THE TRANSFORMATIVE USE DOCTRINE AND FAIR DEALING IN SINGAPORE

Understanding the "Purpose and Character" of Appropriation Art

Generally a transformative work is one that imbues the original "with a further purpose or different character, altering the first with new expression, meaning, or message". Given that the wording of the first statutory factor of fair dealing in section 35(2)(*a*) of the Singapore Copyright Act is identical to section 107 of the US Copyright Act, and that three other statutory factors are also similar, this article argues that the transformative use doctrine in US law is highly persuasive in the Singapore context. It further postulates that transformativeness not only occupies the core of the fair use/fair dealing doctrine but also reduces the importance of all other factors, such that the more transformative the new work, the less significant the other factors will be. It demonstrates through an examination of judicial decisions involving transformative use in contemporary art that a contextual transformation may be sufficient to qualify as a "change in purpose or character" that weighs in favour of fair use. Therefore when a transformation occurs through "*re*purposing" or "*re*characterising", as reasonably perceived by the audience to which the secondary work is directed, the first statutory factor of fair use/fair dealing, whether in the US or Singapore, should weigh in favour of the defendant secondary user.

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I. Introduction

1 The fair use defence has been described as the "most nebulous and unpredictable aspects" in copyright law.[1] In the US, the affirmative

1 J Thomas McCarthy, *The Rights of Publicity and Privacy* (Thomson-West, 2nd Ed, 2000) at § 8:9. Similar exasperating comments abound in American legal scholarship. *Eg*, Paul Goldstein, "Fair Use in Context" (2008) 31 Colum JL &

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defence to copyright infringement is found in section 107 of the Copyright Act,[2] listing four non-exhaustive factors that courts shall consider whether such a use is fair and thus non-infringing. Singapore has adopted almost identical wording in articulating four statutory factors in its revamped fair dealing defence,[3] with the addition of a fifth factor.[4] Fair dealing in the copyright law jurisprudence of many Commonwealth jurisdictions is an exclusion to copyright infringement so that others may be allowed to use copyrighted works without first seeking permission, but only in certain purpose-specific manner – like research, study, criticism and review – as codified in statute. The striking similarity between the US and Singapore provisions is that the fair use/fair dealing defence may be pleaded for *all* uses where infringement is alleged, and is not confined to enumerated categories; this important development signals that Singapore has developed a fair dealing standard that departs from the current practice of other Commonwealth common law jurisdictions like the UK and Australia.[5]

2 The ultimate goal of copyright is arguably to benefit society by stimulating creativity through providing economic incentives to create new works.[6] Its objectives are, first, to promote new and original

Arts 433 at 433 (describing fair use as "the great white whale of American copyright law" and a concept that is "enthralling" and "enigmatic"); David Nimmer, "'Fairest of Them All' and Other Fairy Tales of Fair Use" [2003] Law & Contemp Probs 263 at 280 ("Basically, had Congress legislated a dartboard rather than the particular four fair use factors embodied in the Copyright Act, it appears that the upshot would be the same"). *Contra* Pamela Samuelson, "Unbundling Fair Uses" (2009) 77 Fordham L Rev 2537 at 2541 ("fair use law is both more coherent and more predictable than many commentators have perceived once one recogni[s]es that fair use cases tend to fall into common patterns").

2 Copyrights 17 USC (US); Copyright Act of 1976.

3 Copyright Act (Cap 63, 2006 Rev Ed) s 35(2).

4 This fifth factor appears to have been borrowed from Australian law. See Copyright Act 1968 (Act No 63 of 1968) (Cth) (Aust) s 40(2)(c) ("the possibility of obtaining the work or adaptation within a reasonable time at an ordinary commercial price").

5 *Contra* Copyright Act 1968 (Act No 63 of 1968) (Cth) (Aust) s 40; Copyright Act 1985 (RSC 1985, c C-42) (Canada) s 29; Copyright Act 1994 (No 143 of 1994) (NZ) ss 42–43; Copyright, Designs and Patents Act 1988 (c 48) (UK) ss 29–30. See also Warren B Chik & Saw Cheng Lim, "Opportunity Lost? Revisiting *RecordTV v MediaCorpTV*" (2012) 24 SAcLJ 16 at 23–24; Kenneth Chiu, "Harmonizing Intellectual Property Law between the United States and Singapore: The United States–Singapore Free Trade Agreement's Impact on Singapore's Intellectual Property Law" (2005) 18 Transnat'l Law 489 at 502–504. It has been noted that the UK is especially out of step with majority of the members of the European Union on the issue of parody, with certain Commonwealth jurisdictions like Australia that, at least, recognises a categorical exception for parody and satire. Ronan Deazley, "Copyright and Parody: Taking Backward the Gowers Review?" (2010) 73 Modern L Rev 785 at 803–805.

6 *Eg*, *Sony Corp of America v Universal City Studios Inc* 464 US 417 at 429 (1984); *Twentieth Century Music Corp v Aiken* 422 US 151 at 156 (1975).

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expression in the arts (which includes literature, music and painting), and second, to permit other public interest activities like education, research, news reporting, and comment and criticism of existing works. However, without appropriate limitations, the grant of exclusive monopoly rights over exploitation of these works has the potential to impede, not advance, creativity. Hence the fair use/fair dealing doctrine is the primary mechanism that balances the "inherent tension" between copyright protection and creative expression.[7] It creates "breathing space for cultural engagement in the form of reinterpretation and remixing of copyrighted content … [and] makes it possible for large commercial entities to build tools such as search engines that make the Internet work and to create platforms such as YouTube and Facebook".[8] While Singapore courts have yet to address the interpretation of the factors of fair dealing articulated in section 35(2) of the revised Copyright Act,[9] courts and scholars in the US have grappled with the fair use doctrine for over three decades.[10] In Singapore, academic commentators, Warren Chik and Saw Cheng Lim, have observed:[11]

> An important distinction with the narrower version of fair dealing is that fair use and its functional equivalent is not purpose specific and hence is conceptually wider and allows for a more flexible and expansionist interpretation. In that sense, it is also a more forward-looking and adaptive instrument.

3 In US fair use jurisprudence, the first statutory factor of fair use – the "purpose and character of the use" – is examined in the context of the transformative nature of the infringing work. Generally a transformative work is one that imbues the original "with a further purpose or different character, altering the first with new expression, meaning, or message".[12] According to the Supreme Court in *Campbell v Acuff-Rose Music Inc* ("*Campbell*"), transformativeness not only

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7 *Campbell v Acuff-Rose Music Inc* 510 US 569 at 575 (1994) ("*Campbell*"). Pierre Leval noted that Justice Souter's opinion in *Campbell* "rescued" fair use by "reorient[ing] the doctrine of fair use to serve the central goal of copyright – to promote the growth and dissemination of knowledge": Pierre N Leval, "*Campbell v Acuff-Rose*: Justice Souter's Rescue of Fair Use" (1994) 13 Cardozo Arts & Ent LJ 19 at 26.

8 Matthew Sag, "Predicting Fair Use" (2012) 73 Ohio St LJ 47 at 85.

9 Cap 63, 2006 Rev Ed. The Court of Appeal recently declined to consider the fair dealing provision as the defendant was found not to infringe on the plaintiff's exclusive right to copy and/or communicate the work to the public. See *RecordTV Pte Ltd v MediaCorp TV Singapore Pte Ltd* [2011] 1 SLR 830 at [65].

10 The statutory four-factor fair use test under § 107 of Copyrights 17 USC (US) came into force on 1 January 1978 via the Copyright Act of 1976. For an analysis of almost 30 years of fair use decisions, see Barton Beebe, "An Empirical Study of US Copyright Fair Use Opinions, 1978–2005" (2008) 156 U Pa L Rev 549.

11 Warren B Chik & Saw Cheng Lim, "Opportunity Lost? Revisiting *RecordTV v MediaCorp TV*" (2012) 24 SAcLJ 16 at 22.

12 *Campbell v Acuff-Rose Music Inc* 510 US 569 at 579 (1994).

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occupies the core of the fair use doctrine but also reduces the importance of all other factors such that "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".[13]

4 Given that the wording of the first statutory factor of fair dealing in section 35(2)(*a*) of the Singapore Copyright Act[14] is identical to section 107 of the US Copyright Act,[15] and that three other statutory factors are also similar, this article argues that, notwithstanding the operation of the First Amendment,[16] the transformative use doctrine in US law is highly persuasive in the Singapore context. Therefore this article will focus only on an evaluation of the first fair dealing factor and, more specifically, the potential application of the transformative use doctrine. It intends neither to examine the fair dealing defence in its entirety nor to explore the interaction of various factors of fair dealing. It only seeks to introduce the transformative use doctrine to the courts and practitioners in Singapore in a manner that might be useful for the pleading of the fair dealing defence in the future. Part II provides a brief overview of the legislative history of section 35(2) of the Singapore Copyright Act[17] and highlights its similarities to the US fair use statutory provisions. Part III focuses on an elucidation of the transformative use doctrine as it is presently understood in the US and attempts to categorise the application of the transformative use doctrine in fair use cases into clusters that more accurately reflect a change in "purpose" and/or "character" of the primary work. Part IV, drawing on experiences in contemporary art, posits that when such a transformation occurs through "*re*purposing" or "*re*characterising" as reasonably perceived by the audience to which the secondary work is directed, the first statutory factor of fair use/fair dealing, whether in the US or Singapore, should weigh in favour of the defendant secondary user. Part V illustrates how this transformative use doctrine may be applied to cases involving appropriation art and suggests how the first factor of fair dealing may be interpreted in Singapore in this context. Part VI concludes that in the interpretation of section 35(2)(*a*) of the Copyright Act,[18] courts in Singapore should consider focusing on whether transformation has occurred through a change in the "purpose and character of the dealing"[19] and be guided by the ethos of the transformative use doctrine.

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13 510 US 569 at 579 (1994).
14 Cap 63, 1999 Rev Ed.
15 Copyrights 17 USC (US); Copyright Act of 1976.
16 *Cf Eldred v Ashcroft* 537 US 186 at 219–220 (2003) (the fair use doctrine is a critical "First Amendment safeguard" that helps ensure "copyright's limited monopolies [will remain] compatible with free speech principles").
17 Cap 63, 2006 Rev Ed.
18 Cap 63, 2006 Rev Ed.
19 Copyright Act (Cap 63, 2006 Rev Ed) s 35(2). The text of the Singapore fair dealing provision is largely similar to Copyrights 17 USC (US) § 107, with the inclusion of

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II. Fair dealing in Singapore

5 In Singapore, fair dealing defence as encapsulated in section 35(2) of the Copyright Act[20] states:

> For the purposes of this Act, the matters to which regard shall be had, in determining whether a dealing with a literary, dramatic, musical or artistic work or with an adaptation of a literary, dramatic or musical work, being a dealing by way of copying the whole or a part of the work or adaptation, constitutes a fair dealing with the work or adaptation for any purpose other than a purpose referred to in section 36 or 37 shall include —
>
> (*a*) the purpose and character of the dealing, including whether such dealing is of a commercial nature or is for non-profit educational purposes;
>
> (*b*) the nature of the work or adaptation;
>
> (*c*) the amount and substantiality of the part copied taken in relation to the whole work or adaptation;
>
> (*d*) the effect of the dealing upon the potential market for, or value of, the work or adaptation; and
>
> (*e*) the possibility of obtaining the work or adaptation within a reasonable time at an ordinary commercial price.

