

End Users' Utilization of Copyrighted Work Largely Irrelevant for Fair Use
Vincent De Fontbrune, et al. v. Alan Wofsy, et al., No. 19-17024 (9th Cir. 2022)

By: Lisa Holubar & Andrew Choi | July 23, 2022

On July 13, 2022, the Ninth Circuit held that art editor Alan Wofsy's use of copyrighted photographs in his series of books documenting Picasso's artwork titled, *The Picasso Project*, was not protected by fair use. The copyrighted works at issue were photographs of the works of Pablo Picasso taken (with permission of the Picasso estate) by Christian Zervos and printed in his *Zervos Catalogue*. In 1979, Yves Sicre de Fontbrune acquired the rights to the *Zervos Catalogue*. Wofsy later released "*The Picasso Project*," which books contained reproductions of certain photographs from the *Zervos Catalogue*. In 2001, a French court entered judgment against Wofsy finding the use of Zervos' photos in *The Picasso Project* violated French copyright law and issued an "*astreinte*" – a French legal device that imposed money damages for the continued use of the photographs. In 2013, Sicre de Fontbrune sought recognition of the *astreinte* in a California District Court. Upon cross-motions for summary judgment on defenses under California's Uniform Foreign Country Money Judgments Recognition Act, the District Court granted summary judgment for Wofsy, finding that the fair use defense would have protected his conduct and thus French law's lack of any fair use defense made the judgment repugnant to U.S. public policy protecting free expression. Sicre de Fontbrune appealed.

Upon reviewing the fair use factors for the individual photographs at issue, the Ninth Circuit concluded that Sicre de Fontbrune, not Wofsy, was entitled to summary judgment. Examining the "purpose and character" factor, the Court concluded that the District Court was incorrect in holding that the purpose of *The Picasso Project* aligned with "criticism, comment, news reporting, teaching, ..., scholarship, or research" purposes that Section 107 characterizes as non-infringing, since it was "intended for libraries, academic institutions, [and] art collectors." Rather, the Court reiterated that the work in question was commercial, noting that the "end-user's utilization of the product is largely irrelevant," and the real "use at issue" is the reproduction of copyrighted photographs into a book offered for sale. The Court also cautioned that, while exact copies can sometimes be transformative when they "serve an entirely different function" from the original, a mere "difference in purpose is not ... the same thing as transformation." Here, the exact copies of the photographs, albeit with new captions to aid researchers, neither had a difference in purpose, nor served an "entirely different function" than the originals, both were in books about Picasso, and consequently the use was not transformative. Likewise, upon considering the "nature of the copyrighted work" factor, the Court held that the documentary purpose of the *Zervos Catalogue* did not negate the creative character displayed in the photographs themselves, such as the choices of lighting, filtering, and framing. As for the third factor, the Court found that Wofsy copied 1,492 photographs, each in its entirety, and was not persuaded that there were actually 16,000 photographs in the original work. The fourth and final factor regarding market harm was presumed and un rebutted. In short, the Court found that all four factors weighed against fair use.

The Court did not reach the issue of whether a "clearly meritorious fair use defense would render a foreign judgment repugnant to the public policy of the United States or of California" when the foreign law was void of any fair use defense. When assessing the purpose, character, and transformation factor for fair use, practitioners should avoid conflating alleged infringers' use of copyrighted materials in their commercial product with their customer's expected utilization of that product.