

One Test, Two Test: The Ninth Circuit Further Entangles Copyright Fair Use

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I. OVERVIEW

In mid-2016, with nearly \$30,000 of crowdsourced money in hand and no license in the other, ComicMix LLC (ComicMix) placed a conditional order for 5,000 copies of their book *Oh, the Places You’ll Boldly Go! (Boldly)*.¹ The not-so-subtle Trekian take on Dr. Seuss’s famously inspiring *Oh, the Places You’ll Go! (Go!)* garnered quick attention from ecommerce retailers, hoping to get in on what was sure to be a windfall.² Unfortunately for ComicMix, the grand idea caught the eye of Dr. Seuss Enterprises, L.P. (Seuss), which was used to dealing with licensed works and collaborations.³ Seeing its intellectual property used without authorization, Seuss quickly sent a cease-and-desist letter to ComicMix, which claimed *Boldly* to be a fair use of *Go!*⁴ Seuss also sent notice to Kickstarter—the crowdsourcing platform hosting ComicMix’s fundraising effort—that took down ComicMix’s campaign and blocked their raised funds.⁵

Without cooperation from ComicMix, Seuss filed suit for copyright infringement, trademark infringement, and unfair competition.⁶ The District Court for the Southern District of California dismissed the trademark claim and denied Seuss’s motion for summary judgment on the matter of copyright infringement.⁷ However, on appeal, the Ninth Circuit considered ComicMix’s fair use defense and outlined a restrictive three-

1. Dr. Seuss Enters., L.P. v. ComicMix LLC, 983 F.3d 443, 449 (9th Cir. 2020).

2. *Id.*

3. *Id.* at 450.

4. *Id.*

5. *Id.*

6. *Id.*

7. *Id.*

pronged test to judge a work's transformative use.⁸ Using this new test, the Ninth Circuit found that *Boldly* merely “repackage[d]” *Go!* in to a new format, rather than changing or transforming its “expression, meaning, or message.”⁹ The United States Court of Appeals for the Ninth Circuit held that ComicMix’s mash-up use of Seuss’s intellectual property was not transformative and was thereby not fair use. *Dr. Seuss Enterprises, L.P. v. ComicMix LLC*, 983 F.3d 443 (9th Cir. 2020).

II. BACKGROUND

The exclusive rights of copyright guaranteed in the Constitution are not meant merely to grant individuals security over their “[w]ritings.”¹⁰ Rather, copyrights are in part designed “[t]o promote the Progress of Science.”¹¹ The inherent tension in this goal—promoting progress while securing intellectual property rights—has long been considered by courts.¹² The common law developed to avoid an absolute rule protecting an owner’s intellectual property, offering redress where enforcement “would stifle the very creativity which that law is designed to foster.”¹³ This common law approach was codified in the 1976 Copyright Act, which presented courts with a balancing test that considers “the purpose and character of the use,” “the nature of the copyrighted work,” “the amount and substantiality of the portion used,” and the effect on the copyrighted work’s market.¹⁴ These four factors serve as an informative guide but are not ultimately dispositive.¹⁵ Rather, courts are concerned with whether copyright’s constitutional goal is “better served by allowing the use than by preventing it.”¹⁶

8. *Id.* at 451-53.

9. *Id.* at 454-55.

10. U.S. CONST. art. I, § 8, cl.8.

11. *Id.*; see *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 575 (1994) (“[f]rom the infancy of copyright protection, some opportunity for fair use of copyrighted materials has been thought necessary to fulfill copyright’s very purpose”).

12. U.S. CONST. art. I, § 8, cl.8.; see, e.g., H.R. Rep. No. 94-1476, at 65 (1976) (recognizing the history of courts applying a fair use reasoning before codification).

13. *Stewart v. Abend*, 495 U.S. 207, 236-37 (1990) (quoting *Iowa State Univ. Rsch. Found., Inc. v. Am. Broad. Cos.*, 621 F.2d 57, 60 (2d Cir. 1990)).

14. 17 U.S.C. § 107 (1976); see, e.g., *Folsom v. Marsh*, 9 F.Cas. 342, 348 (CCD Mass. 1841) (No. 4,901) (J. Story explaining the factors used in determining potential fair use as “nature and objects of the selections made, the quantity and value of the materials used, and the degree in which the use may prejudice the sale . . . of the original work”).