This fair dealing defence, which requires an examination of a non-exhaustive but compulsory list of five factors, is applicable to *all* uses except for criticism or review (section 36) and reporting of current events (section 37), came into effect on 1 January 2005. It replaces the previous section 35(2) of the Copyright Act,[21] which lists four non-exhaustive factors to be examined in respect of fair dealing for the *specific* purpose of research or private study. By delinking the new fair dealing defence from these permitted purposes, it was observed that "Singapore shifted away from the British model of fair dealing and

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an additional factor in the balancing test. The implications of this provision is that, at least in theory, appropriation artists can plead fair dealing in a manner similar to their US counterparts. However, substantively it is unclear whether in the absence of an equivalent First Amendment jurisprudence, freedom of artistic expression will be accorded robust protection in Singapore when it clashes with intellectual property rights. *Cf Campbell v Acuff-Rose Music Inc* 510 US 569 (1994); *Jordache Enterprises v Hogg Wyld Ltd* 828 F 2d 1482 (10th Cir, 1987); *Leibovitz v Paramount Pictures Corp* 137 F 3d 109 (2d Cir, 1998); *Suntrust Bank v Houghton Mifflin Co* 268 F 3d 1257 (11th Cir, 2001); *Mattel Inc v MCA Records Inc* 296 F 3d 894 (9th Cir, 2002); *Blanch v Koons* 467 F 3d 244 (2d Cir, 2006); and *Louis Vuitton Malletier SA v Haute Diggity Dog LLC* 507 F 3d 252 (4th Cir, 2007).

20 Cap 63, 2006 Rev Ed.

21 Cap 63, 1999 Rev Ed.

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moved closer towards the American 'fair use' model".[22] The US fair use defence in section 107 of the Copyright Act[23] also contains a non-exhaustive but compulsory list of factors to be examined for all uses. Moreover, section 35(2)(*a*) of the Singapore Copyright Act[24] adopts the exact wording as the first statutory fair use factor of section 107 of the US Copyright Act,[25] substituting the word "use" with "dealing".

6 During the parliamentary readings of the Intellectual Property (Miscellaneous Amendments) Bill 2004,[26] the then Minister for Law, S Jayakumar, explained that the purposes of proposed amendments to the Copyright Act – which include the introduction of a general fair dealing provision – are to update Singapore's intellectual property rights infrastructure and to implement Singapore's commitments under the US–Singapore Free Trade Agreement ("USSFTA").[27] The Minister also stated that "[c]opyright fair dealing provisions … will continue to operate to ensure a balance between creators, industry and consumers … [and that the Government] will continue to monitor international and domestic trends to ensure that the right balance is struck".[28] This suggests that the Singapore government – and the judiciary – would be open to considering how other countries, especially those that share similar copyright statutory provisions, approach the issue of fair dealing or fair use. The Singapore Court of Appeal's recent approval of the US Second Circuit Court of Appeals decision of *The Cartoon Network LP v CSC Holdings Inc*[29] in *RecordTV Pte Ltd v MediaCorp TV Singapore Pte Ltd*,[30] as well as its citation of the US Supreme Court decision of *Feist Publications Inc v Rural Telephone Service Co Inc*[31] in *Asia Pacific Publishing Pte Ltd v Pioneers & Leaders (Publishers) Pte Ltd*,[32] augurs well for the future consideration of relevant US cases when interpreting the fair dealing provision in Singapore.

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22 Ng-Loy Wee Loon, *Law of Intellectual Property* (Sweet & Maxwell, 2008) at para 11.3.16.
23 Copyright Act of 1976, Copyrights 17 USC (US).
24 Cap 63, 2006 Rev Ed.
25 Copyright Act of 1976, Copyrights 17 USC (US).
26 No 52/2004.
27 *Singapore Parliamentary Debates, Official Report* (15 June 2004) vol 78 at col 125 (S Jayakumar, Minister for Law).
28 *Singapore Parliamentary Debates, Official Report* (15 June 2004) vol 78 at cols 125, 134–135 (S Jayakumar, Minister for Law).
29 536 F 3d 121 (2d Cir, 2008).
30 [2011] 1 SLR 830 at [70] ("In *Cartoon Network*, the US Court of Appeals for the Second Circuit held that the public interest in Cablevision's innovative device prevailed over the private interests of the copyright owners concerned. We are of the view that the same position should be adopted in the present case").
31 499 US 340 (1991).
32 [2011] 4 SLR 381 at [38].

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7 Although the Minister clarified that the amendment to the fair dealing provisions was not as a result of implementing Singapore's obligations under the USSFTA, he nonetheless noted that the refinement of the fair dealing provisions based on a set of factors was in tune with developments in other countries like the US.[33] He stated at the second reading of the Copyright (Amendment) Bill 2004:[34]

> [While the closed-list] system provides certainty, it is also restrictive in that it does not cater for other new uses which could fall under the concept of fair dealing. While the current permitted activities have been retained, [the amendment] refines our fair dealing system by allowing other acts to be assessed according to a set of factors in determining whether these acts could constitute fair dealing. … I believe they will create an environment conducive to the development of creative works, and also facilitate greater investment, research and development in the copyright industries in Singapore.

While Chik and Saw have commented that "[a]nalogy can be made to US case law (particularly the US Supreme Court cases) on fair use that deals with the same or similar forms of technology and their reasoning for newer exemptions to be applied (and also for the expansion of the factors test beyond those listed), which can be persuasive authority before our courts",[35] this article suggests that even the reasoning in cases that do not deal with the same or similar forms of technology may be persuasive in the Singapore context. In 1995, ten years before the introduction of the general fair dealing provision, the Singapore High Court had observed that the US fair use provisions were "in many respects similar to those of [section] 35 of the Singapore Act"[36] and considered decisions of the US Second and Ninth Circuit Courts of Appeals in respect of an examination of the factor of the broader public interest as to whether the secondary use was fair.[37] With the 2005 amendment[38] to the Copyright Act, an even more compelling case may be made for the judicial deliberations of the US Supreme Court and the Circuit Courts of Appeals to be considered in Singapore, since both jurisdictions share virtually identical statutory provisions for the examination of general fair use/fair dealing.

33 *Singapore Parliamentary Debates, Official Report* (16 November 2004) vol 78 at col 1070 (S Jayakumar, Minister for Law).
34 No 48/2004. *Singapore Parliamentary Debates, Official Report* (16 November 2004) vol 78 at cols 1052 and 1070 (S Jayakumar, Minister for Law).
35 Warren B Chik & Saw Cheng Lim, "Opportunity Lost? Revisiting *RecordTV v MediaCorp TV*" (2012) 24 SAcLJ 16 at 24.
36 *Aztech Systems Pte Ltd v Creative Technology Ltd* [1995] 3 SLR(R) 568 at [60].
37 *Aztech Systems Pte Ltd v Creative Technology Ltd* [1995] 3 SLR(R) 568 at [61]–[64].
38 Copyright (Amendment) Act 2005 (Act 22 of 2005).

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III. The "transformative use" doctrine in fair use

8 The fair use defence is widely believed to have its American origins in Justice Story's test for a fair and *bona fide* abridgement as set out in his 1841 decision in *Folsom v Marsh*.[39] In the US, if *prima facie* copyright infringement was found, the "fair use" defence – as codified in section 107 of the Copyright Act[40] – can nonetheless provide a safe harbour for the defendant, especially if transformative elements may be discerned in the infringing work. Section 107 states:[41]

> [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. In determining whether the use made of a work in any 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.

The phrase "transformative use" has surged into prominence in fair use jurisprudence ever since the US Supreme Court in 1994 embraced transformativeness as the cynosure of fair use in *Campbell*.[42] The decision is important in its emphasis on how a highly transformative use of an original work may qualify the secondary infringing work for fair use protection even if the latter was commercial in nature, rebutting earlier presumptions in cases like *Harper & Row Publishers v Nation Enterprises*[43] and *Sony Corp of America v Universal City Studios Inc*.[44] In respect of the first factor of fair use, this approach requires courts to examine the "purpose and character of the use", but neither "purpose" nor "character" is defined in the statute. Courts therefore may consider a kaleidoscope of relevant factors like what kind of transformation is present in the secondary work, the track record of the author of the

39 9 F Cas 342 at 349 (CCD Massachusetts, 1841) (No 4901).
40 Copyrights 17 USC (US); Copyright Act of 1976.
41 Copyrights 17 USC (US) § 107; Copyright Act of 1976.
42 The controversial rap group, 2 Live Crew, sampled the distinctive bassline from Roy Orbison's original hit song "Pretty Woman", used the same title in their parody song, and the romantic lyrics were replaced with talk about a "big hairy woman" and her exploits.
43 471 US 539 (1985).
44 464 US 417 (1984).

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secondary work, the extent of commentary or criticism present in the secondary work, the significance of the secondary use to research or study, as well as its public benefit.[45] The *Campbell* court emphasised that the creation of transformative works, although not necessary in every case, lies "at the heart of the fair use doctrine's guarantee of breathing space within the confines of copyright".[46] Neil Netanel argued that under the transformative use paradigm, fair use is viewed as "integral to copyright's purpose of promoting widespread dissemination of creative expression, not a disfavo[u]red exception to copyright holders' exclusive rights".[47]

9 In respect of the first factor of fair use, the transformative test has become the defining standard for fair use, and has risen to the top of the agenda of the copyright academic community in the US in the last five years.[48] At least four empirical studies of US fair use case law offer valuable insights to the transformative use doctrine.

10 Barton Beebe's pioneering empirical study of fair use decisions in the US, which covered judicial opinions from 1978 to 2005,[49] and Matthew Sag's statistical analysis, which focused on the *ex ante* predictability of fair use based on 280 fair use cases decided between 1978 and 2011,[50] affirm the important role that transformative use – a judicial inquiry in the first statutory factor of the fair use inquiry when examining the "the purpose and character of the use" – plays in the evaluation of fair use. Beebe observed that "in 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".[51] While courts have not demonstrated an overriding desire to find transformativeness in the cases before them, Beebe concluded that, based on the regression analysis, if a use were found to be transformative, the defendant's chance of winning the fair

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45 US Constitution Art I § 8 cl 8: "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."

46 *Campbell v Acuff-Rose Music Inc* 510 US 569 at 579 (1994).

47 Neil Weinstock Netanel, "Making Sense of Fair Use" (2011) 15 Lewis & Clark L Rev 715 at 736.

48 Michael D Murray, "What is Transformative? An Explanatory Synthesis of the Convergence of Transformation and Predominant Purpose in Copyright Fair Use Law" (2012) 11 Chi-Kent J Intell Prop 260 at 262.

