in a great deal of harm."

<sup>71</sup> *Id.* at 454-55.

<sup>72</sup> *Id.* at 480 (Blackmun, J., dissenting) (joined by Justices Marshall, Powell, and Rehnquist).

<sup>73</sup> *Id.* at 477 ("An obvious example is the researcher or scholar whose own work depends on the ability to refer to and to quote the work of prior scholars.")

<sup>74</sup> *Id.* at 478-80.

<sup>75</sup> *Id.* at 482.

<sup>76</sup> MARSHALL A. LEAFFER, UNDERSTANDING COPYRIGHT LAW 492 (5th ed. 2010).

<sup>77</sup> *Sony Corp.*, 464 U.S. at 475 (Blackmun, J., dissenting). Prior to 1982, the Supreme Court granted certiorari in only two cases implicating the fair use doctrine. See *Benny v. Loew's, Inc.*, 239 F.2d 532 (9th Cir. 1956), *aff'd per curiam by an equally divided Court sub nom. Columbia Broadcast Sys. v. Loew's, Inc.*, 356 U.S. 43 (1958); *Williams & Wilkins Co. v. United States*, 487 F.2d 1345 (Ct. Cl. 1973), *aff'd per curiam by an equally divided Court*, 420 U.S. 376 (1975).

Blackmun found judges to be somewhat justified in calling the doctrine of fair use “the most troublesome in the whole law of copyright.”<sup>78</sup> Since *Betamax*, the Supreme Court has addressed Section 107 in only three cases: *Harper & Row Publishers v. Nation Enterprises*,<sup>79</sup> *Stewart v. Abend*,<sup>80</sup> and *Campbell v. Acuff-Rose Music, Inc.*<sup>81</sup> Arguably, much of the trouble that the doctrine of fair use posed for judges was the result of dicta in *Harper & Row*.<sup>82</sup> Nine years later in *Campbell*, the Court clarified that there was no presumption against finding fair use for a secondary use that was commercial in nature.<sup>83</sup> Similarly, market harm to a copyright owner does not raise a presumption against fair use.<sup>84</sup>

According to Judge Leval, *Campbell* “revives the transformative-superseding dichotomy as the dominant consideration [in the statutory fair use analysis].”<sup>85</sup> In *Campbell*, the issue before the Court was whether the music of 2 Live Crew’s parody of Roy Orbison’s song, “Oh, Pretty Woman,” represented a fair use under Section 107. The Court easily resolved the issue, stating, “parody has an obvious claim to transformative value . . . . Like less ostensibly humorous forms of criticism, it can provide social benefit, by shedding light on an earlier work, and, in the process, creating a new one.”<sup>86</sup> *Campbell* stands for the premise that a parody is transformative. More importantly, *Campbell* set forth a test and guidance for transformative use:

The central purpose of this investigation is to see, in Justice Story’s words, *whether the new work “merely supersede[s] the objects” of the original creation, or instead adds something new, with a further purpose or different character*, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is “transformative.” Although such transformative use is not absolutely necessary for a finding of fair use, the goal of copyright, to promote science and the arts, is generally furthered by the creation of transformative works. Such works thus lie at the heart of the fair use doctrine’s guarantees of breathing space within the confines of copyright, and *the more transformative the new work, the less will be the significance of other factors*, like commercialism, that may weigh against a finding of fair use.<sup>87</sup>

---

<sup>78</sup> *Sony Corp.*, 464 U.S. at 475 (quoting *Dellar v. Samuel Goldwyn, Inc.*, 104 F.2d 661, 662 (2d Cir. 1939)).

<sup>79</sup> *Harper & Row Publishers v. Nation Enterprises*, 471 U.S. 539, 541-542 (1985) (finding that a magazine’s unauthorized publication of verbatim quotes from an unpublished presidential memoirs was not a “fair use”)

<sup>80</sup> *Stewart v. Abend*, 495 U.S. 207, 211 (1990) (examining the right to create derivative works).

<sup>81</sup> *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 572 (1994) (holding that a parody’s commercial character is only one element to be weighed in a fair use enquiry).

<sup>82</sup> Leval, *supra* note 61, at 1459.

<sup>83</sup> *Campbell*, 510 U.S. at 585 (pertaining to the first fair use factor).

<sup>84</sup> *Campbell*, 510 U.S. at 591 (pertaining to the fourth fair use factor).

<sup>85</sup> Leval, *supra* note 61, at 1466.

<sup>86</sup> *Campbell*, 510 U.S. at 579.

<sup>87</sup> *Id.* (citations omitted) (emphasis added).

The *Campbell* test is ubiquitous in fair use case law.<sup>88</sup> Below are six cases from the Second and Ninth Circuits that analyze transformative use and illustrate its boundaries.<sup>89</sup>

### 1. Illustrations of Transformative Use

In *Blanch v. Koons*, the issue before the Second Circuit was whether Koon's use of Blanch's photograph in his artwork was fair use.<sup>90</sup> The court found that the purpose of Koon's use (to force a viewer to consider how fashion objects affect people) was sufficiently distinct (i.e., transformative) from Blanch's purpose (to create a provocative fashion photograph for a commercial advertisement).<sup>91</sup> The court reasoned:

The test almost perfectly describes Koon's adaptation of "Silk Sandals": the use of a fashion photograph created for publication in a glossy American "lifestyles" magazine—with changes of its colors, the background against which it is portrayed, the medium, the size of the objects pictured, the objects' details and crucially, their *entirely different purpose and meaning*—as part of a massive painting commissioned for exhibition in a German art-gallery space. We therefore conclude that the use in question was transformative.<sup>92</sup>

*Blanch* illustrates that even when a secondary user does not alter the expressive content of a copyrighted work, the use may still be transformative if the court determines that the purpose of the use was distinct from the purpose of how the copyrighted work was used.

In *Bill Graham Archives v. Dorling Kindersley Ltd.*,<sup>93</sup> the Second Circuit again considered whether a secondary use might be transformative without materially changing the original work.<sup>94</sup> Bill Graham Archives ("BGA") created posters to promote interest in Grateful Dead concerts in addition to providing an artistic expression.<sup>95</sup> Dorling Kindersley Ltd. ("DK") displayed several of the posters in reduced form ("thumbnail images") and arranged them in chronological order in a biography of the Grateful Dead.<sup>96</sup> The court reasoned:

DK's purpose in using the copyrighted images at issue in its biography of the Grateful Dead is plainly different from the original purpose for which

---

<sup>88</sup> See *infra* Part II.B.

<sup>89</sup> The Second and Ninth Circuits "dominate our fair use case law." Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978-2005*, U. PA. L. REV. 549, 554, 567-569 (2008).

<sup>90</sup> *Blanch v. Koons*, 467 F.3d 244, 246 (2d Cir. 2006). Andrea Blanch is a fashion photographer and one of her photos was published as an advertisement for nail polish and Gucci sandals. *Id.* at 260. Jeff Koons is a visual artist known for sculptures and paintings that incorporate images taken from popular media and advertisements. *Id.* at 246.

<sup>91</sup> *Id.* at 248, 252.

<sup>92</sup> *Id.* at 253 (emphasis added).

<sup>93</sup> 448 F.3d 605 (2d Cir. 2006).

<sup>94</sup> *Id.* at 608-609.

<sup>95</sup> *Id.* at 609.

<sup>96</sup> *Id.*

they were created. Originally, each of BGA's images fulfilled the dual purposes of artistic expression and promotion. The posters were apparently widely distributed to generate public interest in the Grateful Dead and to convey information to a large number of people about the band's forthcoming concerts. In contrast, DK used each of BGA's images as historical artifacts to document and represent the actual occurrence of Grateful Dead concert events featured in *Illustrated Trip*'s timeline.<sup>97</sup>

Accordingly, the court concluded that DK's transformative purpose was distinct from the original purpose in which the images were used. However, the court went further, finding DK's use minimized the expressive value of the posters because the images in the book were reproduced in reduced size and accompanied by a referencing commentary "to create a collage of text and images on each page of the book."<sup>98</sup>

In *Perfect 10, Inc. v. Amazon.com, Inc.*,<sup>99</sup> the Ninth Circuit considered whether copying posters, but reducing them to thumbnail images for use as computer icons was transformative:

Google's use of thumbnails is highly transformative. . . . Although an image may have been created originally to serve an entertainment, aesthetic, or informative function, a search engine transforms the image into a pointer directing a user to a source of information. . . . Indeed, *a search engine may be more transformative than a parody because a search engine provides an entirely new use for the original work, while a parody typically has the same entertainment purpose as the original work.* . . . The fact that Google incorporates the entire Perfect 10 image into the search engine results does not diminish the transformative nature of Google's use. . . . Google uses Perfect 10's images *in a new context* to serve a different purpose.<sup>100</sup>

In sum, *Perfect 10, Blanch*, and *Bill Graham* each illustrate that even when a secondary user fails to materially alter the content of a copyrighted work, the use may still be transformative if a court finds the secondary purpose to be distinct from that of the original. Further, *Bill Graham* stands for the premise that the blending of copyrighted images with text and original artwork may provide a "collage effect" that transforms the original work through its use as a historical artifact that documents the occurrence of past events.<sup>101</sup>

---

<sup>97</sup> *Id.*

<sup>98</sup> *Id.* at 611.

