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Bridgemen Art Library, Ltd. v. Corel Corporation Revisited: Authors Guild v. Hathitrust and the New Frontier of Fair Use

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***BRIDGEMAN ART LIBRARY, LTD. V. COREL CORPORATION REVISITED:
AUTHORS GUILD V. HATHITRUST AND THE NEW FRONTIER OF FAIR USE***

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I. Introduction

On June 10, 2014, the United States Court of Appeals for the Second Circuit held in *Authors Guild, Inc. v. HathiTrust*,¹ that a research university compiling mass digital copies of copyrighted works to create a library database was fair use under 17 U.S.C. § 107.² This unprecedented decision by the Second Circuit set the stage for how educational mass digitization would be treated in the future.

Prior to this decision, courts had not addressed the issue of whether works as products of a digitization process were copyrightable since *Bridgeman Art Library, Ltd. v. Corel Corporation*.³ Bridgeman Art Library, now Bridgeman Images, was founded in 1972 with the purpose of providing a “central resource of fine art . . . for reproduction to creative professionals.”⁴ Bridgeman is in the business of contracting with art museums and other organizations to obtain color transparencies or digital photographs of public domain artwork from their collections that would be marketed publicly. Copies of these digital photographs are provided to those who license with Bridgeman to use the images, as well as to their clients on

¹ *Authors Guild, Inc. v. HathiTrust*, 755 F.3d 87, 105 (2d Cir. 2014).

² *Id.*

³ *Bridgeman Art Library, Ltd. v. Corel Corp.*, 36 F. Supp. 2d 191 (S.D.N.Y. 1999).

⁴ *About Bridgeman*, BRIDGEMAN IMAGES, <http://www.bridgemanimages.com/en-US/about-bridgeman/> (last visited Aug. 4, 2015).

CD-ROMs.⁵ Corel marketed computer software products – one of which was a set of seven CD-ROMs containing seven hundred (700) digital reproductions of well-known public domain artwork.⁶ Bridgeman contended that the digital images in Corel’s possession could have only come from Bridgeman and therefore infringed their copyright in those images.⁷ Two different cases were filed in the Southern District of New York. The first *Bridgeman* decision, in November 1998, decided that the United Kingdom’s law determined whether Bridgeman’s works were even copyrightable, finding that they did not because they lacked sufficient originality⁸, while United States law was used to decide whether infringement had occurred, which the court also posited it did not because no actual copying had been proved.⁹ Following the first decision, the court agreed to rehear the case after Bridgeman moved for reargument and reconsideration.¹⁰ In the second *Bridgeman* decision, United States law was applied to both issues of copyrightability and infringement, however, the result was the same. The court ultimately reasoned that copyright in the works was unavailable, because Bridgeman, by their own testament, created “slavish copies” that had “no spark of originality.”¹¹

Since *Bridgeman* was decided in 1999, numerous scholars have argued that the case was wrongly decided. Some arguments are grounded in the understanding that not allowing copyright in the photographic reproductions of artworks by museums and institutions like Bridgeman, actually goes against copyright law’s ultimate mission of encouraging public viewing and

⁵ *Bridgeman Art Library, Ltd. v. Corel Corp.*, 25 F. Supp. 2d 421, 423-24 (S.D.N.Y. 1998).

⁶ *Id.* at 424-25.

⁷ *Id.* at 425-26.

⁸ *Id.* at 427.

⁹ *Id.* at 428.

¹⁰ 36 F. Supp. 2d 191, 192 (S.D.N.Y. 1998).

¹¹ *Id.* at 197.

consumption of artwork.¹² Others stand for the proposition that the decision denies the amateur and professional museum photographer incentives to ply their craft by denying protection in a way that is fundamentally unfair.¹³ Regardless, the academic community has analyzed and in many cases criticized the holding of *Bridgeman* and its long-term effects on copyright law.

These arguments have been centered on the debate of whether or not the *Feist Publications, Inc. v. Rural Telephone Service Company, Inc.*, originality requirement of a “minimal degree of creativity” was actually satisfied.¹⁴ I come to the same conclusion as many of these scholars – the decision of *Bridgeman* is wrong – wrong for its impact on the future of copyright law and wrong for its negative effect on society’s access and consumption of artwork. However, I come to this conclusion not on an originality argument, but rather for an argument of fair use. As it stands, under *Bridgeman*, museums have little incentive outside of advertisements for exhibitions and merchandise sales in the gift shop to produce photographic reproductions of their art work still under copyright. An application of fair use would encourage museums to create photographic reproductions of their artwork, furthering the dissemination of such works to society for educational and cultural consumption – a current that runs at the heart of copyright law. Because of the recent decisions by the Second Circuit in *HathiTrust*, understandings of fair use have expanded to adapt to a technologically dependent society and, as a result, seriously call into question the rationale behind *Bridgeman* today.