49 Barton Beebe, "An Empirical Study of US Copyright Fair Use Opinions, 1978–2005" (2008) 156 U Pa L Rev 549.

50 Matthew Sag, "Predicting Fair Use" (2012) 73 Ohio St LJ 47.

51 Barton Beebe, "An Empirical Study of US Copyright Fair Use Opinions, 1978–2005" (2008) 156 U Pa L Rev 549 at 605.

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use defence would be 94.9%.[52] Sag more confidently asserted that the evidence "confirms the centrality of transformative use" and when "[m]easured in terms of the variable Creativity Shift, it appears that transformative use by the defendant is a robust predictor of a finding of fair use".[53]

11 However, it is Neil Netanel's study of US district and circuit court cases decided between 2006 and 2010 that is more conclusive that "the transformative use paradigm ascended to its overwhelmingly predominant position only after 2005, following the period that Beebe studied".[54] Although the US courts have repeatedly asserted that a secondary use need not be transformative in order to be a fair use, and that transformativeness as encapsulated in the first statutory fair use factor is merely a part, albeit a central part, of the fair use inquiry, Netanel's data revealed that there is certainly a strikingly high correlation between judicial findings regarding transformativeness and fair use outcomes.[55] The leading cases also "make quite clear that, in effect, if the first factor favo[u]rs fair use, that will trump the fourth factor".[56]

12 Finally, Michael Murray's explanatory synthesis methodology, a process of induction of principles of interpretation and application concerning the prevailing rules governing a specific legal issue, has been applied to the entire body of copyright fair use case law from the US Courts of Appeals since 1994.[57] His study revealed that "placing [existing copyrighted work] in a new context so as to change the *predominant*

52 Barton Beebe, "An Empirical Study of US Copyright Fair Use Opinions, 1978–2005" (2008) 156 U Pa L Rev 549 at 606.

53 Matthew Sag, "Predicting Fair Use" (2012) 73 Ohio St LJ 47 at 84.

54 Neil Weinstock Netanel, "Making Sense of Fair Use" (2011) 15 Lewis & Clark L Rev 715 at 734.

55 Neil Weinstock Netanel, "Making Sense of Fair Use" (2011) 15 Lewis & Clark L Rev 715 at 742. At 740–741: Twenty of the 22 opinions that found the defendant's use to be "highly", "certainly" or "significantly" transformative, or just simply "transformative", held that the defendant had engaged in fair use. All but three cases that characterised the secondary use in question as non-transformative, or only "minimally", "partly" or "somewhat" transformative, found no fair use.

56 Neil Weinstock Netanel, "Making Sense of Fair Use" (2011) 15 Lewis & Clark L Rev 715 at 743. This is likely to be a result of the conclusion that if a secondary use is unequivocally transformative, then by definition, it causes no market harm to, or has market substitution for, the original work. Perhaps more controversially, Sag surmised that the near-perfect correlation between judicial findings on the fourth factor and fair use case outcomes must mean that the fourth factor is not really an independent variable in judges' fair use analysis: Matthew Sag, "Predicting Fair Use" (2012) 73 Ohio St LJ 47 at 63–64.

57 Michael D Murray, "What is Transformative? An Explanatory Synthesis of the Convergence of Transformation and Predominant Purpose in Copyright Fair Use Law" (2012) 11 Chi-Kent J Intell Prop 260.

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purpose and function of the original material is transformative" [emphasis added].[58]

13 It is important to note that a transformative work that qualifies for fair use protection is different from a "derivative work". Section 106(2) of the US Copyright Act[59] gives copyright owners an exclusive right to prepare derivative works based on the copyright owner's original work; as defined in the statute, a derivative work takes a pre-existing work and "recast[s], transform[s], or adapt[s]" that work.[60] The Singapore statute uses the phrase "adaptation of the work".[61] The kind of transformations referred to in a derivative work in the US are not necessarily "transformative" in the sense that was referred to by the Supreme Court in the context of fair use.[62] A transformative work in the fair use context is one that imbues the original "with a further purpose or different character, altering the first with new expression, meaning, or message".[63] The assessment of transformativeness is "not merely a question of the degree of difference between two works; rather, it requires a judgment of the motivation and meaning of those differences".[64]

14 Although the *Campbell* decision downplayed the commerciality of the infringing use and directed the inquiry to the transformativeness of secondary work, it unfortunately generated tremendous confusion in respect of the application of the transformative use doctrine to parodic and satirical works. Unfortunately, the Supreme Court only provided one concrete example of a sufficiently transformative use that would clearly lead to a fair use determination, that of parody. Over the years, lower courts have bluntly asserted that because a parody targets and comments on the original work and is therefore transformative, while a satire uses the original work as a weapon to comment on something else and is not transformative.[65] However, the *Campbell* court did not state that in order for a use to be transformative, it must always comment on

58 Michael D Murray, "What is Transformative? An Explanatory Synthesis of the Convergence of Transformation and Predominant Purpose in Copyright Fair Use Law" (2012) 11 Chi-Kent J Intell Prop 260 at 276.

59 Copyrights 17 USC (US); Copyright Act of 1976.

60 Copyrights 17 USC (US) § 101; Copyright Act of 1976.

61 Copyright Act (Cap 63, 2006 Rev Ed) ss 7 and 26(1)(*a*)(v).

62 See, *eg*, R Anthony Reese, "Transformativeness and the Derivative Work Right" (2008) 31 Colum JL & Arts 467.

63 *Campbell v Acuff-Rose Music Inc* 510 US 569 at 579 (1994).

64 Matthew Sag, "Predicting Fair Use" (2012) 73 Ohio St LJ 47 at 56.

65 *Eg*, *Dr Seuss Enterprises LP v Penguin Books USA Inc* 109 F 3d 1394 at 1401 (9th Cir, 1997): "It is the rule in this Circuit that though the satire need not be only of the copied work and may … also be a parody of modern society, the copied work must be, at least in part, an object of the parody, otherwise there would be no need to conjure up the original work."

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the original. Souter J, writing for a unanimous court, explained that "[p]arody needs to mimic an original to make its point, and so has some claim to use the creation of its victim's (or collective victims') imagination, whereas satire can stand on its own two feet and so requires justification for the very act of borrowing".[66] In a footnote, the court clarified:[67]

> *[W]hen there is little or no risk of market substitution*, whether *because of the large extent of transformation of the earlier work*, the new work's minimal distribution in the market, the small extent to which it borrows from an original, or other factors, *taking parodic aim at an original is a less critical factor in the analysis*, and looser forms of parody may be found to be fair use, as may satire with lesser justification for the borrowing than would otherwise be required. [emphases added]

This suggests that the degree or extent of transformation is the salient feature of the first factor of fair use, regardless of whether the secondary use is classified as a parody, satire or something else. Furthermore, as Souter J affirmed:[68] "The central purpose of this investigation is to see … 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."

15 Indeed, the transformative use doctrine in the first factor of fair use is a difficult one to elucidate. The phrase "the purpose and character of the use, including whether such use is of a commercial nature or is for non-profit educational purposes" suggests: (a) a change in the purpose of the secondary infringing work *vis-à-vis* the original work (for example, from entertaining to educational) *or* a change in character (for example, change in context or style) is transformative; (b) such changes should be considered in the light of the commerciality of the secondary infringing work, although this examination overlaps with the fourth factor on market impact; and (c) whether the secondary infringing work serves a commercial or non-profit purpose is a separate consideration from "purpose and character of the use". Courts do not usually observe a strict distinction between "purpose" and "character", preferring to assess whether the secondary work was sufficiently transformative according to the guidelines laid down by the Supreme Court in *Campbell*.

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66 *Campbell v Acuff-Rose Music Inc* 510 US 569 at 580–581 (1994).
67 *Campbell v Acuff-Rose Music Inc* 510 US 569 at 581, footnote 14 (1994).
68 *Campbell v Acuff-Rose Music Inc* 510 US 569 at 579 (1994).

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16 Although *Campbell* involved parody, where the rap group, 2 Live Crew, made a direct comment on the original "Pretty Woman" song by Roy Orbison, the Supreme Court did not hold or even suggest that transformativeness is limited to new works that parody the original or comment on it directly. The Second Circuit Court of Appeals expressly disagreed with the suggestion that "comment or criticism" is required to show transformative use,[69] and emphasised that the inquiry should be whether the secondary work may be reasonably perceived to have a meaning, message or purpose that is "separate and distinct" from the original,[70] consistent with the judgment in *Campbell*.[71] The Ninth Circuit also rejected a narrow requirement of commenting or criticising the original work in order to qualify as transformative use;[72] such a broader interpretation that directs judicial inquiry to examining a change in purpose or change in character can better unify the transformative use analysis for expressive parodic, satirical or critical works and non-expressive works in a technological medium like format- or time-shifting. Moreover, from the Ninth Circuit's decision in *Perfect 10 Inc v Amazon.com Inc* ("*Perfect 10*"), it appears that, in evaluating the first statutory factor, courts may be inclined to assess the extent of the "transformative nature" of the defendant's secondary use "in light of its public benefit", and weigh that against the defendant's "superseding and commercial uses".[73]

17 However, the confusion in the US district courts when applying the transformative use doctrine, especially in the recent New York decision of *Cariou v Prince*[74] ("*Prince*"), merits a closer examination of the Supreme Court's interpretation of the first fair use factor in *Campbell*, in respect of the requirement that the secondary infringing work comments on the original. In *Campbell*, the court observed that section 107 of the Copyright Act[75] employs the terms "including" and "such as" in the preamble paragraph to indicate the "illustrative and not

69 *Bill Graham Archives v Dorling Kindersley Ltd* 448 F 3d 605 at 609 (2d Cir, 2006).

70 *Bill Graham Archives v Dorling Kindersley Ltd* 448 F 3d 605 at 610 (2d Cir, 2006); *Blanch v Koons* 467 F 3d 244 at 252 (2d Cir, 2006); *Castle Rock Entertainment Inc v Carol Publishing Group Inc* 150 F 3d 132 at 142 (2d Cir, 1998).

71 *Campbell v Acuff-Rose Music Inc* 510 US 569 at 579 (1994): whether the new work "adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message".

72 *Perfect 10 Inc v Amazon.com Inc* 508 F 3d 1146 at 1165 (9th Cir, 2007) (a search engine puts images "in a different context" so that they are "transformed into a new creation"); *Kelly v Arriba Soft Corp* 336 F 3d 811 at 819 (9th Cir, 2003) (Arriba's use of thumbnails was transformative because "Arriba's use of the images serve[d] a different function than Kelly's use – improving access to information on the internet versus artistic expression").

73 508 F 3d 1146 at 1166 (9th Cir, 2007).

74 784 F Supp 2d 337 (SDNY, 2011). The decision is currently on appeal to the Second Circuit Court of Appeals.