15. *Castle Rock Ent., Inc. v. Carol Publ’g Grp., Inc.*, 150 F.3d 132, 141 (2d Cir. 1998) (quoting *Arica Inst., Inc. v. Palmer*, 970 F.2d 1067, 1077 (2d Cir. 1992)).

16. *Id.*

While fair use's "porous nature" serves, at least in part, the ability to preserve copyright's constitutional purpose, it leaves undefined the test's factors and their relative weight.¹⁷ Such opacity in the law is a necessary evil. Courts and scholars have appreciated the ontological truth that "all intellectual creative activity is in part derivative."¹⁸ Plainly, there exists room for "reasonable disagreement" as to whether a set of facts weighs a factor a certain way.¹⁹

However, the Supreme Court grants noticeably more weight to the first and fourth of the fair use factors.²⁰ Focusing on the character of the use and its market effects, the Court has provided more strict guidance than presented in common law.²¹ This focus is at the core of copyright's dichotomy, attempting to promote both individual security and technological progress.²² In this context, it is important to note that while infringement that tends to further its relevant field is not *per se* fair use, a commercial use of a copyrighted work is not *per se* unfair.²³ This rejection of the categorical rule is simply a reinforcement of the balancing test long practiced at common law.²⁴

Accepting the somewhat esoteric properties of the fair use test, the Supreme Court recognized the relative impact of an infringement's market effects in two landmark cases. In *Harper & Row, Publishers v. Nation Enterprises*, the Court found that the defendant's publication of an excerpt from President Gerald Ford's memoir was not fair use.²⁵ Granting substantive weight to news reporting and commercial purposes, the Court identified the market effect of the fourth factor as "the single most important element of fair use."²⁶

17. *Monge v. Maya Mags., Inc.*, 688 F.3d 1164, 1171 (9th Cir. 2012); see *Princeton Univ. Press v. Mich. Document Servs.*, 99 F.3d 1381, 1392 (6th Cir. 1996) ("Fair use is one of the most unsettled areas of the law . . . [it is] so flexible as virtually to defy definition").

18. Pierre N. Leval, *Commentary: Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1109; see, e.g., *Campbell*, 510 U.S. at 575.

19. *Princeton*, 99 F.3d at 1392; 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.05(A) (1996).

20. See *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 579 ("[transformative] works thus lie at the heart of the fair use doctrine's guarantee . . . and the more transformative the new work, the less will be the significance of other factors").

21. *Monge*, 688 F.3d at 1171 (finding a "shift in analytical emphasis" by the Supreme Court).

22. NIMMER & NIMMER, *supra* note 19, § 13.05(A)(1)(a).

23. *Id.* § 13.05; *Campbell*, 510 U.S. at 585.

24. See *Maxtone-Graham v. Burtchaeil*, 803 F.2d 1253, 1262 (2d Cir. 1986) ("We do not read . . . [the Supreme Court's decision in *Sony Corp. of Am. V. Universal City Studios, Inc.*, 464 U.S. 417, 451 (1984)] as altering the traditional multi-factor fair use inquiry").

25. 471 U.S. 539, 568-69 (1985).

26. *Id.* at 566 (referencing NIMMER & NIMMER, *supra* note 19, § 13.05(A)).

The Court's emphasis on the fourth factor was only complicated in *Campbell v. Acuff-Rose Music, Inc.*²⁷ There the Court clarified that the first factor's "central purpose" was whether the new use was "transformative."²⁸ Such a requirement was derived from Justice Story's formulation that a fair use should not merely "supersede the objects' of the original" but "alter[] the first with new expression, meaning, or message."²⁹ A work's transformative nature ensures that it fulfills the objective of copyright law, "to promote science and the arts."³⁰ Though a transformative use is not "absolutely necessary" for fair use, its finding does lessen the importance of other factors.³¹