¹² Robin J. Allan, *After Bridgeman: Copyright, Museums, and Public Domain Works of Art*, 155 U. PA. L. REV. 961, 964 (2007).

¹³ Terry S. Kogan, *Photographic Reproductions, Copyright and the Slavish Copy*, 35 COLUM. J.L. & ARTS 445, 448 (2012).

¹⁴ *Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 49 U.S. 340 (1991). *See generally* Kimberly N. Dobson, *The Originality of Photographs for Purposes of Copyright Law Before and After Bridgeman Art Library, Ltd. v. Corel Corp.*, 10 FLA. COASTAL L. REV. 319, 320-21 (2009).

II. *Authors Guild v. HathiTrust*

A. Background

In December, 2004, Google announced its Library Project to respond to the demands of the digital world for not only a workable but comprehensive location to access digital copies of published works. Other companies and organizations¹⁵ have attempted to interject themselves into this forum, but pale in comparison to Google's ambitious goal to create a "comprehensive, searchable, virtual card catalog of all books in all languages."¹⁶

Essentially, Google digitizes a library's print work and retains one copy to be made available on Google Books, where users can search the content and view "snippets" of the pages of the books.¹⁷ In exchange for providing books to Google's repository, Google then gives the participating libraries with the other digital copy of the book.¹⁸ Universities that participated in partnerships with Google saw their newfound collection of digitized materials as an opportunity to create a shared digital repository for these Universities in order to provide access to each other's digital collections, and in October, 2008, became the HathiTrust Digital Library (HDL).¹⁹ In other words, after Google supplies the participating Universities with the digital copy of the printed work, it is then made part of the HDL.²⁰

¹⁵ See, e.g., PROJECT GUTENBERG, <http://www.gutenberg.org/> (last visited Aug. 4, 2015); INTERNET ARCHIVE, <https://archive.org/index.php> (last visited Aug. 4, 2015).

¹⁶ *Google Books Library Project*, GOOGLE BOOKS, <https://www.google.com/googlebooks/library/> (last visited Aug. 4, 2015).

¹⁷ *Authors Guild v. HathiTrust*, 902 F. Supp. 2d 445, 448 (S.D.N.Y. 2012).

¹⁸ More than two copies are made of the books in actuality. However, only two copies are made available to the public eye. See Emily Anne Proskine, *Google's Technicolor Dreamcoat: A Copyright Analysis of the Google Book Search Library Project*, 21 BERKELEY TECH. L.J. 213, 217 (2006).

¹⁹ Jeremy York, *This Library Never Forgets: Preservation, Cooperation, and the Making of HathiTrust Digital Library*, in SOC'Y FOR IMAGING SCI. & TECH., ARCHIVING 2008 FINAL PROGRAM AND PROCEEDINGS 5 (2008), available at <http://www.hathitrust.org/documents/This-Library-Never-Forgets.pdf>.

²⁰ *Id.*

B. Procedural History

Twenty authors and authors' associations brought a copyright infringement action against HathiTrust on September 12, 2011, in the United States District Court for the Southern District of New York. The plaintiffs, led by the Authors Guild, sought an injunction against the "reproduction, distribution, or display" of any of their member authors' works, an injunction against the Universities' original supplication of print works to Google for the purposes of digitization unless authorized, and the impoundment of all unauthorized digital copies already in HathiTrust's possession.²¹

HathiTrust moved for summary judgment on the ground that their use of the copyright material was protected under the doctrine of fair use.²² Judge Harold Baer, Jr. granted HathiTrust's motions for summary judgment on the infringement claim and stated that:

Although I recognize that the facts here may on some levels be without precedent, I am convinced that they fall safely within the protection of fair use such that there is no genuine issue of material fact. I cannot imagine a definition of fair use that would not encompass the transformative uses made by [HDL] and would require that I terminate this invaluable contribution to the progress of science and cultivation of the arts that at the same time effectuates the ideals espoused by the [Americans with Disabilities Act].²³

The district court summarized that the digitized works that become a part of the HDL are used in three ways: 1) full-text searches, 2) preservation for the future, and 3) print-disability access.²⁴ In regards to the full-text searches, the district court noted that "[f]or works that are not in the public domain or for which the copyright owner has not authorized use, the full-text search indicates only the page numbers on which a particular term is found and the number of times the

²¹ *Id.*

²² *Id.* at 456.