75 Copyrights 17 USC (US); Copyright Act of 1976.

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limitative" function of the examples given, which thus provide only general guidance about the sorts of copying that courts and Congress most commonly had found to be fair uses.[76] It is clear that if Congress had intended to impose a requirement that all secondary works must comment, it would have done so by adding a comment requirement as a conjunctive element, or by exclusively providing that only those activities listed in section 107 can qualify as fair use. It may be argued that *Rogers v Koons*[77] ("*Koons I*") is of limited precedential value because it was decided before *Campbell*, and there was no requirement in law for a secondary work to comment on the original work so long as the intent of the secondary author was to recode the original expression into entirely new expression with new messages. Moreover, in a more recent case, the Second Circuit have found in *Blanch v Koons* ("*Koons II*") that Jeff Koons' use of Andrea Blanch's photograph to be transformative even though he was not commenting on the underlying work but using the original image "as fodder for his commentary on the social and aesthetic consequences of mass media".[78]

18 The transformation use doctrine as articulated by the Second Circuit in *Koons II* was succinctly stated as: "If the secondary use adds value to the original – if [copyrightable expression in the original work] is used as raw material, transformed in the creation of new information, new aesthetics, new insights and understandings – this is the very type of activity that the fair use doctrine intends to protect for the enrichment of society. [internal quotations omitted]"[79] The Second Circuit did not require the secondary work to comment on the original work or on the original author or artist. Moreover, the Supreme Court held that the 2 Live Crew version of "Pretty Woman" could "reasonably be perceived as commenting on the original or critici[s]ing it, to some degree" because "2 Live Crew juxtaposes the romantic musings of a man whose fantasy comes true, with degrading taunts, a bawdy demand for sex, and a sigh of relief from paternal responsibility".[80] In the copyright infringement dispute regarding the *Harry Potter Lexicon*, Patterson J surveyed a number of Circuit Court decisions and concluded:[81]

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76 *Campbell v Acuff-Rose Music Inc* 510 US 569 at 577–578 (1994).

77 960 F 2d 301 (2d Cir, 1992).

78 467 F 3d 244 at 252–253 (2d Cir, 2006).

79 *Blanch v Koons* 467 F 3d 244 at 251–252 (2d Cir, 2006) (quoting *Castle Rock Entertainment Inc v Carol Publishing Group Inc* 150 F 3d 132 at 142 (2d Cir, 1998) (quoting Pierre N Leval, "Toward a Fair Use Standard" (1990) 103 Harv L Rev 1105 at 1111)).

80 *Campbell v Acuff-Rose Music Inc* 510 US 569 at 583 (1994).

81 *Warner Bros Entertainment Inc v RDR Books* 575 F Supp 2d 513 at 541 (SDNY, 2008). See also at 541: "Because it serves these reference purposes, rather than the entertainment or aesthetic purposes of the original works, the Lexicon's use is transformative and does not supplant the objects of the *Harry Potter* works."

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> Courts have found a transformative purpose both where the defendant combines copyrighted expression with original expression to produce a new creative work, and where *the defendant uses a copyrighted work in a different context to serve a different function than the original*. [emphasis added]

19 In *Bourne Co v Twentieth Century Fox Film Corp*, the defendants initially sought a licence from the plaintiff to use "When You Wish Upon a Star" for their song in *The Family Guy* television comedy programme, but upon the refusal of the plaintiff, proceeded to write "I Need a Jew" that evoked the original song. In granting summary judgment for the defendant, Batts J found that a transformative message could reasonably be perceived:[82]

> The Court finds that by juxtaposing the 'saccharin sweet' song 'When You Wish Upon a Star' with 'I Need a Jew' the Defendants do more than just comment on racism and bigotry generally, as Plaintiff contends. Rather, Defendants' use of 'When You Wish Upon a Star' calls to mind a warm and fuzzy view of the world that is ultimately nonsense; wishing upon a star does not, in fact, make one's dreams come true. By pairing Peter's 'positive', though racist, stereotypes of Jewish people with that fairy tale world view, 'I Need a Jew' comments both on the original work's fantasy of Stardust and magic, as well as Peter's fantasy of the 'superiority' of Jews. The song can be 'reasonably perceived' to be commenting that any categorical view of a race of people is childish and simplistic, just like wishing upon a star.

20 Second Circuit Courts have considered a broader examination of transformation that does not require the presence of comment so long as the purpose in using the original work is "plainly different from the original purpose for which it was created"[83] and have "given weight to an artist's own explanation of their creative rationale when conducting the fair use analysis".[84]

21 In summary, the following types of uses have been found to be transformative:

> (a) directly commenting on or criticising the original work, or targeting the original work for ridicule;[85]

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82 602 F Supp 2d 499 at 506 (SDNY, 2009).

83 *Bill Graham Archives v Dorling Kindersley Ltd* 448 F 3d 605 at 609 (2d Cir, 2006); *Blanch v Koons* 467 F 3d 244 at 252–253 (2d Cir, 2006).

84 *Blanch v Koons* 467 F 3d 244 at 255 (2d Cir, 2006).

85 *Eg*, *Campbell v Acuff-Rose Music Inc* 510 US 569 (1994) (the 2 Live Crew song can be taken as a comment on the naiveté of the original of an earlier day, as a rejection of its sentiment that ignores the ugliness of street life and the debasement that it signifies, and is therefore transformative); *Leibovitz v Paramount Pictures Corp* 137 F 3d 109 (2d Cir, 1998) (the parody advertisement may reasonably be perceived as commenting on the seriousness, even pretentiousness, of the original);

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(b) using the original work to comment on something else, but the secondary work nonetheless contains some underlying critical relevance to the original work;[86]

(c) recontextualising the original work without modification;[87]

(d) changing the purpose of the original work within an expressive context (for example, from entertainment to education or research);[88] and

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NXIVM Corp v The Ross Institute 364 F 3d 471 (2d Cir, 2006) (analyses and critiques of course manuals are transformative); *Suntrust Bank v Houghton Mifflin Co* 268 F 3d 1257 (11th Cir, 2001) (despite borrowing substantially from the original Margaret Mitchell's novel, *The Wind Done Gone* was found to be a transformative use of *Gone With the Wind* as it is a direct critique of Mitchell's depiction of slavery and the Civil War-era American South). *Contra Dr Seuss Enterprises LP v Penguin Books USA Inc* 109 F 3d 1394 (9th Cir, 1997) (a poetic account of the O J Simpson double murder trial entitled *The Cat NOT in the Hat! A Parody by Dr Juice* was not transformative as *The Cat in the Hat* is not conjured up by the focus on the Brown–Goldman murders or the O J Simpson trial); *Salinger v Colting* 641 F Supp 2d 250 (SDNY, 2008) (a fictional novel recounting a meeting of *Catcher in the Rye*'s Holden Caulfield at the age of 76 with the author of that same book, J D Salinger, was a substantial copy of the original novel and was unlikely to constitute fair use).

86 *Eg*, *Blanch v Koons* 467 F 3d 244 (2d Cir, 2006); *Mattel Inc v Walking Mountain Productions* 353 F 3d 792 (9th Cir, 2003) (photographs portraying nude Barbie dolls juxtaposed with vintage kitchen appliances are transformative, as they comment on Barbie's influence on gender roles and the position of women in society). It has also been argued that fan fiction and fan remix works belong in this category and should be protected as transformative fair use. See generally David Tan, "Harry Potter and the Transformation Wand: Fair Use, Canonicity and Fan Activity" in *Amateur Media: Social, Cultural and Legal Perspectives* (Dan Hunter *et al* eds) (Routledge, 2012) at p 94; Rachel L Stroude, "Complimentary Creation: Protecting Fan Fiction as Fair Use" (2010) 14 Marq Intell Prop L Rev 191; Sonia Katyal, "Performance, Property, and the Slashing of Gender in Fan Fiction" (2006) 14 Am U J Gender Soc Pol'y & L 461.

87 *Eg*, *Bill Graham Archives v Dorling Kindersley Ltd* 448 F 3d 605 (2d Cir, 2006) (the use of promotional posters in a rock biography was a purpose separate and distinct from the original artistic and promotional purpose for which the images were created, and was transformative). There is arguably an overlap between categories (c) and (d). Courts have yet to decide if appropriation art, in particular, Sherrie Levine's rephotographs – where there is no modification to the original photograph, but there is a transformation in meaning between the original and the secondary work that may be reasonably perceived by the audience – qualify as transformative use. See generally Johanna Burton & Elisabeth Sussman, *Sherrie Levine: Mayhem* (The Whitney Museum of American Art, 2012); Howard Singerman, *Art History, After Sherrie Levine* (University of California Press, 2011) at pp 280 and 285.

88 *Eg*, *Kelly v Arriba Soft Corp* 336 F 3d 811 (9th Cir, 2003) (despite the fact that Arriba made exact replications of Kelly's images, the thumbnails served an entirely different function than Kelly's original images, and the use of the images in the search engine was transformative); *Perfect 10 Inc v Amazon.com Inc* 508 F 3d 1146 (9th Cir, 2007) (the automated processing and display of thumbnails of

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(e) changing the purpose of the original work albeit in a non-expressive and technological context with significant social benefit (for example, format-shifting and time-shifting).[89]

22 The five broad categories of transformative uses identified above can be said to demonstrate a change in "purpose" or "character" as articulated in section 107 of the US Copyright Act[90] and section 35(2)(*a*) of the Singapore Copyright Act.[91] It is critical to note that the types of uses in categories (a) to (e) are not mutually exclusive and they often overlap.[92] For example, one may construe the secondary work *The Wind Done Gone* by Alice Randall as a change in character compared to *Gone With The Wind* (since it is a critical comment that sets out to "demystify [*Gone With The Wind*] and strip the romanticism from Mitchell's specific account of this period of our history")[93] but not as a change in purpose (since both are novels that entertain), or one may perceive *The Wind Done Gone* as also being educational in purpose (since it is "principally and purposefully a critical statement that seeks to rebut and destroy the perspective, judgments, and mythology" of *Gone With The Wind*[94]), hence demonstrating a change in purpose. Indeed the Eleventh Circuit intimated that categorisation of a secondary work is

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copyrighted photos as part of a visual search engine was a change in purpose and transformative); *Warner Bros Entertainment Inc v RDR Books* 575 F Supp 2d 513 at 539 (SDNY, 2008) (even though the overall secondary work was found not to be consistently transformative, the court held that by "condensing, synthesi[s]ing, and reorgani[s]ing the pre-existing material in an A-to-Z reference guide, the Lexicon does not recast the material in another medium to retell the story of *Harry Potter*, but instead gives the copyrighted material another purpose").

89 *Eg*, *Sony Corp of America v Universal City Studios Inc* 464 US 417 (1984) (holding that the manufacturer of a videocassette recorder was not liable for copyright infringement, in part because consumer time-shifting of broadcast television for later viewing was transformative and was fair use); *Recording Industry Association of America v Diamond Multimedia System Inc* 180 F 3d 1072 (9th Cir, 1999) (strongly suggesting that transferring music from compact disc to MP3 for personal use would be fair use); *AV v iParadigms LLC* 562 F 3d 630 (4th Cir, 2009) (the automated processing of the plaintiff students' work in the defendant's plagiarism detection software was transformative). See also Matthew Sag, "Copyright and Copy-Reliant Technology" (2009) 103 Nw U L Rev 1607 (discussing the application of the fair use doctrine to automatic copying, data processing, and other non-expressive uses).

90 Copyrights 17 USC (US); Copyright Act of 1976.

91 Cap 63, 2006 Rev Ed.

92 There have been several attempts to organise different fair uses into clusters or categories, but none of them have discovered or claimed to have discovered a comprehensive formula to explain or predict all fair use outcomes. *Eg*, Pamela Samuelson, "Unbundling Fair Uses" (2009) 77 Fordham L Rev 2537; Michael J Madison, "A Pattern-Oriented Approach to Fair Use" (2004) 45 Wm & Mary L Rev 1525.

93 *Suntrust Bank v Houghton Mifflin Co* 268 F 3d 1257 at 1270 (11th Cir, 2001).