Where the copying work is transformative, the *Campbell* Court notes that "market substitution is at least less certain," and that market harm to possible derivative works is not easily definable.³² Simply put, where a second work does not supersede the original, its effects on the original's market are likely insignificant or fair.³³ Similarly, where a second work affects the market of the original, it likely does not change the "expression, meaning, or message" enough to be transformative.³⁴ However, the inverse is not true.³⁵ Lower courts seem to have missed this insight, finding unfair use where there is market harm—despite *Campbell's* refinement of the doctrine.³⁶

The Supreme Court's emphatic focus on the first and fourth factors of the fair use test has led lower courts to consider transformative use as nearly dispositive.³⁷ The fourth factor has been similarly decisive.³⁸ Instead of balancing the four factors in light of the purposes of copyright, courts have fallen into the easier practice of weighing the parties' interests

27. *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 575 (1994).

28. *Id.* at 579.

29. *Id.* (quoting *Folsom v. Marsh*, 9 F.Cas. 342, 348 (CCD Mass. 1841) (No. 4,901)).

30. *Id.*; accord *Leval*, *supra* note 18, at 1111.

31. *Campbell*, 510 U.S. at 578-79 ("the more transformative the new work, the less will be the significance of other factors, like commercialism"); see *NIMMER & NIMMER*, *supra* note 19, at § 13.05(A)(1)(b).

32. *Campbell*, 510 U.S. at 591.

33. *Id.* at 579, 591.

34. *Id.* at 579.

35. *Leval*, *supra* note 18, at 1124 ("The fact that the secondary use does not harm the market for the original gives no assurance that the secondary use is justified").

36. Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978-2005*, 156 U. PA. L. REV. 549, 618-19 (2008).

37. *Id.* at 605, 618-19; see also *NIMMER & NIMMER*, *supra* note 19, § 13.05(A)(1)(b) ("many of the applications treated above are conclusory—they appear to label a use "not transformative" as a shorthand for "not fair").

38. Beebe, *supra* note 36, at 618.

against one another.³⁹ The test now appears to balance the alleged infringer's justifications for use per the first three factors, informed primarily by transformativeness, and the market effect of that use as measured by the fourth factor.⁴⁰

The Ninth Circuit displayed *Campbell's* dispositive reasoning in *Seltzer v. Green Day, Inc.*⁴¹ There, the court described a transformative use as one that includes some new expressive content or message.⁴² In analyzing Green Day's alleged infringement, the court noted that the original work was used as a raw material, or component, to build a larger artistic expression.⁴³ Further, the court found that Green Day assuredly changed the meaning of the original work by imposing crosses over it.⁴⁴ However, in its analysis, the court gave little attention to the second and third factors, focusing its analysis primarily on transformativeness and the lack of evidential support for market harm.⁴⁵

Although the Supreme Court eschewed the reasoning proffered in its earlier decisions, there remains confusion.⁴⁶ Not only do lower courts now hold the first and fourth factors as virtually dispositive, but the import of transformativeness from *Campbell* has commandeered the analysis for all fair use factors.⁴⁷ Adding to the confusion is the indeterminacy of transformativeness, a subfactor of the already purposely indeterminate fair use factors.⁴⁸ Though transformativeness necessarily evaluates and

39. *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 578 (1994); Beebe, *supra* note 36, at 621.

40. *Id.*

41. *Seltzer v. Green Day, Inc.*, 725 F.3d 1170, 1176-77 (9th Cir. 2013).

42. *Seltzer*, 725 F.3d at 1176-77.

43. *Id.* at 1176.

44. *Id.* at 1177.

45. *Id.* at 1176-79.

46. *Cf. Campbell v. Acuff-Rose Music*, 510 U.S. 569, 591 (1994) (“No ‘presumption’ or inference of market harm that might find support in *Sony* is applicable to a case involving something beyond mere duplication for commercial purposes”), *with Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 451 (1984) (“every commercial use of copyrighted material is presumptively . . . unfair”), *and Harper & Row, Publishers v. Nation Enters.*, 471 U.S. 539, 566-67 (1985) (referencing *NIMMER & NIMMER*, *supra* note 19, at § 1.10(D)) (“This last factor is undoubtedly the single most important element of fair use”); Beebe, *supra* note 36, at 597.