<sup>99</sup> *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1154 (9th Cir. 2007).

<sup>100</sup> *Id.* at 1165 (emphasis added).

<sup>101</sup> *Bill Graham*, 448 F.3d at 611 ("DK's layout ensures that the images at issue are employed only to enrich the presentation of the cultural history of the Grateful Dead, not to exploit copyrighted artwork for commercial gain."). For a background on "blending," see *Elvis Presley Enterprises, Inc. v. Passport Video*, 349 F.3d 622 (9th Cir. 2003) ("Passport's use of Plaintiffs' copyrights is *not consistently transformative*. True, Passport's use of many of the television clips is transformative because the clips play for only a few seconds and are *used for reference purposes while a narrator talks over them or interviewees explain their context in Elvis' career*. But voice-overs do not necessarily transform a work.") (emphasis added); *Folsom v. Marsh*, 9 F. Cas. 342, 345 (C.C.D.Mass.1841) (Story, J.) ("There must be real, substantial condensation

## 2. Illustrations of Non-Transformative Use

In contrast to *Bill Graham*, the Second Circuit determined that the use of a poster of copyrighted artwork as a set decoration in a television program was not transformative. In *Ringgold v. Black Entertainment Television, Inc.*, the court cautioned:

In considering whether a visual work has been ‘supplanted’ by its use in a movie or a television program, care must be taken not to draw too close an analogy to copying of written works. When all or a substantial portion of text that contains protectable expression is included in another work, solely to convey the original text to the reader *without adding any comment or criticism*, the second work may be said to have supplanted the original because a reader of the second work has little reason to buy a copy of the original.<sup>102</sup>

As stated above, the poster was reproduced in full-size on the television program as a set decoration. That fact provoked the court to conclude that the purpose of the defendant’s use was not transformative: “Nothing that the defendants have done with the poster ‘supplant[s]’ the original or ‘adds something new.’ The defendants have used the poster to decorate their set to make it more attractive to television viewers precisely as a poster purchaser would use it to decorate a home.”<sup>103</sup> The defendants in *Ringgold* and *Bill Graham* both used a copyrighted poster, but only the secondary use in *Bill Graham* was found to be fair. The television show in *Ringgold* was unrelated to the poster, whereas the posters and book at issue in *Bill Graham* were about the same subject matter (the Grateful Dead). It follows that commentary, textual material, and original artwork surrounding a reduced image of a poster in creates a collage effect, but mere reproduction of a poster in a television show that does not create a collage effect. This distinction is understandable because the former use was “an insignificant taking,”<sup>104</sup> whereas the latter use supplanted a visual work “created, in significant part, for there decorative value.”<sup>105</sup>

In *On Davis v. The Gap, Inc.*, the copyright owner sued The Gap because its advertisement depicted a model wearing the plaintiff’s designer sunglasses.<sup>106</sup> Judge Leval, for the Second Circuit, opined: “we find nothing transformative about The Gap’s presentation of Davis’s copyrighted work. The ad shows Davis’s [sunglasses] being worn as eye jewelry in the manner it was made to be worn—looking much like an ad Davis

---

of the materials, and intellectual labor and judgment bestowed thereon; and not merely the facile use of the scissors; or extracts of the essential parts, constituting the chief value of the original work.”)

<sup>102</sup> 126 F.3d 70, 79 (2d Cir. 1997) (emphasis added).

<sup>103</sup> *Id.* Of note, the court also held that the defendant’s use of the poster was not *de minimis*. *Id.* at 74-77 (noting that the Librarian of Congress has regulations to provide royalties for the use of copyrighted visual works in television; the court held that “[t]he *de minimis* threshold for actionable copying of protected expression has been crossed.”).

<sup>104</sup> *Bill Graham*, 448 F.3d at 611.

<sup>105</sup> 126 F.3d 70, 80 (2d Cir. 1997).

<sup>106</sup> 246 F.3d 152, 157 (2d Cir. 2001).

himself might have sponsored for his copyrighted design.”<sup>107</sup> Again, as in *Ringgold*, the secondary use was an arbitrary advertisement garnish, and the copyright infringement was not *necessary* because the sunglasses were unrelated to The Gap’s advertisement and non-proprietary sunglasses could have been utilized.

In *Castle Rock Entertainment, Inc. v. Carol Publishing Group, Inc.*, the Second Circuit concluded that *The Seinfeld Aptitude Test* (“The SAT”), a trivia quiz book devoted to the television show *Seinfeld*, was not transformative.<sup>108</sup> The court reasoned:

Any transformative purpose possessed by *The SAT* is slight to non-existent. We reject the argument that *The SAT* was created to educate *Seinfeld* viewers or to criticize, “expose,” or otherwise comment upon *Seinfeld*. *The SAT*’s purpose, as evidenced definitively by the statements of the book’s creators and by the book itself, is to repackage *Seinfeld* to entertain *Seinfeld* viewers. . . . The book does not contain commentary or analysis about *Seinfeld*, nor does it suggest how *The SAT* can be used to research *Seinfeld* . . . .<sup>109</sup>

The defendants in *Castle Rock* and *Bill Graham* both used a copyrighted work in a book and both books were related to the same subject matter as the copyrighted works. However, Carol Publishing’s post hoc rationalizations purporting to blend a comment or criticism into the purpose of *The SAT* were apparent to the court. Further, even though the use of *Seinfeld* was necessary for *The SAT*, the secondary use could hardly be characterized as *incidental*, like the images in *Bill Graham*.<sup>110</sup> On the contrary, the copyrighted work was the dominant and essential feature of the secondary use. Accordingly, it follows that in order to establish a collage effect, and therefore a transformative use of an unaltered copyrighted work, a defendant’s use must be incidental *and* necessary.

### 3. Transformative Use as Distinct from Derivative Works

The Copyright Act provides a copyright owner the exclusive right to prepare derivative works.<sup>111</sup> A derivative work, by definition, may involve transformation.<sup>112</sup> The Supreme Court’s revival of transformative use in *Campbell* caused concern among

<sup>107</sup> *Id.* at 174.

<sup>108</sup> 150 F.3d 132, 142-43 (2d Cir. 1998).

<sup>109</sup> *Id.*

<sup>110</sup> *Bill Graham*, 448 F.3d at 611 (“BGA’s images constitute an inconsequential portion of Illustrated Trip. The extent to which unlicensed material is used in the challenged work can be a factor in determining whether a biographer’s use of original materials has been sufficiently transformative to constitute fair use.”).

<sup>111</sup> 17 U.S.C. § 106(2) (2006). For a recent review on derivative works, see Glynn S. Lunney, Jr., *Copyright, Derivative Works, and the Economics of Complements*, 12 VAND. J. ENT. & TECH. L. 779 (2010) (analyzing the derivative work right from an economic perspective).

<sup>112</sup> 17 U.S.C. § 101 (2006) (“A “derivative work” is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization . . . or any other form in which a work *may be* recast, *transformed* or adapted.”) (emphasis added).



commentators,<sup>113</sup> and that concern was legitimized in at least one case, when the court “viewed the question of transformativeness as the same in the derivative work and fair use contexts.”<sup>114</sup>

To ascertain whether there is a real relationship between transformative use in fair use and the derivative work right, Professor Reese surveyed thirty-seven circuit court opinions between 1994 (*Campbell*) and 2007 in which the judges applied the fair use analysis.<sup>115</sup> From this survey, Reese concluded, “appellate courts do not view fair use transformativeness as connected with any transformation involved in preparing a derivative work.”<sup>116</sup> As such, *Campbell’s* emphasis on transformative use has not inappropriately interfered with a copyright owner’s right to control derivative works.<sup>117</sup> That concern aside, the more revealing and relevant point with respect to this Article is that, as Reese noted, courts recognize transformative use as a vital indicator of fair use.<sup>118</sup>

### C. Empirical Studies of Transformative Use and Fair Use

#### 1. Purpose is Dispositive of Transformativeness

The results of Reese’s survey illustrate the role that transformative use has had in fair use determinations. There are two distinct scenarios of transformative use. A secondary user may employ the copyrighted work (1) in a different manner by changing its content; or (2) for a different purpose. Of course, a secondary use may also invoke both or neither of those scenarios. Reese’s study reveals that when a secondary user successfully argues that his or her use of the copyrighted work was for a different purpose, then the use will be, or is likely to be, fair:

Thirty-four of the appellate opinions, in 31 cases, expressly addressed transformativeness as part of the first-factor analysis. In all of those opinions, when the court found that the defendant had a transformative purpose for her use, the court found that the transformativeness inquiry weighed in favor of fair use, regardless of whether the court viewed the defendant as having transformed the actual content of the plaintiff’s work in any way. Indeed, *in all of the cases where transformativeness was found based on the defendant’s transformative purpose, the opinion’s ultimate conclusion was that the use was, or was likely to be, fair.*

By contrast, in all of the opinions in which the court determined that the defendant did not have a transformative purpose for her use (or in which the court’s determination about transformative purpose was uncertain), the court decided that transformativeness did not weigh in favor of fair use,

---

<sup>113</sup> R. Anthony Reese, *Transformativeness and The Derivative Work Right*, 31 COLUM. J.L. & ARTS 467, 468-69 (2008).