94 *Suntrust Bank v Houghton Mifflin Co* 268 F 3d 1257 at 1270 (11th Cir, 2001).

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not important for fair use analysis, and the focus ought to be on whether there was a change in purpose or character:[95]

> Justice Kennedy's concurrence simply underscores the danger of relying upon facile, formalistic labels, and encourages us to march this alleged infringement through fair use's four-pronged analysis as we would any other such work. Randall and Houghton-Mifflin may label their book a 'parody,' or a 'novel,' or whatever they like, and that fact would be largely irrelevant to our task.

23 The US fair use cases may arguably be influenced by First Amendment concerns,[96] thereby compromising their persuasive force in a jurisdiction like Singapore, which does not share a similar free speech culture. However, in evaluating transformativeness, many decisions of the Supreme Court and the Circuit Courts do not make express reference to the First Amendment – unlike the libel cases[97] – but are instead focused on examining whether a change in purpose or character may be reasonably perceived in the secondary use. The US courts are often concerned with striking the right balance between creators, industry and consumers – the same concerns expressed by the Singapore government.[98] It is this article's contention that when interpreting section 35(2)(*a*) of the Copyright Act,[99] an examination of the US cases in the context of appreciating the different kinds of transformation will be a valuable exercise.

24 While the repurposing scenarios that deal with search engines and technology are unlikely to present a significant challenge to courts, whether or not the first factor of fair dealing would favour a secondary *artistic* use of an original literary, dramatic, musical or artistic work may

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95 *Suntrust Bank v Houghton Mifflin Co* 268 F 3d 1257 at 1274, footnote 27 (11th Cir, 2001). Pamela Samuelson in "Unbundling Fair Uses" (2009) 77 Fordham L Rev 2537 at 2544 also argues that it "makes little sense to organi[s]e the fair use case law around [categories]" and that one should focus on the three main underlying policies of "promoting free speech and expression interests of subsequent authors and the public, the ongoing progress of authorship, and learning".

96 *Eg*, *Eldred v Ashcroft* 537 US 186 at 219–220 (2003).

97 *Eg*, *New York Times Co v Sullivan* 376 US 254 (1964); *Gertz v Robert Welch Inc* 418 US 323 (1974); *Dun & Bradstreet Inc v Greenmoss Builders Inc* 472 US 749 (1985); Rodney A Smolla, "Defamation and the First Amendment" in *Smolla & Nimmer on Freedom of Speech* (Westlaw-Thomson, 3rd Ed, 1996) § 23:4.

98 See *Singapore Parliamentary Debates, Official Report* (15 June 2004) vol 78 at cols 125, 134–135 (S Jayakumar, Minister for Law) and accompanying text to n 28 above. It was also observed that in the US, the fair use defence functions to balance "the interests of copyright owners in controlling exploitations of their works and the interests of subsequent authors in drawing from earlier works when expressing themselves, as well as the interests of the public in having access to new works and making reasonable uses of them": Pamela Samuelson, "Unbundling Fair Uses" (2009) 77 Fordham L Rev 2537 at 2540.

99 Cap 63, 2006 Rev Ed.

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be more difficult to evaluate in Singapore, in the absence of a robust First Amendment legal culture.[100] Almost a decade ago, the US Ninth Circuit Court of Appeals began to examine how recontextualising an original artistic work can result in a change in purpose or character that is sufficiently transformative. In finding that Thomas Forsythe's photographs that portrayed a nude Barbie doll in danger of being attacked by vintage household appliances was transformative, the court held: "Forsythe presents the viewer with a different set of associations and a different context for this plastic figure."[101] In 2006, the Second Circuit in *Koons II* followed with a more nuanced approach to the transformative use doctrine that focuses on "the creation of new information, new aesthetics, new insights and understandings" as the touchstone of transformativeness,[102] which demonstrated a stronger coherence with the text of section 107 of the US Copyright Act,[103] in terms of analysing whether the secondary work has changed in purpose and character.

IV. The notion of repurposing or recharacterising in transformative use

25 To illustrate how a court might apply the transformative use doctrine in Singapore, this article will explore how a secondary artistic work, when making use of an original work, can be changing the purpose or character of the original work through a variety of transformative techniques. While it is often easy to discern a physical transformation – for example, a visual or aural alteration of the original work – there is much disagreement in respect of the extent of a contextual transformation sufficient to qualify as a "change in purpose or character" that weighs in favour of fair use. The recent lawsuit against contemporary artist, Richard Prince, which resulted in a decision by a New York court to destroy millions of dollars' worth of artworks sent shockwaves through the art world. The decision and its application of the transformative use doctrine – particularly its failure to consider how recontextualising an original artistic work can result in a change in

100 The US Supreme Court had previously stated that "a narrow, succinctly articulable message is not a condition of constitutional protection, which if confined to expressions conveying a 'particulari[s]ed message,' … would never reach the unquestionably shielded painting of Jackson Pollock, music of Arnold Schöenberg or Jabberwocky verse of Lewis Carroll". See *Hurley v Irish-American Gay, Lesbian and Bisexual Group of Boston* 515 US 557 at 569 (1995). However, this does not mean that all appropriation art will automatically qualify for fair use protection. *Eg*, *Rogers v Koons* 960 F 2d 301 (2d Cir, 1992); *United Feature Syndicate Inc v Koons* 817 F Supp 370 (SDNY, 1993).

101 *Mattel Inc v Walking Mountain Productions* 353 F 3d 792 at 802 (9th Cir, 2003).

102 *Blanch v Koons* 467 F 3d 244 at 252 (2d Cir, 2006).

103 Copyrights 17 USC (US); Copyright Act of 1976.

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purpose or character that is sufficiently transformative – merits closer scrutiny.

26 Appropriation art, as a genre of contemporary art, is often an ideological critique that takes or hijacks "dominant words and images to create insubordinate, counter messages".[104] Appropriation art has been defined as "[t]he practice or technique of reworking the images or styles contained in earlier works of art, especially (in later use) in order to provoke critical re-evaluation of well-known pieces by presenting them in new contexts, or to challenge notions of individual creativity or authenticity in art".[105] It is identified closely with the practice of "recoding" (a shift in meaning) or "transcoding" (transforming the original meaning), which occurs purely due to the fact that an original word, image or object has been taken out of its original context.[106] For the purposes of liability for copyright infringement, appropriation art – a secondary artistic use of an original artistic work – cannot be judged according to the more traditional notions of the transformative use doctrine in the fair use defence. For example, it may be difficult to distinguish the extent to which a work of appropriation art comments on the original, or – in the context of Singapore law – whether it is "criticism" that falls under section 36 rather than general fair dealing in section 35(2) of the Copyright Act.[107] However, if one accepts that the secondary artistic work is capable of repurposing or recharacterising the original work to create "new information, new aesthetics, new insights and understandings",[108] then the application of the transformative use doctrine becomes a more useful evaluative concept to determine how transformation may legitimately occur through a change of meaning as reasonably perceived by the audience to which the secondary work is directed.

27 Referring to the iconic silkscreen works of Andy Warhol, the Sixth Circuit, commented that "[t]hrough distortion and the careful manipulation of context, Warhol was able to convey a message that went beyond the commercial exploitation of celebrity images and became a form of ironic social comment on the dehumani[s]ation of celebrity itself".[109] Although almost a literal depiction of celebrities like Marilyn

104 David Evans, "Introduction: Seven Types of Appropriation" in *Appropriation* (David Evans ed) (MIT Press, 2009) at pp 12–13. See also E Kenly Ames, "Beyond *Rogers v Koons*: A Fair Use Standard for Appropriation" (1993) 93 Colum L Rev 1473.

105 Emily Meyers, "Art on Ice: The Chilling Effect of Copyright on Artistic Expression" (2007) 30 Colum JL & Arts 219 at 220.

106 Isabelle Graw, "Fascination, Subversion and Dispossession in Appropriation Art" in *Appropriation* (David Evans ed) (MIT Press, 2009) at p 214.

107 Cap 63, 2006 Rev Ed.

108 *Blanch v Koons* 467 F 3d 244 at 252 (2d Cir, 2006).

109 *ETW Corp v Jireh Publishing Inc* 332 F 3d 915 at 936 (6th Cir, 2003).

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Monroe, Elizabeth Taylor, Elvis Presley and James Dean, the silkscreens created by Andy Warhol were widely accepted by the US courts as being highly transformative, perhaps influenced to some degree by the interpretations of art critics,[110] largely attributed to the social commentary as intended by the artist. Thus Warhol's reproductions are perceived to be transformative because of a change in meaning, context and purpose, despite minimal visual changes to the original likeness of the individuals portrayed.

28 Laura Heymann made a compelling argument that when one assesses artistic meaning – and that is really what courts are doing in the fair use analysis, even if they are anxious to proclaim that they are not evaluating artistic merit – one should keep in mind that meaning is contextual.[111] In essence, the transformativeness inquiry should focus "not on the second-generation creator, who is often cast as either the hero or the villain in fair use stories, but on the reader (or viewer, or listener), who is, after all, claimed to be the beneficiary of the uses that the doctrine promotes".[112] Analysing "The Treachery of Images", one of the famous paintings by surrealist artist René Magritte, Heymann persuasively pointed out that the transformativeness inquiry is focused on whether a second instance of creative expression is "transformative in its meaning – that is, whether the reader perceives the second copy as signifying something different from the first, … whether the reader perceives an interpretive distance between one copy and another (in other words, a lack of similitude)".[113]

29 In copyright fair use, the pertinent inquiry is whether the secondary work "adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message";[114] many recoding practices, especially in appropriation art, have been argued to be "transformative" under this fair use doctrine.[115] Perhaps parodies and fan fiction are the best examples of transcoding

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110 *Eg*, John Coplans, Jonas Mekas & Calvin Tomkins, *Andy Warhol* (Little Brown & Co, 1970) at pp 50–52 (as cited in *Comedy III Productions Inc v Saderup Inc* 25 Cal 4th 387 at 406 (2001)).

111 Laura A Heymann, "Everything is Transformative: Fair Use and Reader Response" (2008) 21 Colum JL & Arts 445 at 450.

112 Laura A Heymann, "Everything is Transformative: Fair Use and Reader Response" (2008) 21 Colum JL & Arts 445 at 450.

113 Laura A Heymann, "Everything is Transformative: Fair Use and Reader Response" (2008) 21 Colum JL & Arts 445 at 455.

114 *Campbell v Acuff-Rose Music Inc* 510 US 569 at 579 (1994).

115 See generally David Tan, "What Do Judges Know About Contemporary Art?: Richard Prince and Reimagining the Fair Use Test in Copyright Law" (2011) 16 MALR 381; William M Landes & Richard A Posner, "The Legal Protection of Postmodern Art" in *The Economic Structure of Intellectual Property Law* (Harvard University Press, 2003) at pp 254 and 269.