47. *See generally, Campbell*, 510 U.S. at 580-86, 591; *see, e.g., Davis v. Gap, Inc.*, 246 F.3d 152, 175-76 (2d Cir. 2001) (analyzing transformativeness in relation to every factor apart from the nature of the copyrighted work, which it notes is “rarely found to be determinative”); *see also Cariou v. Prince*, 714 F.3d 694, 711 (2d Cir. 2013) (equating fair use analysis with transformativeness).

48. *See TCA TV Corp. v. McCollum*, 839 F.3d 168, 180-81 (2d Cir. 2016) (noting the lack of guidance for answering whether and to what extent the new work is transformative).

compares the original and derivative works' purposes, there is no guidance or test for a use to qualify as transformative.⁴⁹

III. COURT'S DECISION

In the noted case, the Ninth Circuit developed a three-factor test to determine transformative use.⁵⁰ In doing so, the court followed the 1976 Copyright Act, holding all four factors are to be “explored, and the results weighed together, in light of the purposes of copyright.”⁵¹ Further, the court emphasized the Supreme Court's “eschew[ing of] ‘bright line rules’ and ‘categories of presumptively fair use’” in favor of a case-by-case analysis.⁵² Ultimately finding every factor to “decisively” weigh against ComicMix's use, with no countervailing copyright principles to support it, the court practiced its own explanation of the Copyright Act.⁵³ However, the court granted “heightened significance” to the first factor, which is itself entirely dependent on the transformative use of the new work.⁵⁴

Though the term “transformative” does not appear in 17 U.S.C. § 107, the court recognizes that it has become the central purpose of first factor analysis.⁵⁵ Adopting the *Campbell* definition, the court explains that a transformative work is one that “adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message.”⁵⁶ Under this definition, mash-ups can decidedly be a fair use—though the question remains as to whether they are transformative.⁵⁷ Answering this question, the court creates a new test that emphasizes the “benchmarks of transformative use,” being (1) further purpose or different character, (2) addition of new expression, meaning, or message to the original, and (3) use of quoted matter as “raw material” rather than merely superseding the original.⁵⁸ The court found that *Boldly*

49. Neil W. Netanel, *Making Sense of Fair Use*, 15 LEWIS & CLARK L. REV. 715, 750 (2011) (“neither the test nor precedent provides dispositive rules for how broad the relevant categories of expressive purpose should be, and just how different the defendant's expressive purpose must be from that of the author”).

50. *Dr. Seuss Enters., L.P. v. ComicMix LLC*, 983 F.3d 443, 453 (9th Cir. 2020) (quoting *Campbell*, 510 U.S. at 578).

51. *Seuss*, 983 F.3d at 451.

52. *Id.* (quoting *Campbell*, 501 U.S. at 577, 584).

53. *Id.* at 451, 455-56, 458, 461.

54. *Id.* at 451-52 (indicating the heightened significance of transformativeness goes on to influence the court's evaluations of the third and fourth factors).

55. *Id.* at 452.

56. *Id.* (citing *Campbell*, 510 U.S. at 579).

57. *Seuss*, 983 F.3d at 452.

58. *Id.* at 453 (referencing *Campbell*, 510 U.S. at 579, with *Seltzer v. Green Day, Inc.*, 725 F.3d 1170, 1176 (9th Cir. 2013)).

possessed none of the benchmarks and instead merely superseded or “repackaged” *Go!* without critique in commercial use.⁵⁹

First, the court found that “the addition of new expression to an existing work is not a get-out-of-jail-free card.”⁶⁰ Though there was certainly new expression in *Boldly*, it still paralleled *Go!*’s purpose.⁶¹ ComicMix merely recontextualized *Go!* by taking “the most visually arresting excerpt[s]” and overlaying a Star Trek theme.⁶² *Boldly* did not provide a further purpose or create new insight to *Go!* and therefore failed to meet the first benchmark of transformation.⁶³

Second, the court found that *Boldly* did not “alter[] the original work” to add value by new expression, meaning, or message.⁶⁴ Again emphasizing ComicMix’s repackaging of *Go!*, the court found that *Boldly* merely took Seuss’s already illustrated “story shell” and overlaid a story of the Enterprise crew.⁶⁵ In short, *Boldly* did not change *Go!*, it just copied it.⁶⁶ In fact, the court notes that ComicMix did not intend to alter it at all.⁶⁷ Rather, ComicMix wanted the attention a Seuss imitation would bring and wanted to avoid the drudgery of creating something fresh.⁶⁸