<sup>114</sup> *Id.* at 469 (discussing *Clean Flicks of Colorado, LLC v. Soderbergh*, 433 F. Supp. 2d 1236 (D.Colo. 2006)).

<sup>115</sup> *Id.* at 471.

<sup>116</sup> *Id.* at 467.

<sup>117</sup> *Id.* at 494.

<sup>118</sup> *See infra* Part II.C.1.

regardless of whether the defendant did or did not alter the content of the plaintiff's work within its four corners. Again, in all of these cases, the opinion's ultimate conclusion was that the use was not, or was not likely to be, fair.<sup>119</sup>

The Reese study confirms Judge Leval's claim that the first fair use factor is the controlling arm of fair use. Even so, Reese concluded that the study leaves many questions about the role of transformative use unanswered.<sup>120</sup> For example, he states that the courts have offered little guidance on how to determine which of a defendant's purposes might be transformative.<sup>121</sup> As described in Part I, *Bouchat v. Baltimore Ravens* invokes that concern.

## 2. Transformativeness is Dispositive of Fair Use

In another 2008 article,<sup>122</sup> Professor Beebe presented a survey of 306 federal opinions (215 cases) from the January 1, 1978 effective date of the 1976 Copyright Act through 2005 in which judges made substantial use of the statutory four-factor fair use test.<sup>123</sup> Since *Campbell*, district court opinions referencing the doctrine of transformative use have increased from 9.8% to 58.8%, while circuit court opinions referencing transformative use have increased from 15.6% to 81.4%.<sup>124</sup> As to whether transformative use influenced a finding of fair use, Beebe explained:

[I]n those opinions in which transformativeness did play a role, it exerted nearly dispositive force not simply on the outcome of factor one but on the overall outcome of the fair use test. More specifically, the data suggest that while a finding of transformativeness is not necessary to trigger an overall finding of fair use, it is sufficient to do so.<sup>125</sup>

Beebe summarized the role of transformative use as follows: “[A] defendant has a 35.5% chance of winning the fair use defense where it has made a nontransformative, commercial use of a creative, published work . . . . If that same use were found to be transformative, the defendant's chance of winning the fair use defense would increase to 94.9%.”<sup>126</sup> In the cases decided since Beebe's article that analyzed the doctrine of transformative use, the probabilities remain true.<sup>127</sup> Therefore, it remains nearly essential

<sup>119</sup> Reese, *supra* note 113, at 485-86 (emphasis added).

<sup>120</sup> *Id.* at 494.

<sup>121</sup> *Id.* at 495.

<sup>122</sup> Beebe, *supra* note 89.

<sup>123</sup> *Id.* at 554, 565, 573 (disclosing that 20.6% of the opinions addressed facts involving video, and “[w]here a shift in medium did occur, the most common was from print to video or vice versa, which was reported in thirteen (or 4.2%) of the opinions”).

<sup>124</sup> *Id.* at 604-605 (“At the district court level, 41.2% of the 119 district court opinions following *Campbell* failed even to refer to the doctrine, while 90.2% of the 92 opinions preceding *Campbell* failed to reference it. . . . Of the 43 circuit court opinions that followed *Campbell*, 18.6% failed to invoke the concept, while 84.4% of the 45 circuit court opinions that preceded *Campbell* failed to invoke it.”).

<sup>125</sup> *Id.* at 605.

<sup>126</sup> *Id.* at 606.

<sup>127</sup> See *infra* Part IV.

for alleged infringers to convince a court that their use is transformative.

In view of the illustrations and empirical research presented above, it is understandable that commentators have expressed concern in regard to the persuasive weight of transformative use in the fair use balance. In Part III, some of those concerns are assessed and two recently proposed alternatives to the statutory fair use analysis are presented.

### III. CRITIQUES AND PROPOSALS FOR FAIR USE REFORM

In 1990, Judge Leval identified several problems associated with fair use: “Judges do not share a consensus on the meaning of fair use. Earlier decisions provide little basis for predicting later ones. . . . Decisions are not governed by consistent principles, but seem rather to result from intuitive reactions to individual fact patterns.”<sup>128</sup> Years later, Judge Leval demonstrated a new kind of judicial gymnastics—a flip that landed him on a floor of optimism:

The doctrine was thus broken into a haphazard assortment of nonfunctional fragments, its core elements forgotten. The happy ending to this story, however, is a perceptive and profound opinion by Justice Souter in *Campbell v. Acuff-Rose*, which retrieved the forgotten structure from the common law and restored order and good sense to fair use. . . . It is impossible to overstate the importance of the *Campbell* opinion for an understanding of the vital right to quote from others. The opinion has completely recast the fair use doctrine, as expounded over the previous ten years, dispelling and reinterpreting the numerous misunderstandings that arose in that period.<sup>129</sup>

One of the misunderstandings in fair use precedent that Judge Leval bemoaned was the inapposite weight afforded to commercial uses of a copyrighted work. He pointed out that most instances of fair use are commercial in nature.<sup>130</sup> Although he was directing this argument towards the legal presumption that a secondary use that is commercial in nature is not a fair use, his argument is relevant to this article as it emphasizes that most of the Section 107 preamble activities are often commercial in nature (the preamble provides courts with fair use guideposts such as commentary, criticism, scholarly articles).<sup>131</sup> In Judge Leval’s view, the more transformative a secondary use is the less significant will be the commercial nature of that use.<sup>132</sup>

---

<sup>128</sup>Leval, *supra* note 24, at 1106-07.

<sup>129</sup>Leval, *supra* note 61, at 1450-51, 1465-66.

<sup>130</sup>*Id.* at 1456.

<sup>131</sup>*Id.*

<sup>132</sup>*Id.* at 1464-65 (“Conversely, if the copying is nontransformative—if it merely duplicates—and thus is done for a commercial purpose, this probably offers a market substitute and is unlikely to be adjudged a fair use.”).

Commentators have long called for legislative<sup>133</sup> and judicial<sup>134</sup> reform to the affirmative defense of fair use. Such observers lament the unpredictable nature of fair use, and suggest that the uncertain scope of the fair use doctrine has resulted in a chilling effect for potential secondary users.<sup>135</sup> With respect to transformative use in particular, it is Professor Cotter's position that the attention received by transformative use is riddled with problems.<sup>136</sup>

Cotter reasoned that such problems include: (1) many uses that qualify as fair, such as classroom copies of a newspaper, do not transform the copyrighted work (i.e., transformative use is underinclusive);<sup>137</sup> and (2) the term *transformative* is legally indefinable, providing "a vague guideline as to when fair use kicks in."<sup>138</sup> In other words, the elastic nature of transformative use is concerning. He states: "At the end of the day, characterizing a use as transformative may be nothing more than a conclusion based on some unconscious, inarticulable balancing of social costs and benefits."<sup>139</sup> Of course, in addition to the issues of scope and definition addressed by Cotter, there are issues with the application of the doctrine as well.

A review of fair use proposals is beyond the scope of this article. However, two recent articles are summarized below because they provide alternative approaches for examining fair use. Each article offers a unique fair use test that provides the courts with a method of reviewing its statutory four-factor fair use conclusions without an inquiry into how transformative the secondary use is.

---

<sup>133</sup> See, e.g., Michael Carroll, *Fixing Fair Use*, 85 N.C. L. REV. 1087, 1090 (2007) (proposing "a Fair Use Board in the Copyright Office that would have authority to adjudicate fair use petitions and, subject to judicial review, issue fair use rulings"); Parchomovsky & Goldman, *supra* note 50, at 1502 (proposing per se fair use safe harbors for certain types of copying).

<sup>134</sup> See, e.g., Wendy J. Gordon, *Fair Use as Market Failure: A Structural and Economic Analysis of the Betamax Case and Its Predecessors*, 82 COLUM. L. REV. 1600, 1614 (1982) (proposing that courts consider whether "(1) market failure is present; (2) transfer of the use to defendant is socially desirable; and (3) an award of fair use would not cause substantial injury to the incentives of the plaintiff copyright owner") Michael J. Madison, *A Pattern-Oriented Approach to Fair Use*, 45 WM. & MARY L. REV. 1525 (2004) (calling upon judges to conduct a "pattern-oriented" analysis of the fair use issue).

<sup>135</sup> Carroll, *supra* note 133, at 1096; Parchomovsky & Goldman, *supra* note 50, at 1486.