²³ *Id.* at 464.

²⁴ Authors Guild v. Hathitrust, 902 F. Supp. 2d 445, 448 (S.D.N.Y. 2012).

term appears on each page.”²⁵ Further, the district court reasoned that HDL had “revolutionized” academic participation for print-disabled students.²⁶

Authors Guild then appealed to the United States Court of Appeals for the Second Circuit, which affirmed the district court’s findings that HathiTrust’s digitization of copyrighted works to permit full-text searches and print-disability access was fair use.²⁷

C. Fair Use

The Copyright Act, while granting exclusive rights to authors of works during their term of copyright, also limits that control through the doctrine of fair use. To determine whether each of a use is protected under the doctrine of fair use, courts look to 17 U.S.C. § 107 for the four non-exclusive factors to be weighed to assess whether a “particular use is fair”:

- [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.²⁸

Rather confusingly, court opinions have lacked specificity on how fair use works: as an affirmative defense to a prima facie showing of infringement²⁹, or a protected use which is not considered infringement at all.³⁰ Regardless, courts can agree that the factors must be evaluated to ultimately determine whether the goal of copyright, “[t]o promote the Progress of Science and

²⁵ *Id.* (internal citations omitted).

²⁶ *Id.* at 449.

²⁷ *Authors Guild, Inc. v. HathiTrust*, 755 F.3d 87, 97-103 (2d Cir. 2014). The issue of preservation for future use was remanded back to the district court to determine whether there were any plaintiffs who had standing to bring suit. *Id.* at 104.

²⁸ 17 U.S.C. § 107 (2012).

²⁹ *Authors Guild*, 902 F. Supp. 2d at 448.

³⁰ *Authors Guild*, 755 F.3d at 95.

useful Arts,”³¹ is best served by allowing the use rather than prohibiting it.³² Further, when evaluating all four factors, courts also consider an important theme that flows through each factor: a fair use will not be considered fair, if it “excessively damage[s] the market for the original by providing the public with a substitute for that original work.”³³

1. Character and Purpose of the Use

The first factor evaluates the character and purpose of the use, with especial focus on whether the use is transformative.³⁴ A use is transformative if it “adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message”³⁵

Rejecting Authors Guild’s argument that the use is not transformative because HDL has not added anything “new,”³⁶ the district court stated that “a transformative use can also be one that serves an entirely different purpose.”³⁷ The district court articulated that HDL serves an entirely different purpose than that of the original print works.³⁸ Further, the district court, based on Second Circuit case law,³⁹ stated that this factor can weigh in a defendants’ favor when the purpose of the use is for scholarship and research.⁴⁰ Despite Authors Guild’s argument that HDL should not be “shielded . . . by virtue of their status as educational non-profits” and that HDL had a primarily commercial purpose when it made its agreement with Google,⁴¹ the district court

³¹ U.S. CONST. art. I, § 8, cl. 8.

³² *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 569 (1994).

³³ *Authors Guild*, 755 F.3d at 95.

³⁴ *Id.* at 96.

³⁵ *Campbell*, 510 U.S. at 569.

³⁶ *Authors Guild v. Hathitrust*, 902 F. Supp. 2d 445, 460 (S.D.N.Y. 2012).

³⁷ *Id.*

³⁸ *Id.*

³⁹ *See NXIVM Corp. v. Ross Inst.*, 364 F.3d 471, 477 (2d Cir. 2004).

⁴⁰ *Authors Guild*, 902 F. Supp. 2d at 459.

⁴¹ *Id.* at 461.

concluded that HDL satisfies the first factor not because of their non-profit status, but rather because the use is so transformative.⁴² Further, the district court added that the use of HDL to provide access for print-disabled patrons as especially transformative: “Print-disabled individuals are not considered to be a significant market or potential market to publishers and authors. As a result, the provision of access for them was not the intended use of the original work (enjoyment and use by sighted persons) and this use is transformative.”⁴³

On this factor, the Second Circuit disagreed with the district court’s finding that a use can be transformative by “[a]dded value or utility,” but rather that the “more transformative the new work, the less will be the significance of other factors . . . that may weigh against a finding of fair use.”⁴⁴ In regards to the full-text searching, the Second Circuit concluded that it is a “quintessentially transformative use.”⁴⁵ Because no evidence can be found that authors write with the purpose of enabling full-text searching, no original purpose is superseded by the secondary creation, rather “HDL adds to the original something new with a different purpose and a different character.”⁴⁶

However, the Second Circuit disagreed with the district court’s finding that print-disabled access is a transformative use.⁴⁷ They still ultimately conclude that the use is fair, but based on three other rationales. First, the Supreme Court in *Sony Corporation of America v. Universal City Studios, Inc.* stated that making available copies of a copyrighted work for print-disabled

⁴² *Id.*

⁴³ *Id.* (internal citations omitted).