Third, the court analyzed the extent of ComicMix’s supersedure and repackaging of *Go!*⁶⁹ In what the court termed the most telling sign of non-transformative use, *Boldly* did not take the “raw material” of *Go!* to build its own work, but merely copied and pasted the original work.⁷⁰ A slew of famous scenes from Seuss’s original work are copied in minute detail and spattered with Star Trek themes and characters.⁷¹ The waiting place in *Go!* is copied down to the couch, fishing spot, and the placement of the characters therein.⁷² A scene in *Sneetches* is copied down to the shape of the hills in the background, the placement of the footprints in the sand, and

59. *Id.* at 455.

60. *Id.* at 453.

61. *Id.* at 454.

62. *L.A. News Serv. v. CBS Broad., Inc.*, 305 F.3d 924, 938-39 (9th Cir. 2002).

63. *Seuss*, 983 F.3d at 454-55.

64. *Id.*; *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1164 (9th Cir. 2007).

65. *Seuss*, 983 F.3d at 454.

66. *Id.* at 454-55 (“*Go!* continues to carry the same expression, meaning, or message: as the *Boldly* text makes clear, the image conveys the sense of being stuck, with ‘time moving fast in the wink of an eye.’”).

67. *Id.* at 454.

68. *Id.*

69. *Id.* at 454-55.

70. *Id.* at 453-54.

71. *Id.*

72. *Id.*

the character's poses.⁷³ The original text was similarly unchanged.⁷⁴ In all, the court found that ComicMix's "repackaging, copying, and lack of critique of Seuss, coupled with its commercial use" did not result in a transformative use.⁷⁵ Therefore, the first factor weighed definitively against ComicMix.⁷⁶

The court made short work of the second fair use factor. Finding that creative works are closer to the core of copyright protection, the court held that *Boldly*'s copying of a creative work like *Go!* weighs the factor against ComicMix.⁷⁷

In analyzing the third factor, the court circled back to transformativeness because the "extent of permissible copying varies" with the character of the second work's use.⁷⁸ The court considered both the "quantitative amount and qualitative value" of the original work used in *Boldly*.⁷⁹ As previously analyzed, the court found *Boldly* to copy substantial portions of Seuss's original work, including fourteen of *Go!*'s twenty-four pages with "significant 'illustrations from *Grinch* and . . . *Sneetches*.'"⁸⁰ ComicMix's extensive copying was more than mere import of "a shape here and a color patch there," but an attempt to replicate the original.⁸¹ The court found that ComicMix took the "heart" of *Go!* in copying the highly expressive, identifiable illustrations and style, weighing the third factor against ComicMix.⁸²

Finally, the court addressed the adverse market effects ComicMix's use would have on Seuss's potential market.⁸³ To begin, the court took care noting that the burden of proof rested firmly on ComicMix as fair use is an affirmative defense.⁸⁴ However, ComicMix argued the burden shifted to Seuss, failing to argue the adequacy of its evidence in proving favorable

73. *Id.* at 455. (Sneetches are a bird-like character from a story called *The Zax*).

74. *Id.* at 455 (noting the *Boldly* illustrator tried to "match the structure of *Go!*" by comparing the two works side-by-side).

75. *Id.*

76. *Id.*

77. *Id.*

78. *Id.* at 456-58.

79. *Id.* at 456 (citing *Seltzer v. Green Day, Inc.*, 725 F.3d 1170, 1178 (9th Cir. 2013)).

80. *Id.* at 456.

81. *Id.* ("*Boldly* illustrator . . . stud[ied] the page [to] get a sense of what the layout was, and then copied the layout so that things are in the same place . . . [copying] the illustrations down to the last detail, even meticulously try[ing] to reproduce as much of the line work as [he could].") (internal quotations omitted).

82. *Id.* at 457-58.

83. *Id.* at 458-61.