<sup>136</sup> Thomas F. Cotter, *Transformative Use and Cognizable Harm*, 12 VAND. J. ENT. & TECH. L. 701 (2010); see also, Shyamkrishna Balganesh, *Foreseeability and Copyright Incentives*, 122 HARV. L. REV. 1569, 1587 (2009) ("Transformative use, as it is understood today, does nothing to connect fair use to a creator's incentive. The overbearing emphasis placed on the work itself, and the rendering of the 'purpose' element of the test practically meaningless, aptly reflect this.").

<sup>137</sup> Cotter, *supra* note 136, at 705.

<sup>138</sup> *Id.* at 706–07.

<sup>139</sup> *Id.* at 725.

### A. Analysis from the Perspective of the Audience<sup>140</sup>

As outlined in *Campbell*, the doctrine of transformative use requires a secondary use to add something new; i.e., to change the original work by adding or removing content or by using the original work for a different purpose.<sup>141</sup> In *Everything is Transformative: Fair Use and Reader Response*, Professor Heymann construes the phrase “adds something new” to represent a subtle shift that “seems to encourage courts to focus on whether the second artist has added material to the first work to the exclusion of consideration of whether the artist has recontextualized the copyrighted work.”<sup>142</sup> It is her position that when an inquiry focuses on what a secondary user has done to an original work, it requires “a shift in focus from reader interpretation to authorial activity.”<sup>143</sup> Heymann explains that *Campbell* called for, if only in some respect, an inquiry from the perspective of the audience (e.g., the reader).<sup>144</sup> Thus, Heymann suggests that:

the better test of whether a second work has contributed a “new expression, meaning, or message” to the first is to turn to the reader, the one who “holds together in a single field all the traces by which the written text is constituted.” Asking the question from the reader’s perspective is more likely, I think, to determine whether the defendant’s use promotes the delivery of new works to the public, the ultimate goal of copyright law.<sup>145</sup>

Heymann cautions that refocusing from the author to the reader is only the starting point.<sup>146</sup> For transformative use to have meaning and to avoid interpretations that allow everything to be transformative, the inquiry must go further. As Heymann explains:

[T]he relevant question should be the degree of transformativeness—the amount of interpretive distance that the defendant’s use of the plaintiff’s work creates. If that distance is significant enough to create a *distinct and separate discursive community* around the second work, the defendant’s

---

<sup>140</sup> One method of interpretation in literary theory is called reader-response criticism, in which the analysis of a work is focused through the lens of the reader or audience, in contrast to focusing primarily on the author. Application of reader-response criticism to fair use in copyright is arguably tied to the justification of copyright itself. See, e.g., Jessica Litman, *Lawful Personal Use*, 85 TEX. L. REV. 1871, 1882 (2007) (arguing that “copyright law encourages authorship at least as much for the benefit of the people who will read, view, listen to, and experience the works that authors create, as for the advantage of those authors and their distributors”).

<sup>141</sup> *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

<sup>142</sup> Laura A. Heymann, *Everything is Transformative: Fair Use and Reader Response*, 31 COLUM. J.L. & ARTS 445, 452 (2008).

<sup>143</sup> *Id.*

<sup>144</sup> *Id.* at 452–53 (“*Campbell* also provides a starting point for refocusing the inquiry. In considering whether a work claimed to be a parody of a copyrighted work might constitute fair use, the Court noted that the threshold question is ‘whether a parodic character may reasonably be *perceived*.’” (emphasis added) (quoting *Campbell*, 510 U.S. at 582)).

<sup>145</sup> *Id.* at 448–49 (quoting ROLAND BARTHES, *The Death of the Author*, in IMAGE-MUSIC-TEXT 142, 148 (Stephen Heath trans., Hill and Wang 1978)).

<sup>146</sup> *Id.* at 450 (explaining that it is the reader “who is . . . the beneficiary of the uses that the doctrine promotes”).

use is more likely to be transformative (and, perhaps, fair). The focus is therefore not on the author's intent (although, like any statement of authorial interpretation, intent may be relevant evidence) but on the reader's reaction.<sup>147</sup>

The “distinct and separate discursive community” inquiry provides courts with a method to double-check their conclusion from the statutory four-factor analysis. The inquiry appears consistent with the result in *Campbell*;<sup>148</sup> however, it appears that the test would be inconsistent with the results obtained by the statutory four-factor analysis in *Bill Graham* and *Castle Rock*.<sup>149</sup> As such, even if the proposed test is not consistent in each case, it still provides another lens for which a court may view a secondary use of a copyrighted work through.

## B. Analysis from the Perspective of the Author

Fair use is an affirmative defense, which means that the defendant must prove that the allegedly infringing work is not harmful to the plaintiff. In *Foreseeability and Copyright Incentives*,<sup>150</sup> Professor Balganesch suggests that the statutory structure is flawed: “It places the entire focus on the defendant, glossing over the uses that the plaintiff might have legitimately expected to control in creating the work. Foreseeable copying shifts the burden onto the plaintiff to establish this point as part of the infringement inquiry.”<sup>151</sup> From his perspective, an objective standard would relieve courts from determining whether a secondary use is transformative and refocus attention on the copyright owner's entitlement.<sup>152</sup>

Accordingly, Balganesch proposes that in order to prove copyright infringement a plaintiff should carry the following burden of proof: (1) ownership of a valid copyright; (2) copying by the defendant of the original; and (3) the defendant's use of the copyrighted work “was foreseeable to the plaintiff—in form and purpose—when the work was created.”<sup>153</sup> The third element of infringement provides the objective component. This element would require courts to determine “whether the use complained of is one that the copyright owner (that is, the plaintiff) could have reasonably foreseen at the time that the work was created (that is, the point when the entitlement commences).”<sup>154</sup> To analyze the foreseeable copying element a court must put themselves in the shoes of the original author.

<sup>147</sup> *Id.* at 449 (emphasis added).

<sup>148</sup> Arguably, distinct and separate discursive communities listen to Roy Orbison and 2 Live Crew because those artists are in different genres of music. Accordingly, the secondary work would be considered transformative.

<sup>149</sup> In *Castle Rock*, the book, *The SAT*, was determined to be non-transformative. In *Bill Graham*, the book, *Grateful Dead: The Illustrated Trip*, was determined to be transformative. However, in both scenarios, communities for the original and secondary works are likely the same.

<sup>150</sup> Balganesch, *supra* note 136.

<sup>151</sup> *Id.* at 1606–07.

<sup>152</sup> *Id.* at 1607.

<sup>153</sup> *Id.* at 1604–05.

<sup>154</sup> *Id.* at 1575. It is presumed that courts are capable of this function because foreseeability is not foreign to copyright law. *Id.* at 1609. In the licensing context, courts “look to popular media, trade journals,

Patent law requires a similar analysis when examining an invention in view of a prior invention with respect to obviousness. The inquiry requires an analysis from the perspective of “a person having ordinarily skill in the art” at the time the invention was made.<sup>155</sup> For copyright infringement, Balganesch provides a divergent approach:

Foreseeable copying would have courts do just the opposite. The test asks courts to determine whether the defendant’s present use should have been “obvious” to the creator (the plaintiff) at the time of creation . . . . Such a standard would presume creators are, at a minimum, informed—in the sense that the creator knows of the different mediums in existence in which the work can be employed—and rational—in that the creator intends to either directly or indirectly control the markets for those different mediums.<sup>156</sup>

The foreseeable copying analysis is compelling because lawyers and jurists are familiar with objective standards. In addition to the “distinct and separate discursive community” test, courts are now armed with additional legal tests that do not inquire about the transformativeness of a secondary use. These tests provide a “check” for the conclusions arrived at from the statutory four-factor fair use analysis and the two tests are utilized herein to revisit *Bouchat*.<sup>157</sup>

#### IV. THE ROLE OF TRANSFORMATIVE USE IN RECENT CASE LAW

In recent years, several courts have examined the doctrine of transformative use in the determination of whether a subsequent use of a copyrighted work is fair or infringement. In fact, a court opinion mentioned the term “transformative” in nineteen cases in 2009 and 2010.<sup>158</sup> One of those cases was a 2009 district court decision that was reconsidered on appeal in 2010.<sup>159</sup> A second case did not examine fair use.<sup>160</sup> A third case invoked transformative use in the misappropriation of the right of privacy.<sup>161</sup> And a fourth case was the district court decision for the title case, *Bouchat v. Baltimore Ravens*.<sup>162</sup>

In each of the remaining fifteen cases, the court’s determination as to whether the secondary use was transformative was coextensive with the overall determination as to whether the secondary use was fair. Of the fifteen cases, there were seven in which the court decided the defendant’s use was transformative and that the defendant’s use was

---

expert testimony, industry practice, and at times, simple logic to assess the foreseeability of a specific use.” *Id.* at 1611.

<sup>155</sup> 35 U.S.C. § 103(a) (2006).

<sup>156</sup> Balganesch, *supra* note 136, at 1612–13.

<sup>157</sup> *See infra* Part V.B.

<sup>158</sup> A search of federal cases in Westlaw revealed nineteen cases—eighteen of which are within the scope of this review (i.e., fair use in copyright infringement).