⁴⁴ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

⁴⁵ *Authors Guild, Inc. v. HathiTrust*, 755 F.3d 87, 97 (2d Cir. 2014).

⁴⁶ *Id.*

⁴⁷ *Id.* at 101-02.

individuals is an “expressly identified . . . example of fair use.”⁴⁸ Second, the House Committee Report that accompanied the Copyright Act of 1976 also stated an intention that making copies of works for the purposes of print-disabled accessibility was a “special instance illustrating the application of the fair use doctrine”⁴⁹ Finally, the passage of the Americans with Disabilities Act demonstrates a Congressional commitment to providing better accommodations for the print-disabled.⁵⁰

2. Nature of the Copyrighted Works

The second factor looks to the nature of the copyrighted work and considers whether it is close to the “core of intended copyright protection.”⁵¹ However, the second factor has limited utility in the fair use analysis when there is a finding in the first instance that the character and purpose is transformative.⁵² Indeed, “the nature of the copyrighted works is not likely to ‘separate the fair use sheep from the infringing goats.’”⁵³

The district court rather briefly dismissed the second factor as “not dispositive,” because they already found the full-text searching and access for print-disabled patrons as transformative.⁵⁴ Similarly, the Second Circuit agreed that the works contained in the HDL are works that copyright laws seek to protect and thus weighs against fair use, but the transformative purpose of the use makes this factor’s weight minimal.⁵⁵

⁴⁸ *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 455 n.40 (1984), *superseded by statute*, Digital Millennium Copyright Act, Pub. L. No. 105-304, 112 Stat. 2860 (1998) (codified as amended at 17 U.S.C. § 1201).

⁴⁹ H.R. REP. NO. 94-1476, at 73 (1976).

⁵⁰ *Authors Guild*, 755 F.3d at 102.

⁵¹ *Authors Guild*, 902 F. Supp. 2d at 461.

⁵² *Id.* at 461-62.

⁵³ *Id.* (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 586 (1994)).

⁵⁴ *Id.* at 461.

⁵⁵ *Authors Guild*, 755 F.3d at 98, 102.

3. Amount and Substantiality of the Work Copied

The third factor “asks whether the secondary use employs more of the copyrighted work than is necessary, and whether the copying was excessive in relation to any valid purposes asserted under the first factor.”⁵⁶ Again, the findings as to the first factor impact the finding of the third, because the amount of allowable copying depends on the purpose and character of the use.⁵⁷

Here, the district court easily found that even though to operate HDL had to make entire copies of the print works, such copies were necessary to accomplish the purpose of full-text searching and access to print-disabled patrons.⁵⁸ The Second Circuit agreed that this factor weighed in favor of HathiTrust, because the copying, though entire, were not excessive or unreasonable when balanced against the purposes identified by HathiTrust.⁵⁹ The court rejected Authors Guild’s argument that HDL need not retain both a text and digital image file copy of the works, because the text files are required for the full-text searching and text-to-speech capabilities, while the image files are even more necessary as the main means of access for disabled patrons.⁶⁰

4. Effect on the Market for or Value of the Works

Finally, the fourth factor requires the court to “assess the impact of the use on the traditional market for the copyrighted work.”⁶¹ As “the single most important element of fair use,”⁶² “the copyright holder must point to market harm that results because the secondary use

⁵⁶ *Id.* at 96.

⁵⁷ *Authors Guild*, 902 F. Supp. 2d at 462.

⁵⁸ *Id.*

⁵⁹ *Authors Guild*, 755 F.3d at 98-99.

⁶⁰ *Id.* at 102-03.

⁶¹ *Id.* at 96.