84. *Id.* at 458; *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 590 (1994); *Harper & Row, Publishers v. Nation Enters.*, 471 U.S. 539, 561 (1985).

market effects.⁸⁵ Even if ComicMix had argued for its evidentiary adequacy, it would face the high burden of showing that Seuss's potential market would not be harmed by both (1) its particular actions and (2) the unrestricted, widespread use of conduct similar to its own.⁸⁶

The court found that *Boldly* adversely affected *Go!*'s market both individually and as a potential collective.⁸⁷ First, ComicMix intended to target the graduation market, in which *Go!* had a solid foothold.⁸⁸ Such a calculated release would affect *Go!*'s potential market.⁸⁹ Second, the court considered Seuss's extensive derivative market, including works and mash-ups ranging from collaborations with the Jim Henson Company to Funko, Inc.⁹⁰ With *Boldly*, ComicMix hoped to garner a potential derivative market and hold Seuss out for a "nice payday."⁹¹ Importantly, though ComicMix claims Seuss is unlikely to license *Boldly*, the court notes a potential market exists independent of the owner's intent.⁹² Lastly, should the court have allowed ComicMix's use, anyone looking to capitalize on Seuss's strong brand could have used its stories without permission.⁹³ Such an allowance is antithetical to the goals of copyright. The court found that such allowance would incentivize uncreative derivative works and disincentivize the continued development of Seuss's brand.⁹⁴ In summary, the court found *Boldly* to have a strong adverse effect on Seuss's potential market, corresponding with its analysis of ComicMix's unfair use.⁹⁵

IV. ANALYSIS

ComicMix's near-theft of *Go!* presents what at first seems like an opportunity for a straightforward analysis of the fair use doctrine. The extensive market implications immediately seem to favor infringement.⁹⁶ Under the test codified in Section 107, adverse market effects should be

85. *Seuss*, 983 F.3d at 459-60.

86. *Id.* at 458; *Campbell*, 510 U.S. at 590.

87. *Seuss*, 983 F.3d at 460-61.

88. *Id.* at 460.

89. *Id.*

90. *Id.* (Henson is of Muppets fame, and Funko, Inc. produces the popular Funko Pop figures).

91. *Id.*

92. *Id.* at 461 (quoting *Monge v. Maya Magazines, Inc.*, 688 F.3d 1164, 1181 (9th Cir. 2012)).

93. *Seuss*, 983 F.3d at 461.

94. *Id.* (quoting *Monge*, 688 F.3d at 1182).

95. *Id.* at 461.

96. *Id.* at 458-61.

considered alongside the use's purpose, the substantiality of the used portion, and the original work's nature to determine whether the new work furthers copyright's purpose.⁹⁷ However, the Ninth Circuit, in line with the fair use doctrine developed post-*Campbell*, placed conclusory weight on transformativeness in the first factor and weighed the third and fourth factors accordingly.⁹⁸ In doing so, the court attempted to rid itself of the porous fair use test and develop a new one.⁹⁹ The court's decision, however, may have further splintered the already fractured doctrine.

A. *How Far Are the Places One Must Go?*

The lack of guidance provided in Section 107 allows courts to justify its conclusions by analyzing the factors post hoc.¹⁰⁰ Though this could be a neutral effect considering the goal of the fair use defense, it provides an opportunity for inequitable and piecemeal adjudication.¹⁰¹ In the midst of apparent madness, the Ninth Circuit offered an alternative to *Campbell*'s transformativeness.¹⁰² The new test effectively replaces the four factors of fair use with the three-part *Seuss* transformative determination, balanced by commerciality of the use and weighed against the substantiality of the second work and its effect on the potential market of the original.¹⁰³ In practice, a finding of transformation will be nearly dispositive except where the second use is noncommercial, miniscule in comparison to the original, or occupies a market the original is unlikely to reach (i.e., parody, criticism, etc.).¹⁰⁴ However, the Ninth Circuit's test is neither significantly more clear nor more practicable than the foregoing factors.

97. 17 U.S.C. § 107 (1976); *Folsom v. Marsh*, 9 F.Cas. 342, 344-45 (CCD Mass. 1841) (No. 4,901).

98. See generally *Dr. Seuss Enters., L.P. v. ComicMix LLC*, 983 F.3d 443 (9th Cir. 2020); *Beebe*, *supra* note 36, at 618-19.