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practices where irreverent portrayals of an iconic literary, dramatic, musical or artistic work recode its semiotic meanings to express a different or counter-viewpoint that creates new understandings, thus rendering the secondary use "transformative" in nature.[116] Rebecca Tushnet explained that fans add new characters, stories or twists to the existing versions of novels and television programmes:[117]

> They are primarily noncommercial and nonprofit. And they give credit to predecessors and originators, whether implicitly or explicitly. Rather than displacing sales of the original, fanworks encourage and sustain a vibrant fan community that helps authori[s]ed versions thrive – Harry Potter, CSI, Star Trek, and other successful works are at the cent[re] of enormous creative fandoms containing hundreds of thousands of fanworks. … Transformativeness in fanworks takes many forms, from critique to celebration to reworking a text so that it better addresses the concerns of a specific audience.

Indeed, one of the most prevalent creative practices of fan communities is "transformation by excavation"[118] – new fan works that creatively illuminate something about the originals by recoding the canonical versions, thereby imparting new meanings to the canonical characters. The author has previously maintained that "in their interpretive activities, fans may arguably, as fair use, comment or criticise the canonical universe of the original author, create parodies of the original works or to express their own creative teleologies that draw on the primacy of the canon".[119] The transformation here is achieved through an interpretive co-ordination between the creators and the audiences with the fan community, and it should be recognised as a legitimate type of transformation. As Tushnet contended, "Using a work as a building block for an argument, or an expression of the creator's imagination, should be understood as a transformative purpose, in contrast to consuming a work [solely] for its entertainment value."[120]

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116 For an account of fan-based activities, see, *eg*, Jonanthan Gray, Cornal Sandvoss & C Lee Harrington eds, *Fandom: Identities and Communities in a Mediated World* (New York University Press, 2007); Karen Hellekson & Kristina Busse eds, *Fan Fiction and Fan Communities in the Age of the Internet* (McFarland & Co, 2006); Henry Jenkins, *Textual Poachers: Television Fans & Participatory Culture* (Routledge, 1992).

117 Rebecca Tushnet, "User-Generated Discontent: Transformation in Practice" (2008) 31 Colum JL & Arts 497 at 503.

118 Rebecca Tushnet, "User-Generated Discontent: Transformation in Practice" (2008) 31 Colum JL & Arts 497 at 503.

119 David Tan, "Harry Potter and the Transformation Wand: Fair Use, Canonicity and Fan Activity" in *Amateur Media: Social, Cultural and Legal Perspectives* (Dan Hunter *et al* eds) (Routledge, 2012) at p 95.

120 Rebecca Tushnet, "User-Generated Discontent: Transformation in Practice" (2008) 31 Colum JL & Arts 497 at 506.

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V. Case study – Making sense of transformative use in appropriation art

A. *The Jeff Koons cases:* Rogers v Koons[121] *and* Blanch v Koons[122]

30 The Second Circuit recognised the genre of appropriation art as a "tradition [that] defines its efforts as follows: when the artist finishes his work, the meaning of the original object has been extracted and an entirely new meaning set in its place. An example is Andy Warhol's reproduction of multiple images of Campbell's soup cans".[123] In *Koons I*, a pre-*Campbell* decision, although the Second Circuit thought that Jeff Koons' earlier work of "a stainless steel casting of an inflatable rabbit holding a carrot" belonged to this genre,[124] it found Koons' sculpture "String of Puppies", which was displayed at an art gallery to be insufficiently transformative and hence infringing the copyright in the original photograph "Puppies" on which the sculpture was based.

31 True to the tradition of appropriation art, there must exist a significant degree of exact reproduction of the original object (for example, Warhol's reverential treatment of the Campbell's soup cans) in order for the artist to convey his comment or criticism of a particular cultural or social phenomenon. It may be just a subtle shift in context, medium, motif or style that delivers the postmodern critique. In *Koons I*, it is arguable that Jeff Koons did just that. He wanted every feature of the photograph by Art Rogers of a typical American scene – a smiling husband and wife holding a litter of eight charming puppies – copied faithfully in the sculpture.[125] The minutiae of Koons' craft itself is a critical commentary of the obsession of the media with, and the general interest of the public in, banality. Four sculptures were made; Koons sold three copies for a total of US$367,000 and kept the fourth for himself. The court accepted Koons' argument that he had drawn upon "the artistic movements of Cubism and Dadaism, with particular influence attributed to Marcel Duchamp, who in 1913 became the first to incorporate manufactured objects (readymades) into a work of art, directly influencing Koons' work and the work of other contemporary American artists".[126] The court also agreed that Koons "belongs to the school of American artists who believe the mass production of

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121 960 F 2d 301 at 304 (2d Cir, 1992).
122 467 F 3d 244 at 252 (2d Cir, 2006).
123 *Rogers v Koons* 960 F 2d 301 at 304 (2d Cir, 1992).
124 *Rogers v Koons* 960 F 2d 301 at 304 (2d Cir, 1992).
125 *Rogers v Koons* 960 F 2d 301 at 305 and 307 (2d Cir, 1992). See also *Campbell v Koons* 1993 WL 97381 (SDNY, 1993) (where Jeff Koons' sculpture "Ushering in Banality" based on Barbara Campbell's photograph "Boys with Pig" was held not to be fair use).
126 *Rogers v Koons* 960 F 2d 301 at 311 (2d Cir, 1992).

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commodities and media images has caused a deterioration in the quality of society, and this artistic tradition of which he is a member proposes through incorporating these images into works of art to comment critically both on the incorporated object and the political and economic system that created it".[127]

32 The Second Circuit's problem with Jeff Koons was that he failed to comment critically on the original photograph that was incorporated into his work. The court was adamant that "[t]he copied work must be, at least in part, an object of the parody … otherwise there would be no real limitation on the copier's use of another's copyrighted work to make a statement on some aspect of society at large".[128] The court found that "even given that 'String of Puppies' is a satirical critique of our materialistic society, it is difficult to discern any parody of the photograph 'Puppies' itself".[129] The fact that Koons had recoded or recontexualised the original photograph and infused it with a new purpose and character was ignored by the court. In finding against fair use, it was evident that the Second Circuit then found repugnant the fact that Jeff Koons was a highly successful appropriation artist, whose artworks often bordered on kitsch and commanded very high prices. The court held that "there is simply nothing in the record to support a view that Koons produced 'String of Puppies' for anything other than sale as high-priced art".[130] However, post-*Campbell*, and indeed 14 years after *Koons I* was handed down, Jeff Koons was back before the Second Circuit again – this time, the result was in his favour, despite the absence of parody.

33 The Second Circuit in *Koons II* did not directly consider the First Amendment freedom of expression interests of Jeff Koons and other appropriation artists in being able to express themselves by drawing upon images from popular culture. Nonetheless, the court demonstrated a greater willingness to embrace appropriation art and its postmodernist technique of repurposing or recharacterising objects and images in mainstream media or familiar to the public at large. Koons' use of Andrea Blanch's photograph "Silk Sandals by Gucci" published in a fashion magazine for his collage "Niagara" – one of the artworks in the

127 *Rogers v Koons* 960 F 2d 301 at 311 (2d Cir, 1992).
128 *Rogers v Koons* 960 F 2d 301 at 310 (2d Cir, 1992).
129 *Rogers v Koons* ("*Koons I*") 960 F 2d 301 at 310 (2d Cir, 1992). Relying on *Koons I*, the New York district court also found against Koons when United Feature Syndicate sued Koons for copyright infringement in his sculptural work "Wild Boy and Puppy" that featured the Odie cartoon dog character from the *Garfield* series. Leisure J did not even attempt to examine issues of parody, satire or critical commentary, but simply cited *Koons I* as authority that the US$125,000 sculptures were nothing but "high-priced art": *United Feature Syndicate Inc v Koons* 817 F Supp 370 at 379 (SDNY, 1993).
130 *Rogers v Koons* 960 F 2d 301 at 312 (2d Cir, 1992).

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Easyfun-Ethereal series exhibited at the Deutsche Guggenheim Berlin – was held to be transformative. To create these paintings, Koons culled images from advertisements or his own photographs, scanned them into a computer, and digitally superimposed the scanned images against backgrounds of pastoral landscapes. He then printed colour images of the resulting collages for his assistants to use as templates for applying paint to billboard-sized 10 × 14-in canvasses. Koons did not intend to parody or comment on the original Blanch photograph, but he claimed that he had created the painting to "comment on the ways in which some of our most basic appetites – for food, play and sex – are mediated by popular images".[131] He also intended to "compel the viewer to break out of the conventional way of experiencing a particular appetite as mediated by mass media"[132] and he used Blanch's photograph because it represented "a particular type of woman frequently presented in advertising" and that this typicality "further[ed] his purpose of commenting on the commercial images … in our consumer culture".[133]

34 The Second Circuit held that even though "Niagara" appears to target the genre of which "Silk Sandals" is typical, rather than the individual photograph itself, "the broad principles of *Campbell* are not limited to cases involving parody".[134] The court implicitly recognised that *Koons I* may not be good law today. Furthermore, the court reiterated that in the examination of fair use in contemporary art, one should not be overly concerned on whether the secondary work comments on the original:[135]

> The question is whether Koons had a genuine creative rationale for borrowing Blanch's image, rather than using it merely 'to get attention or to avoid the drudgery in working up something fresh'. Although it seems clear enough to us that Koons's use of a slick fashion photograph enables him to satiri[s]e life as it appears when seen through the prism of slick fashion photography, we need not depend on our own poorly honed artistic sensibilities.

After *Koons II*, it appears that courts should focus instead on examining the appropriation artist's "justification for the very act of borrowing"[136] and the artist's explanation of how "the use of an existing image advanced his artistic purposes".[137] In *Koons II*, the Second Circuit did not

131 *Blanch v Koons* 467 F 3d 244 at 247 (2d Cir, 2006).
132 *Blanch v Koons* 467 F 3d 244 at 247 (2d Cir, 2006).
133 *Blanch v Koons* 467 F 3d 244 at 248 (2d Cir, 2006).
134 *Blanch v Koons* 467 F 3d 244 at 255 (2d Cir, 2006).
135 *Blanch v Koons* 467 F 3d 244 at 255 (2d Cir, 2006).
136 *Campbell v Acuff-Rose Music Inc* 510 US 569 at 581 (1994); *Blanch v Koons* 467 F 3d 244 at 255 (2d Cir, 2006).
137 *Blanch v Koons* 467 F 3d 244 at 255 (2d Cir, 2006). At 255, footnote 5, the court also cautioned: "Koons' clear conception of his reasons for using 'Silk Sandals', and his ability to articulate those reasons, ease our analysis in this case. We do not

(*cont'd on the next page*)

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find it necessary to examine whether Koons was commenting on Blanch's photograph, but instead pronounced that "[t]he sharply different objectives that Koons had in using, and Blanch had in creating, 'Silk Sandals' confirms the transformative nature of the use".[138]

35 The Second Circuit's focus on "artistic purpose" is consistent with the language of section 107 of the Copyright Act,[139] which directs courts to examine the "purpose and character" of the infringing secondary use when determining fair use. Peter Jaszi suggested that *Koons II* "may signal a general loosening of authors' and owners' authority over, by now, not quite so auratic works, allowing greater space for the free play of meaning on the part of audience members and follow-up users who bring new interpretations".[140] This kind of art – typical of the oeuvre of contemporary artists like Warhol, Koons and Prince – has been termed "non-propositional art" because it conveys "no single representation or message".[141] Randall Bezanson contends that such art yields "a message or meaning that is the creation not of the artist's propositional intention but the viewer's independent construction".[142] Referring to Warhol's Campbell's Soup Cans and Prince's Marlboro Man series, Benzanson argued that "their 'message' is their value as an instrument that unleashes the viewer's own, perhaps idiosyncratic, leap of imagination and perception".[143] These views are reinforced by Murray's explanatory synthesis of decisions rendered by the US Circuits Court of Appeals where he concluded that:[144]

> A change in context for an artistic work even without any changes to the content of the work may be sufficient if the predominant purpose and function of the new work is sufficiently different from the original work *and* fulfils one of the [principal] goals of the copyright laws.