<sup>159</sup> *Salinger v. Colting*, 641 F. Supp. 2d 250, 253 (S.D.N.Y. 2009).

<sup>160</sup> *Warren Publishing Co. v. Spurlock*, No. 08-3399, 2010 WL 760311 (E.D. Pa 2010) (Memorandum Re: Defendant’s Motion for Attorney Fees).

<sup>161</sup> *Hilton v. Hallmark Cards*, 599 F.3d 894 (9th Cir. 2010).

<sup>162</sup> *See* Parts I and V.

fair. In the remaining eight cases, the court considered the defendant's use to be non-transformative or only "somewhat transformative,"<sup>163</sup> and concluded that the defendant's use was copyright infringement. For the purposes of this article, five of the fifteen cases provide minimum insight with respect to the role of transformative use and are omitted from the following discussion.<sup>164</sup>

### A. A Summary of Transformative Use in Case Law

In *A.V. Ex Rel. Vanderhuy v. Iparadigms, LLC*, the Fourth Circuit determined that when a school makes a copy of a student's copyrighted work with its plagiarism technology system and then archives the copy, such a use is transformative and fair.<sup>165</sup> The court held that the secondary use was unrelated to expressive content. Instead, the use was aimed at detecting and discouraging plagiarism.<sup>166</sup> Although the defendant's plagiarism machine is commercial in nature, the Fourth Circuit determined that the fourth factor did not favor the plaintiff because the system did not serve as a market substitute.<sup>167</sup>

In *Warren Publishing Co. v. Spurlock*,<sup>168</sup> the issue before the court was whether defendant's book was copyright infringement for including the artwork of Basil Gogos, an artist who designed cover art for the plaintiff's magazine, *Famous Monsters*.<sup>169</sup> Spurlock argued that the cover art was originally used to generate public interest in—and thereby sell copies of—the magazine by conveying information about the magazine's content.<sup>170</sup> By contrast, Spurlock argued that his book was a biography and artist's retrospective and that the purpose of using the cover art was transformative because he used the artwork as historical artifacts and to represent the work product of Gogos.<sup>171</sup> The court noted that the scenario was nearly identical to *Bill Graham*, which concluded that

<sup>163</sup> *Reyes v. Wyeth Pharmaceuticals, Inc.*, 603 F. Supp. 2d 289, 297 (D. P.R. 2009).

<sup>164</sup> *Bourne Co. v. Twentieth Century Fox Film Corp.*, 602 F. Supp. 2d 499 (S.D.N.Y. 2009) (determining whether the song *I need a Jew* is a parody of the song *When I Wish Upon A Star*, and therefore, necessarily transformative); *U.S. v. A.S.C.A.P.*, 599 F. Supp. 2d 415 (S.D.N.Y. 2009) (determining whether the defendant's use of song snippets, without a license, as phone ringtones was transformative); *Sony BMG Music Entertainment v. Tennenbaum*, 672 F. Supp. 2d 217 (D. Mass. 2009) (holding that defendant's use of downloaded music was not transformative and not even arguably fair use); *Commerce Bancorp, LLC v. Hill*, 2010 WL 2545166 (D. N.J. 2010) (concluding that the defendant's use of plaintiff's presentation materials did not add much of a further purpose or different character to the documents); *Latimer v. Roaring Toyz, Inc.*, 2010 WL 3747148 (M.D. Fla. 2010) (denying defendant's motion for summary judgment because their use of a professional photographer's photos of a customized motorcycle in a magazine was not transformative).

<sup>165</sup> 562 F.3d 630, 640 (4th Cir. 2009).

<sup>166</sup> *Id.*

<sup>167</sup> *Id.* at 643-44. This is noteworthy because the Fourth Circuit's decision in *Bouchat v. Baltimore Ravens* heavily relied on the commercial nature of the defendant's use.

<sup>168</sup> 645 F. Supp. 2d 402 (E.D. Pa. 2009).

<sup>169</sup> *Id.* at 406-07 (noting that fourteen of the book's images were reproductions of original drawings but not reproductions of the magazine covers, and ten of the book's images were exact reproductions of magazine covers).

<sup>170</sup> *Id.* at 417, 420.

<sup>171</sup> *Id.* at 417, 420.



the defendant's book was highly transformative, and granted Spurlock's motion for summary judgment.<sup>172</sup>

In *House of Bryant Publications, L.L.C. v. A&E Television Networks* ("House of Bryant"),<sup>173</sup> the estate of Felice and Boudleaux Bryant, authors of the song "Rocky Top," sued the television network for playing the song in an episode of *City Confidential*.<sup>174</sup> Defendant argued that the use of the song was transformative because its purpose was to comment on the city of Knoxville, Tennessee, where the episode took place.<sup>175</sup>

In *House of Bryant*, both parties relied on *Lennon v. Premis Media Corp.*<sup>176</sup> The defendant argued that the instant facts were analogous to those in *Lennon*, in which the court found the use John Lennon's song, "Imagine," transformative because it was incorporated into the movie for purposes of criticism and commentary.<sup>177</sup> However, the court contrasted the use of "Imagine" from the use of "Rocky Top" because "the transformative nature of 'Rocky Top' is unapparent from a basic viewing of the Episode. . . . and there is no perceptible attempt to actually place 'Rocky Top' in any sort of larger context."<sup>178</sup> The court found that the evidence of record did not support a conclusion of fair use and denied the defendant's motion to dismiss.<sup>179</sup>

In *Reyes v. Wyeth Pharmaceuticals, Inc.*,<sup>180</sup> the plaintiff allowed an acquaintance to photograph her sculpture, *The Watcher of the Fire*, and the photo appeared in an advertisement for defendant's publicity campaign to raise awareness of rheumatoid arthritis ("RA").<sup>181</sup> In discussing transformative use, the court wrote:

The implicit message of the image combined with the text is that the woman depicted, either in reality or as a representative artist, suffers from RA and yet, because of treatments currently available, she was not inhibited from creating the Watcher. This message differs from the purpose or message involved in the sculpture itself, which has nothing to do with RA. At the same time, this additional message does not completely change the character of the sculpture which is still presented to the viewer as a creative work of art. Accordingly, the Court finds

---

<sup>172</sup> *Id.* at 419.

<sup>173</sup> *House of Bryant Publications, L.L.C. v. A&E Television Networks*, No. 3:09-0502, 2009 WL 3673055 (M.D. Tenn. 2009).

<sup>174</sup> *Id.* at \*1 (considering that the plaintiffs actively licensed Rocky Top, the court noted that defendant did not attempt to obtain a license for their use of the song).

<sup>175</sup> *Id.* at \*2 (describing the particular episode of *City Confidential*, the court noted that while the narrator and others discuss Knoxville's culture, in the background, the UT band can be heard playing Rocky Top for 6-7 seconds).

<sup>176</sup> *Id.* at 6 (construing *Lennon v. Premis Media Corp.*, 556 F.Supp.2d 310 (S.D.N.Y. 2008)).

<sup>177</sup> *House of Bryant*, 2009 WL 3673055 at \*6 (construing *Lennon*, 556 F.Supp.2d 310).

<sup>178</sup> *Id.*

<sup>179</sup> *Id.* at \*9 (noting that fair use may be reasserted at the summary judgment stage).

<sup>180</sup> *Reyes v. Wyeth Pharmaceuticals, Inc.*, 603 F. Supp. 2d 289 (D. P.R. 2009).

<sup>181</sup> *Id.* at 293 (noting that the advertisement contains a picture of a woman holding a rectangularly shaped stained glass sculpture).

defendants' use of the Watcher to be *somewhat transformative*, (but not overwhelmingly so).<sup>182</sup>

*Reyes* represents the only case in which a court found the purpose of the use to be "somewhat transformative." The court determined that the first factor favored the plaintiff because the advertisement, which Defendant said was intended to raise awareness of RA rather than directly promote a pharmaceutical product, prominently displayed "Wyeth" and there was an element of bad faith, which collectively overcame the somewhat transformativeness of the advertisement's purpose.<sup>183</sup>

In *Sedgwick Claims Mgmt. Services v. Delsman*,<sup>184</sup> the court granted defendant's motion to dismiss a claim of copyright infringement, finding that the context of defendant's use rendered the copying transformative. Here, the defendant was dissatisfied with the processing of his insurance claim and mailed postcards bearing the photographs of two Sedgwick executives with critical commentary and a stylized "WANTED" across the postcards.<sup>185</sup> One copy of a photo had been altered in order to depict the corporate officers as Adolf Hitler and Heinrich Himmler.<sup>186</sup>

In finding the picture transformative, the court stated: "The question of fair use does not turn simply on whether the photographs themselves were unaltered. . . . [T]he salient inquiry is whether the use of the photos, *in the specific context used*, was transformative."<sup>187</sup> The court explained that the original photographs were used for promotional reasons, whereas the defendant's use was for criticizing the company.<sup>188</sup> The court found the first fair use factor to strongly favor defendant because, "[w]hen viewed in context . . . [the photos were] used . . . for a fundamentally different purpose than they were originally intended."<sup>189</sup>

In *Monge v. Maya Magazines*,<sup>190</sup> the plaintiff, a popular Hispanic celebrity, was photographed while being married in a Las Vegas chapel. After the photos were published, the plaintiff sued for copyright infringement. The court granted the defendant's motion for summary judgment because the wedding photos were used in a different context; i.e., they were transformative because they were not used "as documentation [of the wedding], but to challenge the plaintiff's public denial of marriage." The court stated that such a use was "a function that was distinct from their original purpose."<sup>191</sup>

---

<sup>182</sup> *Id.* at 296-97 (emphasis added).