99. *Seuss*, 983 F.3d at 453-61; *Monge*, 688 F.3d at 1171.

100. *NIMMER & NIMMER*, *supra* note 19, at § 13.05(A)(5)(a).

101. *Castle Rock Ent., Inc. v. Carol Publ'g Grp, Inc.*, 150 F.3d 132, 141 (2d Cir. 1998) (quoting *Arica Inst., Inc. v. Palmer*, 970 F.2d 1067, 1077 (2d Cir. 1992)); see also *Educ. Testing Serv. v. Stanley H. Kaplan Educ. Ctr.*, 965 F.Supp 731, 736 (D.Md. 1997) (dispensing of the usual four-factor analysis as it would tend to confuse rather than aid analysis considering the facts and instead considering fair use as an equitable rule of reason).

102. *Seuss*, 983 F.3d at 453-54; see *Campbell v. Acuff-Rose Music*, 510 U.S. 569, 579 (1994) (citing *Leval*, *supra* note 18, at 1111).

103. *Seuss*, 983 F.3d at 453-61.

104. See *id.* at 460 (noting *Boldly* does not fill a market the owner will avoid or not reach, like a lethal parody or a scathing review); see also *Sofa Entm't, Inc. v. Dodger Prods.*, 709 F.3d 1273, 1278-79 (9th Cir. 2013) (finding a seven-second clip from original work to be transformative and insignificant).

The three parts of the transformation test are described as “benchmarks” of transformative use and as “telltale signs,” offering no guidance on their application to determine a work’s transformativeness.¹⁰⁵ Are the factors to be considered exclusively and weighed? Or are they meant to provide an inclusive checklist for a work? Is satisfying two of the factors sufficient to be transformative? The court’s analysis offers some explanation, though not significantly more than was already present for the codified four factors.¹⁰⁶

At face value, the first two benchmarks seem to overlap with one another. A “further purpose or different character” would seem to involve the addition of value or new meaning into the work and vice versa.¹⁰⁷ The court’s analysis reflects a muddled distinction between the first two benchmarks.¹⁰⁸ However, more telling is the third benchmark, which makes its way into both the first and second benchmarks’ analysis.¹⁰⁹ Instead of explaining how *Boldly* failed to express a further purpose or add a new expression, the court merely notes how *Go!* was kept intact by recontextualizing and repackaging—the essence of the third benchmark.¹¹⁰ The dispositive nature of the third benchmark seems to parallel transformative use’s decisive value in the four-factor test.¹¹¹ Perhaps the benchmarks are better understood as requiring one or both of (1) an additional expression and (2) a different purpose that does not supersede the original material but uses it as a foundation.¹¹² The *Seuss* transformation test sets a standard for lower courts to decide fair use by transformativeness, but it does so no more clearly than the original four-factor test.

105. *Seuss*, 983 F.3d at 453-54.

106. *See id.* at 453-61.

107. *Id.* at 454.

108. *Id.* at 453-54. (noting new expression, by itself, is not sufficient to carry a transformative use; rather, it must be accompanied by the benchmarks, which include new expression as an addition of value).

109. *Id.* (paralleling *Go!*’s purpose is merely “recontextualizing” it and “repackaging” *Go!*’s world into a new format is not an addition of value).

110. *Id.*

111. *See NIMMER & NIMMER*, *supra* note 19, at § 13.05(A)(1)(b) (noting referenced lower court applications treat “not transformative” as a shorthand for “not fair”).

112. *Id.* (acknowledging the two definitions of transformative use considered by lower courts—modifying the content or meaning—both suffer from overbreadth and indecisiveness); *see also Leval*, *supra* note 18, at 1111 (“The use must be productive and must employ the quoted matter in a different manner or for a different purpose from the original.”).