36 Indeed in *Bouchat v Baltimore Ravens Ltd Partnership*, the display of the infringing "Flying B" logo at the Baltimore Ravens' headquarters was a use with a purpose and function different from the

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mean to suggest, however, that either is a *sine qua non* for a finding of fair use – as to satire or more generally."

138 *Blanch v Koons* 467 F 3d 244 at 252 (2d Cir, 2006).

139 Copyrights 17 USC (US); Copyright Act of 1976.

140 Peter Jaszi, "Is There Such a Thing as Postmodern Copyright?" (2009) 12 Tul J Tech & Intell Prop 105 at 116.

141 Randall P Bezanson, *Art and Freedom of Speech* (University of Illinois Press, 2009) at p 280.

142 Randall P Bezanson, *Art and Freedom of Speech* (University of Illinois Press, 2009) at p 280.

143 Randall P Bezanson, *Art and Freedom of Speech* (University of Illinois Press, 2009) at p 285.

144 Michael D Murray, "What is Transformative? An Explanatory Synthesis of the Convergence of Transformation and Predominant Purpose in Copyright Fair Use Law" (2012) 11 Chi-Kent J Intell Prop 260 at 279.

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artistic purpose and meaning of the original work; the secondary use, in a museum-like setting is akin to the fair use of a work for teaching, scholarship or research, was found to be transformative.[145] However, in *Gaylord v United States*, although the photograph and the commemorative postage stamp issued by the US Postal Service ("USPS") depict the plaintiff's Korean War Veterans Memorial sculpture, "The Column", USPS altered the appearance of the sculpture to display a different tone and mood, the ultimate meaning and message of the original memorial and the two artistic adaptations was held to be the same: to remember and celebrate veterans of the Korean War.[146] The lower court had found that there was visual alteration to the original work and as the three-dimensional sculpture was transformed in the photograph by "creating a surrealistic environment with snow and subdued lighting where the viewer is left unsure whether he is viewing a photograph of statues or actual human beings".[147] However, the Federal Circuit held that "although the stamp altered the appearance of 'The Column' by adding snow and muting the colour, these alterations do not impart a *different character* to the work" [emphasis added];[148] essentially mere visual transformation is not sufficiently transformative, the key is a change in character or purpose.

37 In the area of appropriation art, the authorial intent is invariably to do something that is different from the purpose of the original artist. In order to avoid interpretations that allow everything to be transformative, the inquiry must go further than interrogating the intent or purpose of the secondary artist. As Heymann explained:[149]

> [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,

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145 619 F 3d 301 at 314 (4th Cir, 2010). However, the public commercial sale of the Baltimore Ravens highlight films of the 1996, 1997 and 1998 seasons for US$50 each, which feature the infringing "Flying B" logo based on the plaintiff's drawing was not fair use. The court held (at 309): "There is no transformative purpose behind the depiction of the Flying B logo in the highlight films. The use of the logo in the films serves the same purpose that it did when defendants first infringed Bouchat's copyrighted Shield logo design: the Flying B logo identifies the football player wearing it with the Baltimore Ravens. The simple act of filming the game in which the copyrighted work was displayed did not add something new to the logo." [internal citations omitted]

146 595 F 3d 1364 (Fed Cir, 2010).

147 *Gaylord v United States* 85 Fed Cl 59 at 68–69 (2008). At 69: The court determined that the US Postal Service further transformed "The Column" by "making it even grayer, creating a nearly monochromatic image. This adjustment enhanced the surrealistic expression ultimately seen in the Stamp by making it colder".

148 *Gaylord v United States* 595 F 3d 1364 at 1373 (Fed Cir, 2010).

149 Laura A Heymann, "Everything is Transformative: Fair Use and Reader Response" (2008) 21 Colum JL & Arts 445 at 449.

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> the defendant's 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. [emphasis added]

Heymann contended that by asking the question from the reader's perspective, one can better determine whether the defendant's use promotes the delivery of new works to the public, the ultimate goal of copyright law.[150] As such, the notion of recoding an original work to convey new meaning to the public can be an important additional evaluative tool for courts to ascertain if indeed this repurposing or recharacterising has occurred and the original work has been sufficiently transformed.

B. Cariou v Prince[151]

38 In *Cariou v Prince*, the plaintiff Patrick Cariou is a professional photographer who spent time with Rastafarians in Jamaica over the course of six years, "gaining their trust and taking their portraits".[152] Cariou subsequently published a book of photographs in 2000 titled *Yes, Rasta* that contained both portraits of Rastafarian individuals in Jamaica and landscape photos taken by him in Jamaica. In the tradition of his appropriation style, Richard Prince recontextualised Cariou's photographs in his Canal Zone series and "ultimately completed 29 paintings in his contemplated Canal Zone series, 28 of which included images taken from *Yes, Rasta*".[153] In an exhibition at the Gagosian Gallery in New York in 2008, the gallery showed 22 of the 29 Canal Zone paintings at one of its Manhattan locations and also published and sold an exhibition catalogue from that show.

39 In his testimony before the New York district court, Cariou revealed that he was negotiating with gallery owner Christiane Celle, who planned to show and sell prints of the *Yes, Rasta* photographs at her Manhattan gallery, prior to Prince's Canal Zone show's opening. Cariou also testified that he intended in the future to issue artists' editions of the *Yes, Rasta* photographs, which would be offered for sale to collectors. Celle had originally planned to exhibit between 30 and 40 of Cariou's photographs at her gallery, with multiple prints of each to be sold at prices ranging from US$3,000 to US$20,000. However, when Celle became aware of the Canal Zone exhibition at the Gagosian Gallery, she

150 Laura A Heymann, "Everything is Transformative: Fair Use and Reader Response" (2008) 21 Colum JL & Arts 445 at 448–449.
151 784 F Supp 2d 337 (SDNY, 2011).
152 784 F Supp 2d 337 at 342 (SDNY, 2011).
153 *Cariou v Prince* 784 F Supp 2d 337 at 344 (SDNY, 2011).

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cancelled the show "because she did not want to seem to be capitali[s]ing on Prince's success and notoriety".[154]

40 The grant of summary judgment on the issues of copyright infringement, fair use and liability demonstrates more of Batts J's unequivocal disdain for Richard Prince's commercial success and his appropriation art style, rather than an adroit judicial reasoning and a principled approach to fair use. In *Prince*, Batts J ignored Prince's deposition that his Canal Zone series was open to myriad interpretations, and refused to entertain possible reader responses to the recontextualised meanings of Cariou's photographs. Her Honour erred in finding that there was a lack of transformation under the first factor of fair use because "Prince testified that he doesn't 'really have a message' he attempts to communicate when making art. … In creating the Paintings, Prince did not intend to comment on any aspects of the original works or on the broader culture".[155] However, it was clearly shown in the Defendants' Memorandum, that Prince's creation of the Canal Zone series was informed by certain core meanings or messages he intended to convey through them:[156]

> (a) Prince's concept of a fantastical post-apocalyptical world, where music was the only redeeming thing to survive, as shown through repetitive use of the guitar, figures as band members, and rhythm as expressed through various painterly and collaging techniques;
>
> (b) an ongoing exploration of the relationships that exist in the world, which are men and men, men and women, and women and women; and
>
> (c) equality between the sexes, as shown though their nudity and roles as band members.

Moreover, Batts J completely missed the point in Prince's testimony. Prince, in fact, testified that "in any artwork I don't think there's any one message",[157] consistent with how contemporary artists often prefer to let the audience debate the multiplicity of meanings that may be attributed to a particular work of art that has recoded an earlier work.[158] Prince had

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154 *Cariou v Prince* 784 F Supp 2d 337 at 344 (SDNY, 2011).
155 *Cariou v Prince* 784 F Supp 2d 337 at 349 (SDNY, 2011).
156 *Memorandum of Law in Opposition to Plaintiff's Motion for Summary Judgment* (Case 1:08-CV-11327-DAB) (filed 14 June 2010) at pp 12–13.
157 *Memorandum of Law in Opposition to Plaintiff's Motion for Summary Judgment* (Case 1:08-CV-11327-DAB) (filed 14 June 2010) at p 13.
158 *Eg*, Emily Meyers, "Art on Ice: The Chilling Effect of Copyright on Artistic Expression" (2007) 30 Colum JL & Arts 219 at 219 ("Many artists now use existing images and objects, both from fine art as well as from advertising and mass media, to challenge the viewer's conceptions of art and iconography").

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transformed the original purpose and character of Cariou's photographs through a change in context and visual embellishments, thus allowing the audience to reasonably perceive and decode a number of possible new meanings.

41 Richard Prince's use of Cariou's photographs is markedly different from the USPS's use of Frank Gaylord's on postage stamps to honour veterans of the Korean War. Prince did *not* say that his Canal Zone series had no message at all. On the other hand, Batts J held:[159]

> On the facts before the Court, it is apparent that Prince did not intend to comment on Cariou, on Cariou's Photos, or on aspects of popular culture closely associated with Cariou or the Photos when he appropriated the Photos, and Prince's own testimony shows that his intent was not transformative within the meaning of Section 107, *though Prince intended his overall work to be creative and new*. [emphasis added]

This holding is contrary to the principles laid down in *Koons II* (a Second Circuit decision binding on the New York courts), previous decisions of the New York district courts,[160] and the Supreme Court's observations in *Campbell* that the critical message of the artist could reasonably be perceived as commenting on the original because of a juxtaposition of different purposes or meanings.

42 In *Prince*, it ought to be a triable issue of fact whether the Canal Zone series could reasonably be perceived to contain significantly different messages or meanings from Cariou's original photographs – thus creating "new information, new aesthetics, new insights and understandings"[161] – even though there may not have been a direct comment on Cariou's photographs. The value of transformative recoding "lies in the observer's opportunity to confront a familiar work in a nuanced context … [and this] unanticipated juxtaposition of familiar and unfamiliar challenges the viewer's preconceptions as it shifts the force of the dominant culture against itself".[162] The "customi[s]ation of the natural world" through disruptive interventions of colour and artificiality has long been the style of conceptual art

159 *Cariou v Prince* 784 F Supp 2d 337 at 349 (SDNY, 2011).
160 *Eg*, *Bourne Co v Twentieth Century Fox Film Corp* 602 F Supp 2d 499 at 508 (SDNY, 2009); *Warner Bros Entertainment Inc v RDR Books* 575 F Supp 2d 513 at 541 (SDNY, 2008).
161 *Campbell v Acuff-Rose Music Inc* 510 US 569 at 579 (1994).
162 Emily Meyers, "Art on Ice: The Chilling Effect of Copyright on Artistic Expression" (2007) 30 Colum JL & Arts 219 at 220. See also Kembrew McLeod, *Freedom of Expression: Overzealous Copyright Bozos and Other Enemies of Creativity* (Doubleday, 2005) at p 132.