⁶² *Id.*

serves as a substitute for the original work.”⁶³ Further, when a use is found to be noncommercial, like it was for HDL, the plaintiff is required to show that “some meaningful likelihood of future harm exists.”⁶⁴

The district court rejected Authors Guild’s first argument that each copy on HDL represents a “lost sale” that would have occurred had the defendants purchased another copy. Instead, the district court reasoned that such a purchase could not have enabled the transformative uses of full-text searching and print-disabled access.⁶⁵ Authors Guild’s second argument fared no better. The plaintiff’s argument that the availability of the digital copies on HDL exposes their author’s works to “widespread internet piracy” which could greatly disrupt the book’s market, was also rejected for failing to demonstrate the likelihood of any future harm in the face of HathiTrust’s showing of security measures in place.⁶⁶ Third, and lastly, Authors Guild argued that HDL will undermine existing and potential licensing opportunities, though concede they have no evidentiary proof of this future harm.⁶⁷ Indeed, HathiTrust countered that the cost of developing a licensing market for the purposes for which HDL uses the works, full-text searching and print-disabled access, would be entirely cost-prohibitive.⁶⁸

The Second Circuit, similarly concluded that the fourth factor weighs in favor of HathiTrust, and drew important weight on the distinction of the main type of economic harm that is considered by the courts – the harm to a traditional market that is caused because the secondary use is a substitute for the original. Drawing an analogy to book reviews, the Second

⁶² Harper & Row, Publishers, Inc. v. Nation Enter., 471 U.S. 539, 566 (1985).

⁶³ *Authors Guild*, 755 F.3d at 96.

⁶⁴ Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 451 (1984).

⁶⁵ *Authors Guild v. HathiTrust*, 902 F. Supp. 2d 445, 462 (S.D.N.Y. 2012).

⁶⁶ *Id.* at 462-63.

⁶⁷ *Id.* at 463.

⁶⁸ *Id.*

Circuit stated, that “[t]he only market harms that count are the ones that are caused because the secondary use serves as a substitute for the original, not when the secondary use is transformative.”⁶⁹ Like an author upset about a negative review who has no claim for harm, neither does Authors Guild have a complaint here. In regards to the print-disabled market specifically, the Second Circuit notes that the current market for handicap accessible books is so insignificant that “it is common practice in the publishing industry for authors to forgo royalties that are generated through the sale of books manufactured in specialized formats for the blind”⁷⁰

D. Conclusion & Impact

Ultimately, the district court and the Second Circuit reasoned that in weighing the fair use factors, the goals of copyright are best served by allowing the digitization of print materials rather than prohibiting it.⁷¹ The fact that the full-text searching does not divulge any in-copyright material, taken with the important social benefit to the public of providing print-disabled access, confirmed the court’s belief that the basic foundation of copyright law was furthered by the HDL.

The gap in time between the *HathiTrust* decision and the *Bridgeman* decision clearly affected the outcome of *HathiTrust*. A reliance by the general public and scholars alike on the availability of digitized works on the Internet exists in a way that it had not before. Had *HathiTrust* been decided at the same time as *Bridgeman*, it likely would have suffered the same fate. The emphasis now on transformative use allows courts to properly balance social cost with the cost for the copyright owner against a modern technological background.

⁶⁹ Authors Guild, Inc. v. HathiTrust, 755 F.3d 87, 99 (2d Cir. 2014).

⁷⁰ *Id.* at 103.

⁷¹ *Authors Guild*, 902 F. Supp. 2d at 464.

III. *Bridgeman* Revisited

A. The Fair Use Factors

An application of the fair use factors to the facts of *Bridgeman* and similar organizations and institutions, specifically art museums and their policies for digitizing their collections that create repositories of digital photographic reproductions of artworks would reach the conclusion that such a use would likely be considered fair. Despite exact and wholesale copying of artwork by Bridgeman's transformative purpose as an educational and cultural reference repository, as well as its minor effect on either the direct or secondary market, considered as a whole, would weigh in favor of Bridgeman.

1. Character and Purpose of the Use

Section 107 lists several noncommercial purposes that courts have traditionally regarded as fair use, including criticism and parody, scholarship, research, news reporting, and teaching.⁷² The commercial/non-commercial distinction that drives this factor "is not whether the sole motive of the use is monetary gain but whether the user stands to profit from exploitation of the copyrighted material without paying the customary price."⁷³ In other words, even though an entity may profit from their enterprise, the use is not necessarily commercial.

The use by Bridgeman and its counterparts does not fall easily or obviously within either of the two categorical distinctions. This sort of entity, claiming fair use, has never before been brought in front of the courts. While it serves purposes for research and education, it also profits from the licensing service it provides. Its function as an electronic reference database, weighs heavily towards a finding of non-commercialism. However, those looking to use the available digital images for even educational purposes will still be required to pay a licensing fee.