<sup>183</sup> *Id.* at 297.

<sup>184</sup> *Sedgwick Claims Mgmt. Services v. Delsman*, 2009 WL 2157573 (N.D. Cal. 2009).

<sup>185</sup> *Id.* at \*2.

<sup>186</sup> *Id.*

<sup>187</sup> *Id.* at \*5.

<sup>188</sup> *Id.*

<sup>189</sup> *Id.*

<sup>190</sup> *Monge v. Maya Magazines, Inc.*, No. CV 09-5077-R, 2010 WL 3835053 (C.D. Cal. 2010).

<sup>191</sup> *Id.* at \*2.

In *Murphy v. Millennium Radio Group*,<sup>192</sup> the defendant worked as a “Shock Jock” on a radio show. After a photo was taken for the plaintiff’s magazine article, the defendant’s radio show scanned the photo into its website.<sup>193</sup> Subsequently, fans started mailing in altered copies of the photo, which were also posted on the website. The court granted the defendant’s motion for summary judgment after determining that both altered and unaltered copies of the photo were a fair use. In its analysis, the court found that the unaltered photo was transformative because it had a different purpose than that of the original work.<sup>194</sup> The altered photos present the image with a new character and an alternative message.<sup>195</sup> The court stated, “[T]o the extent that the use of the images may have some commercial purpose, this is far outweighed by the transformative nature of the use.”<sup>196</sup>

In *Salinger v. Colting*,<sup>197</sup> the estate of J.D. Salinger sued Fredrik Colting in order to prevent the defendant from publishing, advertising, or otherwise distributing his book titled *60 Years Later: Coming Through the Rye* (“*60 Years Later*”).<sup>198</sup> In *Salinger*, the Second Circuit vacated the district court’s holding as being inconsistent with *eBay, Inc. v. MercExchange, L.L.C.*<sup>199</sup> Although *eBay* pertained to patent infringement the Circuit court adopted its holding for copyright infringement and applied its rule to the facts in *Salinger*.<sup>200</sup>

The Second Circuit reaffirmed the district court’s conclusion of copyright infringement—agreeing that *60 Years Later* was substantially similar to *Catcher in the Rye* (“*Catcher*”).<sup>201</sup> The court took notice of the substantial weight that the district court gave to the first fair use factor—specifically, the purpose of *Catcher*.<sup>202</sup> The court found the purpose of *Catcher* to be particularly relevant to public statements made by Colting. He publicly asserted that the purpose of *60 Years Later* was to exist as a sequel to *Catcher*,<sup>203</sup> and that statement substantially weakened his credibility when he later asserted that the purpose was to comment on J.D. Salinger.<sup>204</sup> The district court held that

---

<sup>192</sup> *Murphy v. Millennium Radio Group, L.L.C.*, No. 08-1743 (JAP), 2010 WL 1372408 (D. N.J. 2010).

<sup>193</sup> *Id.* at \*1.

<sup>194</sup> *Id.* at \*5 (“The Defendants initial use of the unaltered photograph . . . had a different purpose than the original work. Defendants use was designed to inform visitors to the station’s website of the New Jersey Monthly feature. The text beneath the photo states ‘Craig and Ray bare it all for New Jersey Monthly’ and the text in the corner of the photo, although somewhat cut off, clearly references the ‘Best Shock Jocks’ award.”).

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

<sup>196</sup> *Id.*

<sup>197</sup> *Salinger v. Colting*, 607 F.3d 68 (2d Cir. 2010).

<sup>198</sup> *Id.* at 71. In 2009 and under the pseudonym, “John David California,” Colting published *60 Years Later* in England. *Salinger v. Colting*, 641 F.Supp.2d 250, 253 (S.D.N.Y. 2009).

<sup>199</sup> *Salinger*, 607 F.3d at 75. See *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006) (determining and setting forth the requirements for preliminary injunctions).

<sup>200</sup> *Id.* at 74-75.

<sup>201</sup> *Id.* at 84.

<sup>202</sup> *Salinger v. Colting*, 641 F. Supp. 2d 250, 258 (S.D.N.Y. 2009). The purpose of *Catcher* was to comment on society, generally. The main character, Holden Caulfield, was identified by the district court as “often miserable and unconnected as well as frequently absurd and ridiculous.” *Id.*

<sup>203</sup> *Id.* at 260 n.3.

<sup>204</sup> *Id.* at 262.

*60 Years Later* lacked a sufficient nonparodic transforming use and that the defendants were unlikely to win with such a defense.<sup>205</sup>

In *Sofa Entertainment, Inc. v. Dodger Productions, Inc.*,<sup>206</sup> the court granted the defendant's motion for summary judgment even though their play (*Jersey Boys*) about the musical group the Four Seasons used a seven-second clip from *The Ed Sullivan Show*.<sup>207</sup> The court outlined the following subfactors within the first fair use factor: (1) the purpose of the use; (2) transformative use; and (3) commercial or nonprofit use.<sup>208</sup> The court determined that the first subfactor favored the plaintiff because the copying was for a dramatic production.<sup>209</sup> Because the clip was used in a commercial context, the third subfactor also favored the plaintiff.<sup>210</sup>

In regard to the second subfactor, the court determined that the "Defendant's use of the Clip in *Jersey Boys* is certainly more than a 'mere re-broadcast' of a portion of the copyrighted episode of *The Ed Sullivan Show*."<sup>211</sup> In fact, the court analogized the clip to "a short excerpt of news footage of the beating of Reginald Denny in an introductory montage for its show 'Prime Time Justice,' which the Ninth Circuit found to have at least some claim to being a transformative use."<sup>212</sup> Ultimately, the court was persuaded by the argument that the clip represents "a historical reference point" for the story of the musical group the Four Seasons.<sup>213</sup>

In *Gaylord v. U.S.*,<sup>214</sup> the U.S. Court of Appeals for the Federal Circuit reversed a determination by the U.S. Court of Federal Claims that the government's use of Gaylord's sculpture (as a photo thereof) on the face of a stamp was transformative and fair use.<sup>215</sup> Finding that the stamp was transformative, the Court of Federal Claims explained that:

The artistic expression of "The Column" can be summarized as a three-dimensional sculptural snapshot of a group of soldiers on an undefined mission during the Korean War, captured as a single moment in time. Mr. Alli, through his photographic talents, transformed this expression and message, creating a surrealistic environment with snow and subdued lighting where the viewer is left unsure whether he is viewing a

<sup>205</sup> *Id.* at 268.

<sup>206</sup> *Sofa Entm't, Inc. v. Dodger Productions, Inc.*, 782 F. Supp. 2d 898 (C.D. Cal. 2010).

<sup>207</sup> *Id.* at 900.

<sup>208</sup> *Id.* at 903.

<sup>209</sup> *Id.* at 904.

<sup>210</sup> *Id.* at 906 (noting that the commercial aspect was accorded marginal weight).

<sup>211</sup> *Id.* at 905.

<sup>212</sup> *Id.* (internal quotation marks omitted).

<sup>213</sup> *Id.* (citing *Elvis Presley Enterprises, Inc. v. Passport Video*, 349 F.3d 622 (9th Cir. 2003)).

<sup>214</sup> *Gaylord v. U.S.*, 595 F.3d 1364 (Fed. Cir. 2010).

<sup>215</sup> *Gaylord*, the plaintiff, is the sculptor of the Korean War Memorial in Washington D.C. He holds copyrights on *The Column*, which is the name Mr. Gaylord coined for his art installation. Shortly after the installation, John Alli took a photo of the sculpture and started selling prints. To his credit, Mr. Alli sought a copyright license and located Mr. Lecky, who held himself out as the owner of the relevant copyrights. In turn, the U.S. Postal Service selected one of Mr. Alli's photographs for a stamp commemorating the Korean War. *Id.* at 1368.

photograph of statues or actual human beings. . . . Mr. Alli's efforts resulted in a work that has a new and different character than "The Column" and is thus a transformative work.<sup>216</sup>

On appeal, the Federal Circuit made it clear that "the inquiry must focus on the purpose and character of the stamp, rather than that of Mr. Alli's photograph."<sup>217</sup> Thus, the Court of Federal Claims erred when they failed to realize that the stamp did not reflect any further purpose than that of *The Column*.<sup>218</sup> Without adding a new purpose to the use, the government did not transform its character. As reasoned by the Federal Circuit:

[A]lterations do no impart a different character to the work. To the extent that the stamp has a surreal character, The Column and its soldiers themselves contribute to that character. . . . Capturing The Column on a cold morning after a snow storm—rather than on a warm sunny day—does not transform its character . . . . Nature's decision to snow cannot deprive Mr. Gaylord of an otherwise valid right to exclude.<sup>219</sup>

*Gaylord* is insightful because a subtle distinction in how one focuses on the copyrighted and secondary works may result in opposite conclusions with respect to transformativeness.