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photographers like Roy Villevoye and Nina Katchadourian;[163] Prince's photographs could have been examined by a jury against this backdrop of prevailing artistic conventions. As Heymann provocatively put it: "[I]f we are to retain transformativeness as a relevant answer, then, let us at least ask the right question – not 'Who is speaking?' but 'Who is listening?'"[164]

43 It is arguable that Batts J's finding that Prince's Canal Zone series was "minimally transformative"[165] was erroneous because she required comment on the original, and that Prince in presenting a completely different artistic message and purpose from Cariou's original photographs documenting the lives of the Rastafarians, in fact, created highly transformative works.[166] In *Nunez v Caribbean International News Corp*[167] ("*Nunez*"), the First Circuit Court of Appeals found that copying a photograph that was intended to be used in a modelling portfolio and using it instead in a news article was a transformative use. By putting a copy of the photograph in the newspaper, the work was transformed into news, creating a new meaning or purpose for the work. The use of Cariou's images in Prince's Canal Zone series is more analogous to the situation in *Nunez* and *Koons II* because Prince had created a new purpose for the images. There is much similarity between Koons' and Prince's intent in reproducing original photographs in order to successfully convey new meanings through repurposing pre-existing works.

VI. Conclusions

44 The transformative use doctrine can be a chimera. Like the mythological, fire-breathing monster commonly represented with a lion's head, a goat's body and a serpent's tail, its myriad applications to secondary uses from parody rap to fan fiction to internet search engines can be frustrating for anyone who attempts to exhaustively define categories or clusters of transformative fair use. It would be a futile endeavour. Instead, the starting point should be the legislative text and one ought to attempt to discern whether there was a reasonably perceivable change in "purpose" or "character" of the secondary use, and be guided by the US Supreme Court's ruling in *Campbell*. The parody

163 Charlotte Cotton, *The Photograph as Contemporary Art* (Thames & Hudson, 2004) at pp 35–36.
164 Laura A Heymann, "Everything is Transformative: Fair Use and Reader Response" (2008) 21 Colum JL & Arts 445 at 466.
165 *Cariou v Prince* 784 F Supp 2d 337 at 351 (SDNY, 2011).
166 See *Blanch v Koons* 467 F 3d 244 at 253 (2d Cir, 2006): "When, as here, the copyrighted work is used as 'raw material' in the furtherance of distinct creative or communicative objectives, the use is transformative" [internal citations omitted].
167 235 F 3d 18 at 22–23 (1st Cir, 2000).

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and satire distinction – employed by certain lower courts – is a blunt categorical approach to evaluating transformation, since changes in purpose and character may be effected without a direct comment or criticism of the original work.[168] The US Circuit Court decisions in *Perfect 10*, *Koons II* and *Bill Graham Archives* each illustrates 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. Despite the reluctance of some US district courts to follow the Supreme Court precedent,[169] *Campbell* is nonetheless:[170]

> … widely perceived to have set a significant mid-course correction in the direction of fair use law … [and that] fair use would be a true multifactor test in which factors two, three, and four would be assessed and weighed in line with the degree of transformativeness of the use, rather than the market-cent[re]d presumptions set out in *Sony* and *Harper & Row*.

45 Not surprisingly, the statutory factors of fair use/fair dealing will not always all point in the same direction. Moreover, the fair use/fair dealing analysis in the US and Singapore is not limited to the enumerated statutory factors, and courts may take into account other factors like whether the defendant has acted in good faith or what is in the public interest. While this article has focused on the centrality of the transformative use doctrine under the first factor of fair dealing, the fourth factor of fair dealing is also important. However, courts should be careful not to confuse the commercial success of the artist or secondary work with "the effect of the dealing upon the potential market for, or value of, the work or adaptation".[171]

46 Under both the US and Singapore statutory provisions, the "commercial nature" of the secondary work is a relevant consideration under the first factor of fair dealing. However, the *Campbell* court had stated that "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".[172] In *Campbell*, the Supreme Court held that the fourth factor of fair use "requires courts to consider not only the extent

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168 Recent amendments to the Australian Copyright Act have created a categorical fair dealing exemption for both parody *and* satire. See Copyright Act 1968 (Act No 63 of 1968) (Cth) (Aust) s 41A: "A fair dealing with a literary, dramatic, musical or artistic work … does not constitute an infringement of the copyright in the work if it is for the purpose of parody or satire."

169 Barton Beebe, "An Empirical Study of US Copyright Fair Use Opinions, 1978–2005" (2008) 156 U Pa L Rev 549 at 572.

170 Neil Weinstock Netanel, "Making Sense of Fair Use" (2011) 15 Lewis & Clark L Rev 715 at 722–723.

171 Copyright Act (Cap 63, 2006 Rev Ed) s 35(2)(*d*).

172 *Campbell v Acuff-Rose Music Inc* 510 US 569 at 579 (1994).

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of market harm caused by the particular actions of the alleged infringer, but also whether unrestricted and widespread conduct of the sort engaged in by the defendant would result in a substantially adverse impact on the potential market for the original".[173] Indeed, where the secondary work serves as a market replacement for the original or its derivatives, it will be likely that cognisable market harm to the original or its derivatives will occur.[174] However, the repurposed photograph as a sculpture depicting banality in *Koons I* and the recharacterisation of Rastafarians as band members in a post-apocalyptic world in *Prince* have imparted a significantly different purpose and character to the secondary works. Whether a fine art cognoscenti or a layperson, one should have no problem identifying the different markets for the modestly priced artistic works of Art Rogers and Patrick Cariou, and the prohibitively expensive works of Jeff Koons and Richard Prince.[175]

47 Furthermore, the Second Circuit had also clarified:[176]

> The fourth statutory fair use factor requires us to evaluate the economic impact of the allegedly infringing use upon the copyright owner. The focus here is on whether defendants are offering a market substitute for the original. In considering the fourth factor, our concern is not whether the secondary use suppresses or even destroys the market for the original work or its potential derivatives, but whether the secondary use usurps the market of the original work. … [T]he relevant market effect with which we are concerned is the market for plaintiffs' 'expression', and thus it is the effect of defendants' use of that expression on plaintiffs' market that matters, not the effect of defendants' work as a whole.

The "commerciality" of the secondary work (a consideration under the first factor of fair use) is a different analysis from the effect of the secondary use upon the potential commercial market for, or value of, the copyrighted work or its adaptations (a consideration under the fourth factor of fair use).[177] A highly successful secondary work by an appropriation artist does not substitute or reduce demand for the

173 *Campbell v Acuff-Rose Music Inc* 510 US 569 at 590 (1994).

174 *Campbell v Acuff-Rose Music Inc* 510 US 569 at 591–593 (1994).

175 It has been pointed out that courts appear to have a poor understanding of the art market. For example, in her analysis of *Rogers v Koons* 960 F 2d 301 (2d Cir, 1992), Lynne Greenberg argues that it "seems farfetched to imagine that Koons' 'high-priced' kitsch, sold in the elite world of the art gallery, could even tangentially affect the market for either Rogers' commissioned photographs or Rogers' postcards, sold predominantly in gift shops". Lynne A Greenberg, "The Art of Appropriation: Puppies, Piracy, and Post-Modernism" (1992) 11 Cardozo Arts & Ent LJ 1 at 32.

176 *NXIVM Corp v The Ross Institute* 364 F 3d 471 at 481–482 (2d Cir, 2006).

177 In his empirical study, Sag concluded that "[c]ommercial/non-commercial simply does not appear to capture any meaningful distinction in litigated fair use cases": Matthew Sag, "Predicting Fair Use" (2012) 73 Ohio St LJ 47 at 85.

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original work, and may, in fact, increase demand for the original work. However, more importantly, in the primary or print markets for art, there are no true substitutes, even for what may appear to some to be a non-transformative work. Referring to Sherrie Levine's rephotographing of Walker Evans' photographs in her series titled *After Walker Evans*, Emily Meyers argues that "[i]n this regard, authorship is tantamount, for it infuses the appropriated or derivative work with vastly different significance. A derivative or appropriating use in this regard will never substitute for the original".[178] Indeed, the original image by Evans and the second by Levine may be indistinguishable from one another, "the roles each plays in the history of art continuum are unique",[179] but Evans' image clearly has a different purpose and character from Levine's.[180] As Martin Senftleben so eloquently put it:[181]

> In all époques, new cultural productions have been inspired by and based upon pre-existing cultural material … it is a primary goal of copyright to allow authors to build upon pre-existing works when embarking on the creation of a new literary or artistic work. In this way, copyright law ensures a constant cycle of cultural productions on the basis of already existing individual forms of expression.

48 Since *Campbell*, the "transformativeness reasoning gradually rose to become the most important principle in interpreting fair use among judges … [and] became a central principle by which ordinary people could interpret fair use" [internal quotations omitted].[182] Murray's recent empirical study concluded that even if original works were not changed in form, function or genre, the fair use works were transformed through an alteration of the contents, recontextualisation of the copied material or addition of significant creative expression so that the predominant purpose of the new work was significantly

178 Emily Meyers, "Art on Ice: The Chilling Effect of Copyright on Artistic Expression" (2007) 30 Colum JL & Arts 219 at 239.

179 Emily Meyers, "Art on Ice: The Chilling Effect of Copyright on Artistic Expression" (2007) 30 Colum JL & Arts 219 at 239.

180 Art historians have highlighted "the political and feminist underpinnings of the exclusively masculine works by seminal male artists Levine chose to appropriate": Emily Meyers, "Art on Ice: The Chilling Effect of Copyright on Artistic Expression" (2007) 30 Colum JL & Arts 219 at 224. See also Sherrie Levine, "After Walker Evans: 2" (reproduced photograph) at the Metropolitan Museum of Art <http://www.metmuseum.org/toah/works-of-art/1995.266.2> (accessed 23 November 2012).

181 Martin R F Senftleben, "Quotations, Parody and Fair Use" in *1912–2012: A Century of Dutch Copyright Law* (P B Hugenholtz, A A Quaedvlieg & D J G Visser eds) (deLex, 2012) at pp 345–346.

182 Patricia Aufderheide & Peter Jaszi, *Reclaiming Fair Use: How to Put Balance Back in Copyright* (University of Chicago Press, 2011) at p 85.

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different from the original work.[183] Indeed whether the creator of a transformative work is a struggling artist on a shoestring budget like Thomas Forsythe or a hugely successful public figure with funding from the Solomon R Guggenheim Foundation like Jeff Koons, fair use/fair dealing allows artists to enrich the public domain and further the generation of new meaning through repurposing pre-existing works. The US decisions are not as schizophrenic as some commentators have portrayed, and can certainly go a long way in assisting the interpretation of the fair dealing provision in Singapore to foster "an environment conducive to the development of creative works".[184]

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183 Michael D Murray, "What is Transformative? An Explanatory Synthesis of the Convergence of Transformation and Predominant Purpose in Copyright Fair Use Law" (2012) 11 Chi-Kent J Intell Prop 260 at 291.

184 *Singapore Parliamentary Debates, Official Report* (16 November 2004) vol 78 at col 1070 (S Jayakumar, Minister for Law).

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