⁷² See 17 U.S.C. § 107 (2012).

⁷³ *Harper & Row, Publishers, Inc. v. Nation Enter.*, 471 U.S. 539, 562 (1985).

Arguably, very traditional non-commercial entities like libraries and museums also have widespread policies for charging for educational licenses too, despite typically being considered non-commercial. However, because Bridgeman operates solely as a third-party licensing body, the digital photographs would likely would be considered a commercial use.

However, the inquiry does not end there. Since *Campbell, Perfect 10 Inc. v. Amazon.com, Inc.*⁷⁴, *Harper & Row*, and now most significantly, *HathiTrust*, courts have placed heavy weight on whether or not the character and purpose of the use of the copyrighted works is transformative.⁷⁵ For a new work to be transformative, it must do “something more than repackage or republish the original copyrighted work,” rather, adding a new, further purpose or character.⁷⁶ However, a use in itself does not become transformative merely by making an important contribution to the purposes of copyright law.⁷⁷ In fact, the more transformative the new work is found to be, less significance will be placed on other factors, even commercialism, which might weigh against a finding of fair use.⁷⁸ In *Leibovitz v. Paramount Pictures Corp.* the Second Circuit posited that despite the profit motivations of the secondary use, their transformative purposes and characters were enough to weigh the first factor in favor of fair use.⁷⁹ In *Leibovitz*, Paramount’s photograph of Leslie Nielsen commissioned for the film *Naked Gun 33 1/3: The Final Insult* so closely resembled a photograph of Demi Moore by Leibovitz.

⁷⁴ *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d. 1146 (9th Cir. 2007).

⁷⁵ See Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978-2005*, 156 U. PA. L. REV. 549, 604 (2008) (for an empirical study of the “transformativeness doctrine” in fair use case law).

⁷⁶ *Authors Guild, Inc. v. HathiTrust*, 755 F.3d 87, 96 (2d Cir. 2014).

⁷⁷ *Id.*

⁷⁸ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

⁷⁹ *Leibovitz v. Paramount Pictures Corp.*, 137 F.3d. 109, 114 (2d Cir. 1998).

Even though the use was commercial, it was determined to be transformative because of its parodic commentary on the original.⁸⁰

The character and purpose of digitally photographing visual works for licensing, electronic reference, and cultural education is arguably a very transformative use. The physical experience of visiting a museum in person, is one that cannot easily be reproduced, and thus, has a different character and purpose from their digital counterparts.

Like in *Kelly v. Arriba Soft Corp.*, the commercial use should not weigh against fair use because the copies were incidental rather than exploitative and were used for a different purpose than the original.⁸¹ In *Arriba Soft*, Leslie Kelly, who was a professional photographer, maintained a website with thumbnail images of some of his works.⁸² Arriba Soft operated a search engine that displays thumbnail images instead of text and often populates its database by copying images from other website.⁸³ Certainly, it was the intended purpose of the photographers and their institutions that the photographs be exact likenesses of the original artwork, but it was not done with knowing bad faith. Whereas in *Harper & Row*, a journalist for *The Nation* magazine could not depend on a fair use defense when he published verbatim quotes from President Ford's memoirs which had not yet been published.⁸⁴ Rather, the use here is merely one that is already a well-established practice by museums and libraries alike. The Ninth Circuit in *Perfect 10* reasoned that a search engine's use of thumbnail images "provides social benefit by incorporating an original work into a new work, namely, an electronic reference tool."⁸⁵ Here,

⁸⁰ *Id.*

⁸¹ *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 818–19 (9th Cir. 2003).

⁸² *Id.* at 815.

⁸³ *Id.*

⁸⁴ *Harper & Row, Publishers, Inc. v. Nation Enter.*, 471 U.S. 539, 562 (1985).

⁸⁵ *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d. 1146, 1165 (9th Cir. 2007); *see also* Beebe, *supra* note 75, at 604.

the use of images in the way that Bridgeman does, is very similar to the providing of an electronic reference tool. The use of course, is most similar to the transformative use found in *HathiTrust*, focusing heavily on HDL's ability to provide beneficial full-text search.

Bridgeman's assemblage of digital images of visual works from all over the world are searchable by artist, style, period, museum or institution, and medium, to name only a few.

Ultimately, the digital images serve a different function from that of the tangible, visual artworks that hang in museums and galleries all over the world. They provide an opportunity for dissemination of the works to promote cultural and educational aims which might otherwise not be available, except in a physical visit to view the visual work.