## B. A Summary of Transformative Use Legal Theories

The aforementioned cases provide insight with respect to the recent role of transformative use in a fair use analysis. In each of *Gaylord*, *House of Bryant*, *Salinger*, and *Reyes* the courts held the secondary uses to be copyright infringement because such uses failed to add something new and/or otherwise interfered with the copyright owner's commercial market. By contrast, in *Sedgwick* and *Murphy* (altered photo) the courts found that the secondary uses had changed the content in a manner that was transformative. In *Vanderhye*, *Murphy* (the unaltered photo), *Monge*, *Spurlock*, and *Sofa* the courts each concluded that the secondary uses were transformative because the copyrighted works were used for a different purpose.

In particular, the court in *Spurlock* found that the secondary use transformed the original because the purpose of the artwork was distinct under the collage effect theory set out in *Bill Graham*.<sup>220</sup> In *Sofa*, the secondary use was found to be transformed under the historical reference point theory set out in *Elvis Presley Enterprises*.<sup>221</sup> Both the

<sup>216</sup> *Gaylord v. U.S.*, 85 Fed.Cl. 59, 68-69 (Fed. Cl. 2008).

<sup>217</sup> 595 F.3d at 1373.

<sup>218</sup> *Id.*

<sup>219</sup> *Id.* at 1373-1374.

<sup>220</sup> *Warren Publishing Co. v. Spurlock*, 645 F. Supp.2d 402, 419-20 (E.D. Pa. 2009) (The court found: "In comparing Bill Graham to the facts at hand, the Second Circuit's analysis illustrates the differences between the Gogos Book and Plaintiff's magazine covers that establish the transformative nature of the use. . . . Many of the images were reduced in size, had the cover text and the magazine title logo removed, and were the subject of criticism and commentary adjacent to the art.").

<sup>221</sup> 782 F. Supp. 2d 898, 905 (C.D. Cal. 2010) ("Defendant's use of the Clip in *Jersey Boys* represents a transformative use because it is 'cited as a historical reference point' in the Four Seasons' career, which

collage effect and historical reference point theories are applicable to *Bouchat v. Baltimore Ravens* because the purpose for using the *Flying B Logo* was to document the history of the Ravens and its use in the films reduced its expressive value by combining it with team highlights and commentary. *Monge* is also applicable to *Bouchat* because the purpose of using the copyrighted work in that case was to demonstrate a truth. Similarly, in *Bouchat* the purpose of using the *Flying B Logo* was to document particular football highlights in a film for each of the Ravens' first three seasons.

### C. A Summary of Transformative Use in the Fourth Circuit

The Fourth Circuit had only one occasion to examine the doctrine of transformative use prior to the two 2010 appellate decisions, *Vanderhye* and *Bouchat*. In *Sundeman v. The Seajay Society, Inc.*,<sup>222</sup> the executor of a Pulitzer Prize winning author<sup>223</sup> brought suit against a non-profit organization because an officer of the organization used a copy of the author's unpublished book in order to prepare a literary review paper. The Fourth Circuit concluded that although the officer of the Seajay Society quoted and paraphrased a substantial portion of the unpublished book, the use was transformative because the purpose of the paper was to criticize and comment on the book.<sup>224</sup> The court's rationale is set forth below.

A reading of Blythe's paper clearly indicates that she attempted to shed light on Rawlings' development as a young author, review the quality of *Blood of My Blood*, and comment on the relationship between Rawlings and her mother. The "further purpose" and "different character" of Blythe's work make it transformative, rather than an attempt to merely supersede *Blood of My Blood*.<sup>225</sup>

In the opinion, the Fourth Circuit noted that the inquiry for the first fair use factor may be guided by the uses outlined in the preamble of Section 107<sup>226</sup> and it agreed with the district court's characterization of the secondary use.<sup>227</sup> The district court stated that the paper is "a scholarly appraisal of *Blood of My Blood* from biographical and literary perspective."<sup>228</sup> In agreement with most cases in which a court finds the secondary use transformative, here the Fourth Circuit's overall determination was that The Seajay Society's use of the unpublished book was a fair use.

---

use the Ninth Circuit has contrasted with uses the 'serve the same intrinsic entertainment value that is protected' by the copyright in the copied work.") (quoting *Elvis Presley Enterprises, Inc. v. Passport Video*, 349 F.3d 622, 629 (9th Cir. 2003)).

<sup>222</sup> *Sundeman v. The Seajay Society, Inc.*, 142 F.3d 194 (4th Cir. 1998).

<sup>223</sup> *Id.* at 197 (Marjorie Kinnan Rawlings Baskin was the author of *The Yearling*, which won the 1939 Pulitzer Prize. John Sundeman brought suit on her behalf.).

<sup>224</sup> *Id.* at 202-03.

<sup>225</sup> *Id.* at 202.

<sup>226</sup> 17 U.S.C. § 107 (2006) ("[T]he fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.")

<sup>227</sup> *Sundeman*, 142 F.3d at 202.

<sup>228</sup> 142 F.3d at 202 (quoting *Baskin v. Seajay Society, Inc.*, No. 3:90-1100-0, at 30 (D.S.C. Feb. 5, 1997)).

Fourth Circuit precedent, as well as the other recent cases in which the federal courts have analyzed transformative use, provide a legal context for revisiting the decision in *Bouchat v. Baltimore Ravens*. As the aforementioned cases reveal, a finding that the secondary use was transformative is likely to be dispositive for the overall conclusion of fair use.

In the next section, the secondary uses in *Bouchat v. Baltimore Ravens* are reexamined in light of the fair use determinations provided in Part IV, in view of the two alternative fair use tests provided in Part III, in view of the secondary user's need to use the copyrighted work to benefit the public, and in view of the author's right to produce a derivative work of the copyrighted work.

## V. REVISITING *BOUCHAT V. BALTIMORE RAVENS*

### A. In View of Recent Case Law

The secondary use of the *Flying B Logo* in the NFL season highlight videos presented an interesting legal question in *Bouchat v. Baltimore Ravens* because the use invokes the reasoning of several court opinions. First, the secondary use is analogous to the collage effect theory in *Bill Graham* and *Spurlock*. In those cases and in *Bouchat* the copyrighted work was blended with other images or text and presented with commentary. However, the courts in *Bill Graham* and *Spurlock* concluded that the secondary uses were transformative,<sup>229</sup> whereas the Fourth Circuit concluded that the use of the *Flying B Logo* in highlight videos was non-transformative.<sup>230</sup>

Second, the highlight videos invoke the historical reference point theory that was set out in *Elvis Presley Enterprises* and *Sofa*. In those cases, an excerpt from *The Ed Sullivan Show* was taken to provide a historic reference point for the story. In *Sofa*, the play was about the *Four Seasons*, whereas in *Elvis Presley Enterprises*, the documentary was about Elvis Presley. Neither of the secondary uses was about *The Ed Sullivan Show*, exemplifying the fact that a secondary use does not have to be about the copyrighted work from which it was taken.<sup>231</sup> Similarly, the defendant in *Spurlock* successfully argued that his secondary use of Basil Gogos' artwork was transformative because he used the artwork as historical artifacts.

In *Bouchat*, the Ravens use of the *Flying B Logo* in the highlight films provided a historic reference point. A fan watching a video from the years 1996–1998 would gain factual insight about the Ravens logo and uniform even though the films were not about the logo. However, the majority marginalized the film's commentary: "The narrator in the films never comments on the controversy surrounding the use of the Flying B logo.

---

<sup>229</sup> See *supra* Parts II.B.1, IV.A.

<sup>230</sup> See *supra* text accompanying notes 33–34.

<sup>231</sup> In fact, the Fourth Circuit invoked this point in *Vanderhye*. There, it argued that the copy made by the plagiarism technology transformed the original student work because it served a different purpose and it was unrelated to the expressive content.

Nor are the films a documentary on the history of the Ravens logo.”<sup>232</sup> On the contrary, a Ravens fan in the current era would not recognize the *Flying B Logo* as the Raven’s current trademark. The *Flying B Logo* is no longer used and is in fact a historical artifact that is used in a larger context about the Ravens.

Third, the *Flying B logo* used by the Ravens in the highlight videos was unaltered, which is comparable to the unaltered photo in *Murphy* and the unaltered homework paper in *Vanderhye*. In *Murphy*, the court concluded that the secondary use was transformative because it served a different purpose (inform visitors of the station’s website) than the original purpose (document the reception of an award). In *Vanderhye* the court rationalized that the secondary use was for a different purpose (detecting and discouraging plagiarism) than the original purpose (expressive content). However, in *Bouchat*, the Fourth Circuit failed to be influenced by the fact that the defendant’s use of the *Flying B Logo* was to document the early Ravens’ seasons, whereas Bouchat created his *Shield Drawing* as a helmet logo.