B. Too Soon to Split?

The Ninth Circuit's commitment to defining transformativeness, and to following the precedent of *Campbell* and *Seltzer*, is at odds with the Second Circuit's more recent decision in *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*. The Second Circuit in *Warhol* focused heavily on the first and fourth factors.¹¹³ While the Second Circuit properly found Andy Warhol's secondary works to not be transformative of the defendant's original photos, it also spun an unnecessary and complex web around the market effects of Warhol's work.¹¹⁴ The court even noted that the two markets do not overlap.¹¹⁵ Regardless, it continued to develop an analysis focusing on the licensing and potential markets of the original work, and the potential widespread use and public benefits of the secondary use.¹¹⁶ Finding Warhol's secondary work to adversely affect the original's markets and to not benefit the public, the Second Circuit was able to shoehorn the fourth factor, even where it was evident the markets did not overlap.

The uncanny relationship between these two decisions and their fact sets is immediately recognizable. In *Seuss, Boldly* clearly usurped (and intended to usurp) the actual and potential market for *Go!*, making what appears as a push on transformative use fall wayside.¹¹⁷ Oppositely, in *Warhol*, the non-transformative nature of Warhol's series is more evident, as is the clear market separation of the two works.¹¹⁸ The Ninth and Second Circuits, respectively, seem to focus and base their decisions on the wrong factors. Where the Ninth Circuit should have made the gist of its decision on *Boldly*'s market effect, the Second Circuit should have grounded its reasoning in Warhol's non-transformative use. In this way, the facts of each case seem better suited for the opposite decision.

Currently, the two approaches are similar enough. Both go through the steps of analyzing all four factors. However, the decisions signal a growing split in the focus of the courts.¹¹⁹ While the first and fourth factors are universally given the most weight, the Ninth Circuit unquestionably

113. *Andy Warhol Found. for Visual Arts, Inc. v. Goldsmith*, 11 F.4th 26, 37-44, 48-51 (2d Cir. 2021).

114. *Id.* at 48-51.

115. *Id.* at 48-49 (“the primary market for the Warhol Prince Series . . . and the Goldsmith Photograph do not meaningfully overlap . . . [and] Goldsmith does not contend that she has sought to license the Goldsmith Photograph itself”).

116. *Id.* at 49-51.

117. *Dr. Seuss Enters., L.P. v. ComicMix LLC*, 983 F.3d 443, 460-61 (9th Cir. 2020).

118. *Warhol*, 11 F.4th at 37-44, 48-51.

119. *Cf. Seuss*, 983 F.3d at 453-54, with *Warhol*, 11 F.4th at 48.

gives transformativeness dispositive power while the Second Circuit seems to prefer market effects as its decisive factor.¹²⁰ The courts' imposition of such decisive analyses, even where there are clear counterbalancing factors, shows the insistence of applying a definitive test to the first or fourth factors.¹²¹ The Circuits' differing scales could quickly result in disparate judgments. While these two cases offer strong examples of adverse market effects and non-transformative use, it is not difficult to imagine more uncertain facts that would result in differing judgments between the Circuits.

These separate approaches are a result of the unsolidified nature of the Supreme Court's fair use doctrine. Though the codified test is left purposefully vague, the Court has attempted to create a consistent analysis. While the Court may have intended to replace the market focus from *Harper & Row* with a transformativeness focus in *Campbell*, it did not do so clearly and refused to overturn any outdated analysis.¹²² The result is a doctrine prioritizing two effects without any guidance for balance. Lower courts are then forced to judge both, often allowing the weight of one to influence the other.

Seuss and *Warhol* exemplify this approach. While in each case one factor is clear, each court found itself needing to support its decision by manufacturing favor in the other factor.¹²³ In doing so, the courts created more narrow tests that favor a finding of unfair use. When applied, these tests could result in a slew of infringement findings where the court gives decisive force to the first or fourth factors and ignores the goal of copyright.

In conclusion, the Supreme Court should soon be forced to reckon with its jumbled fair use doctrine. In its clarification, the Court would be wise to dispel its previous focus on specific factors and turn back to the promotion of science and arts, where copyright finds its footing.

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120. See *Seuss*, 983 F.3d at 453-54 (considering “‘transformative[ness]’ . . . the ‘central purpose’”); see also *Warhol*, 11 F.4th at 48-51.

121. See, e.g., *Beebe*, *supra* note 36, at 605, 618-19.

122. *Id.* at 617.

123. See *Seuss*, 983 F.3d at 460-61; see also *Warhol*, 11 F.4th at 37-44, 48-51.

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