2. Nature of the Copyrighted Works

The second factor recognizes that there is a hierarchy of copyright protection in which original, creative works are afforded greater protection than derivative works or factual compilations.⁸⁶ In *Campbell* and in *HathiTrust*, the nature of the original copyrighted work was an artistic creation that very much falls close to the "core of intended copyright protection."⁸⁷ The visual artwork from which Bridgeman's digital photographs are taken, are quintessential examples of core protected works. However, this factor is hardly ever found to be determinative in the evaluation of all the factors and is usually given very little weight.⁸⁸ Therefore, even a finding on this factor against a defendant does not end the analysis.

⁸⁶ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 586 (1994).

⁸⁷ *Id.*

⁸⁸ *On Davis v. The Gap, Inc.*, 246 F.3d 152, 175 (2d Cir. 2001).

3. Amount and Substantiality of the Work Copied

The third factor inquires whether more copying than necessary was used and whether or not that copying was excessive.⁸⁹ Because a conclusion on whether copying is excessive depends on the purpose and character of the use,⁹⁰ sometimes it is necessary to copy entire works, and the factor does not weigh against a finding of fair use.⁹¹ For example, in *Bill Graham Archives v. Dorling Kindersley Ltd.*,⁹² *Arriba Soft*,⁹³ and *Perfect 10*,⁹⁴ entire images were copied but were deemed necessary for recognition and to further the ultimate purpose of the secondary use. Because even “wholesale copying” can be protected where the “use and purpose for the copies was clearly distinguishable from those of the original,” a finding of a transformative use may make Bridgeman’s intentionally identical digital photographs of visual artwork necessary.⁹⁵

4. Effect on the Market for or Value of the Works

A finding of commerciality is not necessarily dispositive of a finding against fair use. “The strength of the *Sony* presumption may vary according to the context in which it arises, and the presumption disappears entirely where the challenged use is one that transforms the original work into a new artistic creation.”⁹⁶ In other words, the *Sony* presumption effectively lost its bite when the Supreme Court stated in *Campbell* that “*Sony* stands for the proposition that the ‘fact

⁸⁹ *Authors Guild, Inc. v. HathiTrust*, 755 F.3d 87, 98 (2d Cir. 2014).

⁹⁰ *Campbell*, 510 U.S. at 586-87.

⁹¹ *Authors Guild*, 755 F.3d at 98.

⁹² *Bill Graham Archives v. Dorling Kindersley Ltd.*, 448 F.3d 605, 613 (2d Cir. 2006) (holding that the defendant’s use of Bill Graham Archives’ images “is tailored to further its transformative purpose because DK’s reduced size reproductions of BGA’s images in their entirety displayed the minimal image size and quality necessary to ensure the reader’s recognition of the images.”).

⁹³ *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 821-22 (9th Cir. 2003) (“It was necessary for Arriba to copy the entire image to allow users to recognize the image and decide whether to pursue more information about the image or the originating web site. If Arriba only copied part of the image, it would be more difficult to identify it, thereby reducing the usefulness of the visual search engine.”).

⁹⁴ *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1168 (9th Cir. 2007) (holding that the same analysis applies to Google’s use of Perfect 10’s image).

⁹⁵ *Authors Guild v. HathiTrust*, 902 F. Supp. 2d 445, 460 (S.D.N.Y. 2012).

⁹⁶ *Princeton Univ. Press v. Mich. Document Serv., Inc.*, 99 F.3d 1381, 1386 (6th Cir. 1996).

that a publication was commercial as opposed to nonprofit is a separate factor that tends to weigh against a finding of fair use.”⁹⁷ Therefore, if the use is found to be commercial, there is a tendency towards unfairness in “mere duplication” that effectively replaces the market for the original. However, a use that is non-commercial requires the plaintiff asserting market harm to carry the burden of proving either harm on the potential market or to the potential value of the original.⁹⁸

Any inquiry begins with determining what exactly is the market or markets at issue. First, the new work’s effect on the market or value of the original work is evaluated. The digital photographs of the artwork are not being proffered as fine art like the originals. They are not sold in galleries with the hopes of being mistaken as the original itself, nor are they being sold as new editions of previously published works. The market for the original market, therefore, is untouched. Neither is the value of the original visual art likely to be affected by its digitization. In fact, quite the opposite seems possible. As the visual artwork becomes more notable in the public mind, so too does the value of the artwork itself. Therefore, the primary market and the value of the original is unaffected by making digital photographic copies of the visual work.