Finally, the NFL highlight videos were commercial in nature, as was the defendant’s plagiarism machine in *Vanderhye*. There, the Fourth Circuit reasoned that even though the defendant’s plagiarism machine was commercial in nature, the fourth fair use factor did not favor the plaintiff because the system did not serve as a market substitute. In contrast to that rationale, the Fourth Circuit refused to dismiss the commercial nature of the highlight videos in *Bouchat* even though the plaintiff was not at risk of losing his market opportunity.

Accordingly, it is Judge Niemeyer’s dissenting opinion in *Bouchat* rather than Judge Michael’s majority opinion that is more consistent with the application of transformative use in recent case law.

## **B. In View of Non-Transformative Fair Use Tests**

If *Bouchat* is examined from the perspective of the audience under the distinct and separate discursive community test, then the use of the *Flying B Logo* in highlight videos would be considered a fair use. There are essentially two communities of fans that may be interested in the highlight videos of the early seasons bearing the *Flying B Logo*. One community would include an audience of people that were football fans in 1996–1998. Another community would include an audience of current football fans that were not alive or old enough during that era to be football fans and they may have never seen the original Ravens uniforms.

The latter audience more obviously represents a separate discursive community because they may have never seen the *Flying B Logo* before. The former audience, even if they had previously watched the Ravens games in 1996–1998, would still represent a separate discursive community because their perspective is different. In actuality, the two communities are one audience that would watch the highlight films from a historical or documentary perspective. It is easy to envisage the perspective of someone watching the

---

<sup>232</sup> *Bouchat v. Baltimore Ravens Ltd. P’ship*, 619 F.3d 301, 309 (4th Cir. 2010).



Ravens of the past and conclude that such viewers are interested in the historical nature of the films (as each football team's roster is different from year to year). As such, the purpose of the secondary use of the *Flying B Logo* would be primarily historical and biographical in nature, as it represents a relic of the past.

This test also provides a reason to dismiss the plaintiff's desired relief. An injunction and possible destruction of the films would harm the public. The NFL would be thwarted from creating such works and football fans would not have the ability to see highlights of the early Ravens seasons. When new works are prevented from being delivered to the public the ultimate goal of copyright is denied. The Fourth Circuit failed to consider the net negative effect of finding copyright infringement in this context.

Under the foreseeability copying test, the use of the *Flying B Logo* in highlight videos would be considered a fair use. Bouchat originally created his *Shield Drawing* for use as a symbol on the Ravens uniforms and helmets. It is true that the NFL sold other highlight videos at the time he authored the drawing, suggesting that the secondary uses might have been foreseeable for the NFL. However, such future uses of his *Shield Drawing* would not have been foreseeable to the plaintiff. Because the Ravens and the NFL own the broadcasting rights to their televised games, only those parties had a legal right to produce highlight films. Thus, the highlight films may have been foreseeable, but they would not have been a foreseeable market for Bouchat's *Shield Drawing*.<sup>233</sup>

### C. In View of Necessity

The most analogous precedential support for Judge Michael's opinion is the Second Circuit's decision in *Ringgold v. Black Entertainment Television, Inc.*<sup>234</sup> In *Ringgold*, the defendant used a copyrighted poster as a prop in a television set. The court concluded that the purpose of the defendant's use was not transformative: "Nothing that the defendants have done with the poster 'supplants' the original or 'adds something new.' The defendants have used the poster to decorate their set to make it more attractive to television viewers precisely as a poster purchaser would use it to decorate a home."<sup>235</sup> *Ringgold* illustrates that movies, posters and other visual works cannot easily be blended with comment or other images to establish a collage effect that meets the threshold for transformativeness. Similarly, the Ravens used the *Flying B Logo* in highlight videos and the videos were not commenting on the logo.<sup>236</sup> Accordingly, it is easy to analogize *Ringgold* to the secondary use in *Bouchat*.

However, the purpose of using the *Flying B Logo* in the highlight videos is distinguishable from the purpose of using the poster in *Ringgold*. The highlight videos were about the Baltimore Ravens; therefore, the use of the *Flying B Logo* was *necessary*

---

<sup>233</sup> Bouchat v. Baltimore Ravens Limited Partnership, 587 F. Supp. 2d 686, 696-697 (D. Md. 2008) ("There is nothing to indicate that there is any present or foreseeable market whatsoever for the copyright protected work. Hence, the uses in issue do not have any effect upon the potential market for, or value of, the copyrighted work.")

<sup>234</sup> Ringgold v. Black Entertainment Television, 126 F.3d 70 (2d Cir. 1997).

<sup>235</sup> *Id.* at 79.

<sup>236</sup> *Bouchat*, 619 F.3d at 309.

to make the video. Accordingly, the purpose of using the *Flying B Logo* merges with the purpose of making the video, which was to document the first three seasons of the Baltimore Ravens. In contrast, the defendants in *Ringgold* used the copyrighted poster to create an image of a past era. Such a use was not necessary to the television show because an endless amount of artwork would have sufficed to create the desired atmosphere.

Similarly, the result in *House of Bryant* is distinguishable. There, the use of “Rocky Top” was not necessary in order to make the television show. Any number of songs could have been selected to invoke the culture of Tennessee. Or, because of the television medium, video could have served that function. In *Bouchat*, the Ravens and the NFL would have not been able to make a highlight film of the Ravens without the uniform that bears the *Flying B Logo*.

#### D. In View of the Derivative Work Right

The Ravens and the NFL owned the broadcast rights (copyright) for the games played during the 1996–1998 seasons. Therefore, those entities collectively owned any right to create derivative works. The highlight films at issue in *Bouchat* represent a derivative work of the originally broadcasted Ravens games. The films included edited parts of the Ravens games that were specifically adapted and transformed for their secondary use.<sup>237</sup> In addition to the editing and splicing of various game films, the highlight films also included a narrative.

In the context of the transformative use precedents outlined above, the blending of edited games with the narrator’s commentary adds something new. The purpose of the films was to document each of the Ravens first three seasons. The fact that the copyrighted *Flying B Logo* is apparent and unchanged in the films does not render the use of the logo non-transformative. Just as any biography or documentary needs to incorporate facts regarding the subject of the matter, the NFL films required the incorporation of the *Flying B Logo* in each of its films.

By contrast, the Second Circuit concluded that *The SAT* trivia game in *Castle Rock* was non-transformative because it failed to add something new. The court reasoned that the purpose of the trivia game at issue was not to add commentary or criticism of *Seinfeld*, but merely to repackage the television show into a game—an exclusive derivative work right that Castle Rock Entertainment owned.

## VI. CONCLUSION

This article examined the Fourth Circuit opinions in *Bouchat v. Baltimore Ravens*, in which transformative use played an important role in copyright infringement and fair use analyses for two secondary uses of the *Flying B Logo*. It was determined that the case was decided incorrectly with respect to the use of the *Flying B Logo* in season highlight

---

<sup>237</sup> *Id.* at 306-07 (“The highlight films contain actual game footage, edited with slow motion effects, musical scores, and a narration.”).

films of the Baltimore Ravens because the majority opinion failed to acknowledge that the copyrighted work is a historical artifact that was used out of necessity in order to provide an accurate documentary to the public. Further, the majority opinion overemphasized the commercial nature of the secondary use in its fair use analysis. Since nearly all uses of copyrighted work are commercial in nature, such considerations are only persuasive when a secondary use supersedes the copyrighted work. In *Bouchat*, the Baltimore Ravens and the NFL did not supplant the plaintiff's market for his *Shield Drawing* because season highlight videos were not a foreseeable market for the plaintiff.

The dissent recognized that the use the *Flying B Logo* was incidental and necessary, within a larger context (the highlight film), and for the purpose of documenting history. Such an argument is consistent with the other secondary use in *Bouchat* that was determined to be transformative (the display of the *Flying B Logo* on old tickets and on team uniforms and helmets within two large photographs found at the Ravens' corporate lobby). Further, the dissenting opinion is more consistent with the two other transformative use decisions from the Fourth Circuit as well as the recent federal court opinions that analyzed transformative use in 2009-2010. In addition, a summary of two recently proposed fair use alternative methodologies was presented, wherein an alleged copyright infringement is examined under a distinct and separate discursive community test and a foreseeability copying test. In *Bouchat*, it is the dissenting opinion that passes those supplemental tests because the use of the *Flying B Logo* in season highlight films was not foreseeable to the plaintiff at the time of its creation and the films were created for distinct future audience rather than the audience at the time of its creation.

In this article, I established that when the facts of *Bouchat v. Baltimore Ravens* are reviewed in context of recent legal theories, Fourth Circuit precedent, non-statutory fair use tests, and public welfare, the dissenting opinion correctly determines that using the *Flying B Logo* in season highlight films of the Ravens was a fair use.