The secondary, or derivative market is arguably affected – licensing is essentially monopolized by one organization, but this is a hazard these organizations have chosen to bear. Museums and libraries have already taken this into account, just as the participating libraries in HathiTrust did, in their original agreement with Google. Many have chosen to forego individual licenses (which in many cases they still reserve the right to grant) in favor of this larger one to Bridgeman-like organizations. Even for the museums and libraries that license individually

⁹⁷ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 585 (1994) (quoting *Harper & Row, Publishers, Inc. v. Nation Enter.*, 471 U.S. 539, 562 (1985)).

⁹⁸ *Id.* at 591; *see also, Princeton*, 99 F.3d at 1386.

without third-party assistance, a holding contrary to one in favor of fair use on that factor would affect their potential market just as considerably.

Just as transformativeness plays a significant role in the evaluation of the other factors, so too does it play a role in the analysis of the fourth factor. The Second Circuit, in *HathiTrust* held that a copyright holder cannot detrimentally effect a transformative market.⁹⁹ “Were a court automatically to conclude in every case that potential licensing revenues were impermissibly impaired simply because the secondary user did not pay a fee for the right to engage in the use, the fourth factor would *always* favor the copyright owner.”¹⁰⁰ Therefore, even if the museums and libraries digitally photographing the digital works do not seek a licensing agreement from the artist (though in many cases they do), a loss to a potential licensing market is not enough, because theoretically every fair use case begins because of failures to license.

IV. Conclusion

It seems that for many, the *Bridgeman* holding is in practice, superfluous.¹⁰¹ Museums and other similar organizations, even monoliths like the Art Institute of Chicago and the Metropolitan Museum of Art, continue to license and assert copyright in their photographic reproductions despite a shaky or nonexistent legal basis for their claims of copyright ownership.¹⁰² Such museums have been able to rely on the social pressure and past practices that exist within the museum world regarding each organization’s intellectual property. Some even argue that because *Bridgeman* has never been affirmed on the appellate level, its holdings apply

⁹⁹ Authors Guild, Inc. v. HathiTrust, 755 F.3d 87, 103 (2d Cir. 2014).

¹⁰⁰ Am. Geophysical Union v. Texaco Inc., 60 F.3d 913, 929 (2d Cir. 1994).

¹⁰¹ Mary Campbell Wojcik, *The Antithesis of Originality: Bridgeman, Image Licensors, and the Public Domain*, 30 HASTINGS COMM. & ENT. L.J. 257, 270-72 (2008).

¹⁰² *Id.*

only to the Southern District of New York.¹⁰³ This may well be the case, but here is what we do know:

Any museum that argues the inapplicability of Judge Kaplan's rulings should trade its myopic focus on *Bridgeman* for a clear view of the larger copyright landscape. Because in this landscape one holds no copyright in faithful copies of works that have passed into the public domain, in it, *Bridgeman* is only a single instance among many.¹⁰⁴

Obviously, this is problematic. However, this illustrates the system that has been in place before (and after) *Bridgeman*, has become seriously ingrained, for better or worse, and there is a heavy dependency on its continued existence.

A conclusion that the fair use doctrine applies and allows digital photographic reproductions to be made of works of art, even if effective, still cannot overcome the originality issue that was central to the *Bridgeman* holding as it applies to works in the public domain. From a policy perspective, allowing photographic reproductions of visual artwork as protected through fair use is preferable to the contractual licensing obligations museums would otherwise have to secure, which would certainly be more limiting. As a result, revenue would be taken from museums, the creation of high-quality reproductions would be discouraged, and most importantly, the public would be restricted in its global access to artwork generally. However, as it applies to works still under copyright, under the current rule, museums have very little incentive to continue to make high-quality reproductions of their artwork. It is unlikely that anyone outside of the museum would be inclined to produce reproductions of artworks in a museum's collection, especially so if the work is under the public domain.

It is undoubtable that had *Bridgeman* been decided today, the outcome would have been different. The same can be said for *HathiTrust*, had it been decided in 1999. Copyright law has

¹⁰³ Colin T. Cameron, *In Defiance of Bridgeman: Claiming Copyright in Photographic Reproductions of Public Domain Works*, 15 TEX. INTELL. PROP. L.J. 31, 47 (2006).

¹⁰⁴ Wojcik, *supra* note 101, at 272.

changed – largely due to the advances and reliance on digital technologies – and should, as a result, be followed with a change in the law.